

PATENT FILINGS IN THE USA

IMPORTANT CONSIDERATIONS

[Austen Zuege](#)

Registered U.S. Patent Attorney



About WCK

- Law firm focused on intellectual property law
- Office in Minneapolis, Minnesota
- 19 attorneys and 1 patent agent
- Founded in 1993
- Web: www.wck.com

About WCK (cont.)



About Austen Zuege

- Austen Zuege is a registered U.S. patent attorney who practices in the areas of patent prosecution, litigation, and client counseling for both utility and design patents. This experience includes managing global patent portfolios.
- Austen has an engineering degree and has experience in a variety of technical subject matter areas including mechanical, electrical, electro-mechanical, software, and more.
- Over the years, Austen has also regularly written and spoken on a variety of patent-related topics.

Types of Patents

- Utility
- Design
- Plant

– *But no utility models*

Types of Patent Applications

- Provisional
- Continuation
- Continuation-in-Part
- Divisional

Types of Patent Applications (cont.)

- PCT National Phase Entry (§ 371)
- PCT “Bypass” Application (Continuation, Divisional, CIP)

Naming Applicant(s) Other Than Inventor(s)

Applicant Information:

USPTO form allows only one selection

Providing assignment information in this section does not substitute for compliance with any requirement of part 3 of Title 37 of CFR to have an assignment recorded by the Office.

Applicant 1	<input type="button" value="Remove"/>
<p>If the applicant is the inventor (or the remaining joint inventor or inventors under 37 CFR 1.45), this section should not be completed. The information to be provided in this section is the name and address of the legal representative who is the applicant under 37 CFR 1.43; or the name and address of 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 who is the applicant under 37 CFR 1.46. If the applicant is an applicant under 37 CFR 1.46 (assignee, person to whom the inventor is obligated to assign, or person who otherwise shows sufficient proprietary interest) together with one or more joint inventors, then the joint inventor or inventors who are also the applicant should be identified in this section.</p>	
<input type="button" value="Clear"/>	
<input checked="" type="radio"/> Assignee	<input type="radio"/> Legal Representative under 35 U.S.C. 117
<input type="radio"/> Person to whom the inventor is obligated to assign.	<input type="radio"/> Person who shows sufficient proprietary interest
<p>If applicant is the legal representative, indicate the authority to file the patent application, the inventor is:</p>	
<input type="text"/>	
<p>Name of the Deceased or Legally Incapacitated Inventor: <input type="text"/></p>	
<p>If the Applicant is an Organization check here. <input type="checkbox"/></p>	

Requires Assignment

Death or Incapacity of Inventor(s)

Mix of Inventor(s) and Assignee(s)

Employment or Master Services Agreement, Operation of Law, etc.

Requires Petition and Extra Fee; Rarely Appropriate

Applicant Size Determines Official Fees

- Large Entity (Undiscounted)
- Small Entity
 - *Applicant(s) must each be a person, small business concern (having no more than 500 employees), or nonprofit organization (including nonprofit universities)*
 - *Must pay undiscounted (large entity) fees if associated with a large entity, such as through an affiliation, obligation to assign, licensing agreement, joint ownership, or shop rights*
 - *Small entity status established at time of initial filing, and must be updated at time of issue fee payment (but not during prosecution)*

Applicant Size Determines Fees (cont.)

■ Micro Entity

- *Two bases:*
 - Gross income basis (most common; see [current limits](#)), or
 - Institute of higher education basis (limits on who is Applicant)
- *Must also qualify as small entity*
- *Gross income basis has four prior application limit*
- *Requires certification (see forms: [income](#), [education](#))*
- *Status must be changed whenever micro entity status is lost (even during prosecution)*
- *If in doubt, go with small entity status instead*

Extra Claims

- Basic filing fees include up to twenty (20) total claims and up to three (3) independent claims
 - *Additional total and/or independent claims, whenever presented, require extra claim fees*
 - *Be mindful of restriction practice (unity of invention)*
- Prohibitive fees for multiple dependent claims — disfavored
- Can reduce claims through preliminary amendment(s) (like voluntary amendments)

