

# **LEGAL FRAMEWORK FOR EFS-WEB**

September 2008

## **I. Introduction - Scope of Document**

This Legal Framework provides guidance on the background statutes, regulations and policies that support the Electronic Filing System – Web (EFS-Web) project. The document is provided as a reference for applicants, parties in reexamination proceedings, attorneys, and agents, as well as their staffs using the system.

## **II. Background**

From October 2000 through October 2006, the USPTO provided eFiling software including two client-side components. Those components were EFS-ABX for patent application specification authoring and ePAVE for form generation, validation, and submission to the USPTO. EFS-ABX generated an .abx package that contained the Portable Document Format (PDF) version of the file and an XML version with all associated files needed for rendering in a browser. ePAVE generated XML forms based on user input, allowed for the .abx file to be attached, validated the package, and submitted it to the USPTO for processing. Due to low adoption rates of eFiling, the USPTO requested feedback from the IP community and found that users prefer filing applications using PDF, as well as being free from downloading and installing software on their workstations.

As a result of these user requests, the USPTO created EFS-Web, a PDF-based Internet patent application filing system. The use of a web browser on the client side answered requests for a "light" client, that is a system that does not require a user to download a substantial amount of software onto his/her computer. As a result of the highly favorable reception of the EFS-Web filing system and the low adoption rate of the ePAVE and ABX filing components, the ePAVE and ABX filing components were retired by the USPTO in the Fall of 2006.

## **III. EFS-Web**

EFS-Web is a PDF-based filing system. Accordingly, all EFS-Web submissions are required to be in PDF format unless otherwise indicated below. In addition, PDF files created from scanned documents and submitted via EFS-Web must be created using a scanning resolution no lower than 300 dpi. Lower resolution scans have significantly delayed processing and publication of applications, e.g. resubmission has been required for documents failing to comply with the legibility requirements. See 37 CFR 1.52(a)(1)(v) and (a)(5) regarding document legibility requirements.

EFS-Web collects data elements from on-screen entries made through the EFS-Web graphical user interface (GUI) data collection screens. Needed patent information, however, is also collected on form fillable PDF, or user created PDF files attached to the submission.

The user and the USPTO benefit greatly from such automated processing by increasing the accuracy and timeliness of data going from one system to another, while eliminating the need for the user to prepare paper submissions (which may be extensive) and eliminating the need for the USPTO to process large volumes of paper submissions. An applicant need not provide a duplicate copy of any document filed through EFS-Web unless the Office specifically requires the filing of a duplicate in a particular situation.

The USPTO provides users with PDF Web-based fillable forms. Currently there are several fillable forms including the Provisional Cover Sheet, the Information Disclosure Statement, the Application Data Sheet, Petition to Make Special Under Accelerated Examination Program, Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent, Request for Continued Examination (RCE), and Petition to Make Special Based on Age. The USPTO will continue to convert additional forms to the PDF form-fillable format over time.

EFS-Web permits a legal assistant or paralegal to submit an application/request for reexamination previously reviewed by a registered practitioner without the registered practitioner being present.

#### **IV. Relevant Statutes and Rules**

- 35 USC 111 – filing a patent application
- 35 USC 302, 311 – filing a request for reexamination
- 37 CFR 1.52 – form of an application/reexamination
- 37 CFR 1.4 – signatures
- 37 CFR 1.6 – receipt of correspondence

*Electronic Filing System Available to Public* 1240 OG 45 (14 November 2000) indicates that to the extent that any USPTO regulation is inconsistent with EFS procedures, the regulation will be interpreted in a manner to support EFS.

Improper Use of EFS-Web:

Use of EFS-Web in a manner significantly in violation of the instructions proscribed by the Legal Framework may result in non-entry of the submission or failure to accord a filing date in the event the USPTO does not fully, successfully, and officially receive all of the elements necessary to obtain a filing date for an intended submission once the applicant/patent owner clicks the SUBMIT button on the Confirm and Submit screen.

#### **V. Legal Advantages to the Filer of the EFS-Web Approach**

Major Innovations of EFS-Web:

- a. Web access from anywhere using web browser.
- b. Standard PDF accepted, from commercial and free PDF converters.

- c. Portable PDF forms, can be passed around for collaboration.
- d. Responsible attorney or agent need not be present for submission.
- e. Real time fee payments.
- f. An Acknowledgement Receipt received upon making an electronic filing is the legal equivalent of a post card receipt described in MPEP 503.

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## **VI. Legal Issues & Policies**

This initiative does not depend upon, or require, statutory changes. PDF files when submitted as part of a Patent Application Specification via EFS-Web are used to create the official record.

The following are policies of the Office concerning e-filed patent applications/requests for reexamination under EFS-Web, as well as follow-on papers in applications and reexamination proceedings.

