

# How to file a US patent application by Priority Mail Express

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10AM Mountain Time

Carl Oppedahl  
Oppedahl Patent Law Firm LLC  
[www.oppedahl.com](http://www.oppedahl.com)

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## Preliminary notes

- Feel free to ask questions as they arise
- Note that attending this webinar or viewing these slides does not make you my client and does not make me your attorney
- This is not legal advice
- Read and understand 37 CFR 1.10

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# Live in-person PCT Seminar

Redwood City, California

October 16-18, 2018

2½ day seminar

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## Why we are here

- There have been times when the EFS-Web system has been broken
- Sometimes the EFS-Web contingency server has also been broken
- It is important to know how to file a US patent application by going to the post office

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## Brief summary of procedure

- Assemble your patent application as printouts on paper
- Prepare a return post card
- Prepare a Priority Mail Express shipping label
- Put the Priority Mail Express tracking number on the topmost page in the stack
- Take it all to the post office
- Get a receipt showing the “date in”

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## If the application we are getting ready to file is a PCT application ...

- Then consider e-filing at RO/IB instead of RO/US
- Visit [pct.wipo.int](http://pct.wipo.int) to get a WIPO user ID and password
- If the invention was made in the US, you need an FFL (foreign filing license) before filing in RO/IB
- The FFL in your priority application might cover this

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## Filing in RO/IB

- You need to keep track of when it will be midnight in Switzerland
- The ePCT system displays the current time in Switzerland

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## 37 CFR 1.10

- You need to print out 37 CFR 1.10 and read it several times
- This is your very important source document for filing a US patent application by going to the post office
- ***Do not*** merely rely upon these slides to know how to do the filing

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## Now the details

- Make sure you know where your post office is and make sure it will be open
- Pay no attention to the cutoff time for next-day delivery of Priority Mail Express – that cutoff time is irrelevant
- Know how to prepare a shipping label for Priority Mail Express
- Maybe pick up some blank PME shipping labels from your local post office ahead of time

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## A big tyvek envelope

- You need a big envelope. I strongly suggest using a Tyvek (nonwoven polyolefin fabric) envelope.
- You can use a plain white tyvek envelope
- Optionally – if you like, you can use a Priority Mail Express envelope from the post office (not required) --- they are made of tyvek
- Maybe pick up some PME envelopes ahead of time from your local post office

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## PME flat-rate envelope

- Another option is to use a PME flat-rate envelope from the USPS
- This has the great advantage that you do not need to worry about how many ounces the weight is for your package
- Pick up some PME flat-rate envelopes ahead of time from your local post office

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## Priority Mail Express shipping label

- The Best Practice is to use Click-n-ship to prepare your PME shipping label
- Plan ahead and create a Click-n-ship account on the USPS web site
- Plan ahead and store your credit card in the Click-n-ship system web site
- Plan ahead and put the mailing address for the USPTO into your Click-n-ship address book

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## The shipping label

- The address is:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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## The shipping label

- Make sure that you apply enough postage
- There is a flat rate amount that applies if you use a PME flat rate envelope
- Otherwise you need to weigh your package and make sure you pay enough
- You do not want your PME package returned to sender for insufficient postage

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## Click-n-ship

If you use click-n-ship, the system will print the label on your printer

Three ways to apply the label to your envelope:

- Print on label paper, peel off the label, apply it to your envelope (Best Practice)
- Print on paper, use spray adhesive to apply the paper label to your envelope (second best practice)
- Print on paper, tape the label to your envelope

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## Now you know your tracking number

- The PME tracking number must appear on the topmost sheet of paper in your filing package
- If you hand-write it, proofread it carefully
- USPTO personnel will use this number on the USPS tracking web page to see when you mailed it
- If they can't read the number, you are in big trouble
- Write plainly and in large letters

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## The top-most sheet

- The PME tracking number must appear on the topmost sheet of paper in your filing package
- Best practice is to copy and paste from the USPS web site into your word processor to prepare the topmost sheet, so that the PME tracking number is free from error and clearly legible
- Use a large font

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## The return post card

- Prepare a return post card
- Best practice is to use a post card that you purchased at the post office
- Alternatively use a 4 by 6 inch post card of your own making, on thick card stock
- Make absolutely sure there is enough postage on the post card
- What if the rates went up recently?
- Use a “forever” stamp

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## The return post card

- The return post card absolutely must have your mailing address on it
- This is a frequently made mistake, failing to put a mailing address on the card

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## The return post card

On the card, list everything that is going in the envelope, for example:

- Specification – 10 pages
- Claims – 7 pages
- Abstract – 1 page
- Drawings – 4 pages
- Application data sheet – 7 pages
- Check number 1234 in the amount of \$1760
- Transmittal letter

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## The return post card

The most important thing is the page counts.

Be sure to list how many pages of spec, claims, abstract, and drawings.

You will need this later if USPTO loses one of your pages.

