

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



USPTO Inventor Info Chat Series: How to File an Application

Office of Innovation Development

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Email questions to:
inventorinfochat@uspto.gov

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PATENT AND TRADEMARK OFFICE



Office of Innovation Development

- In Person Assistance (by appointment) for Pro Se Applicants
- Assistance Hotline 1-866-767-3848
- Patent Email Support innovationdevelopment@uspto.gov
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 - Virtual Assistance Pilot Program
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 - Independent Inventor Conferences
 - Education for Inventor Organizations
- <http://www.uspto.gov/inventors>

Overview

You will become more familiar with:

- Methods of filing an application
- Different types of applications that can be filed
- Resources available to aid in the filing process

Send your questions to: inventorinfochat@uspto.gov



Methods of Filing

- **EFS-Web the USPTO's electronic filing system**
 - The only way to avoid paying an additional “non-electronic filing fee” for nonprovisional utility patent applications
- **USPS or U.S. Postal Service Delivery by U.S. mail**
- **Hand delivery to the USPTO Headquarters in Alexandria, Virginia**
 - Mailing and Hand Carry Addresses are available at <https://www.uspto.gov/web/offices/com/sol/og/2005/week28/patboxes.htm>



Online Filing Guides

- Provisional Application for Patent
- Nonprovisional (Utility) Patent Application Filing Guide
- Guide to Filing a Design Patent Application
- Plant Patent Application
- Filing a new international application under the Patent Cooperation Treaty (PCT)
 - PCT Legal Administration
 - International Protection

<https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applicationsproceedings>



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DIFFERENT TYPES OF APPLICATIONS THAT CAN BE FILED

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Provisional Patent Application

A provisional patent application allows you to file without a formal patent claim, oath or declaration, or any information disclosure (prior art) statement.

Items required:

1. Specification → written description of the invention, complying with all requirements of 35 USC 112(a)
2. Drawings necessary for the understanding of the invention
3. Filing fee
4. Cover Sheet (PTO/SB/16)



Provisional Patent Application

Use the USPTO cover sheet (PTO/SB/16) to identify:

- the application as a provisional application for patent;
- the name(s) of all inventors;
- inventor residence(s);
- title of the invention;
- name and registration number of attorney or agent and docket number (if applicable);
- correspondence address; and
- any U.S. Government agency that has a property interest in the application.

Filing Tips – Provisional

- Read the online filing guide before filing:
<https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/provisional-application-patent>
- Claims are not required in a provisional application, but it is recommended that the disclosure of the invention be as complete as possible
- Can be filed up to 12 months following an inventor's public disclosure of the invention (e.g., publishes, uses, sells, or otherwise makes available to the public)
 - Such a pre-filing disclosure, although protected in the United States, may preclude patenting in foreign countries
- Provisional applications for patent cannot claim the benefit of a previously-filed application, either foreign or domestic
- May not be filed for design applications



Nonprovisional Patent Application

Filing Requirements for Examination

- A specification, including a description and a claim or claims
- Drawings, when necessary for an understanding of the invention
- Inventor information including the legal name, residence, and mailing address of each inventor
 - Oath or declaration or an application data sheet
- The prescribed filing, search, and examination fees

<https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/nonprovisional-utility-patent>



Surcharge under 37 CFR 1.16(f)

A surcharge (in addition to any other fees due) will be assessed for:

- Late submission of the basic filing, search or examination fee
- Late submission of inventor's oath or declaration
- Filing an application that does not contain at least one claim on filing
- Submission of an application filed by reference to a previously filed application



Filing Tips – Nonprovisional

- Read the online filing guide before filing:
<https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/nonprovisional-utility-patent>
- Use USPTO forms
 - In general, every applicable section of a form should be completed, but not all sections of a form are applicable to every case
 - If you are unsure which forms to use, ASK!
- Carefully proofread all forms and application papers before submitting
- Register for EFS-Web to file follow-on papers electronically and view your application file wrapper in Private PAIR
 - <https://www.uspto.gov/patents-application-process/applying-online/getting-started-new-users>

Design Patent Application

A Design Patent Application should include the following elements (as set forth in 37 CFR 1.154):

- Design application transmittal form.
- Fee transmittal form.
- Application data sheet (see 37 CFR § 1.76).
- Specification.
- Drawings or photographs.
- The inventor's oath or declaration (see 37 CFR § 1.153(b)).

The filing fee, search fee, and examination fee are also required.



Design Patent Application Specification

The specification of a Design Patent Application should include the following sections, where applicable, in order:

- Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.
- Cross-reference to related applications (unless included in the application data sheet).
- Statement regarding federally sponsored research or development.
- Description of the figure or figures of the drawing.
- Feature description.
- A single claim.



Design Patent Application

- **The drawing disclosure is the most important element of the design application**
 - It is essential that the applicant present a set of drawings (or photographs) of the highest quality which conform to the rules and policies pertaining to the drawing disclosure of a design patent application
 - A design patent application may only include a single claim
 - The claim defines the design which the applicant wishes to patent, in terms of the article in which it is embodied or applied
 - The claim must be in formal terms to: “The ornamental design for (the article which embodies the design or to which it is applied) as shown.”
- **While no specific format is required for other required information, it is strongly suggested that applicant follow the formats presented in the design filing guide to ensure that the application is complete**

Filing Tips – Design

- Read the online filing guide before filing:
<https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide>
- Photographs are permitted if they are the only practicable medium for illustrating the claimed invention
- To meet the requirements of 35 U.S.C. 112, the drawing disclosure must include a sufficient number of views to constitute a complete disclosure of the appearance of the design claimed
 - It is suggested that perspective views be submitted to clearly show the appearance and shape of three-dimensional designs
- Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is used, may be represented in the drawing by broken lines



Applicants' Duty to Disclose

- Each individual associated with the filing and prosecution of the patent application has a “duty to disclose” to the Patent Office all information “known to that individual to be material to patentability...”
- The individual may have derived knowledge or found references material to patentability from a pre-examination search, prior public uses or sales, or from other sources.

