

LEGAL FRAMEWORK FOR THE USE OF THE ELECTRONIC FILING SYSTEM

This document explains the legal framework for the treatment of patent applications filed under the Electronic Filing System (EFS). It describes how an electronic application will be processed by the United States Patent and Trademark Office (USPTO or Office) and clarifies some issues concerning these applications and the regulations of the USPTO. It describes, from a legal point of view, the submission process and the subsequent handling of submissions under the EFS, including New Utility Patent Application Submissions (Part I), Provisional Application Submissions, (Part II), Submissions under Eighteen-Month Publication (Part III), Submissions on Compact Disc (Part IV), and Information Disclosure Statement Submissions (Part V).

This explanation of the Legal Framework is a revision of the version published on April 21, 2002 (1258 Off. Gaz. Pat. Office 93) under the same title, and includes updated material concerning the USPTO's new EFS-ABX patent application authoring tool, which has replaced the current USPTO authoring tool (PASAT).

Special note concerning third party solutions:

The USPTO maintains a relationship with certain Electronic Filing Partners. These companies, pursuing their own business plans, integrate their technology with that of the Office to provide their customers a direct channel of submission to the Office. Support is available through those vendors, with whom the Office cooperates.

In addition, the USPTO is aware that other intellectual property offices offer products that are purportedly compatible with the USPTO's EFS server. The USPTO assumes no responsibility for any incompatibility, error, or other problem directly or indirectly caused by the use of these solutions.

GENERAL RULE: EFFECT OF PATENT REGULATIONS

Section 22 of title 35 of the United States Code expressly provides for electronic filing of documents. To the extent that any existing USPTO rule is inconsistent with EFS, the rule will be interpreted in a manner to support EFS and will be waived, when necessary, until formal regulations directed to electronic submissions are promulgated. See Electronic Filing System Available to Public, 1240 Off. Gaz. Pat. Office 45, Nov 14, 2000 and 37 CFR 1.183. When the Office has more experience with electronic submissions, the Office will propose specific rules relating to electronic submission for public comment, and then, after consideration of any comments, issue final rules.

This policy is consistent with the directives of current statutory guidance, including the Government Paperwork Elimination Act, Title XVII of Pub. L. 105-277 which, in section 1707 states that "electronic records submitted or maintained ... shall not be denied legal effect, validity, or enforceability because such records are in electronic form". The same section gives electronic signatures similar effect.

The procedures and policies of the Electronic Filing System (EFS) are described in this document and the published manuals for the EFS located on the USPTO Patents Electronic Business Center Web site, at <http://www.uspto.gov/ebc>. Some of the current regulations, for example, in 37 CFR 1.4, 1.6, and 1.52, refer to the paper and ink physical counterparts of an electronic submission. For the purposes of submissions using the EFS, those regulations will be applied in a manner consistent with the electronic nature of the EFS submissions. Documents submitted in compliance with the requirements expressed in the EFS documentation will not be held to be incompatible with the regulations solely because of their electronic nature or because they were submitted in electronic form.

Currently the EFS may only be used to submit 1) certain non-provisional utility patent applications, 2) provisional applications, 3) biotechnology sequence listings, 4) copies of patent applications for purposes of having the copies of the patent application published (redacted publication, amended publication, republication as amended, republication as redacted, or voluntary publication), 5) assignments of patents and applications and 6) Information Disclosure Statements. These submissions are itemized on the USPTO web site, and discussed below. Patent assignment information, bio-sequence listings, and Information Disclosure Statements may be electronically filed for recording and entering with or without a patent application. Refer to the EFS user manuals for guidance on the USPTO Patents Electronic Business Center Web site at <http://www.uspto.gov/ebc>.

PART I: UTILITY PATENT APPLICATIONS FILED UNDER THE ELECTRONIC FILING SYSTEM

How are new applications processed under the Electronic Filing System (EFS)?

The process for handling the EFS applications is shown in Attachment 1 at the end of this paper. The following is an overview of the process:

- A. Applications are “authored” by the applicant/attorney using the USPTO-provided EFS-ABX authoring template to put the application into special eXtensible Markup Language (XML) formats that can be accurately processed by the Office’s automated system. With this new EFS-ABX version, the specification, claims, abstract and drawings are also put into the Portable Document Format (PDF). The word processing templates, which are derived from Microsoft Word, allow the user to create an XML patent application document with tags that identify the content of each element of the specification. For example, one XML tag will identify the title and a separate tag will identify the first claim. The PDF version has the complete page image, plus the text from the original Word document. In EFS-ABX, drawings and complex work units (e.g., math or chemical equations, and complex tables) may also be inserted into the template. These images will also be included in TIFF format, referenced in the document, as explained in the Users Guide. The XML tags created in EFS submissions permit the development of automatic application formality review processing.

EFS-ABX allows the user, at any time during the authoring process, to validate the application document to assure that all text is properly formatted, all required headings have been inserted, and images conform to size and format restrictions. The validation process provides detailed error messages to facilitate correction of any problems that arise. Once application files are properly formatted, validated and viewed, EFS-ABX exports the document as a set of both XML and PDF files that are compliant with the international standard for electronic applications specified in the Patent Cooperation Treaty, Administrative Instructions, Annex F. These files are compressed and password protected so they cannot be altered without re-entering EFS-ABX.

