

Patent Law Treaty & Inventor's Oath or Declaration

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for Patent Examination Policy

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Law Treaties Implementation Act

- Patent Law Treaties Implementation Act of 2012 (PLTIA) was enacted on December 18, 2012.
- Title II of the PLTIA amends 35 U.S.C. to implement the PLT.
- Title II of the PLTIA is effective on December 18, 2013.

Areas of Major Changes

- Application filing date and reference filing provisions
- Restoration of the right of priority to foreign applications and domestic benefit of provisional applications
- Restoration of patent rights
- Time periods for action by applicants

Filing Provisions

- PLT and PLTIA:
 - Change application filing date requirements (except for design applications) (aka “application data filing”)
 - Provide for filing an application “by reference” to a previously filed application (aka “reference filing”)

Reference Filing

- Application may be filed “by reference” to a previously filed application.
- Reference must be in English in an application data sheet (ADS) or the PLT Model Request Form.

Reference Filing

- Applicants filing by reference should take care to ensure that the correct previously filed application is specified on the ADS or the PLT Model Request Form.
- If the wrong application is specified on ADS or the PLT Model Request Form, the specification and drawings of the wrong application will be the specification and drawings of the application filed by reference.

Application Filing Provisions

- Application filing provisions of the PLT are a safeguard against the loss of a filing date due to a technicality, *e.g.*,
 - Application missing the claims or the drawings, or
 - Copy of a previously filed application not being available for filing.
- Application filing provisions of the PLT should not be viewed as best practices.

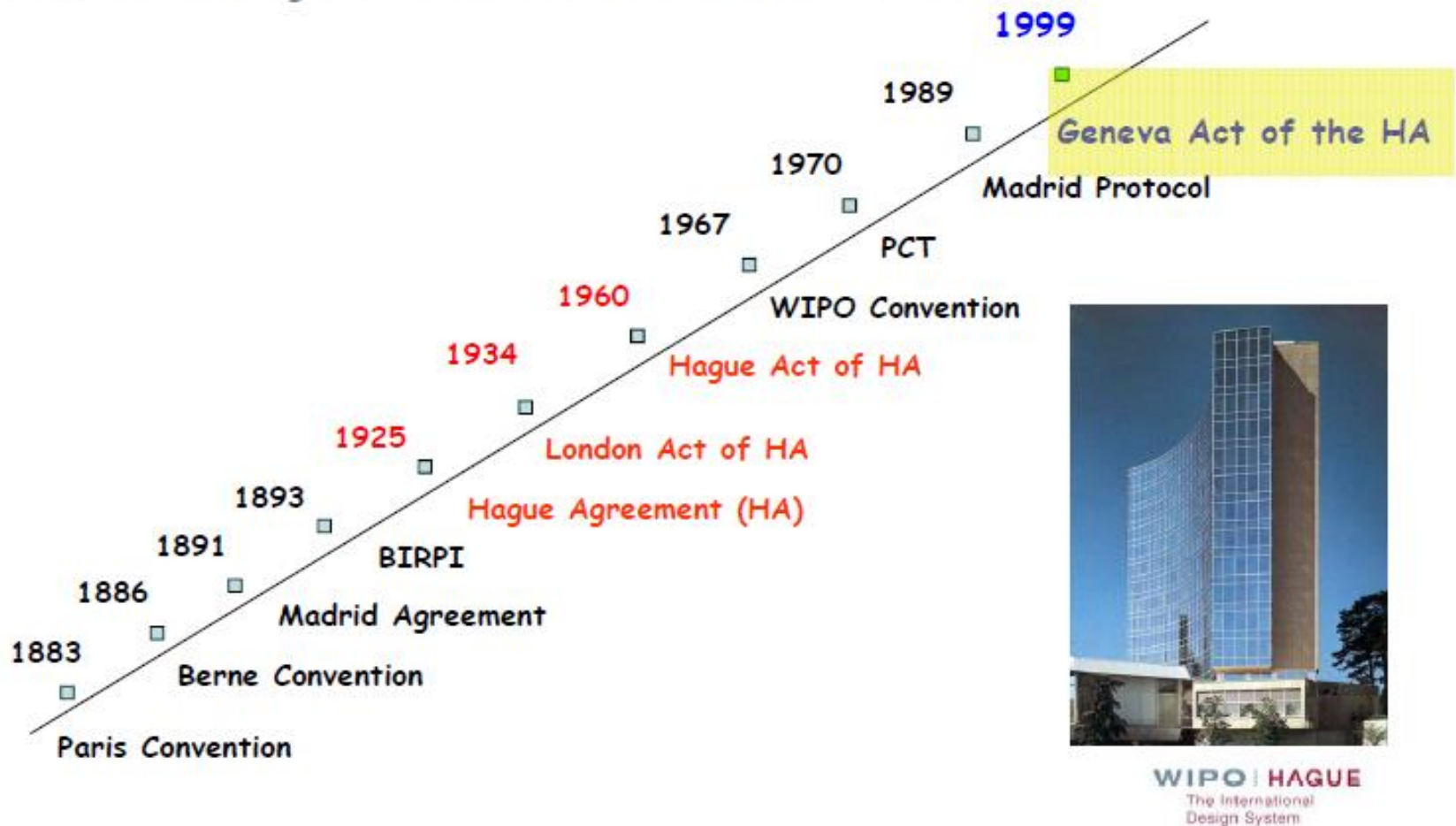
Restoration of Priority or Benefit

- PLT and PLTIA provide for restoration of:
 - Right of foreign priority in applications filed more than twelve months (six months in designs) after the filing date of the foreign application.
 - Domestic benefit of a provisional application in applications filed more than twelve months after the filing date of the provisional application.

Restoration of Priority or Benefit

- PLT and PLTIA require that the delay in filing the “subsequent” application within the priority or benefit period have been unintentional.
 - Not an “extension” of the priority or benefit period.
- PLTIA requires that the “subsequent” application have been filed within two months of the expiration of the twelve-month (six-month in designs) priority or benefit period.

Hague System and Other Major Events From 1883



What is the Hague System?

- A single international application for a single international registration (IR) in which one or more Contracting Parties (CP) are designated
- If no refusal, the resulting international registration has the effect of a grant of protection in each designated Contracting Party

...And What it is Not

- Since the Hague System is primarily a procedural arrangement, it does not determine:
 - the conditions for protection;
 - the refusal procedure to be applied when deciding whether a design may be protected; or
 - the rights which result from protection.
- Such issues are governed by the law of each Contracting Party designated in an international registration.

Filing an International Application

- Language: English, French, or Spanish
- Directly with WIPO, electronically or on paper
- Indirectly through USPTO
- Up to 100 different designs (same Locarno class)
- Single set of formal requirements apply
- Single set of international fees can be paid to WIPO (CHF)



Changes to Title 35 of the U.S.C.

- Title 35 of the United States Code (U.S.C.) is amended to provide for “**international design applications**” (**IDAs**) and treatment / examination of these IDAs.
- Chapter 38 entitled, *International Design Applications*, is added to the Title 35 of the United States Code.
 - Adds new sections 381-390 to the U.S.C.
 - Effective date: “the date of entry into force of the treaty with respect to the United States.”

Proposed Changes to Regulations (37 CFR) in NPRM

- Notice of Proposed Rulemaking published
 - 78 Fed. Reg. 71870 (November 29, 2013)
- Implements Title I of the Patent Law
Treaties Implementation Act of 2012
(PLTIA), Public Law 112-211, 126 Stat. 1527
(2012)
 - Enacted December 18, 2012

Changes to Regulations (37 CFR)

- New subpart I specific to international design applications (IDA)
 - USPTO as an office of indirect filing
 - Form and content requirements
 - National processing provisions
- Changes to various existing rules to accommodate IDAs

Additional Items

- 15 year patent term
 - Applies to patents issuing from IDAs and domestic U.S. design applications filed on or after the date of entry into force of the treaty with respect to the U.S.
 - Applies only to design applications filed on or after May 13, 2015.
- U.S. design patent rights begin upon issuance of patent

Final Rule

- The Final Rule published April 2, 2015
 - 80 FR 17918
<http://www.uspto.gov/sites/default/files/documents/80-fr-17918.pdf>
- More information can be found at
<http://www.uspto.gov/patent/initiatives/hague-agreement-concerning-international-registration-industrial-designs>

AIA Sec. 4 Inventor's Oath or Declaration

- Final Rule published August 14, 2012
 - 77 Fed. Reg. 48775
- Implements Section 4 and part of Section 20 of the Leahy-Smith America Invents Act, Public Law 112-29, 125 Stat. 284 (2011)
 - Effective September 16, 2012.

