

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# How to avoid common application filing issues

Janice Tippett

Program Analyst, Office of Patent Application Processing

United States Patent and Trademark Office

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# Documents must be properly signed

- If you are working with a registered practitioner, the practitioner may sign documents, even if you have not appointed him or her to have power of attorney.
- If you are not working with a registered practitioner and there is no applicant named on an application data sheet (ADS), all inventors must sign each document/submission.
- If you are not working with a registered practitioner and there is no applicant named on an ADS, all inventors may appoint one or more of the inventors to prosecute the application on everyone's behalf:
  - Each inventor must sign the form, even the one being appointed.
  - PTO/AIA/81 may be used.



# Powers of attorney: AIA/81

PTO/AIA/81 (07-13)  
Approved for use through 11/30/2014. OMB 0651-0035  
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.

<b>POWER OF ATTORNEY TO ONE OR MORE OF THE JOINT INVENTORS AND CHANGE OF CORRESPONDENCE ADDRESS</b>	Application Number	
	Filing Date	
	First Named Inventor	
	Art Unit	
	Examiner Name	
	Title	

**NOTE:** This form may be filed by *pro se* inventors (i.e., prosecuting the application without a registered patent practitioner) who are identified as the Applicant in the above-identified application. For a Power of Attorney to one or more registered patent practitioners, see form PTO/AIA/82.

I hereby revoke all previous powers of attorney given in the above-identified application.

I hereby appoint the following joint inventor(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

Please recognize or change the correspondence address for the above-identified application to:

The address associated with Customer Number. (if applicable):   
-To Request A Customer Number see form PTO/SB/124

OR

Individual Name

Address

City  State  Zip

Country

Telephone  Email

I am the Inventor.

**SIGNATURE of inventor**

Signature	<input style="width: 95%;" type="text"/>	Date	<input style="width: 95%;" type="text"/>
Name	<input style="width: 95%;" type="text"/>	Telephone	<input style="width: 95%;" type="text"/>

**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.

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is, in part, by the

- For applications filed on/after September 16, 2012.
- AIA/81 is used by *pro se* joint inventors who are the applicants to give power of attorney to one or more of them.
- The appointed inventor(s) must also submit a signed form.



# Signatures must be properly formatted

- Signatures can be handwritten or electronic signatures.
- If the signature is not properly formatted, the document will be considered to be unsigned.
- Unsigned documents/submissions will not be accepted or entered into the file record.

# S-signature – 37 CFR 1.4(d)(2)

- An 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 single forward slash marks (§ 1.4(d)(2)(i)).
- The name of the person signing must be printed or typed immediately adjacent to (i.e., below, above, or beside) 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. #999999/
  - John Attorney

# Handwritten signature – 37 CFR 1.4(d)(1)

- A handwritten signature must:
  - Be an original, that is, be 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 USPTO may require submission of the original.
- There is no requirement for a printed name to accompany a handwritten signature.

# Additional signatures

- When using web-based forms on the USPTO.gov website, additional signatures can be added to the form by clicking the “Add” button.
- Forms other than those from the USPTO.gov website will need to include additional signatures by other means.
- The USPTO strongly encourages the use of the web-based forms.

<b>Signature:</b>				
<b>NOTE:</b> This Application Data Sheet must be signed in accordance with 37 CFR 1.33(b). However, if this Application Data Sheet is submitted with the <b>INITIAL</b> filing of the application and either box A or B is not checked in subsection 2 of the “Authorization or Opt-Out of Authorization to Permit Access” section, then this form must also be signed in accordance with 37 CFR 1.14(c).				<input type="button" value="Remove"/>
This Application Data Sheet <b>must</b> be signed by a patent practitioner if one or more of the applicants is a <b>juristic entity</b> (e.g., corporation or association). If the applicant is two or more joint inventors, this form must be signed by a patent practitioner, <b>all</b> joint inventors who are the applicant, or one or more joint inventor-applicants who have been given power of attorney (e.g., see USPTO Form PTO/AIA/81) on behalf of <b>all</b> joint-inventor applicants.				
See 37 CFR 1.4(d) for the manner of making signatures and certifications.				
* Signature	<input type="text"/>			(EXAMPLE: /John Smith/)
* First Name	<input type="text"/>	* Last Name	<input type="text"/>	Registration Number <input type="text"/>
Additional Signature may be generated within this form by selecting the <input type="button" value="Add"/> button.				