- B. The user then employs the submission software ePAVE (electronic packaging and validation engine) to attach the compressed and password protected EFS-ABX file package, complete common data elements and required forms, attach any desired external files (e.g. oath or sequence listing), apply an electronic signature to the application, encrypt the signed application, and electronically transmit the application in XML and PDF to the USPTO. The electronic signature should be in the /John Smith/ format, as indicated in Annex F, and consistent with the proposed changes to 37 CFR 1.4(d). The electronic signature will be indicated on the eventual official documents stored in the USPTO's Image File Wrapper (IFW) system, and is the official signature for the purposes of 37 CFR 1.33. Applicant is urged to maintain an electronic copy of this file, similar in concept to the admonition of 37 CFR 1.4(d)(1)(ii) for fax filings.
- C. At the USPTO, the electronic files are checked for technical compliance, virus infection and integrity. Under normal circumstances, the digital signature (part of the public key infrastructure (PKI)) on the document package will prove valid, thus assuring that the files were not altered from the time they were signed. An electronic Acknowledgement Receipt including the Application Number and a Confirmation Number will be produced and sent securely to the applicant as proof of a successful submission. The Acknowledgement Receipt also lists the files received by the USPTO with the name and the size of each file, and includes a unique Message Digest code that is derived from the submission. The applicant will retain this Acknowledgement Receipt as clear evidence that on the date noted the files were successfully received by the USPTO. The Acknowledgement Receipt serves as an "Electronic Post Card" and is assurance to the applicant in the event evidence of filing is ever needed.

An electronic Acknowledgement Receipt, however, does not guarantee that the application meets all the USPTO requirements for a filing date. For example, if a non-provisional application submission does not include required claims, the filing date will be granted when this omission is corrected by applicant.

If the files have technical errors, the applicant is immediately alerted by a return message that does not include an Acknowledgement Receipt as described above. The return message will, instead, indicate to the applicant that a problem has occurred. The applicant will be advised to contact the USPTO for help. If a filing error message is received, the applicant should not simply resubmit the application without resolving the cause of the error and contacting the EFS Help Desk. Improper multiple submissions that contain authorizations to charge a filing fee may result in multiple

charges of that fee to the applicant's account. A request for a refund will not ordinarily be granted if multiple submissions of the same application are intentionally transmitted. (If the error occurs after Help Desk hours, applicant should consider Express Mail or other alternatives.)

What types of utility applications may be submitted under EFS?

The Office only accepts certain utility patent applications via EFS. The Office does not currently accept by EFS: continued prosecution applications (CPAs), design applications, reissue applications, plant applications, secrecy order or national security applications, national stage (i.e. '371) or international applications. Very large applications (over 100 megabytes of compressed data) are accepted only under the compact disc provisions of Part IV. All other submissions should use conventional paper media and, when appropriate under 37 CFR 1.52(e), compact disc media. Although the USPTO permits paper patent applications to be filed in a language other than English, applications submitted through the Electronic Filing System must be in the English language.

How are applications kept secure during filing?

Applications electronically filed under the EFS are submitted using special software employing public key infrastructure (PKI) technology. PKI software assures the integrity, authenticity, non-repudiation and confidentiality of the applications. USPTO security standards are commensurate with the state of the art in electronic commerce across the Internet. Applications are maintained in confidence as required by 35 USC § 122, until the application is published or a patent is issued.

What is the official submission of the new application under the EFS?

Currently the official copies of all USPTO electronic application files are the electronic images of the EFS submission entered into the Office's IFW files. The EFS electronic submission in its original form will be maintained under electronic records management control, and will serve as a safety copy if needed during prosecution or later. The document images stored in the Office's IFW system are the official records used during prosecution. The PDF version from EFS-ABX will be used to create the image version of the specification (description), drawings, claims and abstract. The XML version will create the bibliographic data and 18-Month Publication text.

May a Computer Readable Form (CRF) of Biotechnology Sequence Listings be submitted with the EFS?

Yes, the EFS may be used to submit the CRF submission required of biotechnology applications under 37 CFR 1.821(e) for applications that have already been submitted or for new biotechnology applications concurrently submitted using EFS.

May large tables or computer program listing appendices be submitted with the EFS?

Yes, the submission software enables the electronic filing of such data authored in a text (ASCII) format under 37 CFR § 1.58(b) and 1.96. For EFS-ABX submissions, *tables must be submitted in portrait orientation*, although landscape orientation is accepted in paper.

What is the force and effect of the Acknowledgement Receipt sent by the USPTO under the EFS?

The electronic Acknowledgement Receipt is not the official filing receipt for the application. The paper Filing Receipt (37 CFR § 1.54), PTO Form-103X, is sent after printing the application in step 8 in Attachment 1 below, and reviewing the submitted application parts for compliance with 35 U.S.C. § 111 filing date requirements and will indicate the official filing date. However, the Acknowledgement Receipt establishes the date of successful submission of the associated documents, and is thus a crucial part of the application process in establishing the applicant's filing date.

What is the value of the Acknowledgement Receipt if a problem occurs?

