



US formalities webinar

Anneloes Westein

19/03/2026



INTRODUCTION NLO'S US practice

- 4 US patent attorneys/agents (also EP qualified)
- 4 formalities officers
- Working for both NLO's US cases and US portfolios of outside clients

We daily take care of:

- Filings / Responses to OA's
- Any other communication with USPTO



U.S. Practice

Securing intellectual property rights in the United States offers many advantages. NLO's in-house team of U.S. patent attorneys and agents, authorized to act before the United States Patent & Trademark Office (USPTO), ensures that your patent applications and portfolio are strategically drafted and prosecuted to maximize protection in the U.S. market.

Introduction Kate Bernier and Anneloes Westein



Kate Bernier

- Former US Patent Examiner
- US patent attorney
- Working at NLO since 2019



Anneloes Westein

- EPAC certified formalities officer
- Working at NLO since 2016

Content webinar

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Signed documents:

POA, Oath / Declaration, Assignment

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Your questions

Please put them in the Q&A

**CONTENT
WEBINAR**

Differences between USPTO and EPO



- Forms
- Filing system
- PTA calculations
- No renewal fees until grant
- Official fees have sometimes been lowered at the USPTO
- Helpdesk



Document that require signatures

● Power of Attorney

● Oath / Declaration

● Assignment

What is a Power of Attorney?

A Power of Attorney is a confirmation that a firm/attorney is allowed to act on your behalf.

POWER OF ATTORNEY BY APPLICANT			
I hereby revoke all previous powers of attorney given in the application identified in <u>either</u> the attached transmittal letter or the boxes below.			
Application Number		Filing Date	
(Note: The boxes above may be left blank if information is provided on form PTO/AIA/82A.)			
<input checked="" type="checkbox"/>	I hereby appoint the Patent Practitioner(s) associated with the following Customer Number as my/our attorney(s) or agent(s), and to transact all business in the United States Patent and Trademark Office connected therewith for the application referenced in the attached transmittal letter (form PTO/AIA/82A) or identified above:		
	132452		
OR			
<input type="checkbox"/>	I hereby appoint Practitioner(s) named in the attached list (form PTO/AIA/82C) as my/our attorney(s) or agent(s), and to transact all business in the United States Patent and Trademark Office connected therewith for the patent application referenced in the attached transmittal letter (form PTO/AIA/82A) or identified above. (Note: Complete form PTO/AIA/82C.)		
Please recognize or change the correspondence address for the application identified in the attached transmittal letter or the boxes above to:			
<input checked="" type="checkbox"/>	The address associated with the above-mentioned Customer Number		
OR			
<input type="checkbox"/>	The address associated with Customer Number:		
OR			
Firm or Individual Name			
Address			
City	State	Zip	
Country			
Telephone	Email		
I am the Applicant (if the Applicant is a juristic entity, list the Applicant name in the box):			

How does it need to be signed?

This document needs to be signed by someone authorized to sign on behalf of the applicant.

Signature **Signature**

I am the Applicant (if the Applicant is a juristic entity, list the Applicant name in the box):

Inventor or Joint Inventor (title not required below)

Legal Representative of a Deceased or Legally Incapacitated Inventor (title not required below)

Assignee or Person to Whom the Inventor is Under an Obligation to Assign (provide signer's title if applicant is a juristic entity)

Person Who Otherwise Shows Sufficient Proprietary Interest (e.g., a petition under 37 CFR 1.46(b)(2) was granted in the application or is concurrently being filed with this document) (provide signer's title if applicant is a juristic entity)

SIGNATURE of Applicant for Patent

The undersigned (whose title is supplied below) is authorized to act on behalf of the applicant (e.g., where the applicant is a juristic entity).

Signature	<input type="text"/>	Date (Optional)	<input type="text"/>
Name	<input type="text"/>		
Title	<input type="text"/>		

NOTE: Signature - This form must be signed by the applicant in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. If more than one applicant, use multiple forms.

Total of forms are submitted.

This collection of information is required by 37 CFR 1.431, 1.432, and 1.433. The information is required to obtain or retain a benefit for the public which is to flow from the

When to file?

A POA (Power Of Attorney) is not always required, but it is needed for:

Replacing a prior attorney or agent

Interviews with the examiner; filing terminal disclaimers

What if the applicant does not want to sign?

We can proceed with the application.



What you CAN do

- File an application
- File responses
- Even get a grant without a POA



The risk

If the examiner (or we) want an interview

Oaths/declarations

“A legally required statement by inventors in a patent application, affirming they believe they are the original inventor and that the application was made or authorized by them”

Doc Code: Oath

Document Description: Oath or declaration filed

PTO/AIA/08 (11-15)

Approved for use through 11/30/2027. OMB 0651-0032

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63)	
<input type="checkbox"/> Declaration Submitted With Initial Filing	<input type="checkbox"/> Declaration Submitted After Initial Filing (surcharge (37 CFR 1.16(f)) required)
OR	
Attorney Docket Number	
First Named Inventor	
COMPLETE IF KNOWN	
Application Number	
Filing Date	
Art Unit	
Examiner Name	

<p>(Title of the Invention)</p>
As a below named inventor, I hereby declare that:
This declaration is directed to:
<input type="checkbox"/> The attached application,
OR
<input type="checkbox"/> United States Application Number or PCT International application number _____
filed on _____.
The above-identified application was made or authorized to be made by me.
I believe I am the original inventor or an original joint inventor of a claimed invention in the application.
I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

How does it need to be signed?

