

# Filing a Patent Application: Procedures and Tips



Kevin Little

Director, Office of Patent Application Processing  
United States Patent and Trademark Office



# What We Will Discuss

- ❖ Overview of the Office of Patent Application Processing (OPAP)
- ❖ Avoiding common filing errors
  - Drawings
  - Nucleotide and/or amino acid sequences
- ❖ Miscellaneous filing tips



# Overview of OPAP

- ❖ Prior to OPAP there were two separate units known as the Office of Initial Patent Examination (OIPE) and PCT Operations (PCT Ops).
- ❖ Now there are two divisions of OPAP:
  - Initial Processing Division
    - Mail and Fee Processing Branch
    - Classification and Security Review Branch
    - Formalities Review Processing Branch
  - PCT Operations Division
    - International Application Processing Branch
    - Designated Office/Elected Office – 371 Cases



# Avoiding Common Errors: Drawings

- ❖ Drawings are required "where necessary for the understanding of the subject matter sought to be patented." 37 CFR 1.81(a).
- ❖ Each view of the drawings must be separately described in the Brief Description of the Drawings. 37 CFR 1.74.
- ❖ OPAP reviews the application to determine whether all of the drawings mentioned in the specification are present, and sends a notice if any drawings are missing. MPEP 608.01(f).



# Avoiding Common Errors: Drawings

## ❖ Examples of errors:

- The actual figures are labelled 1A, 1B, and 1C, but the brief description only describes Figure 1 generally.
- The brief description only describes Figure 1 generally, but another portion of the specification discusses Figures 1A, 1B, and 1C.
- The brief description describes Figure 1A, 1B, and 1C, but the only drawing sheet is labelled "Figure 1."



# Avoiding Common Errors: Drawings

In response to an OPAP "Notice to File Corrected Papers" or "Notice of Omitted Items" regarding drawings, the applicant must provide:

- a marked up copy of the specification showing any changes;
- a clean copy of the specification incorporating any changes;
- a statement of no new matter; and
- any necessary substitute drawings.



# Avoiding Common Errors: Sequences

Patent applications disclosing nucleotide and/or amino acid sequences as defined in 37 CFR 1.821(a) (sequence applications) **must contain both:**

- a sequence listing (SL) **as part of the application** in ASCII text format, in PDF format, or on paper (37 CFR 1.821(c)), and
- a copy of the SL in **computer readable form (CRF)** in ASCII text format, if the SL provided as part of the application is in PDF format or on paper (37 CFR 1.821(e)).



# Avoiding Common Errors: Sequences

- Significant processing delays may result when:
  - items are missing upon filing
    - no SL at all
    - no ASCII text file even though a PDF or paper copy of the SL has been provided
    - no statement of identity where more than one SL is of record
  - the applicant responds to a Notification of Missing Parts but fails to include missing sequence requirements
- **RECOMMENDATION:** Comply with sequence requirements as early as possible!





# Avoiding Common Errors: Sequences

RECOMMENDATION: File sequence applications via EFS-Web!

- A single ASCII text copy of the SL, submitted on the filing date, will serve as both the "paper" copy under 37 CFR 1.821(c) and the CRF required by 37 CFR 1.821(e).
- The ASCII text copy is excluded from the application size fee calculation.
- The specification must include incorporation by reference of the ASCII text copy of the SL.
- No statement of identity is required.
- No transfer request is required.

The Legal Framework for EFS-Web is available at [http://www.uspto.gov/patents/process/file/efs/guidance/New\\_legal\\_framework.jsp](http://www.uspto.gov/patents/process/file/efs/guidance/New_legal_framework.jsp).



# Avoiding Common Errors: Sequences

37 C.F.R. §1.821(e) provides for "transfer" of a **compliant** CRF from a previous application **already on file in the Office** to a new application, when

- the previous application and the relevant CRF to be transferred are completely identified in the transfer request, and
- there is a statement that the CRF of the previous application is identical to the **SL contained** in the **new** application. (Note that the application file of the **new** application **must** itself contain a SL.)



