



AR LEGAL SOLUTIONS

Patent Perspectives Quarterly

January 2024

Welcome!

Thank you for taking the time to subscribe to our newsletter, *Patent Perspectives Quarterly*. We hope you enjoy our first-ever issue. Please let us know what you think!

In each issue we will include tips and tricks based on real-world inquiries from paralegals and patent attorneys. We would love for this section to be interactive—feel free to send us additional questions to address in the next newsletter to newsletter@arlegalsolutions.net.

Top 5 FAQs from Patent Paralegals

- 1. I am filing a US national phase application and do not yet have the signed declaration from the inventors. Is a fee due? How does it get paid?** Yes, a fee is due. You'll choose the fee referenced as "Surcharge – Late filing fee, search fee, examination fee, inventor's oath or declaration, or application filed without at least one claim or by reference."
- 2. Are there "tricks" for filing a continuation application that you want to sit in limbo for a period of time? For example, we want to file an application to keep the chain alive, but don't have new material to add—we don't want to have to frequently file new applications.** Here are a few options:
 - File the continuation the day before the parent is due to issue. Don't pay the fees. You'll get a Notice to File Missing Parts, to which you will respond on the last day possible or when you have claims.
 - File a no fee continuation and wait until the Missing Parts deadline to pay the fees. There is a late payment fee for doing this.
 - Hold off on filing Office Action responses until the day before they are due.
- 3. How do I keep internal deadlines organized?** There are several free or reasonably priced software options for managing internal/soft deadlines. Those commonly used include Microsoft Planner, Monday.com, Notion, and Trello. Several offer a phone app for professionals who want to check deadlines on the go.
- 4. Where can I take classes to learn more about patent law?** The USPTO offers free learning resources and events that we have [linked on our website](#). AR Legal Solutions also offers 1-on-1 and group training sessions for both current and aspiring patent paralegals that are customized based on your needs. Contact us for more information on training and coaching options.
- 5. I'm updating the inventor's name with the USPTO. Will I need to pay a fee? What if I am updating the inventor's address? Is a fee due for changing the applicant's name?** A fee is due when adding/updating an inventor's name, but not for an address change/correction. There is no fee due to correct the applicant's name.

PCT Forms Webinars

We like to share high-quality learning materials from trusted sources. Carl Oppedahl is a patent attorney in Colorado who puts out very good content. He recently made available (no purchase necessary) a webinar series on PCT Forms on his blog, [Ant-Like Persistence](#).



Your 2024 Challenge: Keep Work Relationships Healthy

As we dive into a new year at AR Legal Solutions, our focus is to keep our work challenging, not our relationships. One way to keep work relationships healthy is to set and respect boundaries—our own AND those of our coworkers and clients. Here are some tips for setting boundaries in a law firm setting:

- It's never too late to set boundaries and expectations, but the earlier the better.
- Be clear and concise.
- Ask how you can work together and make each other's lives easier. What is each person's preferred communication platform (email, instant message (IM), phone, darken my office door, etc.)? What hours do you work (especially important in a flex or hybrid environment)? What else should you know about each other's working styles and preferences?
- Agree how challenges will be handled.
- Make no assumptions.
- Make sure team members know the "why" behind your request or timeline.
- Communicate as soon as you know you cannot meet a commitment or deadline.

Patent Workflows: Prioritizing

FOR ATTORNEYS:

Bar deadlines vs. promised deadlines. When promising your client a specific filing date, be reasonable in your expectations and turnaround time for the project. Letting your LAA or paralegal know about the promised deadline as early as possible is important, particularly because most legal support staff have multiple assignments with multiple deadlines. Also, realistically prioritize your deadlines. If it's not due today, consider allowing it to wait until your paralegal or LAA can commit. Most firms want to provide work-life balance, limit overtime and avoid employee turnover—goals to consider as you prioritize your work for clients.

FOR LAAs/PARALEGALS:

If your workload may prohibit you from meeting a deadline, first ask the attorney what must absolutely be completed that day. If it's more than you can manage, reach out to the appropriate person in leadership for assistance with workflow. Avoid saying "no" or using phrases like "I can't" or "I'm too busy." Client work must get done, so think about how you can problem solve and use the available resources to complete or delegate a task. Finally, be proactive. Attorneys often have a lot on their plates and some projects can take weeks to complete. That's why it's important to avoid leaving things to the last minute and set calendar reminders in advance of their due date.

CEO Spotlight

Aubré Rabe founded AR Legal Solutions in late 2022. Here, she shares some insights about her decision to launch a service-oriented patent paralegal support company.

How did you go about starting your own business? I spoke with freelancers in the industry about their positive and negative experiences as a business owner. I then reached out to attorneys I had worked with and other contacts to ensure I would have work to do. They were all very encouraging. I also hired a business coach to guide me, which was one of the best investments I made. Then, I got started and figured things out as I went along. Starting can be the most challenging part!

What do you most enjoy about the work you are doing? I love the variety. Not only do I support firms with paralegal work, but I also help firms create efficiencies, develop processes, and train employees and paralegals trying to enter the patent world. It's a great mix that allows me to be creative and requires me to stay current with patent law and practice trends.

What is one life lesson you have learned from a client? I always remind myself that every situation, good or bad, has something to teach us. I have learned from working with demanding clients the importance of adhering to their specific guidelines and timelines. I have had the pleasure of building rapport and lasting relationships with clients stemming from getting the basics right.

