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Patent Quality Chat
Understanding the ADS
Little Things Make a Big Difference

February 14, 2017

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To send in questions or comments during the webinar, please email:

PatentQuality@uspto.gov

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Fees and payment

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Enhanced Patent Quality Initiative




High-quality patents enable certainty and clarity of rights, which fuels innovation and reduces needless litigation. To ensure we continue issuing high-quality patents well into the future, we established the **Enhanced Patent Quality Initiative (EPQI)**. We are strengthening work products, processes, services, and how we measure patent quality at all stages of the patent process.

Updates

- Tune into our next [Patent Quality Chat](#) webinar on Tuesday, Feb. 14, from noon-1 p.m. ET, on "Understanding the ADS: Little Things Make a Big Difference"
- See our new [Quality Metrics](#) approach categorizing into product, process and perception indicators.
- Sign up for an upcoming [Stakeholder Training on Examination Practice and Procedure](#) (STEPP) course in your area.

EPQI programs

You spoke; we listened. To advance our Initiative, we created **12 EPQI programs** based on feedback from internal and external stakeholders. These programs fall into four areas of concertation for enhancing overall patent quality.



Patent Quality Chat

Understanding the ADS

Little Things Make a Big Difference

Janice Tippett

Management and Program Analyst
Office of Patent Application Processing

Email questions to PatentQuality@uspto.gov

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Definitions

- An ADS is a sheet or sheet that provides inventor, correspondence, benefit claim, applicant, and other bibliographic information and is part of the application
- OPAP is the Office of Patent Application Processing – the first area that handles a patent application
- EFS-Web is the USPTO's Electronic Filing System which enables applicants to submit applications electronically rather than by mail or hand-carry



Who Reviews the ADS?

- OPAP is the area that primarily reviews the ADS
 - Captures bib data into office automated systems
 - Records authorizations to provide and receive applications between other partner countries
 - Any corrections to bib data



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
 - Printed name must accompany signature



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



Effect of a Properly Signed ADS

ADS

Properly signed

Establishes inventorship

Establishes applicant

Presents domestic benefit/foreign priority claims

Does NOT establish power of attorney

ADS

*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 documents



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

Email questions to PatentQuality@uspto.gov

Application Information Capture

- Information is captured as it is provided either on an ADS or in other documents of record
 - Information in ADS generally governs when submitted at same time
- No attempt is made to correct:
 - Transposed or misspelled names
 - Misspelled words in the title
 - Incorrect application numbers in domestic benefit/foreign priority claims



ADS Filed 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
 - All changes to information already of record must be marked up
- Some changes must be accompanied by additional forms as required according to nature of changes
 - Changes to applicant – § 3.73 Statement
 - Changes to entity status – certification, written statement, or petition may be required
 - Changes to inventorship – fees, statements, inventor’s oath or declaration may be required
 - Changes to domestic benefit or foreign priority claim may require a petition



Applicant and the ADS

- Inventor is established as applicant by default if an applicant is not otherwise named in a properly signed ADS
- Change of applicant after inventorship is established requires a request under 37 CFR 1.46(c)
- Requirements to comply with 37 CFR 1.46(c)
 - “Corrected” ADS with proper markings
 - Statement under 37 CFR 3.73(c)



Applicant and the ADS (cont.)

- Applicant can only be changed, not deleted
 - Change in applicant requires a § 3.73 Statement to show ownership to new applicant
 - Correction or update in the name of the applicant requires a “corrected” ADS
 - Returning inventors to be the applicant 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



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



ADS Common Problems:

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)



ADS Common Problems:

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)



ADS Common Problems:

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 – be sure to state in request that the change is requested under 37 CFR 1.46(c)(1)



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)



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)



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



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



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

www.uspto.gov/sites/default/files/documents/Quick%20Start%20Guide%20WebADS.pdf

- 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

www.uspto.gov/sites/default/files/documents/Corrected-WebADS-QSG.pdf



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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Let's Chat about Understanding the ADS

Little Things Make a Big Difference

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Next Patent Quality Chat

Trademarks and Quality

March 14, 2017

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A blurred background image of a person's face, showing eyes and a red lip, set against a white background with a dark blue border at the top and bottom.

Thank you for joining us today!

Patent Quality Chat
Webinar Series 2017
February 14, 2017

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DO NOT ENTER – EVENT IN PROGRESS
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