

REPORT

ELECTRONIC FILING OF PATENT APPLICATIONS

December 21, 2005

Oliff & Berridge is pleased to announce that as of December 1, 2005, we began participating in a new U.S. Patent and Trademark Office (USPTO) pilot program for electronic filing of patent applications. We believe that this pilot program, and its eventual general implementation by the USPTO, will be a significant benefit to our clients. While this Special Report does not address many of the technical details of the pilot program, the general procedures for such electronic filings, and various benefits to our clients, are discussed below.

I. Introduction

As part of its 21st Century Strategic Plan, the USPTO has been seeking comments and suggestions for improving its system for the electronic filing of patent applications and patent application-related documents. Oliff & Berridge has taken an active part in that process, to help ensure that any USPTO procedural changes reflect positive benefits to our clients and do not increase the risk, time or cost of filing patent applications and other documents. The USPTO's goal is to encourage, and eventually require, that most or all patent applications and patent application-related documents be electronically filed, so that they are automatically entered into the USPTO Image File Wrapper system.

In its first implementation of an electronic application filing system, the USPTO utilized an XML-based filing system. That electronic filing system required that patent applications be specially formatted in order to be accepted by the USPTO. For example, to comply with the original XML-based system, the applications had to be formatted

with embedded XML tags, and figures were required to be provided as TIFF images. Furthermore, some application contents, such as special characters, tables, and chemical and mathematical formulas, were incompatible with the required format, and thus patent applications including these items could not be electronically filed. The patent application formatting and filing procedures were generally very cumbersome, and were difficult to implement from a user perspective. In addition, the original XML-based filing system did not allow for follow-on application-related filings, such as Responses to Notices to File Missing Parts, Amendments, Petitions, Information Disclosure Statements citing non-US patent references, and the like.

In response to comments from Oliff & Berridge and other law firms and companies, the USPTO is trying to progress to a much more user-friendly electronic filing system.

II. The New USPTO Pilot Program

A. Implementation

In its newest pilot program for electronic filing of patent applications, the USPTO has significantly simplified and expanded the filing system. This pilot program is a testing phase for select USPTO customers, including our firm. Once the pilot program is concluded, the USPTO expects that the electronic filing system will be implemented for all patent application filings. Furthermore, once the USPTO fully implements the electronic filing system, it is expected that the USPTO will very strongly encourage its use, for example by offering reduced filing

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fees to electronic filers similar to the practice used by the USPTO in trademark application filings and by WIPO in PCT application filings.

In the pilot program, patent applications and related documents are uploaded to the USPTO in Adobe® Portable Document Format® (PDF) form. In this format, the previous limitation against including special characters, tables, and chemical and mathematical formulas is avoided. In addition, the cumbersome process of specially formatting the application is also avoided. The application documents need merely be converted or scanned into PDF form for submission. The PDF form is used for all patent application submissions, including the application itself and related filing documents such as the Application Transmittal, Application Data Sheet, Information Disclosure Statement, foreign patent and non-patent references, and the like.

In addition, the pilot program allows not only for electronic filing of original patent application documents, but also for electronic filing of application-related documents throughout the prosecution of the application. Thus, for example, the pilot program also allows for electronic filing of Responses to Notices to File Missing Parts, Information Disclosure Statements and cited references, responses to Office Actions, Petitions, Requests for Continued Examination, and Issue Fee payments. In all of these and other filings, patent application filings are prepared on paper in their normal manner, and are simply scanned into PDF form for submission to the USPTO. This scanning process preserves original signatures, special characters or formatting, and other document content in image form.

All USPTO fees due as a result of an electronic filing are paid online along with the filing, or in some cases can be paid at a later date (although late payment of some fees may require a Response to Notice to File Missing Parts). For example, for filings that we conduct for our clients, USPTO fees may be charged to our deposit account. The electronic filing system also validates some of the fees based upon information already in the USPTO file or

information that we provide, to help ensure that all necessary fees are paid.

B. Applicant Benefits

The electronic filing system provides several benefits to our clients. First and foremost is faster processing of new application documents by the USPTO. When an initial patent application is filed, we obtain a serial number for the application instantly, and the application papers become available in the private side of the Image File Wrapper system almost immediately. This allows our clients to know the application serial number earlier, and allows us to file any follow-on papers (such as executed Declarations, Preliminary Amendments, or the like) sooner. For example, in several test filings that we have conducted, the application has appeared in the private side of the Image File Wrapper system within about 30 minutes. In contrast, for applications that have been paper filed, it may take the USPTO up to several months to return to us our postcard receipt with the application serial number or to process the application to the point that it can be viewed in the Image File Wrapper system. This increased processing speed of the new application helps to ensure that the application has been received and processed, and should reduce the pre-examination processing time of the application before it reaches the Examiner.

