

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Understanding the Application Data Sheet (ADS): Little Things Make a Big Difference

Office of Innovation Development

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Email questions to:
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Overview

- **Understanding the Application Data Sheet (ADS)**
 - Explanation of the ADS, including revisions, and who reviews it
 - Time frame for submission of the ADS

Send your questions to: inventorinfochat@uspto.gov



Definitions

- **The ADS:**
 - is used to provide inventor name(s), applicant name(s), correspondence address, any domestic benefit or foreign priority claim(s), and other bibliographic information; and
 - is considered to be part of the application when submitted with the application on filing
- **Office of Patent Application Processing (OPAP)**
 - the first area that handles a patent application
- **USPTO's Electronic Filing System, EFS-Web**
 - Enables applicants to submit applications electronically rather than by mail or hand-carry

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America Invents Act (AIA)

- **Changes relating to ADS and the Inventor's Oath or Declaration became effective September 16, 2012**
 - Requires use of Application Data Sheet (ADS) for certain types of information
 - Delayed timing for filing the inventor's oath and declaration if a proper ADS is submitted
 - "Applicant" and "Inventor" are no longer necessarily the same



Who Reviews the ADS?

- OPAP is the area that primarily reviews the ADS
 - Captures bibliographic data into office automated systems
 - Records authorizations to provide and receive applications to/from other partner countries
 - Corrects bibliographic data

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Submit an ADS on Day of Filing

- The Office strongly recommends submitting an ADS with the application at the time of filing rather than after filing the application
- The ADS submitted upon filing must be properly signed by party under 37 CFR 1.33(b)
 - S-signature must be acceptable
 - Complete registration number (if a patent practitioner)
 - Printed name must accompany signature
 - If a juristic entity (*e.g.*, a company) is identified as the applicant then the ADS must be signed by a patent practitioner

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S-Signature 37 CFR 1.4(d)(2)

- The S-signature must consist only of letters (including Kanji, etc.), or Arabic numbers, or both, and appropriate spaces, commas, periods, apostrophes, or hyphens for punctuation.
- The person signing must insert his or her own signature between the forward slash marks, § 1.4(d)(2)(i).
- The name of the person signing must be printed or typed immediately adjacent (i.e., below, above, or beside) to the S-signature, and be reasonably specific, so the identity of the signer can be readily recognized.
- A registered practitioner may S-sign but his or her registration number is required, either as part of the S-signature, or immediately below or adjacent to the signature (§ 1.4(d)(2)(ii)).
 - For example: /John Attorney Reg. #99999/
John Attorney

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Handwritten Signature 37 CFR 1.4(d)(1)

- **The handwritten signature must:**
 - Be an original, that is, have an original handwritten signature personally signed, in permanent dark ink or its equivalent, by that person; or
 - Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ [1.6\(d\)](#)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.
- **There is no requirement for a printed name to accompany a handwritten signature**

Effect of a Properly Signed ADS

ADS

Properly signed

Establishes inventorship

Establishes applicant

Presents domestic benefit/foreign priority claims

Does NOT establish power of attorney

ADS

*Unsigned or **not** properly signed*

Does not set inventorship

Does not set applicant

Does not effectively present domestic benefit or foreign priority claims

Most information is disregarded and captured from other documents

Information captured from other sources will become "**of record**" and any changes to this information must be made using a properly signed, properly marked-up ADS

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General Information

- OPAP will capture information as it is provided; we will not attempt to correct:
 - Transposed or misspelled names
 - Misspelled words in title
 - Incorrect application numbers in domestic benefit/priority claims

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General Information, cont.

- If ADS is not signed, or not properly signed, it is treated as transmittal letter only
 - Will not set inventorship or applicant
 - Will not establish benefit or priority claims
- Information can be captured from other sources and will become “of record”

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ADS Submitted After Filing

- All ADSs submitted after filing must be properly marked up
 - **Even if it is the first ADS submitted**, because information was gathered from other documents upon filing and made of record
 - Changes should be shown relative to information of record
 - Informally called a “Corrected” ADS
- **Other papers and/or fees may need to accompany a Corrected ADS, depending on when it is filed and nature of changes**
 - Changes to applicant – request (Form AIA/41 or equivalent); § 3.73 Statement
 - Changes to entity status – certification, written statement, or petition may be required
 - Changes to inventorship – request (Form AIA/40 or equivalent), fees, statements, inventor’s oath or declaration may be required
 - Changes to domestic benefit or foreign priority claim may require a petition, fee and statement of unintentional delay

