

NOW +

NEXT

INTELLECTUAL PROPERTY ALERT | NIXON PEABODY LLP

FEBRUARY 11, 2021



National Stage applications in flux as USPTO shifts course on rules governing RCE practice

By Kevin Gualano and Ben Rosborough

The U.S. Patent and Trademark Office (“USPTO”) has begun issuing Notices of Abandonment in U.S. National Stage applications where a Request for Continued Examination (“RCE”) was filed prior to inventor declarations. This is a change in USPTO procedure and has occurred concurrently with the June 2020 revision of the Manual of Patent Examining Procedure (“MPEP”). The full effect of this change has yet to be determined, but it presents new challenges for patent applicants and owners.

RCEs and declarations

RCE practice is not new, and has for years allowed a patent applicant to re-open prosecution. However, the governing USPTO rule (37 C.F.R. § 1.114) was amended in 2015 to confirm that RCE practice does not apply to “an international application that does not comply with 35 U.S.C. 371.” Section 371 provides the statutory requirements for international applications entering the U.S. National Stage. This section sets a time limit for filing inventor declarations “by the date of the commencement of the national stage or by such later time as may be fixed by the Director.” The latter statement of “or by such later time as may be fixed by the Director” creates the problem. The corresponding rule (37 C.F.R. § 1.495) provides that if the National Stage application is filed with an application data sheet identifying the inventors by name and address, the requirement to file the inventor declarations “may be postponed until the application is otherwise in condition for allowance.” Although it appears that patent applicants can postpone filing inventor declarations until an application is otherwise in condition for allowance, the question arises whether such an application complies with 35 U.S.C. § 371 for the purpose of RCE practice.

The USPTO’s interpretation

The Patent Office’s recent change in procedure answers the question to the detriment of weary patent applicants. In the June 2020 revision to the MPEP, the Patent Office provided:

For an effective request for continued examination (RCE) to be filed in a 35 U.S.C. 371 national stage application, all required inventor’s oaths or declarations (or substitute statements) must be submitted in the application prior to or with the RCE, notwithstanding 37 CFR 1.495(c)(3) permitting an inventor’s oath or

declaration to be postponed until an application is otherwise in condition for allowance. In accordance with 37 CFR 1.114(e), an RCE cannot be filed in an international application that does not comply with 35 U.S.C. 371; 35 U.S.C. 371(c)(4) requires submission of the oath or declaration by the inventor(s) or a substitute statement. (§ 706.07(h))

The basis for this change was the 2015 amendment to the USPTO's rules governing RCE practice. In that amendment, the USPTO indicated that national stage applications do not comply with § 371 until inventor declarations are filed, and thus RCE practice does not apply to such national stage applications—even though the USPTO specifically allows for later filing of inventor declarations. But despite this amendment occurring in 2015, the USPTO has only now decided to implement the change in procedure by sending out Notices of Abandonment in U.S. national stage applications where an RCE was filed before inventor declarations. It is not clear why the USPTO did not enforce this position until now. But, with the June 2020 revisions to the MPEP that expressly state that an RCE cannot be filed prior to the inventor declarations, it does appear that the USPTO will be enforcing this position moving forward.

How to address pending and future applications

Given the USPTO's new enthusiasm for enforcing this rule, there are a number of strategies for practitioners to keep in mind. For National Stage applications where prosecution has not yet closed, the strategy is simple—strive to file the inventor declarations well in advance of the filing of any RCE. For National Stage applications where the applicant has received a notice of abandonment for failing to file a proper RCE, the strategy again appears simple—file a petition to revive the unintentionally-abandoned application, along with the appropriate fee and the inventor declarations.

However, the less straightforward case is applications and patents where an RCE has been filed without the inventor declarations being filed but no notice of abandonment was received. At this time, the prudent approach may be to hold off on acting in response to the USPTO's change in procedure until the dust settles.

For more information on the content of this alert, please contact your Nixon Peabody attorney or:

- Kevin Gualano, 312-425-8526, kgualano@nixonpeabody.com
 - Ben Rosborough, 312-425-3944, brosborough@nixonpeabody.com
 - Jeffrey Costellia, 202-585-8207, jcostellia@nixonpeabody.com
-