

Review of Legal Framework for Electronic Filing System Web (EFS-Web), 74 FR 55200-211 (2009)

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On October 27, 2009, the Patent and Trademark Office had published in the Federal Register a notice titled "Legal Framework for Electronic Filing System Web (EFS-Web)". See 74 FR 55200-211 (2009). Neifeld IP Law, PC is an all electronic office that relies heavily upon the "Electronic Filing System" ("EFS" or "EFS Web" or the like)). Therefore, this notice was of particular relevance to our firm. Accordingly, I summarized the statements in the notice that are most relevant to our practice. Some of the statements are quoted material from the notice, although not necessarily indicated as such, and others are my synthesis. My summary appears below.

Documents not authorized for filing using EFS:

3rd party submissions, public protests, or public use proceedings, see rules 1.99; 1.291; and 1.292. PCT applications in the international stage that include color drawings. PCT does not provide for color drawings. Patent term extensions pursuant to 35 USC 156. (35 USC 156 is for regulatory delay extensions, this limitation does not affect applications for patent term adjustment due to USPTO delay, pursuant to 35 USC 154.) Certified paper documents, registration to practice papers, documents in secret applications, contested case documents (interferences), disciplinary proceeding papers, assignments for recording (file them using EPAS, not EFS),

The Notice defines the official record for a patent application as follows:

Accordingly, the official record for the patent application and reexamination proceeding comprises: (1) ASCII text documents as well as color and grayscale drawings in PDF format as stored in SCORE; and (2) TIFF images of all other original documents as stored in IFW as well as the Electronic Acknowledgment Receipt and the Electronic Patent Application Fee Transmittal, both of which contain information entered via the EFS-Web graphical user interface (GUI) data collection screens.

Regarding sequence listings and computer program listings:

Sequence listings text files associated with a written specification (whether filed EFS or CD) will not count toward the application size fee. Same for computer programs listings.

Regarding fee payments:

Users may also provide authorizations to charge fees to a deposit account with the

documents being submitted electronically via EFSWeb (e.g., a fee transmittal letter or form). When the online fee payment in EFSWeb is unavailable, a deposit account authorization transmittal (e.g., PTO/SB/17) may be included with the documents being submitted via EFSWeb.

Regarding electronic acknowledgment receipt and date of receipt:

The Electronic Acknowledgment Receipt establishes the date of receipt by the USPTO ... The Electronic Acknowledgment Receipt and statement will serve as prima facie evidence that the resubmitted documents are the same as those submitted on the date of receipt, except when the document description used by the user does not match the document.

Regarding the date of receipt:

The EFS-Web system records as the date of receipt of documents the local date in Eastern Standard Time on which the USPTO receives the documents, after the user clicks the SUBMIT button on the Confirm and Submit screen for those documents.

Regarding incomplete filings - same day correction:

The following items may be EFS filed subsequent to the first EFS filing in an application, and counted as part of the original application with no adverse consequences, so long as they are filed on the same day as first EFS filing application:
Inventor Dec, spec, drawings, claims, filing fees,

Legal consequences to EFS availability for weekend and holiday filings:

Paris article 4(c)(3) limits the Paris priority right for filings to 12 months for Utility applications and 6 months for Design applications. Advice - never file a PCT application beyond the literal Paris priority period to which priority is claimed. Validity of such a claim is an open legal question to be decided in each country and on the facts of each case.

For US national filings, one can rely upon US law that extends the date we can respond in all situations not involving PCT applications, to the next business day after a "Saturday, Sunday, or Federal holiday within the District of Columbia".

Regarding EFS system limits on filings:

25 MEG per file; 60 files per submission. PDF document resolution of not less than 300 dpi. PDF comments and annotations will not appear in an EFS filed pdf document. (Furthermore, if a user uses the PDF comments or annotations to enter the information on part of the original disclosure. a form, only the blank form without the PDF comments and annotations

will be processed.)

Regarding compliance with PDF format:

Users must follow the PDF Guidelines for EFS-Web and PDF Creation for EFSWeb ... to create and submit PDF files via EFS-Web to ensure that all of the information in the PDF files is successfully received and processed by the USPTO.

Post EFS filing advice from the USPTO:

After the submission of the follow-on document is completed, the user should log on to PAIR to review the application file and check whether the follow-on document has been filed in the correct application. Checking the application file via PAIR would also help the user to discover other filing errors, such as filing a wrong document or omitting a portion of the document.

Regarding who can use EFS on behalf of a registered patent attorney:

Only a PKI certificate holder (or the designated employee under the certificate holder's direction and control) can submit follow-on documents. EFS-Web also permits a legal assistant or paralegal to submit an application or a request for reexamination previously reviewed by a registered practitioner without the registered practitioner being present. See section E2 for more information.

