



American Intellectual Property Law Association

## PERFECTING THE TASKS ASSOCIATED WITH PATENT PREPARATION AND FILING

WEDNESDAY, JULY 8, 2020

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# AIPLA

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American Intellectual Property Law Association

## Perfecting the Tasks Associated with Patent Preparation and Filing

AIPLA CLE Webinar  
Wednesday, July 8, 2020  
12:30 pm – 2:00 pm Eastern

## Committee Leadership



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## Presenters



### Stephanie Kwong

Partner

**Dicke, Billig & Czaja, PLLC**

Stephanie is a registered patent attorney. In addition to patent prosecution, Stephanie has experience in trademark prosecution and maintenance, opinions, licensing, due diligence review and dispute resolution including intellectual property litigation. Having known from high school that she wanted to be an intellectual property attorney, Stephanie graduated from The University of Wisconsin-Madison with a Bachelor of Science in Industrial Engineering, and then went straight to the Franklin Pierce Law Center (now the University of New Hampshire School of Law) to receive her law degree.

## Presenters

### H. Sanders Gwin Jr.

Principal

**Shumaker & Sieffert, P.A.**



H. Sanders Gwin, Jr. is a Principal of Shumaker & Sieffert. Sanders specializes in patent preparation/prosecution and patent infringement/validity counseling in the chemical, materials and software fields. Previously, Sanders was a Principal of Fish & Richardson P.C., Intellectual Property Counsel with 3M, Associate with Darby & Darby, Intellectual Property Attorney with Allied Signal, and Associate with Sughrue. Sanders also served as a Judicial Clerk to The Honorable Edward S. Smith, United States Court of Appeals for the Federal Circuit.



## Presenters



### Justin Cassell

Shareholder  
**Workman Nydegger**

Justin counsels clients on patent procurement, intellectual property due diligence, validity and infringement, strategic international IP protection, post-grant proceedings, and preliminary patent enforcement and defense actions. He manages patent portfolios of U.S. and foreign clients, ranging from the individual inventor to multinational companies. He represents clients in a wide range of technologies, including materials science, mechanical, electrical, and software technologies, with an emphasis on medical devices and procedures.



## Initial ‘Inventor’ Interview and Invention Disclosure

Stephanie Kwong  
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Minneapolis, Minnesota  
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## The importance of initial interviews

- An interview serves as the foundation for the application
- Makes your job easier





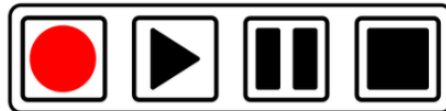


## Types of interviews

- In-person
- Teleconference
  - Phone
  - Video
- Email Q&A

**TIP:** Record all interviews and keep excellent records

- Free yourself from note taking so you can pay attention
- Use recorded interview as a final checklist
- Replicate the inventor's lingo and phrasing





## **Determine why your client wants to file a patent application**

- Competitive advantage (e.g., preventing others from making, using, or selling the invention)
- Bulking up patent portfolio to increase perceived company value
- Litigation leverage
- Defensive publication
- Personal pursuit



## Determine if a patent application should be filed

- Earlier disclosures or sales may bar obtaining a patent
- Trade secret protection may be more suitable
- Enabling invention may require disclosure of proprietary technology



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## Identify potential bar dates and explain significance

- United States 1 year grace period after barring disclosures or sales
- Public disclosure grace periods are often not available in foreign jurisdictions





## The standard for disclosure in a patent application

### 35 U.S.C. §112(a)

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

- The interview should provide you with everything you need to meet this standard
- Explain standard to the inventor(s) prior to the discussion



## Identify what is novel

- Novel aspects will be focus of the claims
- Novel aspects require extra thorough disclosure in both written description and the drawings
- The benefits of novel features should be included in the written description







## Get ahead of potential obviousness rejections

- Why are novel aspects not merely a design choice?
- Surprising or unexpected results?
- Secondary considerations of non-obviousness
  - Long felt but unsolved need
  - Copying by others
  - Industry praise, etc.



## Identify prior art references

- Every person associated with the filing of a patent application has a duty to disclose material pertinent to patentability
- References are cited in an Information Disclosure Statement
- Documents can be useful to reference when drafting the claims and the background sections of the application



## Identify the inventor(s) and owner(s)

- Conduct an accurate conflict check
- Determine who has the authority to make decisions relating to the application preparation and filing
- Prepare strategy for obtaining cooperation of inventor or drafting claims to omit person who would otherwise constitute an inventor
- Early identification of inventor(s) enables prompt completion of formal documents (e.g., oath/declaration, assignment)
- Statement regarding government rights



## Broaden the disclosure

- Put on your “engineering hat”
  - Identify which elements are essential and which are optional
  - How might a competitor modify the disclosed embodiments?
    - Vary materials
    - Vary steps
    - Achieve similar function in a different way
- It is difficult to know what details will ultimately be important
- **Be careful not to become a co-inventor**
  - Ask guiding questions to get your inventor thinking without recommending specific alternatives
  - Prepare a list of broadening topics for discussion before the interview





## Manage inventor/client expectations

- A well-informed client is often a happy client so consider discussing the following:
  - Types of patent applications
  - Outline of the process and timeframe
  - Anticipated costs and client's budget
  - One patent per invention, filing multiple applications may be necessary
  - Be cautious when providing indications of patentability and/or challenges with respect to patentability





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## Watch your language

- Use plain English
- Avoid legalese and jargon





## Concluding the interview

- Prepare a detailed action list for the inventor(s) clearly indicating:
  - What additional information or materials you need from the inventor
  - When you need the additional information or materials



# A Practical Approach to Inventorship

H. Sanders Gwin Jr.

[gwin@ssiplaw.com](mailto:gwin@ssiplaw.com)

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# Why is Inventorship Important?

- **Joint Inventors are Joint Owners**
  - Co-inventor of one claim has a pro rata undivided ownership interest in all claims (absent other contractual arrangements)
  - Co-inventor of only one claim might gain entitlement to ownership of a patent with dozens of claims

# Why is Inventorship Important?

## ▶ Does AIA “grace period” Apply?

- ▶ Enabling Public Disclosures made 1 year or less before the effective filing date are exempt from prior art status if:
- ▶ **Made by the Inventor/Joint Inventor**, or a party that obtained the information from the **Inventor/Joint Inventor**
- ▶ Made after the initial disclosure by the Inventor(s) or a party that obtained the information from the **Inventor/Joint Inventor**

# Law of Inventorship

## Application filed prior to March 16, 2013?

Pre-AIA Law

## Application filed after March 16, 2013?

Pre-AIA law if ALL claims have priority date prior to March 16, 2013

Do ANY claims have priority date AFTER March 16, 2013?

AIA applies to ALL claims in application

# Law of Inventorship

## 35 U.S.C. 101:

*“Whoever invents* or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, *may obtain a patent therefor...”*



# Law of Inventorship

## Inventor - 35 U.S.C. 100(f)

Individual or, if a joint invention, the individuals collectively, who **invented or discovered** the **subject matter of the invention**

# Law of Inventorship

## Joint inventor – 35 U.S.C. 100(g)

any of the individuals who **invented or discovered** the **subject matter of a joint invention**

- ▶ Need not physically work together or at the same time, need not make equal contributions – 35 U.S.C. 116
- ▶ Some **quantum of collaboration** required

# Conception

**Conception is the touchstone when determining inventorship:**

“Formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is to be applied in practice”

# Conception

## ▶ Tests for Conception:

Did Inventor Identify Problem to be Solved?

Did Inventor Determine Solution to Known Problem?

# Conception

## Proving Conception

Sufficiently Developed to Fully Describe Invention  
to One of Ordinary Skill in the Art – Scientific  
Certainty Not Required

Completed Thought Expressed in Clear Terms to  
Enable Skilled Artisans to make/use invention  
without undue further experimentation or research

Conception is Keyed to the Claimed Invention –  
Must Include Every Claim Limitation

# Conception

## ▶ **More Predictable Arts – Less Detail Required**

### ▶ **Mechanical/Electrical**

- ▶ Drawing/circuit diagram

### ▶ **Software**

- ▶ Flow Charts/Definition of Terms

## ▶ **Less Predictable Arts – More Detail Required**

### ▶ **Chemical**

- ▶ Structure, Name, Formula, Chemical/Physical property, Utility, Method of Making (unless routine)

### ▶ **Biotech**

- ▶ Sequence (or other structure), Utility, Method of Obtaining or Making



# Reduction to Practice

## ▶ Construct Embodiment or Perform Process that Meets ALL Claim Limitations

### ▶ Actual

- ▶ Show Invention in Physical/Tangible form

### ▶ Constructive

- ▶ Draft/File patent application that Meets Requirements of Section 112

**Determine Invention Works for Intended Purpose**

**Not Required Prior to Filing!**

# Reduction to Practice

**Process** – successfully performed?

**Machine** – assembled, adjusted, used?

**Article of Manufacture** – fully manufactured?

**Composition of Matter** – completely composed?

*Corona Cord Tire Co. v. Dovan Chemical Corp.*, 276 U.S. 358, 383 (1928).

# Reduction to Practice

- ▶ **NOT** as important as conception, unless art highly unpredictable (chemical/biotech), may in such cases be simultaneous
- ▶ **Can be carried out by the inventors or others working under their direction and control**
- ▶ Were problems encountered during the actual reduction to practice?
  - ▶ Did investigators offer suggestions/ideas leading to an operative invention?

# Factors Tending Away From Inventorship

- ▶ Contribute Obvious Element or Making Superficial Changes to Another's Design
- ▶ Suggest Desired Result - Means to Accomplish it?
- ▶ Following Instructions of Conceivers
- ▶ Explaining How/Why Invention works
- ▶ Explaining State of the Art or Known Component/Starting material

# Inventorship Determination

## ▶ Attorney/Agent's primary role in inventorship determination:

Determine whether each investigator reasonably believes they are an original and first inventor of claimed subject matter

# Suggested Inventorship Determination Process

## ▶ Educate Your Client

- ▶ Importance of having correct inventorship
- ▶ Legal determination made by qualified practitioner (YOU!)
- ▶ Not the same as authorship on research paper (copyright?)
- ▶ Does not reflect quality, value or amount of contribution
- ▶ Is based on the claims

# Suggested Inventorship Determination Process

- ▶ **Make determination after the entire application and claims have been prepared**
- ▶ **Compare contributions of possible inventors to claims**
- ▶ **Interview possible inventors?**
  - ▶ As a group?
  - ▶ Separately?
  - ▶ Look for consistency and credibility in explanations

# **Suggested Inventorship Determination Process**

**Review documentary evidence as needed**

- ▶ Notebooks, invention records, reports, diaries, etc.

**Look for corroborating evidence to resolve  
conflicts, as needed**

▶ **Make final inventorship determination**

- ▶ Can it be easily explained and defended?
- ▶ If alternative determinations are possible, has the most justifiable one been selected?

▶ **Record results in a file memo?**

▶ **Advise client of possible staff conflicts**



# Suggested Questions for Determining Inventorship

- ▶ How did you learn of the problem that you solved?
- ▶ What background information did you have at the start?
- ▶ When and where was the work done?

# Suggested Questions for Determining Inventorship

- ▶ Did you work with anyone else or receive suggestions, ideas or recommendations from anyone else?
- ▶ Do you have any records describing the work that was done?
- ▶ Has the invention been made?
- ▶ Were any problems encountered while making the invention?

# Suggested Questions for Determining Inventorship

## ▶ Try to Eliminate “Legal” Terms

- ▶ Inventorship Discussions
- ▶ Invention Disclosure Form

## ▶ Inventor(s)

- ▶ Investigators may be a better term

## ▶ Conception

- ▶ When was the invention was first thought of or written down?

# Suggested Questions for Determining Inventorship

## ▶ Reduction to practice

- ▶ Ask about experiments or tests instead
- ▶ Did you make the device or the compound?

## ▶ Prior art

- ▶ Background information may be a better term

## ▶ Best mode

- ▶ Preferred design or process?

# QUESTIONS?

## THANK YOU!

# FILING OF A U.S. PATENT APPLICATION

Presented by Justin Cassell

July 2020

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# Types of Patent Applications

- Provisional applications
- Nonprovisional applications
  - Regular nonprovisional without the benefit of priority of an earlier-filed application.
  - Continuation of (MPEP 201.07)
  - Division of (or “divisional”) (MPEP 201.06)
  - Continuation-in-part (“CIP”) of (MPEP 201.08)
  - 35 U.S.C. §371 (National Stage) of an international application (MPEP 1893)
  - Substitution of (MPEP 201.02)
  - Reissue of (MPEP 201.05)
  - Claims benefit of provisional (MPEP 201.04)

# Application Priority

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- Priority claims may be to foreign applications (i.e., “foreign priority” under the Paris Convention through 35 U.S.C. §119(a)/172).
- Priority claims may be to domestic applications (i.e., “domestic benefit” under 35 U.S.C. §120).
- A priority claim is properly made when:
  - the later- and earlier-filed patent applications include a common inventor or joint inventor;
  - the later-filed patent application makes a specific reference to the earlier-filed patent application(s);
  - the claim is made within 16 months from the filing date of the earliest-filed application or 4 months from the filing of the later-filed patent application; and
  - the later-filed patent application is filed before or on the same day as the grant or abandonment of the earlier-filed patent application.



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## Provisional Application

- Establishes an early filing date (“priority”).
- Expires after a 12-month pendency period from the filing date of the provisional application.
- Filing the provisional application:
  - (1) establishes the official United States patent application filing date for the invention;
  - (2) permits the authorized use of “Patent Pending” notice;
  - (3) begins the Paris Convention priority year.
- A provisional is maintained confidential at the USPTO unless a later application claims the benefit of priority of the application and the later application is published.
  - If no priority claim is made on the provisional application, remains confidential from the public.
- A provisional application is not available for design inventions.

