

UNITED STATES
PATENT AND TRADEMARK OFFICE



**Thank you for logging in for the Inventor Info Chat.
The program will start at 11:00 am.**

Tips for Responding to a Pre-Examination Notice

Janice Tippett

Program Analyst, Office of Patent Application Processing
United States Patent and Trademark Office

Email questions to:
inventorinfochat@uspto.gov

UNITED STATES
PATENT AND TRADEMARK OFFICE



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Pre-Examination Notice

- Response period starts on the date the USPTO mails the Notice
- Extensions of time are available in 1-month increments until the maximum time expires
- Extensions of time are not available retroactively
- Response period continues to run until all items and needed extensions of time are submitted



Pre-Examination Notice

Determining the time period for response:

59
CN 59
August 23
600 DULANY STREET
Roadrunner
ALEX AND RIA, VA 78945

FORMALITIES LETTER



0C000000101869141

Date Mailed: 08/28/2018

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

Items Required To Avoid Abandonment:

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

Email questions to:
inventorinfochat@uspto.gov



Submission Methods

- Regular USPS mail with Certificate of Mailing (37 CFR 1.8)
- USPS Priority Mail Express[®] Post Office to Addressee service (37 CFR 1.10)
- EFS-Web (registered users only)
- Facsimile to the USPTO Official Fax Number (571) 273-8300



Electronic Submissions

- Responses that include fee payments, ADS, or drawings should not be submitted without being accompanied by an “Applicant Response to Pre-Exam Formalities Notice” document
- Many document descriptions do not trigger a notification to OPAP, so response may go unnoticed

ADS/Inventor's Oath in Response

- **Inventor's Oath/ADS not provided**
 - Requires either executed inventor's oath or a properly marked up, properly signed ADS that establishes inventorship
 - Not the same as a request under 37 CFR 1.48
- **Mailing address not provided**
 - Requires either a new inventor's oath that provides the mailing address/residence of the inventor or a properly signed ADS that has the mailing address and/or residence properly marked up

ADS/Inventor's Oath in Response

- If *Inventor's Oath* is required, check name on ADS for accuracy
- If *ADS or Inventor's Oath* is required, ensure ADS has been properly signed and/or marked-up



ADS in Response, cont.

- **Inventor names**
 - ADS not provided or improperly signed upon filing, and
 - Inventor Oath not provided for each named inventor
- **After examination**
 - Applicant may need to supply inventor's oath or correct inventor name on ADS (requires 1.48)



ADS in Response

- Correcting and updating an ADS is addressed in 37 CFR 1.76(c)
- The information required on the Notice must be properly marked up
 - An unmarked ADS is not acceptable in response to an OPAP notice
- **The ADS must be properly signed**
 - If an applicant company has been/is being established, registered practitioner must sign
 - If applicant individual has been/is being established, applicant or registered practitioner may sign
 - If no applicant has been/is being established, all inventors or a registered practitioner may sign



ADS in Response, cont.

- Generally, the only information on an ADS that affects the response is:
 - Inventor names
 - Mailing address/residence of inventor
 - Indication of small entity status
 - Applicant information

ADS in Response, cont.

- Information on an ADS that will not affect the response is:
 - Title, docket number changes
 - Filing by reference changes, deletions*
 - Domestic or foreign benefit claims

*Unless no filing date has been granted

ADS in Response, cont.

- **Indication of small entity status**
 - Will affect any fee amounts that are required by the Notice
 - Micro entity status must be established on a proper micro entity certification

ADS in Response, cont.