If the printed version of any document received by the EFS is unreadable, and if it cannot be recovered from the stored files received by electronic submission, then the applicant will be promptly notified by phone, fax or e-mail as indicated in the EFS instructions. Even with prompt processing, if the volume of submissions is high the Office review may take place a few days or weeks later. If an error occurs and the application cannot be reconstructed, the applicant may have to resubmit the application and petition for the original filing date. Such events are expected to be rare. Under this scenario, the applicant would present 1) the Acknowledgement Receipt, 2) a paper version and an electronic version (on floppy disk or CD-R) of the files as submitted and 3) a petition verifying that the attached files are the same as mentioned in the Acknowledgement Receipt for that application number. The Acknowledgement Receipt will establish that the resubmitted documents were exactly those submitted on the date of receipt.

What is the date of receipt of an application received under the EFS?

The application's "date of receipt" is the date that it is fully and successfully received at the USPTO, as shown on the Acknowledgement Receipt. The date at the USPTO is controlling for the purposes of original patent applications. There is no "certificate of transmission" practice for non-provisional or provisional application e-filings (37 CFR 1.8). However, because of the automated processes involved, applicants can usually "see" their submissions over the Internet in the Private PAIR (Patent Application Information Retrieval) system a short time after submission, which is a significant reassurance of successful receipt.

Hours of operation of the EFS will be clearly expressed in the EFS instructions. If a transmission is attempted when the system is down, the Office cannot accept it and will, if possible, transmit back a notice that the Office is closed. No Acknowledgement Receipt will be sent. The "closed" notice will advise the applicant to use alternative filing methods, such as hand delivery of paper to the USPTO or Express Mail (under 37 CFR 1.10), to establish the filing date. Remember that new applications under 37 CFR 1.53 cannot be submitted by fax (37 CFR 1.6(d)(3)), and that normal certificate of mailing procedures do not apply to new applications (37 CFR 1.8(a)(2)(I)(A) and (D)).

If an application is successfully received on a Saturday, Sunday or Holiday, the Office will assign that receipt date at the USPTO to the submission, similar to the Express Mail practice under 37 CFR 1.10.

Are there any legal consequences of the Office's accepting electronic patent applications on Saturday and Sunday?

The USPTO will be open for receiving applications in electronic form during scheduled hours every day of the week. Hours will be announced on the Patents Electronic Business Center Web Page, at the USPTO Website: <http://www.uspto.gov/ebc>. Hours for the Help Desk are also posted.

Electronic filing will provide applicants with the opportunity to receive a filing date on any day of the week, including Saturday, Sunday, and Federal holidays. In addition, consistent with 35 U.S.C. § 21(b), when the last day for taking any action or paying any fee in the USPTO falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken or fee paid on the next succeeding secular or business day. Thus, under United States law, applicants will still be permitted to take action on the next business day when the last day for taking action falls on a weekend or Federal holiday, regardless of the mode or form of filing.

Because the conditions for priority rights are governed by national law, applicants are cautioned to consider possible adverse consequences regarding the determination of priority periods under Article 4(C)(3) of the Paris Convention when filing international applications in the United States. Specifically, the ability to file applications electronically on weekends *may* result in loss of priority rights in foreign jurisdictions designated in international applications filed with the USPTO, if applicants elect to take advantage of sections 21(b) or 119(e)(3) of title 35. In such circumstances, other Patent Offices *may* deny the priority claim on the basis that the international application was not timely filed according to their national law. For this reason, applicants may prefer not to rely upon the "next business day" provisions of sections 21(b) and 119(e)(3) of title 35 when filing international applications with the USPTO, and instead file the application before the Convention year has expired.

PART 2: PROVISIONAL PATENT APPLICATIONS FILED UNDER THE ELECTRONIC FILING SYSTEM (EFS)

Provisional applications under 35 U.S.C. § 111(b) can be electronically authored with EFS-ABX and filed using EFS. The process for handling EFS provisional patent applications follows the same process outlined in Part 1 of the Legal Framework and in Attachment 1 for new utility patent application EFS filings **except for** the following features of the process:

- A. Provisional application must include the Application Data Sheet (Section 1.76) as the equivalent submission of a cover sheet to provide bibliographic information (i.e., inventor names, correspondence address, etc.). The entry of a customer number for a correspondence address will assign to the provisional application the correspondence address associated with the customer number and will enable information about the

application to be obtained using the private Patent Application Information Retrieval (PAIR) system.

- B. The EFS transmittal form will automatically include information identifying the electronic submission as a provisional application.
- C. If the Provisional Application is subject to U.S. government property interest, an explanation should be entered on the EFS transmittal form comments section. Provisional Applications containing national security related matter must not be electronically filed.
- D. Payment of the basic provisional filing fee is required.
- E. The Acknowledgement Receipt returned after a successful electronic filing of a provisional application will contain the USPTO assigned provisional application number and control number.
- F. Provisional Application submissions under EFS will be indexed and sent into the Image File Wrapper (IFW), reviewed for completeness, and a paper Official Filing Receipt will be mailed to the applicant. The Image File Wrapper containing the electronically filed documents (i.e., the provisional application) will not be examined or published.
- G. Provisional Applications submitted under EFS may be in the English language only.

Although the USPTO permits paper patent applications to be filed in a language other than English, provisional and non-provisional applications submitted through the Electronic Filing System must be in the English language.

PART 3: EIGHTEEN-MONTH PUBLICATION SUBMISSIONS SUBMITTED UNDER THE ELECTRONIC FILING SYSTEM (EFS)

EFS is also used for the re-submission of patent applications for the purposes of Eighteen-Month Publication (i.e., Domestic Publication of Patent Applications Published Abroad under P.L. 106-113 or 18 Month Publication). See 37 CFR 1.211-1.221 for the relevant rules.