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## Provisional Application Considerations

- Assure disclosure meets requirements of 35 U.S.C. § 112
- Provide clear and concise drawings
- Provide patent claims
- File with ADS
- Pay basic filing fee at the time of filing the application
- File a power of attorney
- Record an assignment
- Consider filing multiple provisional applications during 12-month pendency
- Avoid Conversion

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## Nonprovisional Application Qualifications

- **A nonprovisional patent application is a U.S. national application for patent filed:**
  - directly filed in the USPTO under 35 U.S.C. §111(a);
  - an international application under the PCT designating the U.S; or
  - an international design application.
- **A nonprovisional application can be:**
  - a plant patent
  - a design patent
  - a utility patent
- **Utility patents:** can come from a nonprovisional utility patent application, a divisional application, continuation, continuation-in-part, a 35 U.S.C. §371 of an international application, a bypass application and a reissue.

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## **Nonprovisional Application Contents**

- **Utility Patent Application Transmittal Form or Transmittal Letter**
- **Appropriate Fees**
- **Application Data Sheet (ADS) (see 37 CFR §1.76)**
- **Specification (with at least one claim)**
- **Drawings (when necessary)**
- **Executed Oath or Declaration**
- **Additional Considerations**
  - Power of Attorney
  - Assignment
  - Information Disclosure Statement
  - Prioritized or Accelerated Examination

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## **Appropriate Fees**

- **Filing Fee**
- **Search Fee**
- **Examination Fee**
- **Excess Claim Fee**
- **Multiple Dependent Claim Fee**
- **Optional Excess Pages Fee**
- **Miscellaneous**
  - Assignment
  - Accelerated Examination

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## Application Data Sheet

- **Mandatory in nearly all patent applications.**
  - Exception is in application where there is no domestic benefit or foreign priority claim.
- **File ADS as computer readable form to assure data is automatically entered – use USPTO form.**
- **Carefully review all fields of ADS to assure data is correct.**
  - Avoid checking box “Filing by Reference.”
  - Carefully consider non-publication request – actual inquiry is necessary if intent is not to foreign file.
- **Get it right the first time.**

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## Application Data Sheet

- **Application Information**
  - Title
  - Attorney Docket
  - Application Type
  - Subject Matter
  - Secrecy Order
  - Entity Status
  - Suggested figure for publication
- **Inventor Address**
  - May be where inventor works
  - A post office box
  - Other address where mail is regularly received

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## Application Data Sheet

- **Domestic Benefit/National Stage/Foreign Priority Information**
  - Know date formats of each document.
  - Know deadline to claim priority benefit.
  - Timely assert benefit/priority information to fulfill 4 or 16 month req.
- **Applicant**
  - Inventor Applicant
  - Non-Inventor Applicant
    - Assignee
    - Party to which inventor has obligation to assign
    - Party having proprietary interest
  - Juristic Entity
    - ADS may only be signed by patent practitioner.



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## Parts of Application

- **Title**
- **Cross-Reference to Related Applications**
- **Statement on Federally Sponsored Research or Development**
- **Field of the Disclosure**
- **Background**
- **Summary**
- **Brief Description of Drawings**
- **Detailed Description of Various Embodiments**
- **Claims**
- **Abstract**
- **Drawings**

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## Oath or Declaration

- **Required Language**

1. The application was made or authorized to be made by the person executing the declaration;
2. The individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application; and
3. An acknowledgment of penalties clause referring to fine or imprisonment of not more than five years, or both.

- **Consider Optional Additional Language**

- Having read and understood contents of application
- Acknowledges the duty of disclosure
- Authorizes to fill information pertinent to application
- Direct correspondence to Customer Number

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## Oath or Declaration

- **Late Filing of Declaration**

- May postpone filing the oath or declaration until the USPTO issues a Notice of Allowability which then provides three-month period.
- Surcharge
- National phase filing – must be filed before RCE is filed.

- **Options**

- Individual inventor
- Multiple inventors
- Declaration/assignment

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## Substitute Statement

- **Substitute Statement (PTO/AIA/02)**
  - Where an inventor's signature cannot be obtained on a declaration, a substitute statement may be executed regarding or for that inventor.
- **Circumstances that apply:**
  - The inventor is deceased or legally incapacitated;
  - The inventor refuses to sign the declaration; or
  - The inventor cannot be found or reached after diligent effort.
- **Proof of Facts:**
  - No proof required
  - Applicant should preserve evidence
- **Who may sign:** Anyone with knowledge of fact – however, list person name, Applicant name and Title of person signing.

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## Power of Attorney

- **When Required:**
  - Formally establish legal representation.
  - Authorization to file terminal disclaimers.
  - Assurance that the customer number is associated with the attorney of record.
  - Change entity status in Private PAIR.
  - Assuming transfer of an application, including establishing new correspondence address and access to PAIR.
  - Ability to file a corrective ADS.
  - Ability to file auto-granted petitions at the USPTO.
  - Payment of issue fee on EFS-Web.

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## Power of Attorney

- **Other Considerations**

- Best Practice is to file a Power of Attorney
- General Power of Attorney
- Applicant Inventor and Separate Assignee
- Avoid Combined Declaration/Power of Attorney
- Continuing Applications

- **PTO Forms**

- PTO/AIA/80: Requesting change in Applicant and 37 CFR 3.73(c) statement required.
- PTO/AIA/81: Used by pro se inventors to appoint an inventor(s) to sign on their behalf.
- PTO/AIA/82: General power of attorney with cover sheet identifying application

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## Assignment

- **Record Assignment promptly**
  - Preferred within three months of execution (35 U.S.C. 261).
- **Legal document establishing ownership**
- **Preferred to file in all types of applications including provisional, nonprovisional and continuing applications**
  - Need new assignment when new matter is added (i.e., CIP application)
- **Have assignment executed when declaration is executed**
  - Consider using a joint declaration/assignment

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## Advancement of Examination

- **Track One Prioritized Examination**
  - Must be requested at the time of filing an application with fee and request form.
  - Both processing fee and Track One fee must be paid.
  - Maximum of four independent claims and thirty total claims.
  - Terminated at final Office Action, extension of time, exceed claims.
- **Petition to Make Special without a Fee**
- **Accelerated Examination**
- **Patent Prosecution Highway**
  - No fee.
  - File petition with supporting information from office of earlier examination (OEE).



# Questions

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- For an updated copy of the accompanying paper, it can be accessed at: <https://www.wnlaw.com/filing-of-a-u-s-patent-application/>
- For additional questions, please feel free to contact by email at:
  - [jcassell@wnlaw.com](mailto:jcassell@wnlaw.com)

## Questions?

Type your questions in the Q&A Pod on your screen. Questions will be answered in the order received.

A screenshot of a web interface for submitting questions. It features a large text input area with the placeholder text "Submit Questions Here" in the top left corner. At the bottom of the input area, there is a small speech bubble icon. The entire interface is enclosed in a black rectangular border.

1. Type question here
2. Click  or press Enter

## Thank you for participating in today's program!

If you have any questions for today's presenters that were not addressed or were stuck in the queue, please email them to:

[Seminar\\_Questions@aipla.org](mailto:Seminar_Questions@aipla.org)

If you purchased and **individual site registration**, you must complete an attendance survey in order to receive CLE credit. If the survey does not automatically pop-up, a link can be found on the resources tab.

If you viewed this webinar as part of a **multiple attendee site registration** and are requesting CLE Credit, you must complete a site attendance roster and complete the webinar survey. The attendance roster and survey information can be found on the resources tab.



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## People

Erik O. Berger  
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Michael R. Binzak  
Timothy A. Czaja  
Steven E. Dicke  
Elizabeth "Betsy" Fenske  
Peter R. Forrest  
Paul S. Grunzweig  
Rudolph P. Hofmann  
Jeffrey A. Holmen  
Paul P. Kempf  
Denise M. Kettelberger  
Gregg A. Kromrey  
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John M. Weyrauch



## Stephanie M. Kwong

**Partner**

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**Download Stephanie's vCard**



**Download Stephanie's Information Sheet**

### Practice Areas

[Patents](#)

[Trademarks](#)

[Rights Enforcement](#)

[Portfolio Management](#)

### Technology Areas

[Mechanical](#)

[Medical Devices](#)

### Admissions and Affiliations

United States Patent and Trademark Office

Minnesota

U.S. District Court, District of Minnesota

Minnesota Intellectual Property Law Association

### Education

B.S. in Industrial Engineering,  
University of Wisconsin-Madison,  
2003

J.D., Franklin Pierce Law Center,  
*Intellectual Property Law Review*,  
2006

### About Stephanie

Stephanie is a registered patent attorney. In addition to patent prosecution, Stephanie has experience in trademark prosecution and maintenance, opinions, licensing, due diligence review and dispute resolution including intellectual property litigation.

Having known from high school that she wanted to be an intellectual property attorney, Stephanie graduated from The University of Wisconsin-Madison with a Bachelor of Science in Industrial Engineering, and then went straight to the Franklin Pierce Law Center (now the University of New Hampshire School of Law) to receive her law degree. Stephanie was a member of IDEA: The Intellectual Property Law Review. During law school, Stephanie had her first glimpse of real-world intellectual property policy and cultural implications in context while studying abroad at Tsinghua University in Beijing, China.

As an avid soccer player, Stephanie understands the power of teamwork and finds value in utilizing individuals' strengths to efficiently achieve the desired outcome. She has a competitive spirit but doesn't take herself too seriously and enjoys a good pun.

In addition to playing soccer, Stephanie enjoys spending time with family, photography and backpacking through developing countries.



## H. Sanders Gwin, Jr.

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---

### Technology Areas

Mechanical

Chemical

Software

## Professional Experience

H. Sanders Gwin, Jr. is a Principal of Shumaker & Sieffert. Sanders specializes in patent preparation/prosecution and patent infringement/validity counseling in the chemical, materials and software fields. Previously, Sanders was a Principal of Fish & Richardson P.C., Intellectual Property Counsel with 3M, Associate with Darby & Darby, Intellectual Property Attorney with Allied Signal, and Associate with Sughrue. Sanders also served as a Judicial Clerk to The Honorable Edward S. Smith, United States Court of Appeals for the Federal Circuit.

## Education

Birmingham Southern College - B.S. Physics and Chemistry 1983 cum laude

Samford University, Cumberland School of Law - J.D. 1989

## Bar Admissions

State of Minnesota

State of Alabama

District of Columbia and the Federal Circuit

United States Patent and Trademark Office

## Affiliations

American Intellectual Property Law Association (AIPLA)



### Education

J.D., George Washington University Law School, 2001

B.S., Mechanical Engineering, Brigham Young University, 1997

### Admissions

- Utah State Bar
- Virginia State Bar
- Registered Patent Attorney, U.S. Patent and Trademark Office

### Memberships

- American Intellectual Property Law Association (AIPLA)
- International Association for the Protection of Intellectual Property (AIPPI)
- International Federation of Intellectual Property Attorneys (FICPI)

### Community Involvement

- Utah State Master Gardener Program, Volunteer
- Junior Jazz Basketball, Coach

### Languages

French

## Justin J. Cassell

Shareholder

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Justin counsels clients on patent procurement, intellectual property due diligence, validity and infringement, strategic international IP protection, post-grant proceedings, and preliminary patent enforcement and defense actions. He manages patent portfolios of U.S. and foreign clients, ranging from the individual inventor to multinational companies. He represents clients in a wide range of technologies, including materials science, mechanical, electrical, and software technologies, with an emphasis on medical devices and procedures.

Justin evaluates inventions according to his clients' business objectives and develops patent procurement strategies to meet such objectives, both domestically and internationally. Justin drafts patent applications, represents his clients before the United States Patent & Trademark Office and the World Intellectual Property Organization, and advises foreign counsel on the examination of such patent applications outside the U.S.

Justin counsels and provides opinions regarding patent matters to address his clients' needs and to fulfill their business objectives. These opinions advise on intellectual property issues ranging from patentability, due diligence, validity and infringement. These opinions may lead to negotiation, licensing, acquisition, enforcement or defense of patents.

Justin manages post-grant proceedings of his clients' patents in both the U.S. and abroad, and initiates post-grant proceedings on behalf of his clients to challenge competitor patents. Justin cooperates with litigation counsel on enforcement and defense of his clients' intellectual property, and advises his clients on such intricacies of U.S. patent litigation.

Justin routinely lectures on intellectual property issues and procedures to clients and organizations, and regularly trains new attorneys in patent law.

Prior to coming to Workman Nydegger, Justin was an attorney at a law firm in the Washington, D.C. area. Before that, Justin worked as an engineer with focus using high temperature materials in industrial applications and the characterization of such materials.

### Experience

- Manages U.S. and global patent portfolios for multinational corporations and subsidiaries thereof.
- Manages U.S. national stage entry practice with at least 150 filings per year.
- Led and negotiated multiple licensing market-wide campaigns on behalf of clients.
- Manages efforts to stop competitors from infringing activities, and defends efforts against clients involving accusations of infringing activities.
- Provides client interface and strategy on litigation related activities.

## **Initial ‘Inventor’ Interview and Invention Disclosure**

**Stephanie Kwong**

**Dicke, Billig & Czaja, PLLC**

**Minneapolis, MN**

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## **Preface**

I want to point out that much of my experience is derived from the preparation and prosecution of patents in the mechanical and medical device arts. Therefore, most of the discussion herein is skewed to situations in which the invention is a tangible item or process that involves the manufacture or use of a physical product.

## **Why are inventor interviews important?**

The ability to effectively conduct inventor interviews is an important aspect of being a patent prosecutor. The disclosure obtained from an inventor interview serves as the framework for the patent application. As with a physical building, a well-laid foundation forms the basis of a solid final product, whereas an unstable foundation will lead to nothing but problems over time. Of course, this is not to say that a good disclosure will automatically result in the allowance of a patent application, but you will find that the odds of allowance will be significantly greater. An effective inventor interview is also important because the process of preparing a patent becomes easier and more efficient when you fully grasp aspects of the invention and establishes your client's objectives from the beginning.

## **Types of inventor interviews**

There are many ways to conduct an inventor interview. Although it is often best to meet in person, this may not always be possible or practical. In-person interviews are beneficial because the inventor can walk you through the invention—perhaps with a prototype or drawings in hand—to demonstrate important functions that may not be readily discernable from written specifications. While face-to-face meetings are ideal, telephone or video conferences are also popular and useful in our increasingly globalized economy, particularly with the rise of ubiquitous high-quality internet-based conferencing programs. In other situations, communicating via email may be the only way to obtain the invention disclosure.