# Avoiding Common Errors: Sequences

**RECOMMENDATION:** Submit an ASCII text copy of the SL rather than a transfer request!

- A copy of the SL in ASCII text format can be easily retrieved from:
  - Applicant's records
  - Private or Public PAIR via Supplemental Content Tab
  - PATENTSCOPE (WIPO Web Site) when provided in an international application
- Transfer request disadvantages:
  - A PDF or paper copy of the SL is required for the new application, and will be included in the calculation of the application size fee.
  - Complete identification of the previous application and of the relevant CRF to be transferred is required.
  - Failure to comply with all transfer requirements introduces delay.



# Avoiding Common Errors: Sequences

Common problems seen in transfer requests:

- Transfer of CRF requested into a new application that does not include a SL, either in PDF or paper.

Response to a defective transfer request notice must include a **new** transfer request, a PDF or paper SL, and an amendment entering the SL into the application.

- CRF to be transferred is not adequately identified (application number, filing date, and submission date of CRF required).
- No compliant CRF on file in the previous application.
- No statement that CRF to be transferred is identical to PDF or paper SL in the new application.



# Avoiding Common Errors: Sequences

- A transfer request is NOT recommended.
- If a transfer request is necessary, form PTO/SB/93 is preferred over an applicant-drafted request.
  - contains necessary statements
  - easy to understand & complete
  - reduces errors
- Access the form at <http://www.uspto.gov/forms/index.jsp#startforms>

Doc Code: CRF.TRNS.REQ

Document Description: Request for Transfer of a Computer Readable Form

PTO/SB/93 (03-10)

Approved for use through 02/28/2013. OMB 0651-0024

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR TRANSFER OF A COMPUTER READABLE FORM UNDER 37 CFR 1.821(e)			
Application No.:		First Named Inventor:	
Filing Date:		Attorney Docket No.:	
Title of the Invention:			
The sequence information in the paper copy or PDF file of the Sequence Listing filed: <input type="checkbox"/> herewith; <input type="checkbox"/> as part of the originally-filed specification of this application; <input type="checkbox"/> as a separate amendment filed on _____; for the above identified application, is identical to the sequence information in the <input type="checkbox"/> only <input type="checkbox"/> last filed <input type="checkbox"/> other (specify second, third, fourth, etc.) _____ computer readable form, which was filed on _____, in application number _____ filed _____.			
This computer readable form was compliant with 37 CFR 1.821-1.825, and applicant hereby requests that it be used as the computer readable form for the present application, in accordance with 37 CFR 1.821(e).			
The above referenced paper copy or PDF file of the Sequence Listing contains no new matter.			
A sequence listing text file submitted via EFS-Web that complies with the requirements of 37 CFR 1.824(a) (2)-(6) and (b) (i.e., is a compliant sequence listing ASCII text file), serves as both the paper copy required by 37 CFR 1.821(c) and the CRF required by 37 CFR 1.821(e). If a user submits a compliant sequence listing ASCII text file via EFS-Web, the U.S. Patent and Trademark Office will not carry out a request to use a compliant computer readable "Sequence Listing" that is already on file for another application pursuant to 37 CFR 1.821(e) but will use the sequence listing submitted with the application as originally filed via EFS-Web.			
It is understood that upon the transfer of a copy of the computer readable form to this application, the U.S. Patent and Trademark Office will update the copy of the computer readable form to reflect the application number and filing date for this application.			
Signature		Date	
Name (Print/Typed)		Registration Number	

This collection of information is required by 35 U.S.C. 22 and 37 CFR 1.821-1.825. The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.



# Filing Tips: Oath/Declaration

- ❖ The America Invents Act (AIA) changed the rules for the inventor's oath or declaration. These changes apply to applications filed on/after 9/16/2012.
- ❖ The term “inventor's oath or declaration” is a catchall phrase that refers to:
  - ❖ A declaration signed by the inventor; An oath sworn or attested to by the inventor; An assignment signed by the inventor that contains the statements required to be made in the oath/declaration; or A substitute statement signed by the applicant on behalf of an inventor.



# Filing Tips: Oath/Declaration

- ❖ A signed Application Data Sheet (ADS) will set inventorship if filed before/with the inventor's oath or declaration. The inventor's oath or declaration will set inventorship if filed before an ADS.
- ❖ If an ADS is used to set inventorship, filing of the inventor's oath or declaration can be delayed until payment of the issue fee.
- ❖ If the inventor's oath or declaration for all named inventors is not present on filing of the application, the surcharge in 37 CFR 1.16(f) is due.