Ordinarily, the submitted copy of a patent application is used for the production of the Patent Application Publication, as it was amended 14 to 9 weeks prior to publication date, when it was sent to the publication facility. However, if applicant desires one of the following:

- a) the publication of a redacted copy of an application (37 CFR 1.217) or
- b) the publication of the application as specifically amended (37 CFR 1.215) or
- c) the voluntary publication of an application filed before, but pending on November 29, 2000 under 37 CFR 1.221, or
- d) a republication under 37 CFR 1.221 of an application previously published under 37 CFR 1.211 (that is not to correct material errors in publication sought to be corrected within 2 months of publication via a paper request)

then the application *must* be submitted in electronic form using the EFS. If the applicant requests early publication of the application under 37 CFR 1.219 he or she *may* submit an electronic copy using EFS, but EFS submissions are currently only capable of use for publication purposes if the application is already on file in the USPTO. Accordingly, to obtain early publication either file the application on paper or through EFS, and, once a confirmation number is obtained (on the Acknowledgement Receipt if electronic or the filing receipt if paper), re-submit the application using EFS and with a request for early publication. Alternatively, the second EFS submission may be eliminated, but publication will be based upon a paper version of the application. Early publication requests require submission of the publication fee. See 37 CFR 1.219.

Background: How are submissions handled under the Electronic Filing System (EFS) for 18-Month Publication?

The process for handling the EFS submission for Eighteen-Month publication is shown on Attachment 2 below. Note the following features of the process:

- A. Applications (including plant patent applications) that are submitted for redacted, “as amended,” voluntary, “previously published” or, optionally, “early” Patent Application Publications are authored using the USPTO-provided authoring tools as described for new applications above. They must contain a statement that the submission does not include any “new matter.”
- B. Application files, once properly authored in EFS-ABX, are assembled, validated, electronically signed, encrypted, digitally signed, wrapped and electronically transmitted to the USPTO. This is the same process used for new applications described above. The XML version of the application will be used for 18-Month Publication and thus the applicant should review the XML document using Internet Explorer to see the application content that will be published.
- C. Any publication or processing fees must be made at the time of submission.
- D. After receipt at the USPTO, the electronic files are checked for technical compliance, freedom from viruses and apparent integrity as described above for new applications.

The Eighteen-Month Publication submissions are transferred to the facility that edits, publishes and produces the Published Patent Application documents directly in electronic form.

Where does the applicant indicate or author the required statement that this resubmission of the application contains no new matter? What other certifications are effective?

The following statement is automatically entered and printed on the completed EFS Application Data Sheet for every Eighteen-Month Publication electronic submission:

“I state that this resubmission of the application contains no new matter. If this resubmission is a redacted copy of an application submitted under 37 CFR 1.217, the applicant hereby

certifies that the redacted copy of the application eliminates only the part or description of the invention that is not contained in any application filed in a foreign country, directly or through a multilateral international agreement, that corresponds to the application filed in the Office and otherwise does not introduce any new matter. Additionally, if this submission is a redacted copy of an application submitted under 37 CFR 1.217, the applicant further certifies that the documents and certification required by 37 CFR 1.217(c) have been filed or will be filed concurrently with the request for redacted publication (See 37 CFR 1.217(c)).”

In accordance with 37 CFR 10.18 (b), by presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, (whether a practitioner or non-practitioner,) is certifying that –

1) All statements made therein of the party’s own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document.

Entry of one electronic signature appearing on the EFS submission transmittal will acknowledge all the certification statements contained in the EFS submission.

May the applicant use a certificate of transmission?

Electronic submissions for Eighteen-Month Publication under EFS of “as amended” applications, “voluntary” or “previously published” publications, or “early” publications may be submitted with a certificate of transmission. Consistent with the certificate practice of 37 CFR 1.8, the local date at the place of submission as indicated on the certificate of transmission will be considered for the purposes of determining if the electronic applications were submitted in a timely manner. This does not apply to “redacted” applications submitted under 37 CFR 1.217 that must be received on the specified date at the USPTO.

PART 4: EFS FILING SCENARIO FOR LARGE SUBMISSIONS USING COMPACT DISCS:

If the Applicant/Attorney attempts to file a Utility or Provisional Patent Application or Eighteen-Month Publication Submission that exceeds the EFS system limit of 100 Megabytes of compressed data, the system will generate an error message and advise the applicant to submit the large application on compact discs (hereinafter CDs or CD-Rs). Submissions exceeding 100 MB cannot be forwarded to USPTO over the Internet using ePAVE. If a large biotechnology sequence listing, table or computer program listing caused the large application

size, the applicant may submit the application according to the requirements of 37 CFR 1.52 (e) with the large section on CD and the rest in paper. However, regardless of the cause of the large size of the submission, EFS can also be used to file the application in the following manner. The process requires the workstation to be connected to a compact disc recorder:

The process for handling large submissions is diagrammed in Attachment 3. Applicant, on creating a large application (>100 Megabytes) will be instructed by ePAVE to:

1. Print out the Transmittal Form.
2. Copy the submission folder containing the whole application from the workstation to compact disc-recordable (CD-R) media. Do not use floppy or Zip disks or other media.
3. Wrap the CD in a hard case within a padded protective mailing envelope, attached to the Transmittal Form. Enclose a cover letter explaining that the submission contains an application that was too large to be submitted under the EFS ePAVE process.
4. Hand carry, or mail the CD-R and a copy of the paper Transmittal Form, with the cover letter to the USPTO, or deposit them with the US Postal Service under the Express Mail procedures of 37 CFR 1.10.