Goals

- Statutory provision and final rules aim to:
 - streamline patent application filing;
 - simplify the content requirements for an oath/declaration; and
 - offer flexibility on the timing for an oath or declaration

Dates

- Effective date: September 16, 2012
- Applicability dates:
 - Applications filed under 35 U.S.C. 111(a) and 363 on or after September 16, 2012:
 - Changes to:
 - 37 CFR 1.9, 1.12, 1.14, 1.17(g), 1.27, 1.32, 1.33, 1.36, 1.41-1.43, 1.45, 1.46, 1.53(f) and (h), 1.55, 1.56, 1.63, 1.64, 1.66, 1.67, 1.76, 1.78, 1.81, 1.105, 1.131, 1.153, 1.162, 1.172, 1.175, 1.211, 1.215, 1.321, 1.421, 1.422, 1.424, 1.431, 1.491, 1.495(a), (c) and (h), 1.497, 3.31, 3.71, 3.73, and 41.9; and
 - Removal of:
 - 37 CFR 1.47 and 1.432
 - All other changes do not depend on the application filing date (e.g., 37 CFR 1.48 and 1.324)

Definitions

- An inventor's oath or declaration includes:
 - An oath or declaration by an inventor;
 - A substitute statement for a nonsigning inventor, where appropriate, § 1.63(f) and § 1.64(d); and
 - An assignment that contains the oath or declaration statements by an inventor, § 1.63(e)(2).
- The inventor's oath or declaration refers to all the documents collectively executed by or with respect to all inventors.

Definitions (cont.)

- Juristic entity: Includes corporations or other non-human entities created by law and given certain legal rights.
- Obligated assignee: A person to whom the inventor is under an obligation to assign the invention.
- An application data sheet in accordance with § 1.76: Requires that the ADS be signed in compliance with § 1.33(b).

The Applicant

- Inventors are no longer the only possible applicants (35 U.S.C. 118, §§ 1.42(a)-(c)):
 - “Applicant” is no longer synonymous with the person who must execute the oath or declaration.
- The regulations pertaining to being applicant have been separated from the regulations pertaining to execution of the inventor’s oath or declaration.



The Applicant (cont.)

- Applicants may be persons (§§ 1.42(b), 1.46):
 - To whom the inventor has assigned;
 - To whom the inventor is under an obligation to assign; and
 - Who otherwise show sufficient proprietary interest in the matter.
- A party who has less than the entire right, title, and interest may **not** on their own make the application for patent.

The Applicant: Assignee, Obligated Assignee

- For an assignee or obligated assignee (§ 1.46(b)(1)):
 - Documentary evidence of ownership should be recorded no later than the date the issue fee is paid, for example:
 - An assignment for an assignee, or
 - An employment agreement for an obligated assignee.

The Applicant: Sufficient Proprietary Interest

- For a person who otherwise shows sufficient proprietary interest in the matter, the applicant must submit a petition including:
 - The fee set forth in § 1.17(g) (\$200);
 - A showing that such person has sufficient proprietary interest; and
 - A statement that making the application is appropriate to preserve the rights of the parties. (§ 1.46(b)(2)).

Note: Such persons are no longer restricted to situations where all the inventors refused to execute or could not be found or reached after diligent effort.



The Applicant: Applicant Data Sheet

- If an application under 35 U.S.C. 111 is made by an assignee, an obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter:
 - The application must contain an application data sheet specifying in the applicant information section:
 - The assignee;
 - Person to whom the inventor is under an obligation to assign the invention; or
 - Person who otherwise shows sufficient proprietary interest in the matter.

The Applicant: Inventor's Name

- The Office will continue to use the inventor's name for application and patent identification purposes as inventor names tend to provide a more distinct identification than assignee names.
(§ 1.5(a))

The Applicant: National Stage Applications

- The applicant for a national stage application is (§ 1.46(b)):
 - The person identified in the international stage as an applicant for the United States.

The Applicant: International Applications

- For international applications filed on/after September 16, 2012, an applicant for the purposes of the United States may be:
 - Sole or joint inventors
 - Legal representative of deceased or legally incapacitated inventor
 - Assignee
 - Obligated assignee
 - Person who otherwise shows sufficient proprietary interest
 - Proof of proprietary interest will be required in the U.S. national phase

The Applicant: Correct, Update, or Change Name

- Use is required of a § 1.76 application data sheet to (§ 1.46(c)):
 - Correct the name of the applicant where the name was originally incorrectly given;
 - Update the name of the applicant where the name of the applicant was either not supplied on filing or the name of the applicant has been updated (*e.g.*, company name change); or
 - Change the name of the applicant where there is a new applicant (*e.g.*, application is sold):
 - Requires compliance with § 3.71(b).
 - Note § 1.46 is amended effective May 13, 2015.



The Applicant: Time of Identification

- The applicant need not be identified on filing of the application.
- It is however, advisable to do so:
 - Granting a power of attorney requires that the applicant be identified so that the power can be from the applicant;
 - The Office will not require identification but may presume the identified inventors are the applicant:
 - A change in applicant would require compliance with § 3.71(b).



Grant of Patent

- Where the applicant is other than the inventor, the Office must grant the patent to the real party in interest (35 U.S.C. 118):
 - Unless notified otherwise by the time of payment of the issue fee, the Office will presume that there has been no change in the real party in interest. (§ 1.46(e))

Name of the Inventor

- 35 U.S.C. 115(a) provides that an application under 35 U.S.C. 111(a) or that commences the national stage under 35 U.S.C. 371:
 - Must include or be amended to include the name of the inventor for any invention claimed in the application.

Name of the Inventor

- Applicants may name the inventor either by use of:
 - A signed application data sheet (ADS) under § 1.76
 - If filed before or with an inventor's oath or declaration; or
 - An executed inventor's oath or declaration
 - If filed before a signed ADS identifying the inventorship.

Name of the Inventor

- To set the inventorship, the inventor's oath or declaration must both name all of the inventors and be executed by or with respect to each inventor.
- Use form AIA/08 (Declaration for Utility or Design Application) if using the declaration rather than an ADS to name the inventor, and use both AIA/08 and AIA/10 if naming joint inventors.

Name of the Inventor: Correction, or Change in Order

- Once the names of the inventors are identified via use of a signed ADS or the signed inventor's oath or declaration, a request under § 1.48 must be submitted other than in reissue applications (§ 1.48(f)) to:
 - Correct inventorship (addition or deletion);
 - Correct or update the name of an inventor (*e.g.*, misspelling, name change); or
 - Change the order of the names as they would be printed on the face of the patent taken from the ADS or oath or declaration.



Name of the Inventor: Inventorship Correction

- Where the inventorship is to be corrected in a nonprovisional application, the following must be submitted (§ 1.48(a)):
 - An application data sheet for the entire actual inventive entity that identifies each inventor by his or her legal name;
 - The processing fee under § 1.17(i)(1) (\$140/\$70/\$35);
 - The fee under § 1.17(d) (\$600/\$300/\$150) if after an Office action on the merits, unless accompanied by statement that the request to change is solely due to cancelation of claims and
 - A § 1.63 oath or declaration or substitute statement will be required for any actual inventor who has not yet executed such an oath or declaration. (§ 1.48(b))

Name of the Inventor: Requirements

- Inventorship corrections no longer require:
 - a statement regarding lack of deceptive intent; or
 - written consent of any assignee.

Name of the Inventor: Examples

- Setting inventorship:
 - Executed declaration filed with the application naming A as an inventor (preamble, § 1.41(b)):
 - Signed ADS filed a week later naming A and B as the actual inventors
 - Inventorship is set by the executed declaration which named A
 - A § 1.48 request is required to correct inventorship to A and B

Name of the Inventor: Examples

- Executed declaration on filing naming A as an inventor without an ADS:
 - Executed declaration filed a week later naming B as an inventor
 - Inventorship is set by the executed declaration that named A
 - A § 1.48 request is required to correct inventorship if the actual inventorship is other than A, *e.g.*, A and B or B alone.

Name of the Inventor: Recap

- Where the inventor's oath or declaration is supplied on filing of the application, applicant must either:
 - Set forth the entire inventive entity in each oath or declaration; or
 - Supply an application data sheet (ADS) naming the entire inventive entity where the oath or declaration only identifies the executing inventor. § 1.63.
- Where applicant delays submission of an inventor's oath or declaration:
 - Applicant will need to identify the inventive entity (name, residence and mailing address) in an ADS under § 1.76.
 - The ADS may be submitted on filing or in response to a notice to file missing parts.