Patent Center Updates

Still getting the hang of Patent Center? Below are some FAQs submitted to the USPTO recently.

Q: Are there forthcoming plans to give Practitioner support access to ePetitions, e[1]Terminal Disclaimers and e-Issue fee payment options going?

A: The ability for Practitioner support to create and save ePetitions for practitioner signature will begin to be available in 2024. The Practitioner must sign and submit the final version of the ePetition. Currently Practitioner support can prepare eTerminal Disclaimer, Corrected ADS and Web85b for Practitioners to sign and submit. Patent Center signature requirements are based on legal requirements and current business rules.

Q: Where do I manage customer numbers in Patent Center and look for office actions issued by customer number?

A: To manage customer numbers, signed in users select the "Manage" menu and "Manage customer numbers". To look for office actions by customer number, signed in users select the "Workbench" menu and select "View correspondence". At the top left of this page there is customer number filter.

Q: Will first office action predictions be available in Patent Center?

A: The first action prediction tool has been disabled in Patent Center because the system that provides this information is making updates. We did not disable this feature in Private PAIR due to the upcoming retirement. At this time, we do not know when the service that provides First Acton Prediction will be available. For the most accurate estimate, please contact the Examiner.

Q: Will there be an attorney docket number column in the Correspondence tab in Patent Center?

A: Attorney Docket number is available on the Workbench/Correspondence page. Select the three vertical dots icon at the top right of the columns and select attorney docket number in the Custom Columns popup window.

Q: What naming convention can I use so that document descriptions can be automatically assigned?

A: Files having the naming convention: Spec, Specification, Claims, Abstract, Drawing, Drw will automatically index with that document description. Document descriptions for NPL and FOR references are automatically assigned by using the following filename conventions for DOCX and PDF uploads:

- **Non-Patent Literature:** NPL_filename, filename_NPL, file_NPL_name or NPL-filename, filenameNPL, file-NPL-name
- **Foreign Reference:** FOR_filename, filename_FOR or FOR-filename, filename-FOR

Upcoming Changes at the USPTO

- The USPTO will start issuing electronic certificates of correction for patents issued on or after January 30, 2024. [You can read more about it here.](#)
- The USPTO plans to implement the surcharge fee starting January 17, 2024, for filing new non-provisional applications not submitted in DOCX format.
- The USPTO has extended the implementation of the Intellectual Property Assignment System to January 15, 2024. The new system will replace both ETAS and EPAS.

Patent Center Known Issues and Work-Arounds

Uploading Large or Complex DOCX files: Currently, there is a 10MB file size limit for DOCX documents in Patent Center. If your multi-section DOCX is larger than 10MB, please split the multi-section document into single documents for uploading. Larger files with large amounts of drawings and pages may take longer to upload. If your document upload times out, we also recommend splitting the file into single sections (whether DOCX or PDF documents). The USPTO is investigating options that will allow them to receive larger files.

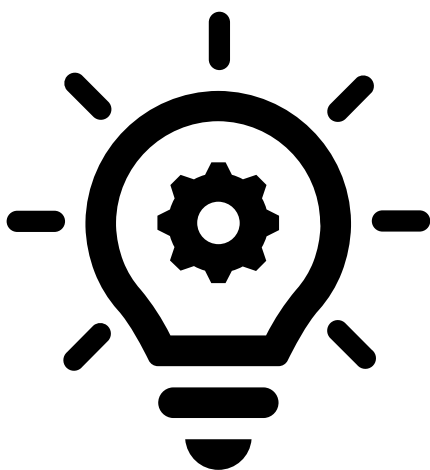
Attorney Docket Number Missing: Some e-Office Action users may notice that the Attorney Docket Number is missing from the e-Office Action notice and from the application after receiving the e-notification. The USPTO is working with the Business Units to correct the issue in Q2 2024.

Ad-blocking software: Some ad-blocking software may erroneously block parts of Patent Center. Although there are no ads in Patent Center, whitelist uspto.gov in your ad-blocking software or disable it for best results.

ePetition for withdrawal from issue after payment of issue fee:

- The ePetitions for withdrawal from issue after payment of the issue fee is experiencing intermittent issues.
- If you are not attempting to file the ePetition as part of a Quick Path IDS submission file the petition manually, as a follow on, by selecting Upload Documents/Pay fees option and using transmittal letter to request withdrawal.
- If you are attempting to file the ePetition as part of a QPIDS submission, and both your patent issue date is not imminent and you have flexibility with the 37 CFR 1.97(e) time period, retry your submission at a later time. If you must file your QPIDS submission as soon as possible, contact the Petitions Help Desk at 571-272-3282 for assistance. If you have any questions regarding what is required for a manual Petition, contact the Petitions Help Desk at 571-272-3282.

Upload ADS errors: If users receive an error when uploading an ADS, it is recommended users submit a Web ADS. The USPTO is working on a timeline for this fix.



Patent Center Notable Updates

- “Aptos” font has been added to the DOCX supported fonts list.
- The Workbench/Correspondence default date range has been changed from 3 days to 7 days.
- File naming convention: The filename extension rule is now enforced in Patent Center. The filename extension must be lowercase (e.g. .docx) to be compatible with other USPTO systems.

Helpful link > [Patent Center Information Page](#)