In all cases, it is highly recommended that you record the interview and keep a good inventory of the information that is presented to you. By freeing yourself from excessive notetaking during the conversation, you can focus on engaging with your inventor, considering questions to ask, and learning about the invention's nuances. A recording also serves as an important way to double-check the application after completing a first draft to ensure that all details are properly disclosed. In addition, recording the precise ways in which your inventor describes the technology will make it easier for you to replicate how certain aspects of the invention are discussed by those who are "skilled in the art," thereby improving the application's accuracy and readability. It will also make your writing easier to follow and sound more intelligent to your client because you will literally be speaking the same language. As you will likely learn in other parts of this week's seminar, there can be reasons wording the application differently, but where there are no strategic reasons for doing so, I recommend using language consistent with that suggested by your inventor(s).

## **Determine if your client really wants to file a patent application, and why**

The inventor interview is also a great opportunity to evaluate your client's goals and to determine whether or not you should prepare and file a patent application. A client may come to you requesting your assistance with preparing and filing a patent application, but a patent may not be the best option to achieve their overall objectives. In some instances, an inventor



interview may reveal problems that would prevent the USPTO from ever issuing a patent, such as a prior disclosure or certain sales activity. In other situations, the invention may be better suited to trade secret protection. Trade secrets serve well for inventions having technology that is difficult to reverse engineer or involves a method that may be a challenge to enforce, especially where it is difficult to determine if others are using similar methods. You may also find that disclosure of proprietary technology is needed to enable someone to manufacture and use the invention. You should make it clear that everything disclosed in a non-provisional application will be made public information if the patent application is granted or if the application is filed without a nonpublication request. Your inventor may determine, based on the interview, that the desire to keep proprietary information confidential outweighs any potential patent protection that could be obtained. If that is the case, you can switch gears to providing guidance on trade secret protections.

It is also important to discuss and understand your client's objectives. You might think that preventing others from making, selling, or using the invention is the sole reason for filing a patent application, but there are many other less common functions a patent application can serve. For example, a client may merely want to bulk up its patent portfolio in anticipation of a possible merger or acquisition. In other situations, a client may want to use the published application as a defensive publication, establishing an official record that the disclosures provided therein were known as of the effective filing date. Such defensive publications can be used as prior art against a competitor or provide a "safe harbor" against competitor's patents that may be filed after the filing date of the defensive patent application. I have even had clients who have pursued patents as a hobby; for the mere satisfaction of having invented something they believe is interesting.

I do not mean to imply that a patent application prepared for a hobbyist is necessarily different from one prepared for a Fortune 500 corporation, but it will help guide your advice if you understand what is important and what the ultimate goal is. For example, for a particular "hobbyist" client of mine, the invention related to a product for which we would file both utility and design patent applications, as the invention had both unique functional aspects, as well as unique aesthetic features. My inventor, an artist, only had hand sketches of the invention and did not have engineering production drawings. I had learned through prior experience that, while formal patent drawings prepared by hand were slightly more expensive, the end results were far superior to many of the drawings prepared using the CAD programs available to many of today's draftsmen, particularly when all views of the invention are not provided by the inventor. Knowing that my inventor-client had the resources to pay a little more for drawing expenses—and that he would also appreciate receiving a ribbon copy patent with really beautiful figures to present to his friends/family/potential investors—I chose to have the drawings prepared by hand by a draftsman I knew would do a great job. I expect that this decision made my client happier in the end, and although I did not personally prepare the drawings, I expect that the beautiful figures reflected well on my work as a patent prosecutor. On the other hand, that strategy may be unnecessary and irritating for corporate clients that want to keep costs to a minimum.

### **Identify any potential bar dates**

As indicated above, it is important to discuss public disclosures, sales activities, and their effects at your inventor interview both to ensure that a patent application is not barred and also to ensure that your inventor understands the consequences of any public disclosures or sales prior to the

filing of the application. In the United States, if an inventor discloses her work or sells her invention more than one year before filing the patent application, she will be barred from obtaining a patent.<sup>1</sup> Establishing that patent protection is not barred due to a public disclosure or sales activity outside of the grace period is one of the first things that a patent prosecutor must confirm. Determining which actions specifically constitute a barring activity is not always a straightforward matter—and another thing that is outside the scope of this paper—but something you should familiarize yourself with. It is worth noting that a grace period such as the one provided by the United States is relatively rare and unavailable in many other patent jurisdictions around the world. Explain to your client the implications of any potential public disclosures or sales activity in other countries, and also that a U.S. application can serve as a priority date for foreign filings, if a public disclosure or offer for sale is to be made before the filing of a corresponding foreign application.

### **The standard for disclosure in a patent application**

Every patent application must meet the requirements of 35 U.S.C. § 112(a), which states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

Therefore, the goal of your inventor interview should be to obtain all of the information necessary to prepare a patent application that meets the stated requirements for disclosure and content. I often find it helpful to explain this standard to inventors to help illustrate that general ideas are not sufficient and that the disclosure will require discussion of how specific embodiments are made and used.

### **Identify what is novel**

Unsurprisingly, your inventors will usually know a great deal more than you do about the existing field of related products or processes and, particularly, how their inventions differ. By focusing on the features that are thought to be novel,<sup>2</sup> you will know what aspects of the invention will be critical to include in your claims, as well as those which will require extra-thorough disclosure in both the written specification and the drawings. Remember that all features in the claims must be shown in the drawings and explained in the written description. If you notice that certain important features are not clearly visible in the drawings available to you, the inventor interview is a good time to determine what additional drawings or views you will need and why. Understanding novelty and the importance of novel features is also important from the start as in some jurisdictions, such as Europe, patentability may rely on establishing that the claimed invention is not only novel but also that the differences between the prior art and the claims provide a benefit (i.e. are significant). In such jurisdictions, such benefits often must be presented in the application if they are to be relied upon for patentability, which means they must be understood and discussed in the written description at the time of filing.

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<sup>1</sup> See *In re Katz*, 687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982); 35 U.S.C. §102(b) (pre-AIA); 35 U.S.C. §102(b).

<sup>2</sup> See 35 U.S.C. §102.

### **Get ahead of potential obviousness rejections**

Perhaps the most common reason for an examiner to reject a patent application claims is that a claimed invention is obvious in view of one or more cited references.<sup>3</sup> An inventor can often clearly indicate why they believe their invention is novel, but I find that it is most often the job of the interviewer to both ask questions and consider why an invention is not an obvious variation compared to what is already known. In a rejection, the examiner may indicate that such a difference is a “mere design choice.” Ask probative questions to identify, if possible, any particularly surprising or unexpected results that may stem from the inventor’s design. If possible, it is also helpful to identify how or why any of your inventor’s changes or modifications to known devices would not be predictable to someone else of skill in the art. For example, if developing the invention required a great deal of research, experimentation, and testing to achieve a workable result, it will be easier to rebut an “obviousness” rejection.

Obviousness rejections can also be overcome if the applicant can show that the invention solves a long-felt, but unmet need; receives industry praise; or is readily copied by others. It can also be very effective to illustrate that elements of the claimed invention interact in a synergistic way that was not predictable at the time of the invention. If you can discuss these topics during your initial inventor interview, the inventor can consider and explore the possibilities with you. You can then emphasize the most relevant evidence in the application such as through a written explanation or test data. It is also beneficial to alert the inventor to these considerations early on, so that if such secondary evidence becomes available at a later date, they will be certain to bring it to your attention for use during prosecution of the patent application.

### **Identify prior art references to cite in an Information Disclosure Statement**

Every person associated with the filing of a patent application has a further duty to disclose any material that may be pertinent to patentability to the patent office.<sup>4</sup> Before scheduling an inventor interview, request that the inventor provide you with copies of any prior art search materials or other documents in their files that disclose related technology. You will need a list for your file to include in an information disclosure statement and can also use those documents to provide a way for your inventor to compare and contrast their invention with the references at the time of the interview.

### **Identify the inventor(s) and owner of the Application.**

Inventorship is often a straightforward topic to discuss with your inventor, however, there are times when questions arise. While the topic of determining who makes up the population of inventors will be covered in a separate presentation, it is important to discuss this with your clients contemporaneously with the inventor interview. If the technology was developed with the assistance of any other parties, such as an engineering firm or outside consultant, you will need to establish if such assistance constitutes “inventorship” relative to the particular invention to be claimed. In addition, it can be very beneficial to have all of the inventor paperwork, (e.g., Declarations and Assignments), signed at the time the application is filed. These documents can be executed at a later date, however, there are times when this can be difficult to accomplish efficiently. Take assignments, for example; it may be difficult to establish ownership five or six

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<sup>3</sup> See 35 U.S.C. §103.

<sup>4</sup> 37 C.F.R. 1.56.

years later, so having documentation from the earliest stages of the process can alleviate a lot of headaches down the road.

It is also important to clearly establish the identity of the owner (or owners) of the application right from the start. This ensures that you can conduct a thorough conflict check and understand who has the authority to make decisions relating to the preparation and filing of the application. In addition, if the government has funded any portion of the research or development associated with the invention, a statement that the government has certain rights with respect to the patent application must be in the patent application.

### **Broaden the disclosure**

An inventor interview is a great time to expand the limits of the disclosure to encompass all of the possible embodiments. This is one of the most enjoyable aspects of being a patent prosecutor because you get to dust off your “engineering hat” and reimagine design aspects of the invention. As the inventor describes the invention to you, consider alternative ways in which one might design a similar product or process. Ask questions to identify what elements or steps are required and which are optional or could be replaced by similar steps. Inventors are often in the mindset of considering the “best” embodiment, which could be the most elaborate, the easiest to manufacture, the most profitable, or something that will suit some other business objective. Explain to the inventor that the goal of the disclosure is to encompass, at the very least, every design that the inventor or patent owner would like to prevent others from making, using, or selling. For example, if an inventor tells you that their composition must be heated at 250 degrees for 20 minutes, ask the inventor what would happen if the composition were heated to only 200 degrees, or to 400 degrees, and for longer or shorter periods of time. If a product design provides a certain function, ask whether that function can be accomplished with different configurations, materials, and so on. Through this discussion, you will identify workable and preferred ranges of the embodiment, as well as learn more about the process and how variations in the steps or elements will affect the outcome.

It is often difficult to predict what aspects of an invention will ultimately be important when it comes to patentability and commercial value. In another example from my experience, I prepared a patent application for an industrial product. The disclosure included about 30 pages of discussion that were mostly directed to embodiments having an element with a particular geometric shape. As we discussed the invention at the inventor interview, we asked, “What if the shape of this element is not so perfectly geometric?” The question got our inventor thinking and, because of that question, the application included one small paragraph (about 10 lines long) that disclosed an alternate embodiment detailing an embodiment with a less-than-perfect geometric shape. It was not what the client had envisioned manufacturing, however, it was worth noting. As it turned out, there was some difficult prior art disclosing the originally envisioned embodiment. It also turned out that the originally envisioned embodiment was not practical to manufacture. All was not lost, however, because the “what if” embodiment was indeed patentable *and* practical from a manufacturing standpoint. In addition, this particular claim was arguably infringed upon by a competitor in at least three countries where patent protection had been obtained, thus providing significant value to the client.

As a word of caution, it is important to keep in mind during such disclosure-broadening brainstorming sessions that you do not inadvertently become a co-inventor of the application. It will likely irritate the owner or inventor if you have explain to them why you need to be listed as

an inventor, and even if you assign your rights to your client, it can create a conflict of interest during prosecution of the application if you are also listed as an inventor. Ensure that you always ask your inventor whether any identified broadening disclosure would be suitable, rather than stating it as a fact or inserting disclosures broader than those provided to you without your inventor prompting you to do so. In this regard, it is also helpful to ask guiding questions to get your inventor thinking, without identifying specific ways in which the invention can be modified or broadened. I find it helpful to review the disclosures prior to my initial inventor interview to come up with a list of ways in which I would like to broaden the disclosures provided and then discuss this list at the interview so that I do not need to continually pepper the inventor with disclosure-broadening questions as the application is drafted.

### **Manage inventor/client expectations**

Particularly for small-to-mid-size clients that may not be familiar with patents and the patent prosecution process, it is important to communicate a few things during the inventor interview. In particular, it is helpful to outline the various types of patent applications, the patent prosecution timeline, and also establish a budget or estimate for the cost for preparing and filing the application. In addition, you may find it helpful to indicate that the patent application will not immediately be allowed and that the application will most likely receive an initial rejection. In the case where multiple inventions are claimed, indicate that you may ultimately need to file more than one application to obtain coverage for all of the disclosed inventions, even if they are all originally presented and filed in a single application. Lastly, while most lawyers know not to speak in absolutes, you should still be cautious when talking about how patentable you believe the invention may be (e.g., “your invention is patentable; “this idea is obvious”). When commenting on patentability, it is best to discuss it as a matter of your personal opinion and what you might see as a possibility for the ultimate outcome based on the information that you are aware of. Finding the line between being overly optimistic or pessimistic about the prospects is challenging, but no less important. By making it clear that you cannot provide a guarantee or certainty regarding an outcome, your client will not be able to hold you to achieving a result that is in many ways out of your control.

### **Watch your language**

Many inventors are excited about their invention and are enthusiastic about participating in the patent prosecution process. Inventors may be turned off or find it difficult to effectively communicate, however, if they cannot follow your line of questioning. It is not uncommon for inventors with multiple patents to their name to still not really understand much of the legalese, processes, or laws associated with patents. When conducting your interview, focus on avoiding jargon. We all know that patent lawyers have a unique way of speaking, even among other attorneys, and I can assure you that citing statutes, Manual of Patent Examining Procedure (MPEP) sections, or other legal terms will not impress anyone participating the interview, but clearly explaining various concepts, options, and objectives certainly will. This can be a difficult mental hurdle for any new patent professional, as you will have recently spent myriad hours ascertaining a plethora of erudite conceptions and vocabulary (a lot of time learning legalese) in preparing for the patent bar. As soon as you begin practicing, however, you should focus on explaining things to your clients and inventors in layman’s terms.

