

JEFFREY T. SPANGLER
JTS273@alumni.Lehigh.edu

Office 703-465-1795
Cell 703-209-0880

DATE : DECEMBER 3, 2007
TO : [REDACTED]
COPY: [REDACTED]
RE : ELECTRONIC FILING SYSTEM [EFS] GUIDANCE

As of December 3, all of [REDACTED]'s PTO filings will be via EFS. I don't know how much experience everyone has with EFS, but I offer these brief points and ask for your input on how to improve the Firm's EFS program. I've had limited experience but managed to run into some problems which are easily avoided.

Attached is a 6-page presentation from Philadelphia IP firm Paul & Paul on EFS traps and tips taken from the Joint Patent Practice CLE materials in New York in May (for more information, see www.jpccle.org). The PTO also has a tutorial and sandbox for practice with EFS.

Manually signed documents are not necessarily required, and I've used PDF copies with the notation "Electronically signed by" on the signature line. Filing on EFS using a Digital Certificate .epf file and its password is a substitute for a manual signature. Once [REDACTED] approves the document, it may be filed without his signature.

When naming PDF files to be uploaded to EFS, be sure to observe its naming rules, and don't use spaces or prohibited characters. A typical name I used Monday was [REDACTED]_ISSUE_FEE_PAYMENT_120308. The filename will appear on the EFS acknowledgement receipt and should be the same as the Word or PDF document we prepare for filing, so it should contain the docket number and be descriptive of the document.

I've been unable to upload directly from WorkSite, so I scan a doc to be filed, email it to myself, save it to WorkSite, and then save a copy to my H drive folder for upload from there. Let me know if you figure out how to upload directly from WorkSite.

One problem I encountered when e-filing an IDS with scientific journal articles I downloaded from the publisher in PDF files was an error which EFS flagged as an "embedded font" problem. I never figured out how to fix it in Adobe and just printed out then scanned the articles for upload.

When making fee payments from the Firm's Deposit Account, you'll need the Authorization Code as well as the account number. In [REDACTED] cases, we use their Deposit Account number, but I don't yet know their authorization code. You'll also need the application number and the confirmation number to access the case on EFS.

I usually print the EFS Acknowledgement Receipt as soon as it appears, then save it to my H drive for storage on WorkSite under the docket number, then print it out for reporting and inclusion in the file folder.

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EFS-Web Tips and Traps

5-9-07

Alex Sluzas

Paul and Paul, Philadelphia

1. It's almost too easy

The United States Patent and Trademark Office has made it possible to file documents on-line, over the Web, for over a year now. This electronic filing system is replacing both a prior e-filing system that was much more difficult to learn and use, and traditional paper filing. The system has proven very popular, and in a relatively short time, electronic filing should be the *de facto* standard for US patent practitioners. The PTO's Electronic Business Center has done an excellent job getting the system to work as well as it does. Nevertheless, there are some important caveats to keep in mind when preparing to file a new patent application or a "follow-on" document such as a response to an Examiner's Action.

2. Preparing the documents for filing

Using the system is very easy. The patent practitioner drafts the documents he or she intends to file in the PTO, for example, a new utility patent application, in the form of a word processing document. The word processing document, typically in Microsoft Word or in WordPerfect format, is then converted into a pdf document, either by using file conversion software (such as Acrobat Distiller), or by scanning.

Trap: Scanning everything always.

Scanning creates an pdf image file, which is always larger than a pdf text file created by using conversion software. Sometimes, scanning is the only option, such as with drawings prepared by hand. At other times, it may be difficult to create non-image pdf files that meet the PTO's technical requirement (e.g. creating a pdf file from a drawing created using drafting software), so that scanning may be the time-saving option.

Tip: The better practice is to use file conversion software for text, and scan the drawings, to minimize the pdf file size. Larger files take longer to upload.

If file conversion software is used, the conversion parameters should meet the PTO's requirements. This is easy to do, by simply downloading the "JobOptions" file from the PTO website and saving it in the root directory of the computer used to create the pdf file.

Tip: Invest in pdf software that permits you to edit pdf documents

Pdf software comes in multiple versions with different capabilities. The initial marketing technique for Adobe was to sell the software needed to create the pdf document ("Acrobat") and give software for reading the pdf document ("Reader") away for free. You need both types of software. You need Acrobat Reader 7.0.8 to be able to fill out the special forms created by the PTO for EFS (ADS, IDS, RCE, etc.) (neither older nor newer versions of Reader will work at this

N.B.: Must use correct Java Runtime Environment.
May be automatically updated on various systems.
"Un-update" if necessary.

time). At the same time you need software to create and edit the pdf documents you plan to submit. Multiple vendors now provide pdf document creation software, including Adobe, CutePDF, Open Office, Primo PDF, et al.