Extra Pages

- Application size fees for each 50 pages over 133 electronic pages
- Sequence listings have extra fees

DOCX Format – New/Upcoming

- Starting January 1, 2022, surcharge for non-DOCX format filings
- USPTO-side conversion/rendering of DOCX files raises concerns for applications with equations, chemical formulas, pseudo computer code with special indenting, text not in Latin (English) characters, or anything created on a word processing program other than Microsoft Word®
 - *in some cases paying surcharge may be worthwhile*

Special Considerations for Design Patent Applications

- Drawing requirements substantially different from other countries
 - *Photographs generally not accepted*
 - *May need additional views (or explanation)*
 - *Use of shading lines (to show curves and flat surfaces)*
- Use of broken (dashed) lines for unclaimed matter
 - *Limits on changing solid lines to broken after filing*

Translation

- English translation of application required
 - *Surcharge for late filing of translation*
 - *Remember to translate text in drawings too*

Certified Copies

- Deadline is 16 months from priority or 4 months from U.S. filing, whichever is later
 - *For design patents, deadline is payment of issue fee*
- Electronic retrieval via WIPO [DAS](#) or [PDX](#) with EPO
- PCT [Rule 17](#) submission avoids need to separately submit certified copy in national phase

Inventor Oaths/Declarations

- Required for a U.S. patent to issue

- Late filing surcharge

- Required for a PCT national phase entry before an RCE
 - *“Zombie” applications – PCT national phase entry is abandoned if RCE filed without a declaration*
 - *Does not apply to RCEs in Paris convention (direct) filings or “bypass” applications*

Inventor Oaths/Declarations (cont.)

- Can sign declaration before PCT filing or national phase filing
 - See *PCT [Rule 4.17\(iv\)](#) and [Rule 51bis.1\(a\)\(iv\)](#)*; and *PCT [RO Guideline 192A](#)*
 - *Can also create inventor declaration form utilizing exact text from PCT [Administrative Instructions Section 214\(a\)](#)*
- Signed declarations can generally be re-used for subsequent U.S. continuation and divisional filings

Assignments

- Generally required in order to name Applicant as entity other than inventor(s)

- Should be recorded with USPTO
 - *Recordation requires serial number or title in assignment*
 - *English translation signed by translator required for recordation of non-English document*
 - *Assignment of PCT application can be recorded against national phase entry*
 - *USPTO does not substantively assess recorded assignments*

Assignments (cont.)

- Recordation not mandated by USPTO, but...
- [35 U.S.C. § 261](#):
 - *“An interest that constitutes an assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.”*

Assignments (cont.)

- Multiple assignees/applicants: default is that each can assign (or license) interest in entire application/patent without accounting to others
 - *All co-owners must join any infringement lawsuit*

- Assignment terms subject to state or foreign law

- Obligations to assign
 - *Employment agreements, master services agreements, or the like obligating assignment can sometimes be recorded (e.g., inventor is unavailable or uncooperative), but usually are not*

- Foreign law effectuates assignment to employer by action of law?
 - *Can record “confirmatory” or “quitclaim” assignment*

Assignments (cont.)

- Notarization (or apostille) not required
 - *Optional witness signatures or notarization still have benefits*

- Defective assignment?
 - *Mark changes and initial and date changes; or*
 - *Sign corrective (nunc pro tunc) assignment*

Recording Licenses, Etc.

- Licenses and security interests can be recorded at USPTO
 - *Not required*
 - *Not common*

Signatures

- USPTO permits electronic signatures *inserted personally*
 - *virgule style: /First Last/*
 - *graphically inserted replicas of pen-and-ink signatures*
- Examples of acceptable e-signatures:
 - https://www.uspto.gov/sites/default/files/documents/sigexamples_alt_text.pdf
- USPTO e-signature rules are not controlling for assignments
 - *State or foreign law applies for assignment signatures*

Duty of Disclosure and Candor

- “Inequitable conduct” can render patent unenforceable

- Anyone associated with an application must disclose any material prior art to USPTO ([37 C.F.R. § 1.56](#); [MPEP ch. 2000](#))
 - *an ongoing duty*
 - *provide copies of non-patent literature (with translations)*