### **Concluding the interview**

End the interview by going over or preparing a detailed action list for the inventor that clearly indicates what additional information you need from the inventor and when you need it. There have been times when I have omitted this step and I have almost always regretted it. Either I forgot what I requested, or the inventor did not understand what exactly I needed by a certain time, and then it delays the project as you await information that is not forthcoming.

### **Wrapping things up**

In all, being skilled at conducting inventor interviews is an important aspect of being a patent prosecutor. It creates the framework—not just for the patent application, but for your relationship with the inventor during what is often a multi-year process—and hopefully results a stronger connection with your client and inventors. Inventor interviews allow you to gather information, frame the next steps, and set expectations that will keep your clients satisfied with your work and the end result.

## FILING OF A U.S. PATENT APPLICATION

Justin J. Cassell, Shareholder

WORKMAN NYDEGGER

Ver. July 2020

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### I. Overview

There are various U.S. patents -- utility, design, and plant. There are also two types of utility and plant patent applications -- provisional and nonprovisional. Each year the USPTO receives approximately 500,000 patent applications.<sup>1</sup> Most of these are for nonprovisional utility patents.

This guide focuses on filing U.S. utility applications, including both provisional and nonprovisional applications. Nonprovisional applications include:

- Regular nonprovisional with or without the benefit of priority<sup>2</sup> of an earlier-filed application.
- Continuation of – A second application for the same invention claimed in a prior nonprovisional application and filed before the original prior application becomes abandoned or patented. (MPEP 201.07)
- Division (or “divisional”) of – A later application for an independent or distinct invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application. (MPEP 201.06)
- Continuation-in-part (“CIP”) of – An application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion of the earlier nonprovisional application and adding matter not disclosed in the the earlier nonprovisional application. (MPEP 201.08)
- National Stage<sup>3</sup> (35 U.S.C. §371) of an international application – A U.S. application for patent, which entered the national phase from an international application under the Patent Cooperation Treaty (PCT). (MPEP 1893)

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<sup>1</sup> Nonprovisional (Utility) Patent Application Filing Guide; A Guide to Filing a Utility Patent Application January 2014, <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/nonprovisional-utility-patent#heading-2>.

<sup>2</sup> Priority claims may be to foreign applications (i.e. “foreign priority” under the Paris Convention through 35 U.S.C. §119(a)/172) or to domestic applications (i.e. “domestic benefit” under 35 U.S.C. §120). While foreign priority and domestic benefit have important distinctions, they are often used interchangeably or described simply as “priority.” Any use of the term “priority” in the ensuing discussion should therefore be interpreted in context and applied in view of the particular requirements for foreign priority and domestic benefit as appropriate.

<sup>3</sup> A U.S. national stage application under 35 U.S.C. §371 is the same as a national phase application referred to outside of the U.S.

- Substitution of – An application that is a duplicate of an earlier application by the same applicant abandoned before filing the later application. A substitute application does not have continuity to the earlier-filed application. (MPEP 201.02)
- Reissue of – An application to replace an unexpired patent that is defective, because of an error in the patent. (MPEP 201.05)
- Claims benefit of provisional – filed within one year and claiming the benefit of a provisional application, which is a regular national filing that starts the Paris Convention priority year. (MPEP 201.04)

An assumption of this document is that the application is complete and ready for filing, as a detailed discussion on the components of the application is not provided in this discussion.

Briefly, on the topic of a priority claim, such a claim is properly made when:

- the later- and earlier-filed patent applications include a common inventor or joint inventor;
- the later-filed patent application makes a specific reference to the earlier-filed patent application(s);
- the claim is made within 16 months from the filing date of the earliest-filed application or 4 months from the filing of the later-filed patent application; and
- the later-filed patent application is filed before or on the same day as the grant or abandonment of the earlier-filed patent application.

## II. Application Types

### A. Provisional Application

A provisional application is an application filed at the USPTO used to establish an early filing date and will expire after a 12-month pendency period from the filing date of the provisional application. The 12-month pendency period cannot be extended, as the application becomes automatically abandoned 12 months after the provisional application filing date. A provisional application does not become a patent as it is not examined.

A provisional application may establish priority to an application when an applicant claims the benefit of priority within the 12 months in a corresponding U.S. nonprovisional application or an international application filed under the PCT. Filing the provisional application (1) establishes the official United States patent application filing date for the invention, (2) permits the authorized use of “Patent Pending” notice, and (3) begins the Paris Convention priority year.

A provisional is maintained confidential at the USPTO unless a later application claims the benefit of priority of the application and the later application is published. If no priority claim is made on the provisional application, it will remain confidential from the public.

A provisional application is not available for design inventions.



## 1. Contents of a provisional application

According to 35 U.S.C. §111(b), a provisional application requires a specification and at least one drawing, when considered necessary.<sup>4</sup> The specification and the drawing need not be in a specific format if the specification explains the invention in clear, concise, and exact terms to enable one to make and use the invention.<sup>5</sup> While the format and manner in which the invention is described in a provisional application are more relaxed than nonprovisional applications, the written description must still satisfy the written description and enablement requirements of 35 U.S.C. §112(a).

A filing date will be accorded to a provisional application only when it contains a written description of the invention that complies with all the requirements of 35 U.S.C. §112(a).

Although the application will be given a filing date whether or not any drawings are submitted, applicants are advised to file with the application drawings necessary for the understanding of the invention, complying with 35 U.S.C. 113. A drawing necessary to understand the invention cannot be introduced into an application after the filing date because of the prohibition against new matter, so it becomes practically impossible to submit later drawings without introducing new matter. Further, 37 CFR1.53(c) prohibits amendments from being filed in provisional applications.

Tip: It is recommended to include at least one drawing at the time of filing the application to ensure compliance with the rules, and to obtain greater coverage for the subject matter of the application.

While a provisional application does not require claims, it is recommended to draft and provide claims with the provisional application. Claims assist the drafter in defining the subject matter of the invention, and in identifying inventorship for the patentable features of the application.

Tip: While claims are not necessary, it is recommended to provide claims to focus the application better and consider stronger priority benefits in applications claiming the benefit of priority of the provisional application.

Because provisional applications are not examined and have more relaxed standards for filing, this can lead to the trap of a deficient disclosure to establish the priority of an invention. If a disclosure in a provisional application is incomplete and is later relied upon for priority in a later-filed application, the applicant may find that disclosing an invention was insufficient and therefore, the invention is not protected by the provisional application. An insufficient provisional application may also compromise the later-filed application.

Tip: It is recommended to prepare a thorough provisional application that can stand on its own at the time of filing, as if it were a nonprovisional application, to comply with the written description requirements, and to provide stronger priority benefits for subsequent applications claiming the benefit of priority.

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<sup>4</sup> 35 U.S.C. §113

<sup>5</sup> 35 U.S.C. §112

## 2. Procedure for filing a provisional application

A complete provisional application must also include the filing fee in 37 CFR 1.16(d)<sup>6</sup> and a cover sheet identifying:

- the application as a provisional application for patent;
- the name(s) of all inventors;
- inventor residence(s);
- title of the invention;
- name and registration number of the attorney or agent and docket number (if applicable);
- correspondence address; and
- any U.S. Government agency with a property interest in the application.

The cover sheet should be an Application Data Sheet (ADS)<sup>7</sup> (discussed more fully below), rather than a Provisional Application for Patent Cover Sheet<sup>8</sup>. The ADS is preferred since the USPTO can extract bibliographic data directly from the ADS, and can avoid data entry errors when creating the official electronic record of the application. Changes to the bibliographic data of the application can be made by filing a corrective ADS.

As there will be additional fees if the ADS is filed later, it is preferred to file the provisional application complete with the ADS and identification of the inventor(s).

The provisional application can be filed electronically or by mail. It is preferred to file the provisional application electronically by EFS-Web, with the documents prepared in Portable Document Format (PDF). When EFS-Web is used, the data entered into the forms are automatically loaded into the USPTO information systems.

The provisional application can be filed without an ADS or cover sheet or the basic filing fee; however the applicant will receive a notice to file the ADS or cover sheet and pay the basic filing within two months of the filing date of the provisional application<sup>9</sup> and must pay the surcharge to avoid abandonment.

Tip: To avoid delays and surcharge for late payment, it is recommended to file the ADS or cover sheet and pay the basic filing fee at the time of filing the application.

## 3. Additional considerations

### i. Power of Attorney

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<sup>7</sup> 37 CFR 1.76; Form AIA/14

<sup>8</sup> Form SB/16 EFS-Web

<sup>9</sup> 37 CFR 1.53(g).

It is recommended to file a Power of Attorney from the assignee or applicant when filing a provisional application. While the ADS will identify the correspondence address for the practitioner, the file management functions are *available* only regarding application files for which the user has filed a Power of Attorney.

A Power of Attorney authorizes a patent attorney to represent a client before the USPTO. Having a Power of Attorney enables a patent practitioner to submit time-sensitive documents during the patent application process, which is especially useful if the patent applicant is unavailable to execute certain documents. Powers of Attorneys will be discussed in more detail below regarding nonprovisional applications.

Tip: It is recommended to file a Power of Attorney in a provisional application to ensure proper routing of correspondence and to enable full access of the practitioner to the application file.

## ii. Assignment

Although patent rights belong to the inventors under U.S. law, some inventors must assign rights to the provisional application to employers or another entity through agreements (such as employment, contractor, collaborator, etc.). Inventors may leave their job before a priority claim is made on the provisional application, and thus it is useful for the assignee, such as an employer, to establish ownership rights in the application and the invention thereof.

If an assignment is executed in the provisional application, and no new matter is introduced, the assignment in the provisional application can be used for later-filed applications claiming the benefit of priority from the provisional application. It is cautioned, however, that if later-filed applications contain new matter beyond the provisional application, a new assignment should be obtained.

Tip: It is preferred to obtain and record assignments in a provisional application. This eliminates uncertainty to the ownership of the application, and will ensure the assignee to file future applications based on the invention of the provisional application.

## iii. Multiple Provisional Applications

An applicant may file as many provisional applications as desired for an invention. In developing inventions, it may be desirable to file an invention early on to establish an early priority date, despite a lack of completion of a project. Multiple provisional applications may be filed at milestones as a project develops, to build an eventual nonprovisional application(s) claiming the benefit of priority from the provisional application(s).

It should be remembered, however, that priority for an invention is only established as of its filing date. If multiple provisional applications are consecutively filed, priority for the new subject matter in each provisional application will have only a priority date as of the date it is

filed in a provisional application. As a provisional application expires after the 12-month pendency period, keep track of the filing dates if consecutive provisional applications are filed.

Tip: Remember the different filing dates if multiple provisional applications are filed and later claimed for the benefit of their priority dates in a nonprovisional application so as not to miss out on the priority date of the earliest filed provisional application. The clock starts at the time of filing the provisional application, and thus the timing of the first filing is important to consider regarding the project on which the subject matter is based.

#### iv. Conversion

Many practitioners speak of the conversion of a provisional and filing a nonprovisional claiming the benefit of a provisional interchangeably. But on converting a provisional application to a nonprovisional application, applicants should carefully consider the patent-term consequences of requesting conversion rather than simply filing a nonprovisional application claiming the benefit of the filing date of the provisional application under 35 U.S.C. 119(e).

If one converts the provisional to a nonprovisional, rules against adding "new matter" to an existing application apply, which would preclude adding anything more to the converted application. The "new matter" rule does not apply, however, if a nonprovisional application claims the benefit of priority from the provisional application. Conversion of a provisional application to a nonprovisional application also requires additional paperwork including a petition, a preliminary amendment to include claims (if necessary), and the normal forms.

The patent term of a converted provisional application will be determined from the filing date of the provisional (now converted to nonprovisional) application, rather than from the later-filed nonprovisional application claiming the benefit of priority from the provisional application, reducing the patent term by a year.

Tip: It is often preferred to avoid converting a provisional application to a nonprovisional application, and rather claim the benefit of priority of a provisional application in a nonprovisional application. Claiming the benefit of the provisional application under 35 U.S.C. 119(e) is less expensive and will cause a longer patent term. The provisional application's filing date is lost, and the filing date for any patent that issues will be the date of conversion.

#### B. Nonprovisional Application and Its Contents

A nonprovisional patent application is a U.S. national application for patent filed:

- directly filed in the USPTO under 35 U.S.C. §111(a);
- an international application under the PCT designating the U.S.; or
- an international design application.<sup>10</sup>

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<sup>10</sup> 37 CFR §1.9

All applications filed under 111(a) are considered nonprovisional patent applications, and are distinguished from a provisional patent application.

A nonprovisional patent application is a domestic U.S. patent application with the possibility to mature into an issued U.S. patent if, after examination, the patent examiner is satisfied that the patentability requirements have been met. A nonprovisional application can seek a plant patent, a design patent or a utility patent. Utility patents, however, can come from a nonprovisional utility patent application, a divisional application, continuation, continuation-in-part, a 35 U.S.C. §371 of an international application, a bypass application<sup>11</sup>, and a reissue application.

When filing a nonprovisional utility patent application, it must be submitted in the English language or be accompanied by a translation in the English language, a statement that the translation is accurate, and have payment of the fee outlined in 37 CFR1.17(i). If an applicant files a nonprovisional utility application in a language other than English without the translation, statement, or fee, the applicant will be given notice and period to submit the missing item(s).

A nonprovisional utility patent application must include a specification, including a description and a claim or claims; drawings, when necessary; an oath or declaration; and the prescribed filing, search, and examination fees.

### III. Filing a Nonprovisional Utility Application

A complete nonprovisional utility patent application should contain the elements listed below, arranged in the order shown. Description of these elements is provided in these sections:

- Utility Patent Application Transmittal Form or Transmittal Letter
- Appropriate Fees
- Application Data Sheet (ADS) (see 37 CFR1.76)
- Specification (with at least one claim)
- Drawings (when necessary)
- Executed Oath or Declaration

#### A. Transmittal Form

When filing a new application by EFS-Web, a signed transmittal form or signed ADS is recommended for identification. However, a signature is not required for a transmittal form or ADS to obtain a filing date for a new patent application.

