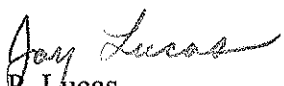




Memorandum

Date: June 19, 2006

To: Technology Center Directors
Patent Examining Corps

From: 
Jay P. Lucas
Deputy Commissioner for Patent Examination Policy

Subject: Reminder - Communications via Internet e-mail

It has been brought to my attention that some examiners are communicating with applicant and/or applicant's representative via Internet e-mail without (1) a prior written authorization by applicant in the application file record giving the Office authorization to communicate with applicant via e-mail, and (2) printing a copy of the e-mail communication to be placed in the application file. This is **not** in accord with the *Patent Internet Usage Policy* published by the Office in June of 1999 (64 *Fed. Reg.* 33056). In particular, Article 5 of the *Patent Internet Usage Policy* (which is reproduced in MPEP § 502.03, subsection II) states in part that

"Without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122...Where a written authorization is given by the applicant, communications via Internet e-mail...may be used. In such case, a printed copy of the Internet e-mail communications **MUST** be...entered in the patent application file."

In addition, Article 8 of the *Patent Internet Usage Policy* (which is reproduced in MPEP § 502.03, subsection V) states in part that

"Internet e-mail shall **NOT** be used to conduct an exchange of communications similar to those exchanged during telephone or personal interviews unless a written authorization has been given under Patent Internet Usage Policy Article 5 to use Internet e-mail. In such cases, a paper copy of the Internet e-mail contents **MUST** be made and placed in the patent application file...in the same manner as an Examiner Interview Summary Form is entered."

The Office has a policy of only communicating with the applicants by e-mail with applicants' informed consent. As noted in Article 6 of the *Patent Internet Usage Policy*, "[t]he misrepresentation of a sender's identity (i.e., spoofing) is a known risk when using electronic communications. Therefore, Patent Organization users have an obligation to be aware of this risk and conduct their Internet activities in compliance with established procedures." Office

employees are **not** permitted to communicate with applicants regarding a patent application via Internet e-mail unless there is written authorization by the applicants in the application file.

Where prior written authorization by the applicants is in the application file and communication via e-mail occurred, a paper copy of all the e-mail communications must be printed and made of record in the application file. The action of the Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of the e-mail communication. The record of the prosecution of the application in the USPTO is vital. Patent suits are won or lost based on the completeness of the application file record. An incomplete record damages our applicants and the USPTO's professional reputation, and it opens the Office to demands for discovery. The application file record should only include subject matter directed to the prosecution of the application and therefore, e-mail communications must **not** include subject matter (e.g., personal business) that is not relevant to the patent application.