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U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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DECLARATION — Utility or Design Patent Application

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers other than a check or credit card authorization form PTO-2038 submitted for payment purposes is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available. Petitioner/applicant is advised that documents which form the record of a patent application (such as the PTO/SB/01) are placed into the Privacy Act system of records DEPARTMENT OF COMMERCE, COMMERCE-PAT-7, System name: *Patent Application Files*. Documents not retained in an application file (such as the PTO-2038) are placed into the Privacy Act system of records DEPARTMENT OF COMMERCE, COMMERCE-PAT-TM-10, System name: *Deposit Accounts and Electronic Funds Transfer Profiles*.

LEGAL NAME OF SOLE OR FIRST INVENTOR:

(E.g., Given Name (first and middle if any) and Family Name or Surname)

Inventor's Signature _____ Date (Optional) _____

Residence: City _____ State _____ Country _____

Mailing Address

City _____ State _____ Zip _____ Country _____

Additional inventors are being named on the _____ Supplemental sheet(s) PTO/AIA/10 attached hereto

PTO/AIA/10 (06-12)
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U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

SUPPLEMENTAL SHEET FOR DECLARATION **ADDITIONAL INVENTOR(S)**
Supplemental Sheet (for PTO/AIA/08,09) Page _____ of _____

Legal Name of Additional Joint Inventor, if any:

(E.g., Given Name (first and middle (if any)) and Family Name or Surname)

Inventor's Signature _____ Date (Optional) _____

Residence: City _____ State _____ Country _____

Mailing Address

City _____ State _____ Zip _____ Country _____

Legal Name of Additional Joint Inventor, if any:

(E.g., Given Name (first and middle (if any)) and Family Name or Surname)

Inventor's Signature _____ Date (Optional) _____

Residence: City _____ State _____ Country _____

Mailing Address

City _____ State _____ Zip _____ Country _____

Legal Name of Additional Joint Inventor, if any:

(E.g., Given Name (first and middle (if any)) and Family Name or Surname)

Inventor's Signature _____ Date (Optional) _____

Residence: City _____ State _____ Country _____

Mailing Address

City _____ State _____ Zip _____ Country _____

A Federal agency may not conduct or sponsor, and a person is not required to respond to, nor shall a person be subject to a penalty for failure to comply with an

When to file an oath/declaration?

As soon as possible!

PCT-US national stage

For national stage applications (PCT-US): you cannot file an RCE if no oaths/declarations are filed.

Before issue fee payment

In any case before the issue fee payment is made.

Examples of Notices requiring inventor's oath or declaration

Date Mailed: 02/26/2026

INFORMATIONAL NOTICE TO APPLICANT

Applicant is notified that the above-identified application contains the deficiencies noted below. No period for reply is set forth in this notice for correction of these deficiencies. However, if a deficiency relates to the inventor's oath or declaration, the applicant must file an oath or declaration in compliance with 37 CFR 1.63, or a substitute statement in compliance with 37 CFR 1.64, executed by or with respect to each actual inventor no later than the expiration of the time period set in the "Notice of Allowability" to avoid abandonment. See 37 CFR 1.53(f).

The item(s) indicated below are also required and should be submitted with any reply to this notice to avoid further processing delays.

. A properly executed inventor's oath or declaration has not been received for the following inventor(s):

An inventor's oath or declaration in compliance with 37 CFR 1.63 or 1.64 executed by or with respect to each inventor must be submitted no later than the date on which the issue fee is paid in response to a notice requiring such fee. See 37 CFR 1.53(f).

Questions about the contents of this notice and the requirements it sets forth should be directed to the Office of Data Management, Application Assistance Unit, at (571) 272-4000 or (571) 272-4200 or 1-888-786-0101.

NOTICE REQUIRING INVENTOR'S OATH OR DECLARATION

An inventor's oath or declaration in compliance with 37 CFR 1.63 or substitute statement in compliance with 37 CFR 1.64 executed by or with respect to each inventor has not yet been submitted.

The inventor's oath or declaration or substitute statement dated 11/19/2025 is defective. The inventor's oath or declaration does not comply with 37 CFR 1.63 or the substitute statement does not comply with 37 CFR 1.64 because it:

does not include a statement that the person executing the oath or declaration or substitute statement believes the named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed invention in the application for which the oath or declaration is being submitted.

does not state that the application was made or was authorized to be made by the person executing the oath or declaration or substitute statement.

does not acknowledge that any willful false statement made in such oath or declaration or substitute statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.

does not identify the person executing the oath or declaration or substitute statement by his or her legal name.

does not identify the application to which the oath or declaration or substitute statement is directed.

Other: Inventor #9 name does not match on Oath & ADS.

