



# **PRACTICE TIPS FOR PATENT PROSECUTION BEFORE THE USPTO**

**HERSHKOVITZ IP GROUP**

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# NEW APPLICATIONS

- Try to obtain written instructions (Order Letter) from client (the following information applies generally for non-provisional applications)
- Order Letter should have:
  - Title of application
  - Inventor(s) information
  - Assignee information, if any
  - Priority information, if any
  - Copy of the application
  - Small or Large entity Status
  - Any bar dates
  - References, if any, for filing an Information Disclosure Statement (IDS)
  - Any special instructions, such as filing Preliminary Amendments

# NEW APPLICATIONS

- Title of application
  - Should be descriptive of the invention
  - Preferably based on the claims of the invention
  - Can be amended later to be based on claims that are elected, if there was a restriction requirement during prosecution
  - Should be the same as the title of the priority application (can be amended via a Preliminary Amendment)
  - Can be amended later if a different title is desired
  - Should be seven words or less
    - Good Examiners will require seven words or less (some do not bother with this requirement)

# NEW APPLICATIONS

- Examiner has discretion to change title before issuance
- Inventor(s) information
  - Is needed to prepare a Declaration or Assignment for Inventors to sign
  - Full name
  - Post office address (address that is recognized by Postal Office to deliver mail to)
  - Citizenship

# NEW APPLICATIONS

- Information above is useful to generate Declaration that will set forth Inventors believing that they are the first to invent, etc., as required by USPTO
- Note that USPTO considers Applicant as the inventors at all times for all application, including International Applications (PCTs) whereas for PCT applications and applications for other countries, an applicant can be a corporation or an entity other than the inventors
- Assignee information:
  - Correct spelling is important
  - Full address
  - Assignment will set forth Inventors' names (Assignors) and their addresses, assigning their rights to the patent application to the Assignee
  - Assignment is filed after the application is filed which must contain the Application Serial Number (can be entered after Inventors signed the Assignment with proper language authorizing such)



# NEW APPLICATIONS

- **Priority information, if any:**
  - **Is this U.S. application claiming priority to another earlier filed application?**
  - **For example, U.S. application can claim benefit from an earlier filed application such as one in Korea, under 35 USC 1.119, if Korean application was filed not more than one year earlier**
    - **Check the dates to ensure the 1 year requirement is met**
    - **If so, must file Claim of Priority at time of filing**
    - **If so, must add language on page 1 of application (description section) claiming priority**
    - **Language should state that the disclosure of the earlier filed application is incorporated herein in its entirety**
    - **Can have more than one priority applications that were filed within the 1 year period**

# NEW APPLICATIONS

- Can claim benefit from an earlier filed International Application (Under Patent Cooperation Treaty (PCT)), under 35 USC 371
  - Commonly called “371 application” or U.S. National Stage application
  - International application act as if this it is the earlier filed U.S. application, thus no language is need to be inserted on page 1 of the description regarding the International application, as is the case of applications claiming priority under 35 USC 1.119
  - Usually, the International application will also have benefit from an earlier filed application, such as a Korean patent application
  - Determine the date of the earliest filed application
  - Calculate the date that is 30 months from the earliest filed application
    - This 30 months date is the deadline to file the U.S. National stage application

# NEW APPLICATIONS

- Copy of the application
  - Important initial items to check:
    - Count all of the pages to make sure information is not missing
    - Check continuity between each pages to ensure information is not missing
    - Check how many figures are listed under the Brief Descriptions of the Drawings
      - Check that the number of figures on the drawings are correct accordingly
    - Check that Abstract is included
      - Abstract should be one paragraph
      - Abstract should be no longer than 150 words
      - Abstract should not have legalese
      - Legalese such as “invention,” “disclose,” “comprising,” etc.
      - Can amend the abstract in a Preliminary Amendment to correct the above errors
    - Check that claims are included and there are no major deficiencies



# NEW APPLICATIONS

- Do the claims have any multiple dependencies?
  - If claims have multiple dependencies, should inform client that they will be rewritten or amended so that there are no multiple dependencies because USPTO charges significant higher fees for multiple dependent claims, than compared to other countries
- Drawings:
  - Check that the number of figures matches those listed in the Brief Description of the Specification of the application
  - Check that the drawings are clear and clean
  - Check that each figure is properly identified, i.e., “Figure 1”
  - “Figure 1” should be labeled under the figure, not on top, etc.
  - Check that the figures do not go over the margins on the paper

