

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 other disciplines.
- Over the years, Austen has also regularly written and spoken on a variety of patent-related topics.

Types of U.S. Patents

- Utility
- Design
- Plant
 - *But no utility models*

Types of U.S. Patent Applications

- Provisional

- Nonprovisional (includes Paris Convention filings)

- Continuing applications:
 - *Divisional*
 - *Continuation*
 - *Continuation-in-Part*

- Reissue (seeking to correct granted patent)

Types of U.S. 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="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"/> Joint Inventor
<p>If applicant is the legal representative, indicate the authority to file the patent application, the inventor is:</p>	
<p>Person who shows sufficient proprietary interest</p>	
<p>Name of the Deceased or Legally Incapacitated Inventor:</p>	
<p>If the Applicant is an Organization check here. <input type="checkbox"/></p>	

Requires Assignment (could occur by operation of law in some jurisdictions)

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 only must be updated at time of issue fee payment (but not during examination)*

Applicant Size Determines Official 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 (4) prior application limit*
- *Requires certification (see forms: [income](#), [education](#))*
- *Status must be changed whenever micro entity status is lost (even during examination)*
- *If in doubt, assert only 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 and Listings

- Application size fees for each 50 pages over 133 electronic pages
 - *But application size fee for a national stage application is determined on the basis of the international application as published by WIPO*
- Sequence listings 300 MB or larger have extra fees

DOCX Format

(New/Upcoming)

- Starting January 1, 2023 (extended by one year from original date), \$400 (large entity) surcharge for non-[DOCX](#) format application filings
 - *PCT national phase entries exempt from surcharge (for now)*
 - *applicability to translations (Paris Convention) unclear*
- USPTO considers the DOCX file the authoritative source or evidentiary copy of the application in order to later make corrections if any errors are produced by USPTO-side conversions/renderings
 - *USPTO-side conversion/rendering errors may arise for applications with equations, chemical formulas, pseudo computer code with special indenting, text in unusual characters, or anything created on a program other than Microsoft Word® (consider embedded images of equations)*
 - *in some cases paying surcharge may be preferable*
- Line numbering & claim autonumbering problematic
- Figures in same DOCX file as specification are problematic
- Metadata should be deleted from DOCX files

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](#) for participating offices
- 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 a request for continued examination (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 international 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 at least serial number or title in assignment*
 - *English translation signed by translator required for recordation of non-English assignment document*
 - *Assignment of PCT application can be recorded against national phase entry*
 - *But 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” and/or “quitclaim” assignment*

Assignments (cont.)

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

- Defective or unrecordable assignment?
 1. *Mark-up changes and have each signatory initial and date the changes;*
or
 2. *Sign new corrective or confirmatory (nunc pro tunc) assignment*

Recording Licenses, Etc.

- Licenses and security interests can be recorded at USPTO like assignments
 - *Not required*
 - *Not common*
- Mergers and changes of name can also be recorded
 - *Recommended to do so*

Signatures

- USPTO permits electronic signatures ***inserted personally*** for inventor declarations and powers of attorney (but not all documents):
 - *virgule style “s-signature”*: /First Last/
 - *inserted graphic representation of pen-and-ink signature*
- Examples of acceptable USPTO e-signatures:
 - https://www.uspto.gov/sites/default/files/documents/sigexamples_alt_text.pdf
- USPTO e-signature rules are **not controlling for validity of assignments**
 - *state or foreign law applies for assignment signatures*

Signatures (cont.)

- “Wet” pen-and-ink signatures still standard for assignments
- But when and how can electronic signatures be used for assignments of U.S. patent rights? Four general requirements in the USA ([ESIGN](#) & [UETA](#)):
 - *Intent to sign*
 - *Consent to do business electronically*
 - *Association of the signature with the record:*
 - system used to capture transaction must keep associated record reflecting process by which signature was created, or generate textual or graphic statement (added to the signed record) proving it was executed with electronic signature*
 - *Record retention*
- But the states of Illinois ([5 ILCS 175](#)), New York ([N.Y. State. Tech § 301 et seq.](#)), and Washington have not adopted uniform law (UETA) applicable in other states

Signatures (cont.)

- Federal ESIGN Act not limited to persons located in USA, but still consider local law regarding electronic signatures for patent assignments for assignor outside USA
- Choice of law issues may arise for electronic signatures when there are multiple assignors in multiple states and/or countries
- Use of “wet” (pen-and-ink) signature on later corrective or confirmative assignment may cure insufficiencies or defects with earlier electronic signature
 - *but defects must be cured before starting enforcement lawsuit to have standing*
- Consider e-signature enforceability for right of priority too

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 Chapter 2000](#))
 - *an ongoing duty*
 - *provide copies of non-patent literature (with translations)*
- Report foreign counterpart office actions and/or search reports 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](#))
 - *Useful categories:*
 - Patent Prosecution Highway ([PPH](#))
 - Age of inventor (65+)
 - Health of inventor
 - *Other categories (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. based on PCT, Paris Convention (including designs), or prior U.S. provisional application priority may be permitted if entire delay was unintentional
 - *Requires petition and fee*
 - *Must be ready to present evidence to substantiate assertion that entire delay was unintentional*
 - *For late Paris Convention or provisional priority filing, unintentional delay is limited to 2 months (that is, must file by 14 months for utility application or 8 months for design application)*
 - *For late PCT cases (beyond 30 months), no fixed limit on length of unintentional delay for revival of international application to permit national phase entry*

- Delayed assertion of claim of priority, revival of abandonment, or late issue fee payment also possible in some circumstances when entire delay was unintentional

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/confidential sales can still bar patenting*
 - *One-year grace period for own disclosures & sales*

Some Notes on Claims

- Means-plus-function (“means for...”) claim format given special (narrow) construction in U.S.
 - *Functional claim language might 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 alternative recitations and the word “or” can be scrutinized
 - *“Markush” group format used instead (“selected from the group consisting of...”)*
- Omnibus claims not allowed (but specific references 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” sufficient to allow artisan to implement functional claim language as integral whole*
 - *For processes/methods, specification (or figures) must disclose algorithm/steps*
- Use of “object” statements discouraged
 - *Also use care when characterizing “the invention” (may limit claim scope)*
- If “examples” are included:
 - *Working examples should use past tense*
 - *Prophetic (or paper) examples should use future or present tense to make clear merely prophetic nature*
- Abstract: limit of 150 words, and should not use claim-like terms (wherein, etc.)

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)”
- If there is only one figure, must omit “FIG. 1” label
 - *Describe it as the “sole figure” in text*

Special Considerations for Design Patent Applications

- Drawing requirements substantially different from other countries
 - *Photographs generally not accepted; use black & white line drawings*
 - *May need additional views (or text 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*
- Estoppel may attach and limit scope of claim if alternative embodiment shown in originally-filed drawings is deleted (but can file divisional application to protect it)

Thank You

Austen Zuege

azuege@wck.com

+1 (612) 330-0585

www.wck.com

[Bio/CV](#) | [LinkedIn](#)

Legal blog: blueovergray.com



Westman, Champlin & Koehler, P.A.
121 South Eighth Street, Suite 1100
Minneapolis, MN 55402
USA