

LEGAL FRAMEWORK FOR PATENT ELECTRONIC SYSTEM

October 23, 2019

Introduction–Scope of Document

This legal framework provides guidance on the background statutes, regulations and policies that support the United States Patent and Trademark Office’s (USPTO or Office) Patent Electronic System. The Patent Electronic System currently comprises EFS-Web, which is the USPTO’s web-based patent application and document submission system; and the Patent Application Information Retrieval (PAIR) system, which is the USPTO’s web-based means for electronically viewing the status of, and documents filed in or associated with, patent applications and proceedings. This legal framework also discusses the two-step authentication method now in place for accessing the Patent Electronic System. This legal framework is provided as a reference for applicants, parties in reexamination proceedings, attorneys, and agents.

This legal framework supersedes all prior versions of the legal framework and Manual of Patent Examining Procedure (MPEP) section 502.05, Ninth Edition, Rev. 08.2017 (January 2018). The following is a brief summary of the major differences introduced by this legal framework:

1. Section B has been revised to further clarify that third-party papers are generally prohibited from being filed via EFS-Web unless specifically authorized.
2. Section D has been revised to clarify that providing an incorrect application number and confirmation number when filing a follow-on document will result in the follow-on document being entered in the wrong application. This may result in either the unintentional abandonment of the intended application for failure to reply to an Office action (or notice) or a reduction in patent term adjustment for failure to take reasonable steps to conclude processing or examination of an application. This may result in applicant having to file a petition to revive an unintentionally abandoned application.
3. Section E has been rewritten to discuss the two-step authentication method now being used to log into EFS-Web and Private PAIR.¹ The two-step authentication method replaced the prior use of Public Key Infrastructure (PKI) certificates to access the Patent Electronic System. PKI certificates were discontinued on July 2, 2019.

¹ PAIR includes both Public PAIR and Private PAIR. Public PAIR provides access to all issued patents and published patent applications. Private PAIR allows registered users to access pending application information in addition to what is also available in Public PAIR. Two-step authentication is required for Private PAIR but not for Public PAIR.

Contact Information

Inquiries regarding the Patent Electronic System and other USPTO information technology (IT) systems may be directed to the Patent Electronic Business Center (Patent EBC), by telephone: (866) 217-9197 (toll-free) and (571) 272-4100, or by e-mail: *ebc@uspto.gov*.

Inquiries regarding IT policy for U.S. national patent applications may be directed to Mark Polutta, Senior Legal Advisor (telephone (571) 272-7709; e-mail at *mark.polutta@uspto.gov*), or Gena Jones, Senior Legal Advisor (telephone (571) 272-7727; e-mail at *eugenia.jones@uspto.gov*), both with the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy.

Inquiries regarding IT policy for international applications (PCT) may be directed to Tamara Graysay, Special Program Examiner (telephone (571) 272-6728; e-mail at *tamara.graysay@uspto.gov*), and inquiries regarding IT policy for international design applications may be directed to Boris Milef, Senior Legal Examiner (telephone (571) 272-3288; e-mail at *boris.milef@uspto.gov*), both with the Office of International Patent Legal Administration, Office of International Patent Cooperation.

Legal Framework

A. General Information on the Patent Electronic System

The Patent Electronic System currently comprises EFS-Web, which is the USPTO's web-based system for electronic filing of patent correspondence; and PAIR, which is the USPTO's web-based means for electronically viewing the status of, and documents filed in or associated with, patent applications and proceedings. The Patent Electronic System is accessible via the USPTO website.

Users may use the Patent Electronic System to access and file documents securely in a variety of applications and proceedings, including patent applications, applications for international registration of industrial designs, reexamination requests and proceedings, and supplemental examination requests and proceedings. The term "users" includes anyone who accesses the EFS-Web system, including inventors, third parties (who may submit some papers such as third-party submissions via a dedicated interface), practitioners, and sponsored support staff. For purposes of readability, the term "application" is used in this document to represent any and all of the possible types of applications and proceedings, except where specifically noted otherwise. Users also may use EFS-Web to submit payments of most patent fees including patent application filing fees.

In particular, users may use the web-based interfaces of EFS-Web to submit documents in Portable Document Format (PDF) directly to the USPTO. All EFS-Web submissions are required to be in PDF unless otherwise indicated in this framework. EFS-Web permits

submission of the following non-PDF formats: (1) the American Standard Code of Information Interchange (ASCII) plain text files (.TXT) to submit nucleotide and/or amino acid sequence listings, computer program listings, mega tables, and Complex Work Units; (2) zip-compressed files to submit the request form generated by PCT-SAFE or ePCT in international applications filed under the Patent Cooperation Treaty (PCT) with the United States Receiving Office; and (3) JPEG reproductions in international design applications. Sections L, M, and N, respectively, of this framework provide further information. (Note: All references to ASCII text in this document, whether specified or not, refers to ASCII plain text only.) Users need not provide a duplicate copy of any document filed through EFS-Web unless the USPTO specifically requires the filing of a duplicate in a particular situation.

The USPTO provides users with PDF EFS-Web-fillable forms, such as the Provisional Application for Patent Cover Sheet, the Information Disclosure Statement (IDS), the Application Data Sheet (ADS), the Petition to Make Special Under Accelerated Examination Program, and the Request for Continued Examination (RCE) Transmittal. When users submit information for an ADS or an IDS using an EFS-Web-fillable form (not a scanned image (PDF) of a document), the information will directly load into the USPTO databases, which will increase accuracy and facilitate faster processing. Users may use other USPTO-created PDF fillable forms available on the USPTO website, or user-created forms in PDF, and submit the completed forms via EFS-Web. The information entered on non-EFS-Web-fillable forms, however, will not be automatically loaded into the USPTO databases.

Users also may use EFS-Web to submit web-based documents, such as ePetitions, Requests for Withdrawal as Attorney or Agent of Record, and eTerminal Disclaimers. Such documents can be filled out completely online through web-based interfaces without the need for any fillable PDF form. These ePetitions, requests, and eTerminal Disclaimers are auto-processed and granted or approved immediately upon submission if the ePetition, request, or eTerminal Disclaimer meets all of the requirements. An ePetition, request, or eTerminal Disclaimer document is generated by EFS-Web based on the information entered into EFS-Web. The ePetition, request, or eTerminal Disclaimer, and a decision granting the ePetition or request, or an approval letter approving of the eTerminal Disclaimer, will be loaded into the electronic application file (i.e., the Image File Wrapper (IFW)), if the ePetition or request is granted, or if the eTerminal Disclaimer is approved. If the ePetition, request, or eTerminal Disclaimer does not meet all of the requirements, it will not be loaded into the electronic application file (i.e., IFW).

Users also may use EFS-Web to submit other documents, such as application data sheets, as web-based documents that can be filled out completely online through web-based interfaces without the need for any fillable PDF form. Documents submitted in this manner will be automatically loaded into the USPTO databases.

Users may review and check their electronic submissions, including their attached PDF files, before submitting the documents to the USPTO. After submitting the documents via

EFS-Web, the system will display a page that states the USPTO has received the user's submission and that provides an application number. Users of EFS-Web will receive an Electronic Acknowledgement Receipt (which can be printed or saved) of a successful submission received by the USPTO on their device, usually within a few minutes. A copy of the receipt is entered into the application file and may be obtained using PAIR. The processing of fees may delay the issuance of the Electronic Acknowledgement Receipt. The Electronic Acknowledgement Receipt is the electronic equivalent of a postcard receipt. *See* MPEP 503. Most documents submitted via EFS-Web will be viewable by the registered user via Private PAIR within an hour after the USPTO receives the documents, if the user has associated the application with the user's customer number. Therefore, users will immediately be able to check the contents of their applications for completeness and accuracy of their electronic submissions. Users may also choose to have an email sent to an email address with limited information such as the application number.

A user may become a registered user by first obtaining a USPTO.gov account and undergoing a required authentication process, detailed further in section E of this framework. All users—whether registered or not—can file most patent applications via EFS-Web. Registered users can also file follow-on documents in a patent application. However, an unregistered user can only file limited types of follow-on documents in a patent application (e.g., petitions to make special based on age and petitions to accept an unintentionally delayed payment of a maintenance fee). Section B of this framework includes more information.

The USPTO website provides additional information on EFS-Web and PAIR, such as instructions, guidelines, frequently asked questions, and tutorials. Users may contact the Patent Electronic Business Center (Patent EBC) for assistance with EFS-Web and PAIR as well as for information for registration for two-step authentication and customer numbers.

The USPTO is developing a new electronic filing and viewing system, Patent Center, to modernize its filing and viewing systems. Once fully developed, Patent Center will replace EFS-Web and PAIR. Patent Center will utilize web-based interfaces to enable users to submit patent documents directly to the USPTO in Open XML format (DOCX) for the specification (including the claims and the abstract) of a new utility nonprovisional, provisional, or national stage under 35 U.S.C. 371 application. The submission of documents in PDF also will be supported. The submission of documents through Patent Center is not addressed by this Legal Framework, but instead will be addressed by a separate Legal Framework.

B. Legal and Document Policies

This Legal Framework sets forth the USPTO's policies concerning documents submitted electronically using EFS-Web, including patent applications, applications for

international registration of industrial designs, reexamination requests and proceedings, and supplemental examination requests and proceedings, as well as follow-on documents for such applications, requests, and proceedings. Applicable regulations will be interpreted consistent with this framework for any document submitted electronically using EFS-Web.

B1. Types of Patent Applications and Documents Permitted to be Filed via EFS-Web.

a. Filings Permitted by Registered and Unregistered Users.

EFS-Web permits registered users (*see* section E) and unregistered users to file the following applications, requests for reexamination, and documents:

1. Provisional patent applications filed under 35 U.S.C. 111(b).
2. Nonprovisional utility patent applications filed under 35 U.S.C. 111(a), which can include other papers such as Track One requests or accelerated examination requests on initial filing.
3. Nonprovisional design patent applications filed under 35 U.S.C. 111(a) (*see* 35 U.S.C. 171).
4. International applications filed under the PCT in the United States Receiving Office (*see* 35 U.S.C. 361).
5. Submissions to enter the national stage under 35 U.S.C. 371.
6. International design applications filed under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (*see* 35 U.S.C. 382).
7. Requests for *ex parte* reexamination under 35 U.S.C. 302 for utility or design patents, as a new submission (i.e., not in the patent file).
8. Requests for supplemental examination under 35 U.S.C. 257 for utility, design, or plant patents, as a new submission (i.e., not in the patent file).
9. Third-Party Preissuance Submissions under 35 U.S.C. 122(e) and 37 CFR 1.290 for utility, design, or plant patent applications using a dedicated EFS-Web interface wherein the information is not directly placed into the application (*see* section I).
10. Citation of prior art and written statements in patent files under 37 CFR 1.501 for utility applications using a dedicated EFS-Web interface, where the information is not directly placed into the patent file (*see* section I).
11. Petitions to make special based on age under 37 CFR 1.102(c).

12. Petitions to accept an unintentionally delayed payment of a maintenance fee under 37 CFR 1.378, and payments of maintenance fees when submitted with the petition.

13. Reissue utility patent applications and reissue design patent applications.

b. Filing of Documents after the Initial Submission of the Application.

Registered users have the capability to file follow-on documents via EFS-Web. No user, whether registered or unregistered, is permitted to file documents in applications, reexamination proceedings, or supplemental examination proceedings in which they are not authorized. Authorization to act comes from being a practitioner of record or acting in a representative capacity pursuant to 37 CFR 1.32 and 1.34 respectively. Note, however, that one is not permitted to file papers in an application or proceeding if they are not a practitioner of record or acting in a representative capacity (37 CFR 1.34), including third parties, or parties who represent less than all inventors or less than all applicants, unless specifically authorized under this framework (*see* section E).

Follow-on documents are any documents filed after the initial submission of the application, request for reexamination, or request for supplemental examination. Follow-on documents include but are not limited to the following: amendments, information disclosure statements (IDS), replies to Office actions and notices, evidence, petitions, and terminal disclaimers. Follow-on documents also include any documents submitted on the same day as the application, but after the initial submission. In addition, registered users may file a copy of a patent application (e.g., a copy of the amended specification including the claims, and drawings) for the purposes of publication of the application when filed with any of the following pre-grant (eighteen-month) publication requests via EFS-Web: amended publication under 37 CFR 1.215(c), redacted publication under 37 CFR 1.217, early publication under 37 CFR 1.219, and voluntary publication or republication under 37 CFR 1.221(a). Section G provides more information on filing these publication requests via EFS-Web. In reexamination proceedings, both the reexamination requester and the patent owner may file documents via EFS-Web, if they are registered users. Registered users may also file a second or subsequent submission for patent term extension under 35 U.S.C. 156 in a patent file via EFS-Web.

