

## **Traps for the Unwary:**

### **A Baker's Dozen of Cautionary Points for the Brave U.S. Patent Attorney**

**By**

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I have been practicing law for over thirty years. For the majority of those years I have been blessed with the ability to practice intellectual property law, largely in a transactional context. While it is not an easy job, compared to my peers who went into litigation (and are now having heart attacks and bypass surgeries), my practice is relatively low stress. My colleagues in the IP bar and I are happily plodding along -- with more years to come.

Unfortunately, in my thirty years of IP practice I have found that there are some instances that can create at least a figurative cardiac event. I wish to share some of these with you in no particular order in hopes that you can avoid these "traps for the unwary."

#### **1. Be Wary of the Official Filing Receipt from the U.S. Patent Office**

You filed a new patent application for your client. Three weeks later you receive the Official Filing Receipt. You check the Filing Receipt to make sure the Office received your filing fee and has recognized your priority claims. All is well, right? In the famous words of Lee Corso on ESPN College GameDay: Not so fast.

Always go back to Private PAIR and check the Office's web-based files. The Patent Office will not tell you in their Private PAIR e-mail if there are missing parts, at least not explicitly. You have to check Private PAIR itself to see if there are missing fees or a missing inventor signature. Failure to respond to a Notice to File Missing Parts that is hiding in the file history will cause your otherwise perfectly good patent application to go abandoned. Sadly, you will not realize there is a "missing part" until the Notice of Abandonment hits your In Box in six months.

#### **2. Be Wary of the Corrected Notice of Allowance**

Congratulations! The U.S. Patent Office has allowed your client's claims and you are ready to pay the Issue Fee. But then you receive an odd mailing from the Examiner – a Corrected Notice of Allowance. This looks imminently harmless and you happily move it into your digital filing system and move on to the next e-mail.

The problem is that this is a trap. If you receive a Corrected Notice of Allowance, the Patent Office requires you to file a separate request to have a previously paid Issue Fee applied to the new ("Corrected") Notice of Allowance. Failure to file this request will cause your patent application to go abandoned.

### **3. Be Wary of Inventor Names**

When the Official Filing Receipt comes in, carefully check the spelling of the inventor names. Make sure the names listed in the Filing Receipt match the names listed in the application papers, e.g., the Application Data Sheet. Correcting inventor names and inventor lists is easy early in the case. Correcting inventor names and inventor lists is difficult (and expensive) after the Issue Fee has been paid.

Note that if an inventor gets married or otherwise changes their name, strictly follow the procedure of 37 CFR 1.48 for correction of inventorship.

### **4. Be Wary of “The Boss”**

On a related matter, pay attention to the list of inventors that is sent to you with the technical disclosure. A flag should go up when there are more than three inventors listed in the disclosure, or when “the boss” is listed at the top of the disclosure.

R&D managers and company owners are notorious for slipping their names into patent applications. Even this week I received an e-mail from a client saying “I own this company and these are my ideas. I should be on the patent application.” That is always a delicate conversation since he is probably the one paying (or at least approving) the bills. Remind the boss that only those who conceive a limitation in at least one claim is an inventor.

### **5. Be Wary of the Lateral Attorney’s Docket**

The process of on-boarding a new attorney could be the subject of a one hour ethics presentation. For purposes of this article, I can say that the greatest risk that any law firm can take is when it on-boards an IP attorney with his or her own busy docket. The attorney will come in with literally hundreds of files, each with its own set of deadlines.

The new law firm cannot bill for the time it takes to enter all of these new matters and deadlines into its system. However, the law firm must make sure that the new lateral attorney is overseeing this process and that all deadlines are accurately merged into the new system. A missed docket entry will turn into a missed deadline.

### **6. Be Wary of Countries That are not Signatories to the PCT**

As of this writing there are over 150 “contracting states” to the PCT. Almost any country your client would want to file in will be a PCT country. However, there are a few non-participating countries that are worth mentioning. These include:

- Argentina;
- Paraguay;
- Uruguay;

- Venezuela;
- Bolivia; and most notably,
- Taiwan.

In addition, the Gulf Cooperation Council which represents six or seven Middle East states is not a signatory.

If you wish to file a national patent application in the GCC or any of these countries, it must be done within twelve months of your first priority application.