Applicant is advised to keep a copy of the CD and transmittal form for his or her records. In step 2 above, an applicant may optionally make a backup copy of the CD and send in both copies to the USPTO. Label the CDs "Copy 1" and "Copy 2" and include a signed statement that the two copies are identical. Copy 1 will be used for processing, unless it is unreadable. Applicant is advised to electronically "compare" the file on the CD with the files on the computer to be sure of accuracy.

The USPTO will receive the application package in the mailroom. The date of receipt of the application will be recorded. The CD will be "uploaded" to the EFS server. The application files will then be processed as EFS submissions.

If the submission was a new application (as opposed to a submission of a copy of an application under 18-Month Publication), an Acknowledgement Form will be printed. However, the Acknowledgement Form will be modified to indicate that the USPTO mail room date of receipt of the CDs, or the Express Mail date when they were submitted to the USPS, is the date of their receipt (the date of uploading to the server will NOT be used). The Acknowledgement Form is placed in the file with the printed application, and a copy of the Acknowledgement Form is sent back to the applicant. A certificate of mailing may be used in the same manner as the certificate of transmission described above.

If the files contain large tables, sequence listings or computer program listings, the Office has the option of not printing the large files, but rather burning two CD-Rs of such data, and treating them under the CD practice of 37 CFR 1.52(e). If the file is an amino acid/nucleotide sequence listing, then one additional copy of such a sequence listing will be created and used as the CRF. In any case, one CD is placed in the file, and one is put in the CD repository.

In other respects, processing will continue as if the application had been submitted by the standard EFS channel.

If an application is too large to use this process successfully (about and over 1 Gigabyte) then please contact the Patent Electronic Business Center (www.uspto.gov/ebc). Some applications may be too big to process using the CD techniques and require special handling.

What is Receipt Date for EFS New Utility or Provisional Application Filing submitted on CD?

The Filing Date of any EFS New Utility or Provisional Application sent in by CD (in a “CD package,” including a paper copy of the ePAVE Transmittal form) will be based on the date the CD package is received at USPTO, if delivered by hand or regular US mail. That date will be indicated in any acknowledgment. If the CD package was sent to the USPTO by Express Mail under 37 CFR 1.10, then the date of deposit with the United States Postal Service will be used.

What is the official copy of the Sequence Listing (1.821 (c)), Table, Program Listing?

For applications that are originally filed using EFS, the copy of the specification that is placed in the Image File Wrapper is the official copy, with one exception. Sequence listings, large tables, and computer program listings may be submitted on CD media, according to 37 CFR 1.52(e). If the Office decides, in a particular instance, to copy a sequence listing file, computer program listing or large table onto CDs instead of printing it to paper, the CDs become the official copy. See Notification of United States Patent and Trademark Office Patent Application Records being Stored and Processed in Electronic Form, 1271 Off. Gaz. Pat. Office 100 (June 17, 2003).

By “official” the Office means the active authoritative copy. The electronic submission will be maintained as an evidentiary copy of what was submitted should any questions arise during prosecution or later.

May an applicant submit more than one copy of the CD to assure readability?

Applicant is required to submit only one EFS New Utility Application CD. However, applicant has the option of submitting a second copy of the CD, but must label the two copies “Copy 1” and “Copy 2”, and certify that Copy 1 and Copy 2 are the same. Copy 1 would be used for processing, unless it is unreadable.

Will Express Mail - submission of EFS New Utility Application CD be accepted?

Yes, if it exceeds the 100 megabytes compressed data limit.

Should applicant be advised to do a file size comparison between encrypted files copied to EFS New Utility Application CD and the EFS files residing on the applicant’s workstation?

Yes, the EFS Guide will advise applicants to do a file comparison.

PART V: INFORMATION DISCLOSURE STATEMENTS FILED UNDER THE ELECTRONIC FILING SYSTEM

Background: How are Information Disclosure Statements (IDS) processed under the Electronic Filing System (EFS)?

Information Disclosure Statements (IDS), except those filed under 37 CFR 1.99, may be electronically submitted to the United States Patent and Trademark Office (USPTO or Office) via the Office's Electronic Filing System (EFS). When making such an EFS submission of an IDS, paper copies of U.S. patents and U.S. application publications cited in the IDS will no longer have to be supplied by applicants. Applicants file an electronic IDS by (1) entering the references' citation information in an electronic data entry form, equivalent to the paper PTO-1449 form; and (2) transmitting the electronic data entry form data to the Office via ePAVE. Electronic submissions under 37 CFR 1.99 (third party submissions) will not be accepted.

What documents may be cited on an electronic Information Disclosure Statement (eIDS)?

This electronic form allows only citations for U.S. patents and U.S. patent application publications.

How does the applicant meet the requirement under 37 CFR 1.98 to submit copies of cited documents?

Applicants will NOT submit copies of any U.S. patent or U.S. patent application publications cited on an electronic IDS form that is electronically transmitted to the Office.