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## Transmittal letter is optional

- You may find it convenient to use Form PTO/AIA/15 Utility Patent Application Transmittal
- Or Form PTO/AIA/18 Design Patent Application Transmittal
- Or Form PTO/AIA/19 Plant Patent Application Transmittal
- For a provisional I would use AIA15 and an ADS, checking the “provisional” box on the ADS

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## Assemble your package

- Topmost sheet must show the PME tracking number
- The return post card
- Application data sheet (form PTO/AIA/14)
- Specification, claims, abstract, drawings
- Maybe a check to pay the fees
- Maybe form 2038 to pay the fees
- Keep a copy or scan of everything that is going into the envelope

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## Checking your package

- Cross-check that page counts for the actual pages match the page counts listed on the post card and on the transmittal letter
- Have a second pair of eyes in this cross-checking
- Make sure the topmost sheet bears the PME tracking number
- Make sure the post card is in the package
- Seal it up

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## Head for the post office

- The single most important thing is you need to walk away from the post office with a receipt that lists your tracking number and shows today's date as the date of mailing
- Nothing else is acceptable

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## At the post office

- The clerk might be pointing out that you arrived too late to get the package delivered tomorrow
- Tell them you don't care about that
- Tell them that what you want is a receipt that says you mailed it **today**
- ***Nothing else is acceptable***
- ***The receipt needs to say you mailed it today***

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## Returning from the post office

- Scan or photocopy the receipt from the post office
- It was printed on thermal paper that will fade with time

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## Tracking the package

- Go to the USPS web site and enter the tracking number.
- Click on the link that lets you set up email notifications
- Set up email notifications
- Smart tip: put your docket number into the “your name” field for the notifications

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## Docketing

- Docket maybe a week to check for receiving the return post card from the USPTO
- Docket maybe a week to check for the application being visible in Private PAIR

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## Finding out your application number

- The USPTO will stamp your application number onto the return post card
- Maybe you will find your application number in the Financial Manager system
- The application number will be stamped on your canceled check
- Hopefully you can look in Private PAIR under your customer number and you can find the application number

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## The penalty

- USPTO charges a \$400 penalty if you paper-file instead of e-filing
- This penalty is statutory, and so the Director is unable to waive the penalty
- \$200 for small entity, \$100 for micro entity
- Penalty does not apply to provisional, design, or plant applications
- Consider whether a provisional application might serve your needs (no good for design)

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Thank you – questions?

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## In a few minutes ...

- Free webinar on how to respond to office actions by fax or postal mail
- <https://attendee.gotowebinar.com/register/3696106586138839298>

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## Live in-person PCT Seminar

Redwood City, California

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2½ day seminar

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## Please report your CLE

- You will need to report your CLE claims directly to your CLE agency
- Please go here to report to us where you claimed CLE: [www.oppedahl.com/cle](http://www.oppedahl.com/cle) (we are required to keep records of this)
- Please complete the evaluation questionnaire

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Description



## Description

Attend a 2½-day live in-person Patent Cooperation Treaty seminar in Redwood City, California. Register by August 27, 2018 to get the sale price.

**Dates:** Tuesday, October 16 to Thursday, October 18, 2018.

**Location:** Courtyard by Marriott, 600 Bair Island Road, Redwood City, California 94063.

**Who should attend?** The program is likely to be of great interest to any paralegal or patent agent or patent attorney, in private or corporate practice, who uses the Patent Cooperation Treaty.

Professional responsibility rules hold attorneys responsible for the work carried out by non-attorneys

under their supervision. Such an attorney ought to know how to complete PCT tasks that they know

**The program.** Strategic topics include:

- Whether to use PCT or Paris Convention.
- Choosing wisely when picking a Receiving Office.
- Choosing wisely when picking an International Searching Authority.
- Deciding whether or not to file a Demand.
- Deciding whether or not to file an Article 19 Amendment.
- Helping the applicant figure out where to enter the national/regional phase.

Professional practice topics include:

- Malpractice avoidance — the importance of making use of PCT-SAFE or ePCT to file a PCT application.
- Drafting a PCT application so as to reduce problems in other patent offices.
- Making strategic choices to maximize possible benefits from the Patent Prosecution Highway.
- Choosing between US national phase entry or US bypass continuation.
- Comparing various filing scenarios (PCT first, running a US case in parallel) and their effects on patent term and filing costs.

Skills and tasks which we will discuss include:

- Filing a PCT application.
- How and where to file a 92bis request.
- How and where to file a Demand and Article 34 amendment.
- How and where to file an Article 19 amendment.
- checking the status and contents of a PCT application in ePCT (similar to Private PAIR).
- entry into US national phase.
- bypass continuation.
- docketing of PCT.

At each point we will identify Best Practices for these tasks.

**The schedule.**

- Tuesday, October 16.
  - 8:30 AM – 9:00 AM – Registration and continental breakfast.
  - 9:00 AM – 10:30 AM – Session 1.
  - 10:30 AM – 10:45 AM – Morning beverage break.
  - 10:45 AM – noon – Session 2.

