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How to Avoid Common Mistakes in a Patent Application

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Research Foundation



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Notice

This content is for informational purposes only and is not legal advice. Please consult with appropriate sources for legal authority and guidance on these matters.

Common filing mistakes

Common mistakes

- Specification Format
- Drawing Format
- Application Data Sheet (Form PTO/AIA/14)
- Signature Requirements
- Micro Entity Certification (Form PTO/SB/15A)

Specification page format

- The specification, including the abstract and claims, must be written in English and have lines that are 1.5 or double-spaced in a single column of text.
- Write on only one side in portrait orientation.
- Use 8.5 by 11 inches with all margins of at least $\frac{3}{4}$ inches except for a left side margin of at least 1 inch.
- Clearly type in non-script font (e.g., Arial, Times New Roman, or Courier, preferably with a font size of 12), without shading, on white paper.
- The application pages must be numbered consecutively (centrally located above or below the text), starting with page one.
- Drawing figures should not be contained within the specification.

Specification sections

- Title of the Invention (short and specific)
- Most common applicable sections
 - Background of the Invention (e.g., state of the art before your invention)
 - Brief Summary of the Invention
 - Brief Description of the Drawings (list of all figures by number with brief statement of what the figure depicts)
 - Detailed Description of the Invention
- Claims (on a separate sheet)
- Abstract (less than 150 words, one paragraph, on separate sheet)

How to file a substitute specification

Three Required Parts of the Submissions:

1. Marked-up copy with proper markings showing all the changes relative to the immediate prior version of the specification of record
2. Clean copy (without markings)
3. Signed statement that the substitute specification contains no new matter

The **entire** specification is required for the marked-up and clean copies, not just the amended portion.

Marked-up vs. clean copy

Marked-up copy:

- A version that shows ALL changes to the most recent specification **of record** with markings
- Additions of text are underlined
- Deletions of text are shown by ~~strike-through~~, except double brackets may be used to indicate deletion of [[five]] or [[fewer]] characters

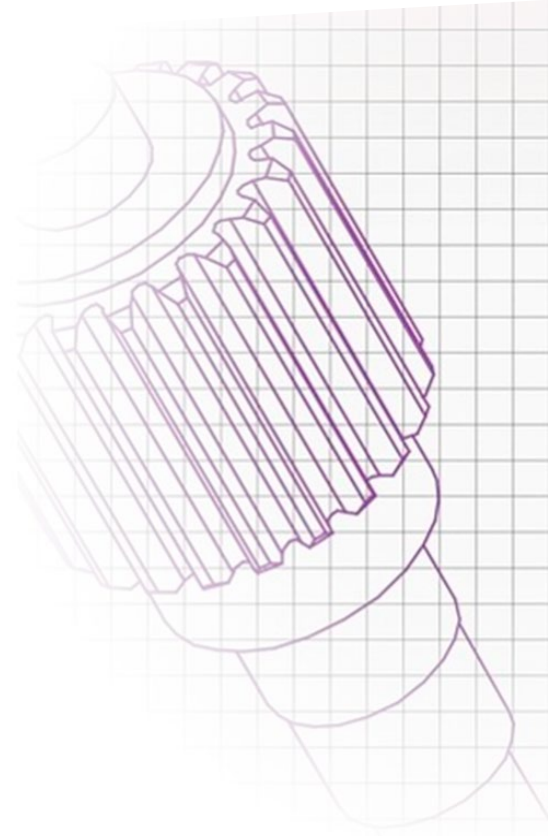
Clean copy:

- A version that includes ALL changes to the most recent specification of record without markings

Drawings

Required if necessary to understand the subject matter to be patented

- A drawing necessary to understand the invention cannot be introduced after the filing date

