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Common Mistakes when filing a Patent Application

Presented By:
Andrew Chriss
Janice Tippett

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Overview

- Filing Requirements
- Common Mistakes that lead to Notices of Missing Parts
 - Specification Format
 - Drawing Format
 - Application Data Sheet (ADS)
 - Signatures
 - Micro Entity Certification
- Resources
- Send your questions to: inventorinfochat@uspto.gov



Filing Requirements

- A specification, including a description and at least one claim
- Drawings, when necessary for an understanding of the invention
- Inventor information including the legal name, residence, and mailing address of each inventor
- Oath or declaration or an application data sheet
- The prescribed filing, search, and examination fees



Surcharge under 37 CFR 1.16(f)

- A surcharge (in addition to any other fees due) will be assessed for:
 - Late submission of the basic filing, search or examination fee
 - Late submission of inventor's oath
 - Filing an application that does not contain at least one claim on filing
 - Submission of an application filed by reference to a previously filed application



Office of Patent Application Processing (OPAP)

- Performs an initial review of the application papers for completeness and compliance with procedural requirements, including inspection of drawings to see if they can be effectively scanned and adequately reproduced
 - This is a separate standard from what the patent examiner will subsequently review during examination
- If deficiencies are found, OPAP will send an Official notice of the deficiencies and set forth a time period for response to avoid abandonment
- Once the application is accepted as complete by OPAP, it will be assigned for examination

SAMPLE Notice to File Missing Parts



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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|-----------------------|-----------------------|------------------------|
|--------------------|-----------------------|-----------------------|------------------------|

CONFIRMATION NO.
FORMALITIES LETTER

Mail date



Date Mailed: 01/28/2015

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

Response period

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

Items Required To Avoid Abandonment

An application number and filing date have been recorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).



Common Mistakes

- **Specification Format**
 - 37 CFR 1.52, 37 CFR 1.71-1.75, 1.77, and 1.121(b) & (c)
- **Drawing Format**
 - 37 CFR 1.84 and 1.121(d)
- **Application Data Sheet (Form PTO/AIA/14)**
 - 37 CFR 1.76
- **Signature Requirements**
 - 37 CFR 1.4
- **Micro Entity Certification (Form PTO/SB/15A)**
 - 37 CFR 1.29



Specification Page Format

- The specification, including the abstract and claims, must be written in English and have lines that are 1.5 or double-spaced in a single column of text
- Written on only one side in portrait orientation
- 8.5 by 11 inches with all margins of at least $\frac{3}{4}$ inches except for a left side margin of at least 1 inch

Specification Page Format

- Clearly typewritten in non-script font (e.g., Arial, Times New Roman, or Courier, preferably with a font size of 12), without shading, on white paper
- The application pages must be numbered consecutively (centrally located above or below the text) starting with page one
- Nonscript font (e.g., Arial, Times Roman, or Courier), preferably with a font size of 12
- Drawing figures should not be contained within the specification

Specification Sections

- **Title of the Invention (short and specific)**
- **Most common applicable sections**
 - Background of the Invention (e.g., state of the art before your invention)
 - Brief Summary of the Invention
 - Brief Description of the Drawings (list of all figures by number with brief statement of what the figure depicts)
 - Detailed Description of the Invention
- **Claims (on a separate sheet)**
- **Abstract (less than 150 words, one paragraph, on separate sheet)**



Substitute Specification

The required item(s) identified below must be timely submitted to avoid abandonment:

- A substitute specification in compliance with 37 CFR 1.52, 1.121(b)(3), and 1.125, is required. The substitute specification must be submitted with markings and be accompanied by a clean version (without markings) as set forth in 37 CFR 1.125(c) and a statement that the substitute specification contains no new matter (see 37 CFR 1.125(b)). The specification, claims, and/or abstract page(s) submitted is not acceptable and cannot be scanned or properly stored because:



Substitute Specification - 37 CFR 1.125

- **3 Required Parts of the Submissions**
 1. Marked-up copy with proper markings showing all the changes relative to the immediate prior version of the specification of record
 2. Clean copy (without markings)
 3. Signed statement that the substitute specification contains no new matter

The ENTIRE specification is required for the marked-up and clean copies, not just the amended portion



Marked-up Copy - 37 CFR 1.125(c)

A version that shows ALL changes to the most recent specification of record with markings.