As with a provisional application, a signed transmittal form is not required if an ADS is filed, as the ADS will substitute for the transmittal form. By using EFS-Web, the bibliographic information is auto-loaded by extracting data from the USPTO fillable forms and loading the

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<sup>11</sup> A bypass application under 35 U.S.C. §111(a) is a continuation application claiming the benefit of a PCT application under 35 U.S.C. §120.

data into USPTO databases. A title and a list of contents filed with the application are listed and entered when using EFS-Web.

Any regular nonprovisional utility application filed by mail or hand-delivery will require payment of an additional \$400 fee called the "non-electronic filing fee," which is reduced by 50 percent (to \$200) for applicants that qualify for small entity status under 37 CFR 1.27(a) or micro entity status under 37 CFR 1.29(a) or (d). The only way to avoid having to pay the additional \$400 non-electronic filing fee is by filing the regular nonprovisional utility application via EFS-Web.

Tip: File a new application with an ADS to avoid filing a transmittal form, and file electronically by EFS-Web to avoid the additional non-electronic filing fee.

## B. Appropriate Fees

The filing fees for a nonprovisional include the filing fee, the search fee, the examination fee, the optional excess claim fee<sup>12</sup>, the multiple dependent claim fee<sup>13</sup>, and the optional excess pages fee<sup>14</sup>. Excess claim fees are counted for both excess independent claims over three and excess claims over twenty. It follows if there are more than three independent claims and twenty claims total, one is assessed for excess claim fees for both the excess independent claim(s) and claims over twenty.

Tip: Consideration should be given before preparing the application to determine whether optional excess claim fees and multiple dependent claim fees are necessary. An examiner may issue a restriction requirement that may remove claims from examination and therefore negate the optional excess claim fees, and many U.S. examiners disfavor multiple dependent claims.

If an application is filed without the basic filing fee, search fee or examination fee, the applicant has three months<sup>15</sup> from the filing date of the application to pay the missing fee(s), and pay the surcharge under 37 CFR 1.16(f).<sup>16</sup> The fees must be paid in response to a Notice of Missing Parts by the specified deadline. The same surcharge applies to the late filing of the oath or declaration.

When filing a U.S. non-provisional application under 35 U.S.C. §371, the Applicant must at minimum pay the basic national stage or basic filing fee at the time of filing the application. Other fees, such as the Search fee or the Examination fee can be paid later, with the surcharge fee.

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<sup>12</sup> 37 CFR 1.16(h) for each independent claim in excess of three; 37 CFR 1.16(i) for each claim in excess of twenty.

<sup>13</sup> 37 CFR 1.16(j).

<sup>14</sup> An application size fee will be due if a total number of specification and drawing pages that exceeds 100 for the first 50 pages.

<sup>15</sup> 37 CFR 1.53(f).

<sup>16</sup> 37 CFR 1.116(f) surcharge for late filing fee, search fee, examination fee, inventor's oath or declaration, or application filed without at least one claim or by reference for a §111 case; 37 CFR 1.492(h) surcharge for late filing of search fee, examination fee or oath or declaration after the date of commencement of the national stage.

## 1. Brief Discussion on Entity Status

As a default, fees are assessed as a large entity.

Discounts are available for small entity status<sup>17</sup> and micro entity status<sup>18</sup>.

## 2. Small Entity Status

Small entity status may be appropriate if the inventors have assigned no rights in the invention in the application and are not under any obligation to do so (as required in an employment contract). By filing electronically via EFS-Web, the filing fee for an applicant qualifying for small entity status is further reduced. If an applicant qualifies for small entity status, no special form is required to declare entitlement to reduced fees (selected in the ADS), and an applicant only pays small entity rates after ensuring that qualification for the small entity status.

"Small Entity" or "Large Entity" status applies to the owner of the patent rights - *not the inventor or inventors, who would always be individuals* under U.S. law. If the owner has granted patent rights to an entity that is not a small entity, then the owner cannot claim Small Entity status.

Once small entity status is established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due. Notification of any change in status resulting in loss of entitlement to small entity status is to be filed in the application or patent before paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate.<sup>19</sup>

The USPTO has defined four categories of concerns that qualify as a "small entity": a university, a nonprofit organization, an individual inventor, or a small business concern. A small business concern is defined as being independently owned and operated, not dominant in the field in which it is bidding on government contracts, and meets any applicable criteria for a particular industry about number of employees (less than 500) or annual receipts (usually less than \$7 million) or annual profits (usually more than \$2 million).

## 3. Micro Entity Status

Although not required for small entity status, micro entity status should be evaluated each time a fee is paid.

Micro entities were introduced by the America Invents Act and receive a further 25% reduction in fees compared to small entities. To receive micro entity status, each applicant and inventor must (1) be a named inventor on no more than four prior U.S. patent applications, (2) must have no more than three times the median household income in the U.S., and (3) may not assigned an

<sup>17</sup> 37 CFR 1.27(a); Please refer to MPEP 509.02. for a more detailed discussion on small entity status.

<sup>18</sup> 37 CFR 1.29(a); Please refer to MPEP 504.04 for a more detailed discussion on micro entity status.

<sup>19</sup> 37 CFR 1.27(g)(1); 37 CFR 1.27(g)(2)

interest in the invention to anyone with an income above three times the median household income. The “Maximum Qualifying Gross Income” for a micro entity is \$184,116.

## C. Application Data Sheet (ADS)

### 1. Overview

Although an ADS is not formally required, it is recommended to file an ADS when filing a nonprovisional application to ensure that the bibliographic information is auto-loaded and to ensure compliance of rules for when an ADS is required. To take advantage of auto-loading an ADS, a Web-based ADS should be filed through EFS-Web rather than using a PDF version of the ADS.

However, sometimes, an ADS is required for applications filed on or after September 16, 2012:

- A claim for foreign priority under § 1.55(d)(1)(i) must be in an ADS: the presence of the priority claim in the oath or declaration will not be recognized (MPEP 210).
- A claim for domestic benefit under § 1.78 must be in an ADS: the presence of the benefit claim in the first sentence(s) of the specification will not be recognized.
- If the applicant is not the inventor, an ADS must be filed to identify the applicant.
- If an applicant postpones submitting an oath or declaration until payment of the issue fee, an ADS must be filed identifying the inventors.

An ADS filed after the submission of the application, even where no ADS was filed, must identify the information being added or deleted, with underlining for additions, and strike-through or brackets for deletions.

Certain information cannot be changed by simply filing a corrected ADS. Changes to the named inventors must comply with the requirements of 37 CFR 1.48, correspondence address changes must comply with the requirements of 37 CFR 1.33(a), and foreign priority and domestic benefit information changes must comply with 37 CFR§ 1.55 and 1.78, respectively.

The USPTO strongly recommends submitting an ADS with the application at the time of filing rather than after filing the application.<sup>20</sup> The ADS submitted upon filing must be properly signed by a party under 37 CFR1.33(b). The S-signature is acceptable with a complete registration number and a printed name.

If an ADS is properly signed, the ADS:

- Establishes inventorship;
- Establishes the applicant; and
- Presents domestic benefit/foreign priority claims.

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<sup>20</sup> Patent Quality Chat, Understanding the ADS, Little Things Make a Big Different, February 14, 2017, USPTO, presented by Janice Tippet, Management and Program Analyst, Office of Patent Application Processing.



A properly signed ADS does not establish power of attorney.

Tip: It is best to file an ADS with all applications given the limited circumstances in which an application data sheet (ADS) is not required.

Information captured from other sources will become “of record,” and any changes to this information must be made using a properly signed, properly marked-up ADS. Information in an ADS generally governs when submitted simultaneously. The USPTO will not attempt to correct misspelled names and title, and incorrect application numbers and dates in domestic benefit/foreign priority claims.

Tip: Make certain that all information is correct in an ADS as that information will serve as the official information for the application.

All ADSs submitted after filing must be properly marked up - even if it is the first ADS, because the information was gathered from other documents upon filing and made of record. All changes to information already of record must be marked up.

Some changes must come with additional forms as required according to the nature of the changes:

- Changes to applicant – § 3.73 Statement and POA may be required.
- Changes to entity status – certification, written statement, or petition may be required.
- Changes to inventorship – fees, statements, inventor’s oath or declaration may be required.
- Changes to domestic benefit or foreign priority claim -- a petition may be required.

## 2. ADS Deep Dive

In the discussion that follows, a step-by-step process for filing an Application Data Sheet (ADS) according to 37 CFR1.76 is described, according to PTO/AIA/14, version of February 2018.

At the header of each page is an information box that automatically populates the attorney docket number, application number (if applicable, as in a corrective ADS) and the title of the invention. One cannot fill in the header, but the information is automatically filled from the Application Information located after the Correspondence Information.

### i. Application Information

Title: The title of the invention is limited to 500 characters and it is preferable if kept in a specific form.

Attorney Docket Number: While this field is optional, it is recommended to insert an identifier to track the application, and it will appear on all USPTO correspondence to the practitioner of record.

Small Entity Status Claimed: This field allows for claiming small entity status. Micro entity status can be checked under small entity status claimed but must be further certified on different forms.<sup>21</sup>

Application Type: Provisional or nonprovisional status is chosen.

Subject Matter: Application can be selected among utility, design or plant.

Total Number of Drawing Sheets: This field provides a good check to ensure the drawings are in order and it is recommended to verify against the Brief Description of the Drawings in the written description.

Suggested Figure for Publication: If a particular figure is desired for being shown on the first page of the publication of the patent, the figure may be referenced in this field.

## ii. Secrecy Order 37 CFR5.2

If an invention has been determined to be a matter of national security, the Commissioner for Patents may keep the invention secret. Under the same rule, applicants must notify the USPTO of any related cases to the application being filed that the Commissioner has kept secret. Documents associated with applications under a Secrecy Order may not be filed electronically.

## iii. Inventor Information

The inventor is established as the Applicant by default if an Applicant is not otherwise named in a properly signed ADS. A change of the Applicant after inventorship is established requires a request under 37 CFR 1.46(c). Requirements to comply with 37 CFR 1.46(c) include (1) a corrective ADS and (2) statement under 37 CFR 3.73(c).

Legal name: The inventor's given and family name are mandatory. The Prefix, Middle name and Suffix are optional.

Residence Information: Select the residency of the inventor. The City information is required if the inventor is a U.S. resident or a non-U.S. resident, as is the State/Province information if the inventor is a U.S. resident. For Active Military Service, indicate the region where the inventor is stationed.

The country of residence will default to the U.S. if the inventor is a U.S. resident. If the inventor is a non-U.S. resident, the country code is required.

Address Information: The inventor's mailing address means the address at which he or she customarily receives his or her mail, even if it is not the main mailing address of the inventor. Either the inventor's home or business address is acceptable as the mailing address. A post office box is also acceptable.

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<sup>21</sup> Form PTO/SB/15A for certifying micro entity status on "gross income basis under 37 CFR §1.29(a); Form PTO SB/15B for certifying micro entity status on the "institution of higher education basis" under 37 CFR §1.29(d).

Additional Inventors: Joint inventors in an application must apply for the patent jointly, and their information must be included by selecting the additional inventor add button, thereafter following the same procedure as the first inventor.

Corresponding information to oath or declaration: When the ADS sets inventorship, the name provided on the inventor's oath or declaration must match the name in the ADS. Note:

- Both documents require a legal name.
- If the names do not match, a new inventor's oath or declaration or § 1.48 request will be needed.
- There is an exception for character substitution for characters that cannot be entered on ADS (for example: ss for ß, ae for ä, oe for ö)

Tip: Make certain to compare the information for the inventor in the ADS to the information of the inventor in the oath or declaration.

Correcting Inventor Information: Although beyond the scope of this document, the correction of inventor information and revisions to the inventorship of an application or issued patent includes a corrective ADS, among other documents such as a petition, oath or declaration, statement from inventors, etc.

#### iv. Correspondence Information

When filing an application, a correspondence address must be set forth in either an ADS (§1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the USPTO may treat the mailing address of the first-named inventor (if provided, see §§1.76(b)(1) and 1.63(b)(2)) as the correspondence address. The USPTO will direct all notices, official letters, and other communications relating to the application to the correspondence address.

The USPTO will not engage in dual correspondence with an applicant and a registered attorney or agent, or with more than one registered attorney or agent except as deemed necessary by the Director. If more than one correspondence address is specified, the USPTO will establish one as the correspondence address.

The checkbox should be selected if correspondence is sent to an address different from a practitioner having a Customer Number. If the checkbox is selected, information fields are provided for directing the correspondence associated with the application.

Customer Number: A Customer Number is assigned by the USPTO to simplify the submission of an address and to associate practitioners linked to the Customer Number. Customer Numbers are primarily used by law firms, attorneys and agents.

Email Address: The email address is provided, and can be associated with the Customer Number to enroll in electronic communications from the USPTO associated with the application.

#### v. Filing by Reference

Do not complete this section if application papers, including a specification and any drawings, are being filed at the time of filing the application. This section is for completion only when filing an application by reference under 35 U.S.C. 111(c).

Tip: A reference filing is useful where time and filing resources are limited and the filing deadline may be missed. It is recommended not to use this section.

This section is not for making domestic benefit or foreign priority claims. Any domestic benefit or foreign priority information must be provided in the “Domestic Benefit/National Stage Information” section and the “Foreign Priority Information” section.

To qualify a filing by reference, the ADS provides the information fields required to qualify under rule 37 CFR 1.53(b) of the application number, filing date and intellectual property authority or country. The ADS also provides the statement that the specification and any drawings of the application being filed are replaced by the reference to the previously-filed application.

#### vi. Publication Information

Request for Early Publication: The request may be made when filing the ADS. For applications filed on or after January 1, 2014, there is no publication fee.

Request Not to Publish: The request can be made in the ADS to not publish the application. By clicking on the box, it is certified that the application according to the ADS will not be the subject of an application in another country requiring publication after eighteen months. The request not to publish must be submitted with the application upon filing (this is a statutory requirement that cannot be waived).

Before Making the Nonpublication Request: A nonpublication request is not appropriate unless an inquiry has been made according to the requirements of 37 CFR 11.18(b). An applicant can file a nonpublication request only if both conditions are met:

- The application under 35 U.S.C. 111(a) has not been the subject of a foreign or international application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing (*e.g.*, a counterpart PCT application); and
- The applicant’s intent at the time the nonpublication request is being filed is that the application under 35 U.S.C. 111(a) will not be the subject of a foreign or international application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing.