# NEW APPLICATIONS

- Margins on the paper should be at least 1 inch on all sides
- Figures can be in landscape or portrait view
- Sheets of drawings should be identified, i.e., 1/5 meaning first sheet of five sheets of drawings
- Sheet identification should be on top center of figure or top right and not within the 1 inch margin
- The figure, the sheet identification, and the Figure label (i.e., “Figure 1”) should all be in the same view (all in portrait view or all in landscape view)
- On top margin of each sheet, should have application identification
  - If a new application, should have the attorney’s docket number

# NEW APPLICATIONS

- If after the application is filed, and the drawings need to be amended, the top of the drawing sheet can be identified by listing the U.S. Serial Number (application number)
- The amended sheet must be labeled at the top within the 1 inch margin as “Replacement Sheet” when the drawings are amended after filing the application
- If this is not done, USPTO will deem it as an improper amendment and not entered
- If application is a U.S. National Stage application, check to ensure that it is a literal translation of the International application (if International application is other than in English) or exactly the same (if International application is in English)
  - Ask the client if you are not sure or can not check this yourself
  - One easy comparison is of the claims: clearly different if there are different number of claims in the International application and the copy that client is asking you to file as the U.S. National Stage application

# NEW APPLICATIONS

- **Small or Large entity Status**
  - Small Entity Status (SES) is for inventors that have not assigned their application to an Assignee, i.e., another company or legal entity
  - Small Entity Status is for an Assignee that has less than 500 employees or is a non-profit organization
  - SES assertion can be made at time of filing the application and later on, in which the fees will be usually ½ as compared to those for large entities
  - Best to assert SES as early as possible in order to reduce all fees

# NEW APPLICATIONS

- If SES changes from small to large during prosecution of the application, or after the application matures to an issued patent (during period of time of paying the maintenance fees), must inform USPTO and start paying fees based on large entity status

# NEW APPLICATIONS

- Any bar dates
  - Cannot file an application more than one year of publication/disclosure (35 USC 102(b))
  - Cannot file an application more than one year from another non-International application
  - Cannot file an application more than one year of offer to sale of the invention
  - Cannot file a U.S. National Stage application based on an International application that is more than 30 months from the earliest filed priority application (look at priority data on front page of International Application)



# NEW APPLICATIONS

- References, if any for filing an Information Disclosure Statement (IDS)
  - Can file an IDS at the same time as filing the application
  - Must cite all relevant publication known by Applicant with respect to the claimed invention
  - For example, if references were cited by an Examiner in another Patent Office in an earlier filed foreign counterpart application, must bring those references to the attention of the Examiner
  - No limit in the number of references filed in an IDS
  - Note that if the references are not in English, the Examiner will cross it out on the submitted form although Applicant has fulfill its duty of disclosure
  - Note that any IDS's filed at the same time as filing the application, within three months after filing the application, or before the Examiner sends out an Office action, does not require a fee
    - Thus, if time is needed, can file an IDS after the application is filed

# NEW APPLICATIONS

- Any special instructions from the client?
  - File no later than a certain date?
  - File only upon receipt of the executed Declaration from client but no later than the bar date?
  - Do not make any changes to the application, no matter how small, without client's written authorization?
  - May make minor changes without written authorization?
  - Watch for high costs, i.e., don't delete one multiple dependent claim while adding 20 claims in its place?
  - Authorization by client to file Formal Preliminary Amendments to correct minor error, or file Substantive Preliminary Amendments to correct substantive errors (best to get client's review of Substantive PA before filing it though)

# NEW APPLICATIONS

- USPTO claims fee:
  - 20 total claims without surcharge
    - Extra claims surcharge is \$26 for each claim for small entity or \$52 for large entity
  - 3 total independent claims without fee charge
    - Extra independent claim surcharge is \$110 for each for small entity or \$220 for large entity
  - Note that both fees apply
    - For example, if you have 21 claims in which of those claims, 4 are independent, you will have to pay an extra \$26 and an extra \$110 (for small entity)
  - Significant higher fee for each multiple dependent claim so best to avoid these
- Other application fee:
  - Surcharge for application having more than 100 pages