Inventor's Oath or Declaration

- An inventor's oath or declaration continues to be required (35 U.S.C. 111(a)(2) and 35 U.S.C. 371(c)) and can be supplied as follows:
 - Inventor executes an oath or declaration under § 1.63(a) (35 U.S.C. 115(a)):
 - Filed in the application;
 - Inventor executes an assignment that contains the statements required by § 1.63 (35 U.S.C. 115(e) and § 1.63(e)):
 - Recorded in the Office's assignment database;



Inventor's Oath or Declaration

- A substitute statement can be submitted where an inventor is deceased, legally incapacitated, cannot be found or reached after diligent effort, or refuses to execute, (35 U.S.C. 115(d), § 1.64).
 - An applicant other than an inventor, *e.g.*, an assignee-applicant, cannot file a substitute statement unless one of the above enumerated conditions is met.

Inventor's Oath or Declaration

- Where an exception exists to an inventor executing the oath or declaration, the following parties may execute a substitute statement:
 - For an inventor who refused to execute or cannot be found after diligent effort:
 - An assignee;
 - A party to whom the inventor is under an obligation to assign;
 - A party who otherwise shows sufficient proprietary interest in the matter; or
 - The other joint inventor or inventors.
 - For a deceased or legally incapacitated inventor:
 - The same parties as above, except other inventors; or
 - The legal representative.

Inventor's Oath or Declaration: Time of Submission

- The submission of an inventor's oath or declaration, including a substitute statement, or assignment containing the required statements, may be postponed until the application is otherwise in condition for allowance (§ 1.53(f)(3)) provided:
 - The application is an original non-reissue application
 - An application data sheet under § 1.76 is earlier submitted:
 - Identifying each inventor by his or her legal name; and
 - Providing a mailing address (where mail is customarily received), and residence for each inventor.
- A surcharge will still be required (35 U.S.C. 111(a)(3) and 371(d)).



Inventor's Oath or Declaration: Time of Submission

- The Office will not send a Notice to File Missing Parts of Application where the required fees have been paid, but the inventor's oath or declaration has not been submitted (§ 1.53(f)(3)(ii)):
 - A Notice to File Missing Parts of Application will be sent requiring an ADS or inventor's oath or declaration where neither has been filed with the application.



Inventor's Oath or Declaration: Time of Submission

- Applicants should continue to exercise reasonable diligence in ascertaining the actual inventorship.
- The Office recommends that applicants continue to provide the inventor's oath or declaration on filing or shortly thereafter.
- The longer the delay, the more difficult it may be to obtain an inventor's signature.



Inventor's Oath or Declaration: Time of Submission

- Under 35 U.S.C. 371:
 - Entry into the national stage no longer requires submission of the inventor's oath or declaration. (§ 1.491(b))

Inventor's Oath or Declaration: Time of Submission

- The applicant must file each required oath or declaration (§ 1.63) or substitute statement (§ 1.64), no later than the issue fee payment.
 - A Notice of Allowability (PTOL-37), will notify applicants if an oath or declaration, or substitute statement with respect to each named inventor has not been received:
 - The time period set in a Notice of Allowability is not extendable.



Inventor's Oath or Declaration: Requirements

- Must contain statements (35 U.S.C. 115(b), § 1.63(a)):
 - Application was made or was authorized to be made by the person executing the oath or declaration.
 - The person executing the oath or declaration believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

Inventor's Oath or Declaration: Requirements

- Must Identify:
 - The application to which it is directed.
 - At least the inventor who is executing the oath or declaration by his or her legal name.
- A claim for foreign priority under § 1.55(a)(1)(i) must be set forth in an application data sheet:
 - Presence of the priority claim in the oath or declaration will not be recognized.



Inventor's Oath or Declaration: Requirements

- The entire inventive entity and the mailing address for each inventor need not be identified (§ 1.63(b)):
 - If a signed ADS, § 1.76, is used to identify each inventor with his or her legal name and a mailing address for each inventor is given.

Inventor's Oath or Declaration: Requirements

- Residence and mailing address:
 - Mailing address is clarified to mean where an inventor customarily receives mail:
 - Includes where the inventor works, or a post office box, preamble § 1.63(b).
- No longer required:
 - Identification of an inventor's citizenship
 - That the inventor believes himself or herself to be the "first" inventor.

Inventor's Oath or Declaration: Requirements

- The oath or declaration is no longer required to state that the person making the oath or declaration:
 - acknowledges the duty of disclosure under § 1.56, and
 - has reviewed and understands the contents of the application.
- However, § 1.63(c) requires that a person may not execute an oath or declaration unless the person: (1) is aware of the duty to disclose all information known to be material to patentability, and (2) has reviewed and understands the contents of the application.

Inventor's Oath or Declaration: Requirements for Declaration

- Penalty clause has changed:
 - Requires an acknowledgement (35 U.S.C. 115(i), § 1.63(g)):
 - Any willful false statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.
- Eliminates the statement that all statements are true and that all statements made on information and belief are believed to be true.

Inventor's Oath or Declaration: Requirements: Alterations

- Interlineation, erasure, cancellation, or other alteration to application papers may be made before or after signing of the oath or declaration (§ 1.52(c)):
 - Provided the statements made in the oath or declaration remain applicable to the altered application papers, *e.g.*,:
 - Correction of obvious typographical errors.
- Note: A substitute specification may be required.

Inventor's Oath or Declaration: Requirements

- National Stage applications:
 - Requirements for the inventor's oath or declaration are set forth in § 1.497
 - § 1.497(b) sets forth minimum requirements to satisfy 35 U.S.C. 371(c)(4)
 - Important for PTA 14-month trigger (35 U.S.C. 154(b)(1)(A)(i)(II))
 - Must still comply with requirements of § 1.63 (§1.497(a) and (c))

Substitute Statement: Requirements

- Comply with the requirements of § 1.63(a);
- Identify the inventor with respect to whom the statement applies;
- Identify the person executing the substitute statement and the relationship to the nonsigning inventor;
- Identify the permitted basis:
 - Whether the inventor is deceased, legally incapacitated, cannot be found after diligent effort or refuses to execute.
- Contain the acknowledgement of penalties clause. (§ 1.64(e))



Substitute Statement: Requirements

- Unless supplied in an application data sheet, § 1.76:
 - The legal name of each inventor; and
 - Last known mailing address and residence of:
 - The person executing the substitute statement, and
 - Of the nonsigning inventor, unless deceased or legally incapacitated.

Substitute Statement: Requirements

- A person may not execute a substitute statement unless that person:
 - Has reviewed and understands the contents of the application, including the claims; and
 - Is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

Substitute Statement: Requirements

- A petition is not required for an assignee or an obligated assignee to be considered the applicant or to execute the substitute statement:
 - A petition is required for a person who otherwise shows sufficient proprietary interest in the matter.
 - Proof of a refusal to execute or that the inventor cannot be found or reached after diligent effort is no longer required.

Substitute Statement: Publication of Application

- The Office will no longer publish notice in the *Official Gazette* of the filing of an application by parties other than the inventor, except where:
 - An application is filed by a person who otherwise shows sufficient proprietary interest in the matter. (§ 1.14(f))

Substitute Statement: Joining of Nonsigning inventor

- A nonsigning inventor may subsequently join in the application by submitting an oath or declaration (§ 1.64(f)):
 - Such submission will not permit the nonsigning inventor or legal representative to revoke or grant a power of attorney.

Assignment-Statements

- An assignment may also serve as an oath or declaration under § 1.63 if the assignment as executed:
 - Includes the information and statements required in § 1.63(a) and (b); and
 - A copy of the assignment is recorded in the Office's assignment database. (§ 1.63(e)(1)(ii))

Assignment-Statements: Paper Submissions

- For a paper submission of a dual purpose assignment along with an application:
 - Utilize a conspicuous indication on the assignment cover sheet (§ 3.31):
 - So the Office will know to scan the assignment into the application file before forwarding the assignment for recording to the Assignment Recordation Branch.

Assignment-Statements: EFS-Web Submissions

- EFS-Web does not accept assignments for recording purposes. (See the EFS-Web Legal Framework, section B2.)
- For an EFS-Web submission of a dual purpose assignment, either with or after an application has been filed, the Office:
 - Will place the assignment in the application file; but
 - Will not forward the assignment to Assignment Recordation Branch for recordation.