## **VII. Subscriber Agreement/ Signature Policy**

A practitioner or an employee acting under the direction and control of a practitioner may, as a general rule, file documents signed by either the practitioner exercising the direction and control or another practitioner via EFS. Filing of a document that is unauthorized to be filed via EFS (e.g., a withdrawal from issue by a third party) is inconsistent with the subscriber agreement. Thus, the certificate holder and employee acting under the direction and control of a registered attorney (or agent) must make sure that documents being submitted are authorized to be filed via EFS, regardless of whether the document is signed by the practitioner exercising the direction and control or another practitioner.

## **VIII. Acknowledgement Receipt Policy**

The Acknowledgement Receipt establishes the date of receipt by the USPTO of electronic documents itemized in the receipt. Under EFS-Web, the Acknowledgement Receipt will contain a full listing of the documents submitted to the USPTO as described by applicant or a reexamination party (patent owner or reexamination requester) during the submission process, including the count of pages and/or byte sizes for each document. Thus, the Acknowledgement Receipt is the electronic equivalent of the post card receipt described in MPEP 503.

The official application filing date will be noted on the Filing Receipt (37 CFR 1.54), PTO Form-103X, after the submitted application parts are reviewed for compliance with 35 U.S.C. § 111. The filing date is based on the dates indicated on the Acknowledgement Receipt assuming that, after review, the documents submitted are found to be entitled to an application filing date. Likewise the official reexamination filing date will be noted on the "Notice of ... Reexamination

Request Filing Date," after Central Reexamination Unit (CRU) review for filing date compliance and is based on the dates indicated on the Acknowledgement Receipt.

If the official version of any document received by the EFS-Web is lost, damaged or rendered unreadable by the USPTO and if it cannot be recovered from the stored files received by electronic submission, then the applicant/reexamination party will be promptly notified. In that situation, the applicant/reexamination party may have to resubmit the document(s) or portion of the document that are lost and petition for the original filing date. Such events are expected to be rare, indeed since inception of the EFS project no documents submitted using USPTO EFS software and received in EFS have been lost. In most cases a phone call to the Electronic Business Center (EBC) will resolve the issue. But if that is not sufficient, the applicant/reexamination party would present: (1) the Acknowledgement Receipt; (2) a copy of the missing files as submitted; and (3) a signed petition and statement verifying that the attached files are the same as mentioned in the Acknowledgement Receipt for that application number. The Acknowledgement Receipt and statement will serve as *prima facie* evidence that the resubmitted documents are the same as those submitted on the date of receipt. Note the Acknowledgement Receipt only indicates that the USPTO received what was actually sent, as opposed to what may have been intended to be transmitted. Applicants/ reexamination parties should exercise the same care in preparing and preserving a copy of a submission in electronic form as in paper.

## **IX. Entry in the US national stage under 35 USC 371**

It is recommended that applicants continue to use the Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Submission Under 35 USC 371 (Form PTO-1390) when electronically filing documents for entry into the US national stage under 35 USC 371. The PTO-1390 Form includes useful information that is not otherwise collected by EFS-Web at this time.

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 USC 371 and other applicable requirements, Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 USC 371 will be issued in addition to the Filing Receipt.

## **X. Security**

The USPTO requires Public Key Infrastructure (PKI) certificates to meet federal government computer system authentication guidelines as defined by the National Institute of Standards and Technology (NIST) and the Office of Management and Budget (OMB). The required evaluation of EFS and PAIR determined that level 3 authentication was needed which is met by the USPTO's PKI.

Only PKI registered users (or persons under their direction and control) can submit follow on papers. This preserves confidentiality, and is consistent with power of attorney and correspondence regulations. In order to obtain a PKI certificate the user must already be a registered attorney (or equivalent) or inventor and complete the appropriate paperwork. Once the user has a PKI certificate, the user can authenticate himself/herself to the USPTO through the

EFS-Web sign-on. This will generate a secure, encrypted, connection with the USPTO. While an inventor and his/her attorney may obtain a PKI certificate, only a single PKI certificate associated with a single customer number is allowed access to a particular application in Private PAIR.

For filers that do not have or do not wish to use a PKI certificate to authenticate to the USPTO, they may still submit new filings only via a non-authenticated workflow. The user would go to the EFS-Web page and choose to submit without a PKI certificate as an unregistered user, which would generate a Transit Layer Security (TLS) connection for the session, thus allowing secure data transmission to the USPTO. Non-authenticated users have the same level of protection for filing as a registered user, but are limited to submission of initial filings. This practice minimizes the risk of improperly filed third party petitions and other papers.

Note: Users are advised that the USPTO may revoke a user's digital PKI certificate if the user makes an improper submission through EFS-Web. See section XXXI (Documents Policy) at page 17. See also paragraph 4 of the "United States Patent and Trademark Office Public Key Infrastructure Subscriber Agreement" located at [<http://www.uspto.gov/ebc/documents/subscribersagreement.pdf>].