Unregistered users cannot file documents after the initial submission via EFS-Web, except for ePetitions to make special based on age and ePetitions to accept an unintentionally delayed payment of a maintenance fee. Unregistered users may file follow-on documents by mail (with a certificate of mailing in accordance with 37 CFR 1.8), Priority Mail Express® from the USPS in accordance with 37 CFR 1.10, or hand-delivery.

Amendments and other papers filed in an application must be signed. Any follow-on document must be signed in accordance with 37 CFR 1.33(b) and it must identify on the top page in a conspicuous location, the application number (consisting of the series code

and the serial number, e.g., 07/123,456), the serial number and filing date assigned to that application by the Office, the international application number of the international application (PCT), or the international registration number of the international design registration. *See* 37 CFR 1.4, 1.5 and 1.33(b).

B2. Types of Patent Applications and Documents Not Permitted to be Filed via EFS-Web.

The following is a list of submission types that are not permitted to be filed using EFS-Web:

1. Plant patent applications (*see* 35 U.S.C. 161) filed under 35 U.S.C. 111(a) and follow-on documents associated with plant patent applications, other than third-party preissuance submissions under 37 CFR 1.290, which may be submitted via a dedicated EFS-Web interface wherein the information is not directly placed into the application file.

2. Requests for Reexamination under 35 U.S.C. 302 for plant patents and documents associated with reexamination proceedings for plant patents.

3. Third-party inquiries, petitions, or papers, unless specifically authorized by this Legal Framework and filed in the manner required by the EFS-Web interface. *See* B1 discussed previously. For example, a third party may file a citation of prior art and written statements in patent files under 37 CFR 1.501 or a Third-Party Preissuance Submission under 37 CFR 1.290 via a dedicated EFS-Web interface; however, the filer must select the appropriate option identifying the type of submission or the submission will be improper. Third-party filing of papers directly into an application, patent, or reexamination is not permitted under the regulations or this Legal Framework. The Office considers inappropriate any third-party inquiry or submission in an application that is not provided for in 37 CFR 1.290. Some examples of third-party papers that may not be filed by EFS-Web or in paper include inquiries into the timing of future actions on an application, disputes over inventorship in an application, requests to change inventorship, correspondence address, a power of attorney, and 37 CFR 3.73 statements.

Note further that EFS-Web may not be used by third parties to file papers that have no right to entry in an application or proceeding under USPTO rules and procedures. For example, a third party is prohibited from filing a demand that the Office withdraw an application from issue under 37 CFR 1.313 on the basis of unpatentability of a claim, and may not attempt to use the Patent Electronic System to evade this prohibition.

4. Initial submissions for patent term extension under 35 U.S.C. 156.

5. Correspondence concerning registration to practice as specified in 37 CFR 1.4(e). *See also* 37 CFR 1.6(d)(1).

6. Certified documents as specified in 37 CFR 1.4(f). *See also* 37 CFR 1.6(d)(2).

7. Certified copies of priority documents. An example of such a submission is a certified copy of a foreign patent application filed pursuant to 35 U.S.C. 119 and 37 CFR 1.55 or a certified copy of an international application filed pursuant to 35 U.S.C. 365 and 37 CFR 1.55.

8. Correspondence to be filed in an application subject to a secrecy order under 37 CFR 5.1 through 5.5. *See also* 37 CFR 1.6(d)(6).

9. Documents filed in contested cases and trials before the Patent Trial and Appeal Board (PTAB), except as the PTAB may expressly authorize. *See also* 37 CFR 1.6(d)(7).

10. Documents filed in contested cases and trials before the PTAB, which are governed by 37 CFR part 41, subpart D and part 42, respectively. For example, petitions for *inter partes* review, post grant review, covered business method patent review, and derivation proceedings cannot be filed via EFS-Web, but instead are filed electronically via the USPTO Patent Trial and Appeal Board End to End System at <https://ptab.uspto.gov/#/login>. *See also* 37 CFR 1.6(d)(3), 1.8(a)(2)(i)(B) and (C).

11. Correspondence filed in connection with a disciplinary proceeding under 37 CFR part 11. *See also* 37 CFR 1.6(d)(3) and 1.8(a)(2)(iii)(A).

12. Maintenance fees submitted under 37 CFR 1.366 that are not submitted with a petition under 37 CFR 1.378 (*see* item 12 in section B1 of this framework). Patent owners may pay electronically using the Patent Maintenance Fees Storefront at <https://fees.uspto.gov/MaintenanceFees>. *See* MPEP 2510 for information regarding the proper methods for submitting maintenance fees.

13. Assignment documents under 35 U.S.C. 261, which may be electronically filed using the Electronic Patent Assignment System (EPAS). Information regarding EPAS is available at <https://epas.uspto.gov>.

14. Submissions that are not associated with a patent, patent application, international design application, reexamination proceeding, or supplemental examination proceeding.

15. Notices of appeal to a court, district court complaints, or other complaints or lawsuits involving the USPTO. *See* MPEP 1216 for instructions on how to properly serve and/or file such documents seeking judicial review of a decision by the PTAB.

If a document or submission listed previously is submitted via EFS-Web, the document or submission will not be accorded a date of receipt and it will not be considered officially filed in the USPTO. Furthermore, no benefit will be given to a certificate of transmission under 37 CFR 1.8 for the document or submission.

B3. Types of Papers That May Be Filed and Processed Electronically.

Registered users may use EFS-Web to submit web-based documents such as ePetitions, Requests for Withdrawal as Attorney or Agent of Record, and eTerminal Disclaimers. These ePetitions, requests, and eTerminal Disclaimers are auto-processed and granted or approved immediately upon submission if the ePetition, request, or eTerminal Disclaimer meets all of the requirements. *See* the ePetition Resource Page at <https://www.uspto.gov/patents-application-process/applying-online/epetition-resource-page> for a list of ePetitions.

Registered users may sign into EFS-Web and provide information in web-based interfaces. An ePetition, request, or eTerminal Disclaimer document (PDF) is generated by EFS-Web based on the information entered into EFS-Web. This document may be reviewed prior to submission to ensure accuracy. This document and a decision granting the ePetition or request, or an approval letter approving of the eTerminal Disclaimer, will be loaded into the electronic application file (i.e., IFW), if the ePetition or request is granted or if the eTerminal Disclaimer is approved. If the ePetition, request, or eTerminal Disclaimer does not meet all of the formal requirements, it will not be accepted for submission and loaded into the electronic application file (i.e., IFW).

EFS-Web permits registered users (*see* section E of this framework) to file the following auto-processed ePetitions, requests, and eTerminal Disclaimers:

1. Request for withdrawal as attorney or agent;
2. Petition to withdraw an application from issue under 37 CFR 1.313, with some restrictions;
3. Petition for revival of an application under 37 CFR 1.137, with some restrictions;
4. eTerminal Disclaimers for nonprovisional utility applications under 37 CFR 1.321(b) and (c); and
5. Petition to correct assignee after payment of Issue Fee under 37 CFR 3.81(b).

EFS-Web permits registered and unregistered users (*see* section E of this framework) to file the following auto-processed ePetitions:

1. Petition to make special based on age under 37 CFR 1.102; and
2. Petition to accept unintentionally delayed payment of the maintenance fee under 37 CFR 1.378(b).

B4. The Official Record of Documents Submitted via EFS-Web.

When the USPTO successfully receives PDF documents filed in accordance with the EFS-Web requirements, the USPTO will convert the PDF files submitted by users into Tagged Image File Format (TIFF) image files and then store the TIFF image files in the IFW as part of the official record, in addition to those drawings which are stored in the Supplemental Complex Repository for Examiners (SCORE) as part of the official record (i.e., color and grayscale drawings and drawings submitted in design applications). The USPTO also will store JPEG drawing files successfully received in international design applications in accordance with the EFS-Web requirements in SCORE as part of the official record. In addition, certain submissions filed as ASCII plain text files (e.g., sequence listings or computer program listings) are stored in SCORE as part of the official record. Accordingly, the official record for the patent application, international design application, reexamination proceeding, or supplemental examination proceeding comprises:

1. ASCII text documents and drawings stored in SCORE as previously set forth;
2. TIFF images of all other original documents as stored in IFW;
3. 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) data collection interfaces; and
4. TIFF images stored in IFW in international design applications generated from XML data received from the International Bureau.

The original documents submitted via EFS-Web (e.g., applications and reexamination and supplemental examination proceeding documents) are stored exactly as filed in an independent location. Section L of this framework provides more information on ASCII text documents, sections K and M2 provide more information on color and grayscale drawings, and section N provides information on international design applications. Submissions for pre-grant (eighteen-month) publication are forwarded to the Pre-Grant Publication Division and are not stored in IFW or SCORE as part of the official record of the patent application. Section G includes more information on publication requests.

B5. Treatment of Internally Inconsistent Information Submitted via EFS-Web.

When filing a new application via EFS-Web, EFS-Web requires the input of certain application data. This includes the type of application being filed (e.g., nonprovisional application under 35 U.S.C. 111(a), U.S. national stage application under 35 U.S.C. 371, international application (PCT), or international design application), the title of the application (unless the application is an international design application), the name of an inventor or applicant, and a correspondence address. In addition, other application data, such as a docket number, may be provided.

Routing of the submission to the appropriate area of the Office for processing is based on the application type indicated in EFS-Web, and such indication will be treated as an instruction to treat the submission as the selected application type. Where the submission includes conflicting indications as to the type of application being filed, and there is no provision under the U.S. rules to resolve such conflict (*see, e.g., 37 CFR 1.495(g)*), the submission may be treated in accordance with the indication provided in EFS-Web, and a petition under 37 CFR 1.182 with the appropriate fee under 37 CFR 1.17(f) may be required to correct the error. In the case of other conflicting information in the submission, the conflict will be resolved in accordance with the applicable regulations. For example, inventorship will be determined in accordance with the provisions of 37 CFR 1.41. Where no correspondence information is included in the submission, or the correspondence information was not made in accordance with the applicable regulations, the Office may use the application data furnished through EFS-Web for purposes of correspondence until corrected by the applicant. For example, the Office may use the correspondence address associated with a customer number entered through EFS-Web rather than an address furnished in an unsigned paper in the new application submission.

B6. Determination of the Paper Size Equivalent for Applications Filed via EFS-Web for Application Size Fee Purposes.

See 37 CFR 1.52(f)(2) and MPEP 607 for the paper size equivalency for application size fee purposes. The paper size equivalency under 37 CFR 1.52(f)(2) for EFS-Web filings does not apply to the application size fee under 37 CFR 1.492(j) for national stage submissions under 35 U.S.C. 371. See MPEP 1893.01(c).

B7. Submission of Fee Payments via EFS-Web.

Both unregistered and registered users may submit the filing fees (e.g., the basic filing fee, search fee, examination fee, and excess claims fee) using the online fee payment in EFS-Web at the time of filing a patent application, request for reexamination, or request for supplemental examination, and may submit fees for third-party preissuance submissions under 37 CFR 1.290. Only registered users may submit payment of fees in a previously filed application, reexamination proceeding, or supplemental examination proceeding.

EFS-Web permits users to electronically submit the payment of fees with a credit/debit card, USPTO deposit account, or electronic fund transfer. Users may also provide authorizations to charge fees to a deposit account with the documents being submitted electronically via EFS-Web (e.g., a fee transmittal letter or form PTO/SB/17). However, users should not submit a credit/debit card charge authorization including the Credit Card Payment Form (PTO-2038) electronically via EFS-Web, because the electronic submission automatically will be loaded into the application file in IFW, and the credit/debit card information may become part of the record of an application file that is open to public inspection.

A credit/debit card charge authorization transmittal (e.g., PTO-2038) may be submitted by facsimile transmission to the USPTO Central Facsimile (571) 273-8300, or sent via Priority Mail Express® from the United States Postal Service (USPS) in accordance with 37 CFR 1.10. Applicants must include the application number from the Electronic Acknowledgement Receipt to ensure that the fees are paid in the correct application. Facsimile submission of the basic national fee for a national stage application under 35 U.S.C. 371 is not accepted. Failure to timely pay the basic national fee prior to the expiration of 30 months from the priority date will result in abandonment of the international application for purposes of the U.S. national phase.

If an applicant wishes to submit the application filing fees on the filing date of a patent application to avoid the surcharge, the payment of the filing fees must be submitted and received by the USPTO before midnight ET on the filing date of the application. The previous paragraph discusses alternative methods that may be used instead of EFS-Web to pay the fees. Failure to pay the fees on the filing date of the application will result in a surcharge.

When the online fee payment in EFS-Web is unavailable, the following types of submissions cannot be filed via EFS-Web, since online fee payment must accompany the submission:

1. Petitions that require a fee for auto-processing by EFS-Web;
 2. Pre-grant publication submissions under 37 CFR 1.211 to 1.221 that require a fee;
 3. Third-party preissuance submissions under 37 CFR 1.290 that require a fee;
- and
4. Web-based Issue Fee Payment (Web 85b).