# Filing Tips: Submitting an ADS

- ❖ The Office recommends submitting an ADS on filing.
- ❖ Sign the ADS! If an ADS is not signed it is treated as a transmittal letter only, and will not set inventorship or establish benefit or priority claims. (37 CFR 1.76(e)).
- ❖ Any ADS received after the filing date of an application is providing new or corrected information relative to the file record – even if no ADS was previously submitted in the application – and must include underlining for additions and strikethroughs or brackets for deletions. Changes should be shown relative to the information of record, which is found on the most recent filing receipt.





# Filing Tips: Submitting an ADS

Common problems with the ADS:

- ❖ inventor residence and mailing address information not provided
- ❖ domestic benefit or foreign priority data missing, incorrect, or improperly formatted
- ❖ domestic benefit or foreign priority claims not timely (must be submitted within the later of 4 months from the actual filing date of the later-filed application or 16 months from the filing date of the prior-filed application (except in design applications))



# Filing Tips: Submitting an ADS

Common problems with the ADS – Inventor/applicant issues:

- ❖ An assignee intended to be the applicant is not included on the ADS submitted on filing, so the inventor is listed as both inventor and applicant on the filing receipt.
- ❖ If an assignee is identified as the applicant after the initial ADS is filed, a request to change the applicant is required.
- ❖ A request to change the applicant (essentially a signed transmittal letter) must comply with 37 CFR 1.46(c) and includes a corrected ADS with markings identifying the new applicant, and a statement under 37 CFR 3.73(c).



# Filing Tips: Submitting an ADS

Common problems with the ADS – Changing applicant issues:

- ❖ To submit a corrected ADS to change the applicant from the inventors to the assignee, the inventors must be listed as applicant on the ADS in the order provided, and then deleted using strikethrough or brackets.
- ❖ The assignee-applicant can then be added using underlining.
- ❖ Failure to use markings to show deletion of the current applicant in the Applicant Information section may result in a notice indicating that the change has not been accepted.



# Filing Tips: Submitting an ADS

Common problems with the ADS – Benefit/priority issues:

- ❖ The current application and its relationship to its parent is omitted from the ADS; no domestic benefit is captured even if the information is in the first sentence(s) of the specification.
- ❖ The relationship (CON, CIP, DIV) between two nonprovisional applications is omitted.
- ❖ Benefit/priority claims are incorrectly listed from the oldest application to the newest, rather than beginning with the application being filed.



# Filing Tips: Reference Filing under PLT

- ❖ Under the Patent Law Treaty (PLT), a nonprovisional application may be filed "by reference" to a previously-filed application.
- ❖ Reference filing is not the same as claiming domestic benefit or foreign priority.
- ❖ Reference filing statements cannot be deleted or rescinded.
- ❖ **RECOMMENDATION:** Reference filing should only be used when a copy of the specification and drawings of the previously filed application are not available.



# Filing Tips: Micro Entity Status

- Micro entity certification must be filed in an application with or before fees may be paid in the micro entity amount.
- Certification must be properly identified by
  - application number OR
  - first named inventor and title of application.
- First named inventor must be the same on all certifications in an application.

<b>CERTIFICATION OF MICRO ENTITY STATUS (GROSS INCOME BASIS)</b>	
Application Number or Control Number (if applicable):	Patent Number (if applicable):
First Named Inventor:	Title of Invention:



# Filing Tips: Rule 1.48 Request to Correct Inventorship

- ❖ OPAP is responsible for processing any 37 CFR 1.48 request filed on or after September 16, 2012.
- ❖ The Office recommends using document description "Request under Rule 48 correcting inventorship."
  - This ensures that OPAP is notified of the Rule 1.48 request and that processing will occur within 10 business days.
  - The use of other document descriptions will result in delays.



# Filing Tips: Rule 1.48 Request to Correct Inventorship

- ❖ The processing fee under 37 CFR 1.17(i)(1) (currently \$140 for undiscounted, \$70 for small entity, \$35 for micro entity) is required for requests filed in **nonprovisional** applications.
- ❖ A signed corrected ADS with markings showing the changes is required.
- ❖ If a corrected ADS with markings is **NOT** provided, the request will be denied.