## **XI. Policy of Annex F of the PCT Administrative Instructions**

EFS-Web employs a Web based approach to document submission which is different from the Annex F "wrapped, bundled and signed package" approach. Thus EFS-Web does not meet Annex F requirements. See Annex F of the PCT Administrative Instructions located at [<http://www.wipo.int/pct/en/texts/>]. While EFS-Web is not required to meet Annex F requirements at this time, work will commence to expand Annex F as a world standard.

## **XII. What is the official record of documents submitted by EFS-Web?**

The Official Record for application files and reexamination proceeding documents (e.g., reexamination requests) submitted via EFS comprises (1) ASCII text documents as well as color and grayscale drawings in PDF format as stored in the Supplemental Complex Repository for Examiners (SCORE) and (2) TIFF images of all other original documents as stored in the Image File Wrapper system as well as the Electronic Acknowledgement Receipt and the Electronic Patent Application Fee Transmittal both of which contain information entered via the EFS-Web graphical user interface (GUI). The original documents submitted via EFS, e.g., applications and, reexamination proceeding documents are stored exactly as filed, for reference, in an independent location.

## **XIII. May biotechnology sequence listings, large tables, or computer program listing appendices be submitted as text files via EFS-Web?**

Yes, all of these types of documents may be submitted as text files for national applications (other than international applications filed under the Patent Cooperation Treaty (PCT)) and reexamination proceeding documents. The CD practice of 37 CFR 1.52(e) and 37 CFR 1.821 remains as a filing option. The filing of international applications under the PCT via EFS-Web is discussed in Part XVIII below.

A filer may submit the following document types, as specified in 37 CFR 1.52(e), as text files via EFS-Web instead of on compact disc provided such files are in compliance with the American Standard Code of Information Interchange (ASCII):

A computer program listing (see 37 CFR 1.96);

A “Sequence Listing” (submitted under 37 CFR 1.821); or

Any individual table (see 37 CFR 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, wherein a table page is a page printed on paper in conformance with 37 CFR 1.52(b) and 37 CFR 1.58(c).

The requirements of 37 CFR 1.52(e)(3)(ii), (4), and (6) are not applicable to computer program listings, sequence listings, and tables submitted as text files via EFS-Web. Further, the specification must contain an incorporation-by-reference of the material in the text file in a separate paragraph identifying the name of the text file, the date of creation, and the size of the text file in bytes as per 37 CFR 1.52(e)(5).

Pursuant to 37 CFR 1.821, a patent application which discloses nucleotide and/or amino acid sequences must contain both “a paper copy” of the sequence listing (37 CFR 1.821(c)) and a computer readable form (CRF) of the sequence listing (37 CFR 1.821(e)). If a sequence listing text file submitted via EFS-Web complies with the requirements of 37 CFR 1.824(a)(2)-(6) and (b) (i.e., is a compliant sequence listing ASCII text file), the text file will serve as both the paper copy required by 37 CFR 1.821(c) and the CRF required by 37 CFR 1.821(e). Thus a statement under 37 CFR 1.821(f) (indicating that the paper copy and CRF copy of the sequence listing are identical) is unnecessary. Furthermore, the filer need not submit any additional copies of the sequence listing pursuant to 37 CFR 1.821(e). If a filer submits a compliant sequence listing ASCII text file via EFS-Web, the filer should not request the use of a compliant computer readable “Sequence Listing” that is already on file for another application pursuant to 37 CFR 1.821(e). If such a request is filed, the Office will not carry out the request but will use the sequence listing submitted with the application as originally filed via EFS. Checker software that may be used to check a sequence listing for compliance with the requirements of 37 CFR 1.824 is available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/checker/>.

If a filer submits a sequence listing (under 37 CFR 1.821(c) and (e)) as a text file via EFS-Web in response to a requirement under 37 CFR 1.821(g) or (h), the sequence listing text file must be accompanied by a statement that the submission does not include any new matter which goes beyond the disclosure of the application as filed. However, if the sequence listing text file complies with the requirements of 37 CFR 1.824(a)(2)-(6) and (b), the filer need not submit (i) any additional copies of the sequence listing pursuant to 37 CFR 1.821(e) nor (ii) the statement described in 37 CFR 1.821(f) and any request under 37 CFR 1.821(e) for the use of a compliant

computer readable “Sequence Listing” that is already on file for another application is unnecessary and will not be carried out.

#### **XIV. How are text files counted for application size fee purposes?**

Any sequence listing submitted as a text file via EFS-Web that is otherwise in compliance with 37 CFR 1.52(e) and 1.821(c) or (e), and any computer program listing submitted as a text file via EFS-Web that is otherwise in compliance with 37 CFR 1.52(e) and 1.96, will be excluded when determining the application size fee required by 37 CFR 1.16(s) or 1.492(j) as per 37 CFR 1.52(f)(1).

Regarding a table submitted as a text file via EFS-Web that is part of the specification or drawings, each three kilobytes of content submitted will be counted as a sheet of paper for purposes of determining the application size fee required by 37 CFR 1.16(s) or 1.492(j). Each table should be submitted as a separate text file. Further, the file name for each table should indicate which table is contained therein.

