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	0	2
Fee Transmittal	2	2	1
Declaration	3	0	2
Power of Attorney	2	1	2
IDS	2	0	3

   B. Remember - You know the filing date, the title, inventor, and attorney docket number.

   C. Be careful with regard to <u>who</u> 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/ Assignee info

   C. Use Customer Number/address

   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

      - When customer number is selected, a drop-down appears

      - If you click US Patent Practitioner, you will have to manually enter your contact info

   G. No Assignment has been filed, so there is no Assignee information

   H. Do not improperly claim that the application claims priority pre-AIA.

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 $800 or $730 (Additional $70 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)

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!

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. Remember to get the e-signature right – if you miss one of the"/", then the USPTO will not accept it

4. Declaration

A. Needs to be signed correctly – by inventor

B. If filing ADS, use correct Declaration for ADS

C. Declaration is being submitted with the application – so needs to be dated at the date of filing or before – 3 people were after filing

D. Need to have the correct title of the invention

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

- Three students submitted a POA that would have been accepted – one omitted the correspondence address, one unsigned, one wrong form.

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.

D. Don't try to hedge your bets and file both – one of them would be inaccurate and potential perjury.

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. Remember that Web Pages are also prior art references!
Always analyze links and all materials provided by the Inventor for potential inclusion in an IDS.
- Many times these are actually probably closer references than the cited patent apps/publications.
- 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

7. Not needed or confusing documents

A. Do not submit both ADS and Utility Patent Application Transmittal (3)

B. Certificate of Transmission is not needed for e-filing (3)

C. IDS size fee form is only needed for more than 50 PA references(1)