The substitute statement dated _____ does not comply with 37 CFR 1.64 because it:

does not identify the inventor with respect to whom the statement applies.

does not identify the relationship to the non-signing inventor.

does not identify the circumstances permitting execution of the statement.

was signed by someone other than the applicant.

Other: _____

An oath or declaration in compliance with 37 CFR 1.63, or a substitute statement in compliance with 37 CFR 1.64, executed by or with respect to each inventor **MUST** be filed **no later than the date on which the issue fee is paid**. See 35 U.S.C. 115(f). Failure to timely comply will result in ABANDONMENT of this application. This period for reply is not extendable under 37 CFR 1.136(a).

What if an inventor does not want to sign?

1

Document the situation

Make sure you have some proof on record that inventor cannot be reached or is unwilling to sign.

2

File a substitute statement

If the inventor is unavailable or unwilling, a substitute statement could be signed (by the applicant).

Example of substitute statement

Doc code: Oath
Document Description: Oath or declaration filed

PTO/AIA/02 (06-15)
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U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

SUBSTITUTE STATEMENT IN LIEU OF AN OATH OR DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (35 U.S.C. 115(d) AND 37 CFR 1.64)

Title of Invention			
This statement is directed to:			
<input type="checkbox"/> The attached application,			
OR			
<input type="checkbox"/> United States application or PCT international application number _____ filed on _____.			
LEGAL NAME of inventor to whom this substitute statement applies:			
(E.g., Given Name (first and middle (if any)) and Family Name or Surname)			
Residence (except for a deceased or legally incapacitated inventor):			
City	State	Country	
Mailing Address (except for a deceased or legally incapacitated inventor):			
City	State	Zip	Country
I believe the above-named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed invention in the application.			
The above-identified application was made or authorized to be made by me.			
I hereby acknowledge that any willful false statement made in this statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.			
Relationship to the inventor to whom this substitute statement applies:			
<input type="checkbox"/> Legal Representative (for deceased or legally incapacitated inventor only),			
<input type="checkbox"/> Assignee,			
<input type="checkbox"/> Person to whom the inventor is under an obligation to assign,			
<input type="checkbox"/> Person who otherwise shows a sufficient proprietary interest in the matter (petition under 37 CFR 1.46 is required), or			
<input type="checkbox"/> Joint Inventor.			

PTO/SB/AIA02 (06-15)
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U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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SUBSTITUTE STATEMENT

Circumstances permitting execution of this substitute statement:

- Inventor is deceased,
- Inventor is under legal incapacity,
- Inventor cannot be found or reached after diligent effort, or
- Inventor has refused to execute the oath or declaration under 37 CFR 1.63.

If there are joint inventors, please check the appropriate box below:

- An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) naming the entire inventive entity has been or is currently submitted.
- OR
- An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) has not been submitted. Thus, a Substitute Statement Supplemental Sheet (PTO/AIA/11 or equivalent) naming the entire inventive entity and providing inventor information is attached. See 37 CFR 1.64(b).

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

PERSON EXECUTING THIS SUBSTITUTE STATEMENT:

Name: _____ Date (Optional): _____

Signature: _____

APPLICANT NAME AND TITLE OF PERSON EXECUTING THIS SUBSTITUTE STATEMENT:

If the applicant is a juristic entity, list the applicant name and the title of the signer:

Applicant Name: _____

Title of Person Executing This Substitute Statement: _____

The signer, whose title is supplied above, is authorized to act on behalf of the applicant.

Residence of the signer (unless provided in an application data sheet, PTO/AIA/14 or equivalent):

City _____ State _____ Country _____

Mailing Address of the signer (unless provided in an application data sheet, PTO/AIA/14 or equivalent)

City _____ State _____ Zip _____ Country _____

Note: Use an additional PTO/AIA/11 or equivalent if the inventor cannot be found or reached.

Assignments

Assignment between inventor(s) and applicant(s)

An assignment is a transfer of ownership of a patent (or trademark) from one party to another. This can include the sale of intellectual property, or as a part of a company merger.

Recording an assignment will have the patent issue in the name of an applicant.

Recording assignments at the USPTO provides a public record of ownership.

ASSIGNMENT BETWEEN:

[Insert name(s) of inventor(s)]

(hereafter: Assignor(s))

and:

[Insert name(s) of applicant(s)]

(hereafter: Assignee(s))

WHEREAS: -

(A) The Assignor(s) is/are the inventor(s) of the Invention(s) known as “ ”, for which patent protection has been applied for in the form of the patent application(s) listed in the schedule below.

(B) The Assignor(s) has/have/had agreed to assign to the Assignee(s), its successors and assigns, all right, title and interest in the Invention(s) and in any and all applications filed thereon, throughout the world and in particular in the United States of America (as defined in 35 U.S.C. § 100) and any territories indicated in the schedule below, including the right to apply for the grant of patents together with the right to apply for the grant of any continuing (continuation, divisional, or continuation-in-part), reissue, reexamination or corresponding application(s) arising from the Invention(s) and improvements and modifications thereof, the right to claim convention priority, the right to be granted patents along with extensions and renewals thereof and the right to enforce any patent(s) granted for the Invention(s) to the full end of the term(s) for which such patent(s) issue, including all claims, if any, that may have arisen for infringement prior to the date of this assignment, such entire right, title and interest to be held and enjoyed by the Assignee to the same extent as they would have been held and enjoyed by the Assignor(s) had this assignment and sale not been made.

