

Cost of Compliance with USPTO Regulations for Submission of Patent Applications

By Rick Neifeld, Neifeld IP Law PLLC

Date: 12/8/2021

By way of background, I have been a patent attorney since 1994, and I have been practicing patent prosecution since that time. This article is based upon my corresponding experience.

The USPTO promulgated regulations and forms for filing patent applications.

The regulations and forms include power of attorney forms, bibliographic information submission forms, and forms for showing to the USPTO that the an entity has the right to prosecute an application (and therefore the right to grant a power of attorney for a patent attorney to represent them in that patent application).

These forms are unnecessarily complicated. At least the AIA/14 form, named "Application Data Sheet," (ADS) (corresponding in name to the application data sheet rule 37 CFR 1.76), is unnecessarily difficult to read and understand and unnecessarily complicated to use. Use of the PTO forms and in particular the AIA/14 form are also inconsistent with, and frustrate, best practices for prosecuting patent applications.

For example, the AIA/14 form is so complicated and difficult to read that the patent applicant's simply cannot interpret how to use it, and cannot review a properly filled out AIA/14 to determine if the form is a properly filled out. Consequently, patent attorneys cannot normally expect patent applicants to complete an AIA/14, and cannot even expect patent applicants to review the information in such a form to confirm that information is correct.

However, the AIA/14 form requires primarily factual information in the possession of the patent applicant, and not their patent attorney. Hence, the patent applicant is in the best position to provide that information. And therefore the logical entity to enter information into a the AIA/14 is the patent applicant, and not the patent attorney.

However, because of the deficiencies in the AIA/14 form that I noted above, patent attorneys have to fill out the AIA/14 form. Consequently, errors in a filled AIA/14 form arise due to inaccurate information and due to editorial errors in entering available information. And those errors result in substantial costs for correction, including USPTO petition fees penalizing applicants for submission of errors in foreign application identifications and dates of filing of foreign applications, and all of the other information required in these forms.

Because patent applicants normally cannot initially fill out AIA/14 forms, and normally cannot review filled AIA/14 forms for accuracy, both types of errors occur in the filled AIA/14 forms filed in patent applications. To minimize the costs attendant to errors, therefore, patent attorneys must take unnecessarily burdensome client communications and unnecessarily heightened levels of review of filled AIA/14 forms.

While the USPTO forms are not required, use of non USPTO forms results in frequent rejection of submitted forms for various reasons. And those reasons are sometimes trivial or baseless. And the cost of responding to those rejections is high. Each such rejection requires a written response, even if the rejection is trivial or baseless. Reviewing a formal rejection, drafting a response, and filing that response normally takes at least an hour of time. Therefore, many practitioners use the USPTO's AIA/14 form instead of preparing their own forms.

Finally, there is a cost to preparing non USPTO forms. For example, I have spent, I estimate, two to three weeks' of my time, in the last decade, preparing non USPTO forms, that is

my own forms, for submission of patent applications that provides me power of attorney and submission of bibliographic information in a manner that complies with the USPTO's rules. And I am likely the exception, since I tended to study the USPTO rules in detail and design forms for submission of the necessary information, and my impression is most patent attorneys instead rely upon the USPTO promulgated forms for initial application filing.

Y:\Library\LAW\FirmPublicationsAndPresentationsAndLectureMaterials\RickNeifeld\articles\C
ost of Compliance.wpd