- **Applicant information**

- Will affect response only when inventor's oath is submitted for a non-signing inventor
- New establishment of applicant must comply with 37 CFR 1.46
- Correction of applicant/applicant name may make a previously submitted substitute statement acceptable

Fees in Response

- **Fee amounts must be paid in full according to the entity status in effect at the time of payment**
 - Entity status change may be included with response
- **Application size fee cannot be reduced or waived by elimination of pages**
- **Excess claims fees may be reduced by amendment included with response**



Substitute Specification

- Problems with the specification frequently require a substitute specification as part of the response
- If complete substitute specification is not received, the *Notice of Incomplete Reply* may contain the same objection text



Substitute Specification

- **Review Notice for description of the problem and correction required**
 - Notice will contain the requirements for a proper response
- **Most specification issues will require a proper substitute specification**
 - Must be relative to the specification of record
 - Sub spec requirement contains 3 pieces:
 - Marked-up copy showing all changes*
 - Clean copy containing the changes made
 - Statement that the sub spec contains no new matter

Substitute Specification

- **Parts of a substitute specification are:**
 - Marked-up copy, *relative to most recent accepted specification*
 - Clean copy containing the changes
 - Statement that the substitute specification contains no new matter
 - Does not include claims, abstract, or figures

Substitute Specification Notice Text

- A **substitute specification** in compliance with 37 CFR 1.52, 1.121(b)(3), and 1.125, **is required**. The substitute specification must be submitted **with markings** and be **accompanied by a clean version** (without markings) as set forth in 37 CFR 1.125(c) and **a statement that the substitute specification contains no new matter** (see 37 CFR 1.125(b)). The specification, claims, and/or abstract page(s) submitted is not acceptable and cannot be scanned or properly stored because:
 - The **line spacing** on the specification, claims, and/or abstract **is not 1½ or double spaced** (see 37 CFR 1.52(b)).
 - The application contains drawings, but the **specification does not contain a brief description of the several views of the drawings** as required by 37 CFR 1.74 and 37 CFR 1.77(b)(9).



Requirements for Substitute Specification

- A marked-up copy of the sub spec is not required for formatting corrections:
 - Font size
 - Line spacing
 - Margins
 - Orientation

Requirements for Substitute Specification

- A marked-up copy is required for text and content additions or deletions that are required
 - Brief description of the drawings missing or incomplete
 - Figure(s) embedded in the specification
 - When text appears to be missing or illegible
 - To show removal of text being moved to separate sheet (claims, abstract)

Requirements for Substitute Specification

- **Common problems are:**
 - Marked up copy not submitted when needed
 - Not needed for changes that don't include text changes, such as margins and line spacing
 - Substitute specification not relative to previous specification
 - Contains changes to text that was not part of previous specification
 - Must have marked-up and clean copy for changes in text
 - The Office will not replace the specification with a newly-filed specification

Requirements for Substitute Specification

- Applicant must have included a statement, directed to the substitute specification, that the substitute specification does not include any new matter

Requirements for Substitute Specification

- **Sub spec is not acceptable if:**
 - The response is missing any one of the marked-up copy (when required), the clean copy, and the statement regarding no new matter
 - The sub spec is not relative to the specification of record

Drawing Requirements

- Review the Notice for the correction required
 - Notice will contain the requirements for a proper response:
- **Replacement drawings** in compliance with 37 CFR 1.84 and 37 CFR 1.121(d) **are required**. The drawings submitted are not acceptable because:
 - **The drawing sheets do not have the appropriate margin(s)** (see 37 CFR 1.84(g)). Each 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).
See Figure(s) <figure number>.

Drawing Requirements

- **Replacement drawings** in compliance with 37 CFR 1.84 and 37 CFR 1.121(d) **are required**. The drawings submitted are not acceptable because:
 - The application contains drawings and the specification contains a brief description of the drawings. However, the **specification does not contain a brief description of the several views** of the drawings as required by 37 CFR 1.74 and 37 CFR 1.77(b)(7) **and/or a drawing(s) has not been labeled** in accordance with 37 CFR 1.84(u)(1). **If each figure** is not labeled "Fig." with a consecutive Arabic numeral (1, 2, etc.) or an Arabic numeral and capital letter in the English alphabet (A, B, etc.), **then the drawing(s) must be relabeled** in accordance with 37 CFR 1.84(u)(1). In addition, **if the brief description** of the several views of the drawings **does not refer to the figure(s)** as properly labeled, then **the specification must be amended** to correspond to the figure(s) as properly labeled **and a substitute specification** in compliance with 37 CFR 1.52, 1.121(b)(3), and 1.125, **is required**.