Assignment-Statements: EPAS

- Recording of assignments may only be done electronically in EPAS (Electronic Patent Assignment System).
- For EPAS submissions of a dual purpose assignment:
 - If there is a conspicuous indication on the cover sheet (*e.g.*, check-box is used), the Office will place a copy of the assignment in the related application file.

Continuing Applications: Copy of Oath or Declaration

- A copy of an inventor's oath or declaration, including a substitute statement or assignment-statement, from a prior application in a benefit chain under 35 U.S.C. 120, 121, or 365(c) in compliance with § 1.78:
 - may be used in continuing applications, including continuation-in-part applications.
(35 U.S.C. 115(g)(1), § 1.63(d))
 - the prior oath or declaration must, however, be compliant with amended 35 U.S.C. 115(a).
(35 U.S.C. 115(g)(1)(A))
- Any new joint inventor must provide an oath or declaration. (§ 1.63(d)(3))

Continuing Applications: Inventorship

- The inventorship in a continuing application filed under 35 U.S.C. 111(a) is (§ 1.63(d)(2)):
 - That specified in an ADS filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application; or
 - What is set forth in the copy of the oath or declaration if there is no ADS, unless
 - The copy is accompanied by a statement signed pursuant to § 1.33(b) stating the name of each inventor in the continuing application.

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)

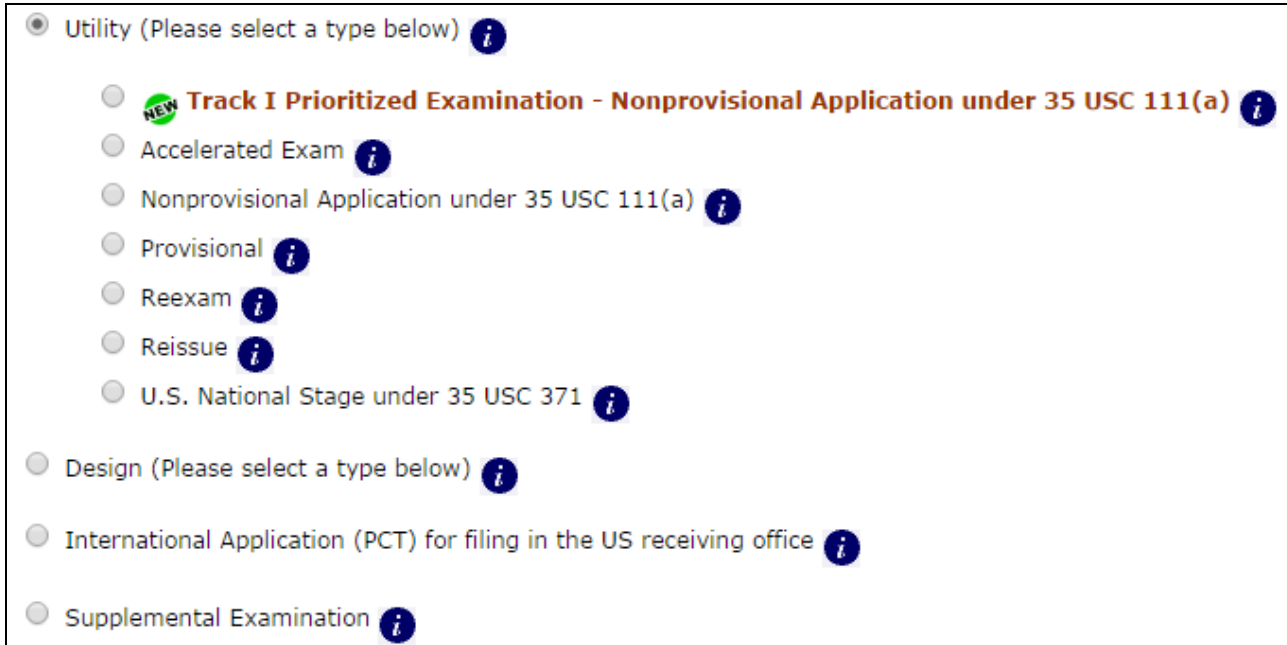
Pre-Examination Tips: Preliminary Amendments

- Avoid submitting Preliminary Amendments on filing*
 - instead, make edits before filing the application
- A substitute specification will be required if a preliminary amendment present on filing makes any changes to the specification, except for:
 - changes to title, abstract, or claims or addition of benefit claim information to the specification

*see the notice "Revised Procedure for Preliminary Amendments Presented on Filing of a Patent Application," 1300 Off. Gaz. Pat. Office 69 (November 8, 2005), available at <http://www.uspto.gov/web/offices/com/sol/og/2005/week45/patrevs.htm>

Filing the Application: EFS-Web

- Properly identify new application filings



The screenshot shows a web form for selecting an application type. The first section is "Utility (Please select a type below)" with a list of options: "NEW Track I Prioritized Examination - Nonprovisional Application under 35 USC 111(a)", "Accelerated Exam", "Nonprovisional Application under 35 USC 111(a)", "Provisional", "Reexam", "Reissue", and "U.S. National Stage under 35 USC 371". The second section is "Design (Please select a type below)" with options: "International Application (PCT) for filing in the US receiving office" and "Supplemental Examination". Each option has a radio button and an information icon.

☒ Utility (Please select a type below) *i*

- ☐ **NEW** Track I Prioritized Examination - Nonprovisional Application under 35 USC 111(a) *i*
- ☐ Accelerated Exam *i*
- ☐ Nonprovisional Application under 35 USC 111(a) *i*
- ☐ Provisional *i*
- ☐ Reexam *i*
- ☐ Reissue *i*
- ☐ U.S. National Stage under 35 USC 371 *i*

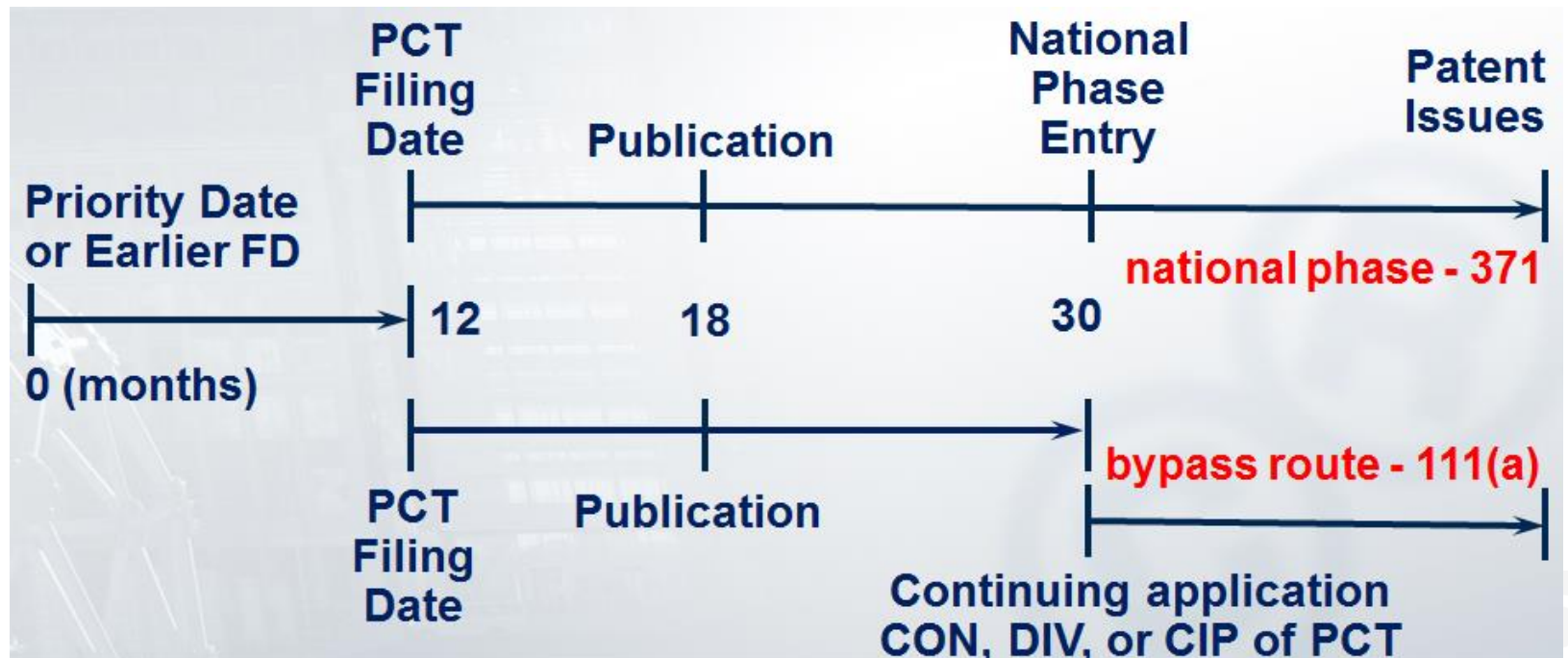
☐ Design (Please select a type below) *i*