C. Electronic Acknowledgement Receipt and Date of Receipt.

The Electronic Acknowledgement Receipt establishes the date of receipt by the USPTO of documents submitted via EFS-Web. The electronic documents are itemized in the Electronic Acknowledgement Receipt, which will contain a full listing of the documents submitted to the USPTO as described by the user during the submission process, including the count of pages and/or byte sizes for each document. Thus, the Electronic Acknowledgement Receipt is the electronic equivalent of the postcard receipt described in MPEP 503.

The official application filing date will be noted on the filing receipt (37 CFR 1.54) after the submitted application parts are reviewed for compliance with 35 U.S.C. 111 (or for compliance with 35 U.S.C. 371 for entry into the U.S. national stage of an international application). The filing date of an application filed under 35 U.S.C. 111 via EFS-Web is

based on the dates indicated on the Electronic 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 *Ex Parte* Reexamination Request Filing Date,” and the official supplemental examination filing date will be noted on the “Notice of Supplemental Examination Request Filing Date” after Central Reexamination Unit (CRU) review for filing date compliance, and is based on the dates indicated on the Electronic Acknowledgement Receipt.

If the official version of any document received by EFS-Web is lost, damaged, or rendered unreadable, and if it cannot be recovered from the stored files received by electronic submission, then the user will be promptly notified. Such events are expected to be rare. In that situation, the user may have to resubmit any lost document and petition for the original filing date. The user would be required to present: (1) the Electronic Acknowledgement Receipt; (2) a copy of the missing files as submitted; and (3) a signed petition accompanied by a statement stating that the attached files are the same as those originally submitted and mentioned in the Electronic Acknowledgement Receipt for that application number (e.g., a petition under 37 CFR 1.53(e) or 1.182 with the appropriate petition fee under 37 CFR 1.17(f)).

The Electronic 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, except when the document description used by the user does not match the document. For example, if an applicant originally filed a specification and a set of claims and used the correct document descriptions for a specification and a set of claims, then the Electronic Acknowledgement Receipt will serve as *prima facie* evidence that the applicant filed the specification and set of claims on the original filing date. However, if the applicant actually filed two sets of claims, i.e., no specification was filed, the Electronic Acknowledgement Receipt will not serve as *prima facie* evidence that the applicant filed a specification and a set of claims (even though the applicant used the document descriptions for a specification and a set of claims). Note the Electronic Acknowledgement Receipt only indicates that the USPTO received what was actually sent, as opposed to what may have been intended to be transmitted. Users should exercise the same care in preparing and preserving a copy of a submission in electronic form as in paper.

C1. The Date of Receipt of a Follow-on Document Received by the USPTO Through EFS-Web.

Follow-on documents filed in an application or reexamination proceeding after the initial filing of the application or request for reexamination will be accorded a receipt date, which is the date the follow-on document is received at the USPTO. *See* 37 CFR 1.6(a)(4).

A follow-on document required to be filed in the USPTO within a set period of time (e.g., a reply to an Office action) will also be considered as being timely filed if the follow-on document is submitted in compliance with the procedure set forth in 37 CFR 1.8(a):

1. The follow-on document is submitted via EFS-Web prior to expiration of the set period of time in accordance with the requirements for EFS-Web; and

2. The document includes a certificate of transmission stating the date of transmission and signed by a person that has reasonable basis to expect that the document would be transmitted on or before the date of transmission. *See* 37 CFR 1.8(a)(1)(i)(C) and (a)(1)(ii).

However, the certificate of transmission practice under 37 CFR 1.8 does not apply to the documents listed in 37 CFR 1.8(a)(2) (e.g., a document filed for the purpose of obtaining an application filing date).

C2. The Date of Receipt of an Application Submitted via EFS-Web.

The time and date of receipt of an application filed via EFS-Web is the local time and date in USPTO headquarters in Alexandria, Virginia. Accordingly, the date of receipt of an application officially submitted through EFS-Web will be the date in the Eastern Time zone when the USPTO received the submission. As such, the submission's "date of receipt," as shown on the Electronic Acknowledgement Receipt, is the Eastern Time zone date that the documents are fully, successfully, and officially received at the USPTO, after the user clicks the SUBMIT button on the Confirm and Submit screen. *See* 37 CFR 1.6(a)(4). This date is controlling for filing date purposes of a newly filed application. There is no "certificate of transmission" practice for new application filings (37 CFR 1.8).

To be specific, the EFS-Web system records, as the time and date of receipt of documents, the local time and date in Alexandria, Virginia, on which the USPTO receives the documents, after the user clicks the SUBMIT button on the Confirm and Submit screen for those documents.

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 p.m. Pacific Daylight Time in California on May 1, that application would be officially received by the USPTO at 1 a.m., local time (i.e., Eastern Daylight Time) on May 2. Accordingly, the application would receive a filing date of May 2. However, the applicant could alternatively file the application using Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 in which case the applicant would have until midnight on May 1 in his or her local time zone to file the application and obtain a filing date of May 1.

C3. Hours of Operation for Filing via EFS-Web.

Hours of operation of EFS-Web will be clearly provided in the EFS-Web instructions when users log on to the system. The USPTO will post information on any scheduled down time due to system maintenance in advance. Users may file patent documents electronically during the hours of operation of EFS-Web every day of the week, including weekends and holidays. If the submission is successfully received (even on a Saturday, Sunday, or Federal holiday within the District of Columbia), the USPTO will assign that receipt date to the submission.

If a transmission is attempted during a down time, i.e., the electronic filing system is unavailable, the USPTO cannot accept it and will, if possible, transmit back a notice that the USPTO is not accepting submissions. No Electronic Acknowledgement Receipt will be sent. Instead a notice will advise the user to use alternative filing methods, such as Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 or hand-delivery of paper to the USPTO, to establish the filing date. Note that applications filed under 37 CFR 1.53, international applications (PCT), international design applications, reexamination requests, and requests for supplemental examination cannot be submitted by facsimile transmission (37 CFR 1.6(d)(3) and (5)), and that certificate of mailing procedures do not apply to new applications, copies of the international application and the basic national fees necessary to enter the national stage as specified in 37 CFR 1.495(b), and reexamination requests (37 CFR 1.8(a)(2)(i)(A), (D), and (F)). 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.

C4. Filing New Applications During an Unscheduled Outage of the Primary Portal to EFS-Web.

The USPTO will provide an EFS-Web Contingency option to users to file new applications, national stage submissions under 35 U.S.C. 371, requests for reexamination, requests for supplemental examination, and certain petitions when the primary portal to EFS-Web is unavailable during an unscheduled outage. The USPTO will post a notification of any unscheduled outage of the primary portal to EFS-Web and provide the link to EFS-Web Contingency on the EFS-Web Internet page (<https://www.uspto.gov/patents-application-process/applying-online/about-efs-web>). The EFS-Web Contingency (<https://www.uspto.gov/patents-application-process/applying-online/efs-web-contingency>) has the same functionality as EFS-Web for unregistered users. It permits users to sign on as unregistered EFS-Web users to file new applications, national stage submissions under 35 U.S.C. 371 submitted with the basic national fee necessary to enter the national stage, requests for reexamination, requests for supplemental examination, and certain petitions. However, other follow-on documents and fee payments filed after the initial submission of the application, reexamination

request, or supplemental examination request (e.g., amendments and replies to Office actions) cannot be filed using EFS-Web Contingency Option.

If systems that EFS-Web Contingency depend on are unavailable, submission types and features in EFS-Web Contingency may be unavailable (e.g., payment processing and data processing). If the USPTO payment system is unavailable, then online payment processing will be unavailable for EFS-Web Contingency (e.g., online payment option is not available for payment of the basic national fee with a national stage submission under 35 U.S.C. 371). If the Patent Application Locating and Monitoring (PALM) database is unavailable, then EFS-Web Contingency cannot access data for processing certain submission types. The unavailability of the PALM system may affect filing types such as national stage submissions under 35 U.S.C. 371 and ePetitions.

a. Proper Submissions Under EFS-Web Contingency Option.

Specifically, EFS-Web Contingency Option only permits users to electronically file the following items:

1. Provisional patent applications filed under 35 U.S.C. 111(b);
2. Nonprovisional utility patent applications filed under 35 U.S.C. 111(a);
3. Nonprovisional design patent applications (*see* 35 U.S.C. 171) filed under 35 U.S.C. 111(a);
4. International applications filed under the PCT in the United States Receiving Office (*see* 35 U.S.C. 361);
5. Submissions to enter the national stage under 35 U.S.C. 371;
6. International design applications filed under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (*see* 35 U.S.C. 382);
7. Requests for *ex parte* reexamination under 35 U.S.C. 302 for utility or design patents;
8. Requests for supplemental examination under 35 U.S.C. 257 for utility, design, or plant patents;
9. Petitions to make special based on age under 37 CFR 1.102(c) when filed as an ePetition (for more information *see* <https://www.uspto.gov/patents-application-process/applying-online/epetition-resource-page>);
10. Petitions to accept an unintentionally delayed payment of maintenance fee under 37 CFR 1.378(b) when filed as an ePetition, for the automatic processing of the

ePetition (for more information *see* <https://www.uspto.gov/patents-application-process/applying-online/epetition-resource-page>);

11. Petition to make special under the accelerated examination program (must be filed with a nonprovisional utility patent application under 35 U.S.C. 111(a));

12. Reissue utility patent applications and reissue design patent applications;

13. Third-Party Preissuance Submissions under 35 U.S.C. 122(e) and 37 CFR 1.290 for utility, design, or plant patent applications using a dedicated EFS-Web interface wherein the information is not directly placed into the application (*see* section I); and

14. Citation of prior art and written statements in patent files under 37 CFR 1.501 for utility applications using a dedicated EFS-Web interface, where the information is not directly placed into the patent file (*see* section I).

Documents filed via EFS-Web Contingency as part of the submissions previously listed must meet the same file format requirements established for EFS-Web, e.g., file size and PDF embedded-font requirements. The same file validation performed in EFS Web will be performed in EFS-Web Contingency. Similar to EFS-Web, EFS-Web Contingency will provide an Electronic Acknowledgement Receipt that establishes the date of receipt by the USPTO of an application or document submitted via EFS-Web Contingency. The applicant is not required to, and should not, resubmit the application or document that was submitted via EFS-Web Contingency when the primary portal to EFS-Web is once again available. Any resubmission of an application will result in filing a duplicate application and, if applicant pays the filing fees again when submitting the duplicate application, no refund will be provided. 35 U.S.C. 42.

Applications filed via EFS-Web Contingency are protected with the same level of security as EFS-Web for unregistered users by using Transport Layer Security (TLS) to encrypt transmission over the Internet. Registered users who have uploaded documents to a Saved Submission package in EFS-Web will not be able to access those Saved Submission documents through EFS-Web Contingency. Applicants can submit online fee payments by selecting fees on the fee calculation screen and completing their payment at the time of submission (i.e., choose the “Yes! I want to pay now” button rather than “No– I will pay later” button).

When the primary portal to EFS-Web is unavailable during an unscheduled outage, applicants may also file new applications, national stage submissions under 35 U.S.C. 371 submitted with the basic national fee necessary to enter the national stage, reexamination requests, and requests for supplemental examination by either hand-delivery to the USPTO or Priority Mail Express® from the United States Postal Service (USPS) in accordance with 37 CFR 1.10, to establish the filing date or national stage submission date. New applications, national stage submissions under 35 U.S.C. 371 submitted with the basic national fee necessary to enter the national stage, reexamination requests, and requests for supplemental examination cannot be submitted by facsimile

transmission, and certificate of mailing procedures under 37 CFR 1.8 do not apply to these items.

The EFS-Web Contingency Option does not permit follow-on fee payments and follow on documents other than those previously listed. Applicants may file the documents or fee payments by: (1) facsimile transmission in accordance with 37 CFR 1.6(d) and 1.8; (2) first class mail with a certificate of mailing in accordance with 37 CFR 1.8; (3) hand-delivery to the USPTO; or (4) Priority Mail Express® from the USPS in accordance with 37 CFR 1.10. Documents that are required to establish the filing date of an application (e.g., a missing drawing figure or page of the specification) cannot be submitted by facsimile transmission, and certificate of mailing procedures under 37 CFR 1.8 do not apply to these documents.

b. Improperly Filed Follow-on Documents.

