

March 2, 2012

Via Electronic Mail
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Mail Stop Comments - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Hiram H. Bernstein

IBM Corporation Comments in response to “Changes to Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act,” 77 Fed. Reg. 982 (January 6, 2012)

IBM fully supports the efforts of the United States Patent and Trademark Office (“Office”) to implement the Inventor’s Oath or Declaration provisions of the Leahy-Smith America Invents Act. We thank the Office for the opportunity to provide our views regarding the proposed changes.

We support the majority of the rule changes proposed in the subject notice (“Notice”). However, we believe that the following provisions raise some concerns and require clarification from the Office.

Proposed Rule 3.73(b)(2)(iii)

The proposed rule provides, in part, “... a patent practitioner of record pursuant to 37 CFR 1.32 could sign a statement under 37 CFR 3.73(b).” Further, the Office states that the patent practitioner’s signature will be accepted “without requiring further evidence of the practitioner’s authority to act on behalf of the assignee.”

Proposed Rule 3.73(b)(2)(iii) gives significantly more authority to patent practitioners than an assignee may otherwise explicitly authorize. A large number of patent practitioners may be involved in the preparation and prosecution of patents for an assignee. While a Power of Attorney (POA) limits patent practitioners to act in a limited number of the assignee’s patent applications, allowing each one of the many patent practitioners to be able to act on behalf of the assignee without formal authorization from the assignee in

regards to matters that require signing of the statement under 37 CFR 3.73(b) could result in situations where patent practitioners take actions in patent applications that are not in line with the assignee's wishes or interests. Also, the assignee may not become immediately aware of undesirable actions that were taken by patent practitioners thereby potentially limiting any corrective action(s) that may be available for the assignee to take.

IBM suggests that the Office does not implement proposed Rule 3.73(b)(2)(iii). Only individuals who are authorized to act on behalf of the assignee should be able to sign a statement under 37 CFR 3.73(b).

Office suggestion to obtain Power of Attorney (POA) from Assignee

The Office states in the Notice (see page 986, column 2) that “[t]he power of attorney should be from the assignee where one exists.” The current process to enter the power of attorney from the assignee (“POA from assignee”) requires processing and filing of the POA from assignee documents after the filing of patent application documents. For example, PTO/SB/96 (statement under 37 CFR 3.73(b)) requires entry of specific application data (e.g., application number and filing date) which are only available after filing of the patent application. As such, an applicant must perform an additional filing step for the POA from assignee documents.

IBM suggests that the Office simplify the process relating to the POA from assignee such that a POA from assignee document(s) may be filed concurrently with the filing of patent application documents. For example, the Office could require that when POA from assignee documents are filed concurrently with an application, then entry of the application number and filing date on PTO/SB/96 are not required.

Conclusion

IBM thanks the Office for providing the public an opportunity to comment on its proposed changes to implement the Inventor's Oath or Declaration provisions of the Leahy-Smith America Invents Act. We remain committed to work with the Office in developing improvements to the patent procurement process to promote efficiency and patent quality.

Respectfully submitted,

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