- ☐ International Application (PCT) for filing in the US receiving office *i*
- ☐ Supplemental Examination *i*

- If submitted, color drawings must be of sufficient quality for details to be reproducible in black and white for publication
- scanned documents should have a resolution no lower than 300 dots per inch (dpi)

Filing a U.S. National Application from an International Application

- Two filing routes
 - National Stage application filed under 35 U.S.C. 371
 - “Bypass” application filed under 35 U.S.C. 111(a)
 - domestic benefit is claimed to the PCT under 35 U.S.C. 120 or 121



Benefits of Filing Under 35 U.S.C 371

- Applicant usually only needs to
 - identify the submission as a filing under 35 U.S.C. 371 and
 - provide the basic national fee
- International Bureau provides copies of
 - published international application
 - international search report
 - certified copies of foreign priority documents
 - international preliminary report on patentability (Chapter I or II)
- Unity of invention is used to determine whether an application contains more than one invention

Benefits of Filing a Bypass Application

- File an idiomatic translation of a non-English PCT
 - rather than a literal translation, as required under § 371
- Add subject matter to the disclosure
 - the application may be a Continuation-in-Part of the international application
- Take advantage of an extension of time to pay fees
 - unlike a application filed under § 371, where the basic national fee must be paid by the entry deadline
- Directly incorporate Article 19 or 34 amendments
 - avoids extensive amendments to the application
- Use of Prioritized Examination, Track 1
 - accelerated examination with about 12 months to final disposition



Post-Filing: Pre-Grant Publication Tips

A Pre-Grant Publication may include amendments to the claims, abstract and drawings, but it will not include amendments to the specification unless submitted as a substitute specification.

- Filing a clean copy of the specification, claims, abstract, drawings and application data sheet in accordance with 37 CFR 1.215(c) will insure that the amendments will be included in the publication.
 - *After filing the application and receiving the confirmation number, submit the clean copy of specification, claims, abstract, drawings and ADS via EFS-Web using the radial button "Pre-Grant Publication under 37 CFR 1.211 to 1.221"*
- Filing a substitute specification including all of the amendments after entering the national stage may be used to generate the Pre-Grant Publication.

Post-Filing: Publication Corrections

- Practitioners should include the assignment information in the ADS
 - to assure publication contains this information
- Review the filing receipt promptly
 - request corrections before publication or export of data for publication
- When requesting Corrected Publication, be sure to indicate the material mistake(s) made by the Office
 - *e.g.*, a mistake affecting the public's ability to
 - to appreciate the technical disclosure of the patent application
 - determine the scope of the provisional rights sought
 - see 37 CFR 1.221(b) and MPEP § 1130

Application Data Sheets

- Clarified that an Application Data Sheet (ADS) may be submitted in a national stage application under 35 U.S.C. 371 (as well as in provisional and nonprovisional applications under 35 U.S.C. 111).
- If an application under 35 U.S.C. 111 is made by a person other than the inventor under § 1.46(a), an ADS must be submitted specifying the applicant in the Applicant Information section. (PTO/AIA/14)

Priority and Benefit Claims

- A claim for foreign priority under § 1.55(a)(1)(i) must be set forth in an ADS:
 - Presence of the priority claim in the oath or declaration will not be recognized.
- A claim for domestic benefit under § 1.78 must be set forth in an ADS:
 - Presence of the benefit claim in the first sentence(s) of the specification will not be recognized.

Application Data Sheets

- Correcting or updating information is done by an ADS with markings (§ 1.76(c)(1)):
 - Such an ADS is no longer considered or called a “Supplemental ADS.”
- 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, except for an initial 35 U.S.C. 371 submission:
 - Underlining for insertions, strike-through or brackets for deletions.

Application Data Sheets

- An ADS must be signed by applicant or a patent practitioner (§ 1.76(e)):
 - If unsigned, treated only as a transmittal letter.
- The most recent ADS will govern with respect to foreign priority (§ 1.55) or domestic benefit (§ 1.78) claims.
- The naming of inventorship is governed by § 1.41:
 - With changes thereto governed by § 1.48.
- A properly executed ADS may now include an Authorization to Permit Access to Application by Participating Offices.

Tips for Application Data Sheets

- Prior to filing an ADS, double check the listing of domestic benefit and/or foreign priority information (priority and benefit information is required to be in an ADS for applications filed on or after September 16, 2012)
 - Typos in application numbers
 - Incorrect filing dates
 - Wrong relationship type (*e.g.*, CON vs. CIP, etc.)

Tips for Application Data Sheets

- Be sure to indicate the correct relationship and order of the domestic benefit applications listed on the ADS. If the order is incorrect, then the Office of Patent Application Processing (OPAP) may not accurately capture the entire benefit claim.
 - An example of an incorrect relationship is misidentifying a 111(a) CON of a 371 national stage entry of the PCT application
 - Another example is non-specific relationship identifiers (*e.g.*, “Continuing” is non-specific; must be Continuation, Divisional or CIP).
- 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).



Tips for Application Data Sheets

- Foreign priority and domestic benefit claims in applications filed on or after September 16, 2012 **MUST** appear in an ADS. See 37 CFR 1.55 for foreign priority claims and 37 CFR 1.78 for domestic benefit claims.
- Make sure the ADS is properly signed.
- Check the filing receipt promptly to ensure that information captured by the Office is correct.

Filing Receipt



UNITED STATES PATENT AND TRADEMARK OFFICE

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	GRP ART UNIT	FIL FEE REC'D	ATTY DOCKET NO	TOT CLAIMS	IND CLAIMS
59/956,507	02/03/2014	3773	1260	45456-0102	12	1

CONFIRMATION NO. 7285

12346

FILING RECEIPT



*OC00000057605684

Inventor(s)

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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.

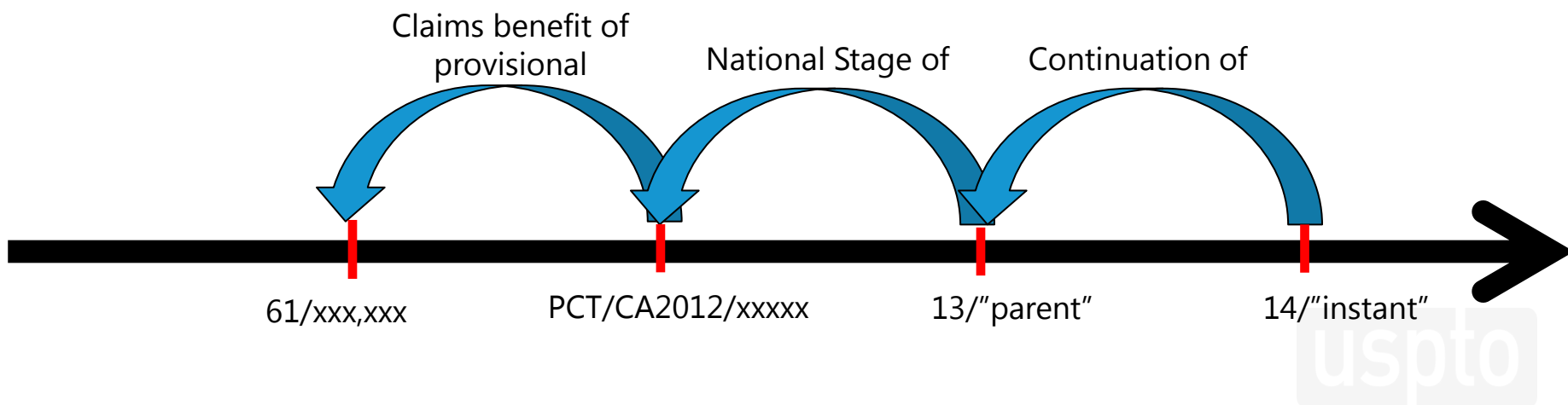
**Domestic Benefit
Data**

**Foreign Priority
Data**

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/xxxxx, 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:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this 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 blank.

Prior Application Status	Pending	Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/"parent"	2013-11-19
Prior Application Status		Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
Prior Application Status		Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.