As previously stated, EFS-Web Contingency (and EFS-Web for unregistered users) permits users to sign on as unregistered EFS-Web users to file new applications, national stage submissions under 35 U.S.C. 371 submitted with the basic national fee necessary to enter the national stage, requests for reexamination, requests for supplemental examination, and certain ePetitions. EFS-Web Contingency (and EFS-Web for unregistered users) have limited functionality and do not permit users to file other follow-on documents and follow-on fee payments after the initial submission of the application, reexamination request, or supplemental examination request (e.g., amendments and replies to Office actions). Note that it is improper for registered and unregistered users to file follow-on documents as new applications. The USPTO provides answers to frequently asked questions and other helpful information on the USPTO website. Users are encouraged to check the USPTO website for more information and contact the Patent Electronic Business Center for questions related to the usage of USPTO Patent Electronic Systems. When an applicant improperly files a follow-on document as a new application via EFS-Web Contingency (or EFS-Web) and wishes the USPTO to move the follow-on document to an existing intended application, a petition under 37 CFR 1.182 accompanied by the petition fee under 37 CFR 1.17(f) will be required in the intended application.

c. Additional Information Regarding National Stage Submissions.

The basic national fee is required in order for an international application to enter the national stage under 35 U.S.C. 371. *See* 37 CFR 1.495. Users are permitted to submit the basic national fee with the national stage submission under 35 U.S.C. 371 via EFS-Web and EFS-Web Contingency Option using the USPTO payment page. If the payment system is unavailable, neither EFS-Web nor EFS-Web Contingency will permit users to make payment using the interactive payment interfaces. Applicant may pay the necessary national stage entry fees by including a written authorization to charge a deposit account the desired fees, together with the national stage submission under 35 U.S.C. 371, or by

sending the payment via Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 on the same date that the national stage submission is electronically filed.

For any national stage submissions under 35 U.S.C. 371 filed via EFS-Web or EFS Web Contingency, the system automatically checks the PALM system to verify that no previous national stage submission has been made for the particular international application (PCT) referenced in the initial national stage submission. If the PALM system is unavailable, neither EFS Web nor EFS-Web Contingency can complete the PALM verification, and thus EFS-Web and EFS-Web Contingency will not permit any national stage submissions under 35 U.S.C. 371 to be filed. Therefore, if PALM is unavailable, applicants may use hand delivery or Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 to submit documents and fees for national stage entry. However, applicants may not file national stage submissions under 35 U.S.C. 371 or the basic national fee necessary to enter the national stage via facsimile transmission. *See* 37 CFR 1.6(d)(3) and 1.8(a)(2)(i)(F). Section M includes additional information pertaining to the filing of international applications (PCT) and entry into the national stage under 35 U.S.C. 371.

C5. Inadvertent Omission of Documents Filed in a New Application via EFS-Web.

One advantage of filing a patent application via EFS-Web is that a registered user may view his or her submission in Private PAIR and file a document directly into the application file 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 a new application in other certain situations.

The following examples describe scenarios raised when applicant inadvertently omits an item when filing an application under 35 U.S.C. 111 electronically via EFS-Web.

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 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 a surcharge for filing the filing fees will not be required.

3. Nonpublication request—Because 37 CFR 1.213(a)(1) requires any nonpublication request to be filed with the application, applicant cannot simply file the nonpublication 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) in the initial application, a petition for express abandonment to avoid

publication under 37 CFR 1.138(c) and the fee under 37 CFR 1.17(h) in sufficient time to permit the appropriate officials in the Pre-Grant Publication Division to recognize the abandonment and remove the application from the publication process.

4. Drawings—Applicant may file 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)(1). If the application was filed with the “wrong drawings,” 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.

5. Claims—Applicant may file claims as a preliminary amendment on the same day that applicant filed the application papers and such claims will be considered as part of the original disclosure of the application.

6. Part of the specification—Applicant may file any 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 a second application to correct an error in the first application, applicant will have filed two applications. Applicant may continue to prosecute the first application that has the error or abandon the first application by filing a petition for 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 a 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 U.S.C. 111(a) and the applicant files a petition for express abandonment in accordance with 37 CFR 1.138(d).

C6. Legal Consequences of the USPTO’s Accepting Electronic Patent Applications on Saturday, Sunday, and Holidays.

Applicants may file patent applications electronically during the hours of operation of EFS-Web every day of the week, including weekends and holidays. EFS-Web 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 U.S.C. 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 the fee paid, on the next succeeding secular or business day.

Further, 35 U.S.C. 119(e)(3) states, in pertinent part:

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 within the District of Columbia, regardless of the mode or form of filing.

However, Article 4 of the Paris Convention addresses the priority period. Article 4(C)(3) 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.

As previously stated, the USPTO is capable of accepting electronic patent application filings every day of the week, including weekends and holidays, through EFS-Web. Thus, applicants filing international applications with the United States Receiving Office or international design applications with the USPTO as an office of indirect filing 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. Specifically, the ability to file applications electronically on weekends and holidays in the USPTO could potentially result in loss of priority rights in foreign jurisdictions designated in either international applications filed under the PCT with the United States Receiving Office or international design applications filed with the USPTO as an office of indirect filing if applicants choose to avail themselves of 35 U.S.C. 21(b) or 119(e)(3). In such circumstances, other patent offices may deny the priority claim on the basis that the international application or international design application was not timely filed if their national law strictly incorporates the provision of Paris Convention Article 4(C)(3) such that it considers the USPTO to be open for the filing of applications on weekends and holidays. For this reason, applicants should consider whether to rely upon the “next business day” provisions of 35 U.S.C. 21(b) and 119(e)(3) when filing international applications or international design applications with the USPTO, and instead file the international application or international design application before the Paris Convention priority period has expired.

D. Proper Usage of EFS-Web.

Users should follow the instructions and guidelines for EFS-Web provided on the USPTO website. Before clicking the SUBMIT button, the user should check whether the correct documents have been attached to the submission and whether the information related to the submission has been entered correctly. Once the user clicks the SUBMIT button on the Confirm and Submit screen, the submission will be electronically sent to

the USPTO. A submission is officially filed at the USPTO when the documents are received by the USPTO (the local time and date in Alexandria, VA, which is located in the Eastern Time zone). Use of EFS-Web in a manner significantly in violation of the instructions and guidelines for EFS-Web provided on the USPTO website and in this 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. Furthermore, electronic files submitted via EFS-Web must be free of executables, worms, viruses, or any other type of potentially malicious content. Please note that under 18 U.S.C. 1030 users may not intentionally cause damage to federal government computers.

D1. Filing documents as PDF Files via EFS-Web.

EFS-Web accepts standard PDF documents up to 25 megabytes for each file, and 60 electronic files per submission. For international design applications, EFS-Web can accept more than 60 electronic files in a single submission, subject to certain conditions. Section L4 of this framework contains more information. 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.

In addition, because the PDF format is so feature-rich, certain PDF features are currently not supported by the USPTO systems. For example, PDF documents with multiple layers must be flattened prior to submission to ensure that the complete document is received by the USPTO and readable to the examiner or other deciding officials. If a document contains layers that are marked as “invisible,” the invisible layers will be lost when the document is processed by the USPTO, and thus the official records in IFW will not contain the information on the invisible layers. Furthermore, if a user enters information on a form using the PDF comments or annotations features, only the blank form without the PDF comments and annotations will be processed. Therefore, the complete document will not be officially filed at the USPTO and the user cannot rely on the Electronic Acknowledgement Receipt as evidence that the completed form was filed at the USPTO. Users are encouraged to check the contents of their submissions for completeness and accuracy via PAIR.

Users must follow the PDF Guidelines for EFS-Web and PDF Creation for EFS-Web (available on the USPTO website) to create and submit PDF files via EFS-Web to ensure that all of the information in the PDF files is successfully received and processed by the USPTO.

D2. Entering Information on EFS-Web Interfaces.

EFS-Web collects information from on-screen entries made by the user through the EFS-Web data collection interfaces. Through these data collection interfaces, the user provides the USPTO with information regarding the electronic submission, such as the type of application being filed, the application number of the application in which a follow-on document is being submitted, or the type of document being submitted. The USPTO systems (e.g., EFS-Web, IFW, etc.) will use the information entered by the user on the EFS-Web interfaces to automatically: (1) assign the application number, create the application, and process the application, if a new application is being filed; (2) upload the follow-on document into the application file specified by the user; or (3) message the deciding official based on the document description selected by the user. Providing incorrect information regarding the submission could lead to, for example: (1) an incorrect type of application file being created; (2) a delay in processing the document; (3) a document being filed in an incorrect application; or (4) the deciding official not recognizing the document in sufficient time to avoid publication, to withdraw the application from issue, or to avoid the abandonment of the application.

a. Filing a new application.

When a user is submitting a new application via EFS-Web, the user is required to select the application type (e.g., design, utility, provisional or nonprovisional) being filed on the EFS-Web interface. Only document descriptions and fee codes pertinent to the selected application type will be available for the submission. The system will also automatically generate the application number based on the user's selection. For example, if the user indicates that the submission is a provisional application by selecting the EFS-Web option for a provisional application, the application will be assigned a provisional application number, provisional application fees will be collected or required, and the application will be further processed as a provisional application. Furthermore, the application will not be assigned to an examiner for examination and will not be published because the submission is processed as a provisional application. Therefore, it is important for the user to select the correct application type on the EFS-Web interface and to review the Electronic Acknowledgement Receipt and the application file using PAIR after the submission is completed.

b. Follow-on documents.

When a user submits a follow-on document (e.g., a reply to an Office action or notice) via EFS-Web, the user is required to enter the correct application number, control number or proceeding number, and confirmation number of the application in which the follow-on document is being filed. Providing the incorrect application number and confirmation number pair will result in filing the follow-on document in the wrong application and the intended application could become unintentionally abandoned for failure to reply to the Office action or notice, this also applies to reexamination proceedings and supplemental

examination proceedings. Therefore, it is important for the user to enter the correct application number and confirmation number on the EFS-Web screen when filing the follow-on document. Furthermore, users cannot file a follow-on document as a new application.

After the submission of the follow-on document is completed, the user should log on to PAIR to review the application file and check whether the follow-on document has been filed in the correct application. Checking the application file via PAIR would also help the user to discover other filing errors, such as filing a wrong document or omitting a portion of the document.

Documents filed in the incorrect application may require a petition to expunge under 37 CFR 1.59 with the appropriate fee under 37 CFR 1.17(g) filed in the incorrect application or a petition to move the document under 37 CFR 1.182 with the appropriate fee under 37 CFR 1.17(f) filed in the intended application.

c. Document indexing.

When a user submits an application or a follow-on document in an application using EFS-Web, the user must select from the list of document descriptions to specify the files being submitted via EFS-Web. For instance, when the user is filing a patent application, the submission must be separated into appropriate sections: specification, claims, abstract, and drawing; and when the user is filing an amendment, the user must select the appropriate type of amendment: amendment after non-final, amendment after allowance, preliminary amendment, and amendment after final. Based on the document description selected by the user, a document code is assigned, and a message regarding the document submitted to the USPTO will be forwarded to the appropriate organization for processing and to the appropriate official for consideration. Furthermore, the IFW and PAIR systems use the document code for identifying the document maintained in the application file. Therefore, accurate document indexing is important to facilitate efficient processing and proper consideration of the document by the USPTO. For example: (a) if the user indicated an after-final amendment as a non-final amendment, the processing of such amendment may be delayed, and the examiner may not have sufficient time to consider the amendment before the time period for reply expires; (b) if the user selects the “Pre-Grant Publication” option on the EFS-Web data collection screen for submitting a substitute specification filed in response to a non-final Office action, the submission will be forwarded to the publication branch rather than processed into IFW and forwarded to the examiner for consideration; and (c) if the user selects “drawings—only black and white line drawings” for submitting color drawings in a utility application rather than “drawing—other than black and white line drawings,” the color drawings would not be processed as color drawings and would be maintained as black and white drawings in IFW.

More information on document indexing is available on the USPTO website. It is important for users to select the correct document description and check the application file via PAIR after the submission is completed.

D3. Refunds for Fees Paid via EFS-Web Due to System Malfunction.

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

E. Security and Authentication.

As the USPTO transitions its Patent Electronic System from EFS-Web and PAIR to Patent Center, changes have been made to the protocols for accessing EFS-Web and PAIR. PKI certificates are no longer being used and have been replaced with a new authentication and log-in method for EFS-Web and PAIR to comply with the latest Federal Information Security Management Act (FISMA) requirements. The new authentication and log-in method is a two-step authentication paradigm requiring each individual registered user of EFS-Web or PAIR to have a unique USPTO.gov account. Users of Financial Manager may already have a USPTO.gov account.

A two-step authentication paradigm also will be implemented in the forthcoming Patent Center. The two-step authentication paradigm will be in effect during the interim period prior to full implementation of Patent Center.