How are Information Disclosure Statements with foreign patent documents or non-patent literature documents or unpublished U.S. applications filed?

If any references to foreign patent documents, non-patent literature documents or unpublished U.S. applications are to be cited, applicants will submit those citations on a conventional paper PTO-1449 form (or revised form PTO/SB/08). A printed copy of each cited foreign patent document, non-patent literature document and unpublished U.S. application (until further notice) should accompany the conventional IDS form. Submissions of these documents may be made by mail, facsimile transmission, or hand delivery.

What data is entered in an electronic Information Disclosure Statement (eIDS)?

The ePAVE software provides an electronic data entry IDS form equivalent to a paper PTO-1449, Information Disclosure Statement form, in which citations for up to 50 U.S. patents and up to 50 U.S. patent application publications may be entered. Each citation requires the patent or application number, the name of the patentee or applicant, and the date of issue or publication. The filer may optionally add the kind code, and U.S. patent class and subclass code for each citation.

How are certifications and statements of relevance required under 37 CFR 1.97(e) submitted with an eIDS?

The electronic IDS form contains preprinted certification statements that allow the user to click on one of the two certifications required under 37 CFR 1.97(e), regarding citation of the documents in a communication from a foreign patent Office and knowledge of the cited documents by individuals under 37 CFR 1.56(c). The electronic IDS form also contains a free form text area to allow the user to include statements of relevance or other remarks with regard to the cited documents.

How are fees submitted?

Since the Non-Patent Literature (NPL), unpublished patent applications and foreign patent documents are to be submitted in paper, while the US patents and published applications are indicated on the electronic IDS, the total IDS may be separated into multiple submissions. Generally a single fee will suffice. The fee under 37 CFR 1.97(c) must be included with the first electronic submission of the electronic IDS. Subsequent submissions of the non-electronic documents will not require a fee if they are received on the same date that the electronic IDS is received by the Office or were deposited in Express Mail, deposited in the first class U.S. mail with a certificate of mailing in accordance with 37 CFR 1.8, or transmitted by facsimile on the same day with a certificate of transmission in accordance with 37 CFR 1.8 on the same date as the electronic IDS that contained the fee. The non-electronic submission must make reference to the electronic IDS.

Details of the fee process are described in the documentation of the EFS at www.uspto.gov/efc.

How does the IDS data get sent to the Office?

The ePAVE software validates the format of data entered into the electronic IDS form and allows the applicant to specify whether the electronic IDS form is to be linked to an accompanying new application filing or is being submitted for a previously filed application. ePAVE transmits the XML formatted IDS data from the electronic data entry form to the Office.

As with the other types of electronic submissions, ePAVE will validate the information, display it to the filer, prompt for the filer's electronic signature, use the filer's digital certificate to encrypt the whole package, and transmit the submission to the USPTO. Upon receipt, the Office will send to the filer an electronic post card "Acknowledgement Receipt" indicating the date of receipt, the message digest, the application number, and the names, types, and sizes of the files received by the USPTO.

Is it possible to submit an eIDS subsequent to filing an application, and, if so, how is any necessary fee flagged?

The IDS may be submitted as part of a new utility EFS electronic application filing, or as a subsequent submission for a previously filed patent application. The ePAVE program will prompt the filer to associate an IDS file with a new application file and to provide payment information, where either is appropriate.

If the IDS submission is subsequent to the application filing, the filer will be required to enter both an application number and a confirmation number. A confirmation number is an additional four-digit identifier assigned to an application, and can be found on the Acknowledgement Receipt and in the upper left-hand corner of the official filing receipt. An IDS cannot be electronically transmitted prior to an initial filing.

How is the eIDS treated by the Office?

The IDS form submitted electronically will be placed in the Office's IFW. The cited document numbers will be made available electronically to the examiner to facilitate searching and retrieval of U.S. patents and U.S. application publications.

The IDS form will be entered as a document into the application file indicating that it was received on the date the form was completely received via EFS. This is the date the Office will use in considering compliance with 37 CFR §§1.97 and 1.98. This document will be treated procedurally the same as any other paper in the file, and will be available to any party viewing the contents of the file.

Examiners will consider the U.S. patents and U.S. patent application publications cited on an electronic IDS form provided the remaining requirements of 37 CFR 1.97 and 1.98 are met, by reviewing electronic or printed copies produced from the Office electronic databases. Examiners will indicate which documents were considered by initialing and dating the paper copy of the eIDS form, and supplying a copy to the applicant with the next Office action, just as with conventional IDS submissions.

What if the applicant transcribes the document numbers incorrectly into the eIDS?

It is most important that the cited U.S. patent and patent application publication numbers be accurate. Because the IDS filer will not submit copies of cited documents, there will be no copies of the disclosed documents in the file wrapper for the examiner to review. Instead, the examiner will electronically retrieve the patents and application publications identified by the cited document numbers.

The only mechanism for having the correct document reviewed and considered when an erroneous U.S. patent or application publication number is cited in an IDS citation will be by citing the correct citation number in a subsequent IDS that conforms to the requirements of 37 CFR 1.97 and 1.98.

