

**DEPARTMENT OF COMMERCE****Patent and Trademark Office****[Docket No.: PTO-P-2008-0045]****Legal Framework for Electronic Filing System—Web (EFS-Web)****AGENCY:** Patent and Trademark Office, Commerce.**ACTION:** Notice.

**SUMMARY:** This Legal Framework provides guidance on the background statutes, regulations and policies that support the Electronic Filing System—Web (EFS-Web) project. The document is provided as a reference for applicants, parties in reexamination proceedings, attorneys, and agents, as well as their employees using the system.

**FOR FURTHER INFORMATION CONTACT:** Joni Y. Chang, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy; directly by phone at 571-272-7720, or by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Inquiries regarding EFS-Web and other USPTO information technology (IT) systems may be directed to the Patent Electronic Business Center (Patent EBC), by telephone: 1-866-217-9197 (toll-free) and 571-272-4100, or by e-mail: [ebc@uspto.gov](mailto:ebc@uspto.gov).

Inquiries regarding IT policy for U.S. national patent applications may be directed to Mark Polutta (571-272-7709), Senior Legal Advisor, Office of Patent Legal Administration.

Inquiries regarding IT policy for international patent applications may be directed to Tamara Graysay (571-272-6728), Special Program Examiner, Office of Patent Cooperation Treaty (PCT) Legal Administration.

**SUPPLEMENTARY INFORMATION:** This notice substantively contains the same information as the EFS-Web Legal Framework posted on the USPTO Web site (September 2008), with certain exceptions. The following is a brief summary of the major differences:

1. The sections have been reorganized so that sections on similar topics are combined or grouped together, and clarifications and definitions of terms related to electronic filings have been added;

2. Section A (former sections II, III and V) has been revised to provide updated general information on EFS-Web;

3. Section B (former sections IV, VI, XII, XX, and XXXI) has been revised to provide a list of applications and

documents that are permitted to be filed via EFS-Web, information on how applications filed via EFS-Web are counted for the application size fee purposes, and fee payments are permitted to be filed via EFS-Web;

4. Section D (part of former sections IV and XXIX) has been revised to provide information on proper usages of EFS-Web;

5. Section E (including subsection E1 and E2, former sections VII, X, and XXVIII) has been revised to permit a Public Key Infrastructure (PKI) certificate holder to designate a single employee of the holder's organization, or a single employee of a contractor, who may use the holder's certificate under the holder's direction and control;

6. Section H (former section XXII) has been revised to permit color and grayscale drawings and photographs to be submitted via EFS-Web in provisional and nonprovisional utility patent applications including reissue applications and national stage applications;

7. Subsection I5 is added to provide that complex work units (such as chemical structure drawings, mathematical formulae, three-dimensional protein crystalline structure data and table data) may be submitted as text files via EFS-Web under the Complex Work Units Pilot Program; and

8. Section J (former sections IX, XVII, XVIII and XIX) has been revised to permit PCT-EASY.zip compressed files to be submitted via EFS-Web when users are filing international applications with the United States Receiving Office, and to provide that tables related to a sequence listing in an international application must be submitted in a PDF file rather than in a text file.

**Table of Contents**

- A. General Information on EFS-Web (Former Sections II, III and V)
- B. Legal and Document Policies (Former Sections IV and VI)
  - B1. Types of Patent Applications and Documents Permitted To Be Filed via EFS-Web (Former Section XX)
  - B2. Types of Patent Applications and Documents *Not* Permitted To Be Filed via EFS-Web (Former Section XXXI)
  - B3. What is the official record of documents submitted via EFS-Web? (Former Section XII)
  - B4. How are applications filed via EFS-Web counted for application size fee purposes?
  - B5. Can fee payments be submitted via EFS-Web?
- C. Electronic Acknowledgement Receipt and Date of Receipt (Former Section VIII)

C1. What is the date of receipt of a follow-on document received by the USPTO through EFS-Web? (Former Section XXV)

C2. What is the date of receipt of an application submitted via EFS-Web? (Former Section XXIII)

C3. Can users file documents during non-business hours via EFS-Web? (Former Section XXVI)

C4. What if the applicant electronically files an application via EFS-Web, and on that same day, realizes that the applicant has inadvertently omitted a document from the application? (Former Section XXIV)

C5. Are there any legal consequences of the USPTO's accepting electronic patent applications on Saturday and Sunday? (Former Section XXVII)

D. Proper Usage of EFS-Web (Former Section IV)

D1. Filing Documents as PDF Files via EFS-Web

D2. Entering Information on EFS-Web Screens

D3. Under what conditions will the USPTO allow refunds for fees paid via EFS-Web? (Former Section XXIX)

E. Security and Authentication (Former Section X)

E1. PKI Subscriber Agreement (Former Section VII)