## **7. Be Wary of the One-Year Deadline for Claiming Priority**

In the United States, a unique feature of the U.S. patent system is that we can file provisional patent applications. These applications will not be substantively examined by the U.S. Patent Office; they are mere placeholders. Provisional patent applications are maintained by the Office in confidence and cannot be accessed by the public.

For a mere \$150 government filing fee, a provisional patent application provides the client with several nice benefits. These include:

- the receipt of a U.S. Serial No.;
- an international priority date; and
- the right to say “patent pending.”

We can claim priority to the provisional patent filings in future foreign applications. My foreign colleagues will bristle at this last statement as many countries are quite strict on the antecedent basis requirements and provisional filings are frequently minimalistic, but still, we can make the priority claim and in the vast majority of cases no problems arise later.

The non-provisional utility patent application must be filed within twelve months of the first provisional application. But do not forget, that same twelve-month deadline applies to your PCT filing and your non-PCT countries as well.

Be courteous to your foreign counsel and give them at least several weeks advance notice of a foreign filing. Note that some law firms increase their hourly rates for rush projects.

## **8. Be Wary of the Notice of Incomplete Application in a PCT Filing**

With all due respect, the forms generated by the International Bureau can be quite cryptic. A Notice of Incomplete Application will tell you if something is missing from your application, but in many cases it will not give you any details. If you aren't sure as to what is missing or how to respond, it is best to call the international help desk. If you don't respond to the Notice correctly, the next notice you get will be one of abandonment.

## **9. Be Wary of the Preliminary Amendment**

It is not uncommon for the United States patent practitioner to file a Preliminary Amendment when or shortly after a utility patent application is filed. This may particularly be done in connection with a national phase filing or a continuation filing. Amendments to the Specification may also sometime be made during a Response to an Office Action. If you amend the Specification in any of these instances, be sure to also file a “Substitute Specification.” This is a specification that includes all amendments, in clean form.

Failure to file a Substitute Specification will draw an objection.

## **10. Be Wary of the Written Opinion**

When a PCT application is filed, the applicant must select an International Searching Authority, or ISA. That ISA will conduct a search and issue a Written Opinion along with an International Search Report, or ISR. The Written Opinion and ISR will typically arrive within six months of the PCT filing date.

Regardless of what the ISA says about the claims, good, bad or indifferent, the U.S. patent practitioner must inform the patent examiner of the Written Opinion and the ISR. Failure to submit these materials to the Examiner can produce an allegation of inequitable conduct someday when the patent is in litigation.

## **11. Be Wary of the Final Office Action**

If you receive a final rejection in an Office Action, U.S. procedures allow you to submit a Response without payment of a fee. The Examiner is then obligated to at least look at the Response. If the Response places the application in a condition for allowance (preferably without any further searching or analysis by the examiner), the examiner can then issue what is known as an after-final allowance. This avoids the filing of an RCE and the payment of a new government filing fee.

However, the Response must be filed within two months of the mailing of the final Office Action. The earlier the after-final response is submitted, the more likely you are to receive substantive attention from the examiner.

## **12. Be Wary of Payment of the Issue Fee**

When a Notice of Allowance is received, the Patent Office will send you an Issue Fee Transmittal form. The applicant is given three months in which to pay the Issue Fee. The trap is that the three-month deadline is non-extendable.

If your client contact is foreign counsel, it is important to report the deadline for payment of the Issue Fee as soon as possible. Foreign counsel’s client may be slow in approving the payment of the Issue Fee.

Be sure that your Inventor Declarations are on file well before the Issue Fee is due. If you file an RCE to buy more time to gather inventor declarations (in spite of repeated pleas to the inventors to sign their Declarations), the USPTO will (a) say your application is not complete, (b) the RCE therefore is improper and (c) the application is abandoned for failure to timely pay the Issue Fee.

### **13. Keep the Process Friendly**

In many areas of law it is about confrontation, but in patent law the first ‘adversary’ is the government agencies. It is better to cooperate rather than confront. We tell our clients that the patent system is “non-adversarial,” and that the process works more smoothly if we keep that in mind. Frequently, the examiner at the government office wants to help you -- given a chance.

There is a published OED opinion where an attorney left less-than-kind voice mail messages with the Trademark Trial and Appeal Board. The OED suspended him from the practice of law for a period of time and ordered that he undergo anger management counseling to keep his license.