See 37 CFR §1.56 and MPEP section 2001.

<https://www.uspto.gov/web/offices/pac/mpep/s2001.html>



Information Disclosure Statements

- An Information Disclosure Statement (IDS) should be provided at the earliest possible stage of prosecution detailing the most pertinent references known to the individual. The Examiner is to consider each reference cited in the IDS prior to the next Office action on the merits.
- Documents that are included in an Information Disclosure Statement (IDS):
 - US Patents
 - US Publications
 - Foreign References
 - Non-Patent Literature e.g. Journal articles, websites, catalogs

Useful Links:

Link to IDS form: https://www.uspto.gov/sites/default/files/documents/updated_IDS.pdf

Link to tutorial on Filing an IDS:

https://www.uspto.gov/sites/default/files/ebc/portal/efs/dct_ids_tutorial.pdf



Requirements for filing an IDS

- A list of all patents, publications, applications, or other references that provides general information for each listed item, i.e. inventor or author, patent number or patent application publication number or title, and issue date or publication. (See 37 CFR §1.98)
- An Information Disclosure Statement Form can be used, e.g. PTO Form PTO/SB/08a – EFS web form.
- No fee is required for an IDS filed before the examiner's 1st Office action, and in situations where information was later discovered by an individual with a duty to disclose.



Basic Fees as of April 20, 2017

- Provisional Utility Application

	Large Entity	Small Entity	Micro Entity
Filing Fee:	\$260	\$130	\$65

- Non Provisional Utility Application

	Large Entity	Small Entity	Micro Entity
Basic Filing Fee:	\$280	\$140	\$70
Search Fee:	\$600	\$300	\$150
Examination Fee:	\$720	\$360	\$180
Issue Fee:	\$960	\$480	\$240
Non-electronic Filing Fee:	\$400	\$200	\$200

- Design Application

	Large Entity	Small Entity	Micro Entity
Basic Filing Fee:	\$180	\$90	\$45
Search Fee:	\$120	\$60	\$30
Examination Fee:	\$460	\$230	\$115
Issue Fee:	\$560	\$280	\$140

Fees are subject to change. See the current fee schedule at:

<https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule#Patent Fees>



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Small Entity Status

An entity that:

1. Falls within one of three categories:

- A nonprofit organization, such as a university,
- A person, such as an individual inventor
- A small business concern meeting the standards set forth by the Small Business Administration (SBA), including the requirement that the number of employees, including affiliates, does not exceed 500 persons. See 13 CFR 121.801 through 121.805.

2. And has not assigned, licensed or otherwise conveyed an interest in the invention to a non-small entity



Micro Entity Status (Gross Income Basis)

To qualify for micro entity status on the gross income basis, the applicant must comply with:

1. SMALL ENTITY REQUIREMENT
2. APPLICATION FILING LIMIT
3. GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS
4. GROSS INCOME LIMIT ON PARTIES WITH AN OWNERSHIP INTEREST

Use form PTO/SB/15A to certify status:

<http://www.uspto.gov/sites/default/files/forms/sb0015a.pdf>



Certification of Micro Entity Status (Gross Income Basis)

CERTIFICATION OF MICRO ENTITY STATUS (GROSS INCOME BASIS)			
Application Number or Control Number (if applicable):		Patent Number (if applicable):	
First Named Inventor:		Title of Invention:	
The applicant hereby certifies the following—			
<p>(1) SMALL ENTITY REQUIREMENT – The applicant qualifies as a small entity as defined in 37 CFR 1.27.</p> <p>(2) APPLICATION FILING LIMIT – Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights, or is obligated to assign all ownership rights, as a result of the applicant's previous employment.</p> <p>(3) GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS – Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.</p> <p>(4) GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST" – Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.</p>			
SIGNATURE by an authorized party set forth in 37 CFR 1.33(b)			
Signature			
Name			
Date	Telephone	Registration No.	
<input type="checkbox"/>	There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. The required additional certification form(s) signed by the other joint inventor(s) are included with this form.		



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Additional Resources

Pro Se Assistance Program: <https://www.uspto.gov/patents-getting-started/using-legal-services/pro-se-assistance-program>

Electronic Business Center New User's Page: <https://www.uspto.gov/patents-application-process/applying-online/getting-started-new-users>

USPTO Patent Databases: <https://www.uspto.gov/patents-application-process/search-patents>

Common Pitfalls on USPTO forms: <https://www.uspto.gov/learning-and-resources/newsletter/inventors-eye/common-pitfalls-uspto-forms>

Upcoming OID Events

- **Upcoming Inventor Info Chat Webinars**
 - How to File a Patent Application electronically 5/18/17
 - Trademark Basics 6-15-17
- **Independent Inventor Conference at Alexandria Headquarters August 11-12, 2017**
 - Conference will include seminars, panels and breakout sessions related to patents and trademarks

For more information or to register for any of the above events contact us at oidevents@uspto.gov



Summary

You should now be more familiar with the following:

- Methods of filing an application
- Different types of applications that can be filed
- Resources available to aid in the filing process





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Thank You!

To inquire about OID services please contact us at:

InnovationDevelopment@uspto.gov

1.866.767.3848

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Sean Wilkerson

Email questions to:
inventorinfochat@uspto.gov



