Changes to the Patent Rules

October 24, 2000

This is the second in a series of Patent News Bulletins to assist you in keeping up to date with significant rule changes which affect your area. Keep this copy to use as a bookmark for your present MPEP, or view this bulletin again on the USPTO Website http://www.uspto.gov/web/offices/com/ola/pbg/index.html.

Supervisory Patent Examiners are advised to use the latest version of 37 CFR 1.324 when deciding petitions to correct inventorship under 37 CFR 1.324. Form Paragraph 10.16 has been modified to reflect the change and will be available in the Office Action Correspondence Subsystem (OACS) in the near future.

The body of the text of Form Paragraph 10.16, as modified, is as follows:

“A petition to correct inventorship as provided by 37 CFR 1.324 requires (1) a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part, (2) a statement from the current named inventors who have not submitted a statement as per "(1)" either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change, (3) a statement from all assignees of the parties submitting a statement under ",(1)" and "(2)" agreeing to the change of inventorship in the patent; (such statement must comply with the requirements of 37 FR 3.73(b); and (4) the fee set forth in 37 FR 1.20(b). This petition lacks item(s) __.”

MPEP 1481

Correction of Inventorship in a Patent.
37 CFR 1.324

Effective September 8, 2000.

37 CFR 1.324(b)(1) is amended to eliminate the requirement for a statement from an inventor being deleted stating that an inventorship error occurred without deceptive intent. The change is made to conform Office practice to Stark v. Advanced Magnetics, Inc., 119 F.3d 1551, 43 USPQ2d 1321 (Fed. Cir. 1997), which held that 35 U.S.C. 256 only requires inquiry into the intent of a nonjoined inventor. It should be noted, however, that 37 CFR 1.324(b)(2) still requires a statement from the current named inventors either agreeing to the requested change or stating that they have no disagreement in regard to the requested change. Thus, an inventor being deleted from a patent must submit a statement under 37 CFR 1.324(b)(2).

37 CFR 1.324(b)(2) in combination with 37 CFR 1.324(b)(1) ensures compliance with the requirement of 35 U.S.C. 256 for application for correction of inventorship in a patent by all parties. This requirement is separate from the requirement that certain parties address the lack of deceptive intent in the inventorship error.

An inventor being deleted from a patent does not have to state that the inventorship error occurred without deceptive intent.