(C) The Assignor has further agreed to assign any copyright, design right, know how, or other intellectual properties associated with the Invention(s) to the Assignee(s).

NOW THEREFORE, in consideration of the good and valuable sum of EURO 1.00 and other good and valuable consideration paid by the Assignee(s) to the Assignor(s), the receipt of which is hereby acknowledged, the Assignor(s) hereby assigns/assigns/acknowledges the transfer to the Assignee(s) all of the rights set out under (B) and (C) above.

The Assignee confirms that it has accepted the assignment.

The Assignor(s) agrees/agree to promptly take any action, including the execution of any papers and the provision of any evidence, required by the Assignee(s) or its/their agent(s) to further the grant of any patent application(s) associated with the Invention(s) and any continuing (continuation, divisional, or continuation-in-part), reissue, re-examination or corresponding application(s) filed therefrom, and the subsequent maintenance and enforcement of any patent(s) granted on such application(s), to execute separate assignment(s) in connection with such application(s) as the Assignee(s) may deem necessary or expedient, and to communicate to Assignee(s), its successors and assigns, or their representative or agents, all facts and information known or available to Assignor(s) respecting the Invention and modifications including evidence

How does it need to be signed?

WHO MUST SIGN

Only the assigning party

For example, only inventors need to sign, not the company they assign it to.

- We prefer to have witnesses sign this as well to confirm the signature of the assignor.

US vs. OTHER COUNTRIES

Other countries

Both assignor AND assignee must sign in case of a transfer.

United States

Assignee signature is not mandatory.

Requirements for assignment



- It must be a written document.
- It must be in English or accompanied by an English translation (signed by the translator).
- There needs to be a clear identification of the IP (usually a patent/application number).
- The full names, addresses and relationship of the assignor and assignee must be mentioned.
- A statement of “Exchange of consideration”, e.g. “for \$1 and other good and valuable consideration”.
- It must be submitted with a cover sheet (we file any assignment via USPTO’s Assignment Center, which always provides a cover sheet automatically).

When to file?

1

Flexible timing

An assignment can be filed any time in the procedure, even after grant.

2

File early

We prefer to have it filed as soon as possible, and before the issue fee is paid in order to avoid any legal complications.

3

Confirmation provided

After filing an assignment, you will always receive a Notice of Recordation, which is a confirmation that the assignment was duly recorded.

What if someone does not want to sign?

1 Check employment contract

Check if there is an employment contract, wherein the inventor agrees that any rights to the invention belong to the employer.

We can use this as a form of assignment.

2 No contract available?

Contact your US attorney as there may be other options available.

⚠ Be aware that if the inventor does not want to sign, the inventor could intervene in the prosecution, and may have rights to the patent (depending on laws where invention was made).

Take-aways for the signed documents

- Do ask the inventor/applicant as soon as possible to sign the oath/POA/assignment.
- Check with your US agent as soon as you get an indication that someone is unwilling or unable to sign.

**TAKE AWAY
MESSAGE**

Audience question declaration

In the US Declaration of inventorship form the residence of Inventor needs to be informed.

What is the appropriate information to be used (Inventor's home town, country, applicant (company) information or blank if not known)?

Due to practical and GDPR reasons, minimizing maintenance of personal data is preferred.

Answer: the inventor's residence (city and country when outside USA) typically goes on the declaration; can be a mailing address (e.g. c/o Company xxx etc).

**AUDIENCE
QUESTION**

Information Disclosure Statements

IDS: Information Disclosure Statement.

All applicants have an ongoing obligation to inform the USPTO about any known prior art that is relevant for their patent applications. By submitting an IDS, this duty of disclosure is met.

The prior art can either be US or foreign patent applications, or articles from for example scientific literature.

We need to submit copies of foreign patent documents and non-patent literature.

In case the foreign patent document is not in English, an English translation of its abstract is required.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT	Application Number	
	Filing Date	
	First Named Inventor	
	Art Unit	
	Examiner Name	
	Attorney Docket Number	

U.S. PATENTS							Remove	
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Inventor of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear		
	1							
If you wish to add additional U.S. Patent citation information, please click the Add button.							Add	
U.S. PATENT APPLICATION PUBLICATIONS							Remove	
Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Inventor or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear		
	1							
If you wish to add additional U.S. Published Application citation information, please click the Add button.							Add	
FOREIGN PATENT DOCUMENTS							Remove	
Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ²ⁱ	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1							
If you wish to add additional Foreign Patent Document citation information, please click the Add button.							Add	
NON-PATENT LITERATURE DOCUMENTS							Remove	
Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, page(s), volume-issue number(s), publisher, city and/or country where published.					T ⁵	

When to file an IDS?

- ✓ Upon filing of a new application (national stage (PCT-US), divisional, continuation, etc).
- ✓ As soon as possible when you are informed of any new cited prior art.



When and what to pay for an IDS?