# NEW APPLICATIONS

- Send “Filing Fax” same day of receiving order letter to client to acknowledge receipt of order letter and instructions
- Filing Fax would 1) confirm information provided by client, 2) can also request additional information/clarification, and 3) provide documents for Applicant to execute such as Declaration and Assignment

# NEW APPLICATIONS

- Important information set forth in Filing Fax (most of the information is based on the earlier review of client's Order letter and the copy of the application that client provided, if one has been provided already:
  - Confirm the Order Letter and the date of the Order letter
  - Confirm the absolute deadline for filing the application and the client's desired deadline for filing if earlier than the absolute deadline date
  - Confirm the Inventors' information. Remind client that proper inventors are named based on what is claimed
  - Provide a filled-in Declaration form for inventors to execute and return for filing
    - Declaration can be filed unexecuted (not signed by the inventors) at time of filing. Executed can be filed after filing but there will be a surcharge (\$65 for small entity, \$130 for large entity, given two months to pay and file executed Declaration, extensible up to four additional months with additional extension fees)
    - File application unexecuted if necessary to beat any bar dates
  - Confirm that Applicant is small or large entity. If client does not provide this information, let client know that application will be filed as a large entity
  - Confirm priority claim and bar dates
  - Confirm that the copy of application is a literal translation of the International application if the present application is a 371 application

# NEW APPLICATIONS

- Confirm instructions regarding filing Preliminary Amendment
- Confirm/Acknowledge Assignee name
  - Provide a filled-in Assignment form having Inventors' names and addresses, title of application and Assignee's name and address
  - Make sure that Assignee's name and Inventors' names are correctly spelled
  - Assignment can only be filed after the application has filed in order to enter the application serial number on the assignment, which is required
    - Note that if application is filed electronically via USPTO Electronic Filing System (EFS), a serial number is simultaneously generated. But if filing by paper, USPTO will spend weeks acknowledging filing and providing a serial number



# NEW APPLICATIONS

- Indicate to client that they are responsible for filing other foreign applications, if applicable
  - If US application is first filed application, then have 1 year to file foreign application (for utility applications, else 6 months for design applications)
  - Note that foreign filing can only be after USTO has reviewed the application and allowed such. This is usually indicated in the application's Official Filing Receipt, which is received sometime after filing. USPTO usually checks that the application does not relate to secret information or information that affects the U.S. national security, i.e., an invention of a nuclear missile that can be launched from Antarctica to arrive at Washington, D.C.
- If correcting or modifying application by adding claim of priority language or placing the claims in a better format (i.e., a Formal Preliminary Amendment to remove multiple dependency from the claims), provide such to client or inform client that one will be provided in due time for its review
- Confirm if client wants you to review the application and make substantive amendments after filing, i.e., a “Substantive Preliminary Amendment”

# NEW APPLICATIONS

- Remind Applicant its duty of disclosure or confirm filing of IDS
- Confirm any deficiencies
  - Ask client to provide better drawings if necessary
  - If Brief Description of drawings is missing from application, ask client to correct
  - Other deficiencies
- Let client knows that application will be published by USPTO 18 months after filing or earliest effective filing. Applicant can request earlier publication for a fee, but unless client requests, you will not do so
- Let client know that you are not responsible for filing other foreign applications, unless specifically asked to
- Confirm the client's desired date of filing the application
- Confirm that the application will be filed upon receipt of executed Declaration (in order to avoid surcharge) or 1 day before bar date, which ever is earlier

# NEW APPLICATIONS

- When filing new applications, a transmittal having is included in the application indicating all of the above relevant information
- However, for International applications, the following must be checked of on the transmittal form, or indicated on the form, in addition to what is applicable for non-international applications as described above
  - Indicate if this is the first (usually this is the case), second, or subsequent submission under 35 USC 371
  - Indicate that this submission is an express request to begin national examination procedures
    - Note that for regular applications (non-international applications), applicant does not have to explicitly request examination, etc. For those cases, simply paying the fees will render it a request for both search and examination. That is different for other countries, where you have to request each phase of the examination process.
  - Indicate that the US has been elected under Article 31 (of the PCT) based on the International application
  - Best to attach a copy of the International application if it is available, or published. If not, indicate that it has been communicated by the International Bureau, or that it is not required as the application was filed in the US as a Receiving Office (which ever is applicable)
  - An English translation is attached if the International application was in a language other than English

