Understanding the Application Data Sheet (ADS): Little Things Make a Big Difference

Office of Innovation Development

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Office of Innovation Development

- In Person Assistance (by appointment) for Pro Se Applicants
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- Patent Email Support innovationdevelopment@uspto.gov
- PTRC Partnership for Patent Education Courses
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Email questions to: inventorinfochat@uspto.gov
Overview

• Understanding the Application Data Sheet (ADS)
  – Explanation of the ADS, including revisions, and who reviews it
  – Time frame for submission of the ADS

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Definitions

• The ADS:
  – is used to provide inventor name(s), applicant name(s), correspondence address, any domestic benefit or foreign priority claim(s), and other bibliographic information; and
  – is considered to be part of the application when submitted with the application on filing

• Office of Patent Application Processing (OPAP)
  – the first area that handles a patent application

• USPTO’s Electronic Filing System, EFS-Web
  – Enables applicants to submit applications electronically rather than by mail or hand-carry

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America Invents Act (AIA)

- Changes relating to ADS and the Inventor’s Oath or Declaration became effective September 16, 2012
  - Requires use of Application Data Sheet (ADS) for certain types of information
  - Delayed timing for filing the inventor’s oath and declaration if a proper ADS is submitted
  - “Applicant” and “Inventor” are no longer necessarily the same

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Who Reviews the ADS?

- OPAP is the area that primarily reviews the ADS
  - Captures bibliographic data into office automated systems
  - Records authorizations to provide and receive applications to/from other partner countries
  - Corrects bibliographic data

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Submit an ADS on Day of Filing

• The Office strongly recommends submitting an ADS with the application at the time of filing rather than after filing the application.

• The ADS submitted upon filing must be properly signed by party under 37 CFR 1.33(b):
  - S-signature must be acceptable
  - Complete registration number (if a patent practitioner)
  - Printed name must accompany signature
  - If a juristic entity (e.g., a company) is identified as the applicant then the ADS must be signed by a patent practitioner.

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S-Signature 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).

• 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.

• 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 (§ 1.4(d)(2)(ii)).
  - For example: /John Attorney Reg. #99999/
  John Attorney

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Handwritten Signature 37 CFR 1.4(d)(1)

• The handwritten signature must:
  • Be an original, that is, have an original handwritten signature personally signed, in permanent dark ink or its equivalent, by that person; or
  • Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

• There is no requirement for a printed name to accompany a handwritten signature
Effect of a Properly Signed ADS

**Properly signed**
- Establishes inventorship
- Establishes applicant
- Presents domestic benefit/foreign priority claims
- Does NOT establish power of attorney

**Unsigned or not properly signed**
- Does not set inventorship
- Does not set applicant
- Does not effectively present domestic benefit or foreign priority claims
- Most information is disregarded and captured from other sources

Information captured from other sources will become “of record” and any changes to this information must be made using a properly signed, properly marked-up ADS

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General Information

• OPAP will capture information as it is provided; we will not attempt to correct:
  – Transposed or misspelled names
  – Misspelled words in title
  – Incorrect application numbers in domestic benefit/priority claims

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General Information, cont.

• If ADS is not signed, or not properly signed, it is treated as transmittal letter only
  • Will not set inventorship or applicant
  • Will not establish benefit or priority claims

• Information can be captured from other sources and will become “of record”

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ADS Submitted After Filing

- All ADSs submitted after filing **must** be properly marked up
  - **Even if it is the first ADS submitted**, because information was gathered from other documents upon filing and made of record
  - Changes should be shown relative to information of record
  - Informally called a “Corrected” ADS

- Other papers and/or fees may need to accompany a Corrected ADS, depending on when it is filed and nature of changes
  - Changes to applicant – request (Form AIA/41 or equivalent); § 3.73 Statement
  - Changes to entity status – certification, written statement, or petition may be required
  - Changes to inventorship – request (Form AIA/40 or equivalent), fees, statements, inventor’s oath or declaration may be required
  - Changes to domestic benefit or foreign priority claim may require a petition, fee and statement of unintentional delay

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Applicant and the ADS

• Inventor is recognized as applicant by default if an applicant is not otherwise named in a properly signed ADS

• Changing applicant to any other party requires a request under 37 CFR 1.46(c)(2)

• Requirements to comply with 37 CFR 1.46(c)(2)
  – “Corrected” ADS with proper markings
  – Statement under 37 CFR 3.73(c)

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Applicant and the ADS, cont.

