

From: Blanco White, Henry [e-mail address redacted]
Sent: Tuesday, January 10, 2012 3:44 PM
To: oath_declaration
Subject: RE: Notice of Proposed Rulemaking, 77 FR 982

Suggested amendment:

In Rule 1.63(a)(5), after "inventor" insert ", except where 35 U.S.C. 115(d) applies"
In Rule 1.497(b)(5), after "inventor" insert ", except where 35 U.S.C. 115(d) applies"

Reason:

In the circumstances enumerated in 35 U.S.C. 115(d)(2), the statement required by proposed Rules 1.63(a)(5) and 1.497(b)(5) will usually not be true. An applicant should not be required to make a statement that is not true.

The suggested amendment is proper, because proposed Rules 1.63(a)(5) and 1.497(b)(5) are based on new 35 U.S.C. 115(b)(1), but 115(b) applies only to declarations under 115(a), not to "substitute statements" under 115(d).

The views expressed in this message are my personal views, and do not necessarily represent the views of any law firm with which I may be associated, or of any client of mine or of any such law firm.

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