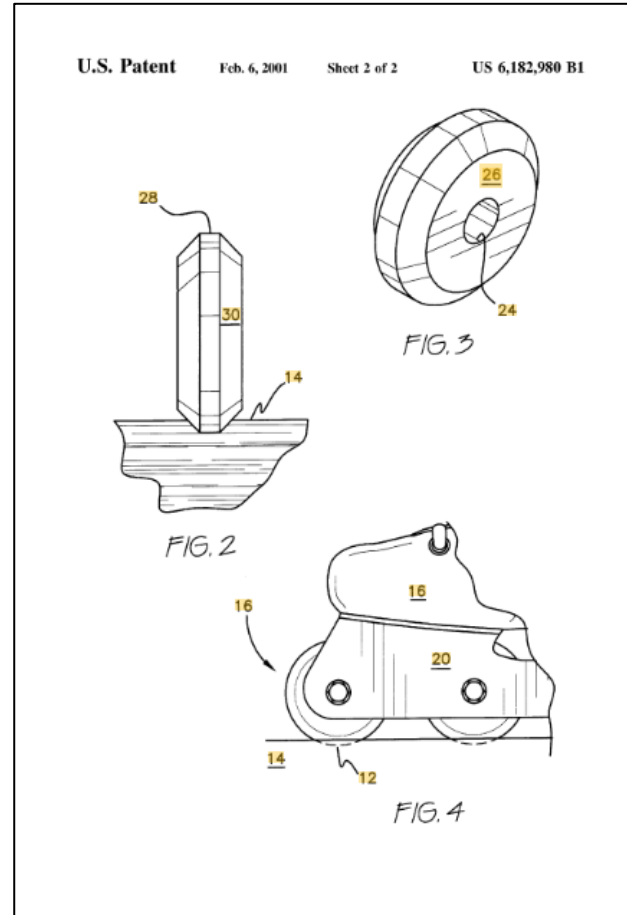
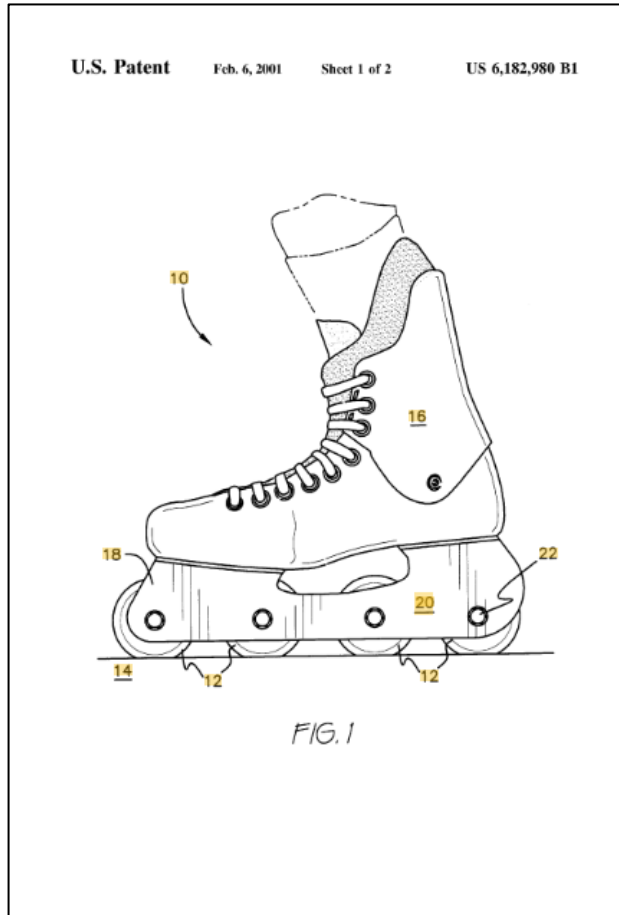


Drawing requirements

- Black and white drawings; lines; numbers heavy enough to permit adequate reproduction.
- Use reference characters (in specification and drawings; numerals preferred).
- Each Figure must be labeled in English (e.g., FIG. 1) with a corresponding description in the Brief Description of the Figures.
- Contain little or no text, and no non-English labeling or text.
- Be on white, non-graph, 8.5 by 11 paper, with margins of at least $\frac{3}{4}$ inch and a left margin of at least 1 inch.
- Be free of erasures, copy marks, overwriting, interlineations, folds, and alterations.
- Numbering of the sheets of drawings should be sequentially numbered. In the top-center of each sheet, the number should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.



Drawing Examples



Common mistakes found during Office of Patent Application Processing (OPAP) drawing review

- Line quality that is too light to be reproduced
- Missing lead lines
- Excessive text or text that is not in English
- Paper format (e.g., margins and paper size)
- Incorrectly labeled figures
- Photographs that have poor resolution after scanning
- Color drawings without a petition
- Each figure described in the brief description of the drawings must correspond to a separately-labeled drawing figure
 - Fig. 1 described in the specification should not be labeled as Fig. 1a
 - Fig. 1a-f described in the specification should not be labeled as Fig. 1



How to make amendments to the drawings

- Each sheet **must be labeled** “Replacement Sheet” or “New Sheet” as applicable in the top margin.
- Marked-up copy is optional unless required by the examiner.
 - Must be labeled “Annotated Sheet” if submitted

Application Data Sheet (ADS)

An ADS is **required** to:

- Identify applicants who are not inventors.
- Set inventorship when an inventor's oath is **not** being submitted until later in the prosecution
- Set inventorship where there are joint inventors, and each joint inventor is executing a declaration that **only** names that inventor and not all inventors.
- Make benefit claims under 37 CFR 1.78 and foreign priority claims under 37 CFR 1.55.



