

Biotechnology, Chemical & Pharmaceutical Customer Partnership

Patent Practice Tips

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Avoid Mistakes Throughout Prosecution

§ Tips and Suggestions

- Filing the Application
- Avoiding Publication Pitfalls
- Examination Processing Tips
- Post Allowance Tips
- Best Practice Tips
- Signatures
- Withdrawing from representation



Pre-Examination Tips

Forms

- Although use of PTO prepared forms is not required, it is advisable to use and not to alter the language.
- If a form is altered for use by a practitioner, the statement regarding approval and the OMB number must be removed.
- Do not use a combined declaration/power of attorney form, use separate declaration and separate power of attorney forms.
- 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. The need for corrected filing receipts related to USPTO errors will be significantly reduced.
2. Accurately recorded application data. This will also reduce application prosecution delays and will improve the accuracy of bibliographic data in patent application publications.

Changes to a benefit claim, inventor name, etc. are simpler to perform if an ADS is used.



Application Data Sheets (Cont'd)

- 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



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
 - See the notice "*Revised Procedure for Preliminary Amendments Presented on Filing of a Patent Application*," 1300 Off. Gaz. Pat. Office 69 (November 8, 2005), available at:

<http://www.uspto.gov/web/offices/com/sol/og/2005/week45/patrevs.htm>



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 less than 300x300 dots per inch (dpi)



Nonpublication Requests

- When filing a utility or plant application, conspicuously **request non publication** if
 - the invention **has not been** and **will not be** the subject of an application ***filed*** in another country (or under multilateral international agreement) that requires eighteen-month publication
 - consider using PTO form PTO/SB/35
 - a non publication request after filing is not permitted.
 - 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 the publication, submit a substitute specification.



Publication Corrections

- Corrected Publication 1.221(b) - timeliness and materiality – applicants often file requests that are late and fail to recite material errors.
- Practitioners must include the assignment information in the transmittal letter or ADS or else the publication will not contain such information.
- Review the filing receipt promptly so that corrections can be requested before publication or export of data for publication.



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.



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.
- 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.



Examination Processing Tips

Pre-Appeal Brief Conference

- Avoid sending the request separate from the Notice of Appeal. Request must accompany 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.
- If prosecution is reopened and another final rejection is made, there is no need for a second Notice of Appeal fee if the application is again appealed.
- Avoid submitting an after-final or proposed amendments with the request or on the same day as the request.



Examination Processing Tips

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.



Issue Fee Payments

- 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).



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).



- Priority Document Exchange Tips

- Have the authorization to permit access signed by an authorized party in accordance with 37 CFR 1.14(c).
- Only the designated attorney or agent in the provisional may grant permission to access the provisional application.



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.
- 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.



2 Types of Permitted Signatures

37 CFR § 1.4(d)

- Handwritten (personally signed) signatures are provided for in § 1.4(d)(1).
- S-signatures are provided for in § 1.4(d)(2):

An S-Signature is a permitted type of signature between forward slash marks that is not handwritten (§ 1.4(d)(1)).

Note: Samples of acceptable signatures are posted on the Office's web site:

www.uspto.gov/web/offices/pac/dapp/opla/preognotice/sigexamples_alt_text.pdf



S-Signatures – 5 Requirements

37 CFR § 1.4(d)(2)

- The S-signature must consist only of letters (including Kanji, etc.), or Arabic numbers, or both, and appropriate spaces, commas, periods, apostrophes, or hyphens for punctuation.
- The person signing must insert his or her own signature between the forward slash marks, § 1.4(d)(2)(i).
 - **Only the signer can insert his or her own signature:**
 - a secretary, paralegal, etc., is not permitted to sign/insert another person's signature, e.g., a practitioner's or inventor's signature, and
 - a practitioner is not permitted to sign/insert an inventor's signature or another practitioner's signature.



S-Signature – 5 Requirements (cont.)

37 CFR § 1.4(d)(2)

- The name of the person signing must be printed or typed immediately adjacent (*i.e.*, below, above, or beside) to the S-signature, and be reasonably specific, so the identity of the signer can be readily recognized.

The name of the person signing may be inserted by someone other than the person signing, but the person signing must personally insert the S-Signature.

A secretary, paralegal, etc., may type the name of the person signing at any time (*e.g.*, before or after the person signing inserts his or her own signature).

- A registered practitioner may S-sign but his or her registration number is required, either as part of the S-signature, or immediately below or adjacent to the signature.

For example: ***/John Attorney Reg. #99999/
John Attorney***



Examples Where S-Signatures Can Be Used

- S-Signatures may be used for correspondence being filed in the Office for patent applications, patents and reexamination proceedings.
- 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;
 - File the document via EFS-Web; or
 - Print the document and then facsimile transmit, mail, or hand-carry the document to the Office
- An affidavit under § 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, in addition to filing via EFS-Web.
- S-Signatures may not be used for papers submitted to the Office of Enrollment & Discipline § 1.4(e).