- noon – 1:00 PM – Lunch (provided).
- 1:00 PM – 2:30 PM – Session 3.
- 2:30 PM – 2:45 PM – Afternoon beverage break.
- 2:45 PM – 5:00 PM – Session 4.
- 5:30 PM – 6:00 PM – wine and beer reception.
- Wednesday, October 17.
  - 8:30 AM – 9:00 AM – Continental breakfast.
  - 9:00 AM – 10:30 AM – Session 5.
  - 10:30 AM – 10:45 AM – Morning beverage break.
  - 10:45 AM – noon – Session 6.
  - noon – 1:00 PM – Lunch (provided).
  - 1:00 PM – 2:30 PM – Session 7.
  - 2:30 PM – 2:45 PM – Afternoon beverage break.
  - 2:45 PM – 5:00 PM – Session 8.
- Thursday, October 18.
  - 8:30 AM – 9:00 AM – Continental breakfast.
  - 9:00 AM – 10:30 AM – Session 9.
  - 10:30 AM – 10:45 AM – Morning beverage break.
  - 10:45 AM – 11:45 AM – Session 10.
  - 11:45 AM – noon – Concluding remarks.

***The classroom.*** The classroom will have free wifi and some seating locations will have electrical power for laptops. Free parking will be available at the hotel.

***Preparing for this class.*** Attendees are strongly urged to do the following in preparation for this class:

- get a WIPO user ID and password (if you do not already have one).
- set up two-factor authentication (“strong authentication”) with ePCT (if you do not already have it set up).
- do an e-handshake with the professor ( user\_US\_OPPEDAHL\_CARL\_2526 ).
- view the PCT application to which Prof. Oppedahl gives you access.
- explore the “demo” ePCT system.

In addition, attendees are strongly urged to enroll in the [WIPO PCT Distance Learning Course](#), study all fourteen modules, and earn the Certificate of Completion. Attendees who bring their Certificate of Completion with them to this course will receive a special gift.

***CLE accreditation?*** This program is CLE accredited in California. A Uniform Certificate of Attendance will be provided, which may be of some help to those seeking CLE credit in other states. It is up to the

attendee to request and obtain his or her own CLE credit; the program organizer will not be taking responsibility for obtaining CLE credit for attendees. Click [here](#) for more information about getting CLE credit.

**What you get?** Program materials will be provided as a printed seminar book. Your registration fee includes a continental breakfast and morning breaks on all three days, lunch on the first two days, and afternoon breaks on the first two days. Also included is a wine and beer reception at the end of the first day. You are on your own for dinner.

**The faculty.** Your professor is [Carl Oppedahl](#), the author of [the Ant-Like Persistence blog](#). He is a consultant for WIPO, lecturing on the PCT. Carl is a partner in Oppedahl Patent Law Firm LLC. Carl is chair of the PCT Issues Committee of the American Intellectual Property Law Association. He has given many dozens of lectures and webinars about intellectual property topics. His firm hosts [the PCT Listserv](#), a collegial email discussion group for power users of the PCT. Carl is a Fellow of the American Intellectual Property Law Association.



Here are some [handwritten comments](#) from people who attended a recent one-day PCT program taught by Carl. Here are some of those comments:

- Carl is an excellent presenter. He made a very dry subject tolerable. And maybe even enjoyable.
- Mr. Oppedahl did an excellent job at keeping the audience's attention for this all-day class. I have been to other seminars where I keep going back for more coffee to stay awake.
- [It would] be nice [if it could] be a two-day event so [we] can go more in depth.

**Airport.** Nearby airports include San Francisco International Airport (SFO) and San Jose International Airport (SJC).

**Hotel.** A limited number of guest rooms will be available at a special room rate. The special room rate will include free parking and free wifi. To book a room at the special room rate, click [here](#).



**UNIFORM CERTIFICATE OF ATTENDANCE**  
**Within 30 days of the activity, this certificate shall be filed**  
**with the appropriate MCLE Board(s) or Commission(s)**

Sponsor: Oppedahl Patent Law Firm LLC - California provider 15406

Activity Title: How to file a US patent application by Priority Mail Express

Date: August 17, 2018

Location: webinar

Activity Number: \_\_\_\_\_  
(for those states designating seminar numbers)

This program has been approved for a total of 1 CLE credit hours based on 60 minute hour

1 CLE credit hours based on 50 minute hour

Of this total, 0 CLE credit hour(s) of this program is/are devoted to instruction in professional responsibility

**Reminder: Introductory remarks, keynote addresses, business meetings, breaks, reception, etc., are not to be included in the computation of credit.**

TO BE COMPLETED BY ATTORNEY

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By signing below, I certify that I actually attended \_\_\_\_ CLE credit hours, including \_\_\_\_ professional responsibility hours.

\_\_\_\_\_  
Attorney Name (Print) Signature

\_\_\_\_\_  
Supreme Court Number **REQUIRED** Date

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