#### **XV. What is the size limit for text files?**

100 megabytes is the size limit for sequence listing text files submitted via EFS-Web. If a filer wishes to submit an electronic copy of a sequence listing text file that exceeds 100 megabytes, it is recommended that the electronic copy be submitted on compact disc via Express Mail in accordance with 37 CFR 1.10 on the date of the corresponding EFS-Web filing in accordance with 37 CFR 1.52(e) if the filer wishes the electronic copy to be considered part of the application as filed. Alternatively, a filer may submit the application in paper and include the electronic copy of the sequence listing text file on compact disc in accordance with 37 CFR 1.52(e). Sequence listing text files may not be partitioned into multiple files for filing via EFS-Web as the EFS-Web electronic filing system is not currently capable of handling such submissions. If the sequence listing is filed on a compact disc, the sequence listing must be a single document, but the document may be split using software designed to divide a file, that is too large to fit on a single compact disc, into multiple concatenated files. If the filer breaks up a sequence listing so that it may be submitted on multiple compact discs, the compact discs must be labeled to indicate their order (e.g., “1 of X”, “2 of X”, etc.).

For all other file types, 25 megabytes is the size limit. If a filer wishes to submit an electronic copy of a computer program listing or table that is larger than 25 megabytes, it is recommended that the electronic copy be submitted on compact disc via Express Mail in accordance with 37 CFR 1.10 on the date of the corresponding EFS-Web filing in accordance with 37 CFR 1.52(e) if the filer wishes the electronic copy to be considered to be part of the application as filed. Alternatively the applicant/patent owner may submit the application in paper and include the electronic copies on compact disc in accordance with 37 CFR 1.52(e). Another alternative would be for the filer to break up a computer program listing or table file that is larger than 25 megabytes into multiple files that are no larger than 25 megabytes each and submit those smaller

files via EFS-Web. If the filer chooses to break up a large computer program listing or table file so that it may be submitted electronically, the file names must indicate their order (e.g., “1 of X”, “2 of X”, etc.).

## **XVI. What is the limit on the number of electronic files submitted via EFS-Web?**

60 electronic files is the file number limit, as EFS-Web is not currently capable of accepting more than 60 electronic files in any one submission. Accordingly, if an application file is comprised of more than 60 electronic files, it is recommended that the filer submit 60 or fewer files in an initial filing via EFS-Web at which time the application will be assigned an application number. Note that regarding the 60 electronic file limit, an applicant may upload and validate in sets up to 20 files each, with a limit of three sets of 20 files. If applicant chooses to divide a file into multiple parts using the multi-doc feature, each part is counted as one file. Then the filer may submit any additional electronic files as follow-on documents later on the same day as the initial filing. This will allow all of the electronic files making up the application to receive the same filing date.

## **XVII. May international applications filed under the Patent Cooperation Treaty (PCT) with the US Receiving Office (RO/US) be electronically submitted via EFS-Web?**

Yes, EFS-Web enables a user to electronically file international applications under the Patent Cooperation Treaty (PCT) with the United States Receiving Office (RO/US).

## **XVIII. May EFS-Web be used to file international applications containing nucleotide/amino acid sequence listings and/or tables related thereto in the United States Receiving Office?**

Yes, applicants may file international applications under the PCT that contain nucleotide/amino acid sequence listings and/or tables related thereto with the United States Receiving Office (RO/US) via the EFS-Web filing system of the USPTO. However, computer program listings may not be included in international applications filed under the PCT.

Applicants are advised that EFS-Web may be used to file either: (1) international applications in fully electronic form or (2) follow-on papers to previously filed international applications. Applications containing large sequence listings and/or tables related thereto (i.e. 400 or more combined sequence listing and/or tables pages) may qualify for a reduced filing fee under Section 707(a-bis) of the PCT Administrative Instructions (AI) as discussed below.

Applicants should note that AI Part 8 does not apply to applications filed via EFS-Web, because AI Part 8 is reserved for applications filed partly on paper and partly on electronic media.

### **A. Sequence Listing:**

Under PCT Rule 5.2(a), the sequence listing part must always be presented as a separate part of the description. The sequence listing part of the description should be submitted as a single ASCII text file with a ".txt" extension (e.g. "seqlist.txt"). Submission of the sequence listing part in PDF format is not recommended because applicant would still be required to supply a copy of the sequence listing in text format in accordance with AI Annex C, ¶39. If the sequence listing part is submitted as a text file, applicant need not submit any additional copies. The text file will serve both as the written portion of the sequence listing under PCT Rule 5.2 and the electronic form under PCT Rule 13ter.1(a). Furthermore, the required statement in paragraph 40 of Annex C that "the information recorded in the electronic form is identical to the sequence listing in the application" is not required. .