- Applicant can only be changed, not deleted
  - Change in applicant requires a § 3.73 Statement (Form AIA/96 or equivalent) to show ownership to new applicant
  - Correction or update in the name of the applicant requires a “Corrected” ADS
  - Changing applicant to the inventors requires a § 3.73 Statement showing title back to inventors
  - A § 1.182 petition is required to attempt correction/removal of an improperly named applicant

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Domestic Benefit/Foreign Priority

• Domestic benefit or foreign priority data only captured from ADS – no consideration given to specification or any other document
• Benefit claims are captured as provided on ADS
• OPAP does not attempt to correct benefit claims that are missing, incorrect, improperly formatted, or not properly marked up

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Domestic Benefit/Foreign Priority

- Domestic benefit or foreign priority claims must be made timely
  - Must be presented 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)
  - Corrections to benefit claims must also be made within above time periods
  - Benefit claims or corrections made outside time periods must petition to accept late claim
Benefit Claims

• Indicate correct relationship of domestic benefit applications listed on ADS
  – Misidentifying a 111(a) CON of a 371 national stage entry of PCT application will result in the application being processed under an incorrect statute
  – Non-specific relationship identifier will prevent capture; relationship should be any one of:
    • Continuation (CON)
    • Divisional (DIV)
    • Continuation-in-Part (CIP)
    • Reissue (REI)
    • National Stage (NST)
    • Claims benefit of (PRO) – for benefit to provisional only

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Benefit Claims, cont.

• Incorrect order or relationship may prevent accurate capture
  – The order of the applications should be listed beginning from the instant application and continuing through the list of parents in reverse chronological order (newest to oldest).
  – Leave the “Application Number” field blank for direct benefit claims (This application is...)

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<th>Prior Application Number</th>
<th>Filing Date (YYYY-MM-DD)</th>
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<tbody>
<tr>
<td>Application Number</td>
<td></td>
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</tbody>
</table>
Benefit Claims, cont.

• Inconsistencies between filing date provided and USPTO records will be noted on filing receipt

• § 371(c) date of National Stage applications will be retrieved instead of date filed in PTO

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ADS Common Problems: Filing by Reference

• Filing by Reference (FBR) section completed by mistake
  – Filing by Reference is not a benefit claim
  – 35 U.S.C. 111(c) prohibits rescission of FBR
  – In limited circumstances, a petition under 37 CFR 1.182 may be available

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ADS Common Problems, cont.: Reference/Benefit/Priority Sections

- Reference filing section completed by mistake
- Domestic benefit or foreign priority data missing, incorrect, improperly formatted, or not properly marked up
- Domestic benefit or foreign priority claims not timely
  - must be presented 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)

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ADS Common Problems, cont.:  
General

- Application not properly identified (when filing an ADS after the filing date) with application number and title
- ADS not properly signed (e.g., incorrect slashes, no registration number, not all inventors) – invalidates ADS
- ADS not properly marked up when submitted after filing
- Inventor mailing address or residence not completed properly (i.e., city/state/country missing or not completed, invalid country name provided)

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 ADS Common Problems, cont.: Applicant Issues

- Failure to use proper markings to show changes to the information of record
- Failure to provide a proper § 3.73 statement, when required
- A rejection of a change of applicant may affect a concurrently-filed power of attorney
- Correction/update of applicant name can be mistaken for change of applicant – use Form AIA/41 or be sure to state in request that the change is requested under 37 CFR 1.46(c)(1)

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ADS and Inventor’s Oath/Declaration

• When the ADS sets inventorship, the name provided on the inventor’s oath or declaration must match the name set forth in the ADS
  – Both documents require legal name
  – If names do not match, new inventor’s oath or declaration or § 1.48 request will be needed
  – Exception for character substitution for characters that cannot be entered on ADS (for example: ss for ß, ae for ä, oe for œ)

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Corrected ADS

• A corrected or later-filed ADS (for applications filed on or after September 16, 2012) must be marked up as set forth in 37 CFR 1.76(c)
  – The corrected ADS will not be processed unless markings properly showing the changes are provided
  – For more information on a corrected ADS, see MPEP 601.05(a)

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Corrected ADS, cont.

- A corrected or updated ADS may include:
  - All sections listed in §1.76(b), or
  - Only those sections containing changed or updated information (§1.76(c)(2))
    - All information in the section must be provided, with identification of what has changed in the section
    - Underlining for insertions, strike-through or brackets for deletions
    - Bold, highlighting, comments, italics, other formatting, etc. are not acceptable markings
    - Unmarked information will not be reviewed

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Showing Changes on a Corrected ADS

• Changes should be shown relative to the information of record, which is generally what is shown on the most recent filing receipt
  – Inventor names may appear on the filing receipt even if inventorship has not been set by ADS or oath/declaration
  – Changes to applicant should include applicant as listed on filing receipt
  – ADS must include all information in the section that contains changes – not just provide information that is being added/corrected
Corrected ADS in EFS-Web

• Office form – almost always best option
• Best way to avoid rejection due to improper markings
• Will retrieve information of record, eliminating guesswork as to what has been captured and is “of record” with the Office
• OPAP no longer captures non-established inventors; only “of record” info is recorded
• Some info will be recorded, but not shown on the filing receipt – mailing address, phone/fax/email

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Web-based ADS and Corrected ADS

- **Web-based ADS** has a pre-population feature which can pre-populate inventor, benefit claim and foreign priority information
- Quick Start Guide for Web-based ADS
  

- **Corrected Web-based ADS** will pre-populate with information that the Office has of record and create the required markings
- Quick Start Guide for Corrected (Web-based) ADS
  

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Resources

• How to get help
  – Application Assistance Unit, 571-272-4000
  – Patents Ombudsman, 571-272-5555 or
    https://www.uspto.gov/patent/ombudsman-program
  – Inventor Assistance Center, 571-272-1000 or
    https://www.uspto.gov/learning-and-resources/support-centers/inventors-assistance-center-iac

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Other Helpful Information
Electronics Submissions

• Using correct document descriptions will ensure that OPAP is notified of the incoming request
  – Applicants don’t always use correct document descriptions
  – Not all documents create a message
  – Combining requests can cause requests to be overlooked

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Electronic Submissions, cont.

• Some documents that **DO NOT** trigger notification to OPAP
  - Application Data Sheet
  - Electronic Fee Transmittal
  - Specification
  - Claims
  - Abstract
  - Drawings
  - Miscellaneous Incoming Letter
  - Transmittal Letter/Transmittal of New Application
  - Oath or Declaration filed

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Electronic Submissions, cont.

• Some documents that DO trigger notification to OPAP
  – Applicant Response to Pre-Exam Formalities Notice
  – Request for Corrected Filing Receipt
  – Power of Attorney
  – Request under Rule 48 correcting inventorship

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Upcoming OID Events

- May 17– Inventor Info Chat: Understanding Prior Art And Its Use In Determining Patentability
- August 17-18, 2018 – Invention Con –
- For more information or to register for any of the above events contact us at oidevents@uspto.gov

https://www.uspto.gov/patents-application-process/inventor-info-chat

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Thank You!

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To inquire about OID services please contact us at:

InnovationDevelopment@uspto.gov

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