Rescind Request: If the applicant filed a nonpublication request and later files a counterpart foreign or international application in another country, or under a multilateral agreement that requires eighteen-month publication, the applicant must either:

- Rescind the nonpublication request before filing such foreign or international application; or
- Notify the USPTO of such filing by 45 days after the filing date of the counterpart foreign or international application.

vii. Representative Information

A Customer Number or representative name can be provided in this section. If both sections are completed the Customer Number will be used for the Representative Information during processing.

viii. Domestic Benefit/National Stage Information

Requirement: Domestic benefit claims must be presented in the Application Data Sheet only for applications filed on or after September 16, 2012. Presence of the benefit claim in the first sentence(s) of the specification will not be recognized.

Application Relationship: Indicate the correct relationship and order of the domestic benefit applications on the ADS. If the order is incorrect, then the Office of Patent Application Processing (OPAP) may not accurately capture the entire benefit claim.

An example of an incorrect relationship is misidentifying a 111(a) continuation application as a §371 national stage entry of the PCT application, or vice versa. Another example is non-specific relationship identifiers (e.g., “Continuing” is non-specific; must be Continuation, Divisional or CIP).

Order of Applications: Newest to oldest. The order of the applications should be listed beginning from the application and continuing through the list of parent applications in reverse-chronological order.

Multiple Chains of Applications: If there is more than one chain of applications for which benefit is being claimed, one must start each chain with the most recent application and go back chronologically to the earliest application in each chain. Otherwise, the benefit claims may not be recognized by the USPTO if not presented in this manner and will not auto-load into the USPTO’s electronic systems.

Continuity Type: Select the relationship between patent applications by selecting one of seven relationships in the drop-down menu. The relationships are continuation, division, continuation-in-part, §371 of international, substitution, reissue and claims benefit of provisional.

Prior Application Number: Provide the application number for the related application to which the application is claiming the benefit. Where the prior application is an international design

application designating the United States, either the U.S. application number or the international registration number may be provided.

Filing Date or 371(c) Date: Select the filing date or §371(c) date of the prior related application from the drop-down menu, which converts into a calendar. The date may be selected from the calendar feature and must be in the format YYYY-MM-DD.

Tip: Know foreign date formats, as they do not always align with the format U.S. practitioners are used to.

Prior Application Status: Select the status of the prior application from Patented, Pending, Abandoned, or Expired.

Reminder on when to claim Priority Benefit: The deadline to claim priority is the later of (1) four months from the filing date of the nonprovisional application in which priority is claimed; (2) sixteen months of the application from which priority is claimed. Failure to timely claim priority will cause a loss of priority rights. If delay is unintentional, a petition may be filed with a fee.<sup>22</sup>

Tip: Clerical mistakes in making the priority benefit may cause the USPTO to reject the priority claim, so pay close attention to the entered information.

#### ix. Foreign Priority Information

Foreign Priority: A claim for foreign priority under § 1.55(a)(1)(i) must be in an ADS. Presence of the priority claim in the oath or declaration will not be recognized.

For applications entering the national stage under 35 U.S.C. §371, foreign priority claims need not be in the ADS. Foreign priority claims in these applications must have been timely made in the international phase in the PCT request form or in a notice from applicant.

Tip: While not a requirement to list foreign priority claims, it is recommended to list such foreign priority claims to ensure proper entry into the application by the ADS.

Application Number: Enter the Foreign Document Number of an associated foreign-filed application in the Application Number field. PCT number format: PCT/aaYY/xxxxx or PCT/aaYYYY/xxxxx, where aa is valid foreign receiving office/country code, YY or YYYY is year, and xxxxx is the five-digit number.

Country and Filing Date: Enter the country where the application was filed and use the World Intellectual Property Organization (“WIPO”) table of countries for abbreviations.

Filing Date: Enter the foreign filing date in the Date filed field. The date should be in the format YYYY-MM-DD.

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<sup>22</sup> 37 CFR §1.55; 37 CFR §1.78; 37 CFR §1.17(m), currently \$1,700 .

Tip: Be careful about the date format of foreign priority applications as date formats vary from country.

Access Code: Enter the access code number to uniquely identify a patent application registered into the WIPO DAS ( Digital Access Service).

#### x. Transition Applications

Transition Application Defined: A “transition application” is any nonprovisional application filed on or after March 16, 2013, that claims the benefit of the filing date of a pre-AIA (filed before March 16, 2013) provisional, foreign, nonprovisional, or PCT application that designates the United States.

Where a transition application adds new matter and that new matter is claimed (or ever was claimed) in the transition application, the applicant must state the USPTO indicating that the transition application contains at least one claim supported by the added matter. If the transition application discloses but does not claim new matter, no statement is needed.

#### xi. Authorization or Opt-Out of Authorization to Permit Access

Authorization: When the ADS is properly signed and filed with the application, the applicant has provided written authority to permit a participating foreign intellectual property (IP) office access to the application-as-filed (see paragraph A in subsection 1 of this section of the ADS) and the European Patent Office access to any search results from the application.

Opt-out: An applicant must opt-out of the authorization upon the initial filing of the application, after which an ADS may not be used to opt-out of the authorization.

#### xii. Applicant Information

Applicants: A party applying for a patent may name the inventor or joint inventors of the invention as the applicant, or may name the assignee, an obligated assignee, or a person who otherwise shows sufficient proprietary interest in the application as the applicant.

Assignee: Typically, an assignee is an applicant if an assignment exists, however the assignee may grant the Power of Attorney without having to establish a right to act. While the assignee may file and prosecute the application, the inventor(s) is still required to execute an oath or declaration.

Recognition of Assignee as Applicant: For the USPTO to recognize an assignee (or another party as described above) as the applicant in an application, assignee information must be included in the Applicant Information section of the ADS. When naming the assignee as the applicant, i.e., on the same day the application is filed, proof that an assignment has been executed and recorded is not required.

Designating the assignee as the applicant is generally favorable for the assignee, as it may be difficult to ensure continued cooperation from the inventors during prosecution of the application. Inventors quit their jobs occasionally, or the relationship between the inventor and the assignee deteriorates.

Applicant Section Left Blank: If the Applicant Information section is left blank, the USPTO will recognize the inventor or joint inventors as the applicant.

Change of Applicant: The Applicant can be changed in prosecution, and requires: (1) Request to Update Applicant under 37 CFR 1.46(c), (2) a corrective ADS, (3) Statement under 37 CFR 3.73(c), and (4) a Power of Attorney from the new applicant.

Incorrect Applicant: A petition under 37 CFR 1.182 must attempt correction/removal of an improperly named applicant, with the document to change the Applicant.

Rejection of Applicant: A rejection of a change of Applicant may affect the currently-filed Power of Attorney by the Applicant.

Juristic Entity: Where the applicant is a juristic entity, the ADS may be signed only by a patent practitioner. For other applicants, the ADS may be signed by either the applicant or a patent practitioner. Juristic entities are corporations and other non-human entities created by law and given certain legal rights that seek to prosecute an application. Post-AIA, juristic entities may be applicants in patent applications.

#### xiii. Assignee Information Including Non-Applicant Assignee Information

Assignee Information: Complete this section if assignee information, including non-applicant assignee information is desired to be included on the patent application publication under 37 CFR 1.215(b). An assignee-applicant identified in the "Applicant Information" section will appear on the patent application publication as an applicant. For an assignee-applicant, complete this section only if identification as an assignee is also desired on the patent application publication.

#### xiv. Signature

Who Signs: This Application Data Sheet must be signed by a patent practitioner if one or more applicants is a juristic entity (e.g., corporation or association, as discussed above). 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 given Power of Attorney (e.g., see USPTO Form PTO/AIA/81) on behalf of all joint inventor-applicants.

#### S-Signature:<sup>23</sup>

- The S-signature must consist only of letters or Arabic numbers, or both, and appropriate spaces, commas, periods, apostrophes, or hyphens for punctuation.

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<sup>23</sup> 37 CFR §1.4



- The person signing must insert their own signature between forward slash marks.
- The name of the person signing must be printed or typed immediately adjacent (i.e., below, above or beside) to the S-signature, and be reasonably specific, so the identity of the signer can be readily recognized.
- A registered practitioner may S-sign but their registration number is required, either as part of the S-signature or immediately below or adjacent to the signature.
- Example: /John Attorney Reg. #10,000/ John Attorney.

#### D. Application

While the following provides drafting suggestions and tips for parts of U.S. patent applications, these are nonlimiting suggestions as each patent application should be treated on a case-by-case specific to the subject matter and applicant strategy for filing the application.

##### 1. Title of the Application

The title is listed in the ADS and this title will control, although it is recommended to include the title at the beginning of the application.

The title should broadly identify the application in short and concise terms, and cannot exceed 500 characters. It should not include terms such as improved, new, novel and other terms characterizing the invention. Articles “a,” “an,” and “the” should not be included as the first words of the title and will be deleted by the USPTO if present.

##### 2. Cross-Reference to Related Applications

If there is a benefit of one or more earlier-filed provisional or nonprovisional applications, these applications may be identified after the title of the application. However, benefit claims, to be recognized by the USPTO, must be made in the ADS.

Incorporate by reference all applications in the chain of priority, including their relevant information such as serial number, publication number or patent number, and their corresponding filing, publication or issue dates, to have at least two fields of corroborating information if one field of information is erroneously identified.

##### 3. Statement Regarding Federally Sponsored Research or Development

A statement regarding federally sponsored research or development is added after the title if the research and development cost of the invention were made using federal money. It is possible that an individual may retain U.S. domestic patent rights; however, the applicant must include a statement at the beginning of the application stating this fact.

Use language such as “This invention was made with government support under [contract number] awarded by [identify government agency]. The government has certain rights in the invention.”

#### 4. Field of the Disclosure

This section is not required; however, it has been found to influence classification of the application by the brief and concise description of the technical disclosure.

Tip: Although often listed as “Field of the Invention,” it is suggested to call the section the field of the “disclosure” as the “invention” may change during prosecution.

The field of the disclosure may include a generalized solution statement to a problem the invention seeks to solve.

#### 5. Background

The background section is not required. There is no requirement to discuss and contrast the prior art.

The Background may provide context for the invention. It may include a statement about the technology or subject matter to which the invention pertains and may paraphrase any related patent classification definitions.

Care should be given when drafting this section to avoid creating Applicant Admitted Prior Art.

If prior art is discussed, it is preferable to cautiously characterize the prior art without comparing the prior art to the disclosure. When characterizing the prior art, rely on neutral explanatory terms to merely specify what it states and avoid comparative terms.

The Background may set up a problem in the art, however it is advisable to reserve a more detailed discussion of the problem or shortcomings of the prior art when comparing the solution in the description of embodiments of the disclosure.

#### 6. Summary

The summary is not required but it is recommended to summarize the disclosure and embodiments. The summary may set up the story of the disclosure by laying the foundation for the problem the disclosure seeks to solve, and then introducing how the embodiments of the disclosure solve the problem.

When introducing the problem, it is recommended to provide a more generalized description of the shortcomings known before the invention, rather than specifically identifying prior art.

A common technique is to place the claims in the summary in plain language to ensure that the disclosure corresponds to the claim language.

The description of the independent claim(s) in the summary should be presented as the broadest embodiment(s) and is/are the general solution to the problem established in the background.

Alternatives to the embodiments may be introduced as variations to expand the solution(s) and scope of the disclosure.

Consider using a transitory paragraph in the summary by indicating that the summary is not intended to be exhaustive of every embodiment or implementation of the disclosure or limiting, and the following discussion exemplifies embodiments of the disclosure in greater detail. For example, “[T]hese and other features, aspects, and advantages of the present disclosure will become better understood regarding the following description, appended claims, and accompanying drawings.”

#### 7A. Drawings

The applicant for a patent must furnish a drawing of the invention where necessary for the understanding of the subject matter sought to be patented.

The drawing in an application must show every feature of the invention specified in the claims, and it is recommended to check the drawings to confirm that the features of the claims and possible variations discussed but not claimed in the disclosure are present in the drawings if an amendment to the claims is made (e.g. narrowing the claims by claiming additional features).

Drawings are not required when the invention relates to chemical compounds or compositions being claimed, or if a method is claimed. Drawings may still be useful in such instances, however, such as for better understanding a method.

Drawings provide a crucial role in understanding an application. Consider how many drawings can demonstrate the invention, including different views which may offer different perspectives over other views to better understand the embodiments.

Consider providing perspective views when different angles yield different understandings of the figure and the claimed subject matter. Consider providing exploded views when a figure includes different components so that each is shown, and its relationship is understood regarding other components.

While informal drawings may be submitted at the time of filing, it is recommended to provide formal line drawings at the time of filing the application to avoid the introduction of new matter.

Consider providing multiple quality drawings to demonstrate the disclosure and cover the embodiments and variations. Color drawings may be included in a utility patent application under 37 CFR1.84. To include color drawings, a petition must be filed explaining why the colored drawings are necessary (*i.e.*, the only practicable medium to display subject matter that is to be patented). Color drawings should be considered only when conversion into black and white would cause a loss of detail that would obscure certain subject matter sought to be patented.

#### 7B. Brief Description of Drawings

Include a list of all figures by numbers with a brief statement explaining what each figure depicts.

Properly identify the drawing and view of each drawing for each figure to explain briefly what it represents. For example, plan view, elevational view, section view, or perspective view. *See* 37 CFR 1.84(h). If prior art is shown in the drawings, identify or label the figure as representing the prior art.

Order the figures according to the discussion of the embodiments and variations thereof in the detailed description of various embodiments.

A transitory paragraph in the detailed description may be used such as “The drawing figures are not necessarily drawn to scale, but instead are drawn to provide a better understanding of the components thereof, and are not intended to be limiting in scope, but to provide exemplary illustrations.”

## 8. Detailed Description of Various Embodiments

This part of the specification should explain the invention and the process of making and using it in full, clear, concise, and exact terms. The description must be clear and complete enough that anyone working in that technology could make and use the invention without extensive experimentation.

Include a transitory paragraph introducing the embodiments such as “A better understanding of different embodiments of the disclosure may be had from the following description read in conjunction with the accompanying drawings in which like reference characters refer to like elements.”

Start by describing the most basic description of an embodiment of the disclosure, followed by a more specific discussion of each feature of the embodiment and variations thereof.

Explain how the basic embodiment solves the problem at the time of the invention. If available describe the basic embodiment as a story of how it solves the identified problem which may be beneficial when discussing the embodiments and corresponding claims during prosecution. Provide various levels of support for each feature to each embodiment that may be relied upon for greater specificity during prosecution.

Describe all drawings and account for each element identified by a reference number in the drawings. During the drafting of the application, consider making a parts list to check off each reference number in the drawings based on a corresponding recitation in the detailed description.

Discuss the embodiments in multiple dependent form to allow for reciting combinations of the embodiments or their features in the claims to avoid being constrained to only the features associated with a discussion of a single embodiment. Express the interrelatedness of each embodiment and features thereof.

Consider defining features of embodiments to ensure such features are accorded the proper construction in the claims. Avoid terminology inconsistent with the ordinary meaning of terms. Avoid excessive qualifiers of the name of features, but explain the quality of the feature after the name of the feature.

If relying on gradations of qualities, such as “substantially,” provide multiple non-limiting descriptions of possible values. Avoid exactness when describing qualities of features, and instead use “may,” “can,” “generally,” “substantially,” or other terms having certain qualities. However, be careful to avoid vagueness, and consider providing ranges or examples if available.

Avoid use of absolute or self-limiting terms, such as: only, minimum (unless defined), maximum (unless defined), all, critical, important, necessary, etc. Avoid overreliance on the term “preferred,” and variants thereof.

Use SI units for measurements to allow for international examination of the application.

Consider using examples, but in doing so, be careful to ensure that the example is sufficiently broad and relatable to the embodiments of the disclosure and limitations in the claims. Indicate that the example is non-limiting and certain features or functions may have any suitable arrangement, order, magnitude, etc.

Consider providing data or examples to demonstrate unexpected results. Consider providing examples of alternative materials and/or arrangements of components to arrive at the same or different result.

Describe “embodiments” of the “disclosure;” avoid describing a particular feature or function as characterizing the “invention.” Doing so carries a strong risk of narrowing the future construction of the claims, *e.g.* to require any interpretation of the claims as necessarily requiring the feature.

Consider providing a statement at the close of the description such as: “While the disclosure is susceptible to various modifications and alternative constructions, certain illustrative embodiments are shown in the drawings and are described below in detail. It should be understood, however, there is no intention to limit the disclosure to the specific embodiments disclosed, but on the contrary, the intention is to cover all modifications, alternative constructions, combinations, and equivalents falling within the spirit and scope of the disclosure.”

## 9. Claims

The claim(s) must point out and distinctly explain the subject matter that the inventor claims as to the invention.

A nonprovisional application for a utility patent must contain at least one claim.

The claim section must begin on a separate sheet or electronic page and all claims should be numbered consecutively in Arabic numbers.

Each claim should be written as a single sentence.

Some claims may be dependent on or limited by other claims in the same application. All dependent claims should be grouped with the claims they are related to and depend from.

An application may contain three independent claims and up to twenty total claims without additional claim fees.

As claim drafting is specific to the embodiments of the disclosure and a skill unto itself, a description of suggestions to claim drafting is not provided.

#### 10. Abstract of the Disclosure

The abstract explains what is new about the disclosure. It should be in narrative form and be limited to a single paragraph.

It must begin on a separate page and should be no longer than 150 words.

#### E. Oath or Declaration

A U.S. patent application must identify the true inventors of the claimed subject matter with an oath or declaration. A patent that fails to properly identify the true inventors is invalid unless corrected (and made without deceptive intent).

Inventorship is based on the claims. Joint inventors are joint owners, and each joint inventor owns an undivided partial interest in the entire patent if the application is not assigned. The requirements for a joint invention are:

- Contribute in some significant manner to the conception or reduction to practice of the invention;
- Contribute to the claimed invention so it is not insignificant in quality, measured against the dimension of the full invention;
- Do more than merely explain to the real inventors well-known concepts or the current state of the art. *See Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 1473 (Fed. Cir. 1997).

#### 1. Declaration

The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent (other than a provisional application) must execute an oath or declaration directed to the application (MPEP 602.01), stating:

1. The application was made or authorized to be made by the person executing the declaration,

2. The individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application, and
3. An acknowledgment of penalties clause referring to fine or imprisonment of not more than five years, or both.

Use of USPTO forms is not mandatory but is strongly recommended. When modifying a USPTO form, remove all indications it is a USPTO form (*e.g.*, SB or AIA designation).<sup>24</sup>

Tip: Consider providing additional language such as the inventor having read and understood the contents of the application and acknowledges the duty of disclosure.

Each declaration need identify only the inventor executing the declaration if an ADS is submitted identifying the entire inventive entity.

Tip: To avoid payment of a surcharge, an inventor's oath or declaration, including a substitute statement, executed by or regarding each inventor must be submitted on the same day as the nonprovisional application is filed.

Continuation, Divisional and Continuation-in-part Applications filed after September 16, 2012: Continuation, divisional and continuation-in-part applications filed after September 16, 2012, and claiming the benefit of priority from applications filed before September 16, 2012, require a new declaration fulfilling the AIA requirements.

International PCT applications filed before 16 September 2012: The pre-AIA declaration forms must continue to be used. PCT applications filed on or after 16 September 2012 date will require the use of the new U.S. inventor declaration forms filed either with the PCT application under PCT Rules 4.17(iv) and 51*bis*.1(a)(iv), or when entering the U.S. national stage. The PCT rules and forms accommodate the new U.S. practice. Only national stage applications with an international filing date on or after September 16, 2012, must submit a new AIA declaration.

Late filing of declaration: An applicant may submit an inventor's oath or declaration on filing of the application or may postpone filing the oath or declaration until the USPTO issues a Notice of Allowability provided that the applicant files a signed ADS identifying the inventive entity.

- Surcharge for late filing of declaration: The USPTO imposes a surcharge (\$160 for §111 cases, \$140 for §371 cases for a large entity) for submitting an oath or declaration after the filing date. The requirement to pay the surcharge will be provided in a notice soon after filing the application. The deadline for payment of surcharge is extendable. The USPTO will require no additional fee beyond the surcharge until the application is otherwise in condition for allowance. The surcharge can be paid at the time of filing to avoid receiving the Missing Parts Notice. An Informational Notice will be sent instead.

Tip: When the declaration is not submitted with the application and a signed ADS, pay the surcharge with payment of filing the application to ensure that the

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<sup>24</sup> 37 CFR 1.4(d)(3)

surcharge for late filing of the declaration is timely paid and avoid Notice to File Missing Parts.

- Deadline for filing declaration: When the declaration is not filed at the time of filing the application and the application is otherwise in condition for allowance, the USPTO will send a Notice of Allowability giving a three-month period to submit the declaration. The three-month period is not extendable.

Options for submitting declarations: Because the USPTO no longer requires a declaration listing each inventor, individual declarations may be prepared and executed for each individual inventor. A combined declaration/assignment may be submitted which includes both the language for the declaration and assignment. If desired, the declaration may still list all inventors and be signed.

- Short-form declaration – individual inventor: An individual inventor signs a single individual declaration form that need not include other inventor information, which is a streamlining of the old practice. Each inventor must be informed, however, that by signing the declaration, the inventor confirms that *the application, including the claims, has been read and understood and that the inventor is aware of the duty to disclose to the USPTO all information known to the inventor to be material to patentability*, which is a current requirement under U.S. patent laws.
- Short-form declaration – multiple inventors: Multiple inventors sign a single individual declaration form that lists the names of the other inventors. Each inventor must be informed, however, that by signing the declaration, the inventor confirms that *the application, including the claims, has been read and understood and that the inventor is aware of the duty to disclose to the USPTO all information known to the inventor to be material to patentability*, which is a current requirement under U.S. patent laws.
- Declaration/Assignment: The form serves as both an oath or declaration and an assignment and includes (1) the information and statements for AIA declarations, and (2) a copy of the assignment to be recorded.

Late filing in § 371 National Phase application: Applicants are cautioned, however, that in a §371 National Phase application, a Request for Continued Examination (RCE) cannot be filed in the application unless the requirements of 35 U.S.C. §371(c) – including the requirement for an executed inventors' oath/declaration (or substitute statement) – have been satisfied. 35 U.S.C. 132(b) (Found in Public Law 106 – 113 – APPENDIX I 113 STAT. 1501A – 561).

Foreign language oaths and declarations: If an individual uses a language other than English for an oath or declaration, the oath or declaration must include a statement that the individual understands the content of any documents to which the oath or declaration relates. If the documents are in a language the individual cannot comprehend, the documents may be explained to him or her so he or she can understand them. The USPTO will accept a single non-English language oath or declaration where there are joint inventors, of which only some understand



English but all understand the non-English language of the oath or declaration. MPEP 602.06; 37 CFR 1.69.

## 2. Substitute Statement

Substitute Statement: Where an inventor's signature cannot be obtained on a declaration, a substitute statement may be executed regarding or for that inventor.

Circumstances for substitute statement: An applicant may execute a substitute statement in these circumstances:

- The inventor is deceased or legally incapacitated;
- The inventor refuses to sign the declaration; or
- The inventor cannot be found or reached after diligent effort.

Relationship to the inventor to whom the substitute statement applies:

- Legal representative
- Assignee
- Person to whom the inventor is under an obligation to assign
- Person who otherwise shows a sufficient proprietary interest in the matter

Legal Name of inventor to whom this substitute statement applies: Must list the name of the inventor, the residence (city, state and country for a U.S. resident; city and foreign country for a non-U.S. resident).

Proof of Facts: An applicant who is an assignee or obligated assignee need not file a petition or provide proof of the facts to be named as the applicant or execute a substitute statement. Though proof need not be submitted to the USPTO, proof of an attempt to secure the inventor's signature should be kept in the applicant's file. There is no change to what is a good-faith attempt to contact an inventor and what constitutes a refusal to sign.

Who signs: The party signing the substitute statement must be an applicant. The signer of the substitute statement may be anyone with knowledge of the facts, such as a designated individual of the assignee. Must list the person executing the substitute statement, and must list the applicant name and title of the person executing the substitute statement.

Tip: When providing substitute statement by assignee, list the title of person executing the statement and fill all appropriate fields on the statement, using PTO Form PTO/AIA/02 to assure compliance of requirements.

## IV. Power of Attorney

While the USPTO rules permit a patent practitioner to represent an applicant through prosecution without filing a Power of Attorney, it is a best practice to file a Power of Attorney in each application.

Power of Attorney: A Power of Attorney is a written document by which a principal authorizes a patent practitioner(s) to act on behalf of the applicant for a patent or patent owner.

Definition of Principal: A principal means a representative of the applicant for an application, *i.e.*, an officer or organizing member of the entity.

A few reasons for filing a Power of Attorney include:

- Formally establish legal representation.
- Authorization to file terminal disclaimers.
- Assurance that the customer number is associated with the attorney of record.
- Change entity status in Private PAIR.
- Assuming transfer of an application, including establishing a new correspondence address and access to PAIR.
- Ability to file a corrective ADS.
- Ability to file auto-granted petitions at the USPTO.
- Payment of issue fee on EFS-Web.

Applications Filed Before September 16, 2012: Applications filed before September 16, 2012, are subject to the above requirements governing a Power of Attorney.

Applications Filed After September 16, 2012: For applications filed on or after September 16, 2012, a Power of Attorney filed must be signed by the applicant for patent, or the patent owner (for reissue applications, reexamination proceedings, and supplemental examination proceedings). Where an assignee is named as the applicant in the patent application in the ADS, the assignee-applicant can give Power of Attorney.

Tip: Know types of Power of Attorney Forms at the USPTO as each has different implications and requires different information. For example, AIA/PTO/80 (request to change ownership), AIA/PTO/81 (*pro se* inventors appointing one or more inventors as having power of attorney), and AIA/PTO/82 (general power of attorney).

Assignee-Applicant: In a patent application filed on or after September 16, 2012, an assignee who is not the applicant may sign a Power of Attorney only if the assignee becomes the applicant because the applicant must sign the Power of Attorney for a patent.

Authorized Signee of Power of Attorney by Assignee-Applicant: The Power of Attorney must be signed by someone authorized to act on behalf of the assignee-applicant (*i.e.*, a person with a title that carries apparent authority, or a person who includes a statement of authorization to act). A patent practitioner may not act on behalf of an assignee simply by the authority to prosecute an application.

Request for Change in Applicant (PTO/AIA/80): When an Assignee who either is named the application or becomes an application by filing a request to change the application under 37 CFR 1.46(c), form PTO/AIA/80 is to be used and must be accompanied with a Statement of Ownership under 37 CFR 3.73(c).

- Statement of Ownership: If the Applicant is the inventor, but the assignee later wishes to take over prosecution of the application and exclude the Inventors, the Assignee signs a Power of Attorney for the individual application and a 3.73(c) statement is submitted with the Power of Attorney using form PTO/AIA/80 with a corrected ADS making the Assignee the Applicant.

The statement of ownership states “I hereby revoke all previous powers of attorney given in the application identified in the attached statement under 37 CFR 3.73(c)” and must be signed by the named assignee or where the assignee is a juristic entity, by someone authorized to act on behalf of the assignee. For the statement of ownership, form PTO/AIA/96 or an equivalent may be used according to the above requirements.

A statement of ownership (i.e., 3.73(c) statement) need not be submitted with the general Power of Attorney when the assignee is identified as the applicant in the ADS; however it is required with form AIA/PTO/80.

- Authorized to Act: Someone “authorized to act” may be an officer with a title carrying apparent authority or someone gave such authority to act.
- Multiple Applicants: If there are multiple Applicants, then all parties must give Power of Attorney to the same practitioner for the power to be effective. *See* MPEP 402.10; 37 CFR 1.32.

Pro Se Inventors: Form PTO/AIA/81 is to be used by *pro se* inventors who are the Applicant for a patent to appoint one or more of the joint inventors as having power of attorney in the application file. The appointed joint inventor(s) permits the sign all correspondence on behalf of the inventors.