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Applicant and the ADS

- Inventor is recognized as applicant by default if an applicant is not otherwise named in a properly signed ADS
- Changing applicant to any other party requires a request under 37 CFR 1.46(c)(2)
- Requirements to comply with 37 CFR 1.46(c)(2)
 - “Corrected” ADS with proper markings
 - Statement under 37 CFR 3.73(c)

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Applicant and the ADS, cont.

- **Applicant can only be changed, not deleted**
 - Change in applicant requires a § 3.73 Statement (Form AIA/96 or equivalent) to show ownership to new applicant
 - Correction or update in the name of the applicant requires a “Corrected” ADS
 - Changing applicant to the inventors requires a § 3.73 Statement showing title back to inventors
 - A § 1.182 petition is required to attempt correction/removal of an improperly named applicant

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Domestic Benefit/Foreign Priority

- Domestic benefit or foreign priority data only captured from ADS – no consideration given to specification or any other document
- Benefit claims are captured as provided on ADS
- OPAP does not attempt to correct benefit claims that are missing, incorrect, improperly formatted, or not properly marked up

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Domestic Benefit/Foreign Priority

- **Domestic benefit or foreign priority claims must be made timely**
 - Must be presented within the later of 4 months from the actual filing date of the later-filed application or 16 months from the filing date of the prior-filed application (except in design applications)
 - Corrections to benefit claims must also be made within above time periods
 - Benefit claims or corrections made outside time periods must petition to accept late claim

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Benefit Claims

- **Indicate correct relationship of domestic benefit applications listed on ADS**
 - Misidentifying a 111(a) CON of a 371 national stage entry of PCT application will result in the application being processed under an incorrect statute
 - Non-specific relationship identifier will prevent capture; relationship should be any one of:
 - Continuation (CON)
 - Divisional (DIV)
 - Continuation-in-Part (CIP)
 - Reissue (REI)
 - National Stage (NST)
 - Claims benefit of (PRO) – for benefit to provisional only

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Benefit Claims, cont.

- **Incorrect order or relationship may prevent accurate capture**
 - The order of the applications should be listed beginning from the instant application and continuing through the list of parents in reverse chronological order (newest to oldest).
 - Leave the “Application Number” field blank for direct benefit claims (This application is...)

| Prior Application Status | | | <input type="button" value="Remove"/> |
|--------------------------|-----------------|--------------------------|---------------------------------------|
| Application Number | Continuity Type | Prior Application Number | Filing Date (YYYY-MM-DD) |
| | | | |

Benefit Claims, cont.

- Inconsistencies between filing date provided and USPTO records will be noted on filing receipt
- § 371(c) date of National Stage applications will be retrieved instead of date filed in PTO

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ADS Common Problems:

Filing by Reference

- Filing by Reference (FBR) section completed by mistake
 - Filing by Reference **is not** a benefit claim
 - 35 U.S.C. 111(c) prohibits rescission of FBR
 - In limited circumstances, a petition under 37 CFR 1.182 may be available

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ADS Common Problems, cont.:

Reference/Benefit/Priority Sections

- Reference filing section completed by mistake
- Domestic benefit or foreign priority data missing, incorrect, improperly formatted, or not properly marked up
- Domestic benefit or foreign priority claims not timely
 - must be presented within the later of 4 months from the actual filing date of the later-filed application or 16 months from the filing date of the prior-filed application (except in design applications)

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ADS Common Problems, cont.:

General

- Application not properly identified (when filing an ADS after the filing date) with application number and title
- ADS not properly signed (e.g., incorrect slashes, no registration number, not all inventors) – invalidates ADS
- ADS not properly marked up when submitted after filing
- Inventor mailing address or residence not completed properly (i.e., city/state/country missing or not completed, invalid country name provided)

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ADS Common Problems, cont.:

Applicant Issues

- Failure to use proper markings to show changes to the information of record
- Failure to provide a proper § 3.73 statement, when required
- A rejection of a change of applicant may affect a concurrently-filed power of attorney
- Correction/update of applicant name can be mistaken for change of applicant – use Form AIA/41 or be sure to state in request that the change is requested under 37 CFR 1.46(c)(1)

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ADS and Inventor's Oath/Declaration

- When the ADS sets inventorship, the name provided on the inventor's oath or declaration must match the name set forth in the ADS
 - Both documents require legal name
 - If names do not match, new inventor's oath or declaration or § 1.48 request will be needed
 - Exception for character substitution for characters that cannot be entered on ADS (for example: ss for ß, ae for ä, oe for œ)

Corrected ADS

- A corrected or later-filed ADS (for applications filed on or after September 16, 2012) must be marked up as set forth in 37 CFR 1.76(c)
 - The corrected ADS will not be processed unless markings properly showing the changes are provided
 - For more information on a corrected ADS, see MPEP 601.05(a)

Corrected ADS, cont.

- A corrected or updated ADS may include:
 - All sections listed in §1.76(b), or
 - Only those sections containing changed or updated information (§1.76(c)(2))
 - All information in the section must be provided, with identification of what has changed in the section
 - Underlining for insertions, strike-through or brackets for deletions
 - Bold, highlighting, comments, italics, other formatting, etc. are not acceptable markings
 - Unmarked information will not be reviewed

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Showing Changes on a Corrected ADS

- Changes should be shown relative to the information of record, which is generally what is shown on the most recent filing receipt
 - Inventor names may appear on the filing receipt even if inventorship has not been set by ADS or oath/declaration
 - Changes to applicant should include applicant as listed on filing receipt
 - ADS must include all information in the section that contains changes – not just provide information that is being added/corrected

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Corrected ADS in EFS-Web

- Office form – almost always best option
- Best way to avoid rejection due to improper markings
- Will retrieve information of record, eliminating guesswork as to what has been captured and is “of record” with the Office
- OPAP no longer captures non-established inventors; only “of record” info is recorded
- Some info will be recorded, but not shown on the filing receipt – mailing address, phone/fax/email

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Web-based ADS and Corrected ADS

- Web-based ADS has a pre-population feature which can pre-populate inventor, benefit claim and foreign priority information
- Quick Start Guide for Web-based ADS

www.uspto.gov/sites/default/files/documents/Quick%20Start%20Guide%20WebADS.pdf

- Corrected Web-based ADS will pre-populate with information that the Office has of record and create the required markings
- Quick Start Guide for Corrected (Web-based) ADS

www.uspto.gov/sites/default/files/documents/Corrected-WebADS-QSG.pdf

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Resources

- How to get help
 - Application Assistance Unit, 571-272-4000
 - Patents Ombudsman, 571-272-5555 or <https://www.uspto.gov/patent/ombudsman-program>
 - Inventor Assistance Center, 571-272-1000 or <https://www.uspto.gov/learning-and-resources/support-centers/inventors-assistance-center-iac>

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Other Helpful Information



Electronic Submissions

- Using correct document descriptions will ensure that OPAP is notified of the incoming request
 - Applicants don't always use correct document descriptions
 - Not all documents create a message
 - Combining requests can cause requests to be overlooked

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Electronic Submissions, cont.

- Some documents that DO NOT trigger notification to OPAP
 - Application Data Sheet
 - Electronic Fee Transmittal
 - Specification
 - Claims
 - Abstract
 - Drawings
 - Miscellaneous Incoming Letter
 - Transmittal Letter/Transmittal of New Application
 - Oath or Declaration filed

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Electronic Submissions, cont.

- **Some documents that DO trigger notification to OPAP**
 - Applicant Response to Pre-Exam Formalities Notice
 - Request for Corrected Filing Receipt
 - Power of Attorney
 - Request under Rule 48 correcting inventorship

Upcoming OI Events

- May 17– Inventor Info Chat: Understanding Prior Art And Its Use In Determining Patentability
- August 17-18, 2018 – Invention Con –
- For more information or to register for any of the above events contact us at oidevents@uspto.gov

<https://www.uspto.gov/patents-application-process/inventor-info-chat>





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Thank You!

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To inquire about OID services please contact us at:

InnovationDevelopment@uspto.gov

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