### **B. Tables Related to a Sequence Listing:**

Tables related to a sequence listing may be either interspersed with the rest of the description or consolidated into a separate part of the description. Description pages, which contain interspersed tables, must be submitted in PDF format. Table pages which are consolidated into a separate part of the description may be submitted in either PDF or text format when using EFS-Web, although text format is preferred. For consolidated tables, each table must be contained in a separate file with the appropriate extension (i.e. ".txt" for text files and ".pdf" for PDF files). Furthermore, each table file must have a filename which indicates the name of the table contained therein (e.g. "table-1.txt", "table-2.txt", "table-3.txt" etc. or "table-1.pdf", "table-2.pdf", "table-3.pdf", etc.). Regardless of the file format used, the spatial relationships (e.g., columns and rows) of the table elements must be maintained.

### **C. File Size and Quantity Limits**

100 megabytes is the size limit for sequence listing text files. For all other file types (including tables related to a sequence listing) EFS-Web is currently not capable of accepting files that are larger than 25 megabytes. Additionally, a single EFS-Web submission may include no more than 60 electronic files. Note that regarding the 60 electronic file limit, an applicant may upload and validate in sets up to 20 files each, with a limit of three sets of 20. If applicant chooses to divide a file into multiple parts using the multi-doc feature, each part is counted as one file. Unusually large or numerous sequence listings and/or tables may prevent applicant from making a complete international application filing in a single EFS-Web submission. In such instances, applicant may use EFS-Web to file part of the international application and to obtain the international application number and the confirmation number. The remainder of

the international application must then be submitted on the same day as one or more follow-on submissions using EFS-Web, Express Mail from the United States Postal Service (USPS) in accordance with 37 CFR 1.10, or hand delivery, as appropriate, in order to secure the same filing date for all parts of the international application. However, sequence listing text files may not be partitioned into multiple files for filing via EFS-Web as the EFS-Web electronic filing system is not currently capable of handling such submissions. In addition, USPS Express Mail and hand carried submissions may not contain PDF files and must fully comply with the guidelines for filing a sequence listing and/or tables related thereto on electronic media as set forth in MPEP 1823.02, except that only one copy of the sequence listing and/or tables is required, and applicant need not make any reference to AI Part 8 or AI § 801. If a sequence listing is filed on a compact disc, the sequence listing must be a single document, but the document may be split using software designed to divide a file, that is too large to fit on a single compact disc, into multiple concatenated files. If the filer breaks up a sequence listing into multiple concatenated files so that it may be submitted on multiple compact discs, the compact discs must be labeled to indicate their order (e.g., “1 of X”, “2 of X”, etc.).

As an alternative to using USPS Express Mail or a hand carried submission to submit a table file related to a sequence listing that exceeds the EFS-Web 25 megabyte limit, applicant may partition the oversize table file into multiple files, each of which is smaller than 25 megabytes. If applicant chooses to partition an oversize table file, the filenames of the resulting segments must indicate their proper order (e.g. "table-35-part1of3.txt", "table-35-part2of3.txt", etc.).

#### **D. Fee Determination for International Applications Containing a Sequence Listing.**

The calculation of the international filing fee shall take into account only the first 400 pages of the combination of any sequence listing and any tables related thereto which are individually consolidated in separate parts of the description. Tables that are not related to a sequence listing will not qualify for any potential fee reduction.

Pursuant to AI § 707(a), the international filing fee, subject to the 400 page limit described above, is calculated on the basis of the number of sheets that the application would contain if presented as a print-out complying with the physical requirements prescribed in PCT Rule 11. For text files, each three kilobytes of content as measured by USPTO computer systems shall be counted as one printed page for fee calculation purposes.

### **XIX. Follow-on Submissions for International Applications.**

As noted above, a sequence listing part and/or tables related thereto may be submitted using one or more follow-on EFS-Web submissions. Such follow-on submissions will form part of the international application if filed on the same date on which the international application was

filed. Note that follow-on submissions may change the number of pages in the international application and therefore may affect the international filing fee.

EFS-Web may also be used to submit a sequence listing in text format after the international filing date in response to a requirement under 37 CFR 1.821(h) and PCT Rule 13*ter*. Such sequence listing will not form part of the international application as set forth in PCT Rule 13*ter*.1(e).

## **XX. May a reissue application or a request for reexamination, and follow on papers be submitted via EFS-Web?**

Yes, EFS-Web permits a user to electronically submit a reissue application under 35 USC 251 and follow-on papers, a request for ex parte reexamination under 35 USC 302 and follow-on papers, or a request for inter partes reexamination under 35 USC 311 and follow-on papers. In reexamination, both the reexamination requester and the patent owner may file via EFS-Web.