Thus, the PKI authentication access system has been phased out and replaced by an authentication system in which each user must obtain his or her own credentials. A practitioner must be a registered user to sponsor support staff. Support staff for practitioners must obtain their own credentials and be sponsored by the practitioner who directs and controls the non-practitioner's work. Credentials may only be used by the person to whom they are registered and assigned. Sharing of credentials is no longer permitted. More information on the new system may be found at the website for the Patent Electronic Business Center, located at <https://www.uspto.gov/learning-and-resources/support-centers/patent-electronic-business-center> and "Authentication Change for EFS-Web and PAIR," located at <https://www.uspto.gov/patent/authentication-changes-efs-web-and-pair>.

E1. PKI Certificates Have Been Discontinued.

PKI certificates were usable through July 2, 2019. The information contained in the previous version of this section and in the PKI Subscriber Agreement remained applicable until that date.

Since January 18, 2019, under the new Patent Electronic System Verification process, to become a registered user, an individual creates a USPTO.gov account and completes the Patent Electronic System Electronic System Verification Form PTO-2042a, available on the USPTO website.

E2. Persons Who May Access the Patent Electronic System.

Inventors, applicants, and patent practitioners, i.e., patent attorneys and agents registered to practice before the USPTO, may obtain credentials to access the Patent Electronic System. No other person may access the Patent Electronic System unless they are sponsored by a patent practitioner. A patent practitioner may sponsor other individuals to access the Patent Electronic System so as to access information and file documents on behalf of that patent practitioner. Such sponsorship is limited to those individuals acting under the direction and control of that practitioner. The sponsoring practitioner will be responsible for the actions of each sponsored individual. Sponsorship is further limited to those individuals performing the role of support staff to the practitioner through an employment agreement, including contractual agreements.

Support staff individuals who are going to be sponsored by one or more patent practitioners will need to create an individual USPTO.gov account. A sponsored support staff individual acting under the direction and control of a patent practitioner may file documents signed by the practitioner via EFS-Web, in compliance with the Patent Electronic System Subscriber Agreement.

When a sponsoring relationship no longer exists (e.g., the practitioner or the sponsored support staff individual are no longer at the same firm) the sponsoring practitioner should remove the sponsorship.

E3. Authorization to File Documents, Access Information, and Pay Fees Through the Patent Electronic System.

Registered users are permitted to access and file via EFS-Web follow-on documents in applications in which they are acting on behalf of the applicant and in reexamination and supplemental examination proceedings in which they are acting on behalf of the owner. Note that, pursuant to 37 CFR 1.31, juristic entity applicants must be represented by a patent practitioner.

Documents submitted through EFS-Web must be signed in accordance with 37 CFR 1.4, 1.33(b), and 11.18. Registered users who are joint inventors, or who represent less than all inventors or less than all applicants, may access their applications, but may not file documents lacking the signatures of all applicants unless specifically authorized under this framework. A sponsored support staff individual may file documents that are properly signed by the practitioner who directs and controls that individual's work. Such a sponsored support staff individual, who is not an authorized party to sign the documents, is not responsible for the contents of the documents submitted. For all

submissions through EFS-Web, the person who signs the documents (e.g., the applicant or a patent practitioner who is representing the applicant) is responsible for the contents. For example, the documents may be electronically signed or ink signed by the applicant or patent practitioner of record in accordance with 37 CFR 1.4(d). The sponsored support staff individual who serves the ministerial function of pickup and delivery of documents may submit the signed documents electronically via EFS-Web under the direction and control of the patent practitioner. (Ink-signed documents can be electronically scanned and then e-filed.) This sponsored support staff individual may also view and retrieve documents from Private PAIR under the direction and control of that practitioner.

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

E4. Filing Documents Without a Patent Electronic System Account as an Unregistered User.

Users that do not have, or do not wish to use, a Patent Electronic System Account to authenticate to the USPTO may submit new application filings via a non-authenticated workflow as an unregistered user. The user would go to the EFS-Web page and choose to submit without a Patent Electronic System Account as an unregistered user, which would generate a TLS connection for the session, thus allowing secure data transmission to the USPTO. Unregistered users have the same level of protection for filing as a registered user, but are limited to submission of initial filings (except as noted in section B1). This practice minimizes the risk of improperly filed third-party submissions and other documents. Unregistered users may file follow-on documents by mail (with a certificate of mailing in accordance with 37 CFR 1.8), by Priority Mail Express® from the USPS in accordance with 37 CFR 1.10, or by hand-delivery.

Note: Users are advised that the USPTO may revoke a user's Patent Electronic System Account if the user makes an improper submission through EFS-Web (*see* section B of this framework). *See also* section 5 of the "United States Patent and Trademark Office Patent Electronic System Subscriber Agreement" (available at <http://www.uspto.gov/patents/process/file/efs/guidance>).

E5. Patent Electronic System Subscriber Agreement.

The Patent Electronic System subscriber agreement (November 2018) explains that a holder of a Patent Electronic System account must update changes in the information in their Patent Electronic System Verification Form (Verification Form) within thirty (30) calendar days of the change. Information may be updated by submitting a new Verification Form and some information can be updated on the account holder's USPTO.gov account profile.

A Patent Electronic System account holder may only use the account for applications for which the account holder is authorized to access; unauthorized use, such as attempting or gaining access to nonpublic information or inadvertently disclosed nonpublic information, may lead to immediate revocation of the Patent Electronic System Account. A Patent Electronic System account holder may only use the account for securing communication with the USPTO, and may not encourage or permit others to use or rely on their Patent Electronic System account log-in credentials.

A Patent Electronic System subscriber who is a practitioner may grant sponsorship to a reasonable number of practitioner support individuals to work on their behalf under their direction and control. A sponsoring practitioner must take reasonable steps to ensure that the access of each sponsored practitioner support individual is consistent with the tasks assigned to that individual. Such reasonable steps include removing sponsorship where appropriate, including where the individual leaves the practitioner's organization or the contractor's organization or when the contractor is no longer under contract to the practitioner or the practitioner's organization.

Each of the practitioner support individuals who are sponsored must have their own USPTO.gov account and must not share accounts among other support staff individuals. Each sponsored practitioner support staff individual must only be: an employee of the practitioner or an employee of practitioner's organization; an individual under contract to the practitioner or the practitioner's organization; or an employee of a contractor under contract to the practitioner or the practitioner's organization.

A practitioner may only sponsor support staff individuals and may not sponsor any other individuals or organizations including a company, a group, a client, a practitioner (*see* 37 CFR 11.1), or an invention promoter (*see* 37 CFR 4.2(a)) to become users of the Patent Electronic System. A sponsoring practitioner is responsible for verifying the identity of any person who is sponsored as stated in the Patent Electronic System Access Document. A sponsoring practitioner may only sponsor a reasonable number of practitioner support individuals to work under their direction for whom he/she can maintain proper control.

A sponsoring practitioner must take reasonable steps to ensure compliance by each sponsored practitioner support person with the requirements set forth in the subscriber agreement, including the restrictions on the software use in section 6 and the restrictions on the export (including deemed export) of technology and software included in patent applications in section 7. If a sponsored practitioner support person is not a U.S. citizen, their access to the technology and software constitutes an export.

A sponsored practitioner support person's access to the Patent Electronic System may not extend beyond those duties performed under the direction and control of a sponsoring practitioner.

A sponsored practitioner support person may only use their Patent Electronic System account to access, in an authorized support capacity, customer numbers and application information associated with their Patent Electronic System profile in accordance with the laws, regulations, and policies of the USPTO including this Legal Framework. A sponsored practitioner support person may only use or rely on their Patent Electronic System accounts for communication with the USPTO in compliance with the laws, regulations, and policies of the USPTO.

More information about the Patent Electronic System subscriber agreement is available on the USPTO website.

A law firm should promptly remove any practitioner who leaves the firm from the list of practitioners associated with the law firm's Customer Number. A practitioner leaving a law firm can also remove themselves from the law firm's Customer Number.

F. Signatures.

Signatures included in image attachments submitted via EFS-Web are governed by the requirements of 37 CFR 1.4(d).

If the signer is submitting an application through EFS-Web as PDF files, he or she may 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 a PDF file. Alternatively, correspondence submitted through EFS-Web may be signed by a graphic representation of a handwritten signature as provided for in 37 CFR 1.4(d)(1) or a graphic representation of an S-signature as provided for 37 CFR 1.4(d)(2). *See* 37 CFR 1.4(d)(3). Follow-on documents, such as responding to a Notice to File Missing Parts of Nonprovisional Application or an amendment filed in an application, must also be signed in accordance with applicable requirements. *See* 37 CFR 1.33(b). Even though a new patent application is entitled to a filing date if it complies with all the statutory requirements set forth in 35 U.S.C. 111(a) or (b), 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, and any nonpublication request and certification that accompanies the application must be signed. The correspondence address must be set forth in either an application data sheet or clearly set forth in another paper submitted with the application, which must be signed. *See* 37 CFR 1.33(a).

The presentation to the USPTO (whether by signing, filing, submitting, or later advocating) of any document constitutes a certification under 37 CFR 11.18(b). *See* 37 CFR 1.4(d)(4).

G. Submission of Pre-Grant (Eighteen-Month) Publication Requests via EFS-Web.

EFS-Web enables registered users to electronically submit pre-grant publication requests for amended publication, redacted publication, early 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 appropriate form-fillable application data sheet (PTO/AIA/14 or 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” option on the EFS-Web data collection screen. It is not sufficient for a user to submit a document via EFS-Web requesting amended publication, redacted publication, voluntary publication, or republication without also selecting the “Pre-Grant Publication” option on the EFS-Web data collection screen.

While the Office may publish certain amendments in the pre-grant publication, to be entitled to have the patent application publication be based upon a copy of the application (specification, drawings, and the application data sheet and/or the inventor’s oath or declaration) as amended, applicant must supply such a copy via EFS-Web as previously set forth. *See* 37 CFR 1.215(c).

H. Submission of Supplemental Examination Requests via EFS-Web.

Patent owners may submit a request for supplemental examination via EFS-Web. When filing a new request for supplemental examination, the patent owner should select the filing option “New application/proceeding,” and then select “Supplemental Examination.” Any paper(s) that are to be filed in an existing supplemental examination proceeding and any paper(s) that are to be filed in a reexamination proceeding ordered as a result of a supplemental examination proceeding may be filed by: (1) selecting “Existing application/patent/proceeding” (e.g., a proceeding that has already been assigned a control number); (2) selecting “Documents/Fees for an existing application/proceeding;” and (3) entering the assigned control number and confirmation number for the proceeding.

I. Filing of Third-Party Preissuance Submissions and Citation of Prior Art and Written Statements in Patent Files Filed via EFS-Web.

Registered and unregistered users may submit a third-party preissuance submission for any non-provisional utility, design, or plant application, including any continuing application. The application may be pending or abandoned and need not be published. To submit a third-party preissuance submission, the option “Third-Party Preissuance Submission under 37 CFR 1.290” must be selected. To submit a Third-Party Preissuance Submission, sign on to EFS-Web and select the “Existing application/patent” option. The Web screen will expand to display additional options. Select the “Third-Party Preissuance

Submission under 37 CFR 1.290” option and enter the Application Number and Confirmation Number. The Confirmation Number can be obtained by viewing the application in the PAIR System. This places the submission in a segregated area separate from the application file. After review by appropriate USPTO personnel, the submission may be placed in the application file.

Registered and unregistered users may submit a prior art and/or written statement submission for entry into a patent file under 37 CFR 1.501. The patent must be enforceable for the submission to be entered. A submission into a patent file under 37 CFR 1.501 cannot be filed via EFS-Web in design or plant patents. To submit a 37 CFR 1.501 submission, select “Prior Art Submission into Patent File under 37 CFR 1.501” and enter the Application Number and Patent Number. This places the submission in a segregated area separate from the patent file. After review by appropriate USPTO personnel, the submission may be placed in the patent file.

J. Submission of Interim Copies of Foreign Priority Documents via EFS-Web.

Interim copies of foreign priority documents as provided for in 37 CFR 1.55(j) may be submitted via EFS-Web in (i) applications filed under 35 U.S.C. 111(a), except for plant patent applications and design applications, and (ii) national stage applications under 35 U.S.C. 371. *See* 37 CFR 1.55 for details regarding claims for foreign priority, including the timing for submitting interim copies. *See also* MPEP 215 et seq.

The following are Frequently Asked Questions (FAQs) regarding interim copies of foreign priority applications:

1. If an applicant submits an interim copy of a foreign priority application, will the applicant still need to provide a certified copy of the foreign priority document? How will an interim copy submission be reflected in the USPTO’s records?

Yes. If an applicant files an interim copy of a foreign priority application in compliance with 37 CFR 1.55(j), the applicant must provide a certified copy of the foreign priority document before patent grant in order to perfect the priority claim. An interim copy of a foreign priority application will be entered into the file wrapper of the application in which it was filed and labeled as “Interim copy of Foreign Priority Document.”