You should have something that will permit you not just to create pdf files; you should have something that will permit you to insert pages, delete pages, replace pages, etc. from existing pdf files. For example, if you plan to submit a new utility application, you may have multiple drawing sheets that have to be scanned, and a lengthy specification in the form of a word processing document. You could create a text-searchable pdf file from the word processing document to minimize the size of the file and upload this separately from the drawings. It may be a better practice to prepare a pdf document that tracks a conventional paper-filed patent application as closely as possible. If you have pdf editing software you can open up the text-searchable specification, and add the scanned drawings, as well as a scanned declaration, to create a single "package" that prints out to look just like what you would expect for a ready-to-file patent application.

3. Filing on EFS-Web

Once a document is created, where does it go?

Trap: Uploading the wrong version of a document.

Once a document has been created, it is a simple matter to upload the document to the PTO's EFS server. If the practitioner has just finished drafting the document, it is possible to convert to pdf, sign in onto the EFS server, upload, and submit the document in a few minutes. Tempting, but perhaps not wise.

Trick: Minimize the change in office practice when implementing electronic filing

While details may vary greatly from office to office, preparing and filing patent documents typically requires a group effort. An attorney may dictate an application draft, and her legal assistant may key in the dictated text, which is subsequently printed out, and reviewed and corrected by the attorney. The legal assistant may be asked to draft associated papers: an application data sheet ("ADS"), a return receipt postcard, and a transmittal letter. The legal assistant may calculate the filing fee required, and submit a request for a check to purchasing. The attorney proofs the legal assistant's work and vice versa. Meanwhile, all the "working" documents are clipped to the paper file wrapper for the application. Finally, when everything is complete and correct, the documents are signed by the attorney, copies are made, the original is stuffed into an envelope addressed to the PTO, and the submission is entrusted to the U.S. Postal Service.

Two aspects of this manual process are important to carry over to electronic filing. The first is organizational. We all spend too much time looking for missing paper. The paper file dictates a system for organizing the efforts expended by the attorney and legal assistant. It takes effort and discipline to reproduce this for electronic filing, and a major shift in focus. When a paper document is your work product, it matters little where the word processing document you used to create that file is saved, whether in "Temp," or "March 2007" or even in the root directory. The word processing document is just a tool, so what if your successor cannot find any of the documents you created?

Electronic filing inverts the priorities. When two or more people create pdf files to be uploaded for a single submission, where should they store them before uploading? Create a single, unique folder or directory on your server for each client matter (e.g. "H://EFS Filings/3569HT12"), and a single, unique subfolder for each electronic filing submission (e.g. "H://EFS Filings/3569HT12/EFS 5-15-07"). When each document in a submission is ready to be filed, a copy of the corresponding pdf document is copied into that folder, as is the pdf acknowledgment receipt received after the documents have been submitted.

Tip: Split the work.

Let your legal assistant upload the files, but know how to do it yourself. One feature of the EFS system makes it superior to paper filing, and well worth the effort of learning to use it, even for the most conservative practitioner. Once the envelope is stuffed and mailed, it is gone. Some of us know practitioners who have camped out next to the mailbox and pleaded with the Postal Service to give it back. Did your legal assistant include the check? What about that terminal disclaimer? Did I really want to say that? By the time you find out the answer to the question that has given you so many sleepless nights, a statutory bar may have run, or it may be too late to correct that trivial typo that suddenly has become so important. And of course, sometimes the Postal Service loses or mis-delivers mail. Most practitioners are too familiar with the process for proving to the PTO that they really did mail that amendment well before the end of the six-month statutory period.

In contrast, the EFS system receives your documents and stores them immediately on the PTO's server ("uploading"). Once they are there, you have four days to review what you uploaded. You can download what you uploaded. If there is an error, delete the document and upload a corrected version. You can review what your legal assistant uploaded. Your associate can review what you uploaded. No more sleepless nights.

When you are sure that all is correct, you "submit" the documents. If a fee is due, you have the opportunity to pay it through the RAM system. When the submission is complete, a pdf electronic filing acknowledgment is generated, which you can print out and save. This is the EFS equivalent of a return-receipt postcard.

Tip: Pay by credit card, not deposit account

Fees are going up, up, up. The PTO does not pay interest on deposit accounts. You can pay your PTO filing fees with a credit card, and thus defer parting with funds at least until you have a chance to invoice the client for whom you have made the disbursement.

Tip: Learn how to "index" your documents

Using EFS-Web forces you to learn more about how the PTO works. Many of the problems new users encounter are associated with what happens just after a document is uploaded. At this point, the user has to decide how to "index" the new document. There are two sets of drop down boxes with multiple choices, and user has to select appropriate "designations." This is the moment of panic. The neophyte scans the list provided, and cannot find "patent application" among the choices. In fact the PTO has broken down the application into recognizable elements, which all must be designated as separate documents. Once you know that a utility

application must be designated as four separate documents, "specification," "claims," "abstract," and "drawings," the scheme begins to make sense. Nevertheless, you may not find an accurate description of your document. At least for the time being, the PTO's quality control staff is reviewing your designations for accuracy. And of course, as EFS-Web is expanded to permit more types of documents to be filed electronically, the list of designators is expanding.

