

How to respond to a USPTO Office Action by fax or mail

August 17, 2018
11AM Mountain Time

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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 1.8

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Live in-person PCT Seminar

Redwood City, California

October 16-18, 2018

2½ day seminar

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Registration is on sale until August 27

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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 respond to a USPTO Office Action by fax or mail

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Brief summary of post office procedure

- Assemble your patent application as printouts on paper
- Prepare a return post card
- Prepare a Priority Mail shipping label
- Include a Form PTO/SB/92
- Take it all to the post office

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37 CFR 1.8

- You need to print out 37 CFR 1.8 and read it several times
- This is your very important source document for responding to a USPTO Office Action by going to the post office
- ***Do not*** merely rely upon these slides to know how to do the filing

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Things you cannot send by fax

- New patent application
- New entry into US national phase

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Now the details

- Make sure you know where your post office drop box is
- You don't have to go in person
- You can just drop it into a box
- Know how to prepare a shipping label for Priority Mail

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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 envelope from the post office (not required) --- they are made of tyvek
- Maybe pick up some PM envelopes ahead of time from your local post office

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PM flat-rate envelope

- Another option is to use a PM 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 PM flat-rate envelopes ahead of time from your local post office

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Priority Mail 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
- You can also use ordinary stamps but then you can't track the package

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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 PM flat rate envelope
- Otherwise you need to weigh your package and make sure you pay enough
- You do not want your 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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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:

- Response to office action – 10 pages
- Claims – 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 response, claims, etc.

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

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Assemble your package

- The return post card
- Transmittal (form PTO/SB/92)
- 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
- Have a second pair of eyes in this cross-checking
- Make sure the post card is in the package
- Seal it up

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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 documents being visible in Private PAIR

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Responding by fax

- Most of the procedure is the same
- Your fax will go to +1-571-273-8300
- No need for a return post card
- Yes include Form PTO/SB/92
- Make sure all the pages go through

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Thank you – questions?

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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 (we are required to keep records of this)
- Please complete the evaluation questionnaire

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THE STATE BAR OF CALIFORNIA

MCLE PROVIDER CERTIFICATION DEPARTMENT

MULTIPLE ACTIVITY PROVIDER RENEWAL APPROVAL

July 9, 2018

Carl Oppedahl
OPPEDAHL PATENT LAW FIRM LLC
2095 West 6TH Ave Ste 211
Broomfield, CO 80020

Re: MCLE Multiple Activity Provider Approval
For the Period: July 1, 2018 to June 30, 2021
Provider Number: 15406

Dear Carl Oppedahl:

The request by OPPEDAHL PATENT LAW FIRM LLC to renew its status as a Multiple Activity Provider has been approved for the period noted above.

All Minimum Continuing Legal Education (MCLE) Providers are expected to conform to the State Bar of California's MCLE rules which can be found [here](#).

Please remember that it is the responsibility of a Multiple Activity Provider to determine whether a presented topic includes any subfield credit, as well as to accurately compute the hours of California MCLE credit. These and other Provider responsibilities can be found [here](#).

Please be sure that you are using the State Bar's most current forms including the Record of Attendance, Evaluation Form, and Certificate of Attendance found [here](#).

For your reference: Qualifying Activities can be found [here](#).

If, upon review of the above information, you have any questions, please do not hesitate to contact me.

Yours truly,

A handwritten signature in black ink, appearing to read "Jonita Rose".

Jonita Rose
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San Francisco, CA 94105
(415) 538-2137
jonita.rose@calbar.ca.gov

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SALE!



Comprehensive live in-person PCT Seminar in Redwood City, California

~~\$699.00~~ \$599.00

Attend this 2½-day live in-person Patent Cooperation Treaty seminar in California. Register by August 27 to get the sale price.

 In stock

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Add to cart

SKU: 0107-7

Category: [Live in-person seminars](#)



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 respond to an Office Action at the USPTO by fax or mail

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

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

Note: If you are required to report to more than one state, complete a form for each state.

State where credits are to be registered

When Required Complete the Following

Acknowledged by: _____
/carl oppedahl/
Sponsor Representative