# NEW APPLICATIONS

- Indicate if amendments to the claims of the IA application has been made, if applicable
- Should provide forms received from the PCT application: forms 304 and 308 relating to the PCT application
- Should provide from the IA application, copies of the International search report (PCT form PCT/ISA/210) and copies of any written opinions (PCT form 220)
- Should file IDS to cite all references cited in the PCT 210 and 220

# NEW APPLICATIONS

- Fees (below are for Large Entity; Small Entity will be ½ of these):
  - Basic National Fee is \$300
  - Search Fee
    - \$0 if US performed/rendered for the international application, both the search and written opinion
    - \$100 if the US performed for the international application, only the search
    - \$430 if another Patent Office performed the search and the results is given to the USPTO
    - \$540 for all other situations
  - Examination Fee
    - \$0 if US performed/rendered for the international application, both the search and written opinion
    - \$220 if US did not performed/rendered the written opinion

# NEW APPLICATIONS

- Excess claims fees are the same as for regular applications
- Note that as with regular applications, all of these fees must be paid at the same time, and upon filing the application in order to obtain a filing date
- Common abbreviations for that you see for 371 applications in relation to international PCT applications:
  - ISA = International Search Authority (Office that performed the prior art search for the international application)
  - IPEA = international Preliminary Examining Authority (Office that rendered the “written opinion on whether the international patent claims meets novelty, inventiveness, industrial applicability, etc. Usually ISA is the same office as IPEA but not necessarily)
  - IB = International Bureau, also known as WIPO = World Intellectual Property Office (headquarters of International application offices located in Geneva, Switzerland)
  - RO = Receiving Office (Office that receives the international application, can be WIPO/IB or one of the few designated patent offices (US, JP, EPO, etc.). At least one inventor must be a resident or national of the country of the receiving office
  - DO = Designated Office (National Office of or acting for the State designated by the applicant for the search)
  - EO = Elected Office (National Office of or acting for the State designated by the applicant for the written opinion)



# NEW APPLICATIONS

- Our Firm uses “second pair of eyes” for filing new applications
  - Two attorneys/agents check that all papers are in order and that no pages are missing or part of the page is missing in the application for paper-filed applications (paper-filing is rarely used, only used Design applications) or uploaded for Electronic filing
  - Check that all signatures are present in relevant documents. The filing of the application requires a signature and registration number of an attorney or agent licensed to practice before the USPTO
  - The transmittal sheet is checked off in which all attachments, i.e., Declaration, Claim of Priority if any, etc., are included in the filing
- Our Firm uses the Buddy System for applications in which the bar date is quickly approaching, i.e., the application must be filed that day
  - Two senior attorneys/agents check on each other that the application has been filed

# NEW APPLICATIONS

- OTHER APPLICATIONS – MANY OF THE PROCEDURES DISCUSSED ABOVE ARE APPLICABLE TO THESE EXCEPT AS FOLLOWS
  - Provisional applications
    - When an application is filed in the U.S. for the first time just to obtain a filing date for priority benefit under 35 USC 1.119(e)
    - The fee is much cheaper (\$110 for small entity, \$220 for large entity)
    - No claims or abstract is required
    - Along with a disclosure of the invention, only require a simple cover sheet
    - Cover sheet requires names and residence city/state and country of inventors

# NEW APPLICATIONS

## — PCT/International Applications

- File Transmittal form (Transmittal Letter to the United States Receiving Office, PTO-1384) which has the following
  - Earliest Priority date if any
  - Check boxes if applicable that states that 1) this is a new international application, 2) Invention was not made in the US, 3) there is no other prior US application, or 4) any other prior application that has related subject matter.
- PCT Request form (PCT/RO/101)
  - Contains info similar to transmittal for US application along with PCT information such as search authority/office being the US
  - Note that unlike other DO, US as DO must list inventors, not a company as the applicant
- PCT fees (transmittal \$240; search \$2080; filing \$1264) are rather high