Drawing Requirements

- **When the objection is for figure labeling, correction can be made by either of:**
 - Replacement drawing sheets containing relabeled figures
 - Substitute specification to add/delete references to mislabeled figures
- **An amendment to the specification is not an acceptable response**



Drawing Issues

- **Figures must be labeled in the same way they are described**
- **There are several objections concerning problematic figure labeling**
- **Notice may indicate omitted figures if drawings are not labeled according to the brief description**

Drawing Issues

Brief Description:

Fig. 1 is a smiley face

Fig. 2 is a heart shape

Figures:



Fig. 1



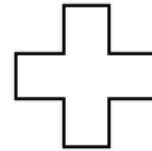
Fig. 2

Drawing Issues - Correct

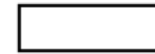
Brief Description:

Fig. 3 is a group of mathematical symbols. Fig. 3a is a plus sign; fig. 3b is a minus sign; fig. 3c is a multiplication symbol; fig. 3d is a division sign.

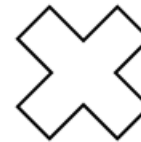
Figures:



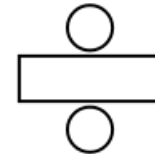
(a)



(b)



(c)



(d)

Fig. 3

Drawing Issues - Correct

Brief Description

Fig. 3a is a plus sign

Fig. 3b is a minus sign

Fig. 3c is a multiplication symbol

Fig. 3d is a division sign

Figures

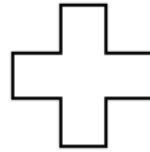


Fig. 3a

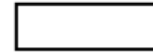


Fig. 3b

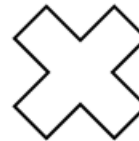


Fig. 3c

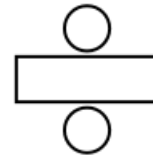


Fig. 3d

Drawing Issues - Incorrect

Brief Description:

Fig. 3 is a group of mathematical symbols. Fig. 3a is a plus sign; fig. 3b is a minus sign; fig. 3c is a multiplication symbol; fig. 3d is a division sign.

(There is no Fig. 3 in the example)

Figures:

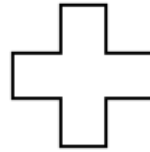


Fig. 3a

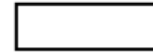


Fig. 3b

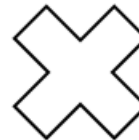


Fig. 3c

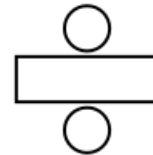


Fig. 3d

Drawing Issues - Incorrect

Brief Description

Fig. 3a is a plus sign

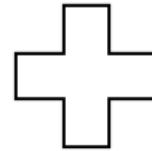
Fig. 3b is a minus sign

Fig. 3c is a multiplication symbol

Fig. 3d is a division sign

(There is a Fig. 3 shown, but no corresponding description provided)

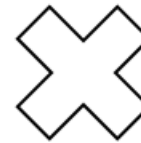
Figures



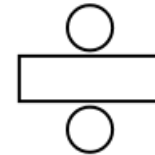
(a)



(b)



(c)



(d)

Fig. 3

Drawing Issues

- Brief description of figures missing – when there is at least one figure that is not described in the specification
 - The application contains drawings, but the specification does not contain a brief description of the several views of the drawings as required by 37 CFR 1.74 and 37 CFR 1.77(b)(9).
- Fix with either
 - a substitute specification to describe each figure that is labeled, or
 - replacement figures that correspond to each figure described.



Drawing Issues

- Figure labeling mismatch

- The application contains drawings and the specification contains a brief description of the drawings. However, the specification does not contain a brief description of the several views of the drawings as required by 37 CFR 1.74 and 37 CFR 1.77(b)(7) and/or a drawing (s) has not been labeled in accordance with 37 CFR 1.84(u)(1). If each figure is not labeled "Fig." with a consecutive Arabic numeral (1, 2, etc.) or an Arabic numeral and capital letter in the English alphabet (A, B, etc.), then the drawing(s) must be relabeled in accordance with 37 CFR 1.84(u)(1). In addition, if the brief description of the several views of the drawings does not refer to the figure(s) as properly labeled, then the specification must be amended to correspond to the figure(s) as properly labeled and a substitute specification in compliance with 37 CFR 1.52, 1.121(b)(3), and 1.125, is required.