Name Requirement for S-Signatures

- There is no requirement that the signer's actual, full or legal name be used.
 - It is strongly suggested that the full name be used for both;
 - The typed or printed name below the signature must be reasonably specific enough so that the identity of the signer can be readily recognized (§ 1.4(d)(2)(iii)(B)).
- Titles may be included as part of the signature.
- Changes in S-signature (different papers or different applications) are not recommended. § 1.4(h)
 - Example: An s-signature that includes the attorney docket number for that application would not be a consistent signature.



Questionable Signatures

- Ratification, confirmation or evidence of authenticity of a signature may be required where the Office has:
 - Reasonable doubt as to its authenticity,
 - Where the signature and typed or printed name do not clearly identify the person signing.
- The failure to follow the S-signature format and content requirements will usually be treated as a bona fide attempt, but will cause the paper to be treated as unsigned with differing results, *e.g.* :
 - Amendments would receive a new 1-month time period
 - § 1.63 declarations would receive a two month time period and a surcharge may be imposed.



Certification Requirements

37 CFR § 1.4(d)(4)

Certification Requirement

- A. For another's signature:** A person submitting a document signed by another under § 1.4(d)(2):
- is obligated to have a reasonable basis to believe that the person whose signature is present on the document actually inserted that signature, and
 - should retain evidence of authenticity of the signature.
- B. For your own signature:** The person inserting a signature under § 1.4(d)(2) in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature.

Violations of the signature certifications may result in the imposition of sanctions under §§ 10.18(c) and (d).



Power of Attorney

37 CFR §1.32(b)

37 CFR § 1.32(b) sets forth power of attorney requirements:

- Must be in writing,
- Name one or more representatives in compliance with § 1.32(c),
- Give the representative power to act on behalf of the principal, and
- Be signed by the applicant for patent (§ 1.41(b)) or the assignee of the entire interest of the applicant.



Power of Attorney

37 CFR §1.32(b)

A power of attorney must name as representative either:

- one or more joint inventors;
- up to ten registered patent attorneys or registered patent agents; **or**
- those registered patent practitioners associated with a Customer Number.



Power of Attorney; 37 CFR 1.32(c)

If a power of attorney names more than ten patent practitioners

- Power of attorney must be accompanied by a separate paper indicating which patent practitioners named in the power of attorney, up to 10, are to be recognized by the Office as being of record in application or patent to which the power of attorney is directed.
- If no separate paper, **no** power of attorney will be entered.
- The separate paper can be signed by one of the attorneys or agents of record, by a patent attorney or agent acting in a representative capacity, the assignee, acting pursuant to 37 CFR § 3.73(b), or by all of the applicants.
- The separate paper cannot request that a Customer Number be used instead, only the applicant or assignee can give power of attorney to a Customer Number.
- Effective Date: June 25, 2004



Acting in a Representative Capacity § 1.34

A registered patent attorney or patent agent not of record but acting in a representative capacity must specify his/her:

- Registration number
- Name
- Signature



Acting in a Representative Capacity § 1.34

A person acting in a representative capacity may not sign:

- A power of attorney (37 CFR 1.32(b)(4));
- A document granting access to an application unless
 - an executed declaration has not been filed, and
 - the practitioner was named in the papers accompanying the application papers (37 CFR 1.14(c));
- A change in correspondence address except where an executed oath/declaration has not been filed and the practitioner filed the application (37 CFR 1.33(a)(1));
- A terminal disclaimer (37 CFR 1.321(b)(1)(iv)); or
- A request for an express abandonment without filing a continuing application (37 CFR 1.138(b)).



Request to Withdraw from Representation in a Patent Application

Change in Procedure for Requests to Withdraw from Representation In a Patent Application 1329 OG 99, effective May 12, 2008.

- Office no longer requires at least 30 days between approval of the withdrawal and the later of the expiration date of a time period which can be obtained by a petition and fee for extension of time for reply for a practitioner to withdraw.
- Office will not grant a request to withdraw in a patent.
- Office will not approve request to withdraw from practitioners who acted in a representative capacity (§ 1.34).



Request to Withdraw from Representation in a Patent Application

Office now requires the practitioner(s) to certify that he, she or they have:

1. Given reasonable notice to the client, prior to the expiration of the response period, that practitioner(s) intend to withdraw from employment;
2. Delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and
3. Notified the client of any responses that may be due and the time frame within which the client must respond.



Request to Withdraw from Representation in a Patent Application

- The Office will no longer accept address changes to a new practitioner, absent a new power of attorney when processing a request to withdraw.
- Correspondence address will be changed to assignee of the entire interest who has properly become of record pursuant to 37 CFR 3.71 or the first named inventor.