E2. Under what authority does an authorized assistant of the digital certificate holder submit signed documents? (Former Section XXVIII)

F. Signature Policy (Former Section XXX)

G. May pre-grant (eighteen-month) publication requests be submitted via EFS-Web? (Former Section XXI)

H. May photographs and color drawings be submitted via EFS-Web? (Former Section XXII)

I. Text Files and File Limits

I1. May biotechnology sequence listings, large tables, or computer program listing appendices be submitted as text files via EFS-Web? (Former Section XIII)

I2. How are text files counted for application size fee purposes? (Former Section XIV)

I3. What is the size limit for text files? (Former Section XV)

I4. What is the limit on the number of electronic files that may be included in a single EFS-Web submission? (Former Section XVI)

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

J. International Applications and Documents for International Applications

J1. May international applications filed under the PCT with the United States Receiving Office be electronically submitted via EFS-Web? (Former Section XVII)

J2. Entry in the U.S. national stage under 35 U.S.C. 371 (Former Section IX)

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? (Former Section XVIII)

J4. Follow-on Submissions for International Applications (Former Section XIX)

J5. Policy of Annex F of the PCT Administrative Instructions (Former Section XI)

### A. General Information on EFS-Web

EFS-Web is the USPTO's system for electronic filing of patent correspondence. EFS-Web is accessible via the Internet on the USPTO Web site. The system utilizes standard Web-based screens and prompts to enable users to submit patent documents in Portable Document Format (PDF) directly to the USPTO. Users may electronically submit most patent applications, reexamination requests, and other patent-related documents securely using EFS-Web. Users may also use EFS-Web to submit payments of most patent fees including patent application filing fees. Users need not provide a duplicate copy of any document filed through EFS-Web unless the USPTO specifically requires the filing of a duplicate in a particular situation. Users may review and check their electronic submissions including their attached PDF files before submitting the documents to the USPTO. After submitting the documents via EFS-Web, the system will display a page that states that the USPTO has received the user's submission. The users, generally within two hours, will receive an Electronic Acknowledgement Receipt of a successful submission received by the USPTO. The processing of fees may delay the issuance of the Electronic Acknowledgement Receipt. The Electronic Acknowledgement Receipt is the electronic equivalent of a postcard receipt. *See Manual of Patent Examining Procedure (MPEP) § 503.* Most documents submitted via EFS-Web will be viewable via the Patent Application Information Retrieval (PAIR) system within an hour after the USPTO receives the documents if the users have associated their applications with their customer numbers. Therefore, users will be able to immediately check the contents of their applications for completeness and accuracy of their electronic submissions.

A user may become a registered user by obtaining a PKI digital certificate. *See* section E of this notice for more information on PKI digital certificates. A registered user may file most patent applications and follow-on documents in a patent application, but a non-registered user is not permitted to file most follow-on documents in a patent application. *See* section B of this notice for more information.

EFS-Web is a PDF-based filing system. Accordingly, all EFS-Web submissions are required to be in PDF format unless otherwise indicated in this notice. EFS-Web permits submission of: (1) The

American Standard Code of Information Interchange (ASCII) text files (.TXT) to submit bio-sequence listings, computer program listings, mega tables, and Complex Work Units; and (2) PCT-EASY.zip compressed files to submit the Request form generated by PCT-EASY in international applications with the United States Receiving Office. *See* sections I and J of this notice for more information on ASCII text files and electronic filing of international applications, respectively. In addition, the USPTO provides users with PDF EFS-Web fillable forms, such as the Provisional Application for Patent Cover Sheet, the Information Disclosure Statement, the Application Data Sheet, Petition to Make Special Under Accelerated Examination Program, Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent, Request for Continued Examination (RCE) Transmittal, and Petition to Make Special Based on Age. When users submit information using an EFS-Web fillable form, the information will directly load into the USPTO databases which will increase accuracy and facilitate faster processing. Users may use other USPTO-created PDF fillable forms available on the USPTO Web site, or user-created forms, and submit the completed forms via EFS-Web. The information entered on these forms, however, will not be automatically loaded into the USPTO databases.

The USPTO Web site provides additional information on EFS-Web and PAIR, such as instructions, guidelines, frequently asked questions, and tutorials ([http://www.uspto.gov/ebc/efs\\_help.html](http://www.uspto.gov/ebc/efs_help.html)). Users may contact the Patent Electronic Business Center (Patent EBC) for assistance with EFS-Web and PAIR as well as for requesting PKI digital certificates and customer numbers.

### B. Legal and Document Policies

To the extent that any USPTO regulation is inconsistent with the procedures for EFS-Web, the regulation will be interpreted in a manner to support EFS-Web. This notice sets forth the USPTO's policies concerning documents submitted electronically using EFS-Web, including patent applications and requests for reexamination, as well as follow-on documents in patent applications and reexamination proceedings.

