

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 | (Messed up by 4 people) |
| 2. Fee transmittal | (Messed up by 5 people) |
| 3. Declaration | (Messed up by 1 person) |
| 4. Power of Attorney | (Messed up by 5 people) |
| 5. IDS | (Messed up by 4 people) |

Yikes!

-4/8 people omitted relevant references from their IDS

– Potential Malpractice

- Check plus = 1, Check = 2, Check Minus = 6

- 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
- D. Signature must be “/name/”

2. ADS (Messed up by 4 people)

- A. Remember – small entity – check it
- B. No Applicant info
- B. Use Customer Number
- C. Read form carefully. It dynamically changes

3. Fee Transmittal (Messed up by 5 people)
 - 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 – total \$785 (Additional \$75 reduction if filing electronically)
 - C. Remember to enter the total fee at the top of the page
 - D. Remember claim fees and page fees if needed
 - E. If filing on paper, remember paper filing surcharge – and get rid of \$75 reduction. If small entity filing electronic, remember discount

4. Declaration (Messed up by 1 person)
 - A. Mostly Correct
 - B. If filing ADS, use correct Declaration for ADS

5. Power of Attorney (Messed up by 5 people)
 - A. Remember that there are several forms – only two of them can work with the inventor as the Applicant. The more general power of attorney 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. Review Class 7 notes, page 58

6. IDS (Messed up by 4 people – likely malpractice)
 - 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 the Invention Disclosure.
 - Streetlight
 - Google auction
 - These are actually probably closer references than the cited patent apps.
 - As long as you included the Streetlight reference, I let it slide, but in practice you would want to disclose every link in the Invention Disclosure as a liability limitation.
 - C. Only need IDS fee after first Office Action