

Comments With Regard to Filing Paperwork

1. General

- A. Note: You really want to get the filing paperwork right because Partners may judge you by your paperwork. If your paperwork includes errors, they might conclude that you do not pay attention to details, are not focused, or are not a good patent attorney.

The required documents were:

1. ADS
2. Fee transmittal
3. Declaration
4. Power of Attorney
5. IDS

Yikes!

- 6/8 people omitted relevant references from their IDS

– Potential Malpractice

- Check plus = 0, Check = 1, Check Minus = 7

- POA issues (but maybe I should have more clearly explained)

- B. Remember - You know the filing date, the title, inventor, and attorney docket number.
- C. Be careful with regard to who signs a document
ADS, Fee Transmittal = attorney (not firm or inventor)
Declaration, Power of Attorney = inventor
Corporate POA = corporate officer +3.73(c) signed by attorney
Micro Entity – need Micro Entity Form (no one went micro-entity)
- D. Signature must be “/name/” - can’t start with “s/name/”

2. ADS

- A. Remember – small entity – check it
- B. Use Customer Number
- C. Read form carefully. It dynamically changes

3. Fee Transmittal
 - A. VERY IMPORTANT - Always give the PTO permission to charge the deposit account – not just for this filing, but for any needed fee. If you do not, and the PTO decides it needs an additional fee, then it won't ask for it – it will just abandon your application –Yikes! BE SURE TO CHECK THE BOX
 - B. Small entity – remember half off on the fee
(Additional \$75 reduction if filing electronically)
 - C. Remember to enter the total fee at the top of the page
 - D. Micro entity – need micro entity form
 - E. If filing on paper, remember paper filing surcharge. If small entity filing electronic, remember discount

4. Declaration
 - A. Mostly Correct
 - B. If filing ADS, use Declaration for ADS

5. Power of Attorney
 - A. Remember that there are several forms – one is signed by the inventor. The other is signed by a corporate officer (this gives power of attorney to the practitioner generally) and then the practitioner submits a copy of the POA with a 3.73(c) statement specifically identifying the application. The PTO does not give POA for a specific application without the 3.73(c) statement. Also, you can't execute the 3.73(c) statement without a signed assignment from the inventor.
 - B. I am not sure I made clear the difference between the POA for an issued patent vs. a patent application
-Review Class 7 notes, page 58

6. IDS

A. An IDS is absolutely necessary to comply with your duty of disclosure. Any material omission can seriously impact the enforceability of your patent and it a real issue.

B. Must include URL for web links in Invention Disclosure.

- Monkeylectric (+video)

- Google

- Walmart

These are actually probably closer references than the cited patent apps

C. Only need IDS fee after first Office Action