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:			
This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this 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 blank.			
Prior Application Status	Pending	Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/"parent"	2013-11-19
Prior Application Status		Remove	

No
Relationship
to instant
application



Domestic Benefit/National Stage Information:			
This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this 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 blank.			
Prior Application Status	Pending	Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/ "parent"	Continuation of		2013-11-19
Prior Application Status		Remove	

Tips for Application Data Sheets

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:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this 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 blank.

Prior Application Status	Pending	Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/"parent"	2013-11-19
Prior Application Status	Pending	Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/"parent"	a 371 of international	PCT/CA2012/XXXXX	2012-05-16
Prior Application Status		Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.

Tips for Application Data Sheets

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.

Prior Application Status	Pending	Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/"parent"	2013-11-19
Prior Application Status	Pending	Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/"parent"	a 371 of international	PCT/CA2012/XXXXX	2012-05-16
Prior Application Status		Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)

These blanks will be read as "this application is" which is inappropriate because the instant application is not directly related to both applications.

Prior Application Status	Pending	Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/"parent"	2013-11-19
Prior Application Status	Pending	Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	a 371 of international	PCT/CA2012/XXXXX	2012-05-16
Prior Application Status		Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)

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.

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this 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 blank.

Prior Application Status	Pending	<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/"parent"	2013-11-19
Prior Application Status	Pending	<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/"parent"	a 371 of international	PCT/CA2012/XXXXX	2012-05-16
Prior Application Status	Expired	<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
PCT/CA2012/XXXXX	Claims benefit of provisional	61/XXX,XXX	2011-05-17

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.

Tips for Application Data Sheets

- A corrected ADS (for applications filed on or after September 16, 2012) must be marked up as set forth in 37 CFR 1.76(c).
- A corrected ADS showing changes relative to the information of record is required regardless of whether an ADS has been previously filed or not.
- The corrected ADS will not be processed unless markings showing the changes are provided.
- For more information on a corrected ADS see MPEP 601.05(a).

Tips for Application Data Sheets

Scenario for correcting an ADS:

Initial filing receipt shows no domestic benefit claims because they were incorrectly entered on the initial ADS. The initial ADS contained the following information:

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this 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 blank.

Prior Application Status		<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Claims benefit of	13/"parent"	2013-11-19
Prior Application Status		<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/"parent"	a 371 of international	PCT/CA2012/XXXXXX	2012-05-16
Prior Application Status		<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
PCT/CA2012/XXXXXX	Continuation of	61/XXX,XXX	2011-05-17

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.

Tips for Application Data Sheets

Scenario for correcting an ADS:

Initial filing receipt shows no domestic benefit claims because they were incorrectly entered on the initial ADS. An appropriate and timely, **corrected ADS** with markings to show changes relative to the information of record, as shown below, will be effective.

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this 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 blank.

Prior Application Status		<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	<u>Continuation of</u>	<u>13/"parent"</u>	<u>2013-11-19</u>
Prior Application Status		<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
<u>13/"parent"</u>	<u>a 371 of international</u>	<u>PCT/CA2012/XXXXX</u>	<u>2012-05-16</u>
Prior Application Status		<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
<u>PCT/CA2012/XXXXX</u>	<u>Claims benefit of provisional</u>	<u>61/XXX,XXX</u>	<u>2011-05-17</u>

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.

Tips for Application Data Sheets

Scenario for correcting an ADS:

Where information of record is being changed, the ADS should identify the information being deleted with strike-through or brackets, and should identify the information being added with underlining.

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this 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 blank.

Prior Application Status			<input type="button" value="Remove"/>
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of Division of	13/"parent"	2013-11-19
Prior Application Status			<input type="button" value="Remove"/>
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/"parent"	a 371 of international	PCT/CA2012/XXXXXX	2012-05-16
Prior Application Status			<input type="button" value="Remove"/>
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
PCT/CA2012/XXXXXX	Claims benefit of provisional	61/XXX,XXX	2011-05-17

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.

Tips for Application Data Sheets

- A corrected ADS should be accompanied by a properly identified/indexed paper requesting action, such as,
 - a **request for a corrected filing receipt** or
 - a request to correct inventorship (§ 1.48 request)
 - a request to change the applicant (under § 1.46(c))
- Information regarding proper indexing of papers can be found at the following three web sites:

http://www.uspto.gov/ebc/portal/efs/rules_doc_codes.htm

<http://www.uspto.gov/patents/process/file/efs/guidance/EFS-WebQuickStartGuide.pdf>

<http://www.uspto.gov/ebc/portal/efs/cbt/efs-web-training.ppt>

Tips for Application Data Sheets

Helpful hints for providing new or corrected information in an ADS:

- Where new or corrected information is being provided, the ADS may include all of the sections, or only those sections that contain the new or corrected information. The ADS must identify the application to which it is directed.
- The sections that contain new or corrected information must include **all** of the information of record for that section.
 - Example 1: A request to correct inventorship is being filed to add a sixth inventor. The Inventor Information section of the ADS must set forth all five current inventors and their information, and the new sixth inventor and his/her information must be shown with underlining.
 - Example 2: A review of the filing receipt reveals that a benefit claim to a provisional application made in the great-grandparent nonprovisional application was not set forth in the original ADS. The Domestic Benefit Claim section of the ADS must set forth the complete benefit claim chain of record, and the claim to the provisional application must be underlined in its entirety.
- Use of the Office's form (AIA/14) is not required. An ADS with new or corrected information can be created in word processing software, if desired. The ADS document must identify the application, contain appropriate markings, and be signed.



“Take Home”



- Make sure the information in the filing receipt you receive is correct. In particular, check your filing receipt promptly to make sure that:
 - all domestic benefit and/or foreign priority claims have been accurately captured and
 - the presence or absence of a § 1.55/1.78 statement has been accurately captured.
- If any information you provided on the ADS was not accurately captured by the USPTO, file a request for a corrected filing receipt.
- If review of the filing receipt and the ADS identifies applicant errors, file both:
 - a request to correct the filing receipt and
 - a corrected ADS

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 Office's web site:

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/sigexamples_alt_text.pdf



S-Signatures – 5 Requirements

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).

– **Only the signer can insert his or her own signature:**

- a secretary, paralegal, etc., is not permitted to sign/insert another person's signature, *e.g.*, a practitioner's or inventor's signature, and
- a practitioner is not permitted to sign/insert an inventor's signature or another practitioner's signature.

S-Signatures – 5 Requirements

37 CFR 1.4(d)(2)

- 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.

The name of the person signing may be inserted by someone other than the person signing, but the person signing must personally insert the S-Signature.

A secretary, paralegal, etc., may type the name of the person signing at any time (*e.g.*, before or after the person signing inserts his or her own signature).

- 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***



Examples Where S-Signatures Can Be Used

- S-Signatures may be used for correspondence being filed in the Office for patent applications, patents and reexamination proceedings.
- A practitioner creates a document and S-signature signs it on his/her PC. The practitioner can then:
 - Facsimile transmit the document directly from the PC to the Office;
 - File the document via EFS-Web; or
 - Print the document and then facsimile transmit, mail, or hand-carry the document to the Office
- An affidavit under § 1.132 is S-signed by the party making the affidavit, the S-signed affidavit is then:
 - Electronically sent to the practitioner, e.g., via an e-mail. The practitioner can then facsimile transmit, mail or hand-carry the S-signature signed document to the Office, in addition to filing via EFS-Web.
- S-Signatures may not be used for papers submitted to the Office of Enrollment & Discipline [§ 1.4\(e\)](#).



Name Requirement for S-Signatures

- There is no requirement that the signer's actual, full or legal name be used.
 - It is strongly suggested that the full name be used for both;
 - The typed or printed name below the signature must be reasonably specific enough so that the identity of the signer can be readily recognized (§ 1.4(d)(2)(iii)(B)).
- Titles may be included as part of the signature.
- Changes in S-signature (different papers or different applications) are not recommended (§ 1.4(h)).
 - Example: An s-signature that includes the attorney docket number for that application would not be a consistent signature.

Questionable Signatures

- Ratification, confirmation or evidence of authenticity of a signature may be required where the Office has:
 - Reasonable doubt as to its authenticity,
 - Where the signature and typed or printed name do not clearly identify the person signing.
- The failure to follow the S-signature format and content requirements will usually be treated as a bona fide attempt, but will cause the paper to be treated as unsigned with differing results, *e.g.*:
 - Amendments would receive a new 1-month time period
 - § 1.63 declarations would receive a two month time period and a surcharge may be imposed.