## **XXI. May pre-grant publication requests be submitted via EFS-Web?**

Yes, EFS-Web enables users to electronically submit pre-grant publication requests for amended publication, redacted publication, voluntary publication, or republication under 37 CFR §§ 1.215, 1.217, 1.219, and 1.221(a) via EFS-Web. When filing pre-grant publication requests via EFS-Web, the form fillable application data sheet (PTO/SB/14) is required to be used for fulfilling the bibliographic data requirements. An electronic submission for voluntary publication, amended publication, republication (37 CFR § 1.221(a)) or redacted publication must be submitted as a “Pre-Grant Publication” by selecting the “Pre-Grant Publication” radio button on the EFS-Web data collection screen. It is not sufficient for a filer to merely submit a document via EFS-Web requesting voluntary publication, amended publication, republication or redacted publication without also selecting the "Pre-Grant Publication" radio button on the EFS-Web data collection screen.

## **XXII. May color drawings for design applications be submitted via EFS-Web?**

Yes, all design application drawings may be submitted via EFS-Web. However, the Office will treat color drawings in design applications as informal drawings unless accompanied by a grantable petition filed under 37 CFR § 1.84(a)(2) explaining why the color drawings are necessary.

The requirement for three (3) sets of color drawings under 37 CFR 1.84(a)(2)(ii) is not applicable to color design drawings submitted via EFS-Web. Only one set of such color design drawings is sufficient when filing via EFS-Web.

Drawings submitted via EFS-Web in application types other than design applications must be in bitonal black and white only.

### **XXIII. What is the date of receipt of an application received under the EFS-Web?**

35 USC 111(a)(4) states in part (emphasis added):

The filing date of an application shall be the date on which the specification and any required drawing are **received in the Patent and Trademark Office**.

Thus, the filing date of an application is the date of receipt of the application in the USPTO. Further, the USPTO is located in the Eastern Standard Time zone. Accordingly, the date of filing of an application officially submitted through EFS-Web will be the date in the Eastern Standard Time zone at the time of submission. As such, the submission's "date of receipt", as shown on the Acknowledgement Receipt, is the Eastern Standard Time date that the documents are fully, successfully, and officially received at the USPTO as indicated by pressing the Submit Button on the Confirm and Submit screen. This date is controlling for filing date purposes of your newly filed application. There is no "certificate of transmission" practice for new application e-filings (37 CFR 1.8). This applies by analogy to reexamination proceedings.

*To be very specific, the EFS-Web system records as the date of receipt of documents the local date in Eastern Standard Time on which it receives an electronic indication that the SUBMIT button has been clicked on the Confirm and Submit screen for those documents.*

So, for example, if an applicant in California officially files a patent application with the USPTO through EFS-Web by clicking on the SUBMIT button at 10:00 PM Pacific Time in California on May 1, that application would be officially received by the USPTO at 1:00 AM Eastern Standard Time on May 2. Accordingly, the application would receive a filing date of May 2. However, the applicant could alternatively file the application using the "Express Mail Post Office to Addressee" service of the United States Postal Service in accordance with 37 CFR 1.10 in which case the applicant would have until midnight on May 1 in his/her local time zone to file the application and obtain a filing date of May 1.

### **XXIV. What if the applicant electronically files an application via EFS-Web, and on that same day, realizes that they have inadvertently omitted a document from the application?**

One advantage of filing an application via EFS-Web is that the applicant may view the submission in PAIR and file a paper directly into the application on the same day as the filing

date of the application. In certain situations, applicant may correct an error by filing a missing item(s) on the same day as the filing date of the application. Applicant, however, may wish to file another new application in other certain situations. For example:

(1) Oath or Declaration - Applicant may file an executed oath or declaration on the same day as the filing date as the application via EFS-Web. The oath or declaration will not be considered late and thus a surcharge for filing a late oath or declaration will not be required.

(2) Filing Fees - Applicant may file the filing fees (e.g., the basic filing fee, search and examination fees, application size fee, or excess claims fee) on the same day as the filing date of the application via EFS-Web. The fees will not be considered late and thus a surcharge for filing the filing fees will not be required.

(3) Non-publication request - Since 37 CFR 1.213(a)(1) requires any non-publication request to be filed with the application, applicant cannot simply file the non-publication request to correct the error. If applicant does not wish to have the application publish, applicant must file: (a) a new application with a nonpublication request; and (b) file a petition for express abandonment to avoid publication under 37 CFR 1.138(c) and fee under 37 CFR 1.17(h) in sufficient time to permit the appropriate officials in Pre-Grant Publication Division to recognize the abandonment and remove the application from the publication process.

(4) Drawings - Applicant may file the missing drawings as a preliminary amendment on the same day as the filing date of the application. The drawings will be considered as part of the original disclosure of the application. See 37 CFR 1.115(a)(2). If the application, however, were filed with the “wrong drawings,” the “wrong drawings” would still be part of the original disclosure. A preliminary amendment could be filed on the same day as the filing date of the application adding the correct drawings and deleting the “wrong drawings.” An amendment adding new drawings and deleting the “wrong drawings,” filed on a day after the filing date of the application, may raise new matter issues. Certainly, if applicant wishes to have an application without the “wrong drawings” being a part of the original disclosure, applicant should file a totally new application (e.g., new specification including claims(s) and fees) comprising the correct drawings, and, if desired, expressly abandon the original application.

