

Comments With Regard to Filing Paperwork

1. General

- A. Note: You really want to get the filing paperwork right because Partners and Clients 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:

Document	✓ +	✓	✓ -
ADS	3	1	1
Fee Transmittal	0	5	0
Declaration	4	0	1
Power of Attorney	1	2	2
IDS	3	1	1

- 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/” – different from Illinois courts
Unsigned documents are not accepted by the PTO

2. ADS – Overall good!
 - A. Remember – small entity – check it
 - B. No Applicant info
 - C. Use Customer Number
 - D. Read form carefully. It dynamically changes
 - E. This is a non-provisional application – not provisional
 - F. Be sure to enter correspondence and representative info

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**
 - If you check ALL of the boxes (Check, Credit Card, Money Order, Deposit Account) then you are telling the USPTO you are paying using ALL of those options – which is not correct.
 - If you only check Deposit Account and check “Except for filing fee”, then you will get a Notice of Missing Parts.
 - B. Small entity – remember 60% off on the fee – total \$728 or \$664 (Additional \$64 reduction if filing electronically – and by your e-signature you are filing electronically, but PTO will accept higher payment.)
 - C. Remember to enter the total fee at the top of the page
 - D. Remember claim fees and page fees if needed (pages include spec + figs)
 - 1 student remembered to pay extra page size fees
 - 1 student forgot to pay extra claim fees, but they gave Deposit Account access
 - E. If you want to be a Micro Entity, you must submit the additional Micro Entity Certification Document (assuming it applies). If you don't know whether it applies, don't submit it. All documents submitted to the USPTO are under penalty of perjury!

- 1 student submitted the Micro Entity Cert. Always confirm that the client qualifies before submitting.
 - F. “Multiple dependent claims” – You don’t have any. These are dependent claims that reference multiple earlier claims and are disfavored by the USPTO. “The system of claims 1 or 2 further including ...”
 - G. Only 2 out of 5 students submitted the correct fee
 - If you file a Micro Entity cert – remember to adjust the fee
 - If you have 4 independent claims – remember excess claim fees
 - No IDS fee if filed within 3 months of filing the app
4. Declaration
- A. Needs to be signed correctly – by inventor
 - B. If filing ADS, use correct Declaration for ADS
5. Power of Attorney
- A. Remember that there are three POA forms – only two of them can work with the inventor as the signatory.
 - What if the POA is faulty? The PTO will still accept the application, and will use correspondence address, but you will not have pre-publication access to the USPTO’s information about the application, Examiners will not talk with you, and you will not be able to take actions like make a Terminal Disclaimer – until you become the official Attorney of Record
 - Only 1 student submitted a working POA
 - Two students used the wrong form
 - Two students filled it out wrong
 - B. To use the Assignee power of attorney, first there has to be an assignment from the inventor to the Assignee. Then the Assignment to the Assignee is listed on a 3.73(c) form. Only then can a POA signed by the Assignee be effective.
 - C. The POA must be signed by either the inventor or the Assignee – not you.

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. Possible Inequitable Conduct and/or Malpractice.
- B. Must include URL for web links in the Invention Disclosure.
 - 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.
 - Best practice to also disclose the articles for safety
- 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?
- E. Typically list inventor names, not Assignee
- F. Signed by you – not the inventor