# Submission methods

- Regular USPS mail with Certificate of Mailing (37 CFR 1.8)
- USPS Priority Mail Express® Post Office to Addressee service (37 CFR 1.10)
- EFS-Web (registered users only)
- Documents required for a filing date cannot be faxed

# Application Data Sheet (ADS)

- The USPTO strongly recommends submitting an ADS with the application at the time of filing rather than after filing the application.
  - An ADS submitted after filing must be properly marked up.
  - Establishment of an applicant after filing must be accompanied by a 3.73(c) statement showing complete chain of title.
  - Benefit claims must be timely submitted.

# Application Data Sheet (ADS)

- ADS submitted upon filing
  - Must be properly signed as above
    - Properly formatted
    - Signed by everyone who needs to sign
  - Will establish inventorship
  - Will establish applicant, when provided
  - Will present domestic and foreign benefit claims
  - Will not establish power of attorney or micro entity status

# Application Data Sheet (ADS)

- If the ADS is not signed, or not properly signed, it is treated as a transmittal letter only.
  - Will not set inventorship or applicant.
  - Will not establish benefit or priority claims.
  - Most information is disregarded and captured from other sources.
  - Information captured from other sources will become “of record.”
  - Any changes made later must be on a properly marked-up ADS.

# Application Data Sheet (ADS)

- The Office of Patent Application Processing (OPAP) will capture information as it is provided; we will not attempt to correct:
  - Transposed or seemingly misspelled names
  - Misspelled words in title
  - Incorrect application numbers in domestic benefit/priority claims

# Inventorship

- Inventor names listed on a properly signed ADS are the inventors who are established in the application.
- Suffixes (Jr., Sr., etc.) are used to confirm proper signatures on inventor's oath and other documents.
- Each inventor must provide his or her mailing address, city of residence, and state or country of residence.

# 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 on the ADS.
  - Both documents require legal name.
  - If names do not match, a 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).

# Application Data Sheet (ADS)

- Docket numbers are recommended for the applicant's identification purposes, especially when the applicant has filed multiple applications.
- Customer numbers are issued by the USPTO; only use a customer number that has been provided by the USPTO when designating the correspondence address.
- Filing by Reference (FBR, Reference Filing) is a very specialized process that should only be used in limited circumstances.

# Filing by Reference

- Filing by Reference is **not the same** as claiming domestic benefit or foreign priority.
- Filing by Reference cannot be corrected, rescinded, or deleted once a filing date is granted for the application.
- Filing by Reference requires that a prior specification is used; newly written specification is not permitted.
- Allows applicant to file application and obtain filing date before submitting the specification and drawings.

# Reference Filing Statement

- Relies on the specification and drawings of a prior application, not a new specification and drawings.
- Provides application number, filing date, and intellectual property authority of the prior application.
- Must be made upon filing an ADS in English.
- Filing date is based on the statement, not a specification document.

# 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 incomplete, incorrect, or improperly formatted.

# ADS – common problems

- Common problems with the ADS:
  - Not properly signed with correct slashes and registration number, or not all inventors – invalidates ADS.
  - Inventor residence not completed properly (city or state/country missing, invalid country name provided).
  - Domestic benefit or foreign priority data incomplete, incorrect, or improperly formatted.
  - Domestic benefit or foreign priority claims not timely (must be presented within the later of four 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)).

# Specification

- Necessary for a filing date, except for FBR.
- Must have written description of the invention.
- Must be in English or have an English translation.
- Fee for more than 100 pages of specification, claims, abstract, appendices, and drawings.

# Specification

- The first specification that contains sufficient disclosure of the invention will establish the filing date and be the specification of record.
- If a filing date is not granted, there is no specification of record.
- Any corrections required must be relative to the specification of record.

