

Questions and Answers: Filing Patent Applications Electronically During Designated Significant Outages of the United States Patent and Trademark Office Electronic Business Systems

The following questions and answers are related to the Federal Register (FR) notice entitled “Filing Patent Applications Electronically During Designated Significant Outages of the United States Patent and Trademark Office Electronic Business Systems,” 83 FR 44264, (Aug. 30, 2018) (“FR notice”).

Question System Outage 1: I was able file my application electronically via EFS-Web Contingency on August 17, 2018, which was during the period of the designated significant unplanned electronic business system outage. Do I need to do anything?

No. There is no need to do anything because an application filed electronically via the EFS-Web Contingency is considered an application filed by the USPTO’s electronic filing system.

Question System Outage 2: What applications are eligible for the alternative electronic filing procedures prescribed in the FR notice?

The alternative electronic filing procedures set forth in the FR notice apply to patent applications filed in paper (*e.g.*, Priority Mail Express® or hand-delivery) from August 15, 2018 through and including August 23, 2018.

Question System Outage 3: I filed a patent application in paper during the designated significant unplanned electronic business system outage and I would like that filing to be treated as being filed by the USPTO’s electronic filing system. The alternative electronic filing procedures set forth in the FR notice require the filing of a copy of the application via EFS-Web. What application papers are considered to be the copy of the application that must be filed via EFS-Web in order to have my application treated as being filed by the USPTO’s electronic filing system?

The copy of the application that must be filed via EFS-Web includes the specification, including claims, the drawings, the abstract, and any preliminary amendments present on the filing date of the application. In addition, if the application was filed with a Sequence Listing or a computer program listing in paper, then a copy of the Sequence Listing or the computer program listing must also be submitted electronically via EFS-Web. If a Sequence Listing or a computer program listing was submitted on CD under 37 CFR 1.52(e) with the application filed in paper, then it is not necessary to submit a copy of such Sequence Listing or computer program listing since the CD is an electronic version.

Furthermore, any other papers that were submitted with the application on filing, such as an Information Disclosure Statement (IDS), an Application Data Sheet (ADS), or the inventor's oath or declaration, should not be resubmitted.

Question System Outage 4: Do I need to submit a request or cover letter when I submit a copy of the application electronically via EFS-Web?

Yes. A request or cover letter should be submitted with the copy of the application being filed electronically via EFS-Web. This is because the copy of the application must be accompanied by a statement that the copy is a true copy of the original application as filed by the alternative filing method. The request or cover letter should also include a request for refund if the non-electronic filing fee has been paid. The USPTO has a form, PTO/SB/448, that may be used as the request/cover letter. The use of the USPTO form and the document description "Refund Request for Papers Filed During a Designated Outage" (identified on the form) will facilitate processing of the request by the USPTO.

Question System Outage 5: According to the FR notice, the copy of the application filed via EFS-Web must be accompanied by a statement that it is a true copy of the original application as filed by the alternative filing method. What language will the USPTO accept for the true copy statement?

The USPTO is looking for an indication that the copy of the application being submitted electronically is a "true copy" of the application that was filed in paper. The USPTO form (PTO/SB/448) includes an acceptable true copy statement.

Question System Outage 6: What is the time period in which I must submit a copy of the application via EFS-Web if I want my application to be treated as having been filed electronically?

If the USPTO issues a filing receipt with a Notice to File Missing Parts, the copy of the application must be submitted as a follow-on document via EFS-Web before the expiration of the period for reply set forth in the Notice to File Missing Parts.

If the USPTO issues a filing receipt without a Notice to File Missing Parts, the copy of the application must be submitted as a follow-on document via EFS-Web within one month from the date the filing receipt was issued.

In the case of a PCT application, if the USPTO as Receiving Office (RO/US) issues Form PCT/RO/105 with a Notification Concerning Payment of Prescribed Fees (Form PCT/RO/102) which indicates that a fee is required, the copy of the application must be submitted as a follow-on document via EFS-Web before the expiration of the time limit set forth in the Notification Concerning Payment of Prescribed Fees. Pursuant to PCT

Rule 16bis.1(d), payment received by the RO/US before the RO/US sends an Invitation to Pay Prescribed Fees Together with Late Payment Fee (Form PCT/RO/133) shall be considered to have been received before the expiration of the time limit set forth in the Notification Concerning Payment of Prescribed Fees. The USPTO will treat a copy of the application submitted with payment of any fee deficiency before issuance of Form PCT/RO/133 as received before the expiration of the time limit set forth in the Notification Concerning Payment of Prescribed Fees.