NO FEES DUE - IF FILED:

Within 3 months of the initial filing
Applies to national stage, divisional, and other filing types

Before the issuance of a first Office Action

After issuance of a first OA but within 3 months after the issuance of an OA in a counterpart foreign application (we need to make a statement about this on the IDS form)

Before the mailing of a first OA after the filing of an RCE.

When and what to pay for an IDS (2)?

A fee of \$280 is due if an IDS is filed

After issuance of a first Office Action and the mentioned prior art is known for more than three months

Before payment of the Issue Fee, after receipt of the Notice of Allowance

After a final OA/Notice of Allowance/Ex Parte Quayle and the prior art is known for less than three months

After a final OA/Notice of Allowance/Ex Parte Quayle and the prior art is known for more than 3 months. In this case an RCE is required (\$ 1500 or more)

When and what to pay for an IDS? (3)

As of 19 January 2025, an IDS size fee got introduced:

- 51-99 documents cited: \$200
- 100-200 documents cited: \$500
- More than 200 documents cited: \$800

There is no discount for small entities.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT	Application Number	
	Filing Date	
	First Named Inventor	
	Art Unit	
	Examiner Name	
	Attorney Docket Number	

<p style="text-align: center;">TIMING STATEMENT</p> <p>Please see 37 CFR 1.97(e) to make the appropriate selection(s):</p> <p><input type="checkbox"/> That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).</p> <p>OR</p> <p><input type="checkbox"/> That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).</p> <p><input type="checkbox"/> See attached timing statement under 37 CFR 1.97(e).</p> <p><input type="checkbox"/> A timing statement under 37 CFR 1.97(e) is not submitted herewith.</p> <p style="text-align: center;">TIMING FEE</p> <p><input type="checkbox"/> The fee set forth in 37 CFR 1.17(p) has been submitted herewith.</p> <p style="text-align: center;">COPIES</p> <p><input type="checkbox"/> An identification of an earlier application pursuant to 37 CFR 1.98(d)(1) is attached.</p> <p style="text-align: center;">SIZE FEE ASSERTION</p> <p>Please see 37 CFR 1.17(v) and the IDS Auto-Load Instructions for completing this form to make the appropriate selection of an assertion under 37 CFR 1.98. For the information disclosure statement (IDS) submitted herewith, the applicant or patent owner certifies the following with respect to the cumulative number of applicant-provided or patent-owner provided items of information submitted to date including those in the accompanying IDS (select only one):</p> <p><input type="checkbox"/> No IDS size fee is required under 37 CFR 1.17(v) at this time.</p> <p><input type="checkbox"/> The IDS is accompanied by the IDS size fee under 37 CFR 1.17(v)(1).</p> <p><input type="checkbox"/> The IDS is accompanied by the IDS size fee under 37 CFR 1.17(v)(2).</p> <p><input type="checkbox"/> The IDS is accompanied by the IDS size fee under 37 CFR 1.17(v)(3).</p>

Take-aways IDS

- Regularly check if any new prior art is mentioned in corresponding applications.
- Immediately inform your US agent if new prior art needs to be cited and inform them **when** this new art was cited.
- The 3m deadline is calculated from the DATE of the OA, not the date you were informed about the OA.

**TAKE AWAY
MESSAGE**

Audience question IDS

Two IDS related questions.

Q1. What is your practice with respect to the citation of office actions. I have noticed different approaches between companies I have worked for. Do you only cite the (new) references therein? Or ALSO the office action itself (and EN translation thereof)?

Q2. Do you as an FO always cross-check any references cited in an application itself, if these have been listed in an IDS? Or do you rely on an attorney to point this out (or perhaps a combination of the two)?

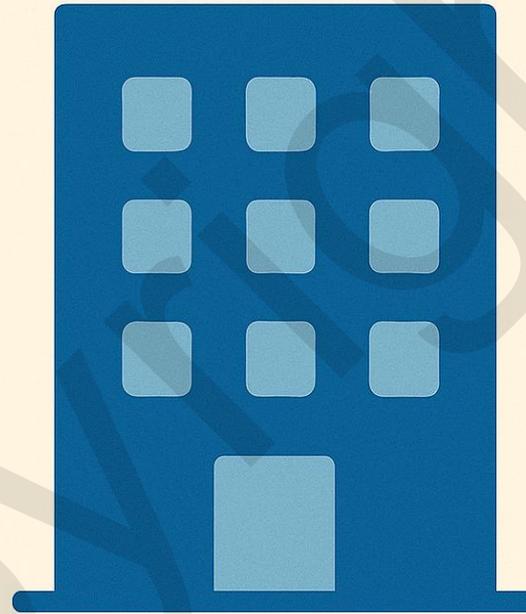
Answer Q1: citing the OA is not compulsory, but some agents do mention it out of habit. The cited documents are most important.

Answer Q2: we rely on the attorney to point this out, but we do doublecheck this before filing, as we prefer to have a complete IDS on filing (references mentioned in the description and mentioned in an SR if available).