Note: **PTO/SB/83** (“Request for Withdrawal as Attorney or Agent and Change of Correspondence Address”)



Initiatives and Programs

- Patents Teleworking and Laptop Programs
- Virtual Art Unit Pilot
- Alternative Examination Products
- Worksharing
- Peer Pilot Review
- Accelerated Examination
- First Action Interview Pilot
- Electronic Filing



Patents Teleworking & Laptop Programs



Over 1,250 examiners participating in the Patents Hoteling Program, since initiated in 2006

- Program allows examiners to work from home 4 days per week with USPTO electronic tools

Over 2300 laptops distributed through Patent Examiner Laptop Program (PELP)

Both Hoteling and Laptop programs show production gains in line with increase in total examination time, as well as improved morale and job satisfaction



USPTO Pilot to evaluate the feasibility of establishing “virtual art units”

- Conducted April 2007 - September 2007
- 13 Examiners and 1 SPE at home
 - received full PHP equipment
- 37 examiners remained on USPTO campus
 - received collaboration tools and training
- Random reviews by Office of Patent Quality Assurance
- Surveys administered to all examiners in the art unit; evaluating application of data



Alternative Examination Products

Patent Public Advisory Committee (PPAC) outreach project

- Conducting focus sessions and interviews to obtain insight and feedback
- Patentee / Trade Organization / User Input
 - Wants and Needs for IP Protection
 - Different Levels of Examination / Protection



- Number of initiatives underway to promote examination efficiencies in participating IP offices
- Patent Prosecution Highway (PPH)
 - Full implementation
Jan. 4, 2008 – JPO,
Jan. 29, 2009 - KIPO
 - Pilot – UK IPO, CIPO,
IPAU, EPO, DKPTO,
IPOS and DPMA



Peer Review Pilot

- 1 year pilot (began June 15, 2007) for members of the public to submit prior art with commentary, using Internet peer review techniques, in volunteered published applications to a public website (www.peertopatent.org)
 - 75 applications volunteered
 - TC 2100 technology only
 - 10 pieces of prior art max per application (avg. was 4)
- Pilot extended 1 year to include Business Methods – Class 705
 - Encourage more participation
 - Technology heavy with Non-patent literature



Accelerated Examination

- Change in practice effective August 25, 2006
- Opportunity for final determination in 12 months
- Participation requires:
 - Applicants provide greater information up front – pre-examination search and accelerated examination support document;
 - file application using electronic filing system;
 - agree to interviews
 - Limited number of claims



Accelerated Examination Current Statistics

- As of Feb. '09:
 - 690 applications allowed
 - On average, 197 days to complete prosecution
 - Minimum number of days to complete prosecution: 18
- 193 patents have issued (8/19/08)
- Participants' response & comments positive
 - Not only faster, but high quality



First Action Interview Pilot

- Applicant requests to participate, as of July 5, 2008, 279 applicants have joined the pilot
- Application is NOT taken out of turn
- “Preliminary office action” is prepared and mailed to applicant – condensed version of typical first action on the merits
- After interview applicant receives copy of action or allowance with entry of proposed amendment
- Piloted in two workgroups of TC 2100



Electronic filing

New EFS-Web system launched
March 2006

- § allows PDF-based submissions
- § replaced XML-based system



2005 result: 2.2% of applications filed electronically

2006 result: 14.3% of applications filed electronically

2007 result: nearly 50% of applications filed received through EFS-Web; over 1,000,000 (total) follow-on papers and new applications received

2008 result: 72.1% of applications filed electronically

2009 result: 81% of applications filed electronically, so far




Electronic filing

- Safe, Simple, Secure
- Many corporations, law firms, and independent inventors moving to 100% electronic filing for new applications and follow-on papers.



Recent Notices and Pre-OG Notices are posted at:
<http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>


United States Patent and Trademark Office
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TITLE*	OG CITE	OG DATE	FR CITE	FR DATE
<p>* active hyperlinks in this column retrieve USPTO documents posted prior to publication in the OG or Fed. Reg.</p>				
<p>Special Mail Stops for Patent Mail (posted 10Mar2005)</p> <p><i>[The changes to this notice pertain to the elimination of filing an expedited Design application by hand-delivery to the Design Group Director's Office, move of Licensing and Review on April 1, 2005; the elimination of Box or Mail Stop 4 in 37 CFR 150.6 and its replacement with Mail Stop Congressional Relations, and the move of the Office of Finance to Suite 807.]</i></p>		5APR2005		



Further Information

USPTO Useful Web Links - <http://www.uspto.gov>

Helpful Web Pages:

- Notices, Recent Patent-Related – a very current list of all Federal Register, Official Gazette and pre-Official Gazette notices, and certain Office memoranda:
<http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>
- Forms Page – current USPTO forms available for use by the Public: <http://www.uspto.gov/web/forms/index.html>
- Manual of Patent Examining Procedure (MPEP):
<http://www.uspto.gov/web/offices/pac/mpep/mpep.htm>



USPTO Useful Web Links (cont'd)

- Mailing Addresses and Mail Stops:
<http://www.uspto.gov/web/offices/com/sol/og/patboxes.htm>
- Facsimile Numbers:
<http://www.uspto.gov/web/offices/com/sol/og/2005/week42/patcorr.htm>
- USPTO Glossary:
<http://www.uspto.gov/main/glossary/index.html>

