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Working with the U.S. Patent and Trademark Office

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Cursor note: This is the second article in a series on intellectual property protection that continues from [Preparing a Patent Application](#).

The more that you as software inventors know about working with the U.S. Patent and Trademark Office (USPTO), the more you'll improve your experience with the process and provide your legal counsel with the information he or she needs to achieve success on your behalf. This article provides some basics on the filing of a patent application with the USPTO.

Submission to the USPTO

- Patent applications can be submitted via surface mail or electronically. See the [USPTO Web site](#) for instructions.
- Required components include claims, specifications and drawings (all explained in my article [Preparing a Patent Application](#)) and declaration and fees (explained in this article).
- Optional components include assignments, powers of attorney, information disclosure statements and requests for non-publication (explained in this article). Note that a request for non-publication can be submitted only at the time the patent application is filed.

Declaration or oath

- Every patent application must be accompanied by a declaration — essentially a statement made under penalty of perjury — signed by the inventors, indicating that the patent application describes their invention.
- It is important that the inventors sign the declaration only after reviewing the final text and components of the application. In other words, if you sign before final changes are made, you may be swearing to something that does not accurately describe your invention.

Power of attorney

- Assuming you have an attorney working for you on the patent application, you should submit a “power of attorney” to the USPTO. The power of attorney gives your attorney the right to interact with the USPTO on your behalf.

- Your attorney can prepare a power of attorney form for you. In some cases, the power of attorney can be combined with the declaration.

Fees

- Patent application fees are calculated based on a variety of factors, including size of company, size of application and number of claims. Your attorney will calculate this for you.

Assignment

- You should inform the USPTO in writing about who will be assigned the rights to the invention. In other words, you should designate the “assignee.” This can be done after the original application is submitted, and there is a fee to record the assignments.
- Assignments of patent applications are public records; anyone can review the assignments.
- The assignee can be one or more individuals or a company. It is not uncommon for employment agreements to require that employees assign their interest in any inventions to the company.

Filing receipt

- After submitting an application, you or your attorney will receive from the USPTO a filing receipt indicating your official filing date — either the date the USPTO received the application or the date of postmark by the U.S. Postal Service, depending on your method of submission.
- This receipt will include a serial number assigned to your application by the USPTO. This number will remain with your application while the application is pending before the USPTO.
- You also will be informed about the “group art unit” that is assigned to review your application. Group art units are teams within the USPTO that specialize — and have particular expertise — in specific technologies or industries. Assuming the patent application was assigned to the correct group art unit, an examiner within that group art unit will shepherd your application through the examination process and be your primary point of contact. The examiner is not identified on the filing receipt; you will find out which examiner is working on your application when you receive your first detailed response — an “office action” — from the USPTO.
- It is important that you and your attorney double-check the filing receipt carefully to ensure that all information is accurate.

Disclosure

- The inventors, attorneys and all other participants in the patenting process are obligated to provide to the USPTO an “information disclosure statement,” disclosing their knowledge about any other documents, called “prior art,” that might affect the patentability of this invention. This disclosure must be made as soon as possible; this means that when you become aware of any documents that might qualify as prior art you must inform your attorney immediately.

- “Prior art” includes any issued patents (U.S. or foreign), published patent applications (U.S. or foreign) or other documents (e.g., journal articles, symposia papers, white papers and even lecture handouts) that might be pertinent to the examination of your patent application. To qualify as material prior art, the document must have been published at least before the date you filed for the patent application. Anything published after the filing date of the patent application is not prior art.
- Given how fast the software field moves, relevant prior art is often not known or available by USPTO search until after the patent application is already filed.
- Note that you are required to disclose only what you actually know about. You are NOT required to go searching for prior art that you do not know about.
- If you know that some prior art exists, it might be worthwhile to perform a search. It is usually less expensive to do the search yourself on the USPTO Web site than to have your attorney do it. If you have found prior art, you may more successfully craft your patent application to distinguish it from that prior art. This is best done before the application is written.

Publication

- It is standard USPTO procedure to publish patent applications. This typically happens 18 months after the earliest priority date. Your priority date would be the date you filed the patent application if it is not related to any patent applications you filed earlier. If, on the other hand, you claimed priority back to an earlier patent application — indicating that at least part of the invention was disclosed in the earlier patent application — then your priority date would be the priority date of the earlier patent application.
- The application will be published with its originally submitted content — not including any future amendments — unless you file additional paperwork and pay additional fees.
- Your patent application is secret until published, at which time the file is open for anyone’s review. The file includes the originally filed application and any subsequent modifications to it, and arguments made by you, your attorney and the patent examiner.
- If you are filing foreign patent applications for this same invention, publication of your application is usually required. But if you are filing only the USPTO application, you may request in writing that it not be published. The form is available on the USPTO Web site, and your attorney will be familiar with its use. Note that requesting non-publication **MUST** be done at the time the patent application is filed; non-publication cannot be requested later.
- There are other related rules to consider, so consult with your attorney.

Now that we’ve looked at the formal process for filing the patent application, in the next article we will discuss the process of moving the application through the USPTO, ideally to issuance.

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