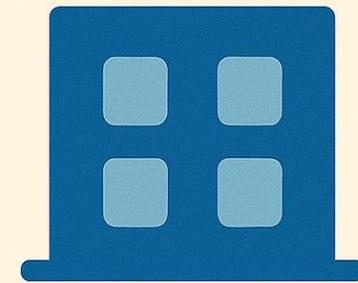
AUDIENCE QUESTION

Entity sizes

Usually any applicant is considered a large entity (USPTO calls it “Regular Undiscounted”), unless they qualify as small entity.



**SMALL
ENTITY**



**MICRO
ENTITY**

Small entity requirements

An applicant can be considered a small entity if:

- It has fewer than 500 employees;
- OR it is a non-profit organization or university;
- OR it is an individual (inventor who did not assign/license to a large entity).
- And no large entity has a stake/interest in the relevant application(s), via e.g. a license.



If you qualify as a small entity, you will get a 50-60% discount on all official fees.

2. Micro entity

Requirements:

- ✓ The applicant has to meet all requirements for a small entity, AND:
- ✓ Meet the income requirement: the gross income per year does not exceed 3x the median household income, AND:
- ✓ the inventor/each joint inventor is not named on more than 4 previously filed non-provisional US applications (this **excludes** provisionals and national stage entries).

There is a **certification of micro entity basis** (form) which has to be filed with the **USPTO** for each application you wish to receive micro entity discount for. Discounts can be 75-80% of the official fees.

Certification of micro entity status

Doc Code: MES.GIB
 Document Description: Certification of Micro Entity Status (Gross Income Basis) PTO/SB/15A (07-14)

CERTIFICATION OF MICRO ENTITY STATUS (GROSS INCOME BASIS)			
Application Number or Control Number (if applicable):		Patent Number (if applicable):	
First Named Inventor:		Title of Invention:	
The applicant hereby certifies the following—			
<p>(1) SMALL ENTITY REQUIREMENT – The applicant qualifies as a small entity as defined in 37 CFR 1.27.</p> <p>(2) APPLICATION FILING LIMIT – Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights, or is obligated to assign all ownership rights, as a result of the applicant's previous employment.</p> <p>(3) GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS – Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.</p> <p>(4) GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST" – Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.</p>			
SIGNATURE by an <u>authorized party</u> set forth in 37 CFR 1.33(b)			
Signature			
Name			
Date	Telephone	Registration No.	
<input type="checkbox"/> There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. The required additional certification form(s) signed by the other joint inventor(s) are included with this form.			

What to ask your client?

01

Written confirmation

Get a written confirmation for your file that they qualify for small/micro entity status.

02

Regular check

Regularly check if the entity status is still correct: any licences, upcoming mergers, or upcoming changes of ownership?

03

Key moments

Especially check upon filing a new application, payment of the issue fee, and payment of the maintenance fee.

