

Electronic Notification of Outgoing Correspondence (e-Office Action)

Effective December 16, 2006, the United States Patent and Trademark Office (Office) will begin a pilot program to provide a limited number of Private PAIR users with the option of receiving electronic notification of some outgoing correspondence related to their US patents and US national patent applications retrievable through Private PAIR instead of a paper mailing of the correspondence. Patent Cooperation Treaty (PCT) applications will not be included in this pilot.

Participants in this pilot program will no longer receive paper mailings for most correspondence originating from a Technology Center. However, since several areas of the Office have independent mailing processes, pilot participants will continue to receive paper mailings for correspondence originating from several areas of the Office including, but not limited to: Office of Initial Patent Examination, Petitions, PCT, Appeals, Publications, Interference, and Reexamination.

A Private PAIR user will be able to opt-in to receive electronic mail message (email) notifications of outgoing correspondence by selecting the appropriate choice on the Customer Number Details screen for a customer number associated with a correspondence address after logging in to Private PAIR and providing between one and three email addresses to be used for these notifications. The Private PAIR user must be a registered patent attorney or agent of record, or a pro se inventor who is a named inventor in the application associated with the customer number through which Private PAIR is accessed. The Office will then send a notification to each provided email address if a new outgoing correspondence has been prepared for the patents or patent applications associated with the user's Customer Number. Each email notification will list all applications, associated with the corresponding Customer Number, in which new outgoing correspondence was prepared for the corresponding electronic application files within the preceding 24 hours. Each email notification will be entered into the corresponding application files. The new outgoing correspondence will become available for viewing and downloading through Private PAIR within two business days of the date of the email notification.

Applicants will have the ability to opt-in or opt-out of receiving electronic notification of Office actions at any time. However, the status of each individual outgoing correspondence, whether electronic or paper, will be determined at the time of the printing of the form PTOL-90 cover sheet (at the time the outgoing correspondence becomes available for viewing, i.e., the date indicated on the correspondence).

The email notification described above will be sent after the Office action has been prepared and entered into the record. The period for reply to any Office correspondence to which a reply is required will commence on the date indicated on the outgoing Office correspondence (i.e., the date the correspondence becomes available for viewing). The date indicated on the Office correspondence will also be considered the date of mailing of

such outgoing correspondence for all other purposes (e.g., 37 CFR 1.71(g)(2), 1.97(b), 1.701 through 1.705). The Office communication will become available for downloading and viewing through Private PAIR on the date indicated on the correspondence.

If none of the documents in each of the applications listed in the email notifications are viewed or downloaded through Private PAIR within seven calendar days after the emails are sent, a courtesy postcard notifying the applicant of the availability of electronic Office action will be mailed to the correspondence address associated with the applicant's corresponding Customer Number for each of those applications. The mailing of a courtesy postcard will **not** restart the time period for reply, and the period for reply to any outgoing Office correspondence to which a reply is required will continue to be measured from the date indicated on such outgoing Office correspondence.

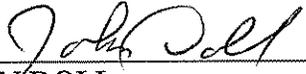
Please note that the email notification procedure outlined above is simply an automated email sent by the Office to alert applicant that an official Office correspondence has been entered in the official record that will be available for viewing via private PAIR. It is not an email sent by the examiner and does not alter the Office policy prohibiting an applicant or examiner from engaging in improper email correspondence. See MPEP section 502.03.

The e-Office Action Pilot Program will begin with a limited number of participants. The Pilot Program will last approximately six months. Upon the conclusion of the pilot program the success of the pilot will be evaluated. At that time decisions will be made as to whether or not to make modifications to the e-Office action program and whether or not to permanently implement the program.

Thus, if the pilot program is successful and a decision is made to permanently implement the program, it is expected that the e-Office Action Program will go into full production sometime around June 2007 at which point the program will be open to all users (registered patent attorney or agent of record, or a pro se inventor who is a named inventor in the application associated with the customer number through which Private PAIR is accessed) having a Customer Number and access to Private PAIR.

For further information please contact the Patent Electronic Business Center (EBC) 866-217-9197 (toll-free) or 571-272-4100 Monday through Friday from 6 a.m. to 12 Midnight Eastern Time or send e-mail to ebc@uspto.gov.

Date: 12/19/06



JOHN DOLL
Commissioner for Patents