- Report foreign counterpart office actions promptly
 - *Patent term adjustment consequences after 30 days*
 - *Fee consequences after 3 months*

Foreign Filing Licenses

- Patent barred if invention was “made” in USA and then filed abroad without a foreign filing license ([35 U.S.C. § 185](#))
- Default license after 6 months if first filed in USA (+RO/US)
- Can request expedited foreign filing license before filing outside USA (takes about 3 days by fax)
- Can petition for retroactive foreign filing license

Accelerated and Prioritized Examination

- Make Special ([accelerated examination](#))
 - *Free categories:*
 - Patent Prosecution Highway (PPH)
 - Age of inventor (65+)
 - Health of inventor
 - *Fee required (often not worthwhile):*
 - Environmental quality
 - Energy
 - Countering terrorism
- Prioritized Examination ([Track One](#))
 - *Expensive official fee*
 - *Need all signature papers with filing*
 - *Not available for national phase entries (bypass instead)*

Missed Filing Deadlines

- Late filing in U.S. may be permitted within 2 months if entire delay was unintentional
- Requires petition and fee
 - *Must be ready to present evidence of unintentional delay*

Some Notes on Patentability

■ Patent eligibility

- *Abstract ideas, laws of nature, and natural phenomena excluded from patent eligibility*
- See <https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility>
- *For example, try “Beauregard” or “CRM” claims: convert pure software recitation (“A program comprising”) to a recitation of an article of manufacture as a computer-readable medium comprising program instructions for carrying out a method stored on that computer-readable medium*

■ On-sale and public use bars

- *Secret sales can still bar patenting*
- *One-year grace period*

Some Notes on Claims

- Means-plus-function (“means for...”) claim format given special (narrow) construction in U.S.
 - *Functional claim language may be construed as a means-plus function recitation even without the words “means for”*
- Conditional method/process recitations (“if...”) may be disregarded during examination
- Product-by-process process recitations ignored during examination but required for infringement (disfavored)

Some Notes on Claims (cont.)

- Use of “or” can be scrutinized
 - *“Markush” group format used*
- Omnibus claims not allowed (but reference to tables or the like permitted in some circumstances)
- Support can be provided by drawings or original claims alone
- Reference numbers in claims not required (removal recommended)

Some Notes on Specifications

- If claims use “means”:
 - *Specification (description) should use structural terms beyond the word “means”*
 - *For processes/methods, specification (or figures) should disclose algorithm/steps*

- Use of object statements discouraged
 - *Also use care when characterizing “the invention” (may limit claim scope)*

Some Notes on Drawings

- Margins ([37 C.F.R. § 1.84\(g\)](#)):
 - *Each drawing sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9 5/8 inches) on 21.6 cm. by 27.9 cm. (8 1/2 by 11 inch) drawing sheets.*

- Numbers, letters, and reference characters in drawings must measure at least 0.32 cm. (1/8 inch) in height ([37 C.F.R. § 1.84\(p\)](#))
 - *Usually satisfied by 12 point font in all capital letters*

Some Notes on Drawings (cont.)

- Should be black-and-white line drawings with clean lines and clear, non-blurry text
 - *Grayscale shading/fill usually objected to (use stippling, cross-hatching, or the like instead)*
 - *Photomicrographs or the like can be acceptable*
 - *Color drawings require petition and fee (disfavored)*
 - *Text must be oriented in same direction on sheet*
 - *Informalities can often be fixed after initial filing*

- Depictions of only prior art must be labeled “(PRIOR ART)”

Thank You

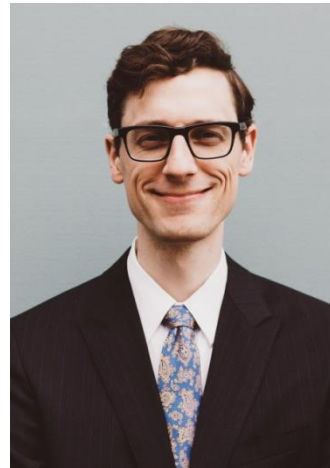
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