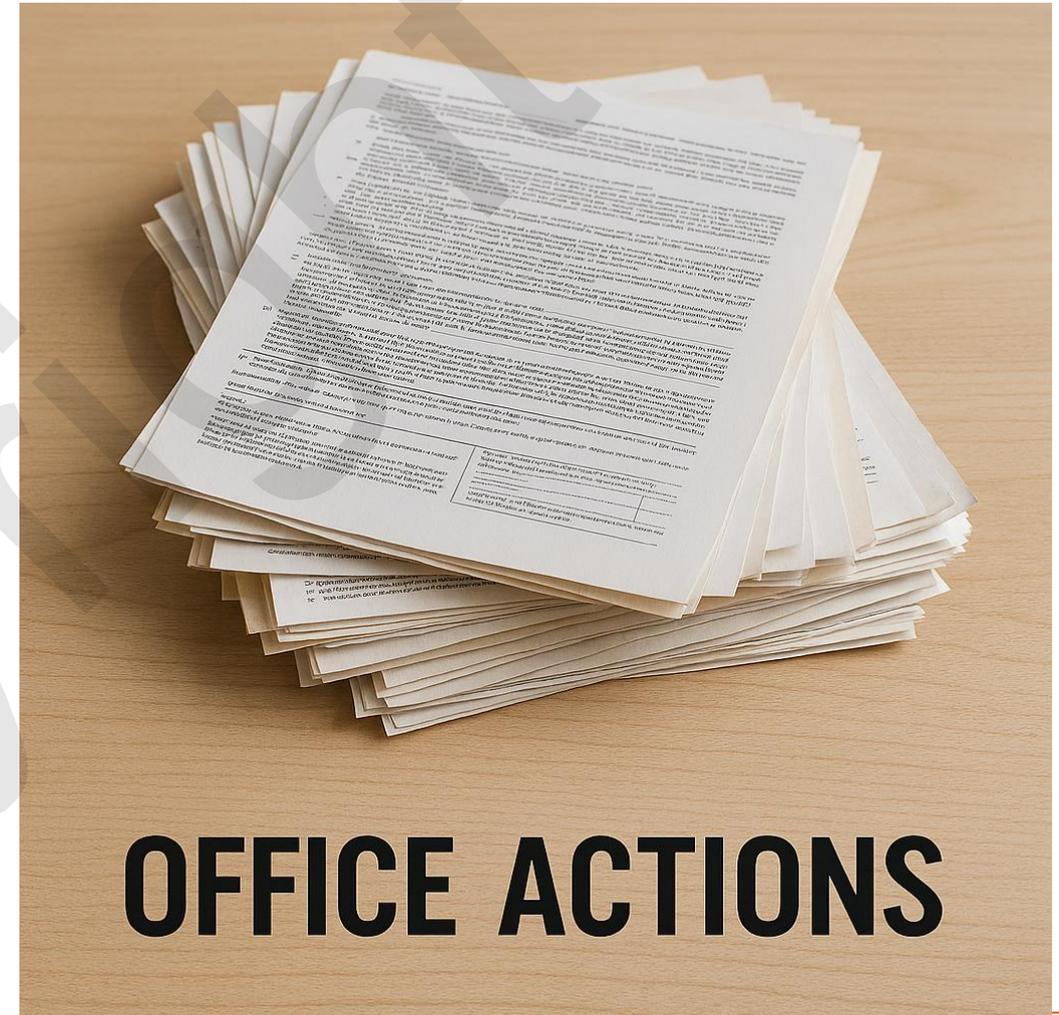
Take-away message entity size

In 2025 the USPTO has expressly authorized the Office of Petitions to review entity status claims. Improper claiming of a reduced entity status is considered **fraud**, and faces serious consequences: fines of “not less than 3 times the amount that the entity failed to pay as a result of the false certification”.

**TAKE AWAY
MESSAGE**

Various kinds of Office Actions

- Extensions of time
- Various kinds of Office Actions (restriction requirement, non-final, final, Ex parte Quayle).



Extensions at the USPTO

- In most cases, you have up to 6 months from the date of an Office Action to file a response.
- You can request extension of time retroactively.

A form for requesting extension of time can be used, but is not mandatory.

Extension fees:

- Month 1: \$235
- Month 2: \$690
- Month 3: \$1590
- Month 4: \$2495
- Month 5: \$3395

small entity:

- \$94
- \$276
- \$636
- \$998
- \$1358

Various kinds of Office Actions: non-final OA

A non-final Office Action raises a first (novelty/inventive step) objection against the application.

A response is due in 3 months from the date of the Office Action (extension possible up to 3 months).

<i>Office Action Summary</i>	Application No.	Applicant(s)	
	Examiner	Art Unit	AIA (First Inventor to File) Status Yes
<p align="center"><i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i></p> <p>Period for Reply</p> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none">- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). <p>Status</p> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>11/28/2025</u>. <input type="checkbox"/> A declaration(s)/affidavit(s) under <u>37 CFR 1.130(b)</u> was/were filed on ____.</p> <p>2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.</p> <p>4) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>			

Various kinds of Office Actions: final Office Action

A final Office Action is issued when the examiner has raised his/her objections with you before and does not think your response resolves his/her objections.

When to file a response:

- Within 2 months (preferred): if the objections are resolved, you may get a Notice of Allowance. If objections are not resolved, you may get an Advisory Action (AA).
- AA: this opens up the **current** deadlines of the final Office Action. The Examiner is not convinced yet by your arguments/amendments, and will give you suggestions about what he/she could grant.
- Why within 2 months: as the AA will open up the current deadlines of the final OA, the sooner you file a response, the sooner you get an AA (or allowance), the less likely you have to pay for extensions.
- OR file a response within the time limit with an RCE (Request for Continued Examination).

Example of final Office Action

Final Office Action issued on 1 February 2026:

- 2 month preferred DL: 1 April 2026; 3m DL without extensions 1 May 2026; final due date including extensions 1 August 2026.
- You file a response without RCE on 15 March 2026.
- You get an Advisory Action on 10 April 2026, which opens up the deadlines again:
 - 3m deadline without extension: 1 May 2026
- If you were to file a response without RCE on 15 April and you got an AA on 10 May, you would have to file a response with RCE AND a one month extension, as the 1 May deadline has already passed.

*Important: should the AA comes late (i.e. at 4 months, you can file an RCE on the day the AA is issued without any extension fees.

Various kinds of Office Actions: final Office Action

Filing a response with a Request for Continued Examination:

- This will remove the finality of the Office Action.
- Does cost quite some money: the fee for a first RCE is \$1500 (\$600 for small entity). The fee for a second and subsequent RCE is \$2860 (or \$1144 for a small entity).

<i>Office Action Summary</i>	Application No.	Applicant(s)	
	Examiner	Art Unit	AIA (First Inventor to File) Status Yes
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>			
Period for Reply			
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.			
<ul style="list-style-type: none">- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).			
Status			
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>11/07/25</u> .			
<input type="checkbox"/> A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on ____.			
2a) <input checked="" type="checkbox"/> This action is FINAL .			
2b) <input type="checkbox"/> This action is non-final.			
3) <input type="checkbox"/> An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.			
4) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.			

Non-final Office Actions and final Office Actions

When can you expect a non-final or a final OA?

An applicant is guaranteed one non-final OA before a final OA is issued. If there are new grounds of rejection after you responded to a first non-final OA, you could receive a new non-final OA.

