

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



How to avoid common application filing issues

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Processing

United States Patent and Trademark Office

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Documents must be properly signed

- If you are working with a registered practitioner, the practitioner may sign documents, even if you have not appointed him or her to have power of attorney.
- If you are not working with a registered practitioner and there is no applicant named on an application data sheet (ADS), all inventors must sign each document/submission.
- If you are not working with a registered practitioner and there is no applicant named on an ADS, all inventors may appoint one or more of the inventors to prosecute the application on everyone's behalf:
 - Each inventor must sign the form, even the one being appointed.
 - PTO/AIA/81 may be used.



Powers of attorney: AIA/81

PTO/AIA/81 (07-13)
Approved for use through 11/30/2014. OMB 0651-0035
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

POWER OF ATTORNEY TO ONE OR MORE OF THE JOINT INVENTORS AND CHANGE OF CORRESPONDENCE ADDRESS	Application Number	
	Filing Date	
	First Named Inventor	
	Art Unit	
	Examiner Name	
	Title	

NOTE: This form may be filed by *pro se* inventors (i.e., prosecuting the application without a registered patent practitioner) who are identified as the Applicant in the above-identified application. For a Power of Attorney to one or more registered patent practitioners, see form PTO/AIA/82.

I hereby revoke all previous powers of attorney given in the above-identified application.

I hereby appoint the following joint inventor(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

Please recognize or change the correspondence address for the above-identified application to:

The address associated with Customer Number, (if applicable):
-To Request A Customer Number see form PTO/SB/124

OR

Individual Name

Address

City State Zip

Country

Telephone Email

I am the Inventor.

SIGNATURE of inventor

Signature		Date	
Name		Telephone	

NOTE: Signatures of all the inventors are required. Submit multiple forms if more than one signature is required, see below. See 37 CFR 1.4 for signature requirements and certifications.

*Total of forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is, in part, by the

- For applications filed on/after September 16, 2012.
- AIA/81 is used by *pro se* joint inventors who are the applicants to give power of attorney to one or more of them.
- The appointed inventor(s) must also submit a signed form.



Signatures must be properly formatted

- Signatures can be handwritten or electronic signatures.
- If the signature is not properly formatted, the document will be considered to be unsigned.
- Unsigned documents/submissions will not be accepted or entered into the file record.

S-signature – 37 CFR 1.4(d)(2)

- An S-signature must consist only of letters (including Kanji, etc.) or Arabic numbers, or both, and appropriate spaces, commas, periods, apostrophes, or hyphens for punctuation.
- The person signing must insert his or her own signature between single forward slash marks (§ 1.4(d)(2)(i)).
- The name of the person signing must be printed or typed immediately adjacent to (i.e., below, above, or beside) the S-signature and be reasonably specific, so the identity of the signer can be readily recognized.
- A registered practitioner may S-sign, but his or her registration number is required, either as part of the S-signature, or immediately below or adjacent to the signature (§ 1.4(d)(2)(ii)).
 - For example: /John Attorney Reg. #999999/
 - John Attorney

Handwritten signature – 37 CFR 1.4(d)(1)

- A handwritten signature must:
 - Be an original, that is, be an original handwritten signature personally signed, in permanent dark ink or its equivalent, by that person; or
 - Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original.
 - In the event that a copy of the original is filed, the original should be retained as evidence of authenticity.
 - If a question of authenticity arises, the USPTO may require submission of the original.
- There is no requirement for a printed name to accompany a handwritten signature.

Additional signatures

- When using web-based forms on the USPTO.gov website, additional signatures can be added to the form by clicking the “Add” button.
- Forms other than those from the USPTO.gov website will need to include additional signatures by other means.
- The USPTO strongly encourages the use of the web-based forms.

Signature:				
NOTE: This Application Data Sheet must be signed in accordance with 37 CFR 1.33(b). However, if this Application Data Sheet is submitted with the INITIAL filing of the application and either box A or B is not checked in subsection 2 of the “Authorization or Opt-Out of Authorization to Permit Access” section, then this form must also be signed in accordance with 37 CFR 1.14(c).				<input type="button" value="Remove"/>
This Application Data Sheet must be signed by a patent practitioner if one or more of the applicants is a juristic entity (e.g., corporation or association). If the applicant is two or more joint inventors, this form must be signed by a patent practitioner, all joint inventors who are the applicant, or one or more joint inventor-applicants who have been given power of attorney (e.g., see USPTO Form PTO/AIA/81) on behalf of all joint-inventor applicants.				
See 37 CFR 1.4(d) for the manner of making signatures and certifications.				
* Signature	<input type="text"/>			(EXAMPLE: /John Smith/)
* First Name	<input type="text"/>	* Last Name	<input type="text"/>	Registration Number <input type="text"/>
Additional Signature may be generated within this form by selecting the <input type="button" value="Add"/> button.				