For further information:

For further information, consult the EFS documentation on the USPTO Patents Electronic Business Center web page which includes a complete description of the EFS process and procedures. It is located on the Internet at <http://www.uspto.gov/ebc>

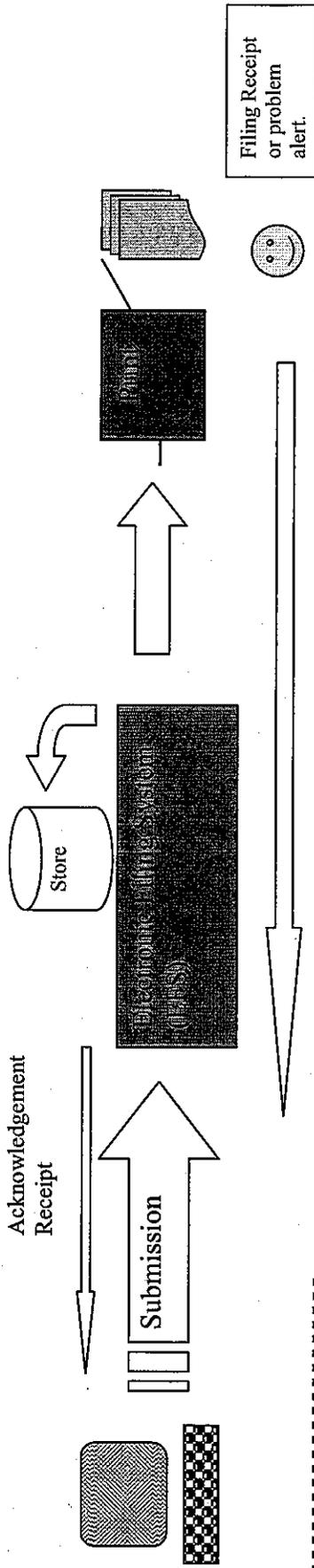
If there are any questions on the Legal Framework, please contact Jay Lucas at jay.lucas@uspto.gov. Questions on the EFS system should be directed to the Patent Electronic Business Center at <http://www.uspto.gov/ebc> or via email at ebc@uspto.gov. Correspondence may also be addressed to Jay Lucas, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.


Stephen G. Kurin

Deputy Commissioner for Patent Examination Policy

Attachment 1:

ELECTRONIC FILING SYSTEM
NEW APPLICATIONS



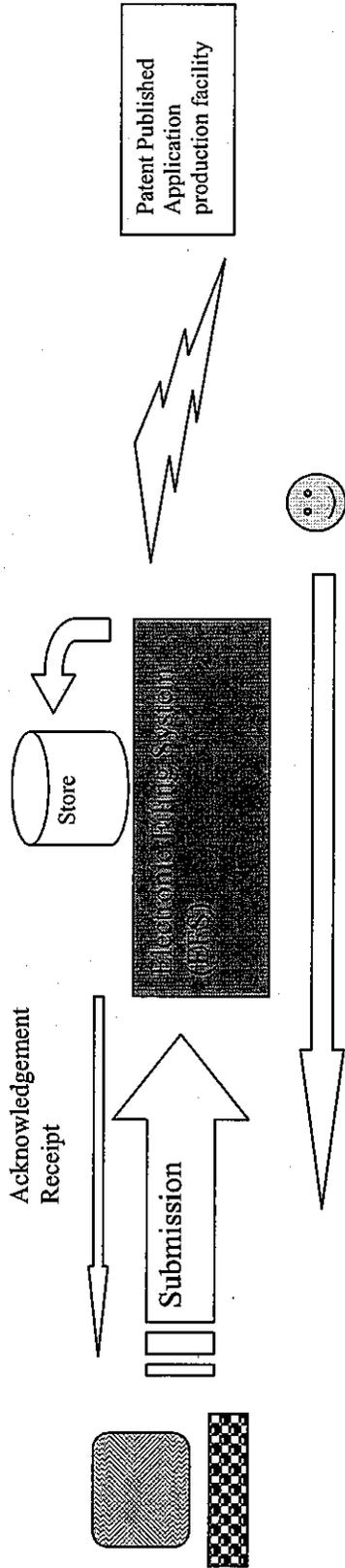
- Applicant**
1. Qualifies for PKI security key pairs and receives from USPTO a digital certificate, authoring and submission software.
 2. Authors application specification following USPTO technical guidelines and template to produce tagged structured XML document, PDF documents and compliant image files.
 3. Uses submission software supplied by USPTO to create form like XML documents, validate and transmit application to USPTO via the Internet.

- USPTO**
4. Receives electronic submission in EFS, unsigned, unwraps and decrypts files.
 5. Stores files in secure repository under Electronic Records Management control.
 6. Checks file attributes for file integrity and successful transmission. Send alert if problems.
 7. Sends to applicant an electronic Acknowledgement Receipt with file names, date, sizes and message digest.

- USPTO**
8. Enters documents into IFW. Reviews pages to determine they are readable.
 9. Files enter normal workflow as official submission. The IFW copy is used for publication of the patent application.
 10. In due course, Filing Receipt is issued when all necessary elements are received.
 11. If a problem occurs with IFW application, first checks electronic version in EFS. If new copy needed, Applicant will be able to resubmit files on presentation of Acknowledgement Receipt.

Attachment 2:

ELECTRONIC FILING SYSTEM
PRE- GRANT PUBLICATION SUBMISSIONS



- Applicant**
1. Qualifies for PKI security key pairs and receives from USPTO a digital certificate, authoring and submission software.
 2. Authors an "as amended, redacted, voluntary, previously published or, optionally, early" application specification following USPTO technical guidelines and template to produce tagged structured document and compliant image files. Includes statement of "no new matter".
 3. Uses submission software supplied by USPTO to create form like XML documents, validate and transmit application to USPTO via the Internet.