Regarding correction when the wrong application is identified in EFS locator information upon filing a document:

Correctable, not fatal. - Errors made in the "locator information" may be corrected by the USPTO on its own initiative, or by the applicant or reexamination party, similar to the way they are corrected in paper processing.

Regarding the number of people other than a registered patent attorney that can use the attorney's EFS registered log on:

**** ONLY ONE. *** ("A PKI digital certificate holder is permitted to designate a single employee of the holder's organization, or a single employee of a contractor, under the PKI subscriber agreement and certificate action form. The designated employee under the direction and control of the digital certificate holder may use the certificate holder's certificate to submit documents through EFS-Web in compliance with the PKI subscriber agreement and the rules and policies of the USPTO.")

Regarding designations of drawings required in EFS * to avoid loss of rights ***:**

For pdf image format that is not black and white, and for pdf images that include other than patent line drawings (pictures, color, grayscale), select "Drawings other than black and white line drawings" document code DRW.NONBW. This must be used for any drawing other than pdf "black and white line drawings". Loss of rights may occur if the wrong drawing type is selected in these circumstances.

For pdf image format that is black and white, and in which the image is conventional patent line drawings, use "Drawings only black and white line drawings" Document code DRW. No loss of rights will occur if the wrong drawing type is selected for black and white line drawings.

Relaxation of certain rule requirements when EFS filing sequence listings in .txt files.

If the sequence listing text file submitted via EFS-Web complies with the requirements of 37 CFR 1.824(a)(2) (6) and (b) (i.e., is a compliant sequence listing ASCII text file), the text file will serve as both the paper copy required by 37 CFR 1.821(c) and the computer readable form (CRF) required by 37 CFR 1.821(e). Thus, the following are not required and should not be submitted: (1) A second copy of the sequence listing in a PDF file; (2) a statement under 37 CFR 1.821(f) (indicating that the paper copy and CRF copy of the sequence listing are identical); and (3) a request the use of a compliant computer readable "Sequence Listing" that is already on file for another application pursuant to 37 CFR 1.821(e). If such a request is filed, the USPTO will not carry out the request but will use the sequence listing submitted in an ASCII text file with the application via EFSWeb. Checker software that may be used to check a sequence listing for compliance with the requirements of 37 CFR 1.824 is available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/checker/>.

Regarding filing applications with large sequence listings:

I3. What is the size limit for text files? One hundred (100) megabytes is the size limit for sequence listing text files submitted via EFS-Web. If a user wishes to submit an electronic copy of a sequence listing text file that exceeds 100 megabytes, it is recommended that the user file the application without the sequence listing using EFS-Web to obtain the application number and confirmation number, and then file the sequence listing on compact disc in accordance with 37 CFR 1.52(e) on the same day by using Express Mail from the USPS in accordance with 37 CFR1.10, or hand delivery...

Regarding complex work units:

I5. May Complex Work Units be submitted electronically via EFS-Web? - YES.

Regarding PCT applications filed using EFS:

J3. May EFS-Web be used to file international applications containing a nucleotide or amino acid sequence listing and/or tables related thereto in the United States Receiving Office? - YES.

If the sequence listing part is submitted as an ASCII text file, applicant need not submit any additional copies. The ASCII text file will serve both as the sequence listing part of the description under PCT Rule 5.2 and the electronic form under PCT Rule 13ter.1(a). Furthermore, the required statement in paragraph 4(v) of Annex C that “the information recorded in the electronic form furnished under Rule 13ter is identical to the sequence listing as contained in the international application” is not required. ... b. Tables Related to a Sequence Listing: Tables related to a sequence listing must be an integral part of the description of the international application, and must not be included in the sequence listing part. Such table will be taken into account when calculating the application page count, and excess page fees may be required. When applicant submits tables related to a sequence listing in an international application via EFS-Web, the tables must be in a PDF file. ... In the situation where applicant needs to file a sequence listing that is over one hundred megabytes, applicant may use EFS-Web to file the international application without the sequence listing to obtain the international application number and the confirmation number, and then file the sequence listing on compact discs on the same day by using Express Mail from the USPS in accordance with 37 CFR 1.10,....

d. Fee Determination for International Applications Containing a Sequence Listing:

The calculation of the international filing fee for an international application, including a sequence listing, filed via EFS-Web is determined based on the type of sequence listing file. A sequence listing filed in an ASCII text file will not be included in the page count of the international application.

The end.

1.I can be reached via telephone at 703-415-0012 or via our web site: <http://www.neifeld.com>.

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Date/time: October 30, 2009 (9:14am)

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