(5) Claims - Applicant may file the claims as a preliminary amendment on the same day that applicant filed the application papers. Please note that the application will not be entitled to a filing date until applicant files at least one claim in the application.

(6) Part of the specification - Applicant may file the missing portion of the written description as a preliminary amendment on the filing date of the application. Such amendment will be considered as part of the original disclosure.

If applicant files another new application to correct the error, applicant will have two applications. Applicant may continue to prosecute the first application that has the error or abandon the first application by filing a declaration of express abandonment. Please note that any fees paid in the first application will not be refunded or applied to the second application. Applicant may request refund of the search fee and any excess claims fees (but not the basic filing fee, examination fee, and application size fee) paid in the first application if the application was filed under 35 USC 111(a) on or after December 8, 2004 and the applicant files a declaration of express abandonment in accordance with 37 CFR § 1.138(d).

## **XXV. What is the date of receipt of follow-on correspondence received by the USPTO through EFS-Web?**

Patent application/reexamination proceeding correspondence filed after the initial application filing (i.e. follow-on correspondence) will receive as an official filing date the date the follow-on correspondence is received at the USPTO. However, follow-on correspondence that is required to be filed within a set time period will be considered timely if the correspondence is officially submitted through EFS-Web prior to the expiration of the set time period, and the correspondence includes a certificate for each piece of correspondence stating the local date of submission. See 37 CFR 1.8(a)(1)(i)(C).

## **XXVI. Hours of Operation**

Hours of operation of the EFS-Web will be clearly provided in the EFS-Web instructions. If a transmission is attempted during a down time, the Office cannot accept it and will, if possible, transmit back a notice that the Office is not accepting submissions. No Acknowledgement Receipt will be sent. Instead a notice will advise the applicant/reexamination party 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. Note that most applications filed under 37 CFR 1.53, and reexamination requests, cannot be submitted by fax (37 CFR 1.6(d)(3) and (5)), and that normal certificate of mailing procedures do not apply to new applications and reexamination requests (37 CFR 1.8(a)(2)(i)(A) and (D)). Users are strongly advised to transmit their electronic filings sufficiently early in the day to allow time for alternative paper filing when transmission cannot be initiated or correctly completed.

If the submission is successfully received on a Saturday, Sunday or Federal holiday within the District of Columbia, the Office will assign that receipt date at the USPTO to the submission.

## **XXVII. 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>.

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, 35 USC 21(b) states:

When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office 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.

Further, 35 USC 119(e)(3) states:

If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

Thus, under United States law, applicants will 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.

However, Article 4 of the Paris Convention addresses the priority period and in Article 4(c)(3) it states:

If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

Further, as stated above, the USPTO is capable of accepting electronic patent application filings every day of the week, including weekends and holidays, through EFS-Web. Thus, applicants are cautioned to consider possible adverse consequences regarding the determination in other countries of priority periods under Article 4(C)(3) of the Paris Convention when filing international applications with the United States Receiving Office (RO/US). Specifically, the ability to file applications electronically on weekends and holidays in the USPTO *may* result in loss of priority rights in foreign jurisdictions designated in international applications filed with the RO/US, if applicants elect, in accordance with 35 USC 21(b) or 119(e)(3), to file an international application on the next succeeding business day in the event that the twelve month Paris Convention priority period set out in Article 4(C)(1) falls on a Saturday, Sunday, or Federal Holiday. In such circumstances, other Patent Offices *may* deny the priority claim on the basis that the international application was not timely filed if their national law strictly incorporates the provision of Paris Convention Article 4(c)(3) and considers the USPTO to be open for the filing of applications on weekends and holidays. 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 applications with the USPTO, and instead file the application before the Paris Convention twelve-month priority period has expired.

## **XXVIII. Under what authority does an authorized assistant of the digital certificate holder submit signed documents?**

Subscriber Agreements and Certificate Action Forms have been written to permit Assistants under the direction and control of the digital certificate holder (applicant/reexamination party or attorney) to submit documents under EFS-Web. The Assistant will use the Certificate Holder's certificate to make the submission.

The Assistant will serve the ministerial function of pickup and delivery of documents that have been electronically or ink signed by the applicant/reexamination party or the attorney. (Ink signed documents can be electronically scanned and then e-filed.) The Assistant, not being a

registered attorney or the applicant/reexamination party, does not have the authority to sign or be responsible for the content of the documents submitted. However, they may view and retrieve documents from Private PAIR, or submit documents under EFS-Web under the direction of a registered practitioner.