Definition of Pro se: Prosecuting an application without a patent practitioner.

General Power of Attorney (AIA/PTO/82): If the Applicant designated is the assignee in an ADS at the time of filing the application, a Power of Attorney can be submitted using form AIA/PTO/82. A general Power of Attorney can be prepared for repeated use in multiple applications without the necessity of preparing a Power of Attorney for each application. A general Power of Attorney can be signed for any applicant, including inventor(s) who remain the applicant.

Transmittal with General Power of Attorney: A transmittal must identify the application to which the Power of Attorney is directed and must be signed by a designated party (e.g., inventor or patent practitioner). An inventor named as the applicant could sign both pages of the form, or the inventor could sign only Part B of the form, and the patent practitioner could complete and sign Part A of the form. Part C is optional if individual practitioners up to ten are appointed.

If the Inventor is the Applicant: The inventor signs the Power of Attorney.

If an Assignee does not desire to be the Applicant: The Inventor signs the Power of Attorney. If multiple inventors, use form AIA/PTO/81.

Combined Declaration/Power of Attorney: The USPTO advises against submitting a combined declaration/Power of Attorney, particularly because of the new rules regarding applicants.

A copy of a Power of Attorney may not be used if a new applicant is being named in a continuing application, *e.g.*, in the prior application, the Power of Attorney was given by the inventors and the continuing application is filed by a juristic entity.

A Power of Attorney given by inventors remains in effect where (1) a 37 CFR 1.48 request is made in a pending application or (2) a continuing application adds an inventor if the added inventor supplies a Power of Attorney consistent with the initial Power of Attorney and a copy of the Power of Attorney is provided in the continuing application.

## V. Assignment

U.S. law presumes that a patent application is owned by the individual inventor(s) unless another person or entity is properly identified and substantiated as the patent owner. The inventor is assumed the owner unless otherwise indicated. The assignment is a valid legal document when signed and completed, but not recorded.

If another person or entity owns the patent rights, the assignment will establish that the law will recognize the transfer of ownership of the application. Ownership impacts the designation of applicant and authority to dictate the course of prosecution of the application. Not only is an assignment a means of transferring ownership in a nonprovisional application, an assignment can assign provisional applications, and title in reissue and continuing applications.

The USPTO provides no assignment form. The assignment should be recorded at the USPTO to be effective.

The assignment should be well-executed and should:

- Be in writing.
- Clearly identify all parties: Recite names, addresses, and the relationship of the assignor(s) and the assignee.
- Identify the property: State patent or patent application number, title, inventors, and filing date.
- Recite exchange of consideration: A standard for almost any contract, and here, even nominal consideration may be sufficient.
- Notarization: Notarization is optional. Notarization serves as *prima facie* evidence the signature(s) is/are valid, but if notarization is not possible, the signatures should be attested to by two witnesses.

Technically, the USPTO is charged with recording assignments and all other documents “affecting title to applications, patents, and registrations.” (37 CFR 3.11). Rarely is a question raised about a document being recordable.

How an Assignment is recorded: USPTO Recordation Cover Sheet

- The name of the party conveying the interest.
- The name and address of the party receiving the interest.
- A description of the interest conveyed or transaction to be recorded.
- Identification of the interests.

Filing an Assignment containing inventor’s Oath or Declaration: An assignment that contains the information and statements in an Oath or Declaration (“assignment-statement”) may be the inventor’s Oath or Declaration. The assignment must be recorded, and the best way to effect recordation is through the Electronic Patent Application System (EPAS).

- File the application via EFS-Web and obtain an application number.
- Submit the assignment-statement for recording in EPAS on the same day the application is filed to avoid a surcharge for delayed submission of the inventor’s oath or declaration. Check the box in EPAS to notify the USPTO that the assignment statement is used as the inventor’s oath or declaration. The USPTO will then place a copy of the assignment-statement into the application file.<sup>25</sup>

Assignment records are available for public inspection at the USPTO only for patents and published applications.

Recordal: Assignments must be recorded to be effective as against third parties who do not know the assignment. According to 35 USC §261, Para. 4: If an assignment is not recorded within three months after signing, the assignee stands at risk of having its rights subordinated to a subsequent bona fide purchaser or lender acting without notice of the assignment.

Tip: It is recommended to file an assignment promptly after receiving it to avoid missing the three months.

Change of Corporate Name: Not a change of corporate entity, so there is not a change of ownership. However, recordation is recommended for reflecting proper chain of ownership. Recordation document may be a certificate obtained from secretary of state for state of incorporation. A copy of the certificate is recorded; the original document, and signatures, are not required.

Merger, Corporate Conversion, etc.: A merger is a change of corporate entity -- one company merging into another with only the latter surviving -- so there is a change of ownership. A Certificate of Merger is obtained from the Secretary of State for either state of incorporation. Original certificate and signatures are not required. A merger often includes a change of name for

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<sup>25</sup> AIA Inventor's Oath or Declaration Quick Reference Guide, United States Patent and Trademark Office, [http://www.uspto.gov/aia\\_implementation/inventors-oath-or-declaration-quick-reference-guide.pdf](http://www.uspto.gov/aia_implementation/inventors-oath-or-declaration-quick-reference-guide.pdf).

a surviving corporation, requiring a second recordation of the certificate. Recordation is recommended for maintaining proper chain of record title.

Provisional, continuation, divisional and continuation-in-part applications: It is not always necessary to assign for ownership, but recommended for notice (to third parties, potential infringers, etc.) and for reflecting record chain of ownership and standing. If the applications are identical, there is technically no requirement to record an assignment against the new application. However, often, because of *e.g.* funding, sale of company, etc., it will be far easier (and less expensive) to record than to explain why it is unnecessary. Recording also ensures that anyone looking for ownership information will more easily find it.

Tip: Refile assignment from parent application in continuing applications to assure a clear chain of title for the application family.

New matter: If the applications are at all different, a new assignment should be executed and recorded against the application. With a CIP, assignment of the parent conveys ownership of “inventions and improvements” so the assignee of the parent may own rights in the CIP; however, the USPTO will not accept an assignment of the parent for recordation against the CIP (claiming that new matter creates new property).

Unavailable inventor: The USPTO will proceed with an assignment recordal for an unavailable inventor if the entity pursuing the assignment has rights, including an employee agreement, or an earlier assignment (such as in a provisional application from which the benefit of priority is claimed, or other documentary evidence establishing those rights).

Deceased inventor: The USPTO will insist upon a statement from an executor of an estate or legally determined heir.

Tip: Evidence of ownership (*e.g.*, an assignment, employment agreement, etc.) should be recorded at the USPTO by the date the issue fee is paid. Where the applicant is an assignee or obligated assignee and the real party in interest at the time of allowance has changed, the USPTO should be notified of the change so that the patent can issue to the real party in interest. Any changes in the ownership status of a patent should similarly be updated and recorded at the USPTO to avoid confusion.

## VI. Information Disclosure Statement

It is recommended to file an information disclosure statement (IDS) early to ensure that it will be considered by the Examiner and to avoid incurring additional costs.

At the time of filing: According to 37 CFR 1.97(b) an applicant may file an IDS within three months of the U.S. filing date, or before a first Office Action on the merits was mailed or after filing a Request for Continued Examination (RCE). If an IDS is filed during this stage of the prosecution, there is no need to file a 37 CFR 1.97(e) statement or a government fee in addition.

Tip: It is best to file the IDS at the time of filing the application to avoid unnecessary costs and to ensure that the Examiner has the art before making a first Office Action.

## VII. Advancement of Examination

Perhaps whether one is about to submit a patent application — or perhaps a final Office Action has been issued, no matter where an application is at in the patent process, there are options for speeding up patent prosecution with the USPTO.

### A. Track One Prioritized Examination

Track One is the USPTO's prioritized patent examination program. It aims to give applicants a final disposition within twelve months from the date the Track One request is granted. A limited number of applications can enter the program per year.

Prioritized Examination under Track One must be requested at the time of filing a utility or plant application, and all fees must be paid at the time of filing the utility application with the Request for Prioritized Examination form. Examination support documents are not required, as in accelerated examination program (see below). A maximum of four independent claims are permitted and up to 30 claims total with no multiple dependent claims. Track One can also be filed with RCE, or before receiving a first Office Action responsive to the request for continued examination.

Termination: Track One is terminated if an extension of time is filed or if any amendments are filed that increase the claims beyond their allotment. Track One is also terminated upon reaching a final Office Action.

Tip: Make certain to comply with all requirements at the time of filing the application to ensure compliance with the Track One and to avoid losing Track-One status.

### B. Petition to Make Special without a Fee

Petitions to Make Special without a fee apply to only a few patent applicants under these conditions:

- The applicant's age (older than 65) or health, or
- The invention will materially:
  - Enhance the quality of the environment
  - Contribute to developing or conserving energy resources
  - Contribute to countering terrorism

### C. Accelerated Examination

Accelerated examination is, essentially, a subset of the petition to make special. The program aims to give for final disposition within 12 months.

To enter the program, a petition to Make Special must be filed, a fee must be paid, the application must be filed with three or fewer independent claims, and only 20 claims with no multiple dependent claims, and be directed to a single invention. The applicant must agree to an interview with the examiner, and the applicant must conduct a pre-examination search and provide a statement that the search was conducted. The applicant must provide an accelerated examination support document explaining how each claim is patentable over the identified prior art.

Tip: It is preferable to request prioritized examination with a Track One request rather than proceed with a petition to make special for accelerated examination due to the cost and time involved in preparing the documents, and to avoid possible undesirable prosecution history estoppel.

#### D. Patent Prosecution Highway (PPH)

A PPH request can be made if there is a counterpart foreign or PCT application, and another patent office that participates in the PPH program has found at least one claim of the counterpart application to be allowable. There is no fee.

The PPH program does not aim to reach a final disposition more quickly than a standard prosecution, rather it prioritizes the application to the first Office Action.

#### Requirements:

- A PPH request in an application that has not yet received an Office Action;
- Demonstrate that the application for which participation is sought has the same earliest priority date or filing date of the counterpart application in the office of earlier examination (OEE);
- Identify and provide copy of OEE work product (if not a PCT application or Extended European Search Report, a copy of office correspondence immediately prior to “Decision to Grant a Patent”) and translation if necessary; or request USPTO to obtain OEE work product from Dossier Access System or PATENTSCOPE.
- Provide an IDS listing the references cited in the work product, if any.
- Demonstrate that the pending claims, as originally filed or as amended, sufficiently correspond to the claims by a submission of a claims correspondence table;
- Submit PPH request only by EFS-WEB.

#### E. First Office Action Interview Program

The First Action Interview Pilot Program (“FAIPP”) allows applicants to interview an Examiner before a first Office Action. After enrolling in the FAIPP, the Examiner provides a pre-interview communication which provides the Examiner’s prior-art search results. The applicant may then request an interview to discuss the search results and to resolve issues before a first Office Action. The FAIPP allows an applicant to expedite prosecution without incurring additional costs.



To qualify, participation must be requested at least one day before receiving a first Office Action in PAIR. The application may contain no more than three independent claims and no more than 20 total claims, and no multiple dependencies. Restriction requirements may not be traversed.

### Conclusion

This guide summarizes what is generally entailed when filing a new U.S. application. This document, while not comprehensive, contains commonly required elements needed to assemble and file an application before the USPTO.

## U.S. PROVISIONAL APPLICATION FILING CHECKLIST

Docket No. \_\_\_\_\_

Filed on: \_\_\_\_\_

Application Filed Complete: Yes ☐ No ☐

Missing Item: \_\_\_\_\_

- ☐ Application Data Sheet (verified by: \_\_\_\_\_)
  - ☐ Verification of Inventor Names
  - ☐ Verification of Applicant
  - ☐ Verification of Assignee
  - ☐ Entity Status \_\_\_\_\_
- ☐ Application
  - ☐ Specification
  - ☐ Drawings (Drawing Pages: \_\_\_\_\_; Figures \_\_\_\_\_)
- ☐ Basic filing fee paid
- ☐ Power of Attorney
- ☐ Assignment (verified by: \_\_\_\_\_)
- ☐ Post Filing Verification
  - ☐ Filing Receipt (verified by: \_\_\_\_\_)
  - ☐ Assignment Recordal (verified by: \_\_\_\_\_)
  - ☐ Power of Attorney
- ☐ Docket Expiration Date

## U.S. NONPROVISIONAL APPLICATION FILING CHECKLIST

Docket No. \_\_\_\_\_

Filed on: \_\_\_\_\_

Application Filed Complete: Yes ☐ No ☐

Missing Item: \_\_\_\_\_

- ☐ Application Data Sheet (verified by: \_\_\_\_\_)
  - ☐ Verification of Inventor Names
  - ☐ Verification of Applicant
  - ☐ Verification of Assignee
  - ☐ Verification of Priority Applications
  - ☐ Entity Status \_\_\_\_\_
- ☐ Application
  - ☐ Specification
  - ☐ Claims (Independent \_\_\_\_\_; Dependent \_\_\_\_\_)
  - ☐ Abstract (Under 150 Words)
  - ☐ Drawings (Drawing Pages: \_\_\_\_\_; Figures \_\_\_\_\_)
- ☐ Basic filing fee paid
- ☐ Declaration: ☐ AIA ☐ Pre-AIA
- ☐ Power of Attorney
- ☐ Assignment (verified by: \_\_\_\_\_)
- ☐ Information Disclosure Statement (verified by: \_\_\_\_\_)
  - ☐ Follow-up Information Disclosure Statement (Reason: \_\_\_\_\_)
- ☐ Prioritized Examination (type: \_\_\_\_\_)
  - ☐ Fee
- ☐ Post Filing Verification
  - ☐ Filing Receipt (verified by: \_\_\_\_\_)
  - ☐ Assignment Recordal (verified by: \_\_\_\_\_)
  - ☐ Power of Attorney

- ☐ For 371 Applications
  - ☐ 371 Transmittal Form & Preliminary Amendment
  - ☐ Verify that certified copies were received at the IB
- ☐ For Paris Convention Applications
  - ☐ DAS Code?
  - ☐ Request and submit certified copy of priority documents (if not retrievable electronically)