If the RO/US issues Form PCT/RO/105 with a Notification Concerning Payment of Prescribed Fees that does not indicate that a fee is required, the copy of the application must be submitted as a follow-on document via EFS-Web within one month from the date Form PCT/RO/105 was issued.

Question System Outage 7: What fees will be refunded (or not required) if I comply with the alternative electronic filing procedures prescribed in the FR notice?

If the alternative electronic filing procedures set forth in the FR notice are complied with, the USPTO will refund (or not require) the non-electronic filing fee under 37 CFR 1.16(t) for a nonprovisional utility application or the non-electronic filing under 37 CFR 1.445(a)(1)(ii) for an international application designating the U.S. In addition, if the application is a utility application that was filed by a small entity, the applicant will be entitled to the pay the reduced basic filing fee for small entities who file in compliance with the USPTO's electronic filing system. Thus, the USPTO will refund (or not require) the difference between the small entity basic filing fee for filing a utility application in paper and the small entity basic filing fee for filing a utility application electronically. The application will also be treated as being filed by the USPTO's electronic filing system for purposes of calculation of the application size fee set forth in 37 CFR 1.52(f)(2). Therefore, some applicants may be entitled to a refund or (or not have to pay) the application size fee or a portion thereof based on the calculation.

Question System Outage 8: What if I mistakenly filed the copy of the application via EFS-Web as a new application, rather than as a follow-on paper in the application? Can I file a request or petition to move the copy of the application to the application for which it was intended and have my application treated as an application filed by the prescribed alternative electronic filing means?

If the copy of the application is filed via EFS-Web as a new application, the copy will be treated as a new application, and the application filed by an alternative filing method will **not** be treated as an application filed by the prescribed alternative electronic filing means. If there is still time to do so, applicant should file a copy of the application via EFS-Web as a follow-on paper in the correct application along with the true copy statement and the request for refund, *e.g.*, USPTO form (PTO/SB/448). The USPTO will not grant a

request or petition to move the copy of the application to the application for which it is intended. Applicant may wish to expressly abandon the new application that was mistakenly filed. If the search fee or excess claims fees were paid for the new application that was mistakenly filed, applicant may wish to file a petition for express abandonment under 37 CFR 1.138(d) to obtain a refund of the search fee or any excess claims fees.

Question System Outage 9: Can I follow the alternative electronic filing procedures prescribed in the FR notice any time that I am unable to file an application electronically for reasons other than a designated significant unplanned electronic business system outage?

No. The alternative electronic filing procedures prescribed in the FR notice will only be available when there is a significant unplanned electronic business system outage that precludes patent applicants and patentees from filing patent documents and fees via the electronic filing system for a significant period of time, as designated by the Director of the USPTO (a “designated significant unplanned electronic business system outage”).

Question System Outage 10: How will the USPTO notify the public when a future system outage is designated as a significant unplanned electronic business system outage?

The USPTO will post a notice on its Internet website in the event of a future designated significant unplanned electronic business system outage, and indicate the dates for which the alternative electronic filing procedures are available due to such designated significant unplanned electronic business system outage.

Question System Outage 11: Why is the USPTO requiring a copy of the application to be filed via EFS-Web? What will the copy of the application be used for?

The alternative electronic filing means prescribed by the Director includes filing a copy of the application via EFS-Web so that the application can be treated as having been filed electronically. The USPTO plans to use the copy of the application for printing of the pre-grant publication and the patent and it may also be used for examination purposes. An application filed via EFS-Web is usually of much better quality than an application filed in paper and scanned into the file wrapper.

Question System Outage 12: If I follow the electronic filing procedures prescribed in the FR notice and the filing of my application is treated as an application filed by the USPTO’s electronic filing system, will the copy of the application filed in paper (*e.g.*, Priority Mail Express[®] or hand-delivery) or the copy of the application filed via EFS-Web be used to create a certified copy of the application as filed?

The USPTO will use the copy of the application as originally filed in paper to create the certified copy of the application as filed.