Understanding the Application Data Sheet (ADS): Little things make a big difference

Invention-Con 2019 Preconference Session
September 12, 2019
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
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
ADS submitted after filing

• All ADS submitted after filing must be properly marked up (37 CFR 1.76(c) and MPEP 601.05(a)).
  – 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
ADS submitted after filing (continued)

• Other papers and/or fees may need to accompany a Corrected ADS, depending on when it is filed and nature of the 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
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
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
Filing receipt

United States Patent and Trademark Office

INVENTOR(S)
Charles Jordan, Sr. Brooklyn, NY
Alexander Robert Thompson, New York, NY
Kwan Jian Pak Seoul, KOREA, REPUBLIC OF,

APPLICANT(S)
VICTOR PEST CONTROL COMPANY

Assignment For Published Patent Application
VICTOR PEST CONTROL COMPANY

Power of Attorney: The patent practitioners associated with Customer Number 12346.

Domestic Priority data as claimed by applicant
NONE

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.)
REPUBLIC OF KOREA 12-2013-004567892 10/2/2013

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.
Tips for application data sheets

Former Domestic Benefit Claim Practice:
This application is a continuation of U.S. Application No. 13/"parent", filed on 2013-11-19, which was the National Stage of International Application No. PCT/CA2012/xxxx, filed on 2012-05-16, which claims the benefit of U.S. Provisional Application No. 61/xxx,xxx, filed on 2011-05-17.
Tips for application data sheets: newly filed application

This application is a continuation of U.S. Application No. 13/"parent", filed on 2013-11-19, which was the National Stage of International Application No. PCT/CA2012/xxxxx, filed on 2012-05-16, which claims the benefit of U.S. Provisional Application No. 61/xxx,xxx, filed on 2011-05-2017.

### Domestic Benefit/National Stage Information:

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No Relationship to instant application

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Tips for application data sheets

These blanks will be read as “this application is” which is inappropriate because the instant application is not directly related to both applications.
Tips for application data sheets

Information captured on the filing receipt:
This application is a continuation of U.S. Application No. 13/"parent", filed on 2013-11-19, which was the National Stage of International Application No. PCT/CA2012/xxxxx, filed on 2012-05-16, which **claims the benefit of U.S. Provisional Application No. 61/xxx,xxx, filed on 2011-05-2017.**

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Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.
ADS common problems: Reference/benefit/priority sections

• Reference filing section completed by mistake
  – Filing by Reference is not a benefit claim

• Domestic benefit or foreign priority data missing, incorrect, improperly formatted, not timely, or not properly marked up

• Inventor mailing address or residence not completed properly (i.e., city/state/country missing or not completed, invalid country name provided)
Reference filing

• Reference filing is not the same as claiming domestic benefit or foreign priority
• Reference filing cannot be rescinded or deleted
# Reference Filing

## Filing By Reference:

Only complete this section when filing an application by reference under 35 U.S.C. 111(c) and 37 CFR 1.57(a). Do not complete this section if application papers including a specification and any drawings are being filed. Any domestic benefit or foreign priority information must be provided in the appropriate section(s) below (i.e., “Domestic Benefit/National Stage Information” and “Foreign Priority Information”).

For the purposes of a filing date under 37 CFR 1.53(b), the description and any drawings of the present application are replaced by this reference to the previously filed application, subject to conditions and requirements of 37 CFR 1.57(a).

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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)
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
  
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
Enhanced Web-based ADS

The Web-based ADS is only displayed for new Utility and Design applications. It is currently not available for International or existing applications, or Supplemental Examination proceedings.

To access the Web-based ADS, select the second radio button, “Web-based ADS.” This will expand the web screen and display the Web-based ADS fields.
Enhanced Web-based ADS

• Option to **pre-populate application information** based on a previously filed application.