2. Are there any special instructions for filing an interim copy of the foreign priority application?

Yes. Main parts of the interim copy of the foreign priority application, i.e., Abstract, Drawings, Specification, Claims, and, where applicable, Sequence Listing or Computer Program Listings, along with the separate cover sheet required by 37 CFR 1.55(j), may be filed as a single PDF file via EFS-Web (or as a single paper document). The PDF file will be stored in the Image File Wrapper of the application, and applicants

must select the document description “Interim copy of Foreign Priority Application” to index this document when filing online.

Application parts that were filed in a foreign patent office only as plain text computer files (e.g., TXT file), such as a Sequence Listing, lengthy Tables(s), or Computer Program Listing appendix, may be filed as a TXT file via EFS-Web (or on compact disc). When filing online via EFS-Web, applicants must select the document description “Interim copy of Foreign Priority (text file)” to index a plain text file part of the application. Please note that EFS-Web will not perform preliminary validation on an interim copy sequence listing text file, and a sequence listing in an interim copy of a foreign priority document over 25 MB must be split into multiple files under the 25 MB upload limit. If a TXT file is filed on compact disc, the compact disc must be labeled as “Text File of Interim Copy of Foreign Priority Application” along with (1) the country code and application number of the foreign priority document, (2) at least two pieces of identifying information for the application (e.g., application number, docket number, title, etc.) in which the interim copy of the foreign application was filed, and (3) if multiple compact discs are submitted, a label indicating their order (e.g., “1 of X”).

The file name of each TXT file must begin with the country code and application number of the foreign priority application of which it is a part (any punctuation or space in the application number must either be omitted or replaced with a dash “-” or underscore “_” character); e.g., “EP111838637_SequenceListing.txt” or “EP_11183863_7_Table 2.” Where an original TXT file must be split into multiple parts, the file name for each part should indicate the order, for example, EP111838637_SeqList_part1of2.txt and EP111838637_SeqList_part2of2.txt.

K. Submission of Photographs and Drawings via EFS-Web.

When applicants are required to submit drawings in patent applications, black and white line drawings as prescribed in 37 CFR 1.84(a)(1) are required except as follows. Pursuant to 37 CFR 1.84(a)(2), color drawings are permitted in design applications filed under 35 U.S.C. chapter 16. As stated in 37 CFR 1.84(a)(2), color drawings are not ordinarily permitted in utility patent applications, and, as stated in 37 CFR 1.84(b), photographs are not ordinarily permitted in utility or design patent applications, but the USPTO will accept photographs in utility or design patent applications or color drawings in utility patent applications, if they are the only practicable medium for illustrating the claimed subject matter. The photographs and color drawings submitted in utility or design patent applications must be of sufficient quality such that all details in the photographs and drawings are reproducible in black and white in the printed patent.

Drawings submitted in international applications (PCT) are required to comply with PCT Rule 11.13, which does not permit color drawings. Furthermore, there is no provision for photographs in international applications. Nevertheless, black and white photographs will be accepted where it is impossible to present in a drawing what is to be shown (e.g.,

crystalline structures). Color photographs are not permitted in international applications. Applicants should, where possible, adhere to PCT Rule 11.13 and provide any necessary explanation of relevant colors in the description, since black and white drawings may be required by some offices in the national phase. Providing drawings and photographs in black and white will also help avoid receiving an invitation from the United States Receiving Office (RO/US) to comply with PCT Rule 11.13. Furthermore, the RO/US converts color drawings/photographs into black and white TIFF images, and such conversion may result in details being lost. Similarly, the International Bureau will, for international publication purposes, convert color drawings/photographs into black and white (not grayscale), which may result in details being lost. Consequently, conversion from color to black and white could impact the disclosure of the invention in the international application and affect the processing of the international application in the international and national phases.

Color drawings and photographs (in black and white or in color) may be submitted in international design applications, as provided under section 401 of the Administrative Instructions for the Application of the Hague Agreement. Section N contains additional information concerning in international design applications.

The USPTO may object to the drawings and photographs, and require corrections or deletions if they do not comply with 37 CFR 1.84 or PCT Rule 11.13. The USPTO will accept color drawings or photographs in utility applications only after granting a petition explaining why the color drawings or photographs are necessary (37 CFR 1.84). Additionally, because color drawings are not permitted in international applications (PCT), color drawings and color photographs filed in a national stage application under 35 U.S.C. 371 will be treated as an amendment and will be objected to if they introduce new matter.

K1. Types of Photographs and Drawings Permitted To Be Filed via EFS-Web.

Black and white line drawings may be submitted via EFS-Web in the types of applications and proceedings listed in section B1 of this framework. However, photographs, color drawings, grayscale drawings, and other drawings that are not black and white line drawings may be submitted via EFS-Web in only the following types of applications and proceedings:

1. Nonprovisional design patent applications, including reissue design patent applications;
2. Provisional applications under 35 U.S.C. 111(b);
3. Nonprovisional utility patent applications under 35 U.S.C. 111(a), including reissue utility patent applications;
4. U.S. national stage applications under 35 U.S.C. 371;

5. International design applications;
6. Reexamination proceedings for utility or design patents; and
7. Supplemental examination proceedings under 35 U.S.C. 257.

Only black and white photographs, and black and white line drawings, may be submitted via EFS-Web in international applications (PCT).

K2. Document Description for Photograph and Drawings.

Users must select the correct document description when submitting photographs and drawings via EFS-Web. Selecting an incorrect document description may cause the photographs and drawings to be processed in a quality that is not sufficient for examination and publication. Applicant must select:

1. “Drawings—only black and white line drawings” (document code “DRW”) for the following:

a. Black and white line drawings in: (i) provisional applications under 35 U.S.C. 111(b); (ii) nonprovisional utility patent applications under 35 U.S.C. 111(a), including reissue utility patent applications; (iii) international applications (PCT) and national stage applications under 35 U.S.C. 371; and (iv) reexamination proceedings for utility patents. These drawings will be converted into TIFF images and stored in IFW.

b. Black and white line drawings in design applications, including reissue design patent applications, international design applications, and reexamination proceedings for design patents. These drawings will be stored in SCORE, and a black and white copy will be stored in IFW along with a SCORE placeholder sheet.

2. “Drawings—other than black and white line drawings” (document code “DRW.NONBW”) for the following:

a. Photographs, color drawings, grayscale drawings, and other drawings that are not black and white line drawings in: (i) provisional applications under 35 U.S.C. 111(b); (ii) nonprovisional utility and design patent applications under 35 U.S.C. 111(a), including reissue utility and design patent applications; (iii) national stage applications under 35 U.S.C. 371; (iv) international design applications; (v) reexamination proceedings for utility patents and design patents; and (vi) supplemental examination proceedings. These drawings will be stored in the Supplemental Complex Repository for Examiners (SCORE), and a black and white copy will be stored in IFW along with a SCORE placeholder sheet.

b. Black and white photographs and grayscale drawings in international applications (PCT). These drawings will be stored in SCORE, and a black and white copy will be stored in IFW along with a SCORE placeholder sheet.

K3. Additional Requirements.

For color drawings in utility patent applications, a petition filed under 37 CFR 1.84(a)(2) explaining why the color drawings are necessary is required. *See* MPEP 608.02. Pursuant to 37 CFR 1.84(a)(2)(ii), only one set of such color drawings is necessary when filing via EFS-Web.

EFS-Web supports the use of black and white, color, or grayscale images within the PDF document. However, grayscale or color images filed as “drawings—other than black and white line drawings” in a utility patent application will be electronically converted to black and white images when stored into IFW. The quality of black and white images may be degraded.

To obtain sufficient quality so that all details in the images are reproducible in black and white in the eighteen-month publication and in the printed patent, images must be scanned at a minimum resolution of 300 DPI. Furthermore, PAIR is only capable of displaying portrait orientation. Users should not submit landscape-oriented drawings via EFS-Web because PAIR will automatically convert the image to portrait, which may cause the images to be distorted during viewing.

For international design applications, EFS-Web supports the use of black and white, color, or grayscale images within a JPEG document. To obtain sufficient image quality for purposes of WIPO publication of the international application and any subsequent U.S. patent that may issue thereon, image resolution should be between 250x250 DPI to 300x300 DPI. In addition, the images should have at least a one-pixel border and preferably a border of between 1-20 pixels. Section N includes further information concerning reproductions in international design applications.

L. Text Files, JPEG Files and File Limits.

L1. Biotechnology Sequence Listings, Large Tables, or Computer Program Listing Appendices Submitted as Text Files via EFS-Web.

All of these types of documents may be submitted as ASCII text files with a “.txt” extension (e.g., “seqlist.txt”) for applications filed under 35 U.S.C. 111, national stage applications under 35 U.S.C. 371, reexamination proceedings, and supplemental examination proceedings. The compact disc practice of 37 CFR 1.52(e) and 1.821 et seq. remains a filing option. The filing of international applications (PCT) via EFS-Web is discussed in section M of this framework.

As discussed at MPEP 608.05, users may submit the following document types (specified in 37 CFR 1.52(e)) as ASCII text files via EFS-Web instead of on compact disc, provided the specification contains a statement in a separate paragraph that incorporates by

reference the material in the ASCII text file identifying the name of the ASCII text file, the date of creation, and the size of the ASCII text file in bytes:

1. A computer program listing (*see* 37 CFR 1.96);
2. A sequence listing (submitted under 37 CFR 1.821); or
3. 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. A table page is a page printed on paper in conformance with 37 CFR 1.52(b) and 1.58(c).

If the “Sequence Listing” required by 37 CFR 1.821(c) was submitted in ASCII text format in an international application (PCT) indicated on the Request as part of the international application and published as part of the international application for which national stage is entered under 35 U.S.C. 371, then no further submission, amendment, or incorporation by reference into the specification is required.

The requirements of 37 CFR 1.52(e)(3)-(6) for documents submitted on compact disc are not applicable to computer program listings, sequence listings, and tables submitted as ASCII text files via EFS-Web. However, each text file must be in compliance with ASCII and have a file name with a “.txt” extension. Further, the specification must contain an incorporation-by-reference of the material in the ASCII text file in a separate paragraph identifying the name of the ASCII text file, the date of creation, and the size of the ASCII text file in bytes, similar to the requirements of 37 CFR 1.52(e)(5) and 1.77(b)(5) for compact discs. *See* MPEP 608.05.

It is recommended that a sequence listing be submitted in an ASCII text file via EFS-Web rather than in a PDF file. If a sequence listing ASCII text file submitted via EFS-Web on the application filing date complies with the requirements of 37 CFR 1.824(a)(2)-(6) and (b), and applicant has not filed a sequence listing in a PDF file (or on paper) on the same day, the text file will serve as both the paper copy required by 37 CFR 1.821(c) and the computer readable form (CRF) required by 37 CFR 1.821(e). Thus, the following are not required and should not be submitted: (1) a second copy of the sequence listing in a PDF file; (2) a statement under 37 CFR 1.821(f) (indicating that the paper copy and CRF copy of the sequence listing are identical); and (3) a request to use 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 USPTO will not carry out the request but will use the sequence listing submitted in an ASCII text file on filing of the application via EFS-Web. Checker software that the applicant may use prior to submission to check a sequence listing for compliance with the requirements of 37 CFR 1.824 is available on the USPTO website at <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/utility-patent/checker-version-446>. The User Notes on the Checker website should be consulted for an explanation of errors that are not indicated, and content that is not verified, by the Checker software.

Section M5 of this framework contains more information on the sequence listing in international applications (PCT) and national stage applications under 35 U.S.C. 371.

If a user submits a sequence listing (under 37 CFR 1.821(c) and (e)) as an ASCII 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. In addition, if a user submits an amendment to, or a replacement of, a sequence listing (under 37 CFR 1.821(c) and (e)) as an ASCII text file via EFS-Web, the sequence listing text file must be accompanied by: (1) a statement that the submission does not include any new matter, and (2) a statement that indicates support for the amendment in the application, as filed. *See* 37 CFR 1.825. The specification must be amended to contain an incorporation-by-reference statement of the sequence listing in both of these instances.

Submission of the sequence listing in a PDF file on the application filing date is not recommended. Applicant must still provide the CRF text file required by 37 CFR 1.821(e), and the sequence listing in the PDF file will not be excluded when determining the application size fee. The USPTO prefers the submission of a sequence listing in an ASCII text file via EFS-Web on the application filing date because as previously stated, if applicant has not filed a second copy of the sequence listing in a PDF file (or on paper) on the same day, 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). Any sequence listing submitted in PDF format (or on paper) on the application filing date is treated as the paper copy required by 37 CFR 1.821(c). If applicant submits a sequence listing in both a PDF file and an ASCII text file via EFS-Web on the application filing date, a statement that the sequence listing content of the PDF copy and the ASCII text file copy are identical is required. In situations where applicant files the sequence listing in PDF format and requests the use of the CRF of another application under 37 CFR 1.821(e), applicant must submit a letter and request in compliance with 37 CFR 1.821(e) and a statement that the PDF copy filed in the new application is identical to the CRF filed in the other application.