- Fix with

- Replacement drawings if the labeling is incorrect, or
- Sub spec if the description is incorrect



Drawing Issues

- More than one figure and not labeled correctly
 - More than one figure is present and each figure is not labeled "Fig." with a consecutive Arabic numeral (1, 2, etc.) or an Arabic numeral and capital letter in the English alphabet (A, B, etc.)(see 37 CFR 1.84(u)(1)). See Figure(s) _____. A brief description of the several views of the drawings (see 37 CFR 1.74) should be added or amended to correspond to the corrected numbering of the figures. See also 37 CFR 1.77(b)(9).
- Figure missing a label, multiple figures with same label
- Fix with replacement drawings
- If figure labels are added that do not correspond with a description in the spec, a sub spec will be needed



Drawing Issues

- Omitted figure – when a figure described in the specification is not shown in the drawings with a separate label

The following item(s) appear to have been **omitted** from the application:

- Figure(s) _____ described in the specification.

- Does not always require a petition
- Often can be fixed under option III with:
 - Replacement drawings
 - Substitute specification



Omitted Items Response

- Page or figure may appear to be omitted if the page numbering is not consecutive or the figure labeling does not agree with the brief description
 - Applicant may accept the application as filed and either submit the item or delete references to the item as described in the Notice



Omitted Items Response

- Does not always require a petition
- Often can be fixed under Option III
 - Replacement drawings
 - Substitute specification
- Requirements for a proper response are on the Notice; need to look closely

Omitted Items Notice

III. Acceptance of application as deposited: Applicant may accept the application as deposited in the USPTO by filing an appropriate amendment as set forth in either (A) or (B) below within **TWO MONTHS** of the date of this Notice. **THIS TWO MONTH PERIOD IS EXTENDABLE UNDER 37 CFR 1.136(a) or (b)**. The application will maintain a filing date as of the date of deposit of the application papers in the USPTO, and original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the date of deposit. A petition is not required for this option.

(A) If applicant wants to accept the application as deposited without adding the subject matter that was in the omitted item (e.g., a missing page or figure), applicant is required to submit one or more of the following items without adding any new matter (see 35 U.S.C. 132(a)):

1. For a missing page of the specification, a substitute specification including claims that amends the specification to renumber the pages consecutively and cancels any incomplete sentences, and a statement that the substitute specification includes no new matter, in compliance with 37 CFR 1.121(b)(3) and 1.125;
2. For a missing figure of the drawings (including a mislabeled figure), replacement drawing sheets in compliance with 37 CFR 1.121(d) to renumber the drawing figures consecutively (if necessary), a substitute specification excluding claims that amends the specification to cancel any references to any omitted drawing(s) and corrects the references in the specification to the drawing figures to correspond with any relabeled drawing figures, and a statement that the substitute specification includes no new matter, in compliance with 37 CFR 1.121(b)(3) and 1.125;

(B) Alternatively, if applicant wants to accept the application as deposited but wishes to add the subject matter in the omitted item (e.g., a missing page or figure) by relying on an incorporation by reference under 37 CFR 1.57 or other portions of the original disclosure, applicant is required to submit one or more of the following items without adding any new matter (see 35 U.S.C. 132(a)):

1. To add the subject matter in a missing page of specification, a substitute specification excluding claims and a statement that the substitute specification includes no new matter, in compliance with 37 CFR 1.121(b)(3) and 1.125;
2. To add a missing figure of the drawings, new and replacement drawing sheets in compliance with 37 CFR 1.121(d);

Upcoming OI Events

- October 21, 2018– Inventor Info Chat: “Como Responder a las Notificaciones Durante el Proceso de Pre-examinación”.
- 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!

Send your questions to: inventorinfochat@uspto.gov

To inquire about OID services please contact us at:

InnovationDevelopment@uspto.gov

1.866.767.3848



Email questions to:
inventorinfochat@uspto.gov