The following could happen:

- Non-final OA
- Non-final OA
- Final OA (response with RCE)
- Non-final OA
- Final OA

If this is going on, your US attorney will likely conduct an Examiner Interview after receipt of the second non-final OA.

Take-aways Office Actions

Extensions are usually available but can cost quite a bit of money.

In case of a final OA, try to respond within 2 months after issuance of the OA in order to get an Advisory Action early.

**TAKE AWAY
MESSAGE**

Audience questions

1. Could you give more information about the terminal disclaimer we sometimes receive at the grant of a patent?
2. How do you calculate the expiry date of a continuation, CIP and divisional patent application? Is it always the same formula?

See next slides for answers.

**AUDIENCE
QUESTION**

Terminal disclaimers and expiry date calculation

What is a terminal disclaimer?

- You have an ODP rejection: obviousness-type double patenting
- A terminal disclaimer is a legal document filed with the USPTO to overcome a double patenting rejection by agreeing that a later patent will expire on the same date as an earlier, related patent.
- Official fee for filing terminal disclaimer is \$183 (for all entities).

The terminal disclaimer means the second patent expires when the first patent does. It also means the inventor agrees that the patents will remain commonly owned. If the inventor sells the first patent, he or she can't enforce the second one.

Example of terminal disclaimer

We have a granted mother application (Patent 1) and a continuation thereof, which is still pending (Patent 2). In Patent 2 we got a double patenting objection. Let's assume that Patent 1 has no Patent Term Adjustment.

PTA: US extension of the 20-year expiry period of a patent to compensate for administrative delays.

Scenario 1: we object against the double patenting objection, the Examiner agrees and grants a patent. No terminal disclaimer needed. Patent 2 gets a later expiry date than Patent 1: 20 years from filing date, with a PTA of 400 days.

Scenario 2: we file a terminal disclaimer, and the Examiner grants a patent for Patent 2. Patent 2 gets a PTA of 400 days, BUT because of the terminal disclaimer, will expire on the same date as Patent 1.

Expiry date calculation

Use the patent term calculator – provided by USPTO



PATENT TERM CALCULATOR

Clear all entries.

If this estimate is for either a **reexamination** or a **reissue** you must use the **original patent's** information.

NOTE: If you wish to save this file for future reference, please retype the date in this calculated field.

Today's date is:

MM	DD	YYYY
1	22	2019

For what type of patent are you calculating a term?

▼



Explanation

(NOTE: if a **reexamination** or **reissue**, base calculations on the **original patent's** information)

What is the filing date of the patent (U.S. or 371 International Date, if applicable)?

MM	DD	YYYY

Domestic Benefit

Does the patent claim any domestic benefit?

Yes No

If the patent claims any domestic benefit, what is the Earliest Effective Filing Date?

MM	DD	YYYY

Domestic Benefit = Continuation, Continuation-in-Part, or Divisional

What is the grant date of the patent?

MM	DD	YYYY

Terminal Disclaimers

Does the patent have any terminal disclaimers?

Yes No

If there are any terminal disclaimers, what is the earliest TD-based expiration date?

MM	DD	YYYY

Timely Payment of Maintenance Fees

NOTE: For patents that are not designs or plants, maintenance fees must be paid on time to preserve the full patent term. Maintenance fees are due three times during the life of a patent, and may be paid without surcharge 3 to 3.5 years, 7 to 7.5 years, and 11 to 11.5 years after the date of issue and cannot be paid early. Maintenance fees may also be paid with a surcharge during the "grace periods" of 3.5 to 4 years, 7.5 to 8 years, and 11.5 to 12 years after the date of issue.

The dates below reflect the latest possible payment date, including grace periods.

Your first Maintenance Fee should be paid no later than 4 years after issue:

MM	DD	YYYY

Your second Maintenance Fee should be paid no later than 8 years after issue:

MM	DD	YYYY

ANY FURTHER QUESTIONS?

- Please put them in the Q&A of this webinar.
- Let's connect via LinkedIn or westein@nlo.eu.

THANK YOU FOR YOUR ATTENTION!

THANK YOU
ANY QUESTIONS?

Audience question

Situation: there are two applicants for a claimed priority right, and we filed a PCT application claiming this priority with only one of these applicants. We file PCT declarations in which we refer to the two applicants of the priority right.

How do we show to the USPTO how the rights have been transferred from one applicant to another?

Answer: we will have to file 4 things at the USPTO:

- Form to request to change the applicant (Rule 37 CFR 1.46)
- A corrected Application data sheet
- Form with a statement of the correct applicant (Statement under 3.73(c))
- Power of Attorney for new applicant

**AUDIENCE
QUESTION**

Audience question

Foreign Filing Licence: 1st example: inventor is Italian, place of invention is an a) American, b) Italian company in the USA

2nd example What about a German inventor having the US citizenship working for a German company with a branch in the USA , if place of invention is in a) USA, b) Germany

Question: what is the more important criterium - citizenship or place of invention? Does this vary depending on nationality IT/US/FR?

The place of the invention is what dictates the need of a Foreign Filing License: is the invention made in the US or not. Nationality or residence of inventors/applicant is irrelevant.

**AUDIENCE
QUESTION**