L2. How Text Files Are Counted for Application Size Fee Purposes.

Any sequence listing submitted as an ASCII text file via EFS-Web that is otherwise in compliance with 37 CFR 1.52(e), 1.824(a)(2)-(6) and (b), and any computer program listing submitted as an ASCII 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 an ASCII 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). Each table should be submitted as a separate text file. Further, the file name for each table should indicate which table is contained therein.

L3. The Size Limit for Text Files and JPEG Files.

One hundred (100) megabytes is the size limit for sequence listing text files submitted via EFS-Web. If a user wishes to submit an electronic copy of a sequence listing text file that exceeds 100 megabytes, it is recommended that the user file the application without the sequence listing using EFS-Web to obtain the application number and confirmation number, and then file the sequence listing text file on compact disc in accordance with 37 CFR 1.52(e) on the same day by using Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 or by hand-delivery, in order to secure the same filing date for all parts of the application. Note: a submission of a sequence listing in electronic form of 300 MB or more in size is subject to the fee set forth in 37 CFR 1.21(o). Alternatively, a user may submit the application on 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 system is not currently capable of handling such submissions. The sequence listing must be in a single ASCII plain text file. A sequence listing ASCII plain text file that does not fit on a single compact disc may be split into multiple file parts for subsequent reassembly of the single ASCII plain text file using software designed for that purpose. If the sequence listing is submitted on multiple compact discs, the compact discs must be labeled to indicate their order (e.g., “1 of X”, “2 of X”).

For nearly all other file types, 25 megabytes is the size limit. If a user 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 Priority Mail Express® from the USPS 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 user wishes the electronic copy to be considered to be part of the application as filed. Alternatively, the user may submit the application on paper and include the electronic copies on compact disc in accordance with 37 CFR 1.52(e). Another alternative would be for the user 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 user 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”).

The exceptions to the 25-megabyte size limit are JPEG image files submitted via EFS-Web in international design applications and PDF image files submitted in international design applications using the “Attach Reproductions” section of the “Attach Documents” EFS-Web screen. These are limited to a file size of two megabytes. Section N of this framework includes additional information concerning international design applications.

L4. The Limit on the Number of Electronic Files That May Be Included in a Single EFS-Web Submission.

The file number limit per submission is sixty (60) electronic files, as EFS-Web is not currently capable of accepting more than 60 electronic files in any one submission (subject to certain exceptions for international design applications set forth in the next paragraph). Accordingly, if an application file includes more than 60 electronic files, it is recommended that the user 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 of 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 user 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.

For international design applications, the limit of 60 electronic files per submission excludes electronic files of reproductions that are attached via the “Attach Reproductions” section of the “Attach Documents” screen in EFS-Web (available for submissions through the USPTO as an office of indirect filing prior to transmittal of the application to the International Bureau) or are attached via the “Attach JPEG Reproductions” section of the “Attach Documents” screen in EFS-Web (available after transmittal of an international design application to the International Bureau or, where the USPTO was not an office of indirect filing, after receipt of the WIPO publication of an international design application designating the United States). The “Attach Reproductions” section allows up to 5000 (up to 100 designs with 50 views per design) additional single-page PDF and JPEG image files to be uploaded in one submission. The “Attach JPEG Reproductions” section allows up to 50 additional JPEG image files to be uploaded in one submission. Section N of this framework contains further information concerning international design applications.

L5. Complex Work Units May Be Submitted Electronically via EFS-Web.

Under the Complex Work Unit Pilot Program, complex work units (such as chemical structure drawings, mathematical formulae, and three-dimensional protein crystalline structure data and table data) may be submitted as ASCII text files via EFS-Web for applications filed under 35 U.S.C. 111, national stage submissions under 35 U.S.C. 371, reexamination proceedings, and supplemental examination proceedings. Complex work units cannot be submitted as ASCII text files in international applications (PCT). More information is available on the USPTO website at <https://www.uspto.gov/patent/initiatives/complex-work-unit-pilot-program>.

M. New International Applications (PCT), New National Stage Submissions, and Associated Documents.

The term “international application (PCT)” as used in this framework refers to an international application filed under the PCT. The term “national stage submission” as used in this section of the framework refers to an international application (PCT) designating the United States where a submission has been made to enter the U.S. national stage under 35 U.S.C. 371.

M1. New International Applications (PCT) Filed Under the PCT with the United States Receiving Office.

EFS-Web enables users to electronically file international applications (PCT) with the United States Receiving Office (RO/US). The required page size for international applications (PCT) filed via EFS-Web in PDF format is A4 (29.7 cm x 21 cm). *See* PCT Rule 11.5. Section M7 contains more information about follow-on submissions during the international phase.

a. The Request: EFS-Web permits users to submit zip files created by PCT-SAFE or ePCT.

A zip file created using PCT-SAFE or ePCT will contain the PCT Request and a fee calculation sheet in PDF format, which are converted to TIFF images and loaded into the image file wrapper by the USPTO. PCT-SAFE and ePCT users may create and electronically sign using an S-signature the PCT Request, including the Declaration of Inventorship, for the purposes of filing via EFS-Web with the United States Receiving Office. PCT-SAFE and ePCT users may create a zip file containing a validated PCT Request which will entitle the applicant to a reduction of the international filing fee when the PCT-SAFE or ePCT zip file is included in a new international application (PCT) filed with the United States Receiving Office via EFS-Web. *See* Use of WIPO's ePCT System for Preparing the PCT Request for Filing as Part of an International Application With the USPTO as Receiving Office, 81 FR 27417 (May 6, 2016). Alternatively, if the applicant chooses not to use PCT-SAFE or ePCT to create the PCT Request and fee calculation sheet, the applicant may use Form PCT/RO/101 (or equivalent) for the Request and attach the PDF file to the EFS-Web submission.

b. Other Documents.

All other documents including application parts (e.g., description, claims, drawings and abstract) and accompanying items must be separately prepared as PDF files and attached to the EFS-Web submission.

Section M5 of this framework provides more information on sequence listings.

More information regarding filing international applications (PCT) is available on the USPTO website (<https://www.uspto.gov/patents/process/file/efs/guidance/indexing-pct-new-appl.pdf>).

M2. Specific Requirements for Drawings or Photographs.

a. International Application (PCT).

Drawings submitted in international applications (PCT) are required to comply with PCT Rule 11.13, which does not permit color drawings. Furthermore, there is no provision for photographs within the PCT Regulations. Nevertheless, black and white photographs will be accepted where it is impossible to represent in a drawing what is to be shown (e.g., crystalline structures). Color photographs are not permitted in international applications (PCT) (*see also* section K1).

The United States Receiving Office may invite the applicant to correct any defects in the drawings or photographs if they do not comply with PCT Rule 11.13.

b. National Stage Submission.

Since color drawings and color photographs are not permitted in international applications (PCT), color drawings and color photographs filed in a national stage application will be treated as an amendment and will not be entered if they introduce new matter. *See* 37 CFR 1.121(d) and (f). Section K1 includes more information regarding a petition to accept color drawings.

M3. Specific Requirements Pertaining to New National Stage Submissions, Including the Payment of the Basic National Fee.

a. Online Payment Option.

The basic national fee is required in order for an international application (PCT) to enter the national stage under 35 U.S.C. 371. *See* 37 CFR 1.495. Users are permitted to submit the basic national fee with the national stage submission under 35 U.S.C. 371 via EFS-Web using the USPTO payment page.

b. Alternative Payment Methods.

If the payment system is unavailable, EFS-Web will not permit users to make payment using the interactive payment interface. The applicant may pay the basic national fee by either (a) including a written authorization to charge the fee to a deposit account together with the national stage submission under 35 U.S.C. 371, (b) hand-delivering the fee payment, or (c) sending the payment via Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 on the same date that the national stage submission is

electronically filed. However, applicants may not submit the basic national fee via facsimile transmission. *See* 37 CFR 1.6(d)(3) and 1.8(a)(2)(i)(F).

For more information on fees associated with national stage submissions under 35 U.S.C. 371, *see* MPEP 1893.01(c).

M4. New National Stage Submissions to Enter the U.S. National Stage under 35 U.S.C. 371.

a. Validation by PALM.

New National Stage Submission: For any new national stage submissions under 35 U.S.C. 371 filed via EFS-Web, the system automatically checks the PALM system to verify that no previous national stage submission has been made for the particular international application (PCT) referenced in the new national stage submission. EFS-Web users should confirm that the correct international application (PCT) number is entered on the EFS-Web screen to insure that the correct international application (PCT) is initialized as a national stage application. If the PALM system finds a previous national stage submission has been made, the user will be given a warning message and an opportunity to verify, and correct if necessary, the referenced international application (PCT) number. If the PALM system is unavailable, EFS-Web cannot complete the PALM verification, and thus EFS-Web will not permit a new national stage submission under 35 U.S.C. 371 to be filed. Therefore, if PALM is unavailable, applicants may send a new national stage submission by hand-delivery or by Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 to timely submit documents and fee(s) for national stage entry. Applicants may not file either a copy of the international application or the basic national fee necessary to enter the national stage as specified in 37 CFR 1.495(b) via facsimile transmission. *See* 37 CFR 1.6(d)(3) and 1.8(a)(2)(i)(F).

b. Transmittal Letter.

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 U.S.C. 371 (Form PTO-1390) when electronically filing documents for entry into the U.S. national stage under 35 U.S.C. 371. The PTO-1390 Form includes useful information that is not otherwise collected by EFS-Web at this time. EFS-Web users should confirm that the correct international application (PCT) number is entered on the EFS-Web screen to help insure that the correct international application (PCT) is initialized as a national stage submission. A petition under 37 CFR 1.182 with the appropriate fee under 37 CFR 1.17(f) may be required to correct inconsistencies in the international application (PCT) number indicated in the submission to enter the national stage under 35 U.S.C. 371.

c. Application Data Sheet.

An application data sheet is recommended for new national stage submissions.

d. Initial Processing.

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

M5. Specific Requirements for Nucleotide and Amino Acid Sequence Listings in International Applications (PCT).

a. Sequence Listing.

Under PCT Rule 5.2(a), the sequence listing must always be presented as a separate part of the description. When filing an international application (PCT) using EFS-Web, the sequence listing part of the description may be submitted either as a single ASCII text file with a “.txt” extension (e.g., “seqlist.txt”) or as a PDF file. Note that 100 megabytes is the size limit for submitting a sequence listing text file via EFS-Web. If the sequence listing is submitted as an ASCII text file, applicant need not and should not submit any additional copies. The single ASCII text file is preferred because the ASCII text file will serve both as the sequence listing part of the description under PCT Rule 5.2 and the electronic form under PCT Rule 13*ter*.1(a) in the absence of a PDF sequence listing file. The check list of the PCT Request provided via EFS-Web together with the international application (PCT) must indicate that the sequence listing forms part of the international application. Furthermore, the statement set forth in paragraph 4(v) of Annex C of the Administrative Instructions under the PCT (AI Annex C) that “the information recorded in electronic form furnished under Rule 13*ter* is identical to the sequence listing as contained in the international application” is not required. Also, the sequence listing in an ASCII text file will not be taken into account when calculating the application sheet count, i.e., no excess sheet fee will be required for the sequence listing text file.

Submission of the sequence listing part of the description in a PDF file is not recommended because the applicant would also be required to supply a copy of the sequence listing in an ASCII text file to the appropriate authority for purposes of international search and/or international preliminary examination in accordance with paragraph 40 of AI Annex C. When a sequence listing is filed via EFS-Web in a new international application (PCT) in both a PDF file and an ASCII text file, but the Request form Box No. IX does not indicate which one forms part of the international application, the PDF copy of the sequence listing will be considered to form part of the application and the ASCII text file will be considered an accompanying item for search purposes under PCT Rule 13*ter*.1(a) only. The pages of the PDF file that contain the sequence

listing will be taken into account when calculating the application sheet count, i.e., excess sheet fees may be required for the PDF file.

b. File Size and Quantity Limits.

One hundred (100) megabytes is the size limit for sequence listing text files submitted via EFS-Web. Sequence listing text files must 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. For all other file types 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 limit of 60 electronic files, an applicant may upload and validate in sets of 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. The need to submit unusually large sequence listings and/or numerous electronic files may prevent applicant from making a complete international application (PCT) filing in a single EFS-Web submission. Registered EFS-Web users may file part of the international application (PCT) to obtain the international application (PCT) number and the confirmation number, and then file the remainder of the international application (PCT) on the same day as one or more follow-on submissions using EFS-Web, in order to secure the same filing date for all parts of the international application (PCT).