Certification Requirements

37 CFR 1.4(d)(4)

Certification Requirement

- A. For another's signature:** A person submitting a document signed by another under § 1.4(d)(2):
- is obligated to have a reasonable basis to believe that the person whose signature is present on the document actually inserted that signature, and
 - should retain evidence of authenticity of the signature.
- B. For your own signature:** The person inserting a signature under § 1.4(d)(2) in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature.

Violations of the signature certifications may result in the imposition of sanctions under §§ 10.18(c) and (d).

Power of Attorney

37 CFR 1.32(b)

For patent applications filed before September 16, 2012, 37 CFR 1.32(b) sets forth power of attorney requirements:

- Must be in writing,
- Name one or more representatives in compliance with § 1.32(c),
- Give the representative power to act on behalf of the principal, and
- Be signed by the applicant for patent (§ 1.41(b)) or the assignee of the entire interest of the applicant.

Power of Attorney

37 CFR 1.32(b)

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.

Acting in a Representative Capacity 37 CFR 1.34

A registered patent attorney or patent agent not of record but acting in a representative capacity must specify his/her:

- Registration number
- Name
- Signature

Acting in a Representative Capacity 37 CFR 1.34

A person acting in a representative capacity may not sign:

- A power of attorney;
- A document granting access to an application unless
 - For an application filed before 9/16/12, an executed declaration has not been filed, and the practitioner was named in the papers accompanying the application papers, or
 - For an application filed on or after 9/16/12, the practitioner is named in the papers accompanying the application papers, and no power of attorney has been appointed;
- A change in correspondence address except where an executed oath/declaration has not been filed and the practitioner filed the application (37 CFR 1.33(a)(1)), unless the patent has issued (37 CFR 1.33(g);
- A terminal disclaimer; or
- A request for an express abandonment without filing a continuing application.



Power of Attorney by the Inventor

- Use the PTO/SB/81 form.
- If a power of attorney is signed by less than all the inventors/owners, it must be accompanied by a petition under 37 CFR 1.183, unless the application is proceeding under 37 CFR 1.42, 1.43 or 1.47.
- Different Customer Numbers can be used for power of attorney and correspondence address.
- Power of attorney cannot be given to both attorneys associated with a Customer Number and specific practitioners.
- If the inventor dies, power of attorney terminates.
- The legal representative can give power of attorney.

Power of Attorney by the Assignee

- Execute a single PTO/SB/80 form.
 - It is general POA, and it will be effective for any/all of assignee's applications in which it is filed.
- Use PTO/SB/96 form (Statement under 37 CFR 3.73(b)) to establish assignee ownership and the right of the assignee to take action in a specific application.
 - Indicate the reel and frame where the chain of title documents have been recorded in the Office; or Append a copy of title document(s) and check the box that documentary evidence has been, or is currently being, submitted (separately) for recordation to the Assignment Division.
- Give specific authority to an appointed practitioner to act on behalf of the assignee.
 - Practitioner must be given authority to bind the assignee entity. This can be accomplished in a separate document signed by the assignee (client) that is retained in the practitioner's files. Then, a PTO/SB/96 can be completed and signed by the practitioner for each specific application, rather than having the assignee sign a PTO/SB/96 for each application.

Powers of Attorney

- Must be signed by the applicant for patent (§ 1.42) or the patent owner.
 - An assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest in the matter applying for the patent may sign the power of attorney (no § 3.73(c) statement must be filed).
- Inventors who are not the applicant may not sign the power of attorney.
- A combined inventor declaration and power of attorney should not be used.

Powers of Attorney: From Inventors

- The grant of a request to correct the inventorship by addition of an inventor results in loss of any power of attorney given by the prior inventors unless (§ 1.32(e)):
 - The added inventor provides a power consistent with the power granted by the originally named inventors.
- Where an added inventor does not provide a power of attorney:
 - A practitioner may act in a representative capacity under § 1.34, if applicable.



Powers of Attorney: Copies from Prior Applications

- The power of attorney from a prior national application may have effect in a continuing application claiming benefit to the prior application if a copy of the power is provided in the continuing application, unless:
 - The power in the prior application was granted by the inventor, and
 - The continuing application names an inventor who was not named as an inventor in the prior application.



Powers of Attorney: Prosecution by Assignee

- The assignee of the entire right, title and interest, or partial assignees and inventors who have not assigned who together own the entire right title and interest, may conduct prosecution of a (§ 3.71(a)):
 - National patent application as the applicant under § 1.46;
 - Supplemental examination; or
 - Reexamination proceeding.

Powers of Attorney: Prosecution by Assignee

- An assignee who is the original applicant need not resort to §§ 3.71 and 3.73 to conduct prosecution, such as by appointing a power of attorney.
- An assignee who is not the original applicant must comply with § 1.46(c) to become the applicant and establish its ownership pursuant to § 3.73(c):
 - If more than one assignee exists, each assignee either:
 - Establishes its extent of ownership (by percentage), or
 - Submits a statement identifying the parties who together own the entire right, title and interest.



Powers of Attorney: Prosecution by Assignee

- If two purported assignees file conflicting statements under § 3.73(c), the Director will determine which, if any, will be permitted to control prosecution of the application.
- The submission establishing ownership must be signed by a person authorized to act on behalf of the assignee:
 - For patent matters only, a submission signed by a practitioner of record is now identified as also acceptable. (§ 3.73(d)(3))



Powers of Attorney: Prosecution by Assignee

- The power of attorney by assignee must be signed by either:
 - A person having a title that carries apparent authority (*e.g.*, "President," or in foreign countries "Manager" or "Director")
 - A person who makes a statement of authorization to act.
- A power of attorney to a practitioner does not empower the practitioner to sign the submission on behalf of the assignee.
- See MPEP § 325, V. Party Who Must Sign.



Powers of Attorney: USPTO Forms

- There are three power forms for use in patent applications filed on or after 9/16/12:
 - PTO/AIA/82 (power of attorney by applicant)
 - PTO/AIA/81 (power of attorney to one or more joint inventors)
 - PTO/AIA/80 (power of attorney by assignee who is becoming the applicant under § 1.46(c))
- Information about the new powers is available on the USPTO web site at:
http://www.uspto.gov/forms/guid_aia-poa.pdf



Powers of Attorney: AIA/82

- The AIA/82 has three pages, AIA/82A, AIA/82B and AIA/82C.
- AIA/82A is the transmittal that identifies the application to which the power is directed and may be signed by the applicant or a patent practitioner (§ 1.33).

Doc Code: PA...
Document Description: Power of Attorney

PTO/AIA/82A (07-12)
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.

TRANSMITTAL FOR POWER OF ATTORNEY TO ONE OR MORE REGISTERED PRACTITIONERS			
NOTE: This form is to be submitted with the Power of Attorney by Applicant form (PTO/AIA/82B or equivalent) to identify the application to which the Power of Attorney is directed, in accordance with 37 CFR 1.5. If the Power of Attorney by Applicant form is not accompanied by this transmittal form or an equivalent, the Power of Attorney will not be recognized in the application.			
Application Number			
Filing Date			
First Named Inventor			
Title			
Art Unit			
Examiner Name			
Attorney Docket Number			
SIGNATURE of Applicant or Patent Practitioner			
Signature		Date	
Name		Telephone	
Registration Number			
NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications.			
<input type="checkbox"/> *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 to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Powers of Attorney: AIA/82B

- AIA/82B is the power of attorney by applicant. It must be accompanied by a transmittal letter (AIA/82A or equivalent) that identifies the patent application to which the power is directed.

Doc Code: PA..

Document Description: Power of Attorney

PTO/AIA/82B (07-13)

Approved for use through 11/30/2014. OMB 0651-0051
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

POWER OF ATTORNEY BY APPLICANT

I hereby revoke all previous powers of attorney given in the application identified in either the attached transmittal letter or the boxes below.

Application Number	Filing Date

(Note: The boxes above may be left blank if information is provided on form PTO/AIA/82A.)

☐ I hereby appoint the Patent Practitioner(s) associated with the following Customer Number as my/our attorney(s) or agent(s), and to transact all business in the United States Patent and Trademark Office connected therewith for the application referenced in the attached transmittal letter (form PTO/AIA/82A) or identified above:

OR

☐ I hereby appoint Practitioner(s) named in the attached list (form PTO/AIA/82C) as my/our attorney(s) or agent(s), and to transact all business in the United States Patent and Trademark Office connected therewith for the patent application referenced in the attached transmittal letter (form PTO/AIA/82A) or identified above. (Note: Complete form PTO/AIA/82C.)