Additions of text are underlined.

Deletions of text are shown by ~~strike-through~~, except double brackets may be used to indicate deletion of ~~[[five]]~~ or ~~[[fewer]]~~ characters.

*
*
*

SUMMARY OF THE INVENTION

Accordingly, it is an ~~objet~~object of the present invention to provide a device and ~~[[a]]~~ method of allowing air to circulate into and out of a hat.

BRIEF DESCRIPTION OF THE DRAWINGS

For a fuller understanding of the nature and objects of the invention, reference should be made to the following detailed description taken in conjunction with the accompanying drawings, in which:

FIG. 1 is a pictorial view showing the invention.

FIG. 2 is a pictorially exploded view showing the invention.

FIG. 3 is a perspective view of an absorbent material according to the present invention.

FIGS. 4 and 5 are perspective views of a vented hat according to the present invention.

DETAILED DESCRIPTION:

*
*
*

Clean Copy - 37 CFR 1.125(c)

A version that includes ALL changes to the most recent specification of record without markings.

*
*
*

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FIG. 3 is a perspective view of an absorbent material according to the present invention.

FIGS. 4 and 5 are perspective views of a vented hat according to the present invention.

DETAILED DESCRIPTION:

*
*
*

Statement – 37 CFR 1.125(b)

The submission must be accompanied by a statement that the substitute specification includes no new matter.

By my signature below, I confirm that the attached substitute specification under 37 CFR 1.25 includes no new matter.

Signature

Date

Printed Name



Drawings

- **Required if necessary to understand the subject matter to be patented**
 - A drawing necessary to understand the invention cannot be introduced after the filing date
- Replacement drawings in compliance with 37 CFR 1.84 and 37 CFR 1.121(d) are required. The drawings submitted are not acceptable because:

Drawing Requirements

- Black and white drawings; lines; numbers heavy enough to permit adequate reproduction
- Use reference characters (in specification and drawings; numerals preferred)
- Each Figure must be labeled in English (e.g., FIG. 1) with a corresponding description in the Brief Description of the Figures
- Contain little or no text, and no non-English labeling or text
- Be on white, non-graph, 8.5 by 11 paper, with margins of at least $\frac{3}{4}$ inch and a left margin of at least 1 inch

Drawing Requirements

- Be free of erasures, copy marks, overwriting, interlineations, folds, and alterations
- Numbering of the sheets of drawings should be numbered. In the top-center of each sheet, the number should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.

OPAP Drawing Review - MPEP 507

- Line quality that is too light to be reproduced
- Missing lead lines
- Excessive text or text that is not in English
- Paper format (e.g., margins and paper size)
- Incorrectly labeled figures
- Photographs that are illegible after scanning
- Color drawings without a petition



OPAP Drawing Review - MPEP 507

- Each figure described in the brief description of the drawings must correspond to a separately-labeled drawing figure
 - Fig 1 described in the specification should not be labeled as Fig 1a
 - Fig 1a-f described in the specification should not be labeled as Fig 1

Amendments to the Drawings

37 CFR 1.121(d)

- Must comply with 37 CFR 1.84
- Each sheet **must be labeled** “Replacement Sheet” or “New Sheet” as applicable in the top margin
- Marked up copy is optional unless required by the examiner
 - Must be labeled “Annotated Sheet” if submitted

Application Data Sheet (ADS)

- An ADS is **required** to:
 - Identify applicants who are not inventors
 - Set inventorship when an inventor's oath is NOT being submitted until later in the prosecution
 - Set inventorship where there are joint inventors and each joint inventor is executing a declaration that ONLY names that inventor and not all inventors
 - Make benefit claims under 37 CFR 1.78 and foreign priority claims under 37 CFR 1.55
- The ADS received on [DATE] was not properly signed. Therefore, the Office will treat it only as a transmittal letter. See 37 CFR 1.76(e). Inventorship has not been set by this document and any foreign priority or domestic benefit claims contained therein are ineffective. See 37 CFR 1.55 or 37 CFR 1.78.

Helpful Hints - ADS

- **Signature**

- Every ADS must be signed by either a registered patent practitioner or the applicant.
 - When a named applicant in the “Applicant Information” section is a juristic entity (e.g., a company), the ADS must be signed by a registered patent practitioner.
- An unsigned ADS will be treated only as a transmittal letter (37 CFR 1.76) with limited information being made of record from it.

- **Domestic benefit**

- If an applicant wishes to claim the benefit of an earlier-filed US application (e.g., a provisional application), the claim must be made in the “Domestic Benefit/National Stage Information” section of an ADS.



Helpful Hints - ADS

- **File by reference**
 - In an overwhelming majority of filed applications, the “Filing by Reference” section of the ADS should be left BLANK. Overcoming a mistake in completing this section can be particularly costly and time consuming.
- **Typographical errors**
 - Applicants should be sure to carefully check each entry in the ADS for typographical errors. Errors in the spelling of names, prior application numbers, addresses, etc. are not always easy to fix and can cost applicants money, time, and additional paperwork.



Check the Filing Receipt



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| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE RECD | ATTY DOCKET NO | TOT CLAIMS | IND CLAIMS |
|--------------------|-----------------------|--------------|--------------|----------------|------------|------------|
| 14/550,910 | 11/21/2014 | 1791 | 435 | | 2 | 2 |

120070
 George Pul
 PO Box 60244
 Las Vegas, NV 89160

CONFIRMATION NO. 8826
 UPDATED FILING RECEIPT



000000072682112

Date Mailed: 01/06/2015

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Inventor(s)

Applicant(s)

Inventor(s) George Pul, Las Vegas, NV;
Applicant(s) George Pul, Las Vegas, NV;

Power of Attorney: None

Domestic Priority

Domestic Priority data as claimed by applicant
 This appln claims benefit of 61/909,203 11/26/2013

Foreign Priority

Foreign Applications for which priority is claimed (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see <http://www.uspto.gov> for more information.) - None.
Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.

Fee status

If Required, Foreign Filing License Granted: 12/08/2014
 The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 14/550,910**
Projected Publication Date: 05/28/2015
Non-Publication Request: No
Early Publication Request: No
**** MICRO ENTITY ****



Updating the ADS

- All changes to the ADS must be properly marked up
- Information may be corrected or updated by filing a ***corrected*** ADS that contains all sections of the form or only the sections of the form containing changed or updated information
- Changes must be shown by underlining for insertions and ~~strike-through~~ or [brackets] for deletions



Updating the ADS

- Each section containing changes or updated information must contain **all** of the information already of record with the changes shown by markings
- If the ADS is submitted after the submission of the application, even if it is the first submission of an ADS, any information being added or deleted relative to the information of record must be indicated by markings

Example: Correcting a Benefit Claim

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) or indicate National Stage entry from a PCT application. Providing benefit claim information in the Application Data Sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78. When referring to the current application, please leave the "Application Number" field blank.

| | | | |
|---|--------------------------------------|---------------------------------------|------------------------------------|
| Prior Application Status | Expired | <input type="button" value="Remove"/> | |
| Application Number | Continuity Type | Prior Application Number | Filing or 371(c) Date (YYYY-MM-DD) |
| | <u>Claims benefit of provisional</u> | <u>61973005</u> | <u>2014-03-31</u> |
| Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the Add button. | | | <input type="button" value="Add"/> |

This correction rectifies a situation in which the as-filed ADS did not make a benefit claim (or the benefit claim was not properly presented). The underlining shows the benefit claim is being added. The underlining is relative to the information of record shown on the filing receipt.

*Signature is also required



Signature Requirement – 37 CFR 1.4

- Handwritten – 37 CFR 1.4(d)(1) /John T. Smith/
- S-signature – 37 CFR 1.4(d)(2) John T. Smith
 - Name between two single forward slashes
 - Signature must be accompanied by printed/typed name of signer and be easily identifiable
- Graphic representation – 37 CFR 1.4(d)(3)
 - For electronically submitted correspondence
 - Graphic representation of handwritten signature or S-signature



Signature Requirement (cont.)

