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Insights

U.S. PATENT & TRADEMARK OFFICE UPDATE: RCE RULE 1.114 ENFORCEMENT CHANGE

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The United States Patent & Trademark Office ("USPTO") recently changed its enforcement of 37 C.F.R. 1.114(e)(3) as it relates to an inventor's oath or declaration, and the change may impact U.S. national stage applications going forward.

A Request for Continued Examination ("RCE") is commonly used to continue patent prosecution after the USPTO issues a final office action during its consideration of a patent application. 37 C.F.R. 1.114 ("Rule 1.114") sets forth certain RCE requirements and limitations, and expressly states that its provisions do not apply to, *inter alia*, "[a]n international application filed under 35 U.S.C. 363 before June 8, 1995, or an *international application that does not comply with 35 U.S.C. 371*" (Rule 1.114(e)(3), italics added). This exception is noteworthy because an applicant for an international application under 35 U.S.C. § 371(c)(3) shall file "an oath or declaration of the inventor."

The USPTO has taken the position that, in order to file an RCE off of a national stage application, an oath or declaration of the inventor must be filed before or with the filing of an RCE. The USPTO's position is based upon its assessment that national stage applications without an inventor's oath or declaration do not comply with 35 U.S.C. § 371 and, therefore, are unavailable for an RCE under Rule 1.114(e)(3). MPEP 706.07(h); 80 Fed. Reg. 17918, 17930 (April 2, 2015). It is noteworthy that the USPTO has taken this position notwithstanding other rules that permit filing an inventor's oath or declaration in a national stage application "no later than the date on which the issue fee for the patent is paid." 37 C.F.R. 1.495(c)(3)(ii).

In practice, the USPTO's interpretation of Rule 1.114(e)(3) is that an applicant's filing of an RCE has no effect in a U.S. national stage application unless an inventor's oath or declaration is already of-record or is contemporaneously filed with the RCE. Absent that, the application will be deemed abandoned six months after the final office action's mailing date. The USPTO's interpretation of Rule 1.114(e)(3), while previously disclosed, had not been enforced. Until now.

Recently, the USPTO has begun identifying pending national stage applications with RCEs that were filed without an inventor's oath or declaration, or where the oath or declaration was filed after the filing of the RCE. For those applications, the USPTO is issuing retroactive notices of abandonment on the basis that a proper reply to a final office action was not timely filed. It is our understanding

that, in some cases, these notices of abandonment are issuing even where there have been several years of continued prosecution of the application subsequent to the filing of the RCE. It appears that one method available to remedy the retroactive abandonment determination is filing a petition to revive, paying the requisite fee(s), and submitting any missing inventor's oath(s) or declaration(s).

This change in the USPTO's enforcement of Rule 1.114(e)(3) illustrates the importance of timely filing an inventors oath or declaration in all 35 U.S.C. § 371 national stage applications before an RCE is filed to avoid a potential abandonment.

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