Please recognize or change the correspondence address for the application identified in the attached transmittal letter or the boxes above to:

☐ The address associated with the above-mentioned Customer Number

OR

☐ The address associated with Customer Number:

OR

Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone			Email		

Powers of Attorney: AIA/82B

- AIA/82B must be signed by the applicant. If there are multiple applicant parties, submit one form signed by each party.

I am the Applicant (if the Applicant is a juristic entity, list the Applicant name in the box):

☐ Inventor or Joint Inventor (title not required below)
☐ Legal Representative of a Deceased or Legally Incapacitated Inventor (title not required below)
☐ Assignee or Person to Whom the Inventor is Under an Obligation to Assign (provide signer's title if applicant is a juristic entity)
☐ Person Who Otherwise Shows Sufficient Proprietary Interest (e.g., a petition under 37 CFR 1.46(b)(2) was granted in the application or is concurrently being filed with this document) (provide signer's title if applicant is a juristic entity)

SIGNATURE of Applicant for Patent

The undersigned (whose title is supplied below) is authorized to act on behalf of the applicant (e.g., where the applicant is a juristic entity).

Signature		Date (Optional)	
Name			
Title			

NOTE: Signature - This form must be signed by the applicant in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. If more than one applicant, use multiple forms.

☐ Total of forms are submitted.

This collection of information is required by 37 CFR 1.131, 1.32, and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete.

- Where the applicant is a juristic entity (e.g., an assignee corporation) the power must be signed by someone with a title that carries apparent authority (an officer of the assignee) or include a statement of authorization to act.

Powers of Attorney: AIA/81

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

PTO/AIA/81 (07-12)
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.

POWER OF ATTORNEY TO ONE OR MORE OF THE JOINT INVENTORS AND CHANGE OF CORRESPONDENCE ADDRESS	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

<input type="checkbox"/> Individual Name			
Address			
City		State	Zip
Country			
Telephone		Email	

I am the Inventor.

SIGNATURE of Inventor			
Signature			Date
Name			Telephone

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 the (and by the

Powers of Attorney: AIA/80

- AIA/80 is used by assignees who are becoming the applicant under § 1.46 and are giving power of attorney.
- AIA/80 is submitted together with a § 3.73(c) Statement (AIA/96 or equivalent)
- An assignee-applicant (*i.e.*, who was named as the applicant in the ADS) could use AIA/80 (along with AIA/96) if desired.

PTO/AIA/80 (07-12)
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.

POWER OF ATTORNEY TO PROSECUTE APPLICATIONS BEFORE THE USPTO

I hereby revoke all previous powers of attorney given in the application identified in the attached statement under 37 CFR 3.73(c).

I hereby appoint:

☐ Practitioners associated with Customer Number:

OR

☐ Practitioner(s) named below (if more than ten patent practitioners are to be named, then a customer number must be used):

Name	Registration Number

Name	Registration Number

As attorney(s) or agent(s) to represent the undersigned before the United States Patent and Trademark Office (USPTO) in connection with any and all patent applications assigned only to the undersigned according to the USPTO assignment records or assignments documents attached to this form in accordance with 37 CFR 3.73(c).

Please change the correspondence address for the application identified in the attached statement under 37 CFR 3.73(c) to:

☐ The address associated with Customer Number:

OR

☐ Firm or Individual Name

Address

City State Zip

Country

Telephone Email

Assignee Name and Address:

A copy of this form, together with a statement under 37 CFR 3.73(c) (Form PTO/AIA/96 or equivalent) is required to be filed in each application in which this form is used. The statement under 37 CFR 3.73(c) may be completed by one of The practitioners appointed in this form, and must identify the application in which this Power of Attorney is to be filed.

SIGNATURE of Assignee of Record
The individual whose signature and title is supplied below is authorized to act on behalf of the assignee

Signature <input type="text"/>	Date <input type="text"/>
Name <input type="text"/>	Telephone <input type="text"/>
Title <input type="text"/>	

This collection of information is required by 37 CFR 1.51, 1.52 and 1.53. The information is required to obtain or retain a benefit by the rights which is in this form.

Correspondence Address

- Where multiple correspondence addresses are supplied either in a single document or in multiple documents (*e.g.*, on filing of an application) (§ 1.33(a)):
 - The Office may select the address associated with a Customer Number over a typed correspondence address.

Correspondence Address

- The ability to change a correspondence address by various parties is no longer dependent upon whether an oath or declaration has been filed.
- A correspondence address may now be changed at any time by (§ 1.33(a)):
 - A patent practitioner of record, or
 - The applicant (§ 1.42).

Correspondence Address

- After a patent issues (§ 1.33(g)):
 - A patent practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in the application:
 - May change the correspondence address, provided the change is accompanied by a statement that notice has been given to the patentee or owner.

Correspondence Address

- Where the correspondence address was changed during the prosecution of a prior application (§ 1.33(f)):
 - The correspondence address for a continuing application must be supplied in an ADS or separate paper.
 - This is important where application papers from a prior application are used in the continuing application (*e.g.*, an oath or declaration that sets forth the previous correspondence address).

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; and
 - Executing statements under § 3.73(c).

Reissue Applicants

- The reissue applicant is the original patentee, or the current patent owner if there has been an assignment.
- The assignee of the entire interest may now be the applicant of a reissue:
 - Including a broadening reissue where (35 U.S.C. 251, § 1.172):
 - The application for the patent being reissued was filed under § 1.46 by the assignee of the entire interest (would only apply to an application filed on/after 9/16/2012).



Execution of the Reissue Oath or Declaration

- The assignee of the entire interest may sign the inventor's oath or declaration for a reissue application where:
 - The reissue is not a broadening reissue (§ 1.175(c)(1)); or
 - The reissue is a broadening reissue, if the application for the original patent was filed under § 1.46 by the assignee of the entire interest. (§ 1.175(c)(2))

Reissue Oaths or Declarations: Submission

- The ability to delay submission of an inventor's oath or declaration until a Notice of Allowability issues:
 - Does not apply to reissue oaths or declarations, § 1.175(e).
- The oath or declaration must be present before a reissue application will be examined.
- An oath or declaration filed at any time will be placed in the file record (§ 1.175(g)):
 - But may not be reviewed.

Miscellaneous

- An executed oath or declaration is no longer required for publication of the application (§ 1.211):
 - The Office may delay publication until the application includes an oath or declaration or ADS containing the information required in § 1.63(b).
- The “without deceptive intention” requirements have been eliminated from requests to correct inventorship in:
 - Applications (§ 1.48);
 - Patents (§ 1.324); and
 - *Ex parte* and *inter partes* reexaminations (§ 1.530).

Miscellaneous:

Small Entity Status

- A written assertion of entitlement to small entity status can be signed by (§ 1.27(c)(2)):
 - The applicant;
 - A patent practitioner of record or acting in a representative capacity;
 - An inventor or joint inventor only if the inventor is the applicant; or
 - The assignee of the entire right, title and interest.
- Written assertions can no longer be signed by:
 - An inventor who is not an applicant, or
 - A partial assignee.

Miscellaneous:

Credit Card Payments

- Credit card payments, not being made via the Office's electronic filing systems (*e.g.*, EFS-Web), may only be submitted with:
 - An original handwritten signature;
 - That is personally signed; and
 - In permanent dark ink or its equivalent.(§ 1.4(e)(2))
- An S-signature (§ 1.4(d)(2)) may no longer be used for such payments.
- Facsimile transmission to the Central Facsimile Number is a paper submission.

Miscellaneous: National Stage

- An application submission containing conflicting indications as between an application under 35 U.S.C. 111 and a submission to enter the national stage under 35 U.S.C. 371 will be treated as a submission to enter the national stage under 35 U.S.C. 371. (§ 1.495(g))

Miscellaneous: New Forms

- Declaration forms for use with an ADS:
 - Utility or Design Application: PTO/AIA/01
 - Plant Application: PTO/AIA/03
- Substitute Statement:
 - Utility or Design Application: PTO/AIA/02
 - Plant Application: PTO/AIA/04
 - Supplemental Sheet: PTO/AIA/11

Miscellaneous: New Forms (cont.)

- Reissue Application Forms:
 - Declaration by the Inventor: PTO/AIA/05
 - Declaration by the Assignee: PTO/AIA/06
 - Substitute Statement: PTO/AIA/07
- Declaration forms for use without an ADS:
 - Utility or Design Application: PTO/AIA/08
 - Plant Application: PTO/AIA/09
 - Supplemental Sheet for Declaration: PTO/AIA/10
- Use of an ADS, and forms that utilize an ADS, is strongly recommended.

Thank you!