In the submission process, the Assistant is required to specify certain "locator information" so the documents can be associated with the proper electronic File Wrapper in the IFW system. That locator information may include the application's title, first named inventor, docket number, application number, confirmation number, correspondence address and filing date, all if available. The type of application (e.g. 111(a), 371, international application, etc) and information necessary for the payment of fees are not considered to be locator information. This information is entered on submission to assure that the documents are placed in the proper file, and do not constitute a signed submission of bibliographic data on behalf of the applicant/reexamination party. Errors made in the "locator information" may be corrected by the Office on its own initiative, or by the applicant/reexamination party, similar to the way they are corrected in paper processing.

It also should be noted that the assistant could pay the fees associated with the submission in the EFS-Web solution. This is comparable to the paper practice in which law firms designate individuals to pay fees.

## **XXIX. Under what conditions will the EFS-Web allow refunds?**

The USPTO will grant refunds to e-filers when, due to a malfunction with the EFS-Web system, the EFS-Web system has misled a filer into paying a fee in error. If it cannot be determined that a malfunction occurred, but rather seems only to be an e-filer error, no refund will be given. The filer should contact the EBC if there are any issues associated with their submission.

## **XXX. Signature Policy**

Signatures, other than handwritten signatures meeting the standard of 37 CFR 1.4(d)(1), included in image attachments submitted via EFS-Web are governed by the S-signature requirements of 37 CFR 1.4(d)(2) (See also 69 FR 56186, Sept. 21, 2004).

If the signer is submitting an application through EFS-Web in image-based PDF format, he or she should apply either a handwritten signature in compliance with 37 CFR 1.4(d)(1) or an S-signature in compliance with 37 CFR 1.4(d)(2) before scanning the document or converting it to image-based PDF form. It is noted that when filing a new application by EFS-Web, a signed transmittal form or a signed application data sheet (ADS) is recommended for identification purposes. It should be noted, however, that a signature is not required to obtain a filing date for a new patent application.

A legible electronic image of a handwritten signature inserted, or copied and pasted by the person signing the correspondence into an application document may be considered to be an

acceptable signature. The legible image of the handwritten signature of the person signing the correspondence must be inserted by the person. Additionally, the signature must be surrounded by a first single forward slash mark before the electronic image and a second single forward slash mark after the electronic image. That is, the legible electronic image of a handwritten signature must be enclosed between two single forward slashes and the signer's name is indicated below or adjacent the signature as per 37 CFR 1.4(d)(2). The slashes may be inserted into the document prior to the insertion of the signature.

The presentation to the USPTO (whether by signing, filing, submitting, or later advocating) of any document constitutes a certification under 37 CFR 10.18(b)(2). See 37 CFR 1.4(d)(4).

### **XXXI. Documents Policy**

EFS-Web will allow registered users to file both new submissions and follow-on documents. The following is a list of submission types that are not allowed to be filed using EFS-Web:

- 1) Correspondence concerning **Registration Practice** submitted under 37 CFR 1.4(e), which states:  
Correspondence requiring a person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent by that person. See 37 CFR 1.6(d)(1)
- 2) **Certified Copies** submitted under 37 CFR 1.4(f), which states:  
When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable. See 37 CFR 1.6(d)(2). An example of such a submission is a certified copy of a foreign patent application filed pursuant to 35 USC 119 or a certified copy of an international application filed pursuant to 35 USC 365.
- 3) Correspondence to be filed in a patent application subject to a **secrecy order** under §§ 5.1 through 5.5 of this chapter. See 37 CFR 1.6(d)(6).
- 4) Submissions in contested cases before the **Board of Patent Appeals and Interferences**, except as the Board may expressly authorize. See 37 CFR 1.6(d)(9).
- 5) Papers filed in contested cases before the **Board of Patent Appeals and Interferences**, which are governed by 37 CFR 41.106(f). See 37 CFR 1.6(d)(3).
- 6) Correspondence filed in connection with a **disciplinary proceeding** under 37 CFR part 10. See 37 CFR 1.6(d)(3).
- 7) Submissions that are **not associated with an application/reexamination proceeding**.
- 8) **Third party papers** under 37 CFR 1.99.

- 9) **Protests** under 37 CFR 1.291.
- 10) **Public use hearing papers** under 37 CFR 1.292.
- 11) **Maintenance fees** submitted under 37 CFR 1.366. See MPEP 2510 for information regarding the proper methods for submitting maintenance fees.
- 12) Assignment documents under 35 USC 261, which may be electronically filed using the Electronic Patent Assignment System (EPAS) or the Electronic Trademark Assignment System (ETAS). Information regarding EPAS is available at: <http://epas.uspto.gov>. Information regarding ETAS is available at: <http://etas.uspto.gov>.
- 13) Submissions under 35 USC 161 associated with **plant applications**.
- 14) Initial submissions for Patent Term Extension under 35 USC 156.

For more information on these policies, please contact Diana Oleksa, Legal Advisor – IT Projects, PCT Legal Administration, at [Diana.Oleksa@uspto.gov](mailto:Diana.Oleksa@uspto.gov) .



John J. Love  
Deputy Commissioner for Patent Examination Policy

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