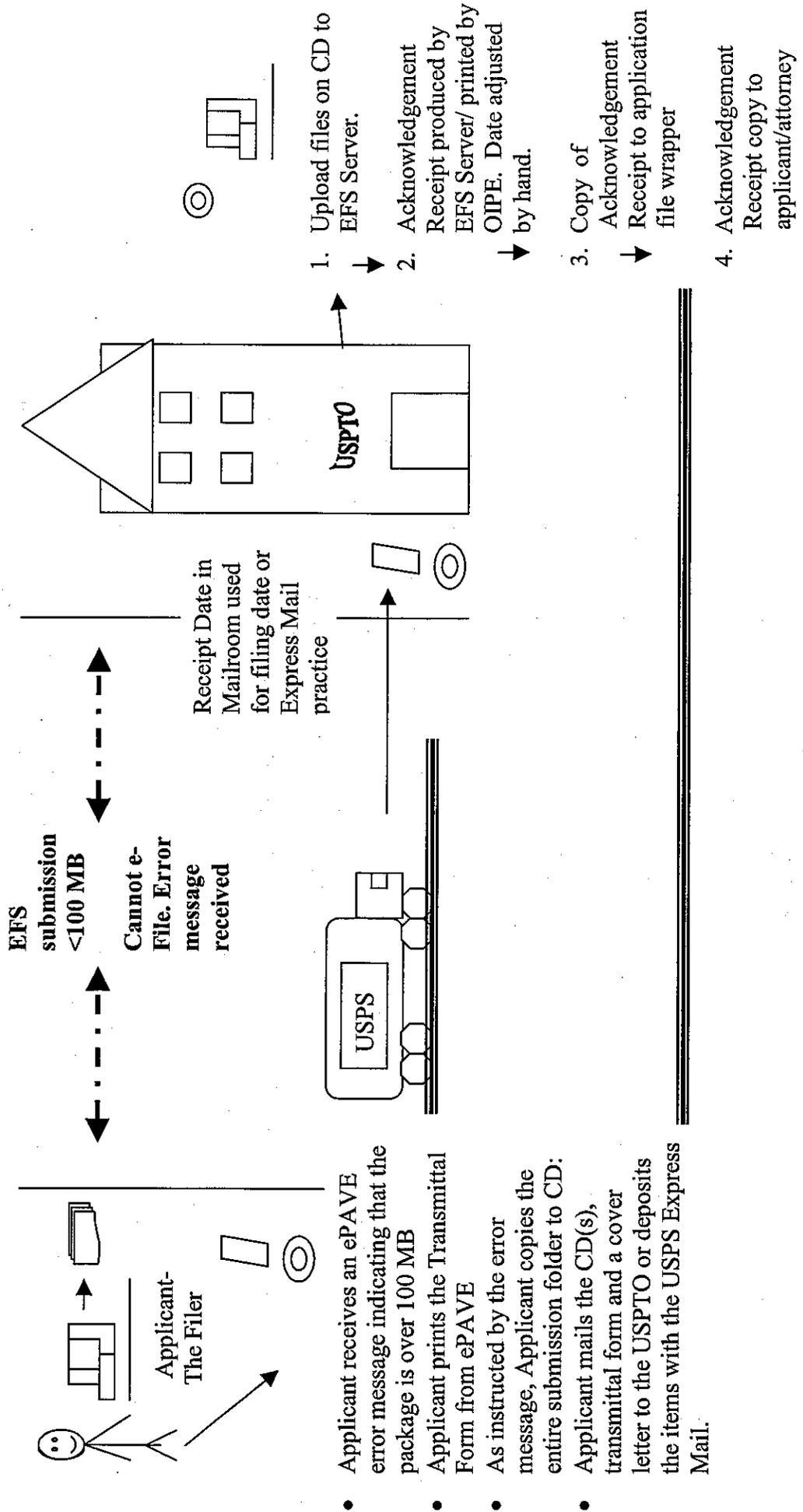
- USPTO**
4. Receives electronic submission in EFS, unsigns, unwraps and decrypts files.
 5. Stores files in secure repository under Electronic Records Management control.
 6. Checks file attributes for file integrity and successful transmission. Send alert if problems.
 7. Sends applicant an electronic Acknowledgement Receipt with file names, date, sizes and message digest.

- USPTO**
8. Documents are sent in electronic form to the facility that produces the Published Patent Application document.
 9. If a problem occurs with published application, first check electronic version in EFS. If new copy needed, Applicant will be able to resubmit files.

Attachment 3: EFS Filing Scenario with Compact Discs:

Applicant/Attorney attempts to file a New Utility Patent Application that exceeds the EFS system limit of 100 Megabytes and cannot be forwarded to USPTO over the Internet using ePAVE, EFS submission software.

Scenario Illustration:



- Applicant receives an ePAVE error message indicating that the package is over 100 MB
- Applicant prints the Transmittal Form from ePAVE
- As instructed by the error message, Applicant copies the entire submission folder to CD:
- Applicant mails the CD(s), transmittal form and a cover letter to the USPTO or deposits the items with the USPS Express Mail.