A second benefit is reduced filing costs. Because we can file the application and related documents electronically, rather than on paper, our copying costs are reduced. Electronic filing at least avoids the necessity of making an additional copy of the application papers, and multiple copies of some transmittals that are otherwise filed in the USPTO in duplicate or triplicate. Although this may be a minor cost in each application, the reduced copying costs can add up to a significant amount for clients that file a number of applications each year.

A third benefit is faster processing of follow-on patent application documents by the USPTO. As with new patent application documents mentioned above, follow-on patent application documents such as Office Action responses and the like become available in either the public or private side

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of the Image File Wrapper system almost immediately. In several test filings that we have conducted with Office Action responses and Issue Fee payments in published applications, the respective filings appeared in the public side of the Image File Wrapper system within about one hour. In contrast, for patent applications that have been paper filed, it may take the USPTO several weeks to process the filing so that it is available to the Examiner. This decreased processing time for such follow-on filings should thus accelerate prosecution, which is particularly important in patent applications that are under a Final Rejection where slower processing can result in extra extension of time fees.

Of course, the slower processing time of paper filings can still advantageously be used in cases where quick action by the USPTO is not desired. Thus, for example, if a client wishes an application or response to be acted upon more slowly by the Examiner, it may be beneficial to file the application or response as a traditional paper filing. We can thus tailor our filing procedures to the particular strategic desires of our clients.

Our initial impressions of the pilot program electronic filing system is that it may be a great benefit to our clients. The pilot program is very easy to implement and integrate into our filing procedures, thus allowing its use without increasing the time and costs necessary for submitting the application or follow-on filings. We are thus optimistic that the electronic filing system will decrease overall application pendency for our clients' applications, without increasing filing costs.

For clients that have a strong desire to further participate in electronic filing, additional cost savings can be realized. For example, because all documents are submitted in PDF form, and because the USPTO does not maintain paper copies of original documents, it would be acceptable for clients to forward their order letters, applications, and related documents by email rather than facsimile, courier, or airmail. If we are provided with PDF copies of the application, executed Declaration, executed Assignment, and the like, then we can directly process those files for electronic filing. This process would not

only shorten processing time by shortening transit time, but it would further reduce copy, facsimile, courier, and airmail costs to our clients. Of course, because Preliminary Amendments may be necessary for various reasons, we would also request an editable version of the application (such as in Microsoft Word® format). In addition, it would still be necessary to send to us the actual certified copies of priority applications.

C. Limitations

The current pilot program allows for nearly all patent application filings, from initial application filing through payment of the Issue Fee. However, there are still several filings that are not permitted through the electronic filing system, and that must still be made on paper. Those filings include, for example, submission of certified copies of priority documents, sequence listings, computer program listings, third party submissions, and all filings in applications that are under a secrecy order. Furthermore, electronic filings are not yet permitted in reexamination applications, reissue applications, new plant patent applications, or in contested cases before the Board of Patent Appeals and Interferences. However, the Board of Patent Appeals and Interferences has its own electronic filing pilot system for some contested cases, which is very similar to that described above for patent application filing and in which Oliff & Berridge has also participated.

D. Security and Confidentiality

A principal concern among many clients and practitioners is the security and confidentiality of information submitted in electronic form. Like the original USPTO electronic filing system, the current pilot program is implemented to maintain security and confidentiality of all submissions, in the same manner as if they were filed in paper form. In our case, all of our electronic filings are made by a certified electronic filer, using a USPTO-issued Public Key Infrastructure (PKI) digital certificate. The electronic filings are made over the internet using a secure data encryption (SSL). Further, once documents are electronically filed, they are either maintained confidential or made publicly available depending upon whether the

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application has been published -- the same as with paper filings. To ensure that application documents are submitted in the correct corresponding application, the pilot program filing system requires confirmation of application information whenever a filing is being submitted in a pending application. This procedure helps ensure that documents are not misfiled in an incorrect application in the USPTO Image File Wrapper.

III. Conclusion

We will advise you of any future significant developments. In the meantime, Oliff & Berridge is participating in the new USPTO pilot program system on a limited basis with select patent applications. Clients that are particularly interested in electronic filing are invited to contact us to discuss this matter further. We welcome any questions or concerns that you may have in this regard.

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Oliff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oliff & Berridge, PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

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