Avoid the most common mistakes made by practitioners: Suggestions and Tips

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Avoid Mistakes Throughout Prosecution

- Tips and Suggestions
  - Preparing the Application
  - Filing the Application
  - Avoiding Publication Pitfalls
  - Examination Processing Tips
  - Post Allowance Tips
  - Best Practice Tips (see Appendix)
Preparing the Application

- Avoid submitting an application in the European problem/solution format.
  - Format the application according to US rules and procedures. See MPEP § 608

- Avoid including multiple dependent claims that depend from other multiple dependent claims
  - Craft claims according to US practice, see MPEP § 608.01(n)

- Avoid including “Use” claims
  - Craft claims according to US practice, see MPEP § 608.01(k)
**Pre-Examination Tips**

**Forms**

- Do use USPTO forms without altering the language.
- Do not use a combined declaration and power of attorney form.
- USPTO forms can be found at: http://www.uspto.gov/web/forms/index.html
Application Data Sheets

- Do use an Application Data Sheet (ADS), although an ADS is not required. Customers using an ADS can expect two advantages when applying for a patent:

1. Improved accuracy of filing receipts.
2. Accurately recorded application data.
Use of a supplemental ADS is possible even though no original ADS was submitted on filing.

The following information can be supplied on an ADS:

- Application Information
- Applicant Information
- Correspondence Information
- Representative Information
- Domestic Priority Information
- Foreign Priority Information
- Assignment Information
Pre-examination Tips

Preliminary Amendments In New Applications

- Avoid submitting Preliminary Amendments on filing
- A substitute specification will be required if a preliminary amendment present on filing makes changes to the specification, except for:
  - Changes to title, abstract, claims or addition of benefit claim information to the specification

Pre-Examination Tips

Preliminary Amendments in Continuations and Divisionals

- Avoid submitting Preliminary Amendments on filing a Continuation or Divisional

- Avoid Preliminary Amendments that cancel all the claims and add new ones
Filing the Application

Select a method of filing the application

1. Accelerated Examination
2. EFS-Web
3. Traditional Mail Route
Filing the Application

- **Accelerated Examination Common Failings**
  - Failure to provide the text search logic. A mere listing of terms will not suffice.
  - Failure to search the claimed invention. The petition for accelerated examination may be dismissed if the search is not commensurate in scope with the claims.
  - Failure to show support in the specification and/or drawings for each limitation of each claim.
Accelerated Examination Common Failings (Cont)

- Failure to show support in the specification and/or drawings for each limitation of each claim for every document whose benefit is claimed.
- Failure to specifically identify the limitations in each claim that are disclosed in each reference.
Filing the Application

EFS-Web Filing

- Avoid coding (identifying) a Request for Continued Examination (RCE) as an “Amendment” when filing an RCE
- Avoid identifying papers after the initial filing as “new”
- Avoid common PCT filing mistakes
- Avoid filing color images or images that have a resolution higher than 300x300 dots per inch (dpi)
Avoid inconspicuous requests for nonpublication.

Publication will generally include all preliminary amendments submitted in time to be included in the publication.

If amendments to the specification are desired to be included in publication, submit a substitute specification.
Avoid Publication Pitfalls

Publication Corrections

- Practitioners must include the assignment information in the transmittal letter or ADS.
- Avoid misspelling the names of inventors or assignees.
- Review the filing receipt promptly so that corrections can be requested before publication or export of data for publication.
- Avoid filing requests for Corrected Publication 37 CFR § 1.221(b) that fail to recite material errors.
Examination Processing Tips

General Prosecution Advice

- Amendments to the claims and/or specification should be accompanied by a written statement indicating specific support for the change. If the support is implicit, an explanation is beneficial.

- In response to restriction requirements, where inventions are indeed patentably indistinct, applicants should present arguments to that end.

- Read the entire prior art reference cited by the examiner, not just the part relied upon by the examiner in the rejection.
Examination Processing Tips

Pre-Appeal Brief Conference

- Avoid sending the request separate from the Notice of Appeal.
- Avoid making a request when there is an outstanding after-final amendment.
- Avoid attaching more than five pages to the cover form.
- Avoid sending in a supplemental request.
- Avoid paying a second Notice of Appeal fee in the application.
Filing of Continuation-in-Part (CIP) Applications

- Consider prosecuting an improved CIP invention independently of the prior invention:
  - File, if need be, a continuation only to the original invention, or take an appeal on the original invention, and
  - File a new application, rather than a CIP, for only the new invention:
    - without a benefit claim (35 U.S.C. §120, 37 CFR § 1.78) to the initial application, and
    - therefore without shortening the patent term of the initial invention if it were to be included in the CIP application, as
    - any benefit claim in a CIP cannot protect the new invention.
Avoid filing an Information Disclosure Statement (IDS) after payment of the issue fee.