Tip: Get it right the first time

It is difficult to correct mistakes in submitted documents, just as it is difficult to correct mistakes in documents filed on paper. While the PTO will permit you to change your own docket number yourself, on-line, at any time, most of the information associated with a patent application is much more difficult to change. You cannot do it yourself, you must convince somebody at the PTO to actually make the change. This may require several phone calls just to locate the right person. The results are too frequently disappointing, either the change is not made, or a new error appears. The best way to avoid the problem is to do it right the first time.

Tip: Use the PTO's PDF fillable forms

The PTO has made it easy for you to get accurate bibliographic information into its server. You can download a special Application Data Sheet form, which you must fill out using Acrobat Reader 7.0.5. When you upload and submit this ADS, your data is funneled right into the system, without human intervention. If you had the information right when you put it into the ADS, it will be correct in the PTO's database. If you do not use an ADS, somebody at the PTO has to hand-key this information into the PTO database. Often, the next thing you must do is request a corrected filing receipt.

Currently, there are only a few types of the special fillable forms available. The most important are the ADS and an IDS form. Use both.

Tip: Upload early

The EFS system is extremely popular, and has a limited amount of resources. When too many people are trying to use the system, it slows down, and may simply crash. If you have something that must be filed today, upload it as early as possible in the day, before our colleagues in more western time zones begin to try to upload their own work.

The PTO does not currently provide any objective indication of just how busy its servers are.

Tip: Do not throw out the postage meter

If your pdf files are unavoidably large and you are right up against a bar date, the EFS system may slow down or crash nonetheless. Know where the post office is located and how it will accept Express Mail. Keep this in mind when you begin trying to file electronically.

Tip: Know what cannot be filed through EFS

Not everything can be filed using EFS. Requesting reexamination? Use paper. The PTO has been expanding the types of documents that can be filed through EFS. This past fall it began to

permit PCT applications to be filed at the United States Patent and Trademark Office as an International Receiving Office. The plan is to expand the types of filing permitted. Nevertheless, always confirm that what you want to file is permitted before filing by checking the latest information on the PTO website (currently, http://www.uspto.gov/ebs/efs_faqs.htm)

4. After the first filing

Tip: Use the data

One immediate benefit from filing an application using EFS-Web is that the serial number and (unofficial) filing date are provided. If you filed without a signed declaration, you can fill this information in and e-mail the draft declaration to the inventors. Similarly, you can prepare an assignment identifying the application immediately. No need to wait a few weeks for the return receipt postcard.

Tip: Get your digital certificate as soon as possible

Do you have a digital certificate? While you can file patent applications without one, there are important advantages to being able to identify yourself to the PTO as a register agent or attorney in this way. First, you get access to Private Pair. Private Pair gives you access to the PTO's electronic file for your applications that have not been published. You can monitor when your application has left OIPE, whether it has been identified for a higher level security review, when it been assigned to a GAU, etc. Not every pending application is accessible - only those associated with a customer number. If you file electronically, and include a customer number as your correspondence address on the ADS, the new application will be associated with that customer number. If you filed the application on paper, the process may be more complicated. Second, only those with digital certificates can make "follow-on" filings, such as IDS's, preliminary amendment, responses to Examiner's Actions, and the like.

Tip: Maintain only one copy of your digital certificate

Each time your digital certificate is used, it is "imprinted" by the PTO. Using multiple copies may confuse the certification software and result in an invalidated certificate.

Tip: Get a customer number, maybe several

If you are in-house counsel supervising patent work at several firms, you can get a customer number for each firm, and assign both yourself and the firm's practitioners to that customer number. Now you can check on the status of your pending, non-published patent application on Private Pair, under each of the customer numbers.

If your firm has multiple clients who would like to be able to monitor the progress of their applications on Private Pair, get a customer number for each client, and assign the respective in-house practitioners to the appropriate customer number in addition to your firm's practitioners.

Tip: Establish a dedicated electronic mailbox for PTO notices

Prepare for the delivery of PTO e-mail notifications of Examiner's Actions by setting up a

dedicated mailbox and assigning responsibility for monitoring, retrieving the Actions from Private Pair, and docketing the response due dates.

Tip: Keep your head up

On-line filing is half the story. A pilot program for electronic delivery of Examiner's Actions is nearing completion. Soon, the PTO will not be mailing them to you any more. You will receive an e-mail telling you an action has been issued, and it will be up to you to go and download it from Private Pair. You need to think about who is going to be receiving these e-mails and downloading the office actions. Should you print them out? Do you still need to maintain your paper files for new applications? If your patent files are going to be electronic, do you need to come into the office to work if you can access them from home? Why are you paying rent for that office if no one is actually working there?