

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

UNIVERSITY OF NEW MEXICO

(*,**,**),

Junior Party,

v.

FORDHAM UNIVERSITY

(0*/**,**),

Senior Party.

Patent Interference No. 104,761

ORDER

(SETTING PROCEDURES FOR ELECTRONIC TRANSMITTAL OF PAPERS)

INTRODUCTION

On 6 December 2001, at about 5 p.m. (Eastern), there was a telephone conference involving

1. Debra Shetka for the University of New Mexico (UNM);
2. Samuel Abrams and Michael Ryan for Fordham University, and
3. Richard Torczon, Administrative Patent Judge.

During the conference, counsel for both parties indicated a willingness to participate in an electronic filing pilot project.

ORDER

It is

ORDERED that the procedures set forth in the appendix shall govern further proceedings in this, and only this, interference.

Entered: 10 December 2001

RICHARD TORCZON
Administrative Patent Judge

cc (via electronic mail):

Counsel for the University of New Mexico:

Debra A. Shetka (***)@mofo.com)
Thomas E. Ciotti (***)@mofo.com)

Counsel for Fordham University:

Samuel B. Abrams (***)@pennie.com)
Michael J. Ryan (***)@pennie.com)

APPENDIX:
Electronic Filing Procedures

I. Policy

A. The purpose of this pilot project is

1. To speed communications,
2. To reduce costs of communications,
3. To increase reliability in the face of recent postal disruptions,
4. To implement various Administrative and legislative policies for providing the option of electronic filing,
5. To identify other benefits, as well as to correct problems, that may arise during the course of the pilot program.

B. Participation is voluntary, but electronic filing is strongly encouraged. A participant may opt out of the program but must initiate a teleconference with the administrative patent judge and the opposing party to provide notice. (An explanation of why it was not working would be appreciated.)

C. Switching between modes of communication is very strongly discouraged (i.e., as long as a party is in the program, it should only file electronically except as provided below).

II. Format

A. All papers, excluding exhibits, should be filed in Adobe® portable document format (pdf). This requirement is necessary to ensure standardization and consistent pagination regardless of the user's hardware and software.

B. Each paper (not each page) should be a separate pdf file.

C. Exhibits may be filed in either paper or pdf, although any reasonable efforts to provide a pdf copy is encouraged.

D. Papers should preferably be filed in **text-searchable** pdf whenever reasonably possible. Newer versions of Corel WordPerfect provide this translation capacity as a built-in feature. Adobe Acrobat software can provide this conversion capability for other word processors.

E. A pdf paper filed by a registered practitioner must have a signature block indicating the responsible practitioner, but need not have an actual signature **provided** the paper is electronically filed from a mail address at the counsel's firm (currently mofo.com and pennie.com, respectively).

F. Other documents requiring an original signature must be in image (scanned) format.

G. The STANDING ORDER requirements for formatting (paper size, etc.) remain in effect even for pdf papers.

H. Counsel should review the pdf file to ensure that scanning or translation has not produced errors. In particular, translation can produce unexpected results for special characters (e.g., foreign characters and "curly" quote marks) and for unusual fonts. Misfed or misoriented papers can produce problems in scanning.

III. Filing

A. The provisions of other orders in this interference continue to apply to papers filed in paper. Similarly, the timeliness of electronic files delivered by conventional (non-electronic mail) means is governed by those orders.

B. Papers, other than exhibits, filed electronically must be

1. Electronically mailed to

*****@USPTO.GOV

(*****.)

2. Include "104761 RT" (without a comma) in the subject line.

3. No papers unrelated to this interference should be filed at this electronic mail box without express written authorization from the United States Patent and Trademark Office.

C. Exhibits filed with the record may be electronically mailed or otherwise delivered in any of the following PC-compatible media:

1. A compact disc,
2. 3¼ inch diskette,
3. A 100 MB Zip® disk, or
4. A 2 GB Jaz® disk.

Counsel should, of course, exercise common sense in choosing the mode of filing with due consideration for the difficulties inherent in filing very large files via electronic mail.

D. Papers mailed electronically will be considered timely if they are received at the board (as determined by the board's date stamp) no later than 10 a.m. (Eastern) of the business day following the due date for the paper (the nominal filing date). The provisions of other orders govern the timeliness of electronic media delivered by non-electronic means.

E. The electronic mail message accompanying the papers should indicate in the body of the message the papers being filed. For example, "FORDHAM PRELIMINARY MOTION 1".

IV. Service

A. When papers are served in paper format, the provisions of other orders in this interference continue to apply. Similarly, when service of electronic media is effected by conventional delivery means, the provisions of the timeliness provisions of the other orders apply.

B. Service should be made by a method calculated to effect delivery within one business day of the nominal filing date for the paper.

C. Service will not be considered effective if the paper is served on an electronic medium that opposing counsel is not equipped to read. Hence, the parties should identify in advance the preferred modes of service. The default is service in paper format.

D. No certificate of service will be required if opposing counsel is included in the "cc" line of the electronic filing. If service is effected by conventional delivery means, the existing practice of incorporating the certificate in the paper should be used. If service is accomplished by a separate electronic mail message, an electronic mail message should be filed so stating, with a "cc" to opposing counsel.