Electronic Filing Top 10 Wish List

BY ALLEN E. HOOVER[1] OF BANNER & WITCOFF

This article is addressed to patent attorneys and agents who are active in prosecuting patent applications before the PTO.

If you (or your support staff) haven't used the PTO's new electronic filing system ("EFS"), you should look into it. PTO practitioners can use EFS to file new patent applications and follow-on documents. After filing, the practitioner can immediately view and download application papers. Unlike the former electronic filing system, the new EFS is easy to use, and does not require specialized software. Best of all, attorneys can delegate the actual use of the computer for filing to a secretary or paralegal. You, the practitioner, need not ever touch the computer (if that's your preference), and once you've finalized a document, you don't need to spend more time on the computer filing it.

If you or your support staff uses electronic filing, you'll enjoy quite a few advantages over traditional filing by mail, such as the following:

- No more rushing to the post office. If your client has a bar date today, you can file until the clock strikes midnight at the PTO. (By the way, no more postage costs, either).
- You'll receive a serial number immediately.
- Worried that the papers were somehow mis-filed? You can view the application on-line immediately after it is filed to confirm that everything was filed properly (this feature is called Patent Application Information and Retrieval, or "PAIR"). If your secretary dropped the drawings on the way to the photocopier before filing the application, you can fix the application today (as opposed to receiving the dreaded "filing date not assigned" notice weeks later).
- No more post office or PTO mailroom delays. After the application has been filed, any papers that are filed electronically become part of the official file history of the patent instantly.
- No more PTO lost files. The electronic file is the official PTO copy of the patent application. For that matter, no more papers lost by the post office.

- You can track the status of any application, for instance, to see whether the application has been assigned to an Examiner
- The PTO will estimate the number of months until the first Office Action.
- Did you lose any papers from your office's file? You can in most cases obtain a copy of the missing paper online from the PTO, immediately, at no cost.
- Are you away from your office? If you yourself use EFS, you can file documents from anywhere, so long as you have a computer and an Internet connection. Also, using PAIR, you can view your applications online from anywhere.

In short, today's EFS and PAIR are very good. They're much, much better than the old PTO electronic filing system. EFS likely will become the predominant method of filing papers in the PTO within a few years.

In a few ways, though, EFS could be improved. Here's a "wish list" for some changes.

1. E-mail confirmation of filing

By far, this is the most needed change to EFS. Electronic filing brings with it significant new concerns with respect to docketing. As every practitioner knows, every time a new application or a follow-on paper is filed, that event must be docketed. With paper filings, usually the practitioner will include a postcard receipt, which the PTO stamps and returns to the practitioner. It's easy for a docketing department to watch the postcard receipts and thereby check on the status of recently filed applications and follow-on papers. Likewise, with a centralized mailroom, it's easy to log mail and faxes that are sent to the PTO. Individual practitioners within the firm or legal department usually make use of centralized filing procedures.

None of this is true for electronic filing, where any practitioner can file any document from anywhere in the world. Using today's EFS, it's not possible to electronically monitor what every practitioner or support staff member has filed. Also, with EFS, the PTO does not send a postcard to confirm receipt of an electronically filed document.

To address this problem, today a law firm or legal department might take one of

two approaches. First, individual use of EFS might be banned altogether. This approach, however, would obviate many of the benefits of EFS. Second, EFS users might be required to notify the docketing department every time a filing has been made. Obviously, this second approach – which depends on compliance from 100% of the users, 100% of the time – would be far from foolproof.

It would seem very easy to modify EFS to allow applicants to specify one or more docketing e-mail addresses for each customer number[2] (for instance, "docketing@yourfirm.com"). Each time a document is filed or fee is paid, a confirming e-mail would be sent to the address or addresses specified. The e-mails could be addressed directly to the docketing department. That way, the docketing department would be informed immediately once something had been filed. An e-mail addressed to the docketing e-mail address thus would be essentially equivalent to the postcard receipt used in paper filings.[3]

2. View recent submissions

Today, a practitioner can use EFS to view his or her last twenty EFS submissions. This is a useful feature.

It would also be useful to allow users of the electronic filing system to view a history of documents submitted *by anyone* in connection with any associated customer number. For instance, if the practitioner is associated with customer number 12345, he or she would be able to view a history of submissions under customer number 12345 by any practitioner associated with that customer number. This feature would, for instance, allow docketing departments or senior managers to keep track of filings.

3. Consistent and clearer coding

To use EFS, an applicant must "code" or assign a description to each page of an electronic submission. Sometimes this is easy and straightforward. For instance, when filing a new application, there are codes for "specification," "claims," "abstract," "drawings," and other application parts. When you file a new patent application, you (or your secretary) might label pages 1-10 as "specification," pages 11-12 as "claims," and so on. Easy enough.

Some of the codes, though, are confusing. For instance, it appears that the first page of every response to an Office Action must be described either as "Amendment – After Non-Final Rejection" or "Amendment After Final." You must so describe your submission even if you aren't actually making any amendments to the application. On the other hand, if amendments are made in

subsequent pages of the document, these labels are not used. For instance, if you're amending the claims, those pages of the submission should be labeled "claims" (rather than using one of the "amendment" labels). Not so easy.