# AFTER APPLICATION HAS BEEN FILED

- Proper docketing/procedures immediately after application has been filed:
  - Give file to docketing team to docket deadlines:
    - Deadlines can be for example, filing IDS, filing Preliminary Amendments, filing Executed Declaration, etc.
  - Send Filed Fax with 1 day
    - Filed Fax lets client knows application has been filed already
    - Alleviate their concerns, especially when the application is being filed very near the absolute/bar deadline date
    - Provides filing receipt to client
  - File assignment if one is needed
  - Invoice client, providing details of the filings and a copy of all filed documents

# AFTER APPLICATION HAS BEEN FILED

- **USPTO Notice To File Missing Parts (NTFMP)**
  - Might indicate to applicant that declaration was filed unexecuted and therefore an executed declaration is required to be submitted
    - File executed Declaration within 2 months from Notice with surcharge (\$65 for small entity or \$130 for large entity), with out an Extension of Time (EOT)
    - Can file up to 4 months after the 2 month deadline if paying fees for Extension of Time. USPTO operates by monthly extension of time.
  - Might require better drawings
  - Might require English translation if application as filed was not in English
    - Need to have a Statement that translation was accurate
  - Might require filing fees to be paid if not paid earlier, or fees were deficient

# AFTER APPLICATION HAS BEEN FILED

- **USPTO Notice to Correct Application Papers (NTCAP)**
  - **Indicate to application that certain papers need to be corrected**
    - **For example, cleaner or clearer drawings if figures are blurry, outside of the borders/within the margins, sheet numbers or figure numbers are not in the correct orientation, figures are too light, too small, etc.**



# AFTER APPLICATION HAS BEEN FILED

- Preliminary Amendments
- Formal Preliminary Amendments
  - Removing multiple claim dependencies
  - Change “characterized” language, which is often used in European patent applications, to “comprising” language
  - Other minor changes
  - Usually filed at time of filing application in order to avoid high claim fees, but if other reasons and did not have time, can file this after application is filed

# AFTER APPLICATION HAS BEEN FILED

- **Substantive Preliminary Amendments**
  - Usually do this after the application has been filed because it takes time to review the application substantively
  - Review the description, drawings, and claims for any substantive errors
  - But also review the entire application for typographical errors and grammatical errors

# AFTER APPLICATION HAS BEEN FILED

- If too many changes in the description of the invention, must file Substitute Specification (both a marked-up copy and a clean copy)
  - Marked-up copy has underlines for added language and strike-throughs for deleted language
  - Clean copy does not have strike-throughs and underlinings
- Best to file these amendments before the Examiner takes action on the application (thus “Preliminary Amendment”)
  - Usually have plenty of time before Examiner takes action on backlogged cases (i.e., 2-3 years for electrical and business method applications), but perhaps 6 mo. to 1 year for others such as mechanical applications

# AFTER APPLICATION HAS BEEN FILED

- Other papers from USPTO after filing (reserved for other discussions/lectures)
  - Restriction Requirement: Examiner indicates that claims are drawn to more than one invention or species and requires applicant to elect one
  - First Office action on the Merits: Examiner usually make a rejection or rarely indicates allowance via a Notice of Allowance
  - Final Office action: Examiner is rejecting for the second time and makes it “final”

# AFTER APPLICATION HAS BEEN FILED

- **Advisory Action:** When applicant had filed a response or amendment after the Final Rejection and Examiner is still not persuaded to allow the application
- **Notice of Allowance:** indicates allowance of all of the claims
- **Notice of Abandonment:** indicates that applicant has not responded to Examiner's Office action for more than 6 months and thus the application is abandoned

# AFTER APPLICATION HAS BEEN FILED

- Provisional applications – No examination
- PCT/International Applications – Designated Office will issue Search Report and Elected Office will issue “Written Opinion”
- International application will usually be published 18 months from the earliest priority application
- As the SR and Written Opinion does not carry much authority and applicants must file national applications later where rights are given, not many applicant care to respond to the SR and Written Opinion



# Thank You

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U.S. PATENT AND TRADEMARK OFFICE

# The End

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