# Specification

- Paper, language, writing, and margin requirements:
  - 1.5 or double spacing
  - Sufficient clarity (font, font size, not handwritten, white background)
  - No missing or illegible text or pages
  - Brief description of figures (if drawing figures are submitted)
  - Landscape orientation
  - No embedded figures

# Application size

- Specification, claims, and abstract
- Drawing sheets
- Application parts (specification, drawings) added by petition or as a required response to a Notice
- Appendices
- Computer program listing filed in paper
  - If filed in electronic form, it is excluded from application size calculation
- Tables submitted as an ASCII file are counted as one sheet of paper for each 3 KB of content

# Claims

- Recommended to be submitted upon filing (surcharge if submitted after filing)
  - For design application, necessary for a filing date
- In English
- Fee for total claims over 20, independent claims over three, and for presence of multiple dependent claims
- Must commence on a separate page
- Same paper, language, writing, and margin requirements as specification

# Abstract

- Present and in English
- Must commence on a separate page
- Same paper, language, writing, and margin requirements as specification

# Drawings

- Proper labeling
  - Drawing figure labeling must correlate with figure number described in specification
  - “Fig.” or “Figure” followed by Arabic numerals or Arabic numerals with single letter (Fig. 1, Fig. 2, Fig. 3, etc. or Figure 1a, Figure 1b, Figure 2a, Figure 2b, etc.)
  - In English
- Line drawings
- Proper margins and orientation
- Clarity (erasures, background, blurry, weight of lines)
- No extraneous text, captioning

# Figure labeling

- Figures must be labeled in the same manner they are described.
  - Numbering of the figures must be consistent with the numbering in the brief description of the drawings.

# Figure labeling

- Brief description:
  - Fig. 1 is a smiley face.
  - Fig. 2 is a heart shape.

Figures:



Fig. 1



Fig. 2

# Figure labeling

- Brief description:
  - Fig. 3 is a group of mathematical symbols. Fig. 3a is a plus sign, Fig. 3b is a minus sign, Fig. 3c is a multiplication sign, and Fig. 3d is a division sign.

Figures:

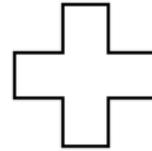


Fig. 3a



Fig. 3b

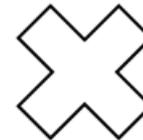


Fig. 3c

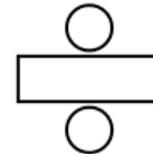


Fig. 3d

Fig. 3

# Figure labeling

- Brief description:
  - Fig. 3a is a plus sign.
  - Fig. 3b is a minus sign.
  - Fig. 3c is a multiplication sign.
  - Fig. 3d is a division sign.

Figures:

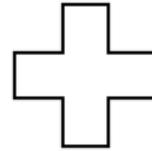


Fig. 3a



Fig. 3b

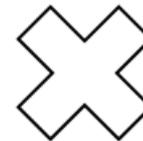


Fig. 3c

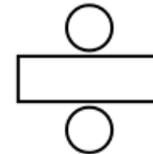


Fig. 3d

Fig. 3

# Figure labeling

- Brief description:
  - Fig. 3 is a group of mathematical symbols. Fig. 3a is a plus sign, Fig. 3b is a minus sign, Fig. 3c is a multiplication sign, and Fig. 3d is a division sign.
  - (There is no Fig. 3 in the example.)

Figures:

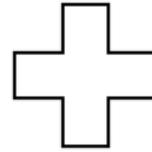


Fig. 3a



Fig. 3b

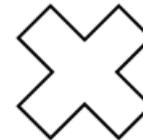


Fig. 3c

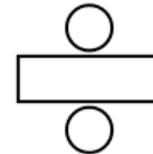


Fig. 3d

Fig. 3

# Figure labeling

- Brief description:
  - Fig. 3a is a plus sign.
  - Fig. 3b is a minus sign.
  - Fig. 3c is a multiplication sign.
  - Fig. 3d is a division sign.
  - (There is a Fig. 3 shown, but no corresponding description provided.)