• Data may be retrieved for:
  – Registered eFilers who have power of attorney in the parent application; or
  – Both registered and non-registered eFilers if the parent application is made available to the public, i.e. published or patented
The first step is to enter the application and confirmation number of the parent application, then click the “Show” button. Bibliographic information of the entered application number is displayed for verification purposes.
Enhanced Web-based ADS

- After verifying the bibliographic information, then the options to populate the following sections are available:
  - Inventor Information
  - Domestic Benefit/National Stage Information
  - Foreign Priority Information
- Check the appropriate boxes and click Retrieve.
Enhanced Web-based ADS

• These steps may be repeated to retrieve data from multiple applications to create multiple chains of priority

• When retrieving Domestic Benefit/National Stage Information the entered parent information will be used as the first claim entry to the current application

• You must enter the continuity type and status information for each application for which retrieval is requested
Enhanced Web-based ADS

- In the Inventor Information section, the required fields are indicated by an asterisk.
- You will not be able to proceed if a required field is missing.
- If more than one inventor is entered, the order can be changed by renumbering. Make sure each number is used only once.
Enhanced Web-based ADS

- The correspondence section is a required section
  - A Customer Number or an address must be entered; the default field is the Customer Number
  - Registered eFilers will be able to select a Customer Number from the drop down menu or enter a Customer Number
  - Unregistered eFilers will only be able to enter a Customer Number (not select from a list) or select the checkbox to expand the section to allow an address to be entered.
Filing by reference

- The lower screen will not be visible unless Filing By Reference is selected.
- This section is not for making domestic benefit or foreign priority claims.
- Do not complete this section if application papers including a specification and any drawings are being filed at the time of filing the application.
Filing by reference

If you complete the filing by reference section, you will be limited to the disclosure of the prior application that is referenced.

- You will need to pay a surcharge, and
- You will need to submit a copy of the specification and any drawings of the prior application in response to a Notice to File Missing Parts.

**FILING BY REFERENCE**

Complete this section ONLY when filing by reference, click “<<” to expand/collapse section.

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**Signature**

- This form must be signed in accordance with 37 CFR 1.33(b)
- May also need to be signed in accordance with 37 CFR 1.14(c)
- The registration number block will accommodate “,” and “L” numbers

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<table>
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**NOTE:** 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 initial 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).

This Application Data Sheet must be signed by a patent practitioner if one or more of the applicants is a juristic entity (e.g., corporation or association). If the applicant is two or more joint inventors, this form must be signed by a patent practitioner, all 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 all joint-inventor applicants.

See 37 CFR 1.4(d) for the manner of making signatures and certifications.

<table>
<thead>
<tr>
<th>* Signature</th>
<th><em>(EXAMPLE: John Smith)</em></th>
</tr>
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<tr>
<td>* First Name</td>
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Additional Signature may be generated within this form by selecting the Add button.
Signatures 37 CFR 1.4(d)

- Three types of permitted signatures
  - Handwritten (personally signed) signatures are provided for in § 1.4(d)(1)
    - S-signatures are provided for in § 1.4(d)(2):
      - An S-Signature is a permitted type of signature between forward slash marks that is not handwritten (§ 1.4(d)(1))
      - Graphic representation of a handwritten signature or a graphic representation of an S-signature may be submitted via the Office’s electronic filing system (EFS-Web) (§ 1.4(d)(3))
- Note: Samples of acceptable signatures are posted on the USPTO’s website:
Power of attorney - 37 CFR 1.32(b)

For apps filed on/after 9/16/12

• A power of attorney must name as representative either:
  – one or more joint inventors;
  – up to ten registered patent attorneys or registered patent agents; or
  – those registered patent practitioners associated with a Customer Number.
Powers of attorney: AIA/81

- AIA/81 is used by pro se joint inventors who are the applicant to give power of attorney to one or more of them. The appointed inventor(s) must also submit a signed form.

For apps filed on/after 9/16/12
Juristic entities

• Juristic entities who seek to prosecute an application, including taking over prosecution (§§ 1.31 and 1.33(b)(3)):
  – must be represented by a patent practitioner

• Juristic entities can continue to take actions, such as:
  – executing terminal disclaimers
  – executing statements under § 3.73(c)
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