In other ways, the codes are a bit confusing and inconsistent. Rule 131 or 132 affidavits are filed as "Rule 131 or 132 affidavits," but Rule 501 submissions as "1.501 Submission By Patent Owner" (not "Rule 501 Submission"). A response to a restriction requirement is filed as "Response to Election / Restriction Filed," but a response to a notice to file missing parts as "Applicant response to pre-exam formalities notice" (not "Response to notice to file missing parts"). In PAIR, the code "Status letter mailed to applicant" evidently refers to an electronic notice that is posted in EFS, but that is *not*, in fact, mailed to applicant (nor to the practitioner). Particularly for new users, these idiosyncrasies can make EFS a little hard to use. The PTO should make these codes more consistent and more user-friendly.

4. Change application data

EFS should allow a practitioner to make certain bibliographic changes to the application data, such as changes to the attorney docket number or to the order of inventors named in the application.

6. Explanation of "Transaction history" entries

This is an easy one.

The "transaction history" section of PAIR provides information as to the status of the application. Often, these entries are easy to understand (e.g. "Non-final Office Action").

Some of the entries that show up in the "transaction history," though, are not inherently understandable, e.g., "Cleared by OIPE CSR," or "Receipt of Acknowledgment Letter." Occasionally, even experienced practitioners are stumped by the meanings of some of these entries. Presently, there is no posted index or table of what the entries in "transaction history" mean. The PTO should provide such a list.

5. Better integration with patent search

The PTO has a useful "search" website, where anyone can search decades worth of patents and published patent applications.[4] It would be helpful if this were tied into PAIR, so that a user could, for instance, link directly to the file history of a patent or published application of interest.

7. Online application data sheet

It would be helpful if application data sheets under 37 C.F.R. 1.76 could be pre-

pared and submitted via an online Web form. It would be even more helpful if supplemental application data sheets could be prepared and submitted via an online Web form, such that corrections could be made easily.

8. Better references retrieval

Using the "display references" feature of EFS, a practitioner viewing one of his or her own applications may download U.S. patent and published application references. This is a useful tool.

The existing "display references" software, however, is quirky and difficult to use. First, you must download a large (2MB) Java program. Upon running the program, you'll see that you can select references from any IDS that you submitted or any for 892 that the Examiner supplied to you – but only U.S. patent or published application references. You can't use the "display references" program to retrieve foreign references or non-patent references that are of record in the application.[5]
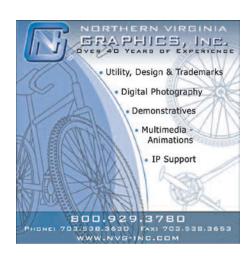
If all you want are U.S. patents or published applications, you are forced to select only one IDS or 892 form at a time from which to download references. For instance, if you have submitted three IDS forms and received two 892 forms, you must repeat the download procedure five times if you want to download all of the available references in the application. If you only want a few references, but you aren't sure from which 892 or IDS form the reference originated, there's no easy way to find out – you'll need either to guess, or to go back to PAIR to inspect each form individually.

Assuming you only want U.S. references, and once you've selected a form from which to obtain the references, the software provides you with the name of a directory into which to download the references. You aren't allowed to change the name of that directory, and you aren't allowed to change the file names of the references that you download.

The existing "display references" software should be scrapped or substantially revised, and new software that addresses the foregoing shortcomings should be made available.

9. Filing receipts and other documents in image file wrapper

Application filing receipts are not available online via PAIR. It would be helpful to provide an application filing receipt online; for instance, where the original is lost by the post office. It's not clear whether any other types of papers are not routinely stored in PAIR. If so, such other papers also should be stored in PAIR and made available online.

10. Client view

It would be useful to allow non-practitioners to have read-only access to private PAIR. Many inventors are prolific patentees, and such inventors sometimes would find it useful to check into the status of their applications online. This feature also would be useful for corporate legal departments, such that, for instance, the head of a corporate legal department could keep an eye on the corporation's patent applications even if the head of the legal department is not a registered practitioner.

11. Others in progress

These suggestions from others didn't make the "top 10" list, because according to the PTO these changes are already in progress or under consideration:

- Submission of new PCT applications via EFS
- Submission of sequence listings via EFS
- Use of EFS to change your password
- Document management integration
- Better integration of assignment data
- Submission of alternative file types (other than .pdf).

That's the wish list! **IPT**

ENDNOTES

1. Banner & Witcoff, Ltd. (Chicago). The views and comments expressed herein are solely those of the author and are not necessarily those of the author's law firm or any of its members or clients. The author may be reached at 312-463-5000 or ahoover@bannerwitcoff.com.
2. For the uninitiated, a "customer number" is a number associated with a group of practitioners, such as all of the practitioners in a law firm.
3. The PTO has expressed concern over the foregoing proposal, stating that e-mail transmission is not secure. This does not seem to be a valid concern. E-mail transmission is likely to be much more secure than a postcard, which can be read by anyone.
4. http://www.uspto.gov/patft/index.html
5. Such references may be obtained otherwise from PAIR. Each reference, though, is describes as "foreign reference," with no identifying information.