Figures:

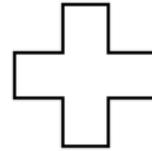


Fig. 3a



Fig. 3b

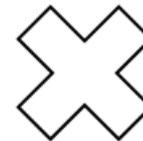


Fig. 3c

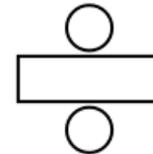


Fig. 3d

Fig. 3

# Fees

- Filing fees paid in full (surcharge if submitted after filing date)
  - Non-electronic filing fee for applications submitted in hard copy (mailed or hand-carried to the USPTO)
  - Excess claims fees
  - Application size fees
  - Fees for large sequence listing submitted/transferred
  - Other fees as applicable
- Fees paid according to the entity status established at the time of payment

# Forms of payment

- Credit card payment
  - Must be signed by authorized user
  - Must be specific about fees to be paid
- Check or money order
- Deposit account can be set up with the USPTO
  - [www.uspto.gov/learning-and-resources/fees-and-payment/deposit-account-rules-and-information](http://www.uspto.gov/learning-and-resources/fees-and-payment/deposit-account-rules-and-information)
  - Easily pre-authorize payment of fees



# Micro entity certification

- Identified with correct information
  - Inventor name spelled as provided on the ADS or inventor's oath
  - Title matches ADS or title of record
  - Application number, if provided, is that of current application (not parent or prior-filed)
- Properly signed

<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:

# Micro entity certification

- Fees paid in micro entity amounts will be “held” in those amounts until:
  - Problems with micro entity certification are resolved, or
  - Fees are paid in full under the established entity status.
- Surcharge will be due when fees are not paid in full at the time of filing.
- Fees paid in full in higher amounts are not refundable upon later certification.

# Applicant

- Can only be named on an ADS.
- Inventor is established as applicant by default if an applicant is not otherwise named.
- Applicant can only be changed, not deleted.
- Correction to applicant name must be shown on a properly marked-up ADS.

# Applicant

- Change of applicant after inventorship is established requires a request under 37 CFR 1.46(c), which requires:
  - Corrected ADS with proper markings
  - Statement under 37 CFR 3.73(c) showing complete chain of title
  - Returning inventors to be the applicant requires 3.73 showing title back to inventors
  - Removal of applicant requires 1.182 petition

# Applicant

- 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.

# Inventor's oath or declaration

- May be submitted instead of an ADS to set inventorship
- Submitted for each inventor (surcharge if submitted after filing)
- Correlates to name on ADS, if applicable
- Properly signed
- Contains required statements:
  - Believed to be original (joint) inventor
  - Application made or authorized to be made by inventor
  - Acknowledge penalty for making willful false statements
- Substitute statements are properly completed



# Fees in response

- Fee amounts must be paid in full according to the entity status in effect at the time of payment.
  - Entity status change may be included with response.
- Application size fee cannot be reduced or waived by elimination of pages.
- Excess claims fees may be reduced by amendment included with response.

# Submission methods

- Regular USPS mail with Certificate of Mailing (37 CFR 1.8)
- USPS Priority Mail Express® Post Office to Addressee service (37 CFR 1.10)
- EFS-Web (registered users only)
- Responses may be faxed to the USPTO official fax number at 571-273-8300.

# Electronic submissions

- The USPTO strongly recommends using correct document descriptions for submissions in EFS-Web.
- Using correct document descriptions will ensure that OPAP is notified of the incoming submission.
- Combining requests on one document can lead to delays.
- Each item requiring action should be distinguishable.
  - Petition/request embedded with response.
  - Power of Attorney (POA) contained in combined oath/POA document.



# Response submissions

- Responses that include fee payments, ADS, or drawings should not be submitted without being accompanied by an “Applicant Response to Pre-Exam Formalities Notice” document.
- Many document descriptions do not trigger a notification to OPAP, so response may go unnoticed.

# Review filing receipt

- Check the information carefully when you receive a filing receipt.
- OPAP will correct typographical errors made by the USPTO.
- Incorrect or missing information could cause impacts during prosecution.
  - Inventorship → First Inventor to File (FITF), micro entity status
  - Benefit claims → FITF, publication date
  - Applicant → power of attorney
  - Filing date → copendency, patent rights, foreign filing

# Review filing receipt, cont.

- Properly marked-up ADS is needed to make corrections.
- Corrections to inventorship and applicant cannot be made after issue fee is paid.
- Delay in correcting benefit claim could result in need for petition.

# Questions regarding notices

- All inquiries are to be directed to the Application Assistance Unit, as stated on the Notice.
  - Individual signing the Notice should not be contacted.
  - Attempts to contact an individual directly will not be acknowledged.
- Email inquiries require authorization for detailed response (MPEP 502.03).
  - Copy of communication will be made of record.
  - The USPTO is not required to respond to an email inquiry if there is no authorization in the application file.

# 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>