Common Mistakes found in ADS

- **Signature**
 - Every ADS must be signed by either a registered patent practitioner or the applicant:
 - When a named applicant in the “Applicant Information” section is a juristic entity (e.g., a company), the ADS must be signed by a registered patent practitioner.
 - An unsigned ADS will be treated only as a transmittal letter (37 CFR 1.76) with limited information being made of record from it
- **Domestic benefit**
 - If an applicant wishes to claim the benefit of an earlier-filed U.S. application (e.g., a provisional application), the claim must be made in the “Domestic Benefit/National Stage Information” section of an ADS.



Common Mistakes found in an ADS (cont.)

- File by reference
 - In an overwhelming majority of filed applications, the “Filing by Reference” section of the ADS should be left **blank**. Overcoming a mistake in completing this section can be particularly costly and time consuming.
- Typographical errors
 - Applicants should be sure to carefully check each entry in the ADS for typographical errors. Errors in the spelling of names, prior application numbers, addresses, etc., are not always easy to fix and can cost applicants money, time, and additional paperwork.



Updating the ADS

- All changes to the ADS must be properly marked up.
- Information may be corrected or updated by filing a **corrected** ADS that contains all sections of the form or only the sections of the form containing changed or updated information.
- Changes must be shown by underlining for insertions and ~~strike-through~~ or [brackets] for deletions.
- Each section containing changes or updated information must contain **all** of the information already of record with the changes shown by markings.
- If the ADS is submitted after the submission of the application, even if it is the first submission of an ADS, any information being added or deleted relative to the information of record must be indicated by markings.

Example: correcting a benefit claim

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) or indicate National Stage entry from a PCT application. Providing benefit claim 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” field blank.

Prior Application Status	Expired	<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing or 371(c) Date (YYYY-MM-DD)
	<u>Claims benefit of provisional</u>	<u>61973005</u>	<u>2014-03-31</u>
Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the Add button.			<input type="button" value="Add"/>

This correction rectifies a situation in which the as-filed ADS did not make a benefit claim (or the benefit claim was not properly presented). The underlining shows the benefit claim is being added. The underlining is relative to the information of record shown on the filing receipt.



Documents must be properly signed

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



Signature requirement

- Handwritten
- S-signature
 - Name between two single forward slashes
 - Signature must be accompanied by printed/typed name of signer and be easily identifiable
- Graphic representation
 - For electronically submitted correspondence
 - Graphic representation of handwritten signature or S-signature
- **Multiple Inventors**
 - **All** inventors must sign **unless** a power of attorney has been granted to one or more of the joint inventors

Sample S-Signatures

I. S-SIGNATURE EXAMPLES, 37 CFR 1.4(d)(2) effective September 21, 2004

A. BY INVENTORS, AFFIANTS (e.g., §§ 1.131 & 1.132), ASSIGNEES AND PRACTITIONERS SIGNING AS INVENTORS

	<u>SIGNATURE TYPE</u>	<u>SIGNATURE</u>	<u>TREATMENT</u>	<u>PREFERRED</u>
1.	S-Signature within forward slashes, name below	<u>/John T. Smith/</u> John T. Smith	Proper Signature Treat as signed, § 1.4(d)(2).	✓
2.	S-Signature with spaces within forward slashes, name below	<u>/ John T. Smith /</u> John T. Smith	Proper Signature Treat as signed, § 1.4(d)(2).	
3.	S-Signature within forward slashes, name below but no line under the S-Signature	<u>/John T. Smith/</u> John T. Smith	Proper Signature Treat as signed, § 1.4(d)(2), as a line is not required, although it is recommended.	
4.	Script font S-Signature within slashes, name below	<u>/John T. Smith/</u> John T. Smith	Proper Signature Treat as signed, § 1.4(d)(2).	
5.	Name above, S-Signature within slashes, below	John T. Smith <u>/John T. Smith/</u>	Proper Signature Treat as signed, § 1.4(d)(2).	
6.	S-Signature within slashes, name on right side	/John T. Smith/ John T. Smith	Proper Signature Treat as signed, § 1.4(d)(2).	

https://www.uspto.gov/sites/default/files/documents/sigexamples_alt_text.pdf





Thank you!



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