In the situation where applicant needs to file a sequence listing that is over one hundred (100) megabytes, applicant may use EFS-Web to file the international application (PCT) without the sequence listing to obtain the international application (PCT) number and the confirmation number, and then file the sequence listing on compact discs on the same day by using Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 or by hand-delivery, in order to secure the same filing date for all parts of the international application (PCT). However, Priority Mail Express® from the USPS and hand-delivered submissions must not contain PDF files and must fully comply with the guidelines for filing a sequence listing on electronic media as set forth in MPEP 2422.03(a), subsection IV. The check list of the PCT Request provided via EFS-Web together with the international application (PCT) should indicate that the sequence listing part of the description will be filed separately on physical data carrier(s) on the same day and in the form of an Annex C/ST.25 text file. The sequence listing must be in a single ASCII plain text file. Where a sequence listing ASCII plain text file does not fit on a single compact disc software may be used to prepare multiple concatenated file parts for submission on multiple compact discs. If the sequence listing is submitted on multiple compact discs, the compact discs must be labeled to indicate their order (e.g., “1 of X”, “2 of X”). This allows the multiple parts to automatically join and form the single ASCII plain text file when the properly labeled multiple compact discs are subsequently processed by the USPTO.

c. Fee Determination for International Applications (PCT) Containing a Sequence Listing.

The calculation of the international filing fee for an international application (PCT), including a sequence listing, filed via EFS-Web is determined based on the type of sequence listing file. A sequence listing filed in an ASCII text file will not be included in the sheet count of the international application (PCT). A sequence listing filed in a PDF file will be included in the sheet count of the international application (PCT). Therefore, the sheet count for an EFS-Web filed international application (PCT) containing both a PDF file and a text file sequence listing will be calculated to include the number of sheets of the PDF sequence listing.

M6. Limitations Concerning Computer Program Listings and Tables Related to a Sequence Listing in International Applications (PCT).

a. Computer Program Listings.

There is no provision for computer program listings in ASCII text file in international applications (PCT).

b. Tables Related to a Sequence Listing.

Tables related to a sequence listing must be an integral part of the description of the international application (PCT), and must not be included in the sequence listing part or the drawing part. Such tables will be taken into account when calculating the application sheet count, and excess sheet fees may be required. When applicant submits tables related to a sequence listing in an international application (PCT) via EFS-Web, the tables must be in a PDF file. If applicant submits tables related to a sequence listing in a text file, such tables will not be accepted as part of the international application (PCT). *See Sequence Listings and Tables Related Thereto in International Applications Filed in the United States Receiving Office*, 1344 Off. Gaz. Pat. Office 50 (July 7, 2009).

M7. Follow-on Submissions for International Applications (PCT).

As previously noted, a sequence listing in an ASCII text file, as well as additional PDF files, may be submitted in one or more follow-on submissions via EFS-Web. Such follow-on submissions will form part of the international application (PCT) if filed on the same date on which the international application (PCT) was filed. Note that follow-on submissions of PDF files (including, but not limited to, PDF sequence listings) may change the number of pages in the international application (PCT) and therefore may affect the international filing fee.

EFS-Web may also be used to submit a sequence listing in an ASCII text file after the international filing date in response to a requirement made by the United States International Searching Authority or United States International Preliminary Examining

Authority under 37 CFR 1.821(h) and PCT Rule 13^{ter}. Such sequence listing will not form part of the PCT international application as set forth in PCT Rule 13^{ter}.1(e).

M8. Policy of Annex F of the PCT Administrative Instructions (AI Annex F).

EFS-Web employs a Web-based approach to document submission which is different from the AI Annex F “wrapped, bundled and signed package” approach. Thus EFS-Web does not meet the AI Annex F requirements. *See* Annex F of the PCT Administrative Instructions located at <http://www.wipo.int/pct/en/texts/>.

N. International Design Applications and Associated Documents.

The term “international design application” as used in this framework refers to an application for international registration of an industrial design filed under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (“Hague Agreement”). The term “Rule” as used in this section refers to the “Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement” (as in force on January 1, 2019).

N1. New International Design Applications Filed Through the USPTO as an Office of Indirect Filing.

EFS-Web enables registered and unregistered users to electronically file new international design applications through the USPTO as an office of indirect filing. To submit an international design application through EFS-Web, users must select “International Design Application (Hague) for filing through the USPTO as an office of indirect filing” after selecting “New application/proceeding” on the main EFS-Web screen. The following documents should be included in new international design application submissions:

a. Official form (Form DM/1).

Applicants filing international design applications through the USPTO are required to present the international design application on the official form established by the International Bureau (i.e., Form DM/1, entitled “Application for International Registration”) or on any form having the same form and content as the official form. Form DM/1 is available on the website of the International Bureau at <http://www.wipo.int/hague/en/forms/>. The DM/1 form includes boxes for providing information concerning the applicant, applicant’s entitlement to file an international design application, the creator, product identification, designations of Contracting Parties, priority claim, description, and other relevant information.

Users should use the document description “App for Intl Registration (DM/1 or equiv)” for a DM/1 form (or equivalent) submitted via EFS-Web. For new international design

application submissions, EFS-Web will check for the presence of the document description for the DM/1 form when upload and validation functions are performed and, if not present, will alert the user that the DM/1 form is not indicated as being attached. EFS-Web will not block submission of a new international design application based on the missing document description. If the DM/1 form document description is present, EFS-Web will prompt the user to verify that the DM/1 form indicates applicant's entitlement to file the international design application through the USPTO as an office of indirect filing. The USPTO will not transmit an international design application to the International Bureau if applicant's entitlement to file the application through the USPTO is not indicated in the submission.

b. Reproductions.

Reproductions of industrial designs are required in international design applications and may be submitted as drawings, photographs, or a combination thereof, and may be in black and white or in color. *See* Rule 9 and Part Four of the Administrative Instructions for the Application of the Hague Agreement. Reproductions may be submitted through EFS-Web as PDF or JPEG files as set forth in the next paragraphs. Technical requirements regarding image files, such as resolution, minimum and maximum image size, border width, etc., are also set forth on the website of the International Bureau at https://www.wipo.int/hague/en/how_to/file/prepare.html.

Reproductions may be submitted as single-page PDF or JPEG files by attaching the file(s) using the "Attach Reproductions" section of the "Attach Documents" screen. Alternatively, applicants may attach reproductions as PDFs (including multi-page PDFs) using the "Attach Documents other than Reproductions" section of the "Attach Documents" screen. Attaching compliant reproductions via the "Attach Reproductions" section, rather than the "Attach Documents other than Reproductions" section, may help to avoid incurring additional per-page publication fees that might otherwise be required by the International Bureau. Each image file attached through the "Attach Reproductions" section should contain only one view of the design. The "Attach Reproductions" section will prompt the user to assign a design and view number to each file attached under this section.

In accordance with the technical requirements set forth by the International Bureau, EFS-Web will not permit submission of any PDF or JPEG file via the "Attach Reproductions" section that exceeds a file size of two megabytes. For JPEG submissions, EFS-Web will provide warnings where requirements pertaining to image resolution and minimum and maximum dimensions have not been satisfied; EFS-Web does not check color mode or border size for JPEG images. For PDF submissions via the "Attach Reproductions" section, EFS-Web will not permit submission of any PDF file that is more than one page. In addition, EFS-Web does not check color mode, border size, resolution, or maximum or minimum dimensions of the reproduction (other than certain minimum and maximum

page size dimensions) for PDF images. It is the responsibility of applicants to ensure that reproductions satisfy all applicable requirements.

Users attaching reproductions under either the “Attach Reproductions” section or the “Attach Documents other than Reproductions” section should use the document description “drawings – only black and white line drawings” or “drawing – other than black and white line drawings,” as appropriate. EFS-Web will provide a warning to users about the possibility of incurring additional per page publication fees where reproductions are attached via the “Attach Documents other than Reproductions” section. EFS-Web will also provide a warning to users where a new international design application does not contain an indication that at least one reproduction is attached.

c. Annexes.

An international design application may be accompanied by annexes submitted for the purpose of complying with certain national law requirements that may be applicable to a designated Contracting Party, for example, the requirement for an inventor’s oath or declaration where the United States is designated. Annex forms specific to particular Contracting Parties are available on the website of the International Bureau at <https://www.wipo.int/hague/en/forms/>. Annexes should be attached to the EFS-Web submission using the document description “Annex(es) to the DM/1 or equivalent.”

More information regarding filing international design applications is available on the USPTO website at <https://www.uspto.gov/patents-application-process/applying-online/efs-web-guidance-and-resources>.

N2. International Design Application Fees Required by or Payable Through the USPTO as an Office of Indirect Filing.

a. Transmittal fee.

International design applications filed through the USPTO as an office of indirect filing are subject to payment of a transmittal fee. *See* 37 CFR 1.1031(a). Users are permitted to submit the transmittal fee via EFS-Web using the USPTO payment page. The USPTO will not transmit the international design application to the International Bureau if the transmittal fee has not been paid to the USPTO. *See* 37 CFR 1.1045. Applicants are cautioned that an international design application not received by the International Bureau within six months from the date the international design application is received by the USPTO will not be entitled to a filing date as of the date of receipt by the USPTO. *See* Rule 13.

b. International fees payable to WIPO.

Certain international design application fees payable to the International Bureau may be paid through the USPTO as an office of indirect filing, provided such fees are paid no later than the date of payment of the transmittal fee. *See* 37 CFR 1.1031(c). Applicants are not required to pay such fees through the USPTO but rather may pay such fees directly to the International Bureau. Furthermore, any payment of such fees through the USPTO must be in U.S. dollars. Because all payments made to the International Bureau must be in Swiss currency, the U.S. dollar amount collected may, when converted to Swiss currency, be different than the required Swiss currency amount. Accordingly, applicants are cautioned that paying such fees through the USPTO may still result in a requirement by the International Bureau to pay additional amounts where the conversion from U.S. dollars to Swiss currency results in the International Bureau receiving less than the prescribed amounts. *See* 37 CFR 1.1031(d).

International fees payable to WIPO include the prescribed fees set forth under Rule 12(1) (i.e., the basic fee, standard designation fee(s), individual designation fee(s), and publication fee) and Rule 11(2) (fee for a description exceeding 100 words). The “Calculate Fees” screen of EFS-Web does not provide for individual selection of these fees but rather provides for input of one lump sum in Swiss francs. The screen includes a link to the WIPO Hague System Fee Calculator (<https://www.wipo.int/hague/en/fees/calculator.jsp>) where users can input the appropriate data concerning their international design applications, and the WIPO Fee Calculator will determine the total amount of fees required in Swiss francs. Users can then copy and paste this amount into the “International Fees Payable to WIPO (CHF)” field of the EFS-Web Calculate Fees screen, and EFS-Web will calculate the U.S. dollar amount based on current exchange rates. EFS-Web will only permit payment of the international fees that are payable to WIPO until 12 midnight Eastern Time of the date of payment of the transmittal fee required under 37 CFR 1.1031(a).

N3. Follow-on Submissions in International Design Applications.

In accordance with the requirements of this framework, only registered users may file follow-on submissions via EFS-Web in international design applications.

Where an international design application was filed with the USPTO as an office of indirect filing, the USPTO will generally not forward communications to the International Bureau received after transmittal of the application to the International Bureau has been effected. Thus, for example, where the International Bureau has sent an invitation requiring compliance with a requirement under the Hague Agreement, the applicant must file any reply to that invitation directly with the International Bureau to avoid abandonment or other loss of rights under the treaty. *See* 37 CFR 1.1045.

The available document descriptions and fees that may be paid through EFS-Web will differ depending on the stage of processing of the international design application. After

transmittal of the international design application to the International Bureau has occurred, the document descriptions and fees that may be paid through EFS-Web include those that would be relevant for U.S. national processing and examination. Follow-on submissions filed after transmittal of the international design application to the International Bureau but prior to WIPO publication of the international design application designating the United States will generally be presumed to have been intended for consideration by the USPTO acting as an examining office for the application. Accordingly, action by the Office on any such submission will generally be taken after receipt of the WIPO publication of the international design application designating the United States.

No follow-on submission or fee payment is required from the applicant to initiate examination of an international design application that designates the United States. Upon receipt by the Office of the WIPO publication of an international design application designating the United States, the Office will prepare the application file for examination. Registered users may, in accordance with this framework, file follow-on submissions in the international design application via EFS-Web relevant to U.S. national processing and examination. Reproductions amended pursuant to 37 CFR 1.121 may be submitted via EFS-Web as either PDF or JPEG electronic files. Any such JPEG file must be attached to the EFS-Web submission using the “Attach JPEG Reproductions” section of the “Attach Documents” EFS-Web screen. Section L3 contains more information on JPEG file size limits and section L4 contains more information on the limit on the number of JPEG files that may be attached in one submission.