# Filing Tips: Rule 1.48 Request to Correct Inventorship

- ❖ An additional fee is required in **nonprovisional** applications if the request is filed after a First Action on the Merits is given/mailed, unless the request is accompanied by a signed statement that the change is due solely to the cancellation of claims.
- ❖ The fee under 37 CFR 1.17(d) is currently \$600 for undiscounted (\$300 for small entity, \$150 for micro entity).
- ❖ Rule 1.48 requests submitted in the "Remarks" of an amendment are not received by OPAP.



# Filing Tips: Rule 1.48 Request to Correct Inventorship

- ❖ A processing fee under 37 CFR 1.17(q) (currently \$50 for all applicant types) is required for requests filed in **provisional** applications.
- ❖ A signed request that identifies each inventor by his or her legal name is required.
- ❖ A corrected ADS with markings is not required but is strongly recommended.



# Filing Tips: Rule 1.48 Request to Correct Inventorship

- ❖ If the request is denied, a notice will be mailed identifying the reason.
- ❖ If the Rule 1.48 request is granted, only a Corrected Filing Receipt will be issued.
- ❖ In the future, our automated systems will be modified to issue a decision granting the request.



# Filing Tips: Powers of Attorney

- Where a valid power of attorney is filed with the application, OPAP no longer prints a separate Acceptance of Power of Attorney notice.
- The filing receipt indicates that a power of attorney is accepted.
- Later-filed POAs will have an acceptance notice or denial notice mailed.



# Filing Tips: Powers of Attorney

- The power of attorney section on the filing receipt will indicate:
  - the patent practitioners associated with the designated customer number
  - a listing of up to 10 names and registration numbers of patent practitioners



# Filing Tips: Powers of Attorney

- Only the applicant can give power of attorney in an application filed on/after 9/16/2012.
- If the applicant is the joint inventors, more than one assignee/obligated assignee, or a combination of the two, POAs by all named applicants must be filed together in order to be accepted.
- POA by an assignee who is not the applicant will not be accepted.



# Filing Tips: Powers of Attorney

- A party who is not the applicant must first become the applicant in order to give POA. A request under 37 CFR 1.46(c) is required.
- If the applicant is a juristic entity, ensure that POA contains the name of the juristic entity, as well as the name of the signer. If the signer does not make a statement that he/she is authorized to act on behalf of the applicant, the signer must have a title that carries apparent authority.



# Filing Tips: Filing Receipts

- Check the data carefully when you receive a filing receipt.
- OPAP will correct any typographical errors made by the Office at no charge.





# Filing Tips: EFS-Web Submissions

- ❖ The Office recommends using correct document descriptions for submissions in EFS-Web.
- ❖ Using correct document descriptions will ensure that OPAP is notified of the incoming request.
- ❖ Combining requests on one document can lead to delays.



# Filing Tips: EFS-Web Submissions

## Correct EFS-Web Document Descriptions for Frequently Mislabeled Documents

<b>Correct Description</b>	<b>Documents</b>
Applicant Response to Pre-Exam Formalities Notice	Responses to <ul style="list-style-type: none"><li>•Missing parts</li><li>•Notice of Incomplete Application</li><li>•Sequence Compliance Notice</li><li>•Omitted Items</li><li>•Corrected Application Papers Notice</li></ul>
Request under Rule 48	Any inventorship corrections
Power of Attorney	Any POA submissions



# Filing Tips: EFS-Web Submissions

- Do not submit fee payments with an ADS without a preceding document such as "Applicant Response to Pre-Exam Formalities Notice."
- Otherwise, OPAP may not know that the document was submitted.



# Contact Information

- Contact the Sequence Systems Service Center (S3C) Help Desk for questions regarding sequence compliance or requests for transfer of a CRF.

(571) 272-2510

[STIC-SSSCHelpdesk@uspto.gov](mailto:STIC-SSSCHelpdesk@uspto.gov)

- Call the Application Assistance Unit for other questions related to patent application filing issues.

571-272-4000

571-272-4200

888-786-0101



# Questions?

## Thank You!