Submission methods

- Regular USPS mail with Certificate of Mailing (37 CFR 1.8)
- USPS Priority Mail Express[®] Post Office to Addressee service (37 CFR 1.10)
- EFS-Web (registered users only)
- Documents required for a filing date cannot be faxed

Application Data Sheet (ADS)

- The USPTO strongly recommends submitting an ADS with the application at the time of filing rather than after filing the application.
 - An ADS submitted after filing must be properly marked up.
 - Establishment of an applicant after filing must be accompanied by a 3.73(c) statement showing complete chain of title.
 - Benefit claims must be timely submitted.

Application Data Sheet (ADS)

- ADS submitted upon filing
 - Must be properly signed as above
 - Properly formatted
 - Signed by everyone who needs to sign
 - Will establish inventorship
 - Will establish applicant, when provided
 - Will present domestic and foreign benefit claims
 - Will not establish power of attorney or micro entity status

Application Data Sheet (ADS)

- If the ADS is not signed, or not properly signed, it is treated as a transmittal letter only.
 - Will not set inventorship or applicant.
 - Will not establish benefit or priority claims.
 - Most information is disregarded and captured from other sources.
 - Information captured from other sources will become “of record.”
 - Any changes made later must be on a properly marked-up ADS.

Application Data Sheet (ADS)

- The Office of Patent Application Processing (OPAP) will capture information as it is provided; we will not attempt to correct:
 - Transposed or seemingly misspelled names
 - Misspelled words in title
 - Incorrect application numbers in domestic benefit/priority claims

Inventorship

- Inventor names listed on a properly signed ADS are the inventors who are established in the application.
- Suffixes (Jr., Sr., etc.) are used to confirm proper signatures on inventor's oath and other documents.
- Each inventor must provide his or her mailing address, city of residence, and state or country of residence.

ADS and inventor's oath/declaration

- When the ADS sets inventorship, the name provided on the inventor's oath or declaration must match the name set forth on the ADS.
 - Both documents require legal name.
 - If names do not match, a new inventor's oath or declaration or § 1.48 request will be needed.
 - Exception for character substitution for characters that cannot be entered on ADS (for example: ss for ß, ae for ä, oe for œ).

Application Data Sheet (ADS)

- Docket numbers are recommended for the applicant's identification purposes, especially when the applicant has filed multiple applications.
- Customer numbers are issued by the USPTO; only use a customer number that has been provided by the USPTO when designating the correspondence address.
- Filing by Reference (FBR, Reference Filing) is a very specialized process that should only be used in limited circumstances.

Filing by Reference

- Filing by Reference is **not the same** as claiming domestic benefit or foreign priority.
- Filing by Reference cannot be corrected, rescinded, or deleted once a filing date is granted for the application.
- Filing by Reference requires that a prior specification is used; newly written specification is not permitted.
- Allows applicant to file application and obtain filing date before submitting the specification and drawings.

Reference Filing Statement

- Relies on the specification and drawings of a prior application, not a new specification and drawings.
- Provides application number, filing date, and intellectual property authority of the prior application.
- Must be made upon filing an ADS in English.
- Filing date is based on the statement, not a specification document.

Domestic benefit/foreign priority

- Domestic benefit or foreign priority data only captured from ADS; no consideration given to specification or any other document.
- Benefit claims are captured as provided on ADS.
- OPAP does not attempt to correct benefit claims that are incomplete, incorrect, or improperly formatted.

ADS – common problems

- Common problems with the ADS:
 - Not properly signed with correct slashes and registration number, or not all inventors – invalidates ADS.
 - Inventor residence not completed properly (city or state/country missing, invalid country name provided).
 - Domestic benefit or foreign priority data incomplete, incorrect, or improperly formatted.
 - Domestic benefit or foreign priority claims not timely (must be presented within the later of four months from the actual filing date of the later-filed application or 16 months from the filing date of the prior-filed application (except in design applications)).

Specification

- Necessary for a filing date, except for FBR.
- Must have written description of the invention.
- Must be in English or have an English translation.
- Fee for more than 100 pages of specification, claims, abstract, appendices, and drawings.

Specification

- The first specification that contains sufficient disclosure of the invention will establish the filing date and be the specification of record.
- If a filing date is not granted, there is no specification of record.
- Any corrections required must be relative to the specification of record.