- File an IDS filed after payment of the issue fee with a Petition for Withdrawal from Issue (37 CFR 1.313(c)) and an RCE (37 CFR § 1.114). Otherwise, the IDS will be placed in the file and the cited documents will not be considered by the examiner.

Avoid delays in paying the issue fee.

- The issue fee payment may be submitted via facsimile to the Office of Patent Publications ((571) 273-2885) or EFS-Web to ensure the payment is received within the non-extendable time period set forth in the Notice of Allowance and Fee(s) Due (PTOL-85).
Post Allowance Tips

Withdrawal from Issue

- Petitions to Withdraw from Issue may be hand carried or sent via facsimile to the Office of Petitions.
  - Hand carries should be brought to the security guard station of the Madison West building, 600 Dulany Street, Alexandria VA 22314.
  - The facsimile number for the Office of Petitions is (571) 273-0025.

Note: All other types of petitions must be directed to the Central FAX ((571) 273-8300).
Patent Term Adjustment under 35 USC § 154

- Extensions due to examination delay under 37 CFR § 1.701 are very limited and apply only to original applications, other than designs, filed on or after June 8, 1995 and before May 29, 2000.

- Extensions due to examination delay under 37 CFR §§ 1.702-1.705 are less limited and apply to original applications filed on or after May 29, 2000.

- Applicants are advised to check public/private PAIR for patent term adjustment determinations.
Thank You.
A practitioner creates a document and S-signature signs it on his/her PC. The practitioner can then:
- Facsimile transmit the document directly from the PC to the Office; or
- Print the document and then facsimile transmit, mail, or hand-carry the document to the Office.

An affidavit under 37 CFR § 1.132 is S-signed by the party making the affidavit, the S-signed affidavit is then:
- Electronically sent to the practitioner, e.g., via an e-mail. The practitioner can then facsimile transmit, mail or hand-carry the S-signature signed document to the Office.
Best Practices

- Power of Attorney Tips:
  - Do direct a Power of Attorney to the Attorneys Associated with the Customer Number to the Customer Number
  - Do provide a separate Power of Attorney and a separate Oath/Declaration
Priority Document Exchange Tips

- Do provide a valid power of attorney with a submission for permission to access
- Only the designated attorney or agent may grant permission to access.
Best Practices

Fee Payment Tips

- Avoid placing a stop payment on a check for USPTO services or to circumvent the rules of practice. This action is not appropriate.
  - Request a refund (37 CFR § 1.26) where fees were paid by mistake or in excess of the amount required.

- Avoid drafting a check to the USPTO for services on an account with insufficient funds.
  - Ensure that the account from which the check is drawn contains sufficient funds prior to submitting the check to the USPTO.
Fee Payment Tips

- Do use a Deposit Account Number on a transmittal form authorizing payment
  - Do not use a Customer Number to authorize payment of fees.
- Be clear with payment authorization statements.
  - Avoid contradictory statements on payment
Best Practices

Maintenance Fees/Deposit Accounts

- Maintenance fees and replenishing of deposit accounts at the USPTO can be done online: https://ramps.uspto.gov/eram
- Inquiries related to deposit accounts, maintenance fees and refunds may be directed to the Office of Finance (571) 272-6500.
Best Practices

Prosecution Tips

- Proofread claims for clarity and precision
- Present all cogent arguments and evidence before final rejection
- If the examiner is believed to be ignoring a claim limitation, a personal or telephonic interview may facilitate the prosecution to completion.
Prosecution Tips (cont’d)

- Don’t initiate a response on the absolute last day of the statutory period, if possible.

- Don’t personally attack the Examiner in a response to Office Action.

- Follow the chain of command for assistance:
  - First, call the Examiner.
  - If he or she is non-responsive or unavailable, contact the Supervisor.
  - If the issue is still not resolved, contact the Technology Center Director.
Further Information
USPTO Useful Web Links - http://www.uspto.gov

Helpful Web Pages:


- Forms Page – current USPTO forms available for use by the Public: http://www.uspto.gov/web/forms/index.html

Further Information

USPTO Useful Web Links (cont’d)

- Mailing Addresses and Mail Stops:
  http://www.uspto.gov/web/offices/com/sol/og/patboxs.htm

- Facsimile Numbers:

- USPTO Glossary: