

# 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 (Wrong/Not PTO acceptable = 9)  
- Blew the client's foreign rights by requesting Non-publication - 3
2. Fee transmittal (Wrong/Not PTO acceptable = 6)
3. Declaration (Wrong/Not PTO acceptable = 6)
4. Power of Attorney (Wrong/Not PTO acceptable = 7)
5. IDS (Wrong/Not PTO acceptable = 8)

Yikes! Mostly Correct – 2228 Better IDSs – 97411, 2211

- 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  
+ Assignment to company signed by inventor
- D. Signature must be “/name/”  
- 6 people had improper/Non-PTO Acceptable signatures  
- Specific reminder and appearance in last year's comments

2. ADS (Wrong/Not PTO acceptable = 9)
  - A. Remember – small entity – check it
  - B. No Applicant info
  - C. Use Customer Number
  - D. Read form carefully. It dynamically changes
  - E. Non-Publication Requests require you to forego foreign filing – absolutely confirm with the client first
  - F. Micro-Entity is a sub-category of Small Entity.
  
3. Fee Transmittal (Wrong/Not PTO acceptable = 6)
  - 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
  
4. Declaration (Wrong/Not PTO acceptable = 6)
  - A. Needs to be signed correctly – by inventor
  - B. If filing ADS, use correct Declaration for ADS  
-5 people were using the wrong Declaration
  
5. Power of Attorney (Wrong/Not PTO acceptable = 7)
  - 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 (Wrong/Not PTO acceptable = 8)
- 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. Possible Inequitable Conduct and/or Malpractice.
  - B. Must include URL for web links in the Invention Disclosure.
    - 6/8 people omitted relevant references from their IDS
    - Disclose all websites, including electrocore website, gammacore website, EliteHRV website, Oura
    - These are actually probably closer references than the cited patent apps.
    - 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
  - D. Do NOT specify specific sections of the references – what if you are wrong or miss something?