Specification

- Paper, language, writing, and margin requirements:
 - 1.5 or double spacing
 - Sufficient clarity (font, font size, not handwritten, white background)
 - No missing or illegible text or pages
 - Brief description of figures (if drawing figures are submitted)
 - Landscape orientation
 - No embedded figures

Application size

- Specification, claims, and abstract
- Drawing sheets
- Application parts (specification, drawings) added by petition or as a required response to a Notice
- Appendices
- Computer program listing filed in paper
 - If filed in electronic form, it is excluded from application size calculation
- Tables submitted as an ASCII file are counted as one sheet of paper for each 3 KB of content

Claims

- Recommended to be submitted upon filing (surcharge if submitted after filing)
 - For design application, necessary for a filing date
- In English
- Fee for total claims over 20, independent claims over three, and for presence of multiple dependent claims
- Must commence on a separate page
- Same paper, language, writing, and margin requirements as specification

Abstract

- Present and in English
- Must commence on a separate page
- Same paper, language, writing, and margin requirements as specification

Drawings

- Proper labeling
 - Drawing figure labeling must correlate with figure number described in specification
 - “Fig.” or “Figure” followed by Arabic numerals or Arabic numerals with single letter (Fig. 1, Fig. 2, Fig. 3, etc. or Figure 1a, Figure 1b, Figure 2a, Figure 2b, etc.)
 - In English
- Line drawings
- Proper margins and orientation
- Clarity (erasures, background, blurry, weight of lines)
- No extraneous text, captioning

Figure labeling

- Figures must be labeled in the same manner they are described.
 - Numbering of the figures must be consistent with the numbering in the brief description of the drawings.

Figure labeling

- Brief description:
 - Fig. 1 is a smiley face.
 - Fig. 2 is a heart shape.

Figures:



Fig. 1



Fig. 2

Figure labeling

- Brief description:
 - Fig. 3 is a group of mathematical symbols. Fig. 3a is a plus sign, Fig. 3b is a minus sign, Fig. 3c is a multiplication sign, and Fig. 3d is a division sign.

Figures:

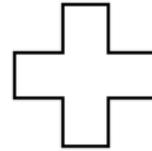


Fig. 3a

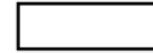


Fig. 3b

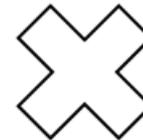


Fig. 3c

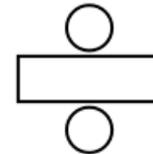


Fig. 3d

Fig. 3

Figure labeling

- Brief description:
 - Fig. 3a is a plus sign.
 - Fig. 3b is a minus sign.
 - Fig. 3c is a multiplication sign.
 - Fig. 3d is a division sign.

Figures:

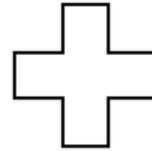


Fig. 3a

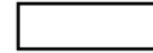


Fig. 3b

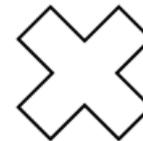


Fig. 3c

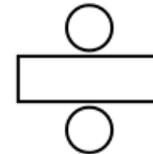


Fig. 3d

Fig. 3

Figure labeling

- Brief description:
 - Fig. 3 is a group of mathematical symbols. Fig. 3a is a plus sign, Fig. 3b is a minus sign, Fig. 3c is a multiplication sign, and Fig. 3d is a division sign.
 - (There is no Fig. 3 in the example.)

Figures:

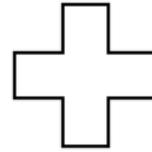


Fig. 3a



Fig. 3b

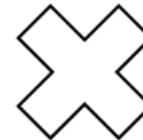


Fig. 3c

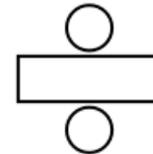


Fig. 3d

Fig. 3

Figure labeling

- Brief description:
 - Fig. 3a is a plus sign.
 - Fig. 3b is a minus sign.
 - Fig. 3c is a multiplication sign.
 - Fig. 3d is a division sign.
 - (There is a Fig. 3 shown, but no corresponding description provided.)

Figures:

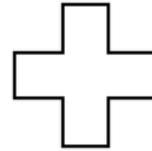


Fig. 3a



Fig. 3b

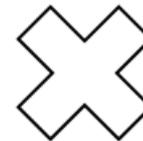


Fig. 3c

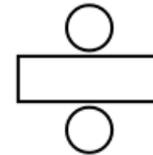


Fig. 3d

Fig. 3

Fees

- Filing fees paid in full (surcharge if submitted after filing date)
 - Non-electronic filing fee for applications submitted in hard copy (mailed or hand-carried to the USPTO)
 - Excess claims fees
 - Application size fees
 - Fees for large sequence listing submitted/transferred
 - Other fees as applicable
- Fees paid according to the entity status established at the time of payment

Forms of payment

- Credit card payment
 - Must be signed by authorized user
 - Must be specific about fees to be paid
- Check or money order
- Deposit account can be set up with the USPTO
 - www.uspto.gov/learning-and-resources/fees-and-payment/deposit-account-rules-and-information
 - Easily pre-authorize payment of fees