- Multiple Inventors: ALL inventors must sign UNLESS a power of attorney has been granted to one or more of the joint inventors
 - Form PTO/AIA/81 can be used for this
 - Each inventor must complete a separate form, including

NOTE: Signatures of all the inventors are required. Submit multiple forms if more than one signature is required, see below*. See 37 CFR 1.4 for signature requirements and certifications.

*Total of _____ forms are submitted.

Micro Entity Status – 37 CFR 1.29

- Reduces most fees by 75%

This application, which was filed with an indication of micro entity status, fails to meet the requirements for establishing micro entity status because:



Micro Entity 37 CFR 1.29(a)

Gross income - Use form SB/15A to certify:

1. The applicant qualifies as a small entity
2. No inventor and no other applicant (if any) has been named as an inventor on more than 4 previously filed U.S. nonprovisional patent applications
3. No inventor and no other applicant (if any), in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income exceeding 3 times the median household income most recently reported by the U.S. Census Bureau

Micro Entity 37 CFR 1.29(a)

4. No inventor and no other applicant (if any) has assigned, granted, or conveyed (and is not under obligation to do so) a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income exceeding 3 times the median household income most recently reported by the U.S. Census Bureau

Helpful Hints – Micro Entity

- Be sure to properly sign the form
- Identifying Information
 - First named inventor is a single name that will be the same on every micro entity certification form submitted in an application
 - Title listed should match that in the ADS or specification
 - If filed before an application number is assigned, the application must be identified with **both** the first named inventor AND the correct title of invention
 - Leave the application number section BLANK if no application number has been assigned
- Each applicant must submit a separate form



Online Educational Resources

- **Nonprovisional (Utility) Patent Application Filing Guide**
<https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/nonprovisional-utility-patent>
- **Important Information for Completing an ADS**
<https://www.uspto.gov/patent/forms/important-information-completing-application-data-sheet-ads>
- **ADS Instructions Document**
www.uspto.gov/sites/default/files/ebc/portal/efs/ads_form_inst.doc
- **Article on Common Pitfalls on USPTO Forms**
<https://www.uspto.gov/learning-and-resources/newsletter/inventors-eye/common-pitfalls-uspto-forms>

Additional Resources

- **Substitute Specification: MPEP 608.01(q), 37 CFR 1.125**
 - Clean/marked-up copy: 37 CFR 1.125(c)
 - Statement of no new matter: 37 CFR 1.125(b)
- **Signature Requirement: 37 CFR 1.4(d)**
 - Power of Attorney to Joint Inventor(s): Form PTO/AIA/81
- **Drawings: MPEP 507**
 - Drawing requirements: 37 CFR 1.84
 - Amendments to Drawings: 37 CFR 1.121(d)



Additional Resources

- **Micro Entity Status: MPEP 509.04, 37 CFR 1.29, 35 USC 123**
 - Gross Income: Form SB/15A
 - Institute of Higher Learning: Form SB/15B
 - Application Data Sheet (ADS): Form PTO/AIA/14
- **Application Data Sheet (ADS): Form PTO/AIA/14**

Glossary of patent terms

- **Applicant** – the inventor or all the joint inventors who are applying for a patent on their own invention, or the person mentioned in 37 CFR 1.43, 1.45 or 1.46 who is applying for a patent in place of the inventor.
- **Application Number** - the unique number assigned to a patent application when it is filed. The application number includes a two digit series code and a six digit serial number.
- **Juristic Entity** - corporations and other non-human entities created by law and given certain legal rights.



Glossary of patent terms

- Benefit Claim - the claiming by an applicant in a nonprovisional application the benefit of the filing date of a prior-filed copending provisional or nonprovisional application, or international application designating the U.S. for the purposes of securing an earlier-effective filing date for the nonprovisional application.
- Filing Date - the date of receipt in the Office of an application which includes (1) a specification containing a description.