Micro entity certification

- Identified with correct information
 - Inventor name spelled as provided on the ADS or inventor's oath
 - Title matches ADS or title of record
 - Application number, if provided, is that of current application (not parent or prior-filed)
- Properly signed

CERTIFICATION OF MICRO ENTITY STATUS (GROSS INCOME BASIS)	
Application Number or Control Number (if applicable):	Patent Number (if applicable):
First Named Inventor:	Title of Invention:

Micro entity certification

- Fees paid in micro entity amounts will be “held” in those amounts until:
 - Problems with micro entity certification are resolved, or
 - Fees are paid in full under the established entity status.
- Surcharge will be due when fees are not paid in full at the time of filing.
- Fees paid in full in higher amounts are not refundable upon later certification.

Applicant

- Can only be named on an ADS.
- Inventor is established as applicant by default if an applicant is not otherwise named.
- Applicant can only be changed, not deleted.
- Correction to applicant name must be shown on a properly marked-up ADS.

Applicant

- Change of applicant after inventorship is established requires a request under 37 CFR 1.46(c), which requires:
 - Corrected ADS with proper markings
 - Statement under 37 CFR 3.73(c) showing complete chain of title
 - Returning inventors to be the applicant requires 3.73 showing title back to inventors
 - Removal of applicant requires 1.182 petition

Applicant

- Applicant can only be changed, not deleted.
 - Change in applicant requires a § 3.73 statement (form AIA/96 or equivalent) to show ownership to new applicant.
 - Correction or update in the name of the applicant requires a “corrected” ADS.
 - Changing applicant to the inventors requires a § 3.73 statement showing title back to inventors.
 - A § 1.182 petition is required to attempt correction/removal of an improperly named applicant.

Inventor's oath or declaration

- May be submitted instead of an ADS to set inventorship
- Submitted for each inventor (surcharge if submitted after filing)
- Correlates to name on ADS, if applicable
- Properly signed
- Contains required statements:
 - Believed to be original (joint) inventor
 - Application made or authorized to be made by inventor
 - Acknowledge penalty for making willful false statements
- Substitute statements are properly completed



Fees in response

- Fee amounts must be paid in full according to the entity status in effect at the time of payment.
 - Entity status change may be included with response.
- Application size fee cannot be reduced or waived by elimination of pages.
- Excess claims fees may be reduced by amendment included with response.

Submission methods

- Regular USPS mail with Certificate of Mailing (37 CFR 1.8)
- USPS Priority Mail Express® Post Office to Addressee service (37 CFR 1.10)
- EFS-Web (registered users only)
- Responses may be faxed to the USPTO official fax number at 571-273-8300.

Electronic submissions

- The USPTO strongly recommends using correct document descriptions for submissions in EFS-Web.
- Using correct document descriptions will ensure that OPAP is notified of the incoming submission.
- Combining requests on one document can lead to delays.
- Each item requiring action should be distinguishable.
 - Petition/request embedded with response.
 - Power of Attorney (POA) contained in combined oath/POA document.



Response submissions

- Responses that include fee payments, ADS, or drawings should not be submitted without being accompanied by an “Applicant Response to Pre-Exam Formalities Notice” document.
- Many document descriptions do not trigger a notification to OPAP, so response may go unnoticed.

Review filing receipt

- Check the information carefully when you receive a filing receipt.
- OPAP will correct typographical errors made by the USPTO.
- Incorrect or missing information could cause impacts during prosecution.
 - Inventorship → First Inventor to File (FITF), micro entity status
 - Benefit claims → FITF, publication date
 - Applicant → power of attorney
 - Filing date → copendency, patent rights, foreign filing

Review filing receipt, cont.

- Properly marked-up ADS is needed to make corrections.
- Corrections to inventorship and applicant cannot be made after issue fee is paid.
- Delay in correcting benefit claim could result in need for petition.

Questions regarding notices

- All inquiries are to be directed to the Application Assistance Unit, as stated on the Notice.
 - Individual signing the Notice should not be contacted.
 - Attempts to contact an individual directly will not be acknowledged.
- Email inquiries require authorization for detailed response (MPEP 502.03).
 - Copy of communication will be made of record.
 - The USPTO is not required to respond to an email inquiry if there is no authorization in the application file.

Resources

- How to get help:
 - Application Assistance Unit, 571-272-4000
 - Patents Ombudsman, 571-272-5555 or <https://www.uspto.gov/patent/ombudsman-program>
 - Inventor Assistance Center, 571-272-1000 or <https://www.uspto.gov/learning-and-resources/support-centers/inventors-assistance-center-iac>