**B1. Types of Patent Applications and Documents Permitted to be Filed via EFS-Web:** EFS-Web permits registered users (who have a PKI digital certificate) and non-registered users to file the

following patent applications, requests for reexamination, and documents:

1. Provisional patent applications under 35 U.S.C. 111(b);
2. Nonprovisional utility patent applications under 35 U.S.C. 111(a) (including reissue utility patent applications);
3. Nonprovisional design patent applications under 35 U.S.C. 171 (including reissue design patent applications);
4. International applications under PCT Article 11, designating the United States, for filing in the United States Receiving Office;
5. National stage applications under 35 U.S.C. 371;
6. Requests for *ex parte* reexamination under 35 U.S.C. 302 for utility or design patents;
7. Requests for *inter partes* reexamination under 35 U.S.C. 311 for utility or design patents;
8. Petitions to make special based on age under 37 CFR 1.102(c); and
9. Petitions to accept an unintentionally delayed payment of maintenance fee under 37 CFR 1.378(c), and payments of maintenance fees when submitted with the petition.
10. Petition to make special under accelerated examination program (must be filed with a nonprovisional utility patent application under 35 U.S.C. 111(a)).

**Follow-on documents:** Registered users are permitted to file follow-on documents in the patent applications and reexamination proceedings listed above via EFS-Web. Follow-on documents are documents filed after the initial submission of the application or request for reexamination, which include, but are not limited to, the following: amendments, information disclosure statements (IDS), replies to Office actions and notices, evidence, petitions, and other documents filed after the filing of a patent application or request for reexamination. In addition, registered users may file copies of the patent application (e.g., a copy of the amended specification including the claims, and drawings, for the purposes of publication of the application) for the following pre-grant (eighteen-month) publication requests via EFS-Web: amended publication under 37 CFR 1.215(c), redacted publication under 37 CFR 1.217, early publication under 37 CFR 1.219, and voluntary publication or republication under 37 CFR 1.221(a). *See* section G for more information on filing these publication requests via EFS-Web. Follow-on documents also include any documents submitted on the same day as the application, but after the initial submission. In

reexamination proceedings, both the reexamination requester and the patent owner may file documents via EFS-Web, if they are registered users. Registered users may also file a second or subsequent submission for patent term extension under 35 U.S.C. 156 in a patent file via EFS-Web.

Non-registered users are not permitted to file follow-on documents via EFS-Web, except those listed in items 8–10 above. Non-registered users may file follow-on documents by mail (with a certificate of mailing in accordance with 37 CFR 1.8), Express Mail from USPS in accordance with 37 CFR 1.10, or hand delivery.

*B2. Types of Patent Applications and Documents Not Permitted to be Filed via EFS-Web:* The following is a list of submission types that are not permitted to be filed using EFS-Web:

1. Plant patent applications under 35 U.S.C. 161 and documents associated with plant patent applications.

2. Requests for Reexamination under 35 U.S.C. 302 and 311 for plant patents and documents associated with reexamination proceedings for plant patents.

3. Third party submissions under 37 CFR 1.99.

4. Protests under 37 CFR 1.291.

5. Public use papers under 37 CFR 1.292.

6. Color drawings and color photographs for international applications that have not entered the national stage.

7. Initial submissions for patent term extension under 35 U.S.C. 156.

8. Correspondence concerning registration practice as specified in 37 CFR 1.4(e). *See also* 37 CFR 1.6(d)(1).

9. Certified documents as specified in 37 CFR 1.4(f). *See also* 37 CFR 1.6(d)(2). An example of such a submission is a certified copy of a foreign patent application filed pursuant to 35 U.S.C. 119 or a certified copy of an international application filed pursuant to 35 U.S.C. 365.

10. Correspondence to be filed in a patent application subject to a secrecy order under 37 CFR 5.1 through 5.5. *See also* 37 CFR 1.6(d)(6).

11. Documents filed in contested cases before the Board of Patent Appeals and Interferences (BPAI), except as the BPAI may expressly authorize. *See also* 37 CFR 1.6(d)(9).

12. Documents filed in contested cases before the BPAI, which are governed by 37 CFR 41.106(f). *See also* 37 CFR 1.6(d)(3) and 1.8(a)(2)(i)(C).

13. Correspondence filed in connection with a disciplinary proceeding under 37 CFR parts 10 and 11. *See also* 37 CFR 1.6(d)(3).

14. Maintenance fees submitted under 37 CFR 1.366 that are not submitted with a petition under 37 CFR 1.378(c) (see item 9 in section B1 of this notice). Patent owners may be paid electronically using the Office of Finance On-Line Shopping Page at <https://ramps.uspto.gov/eram/>. *See* MPEP § 2510 for information regarding the proper methods for submitting maintenance fees.

15. Assignment documents under 35 U.S.C. 261, which may be electronically filed using the Electronic Patent Assignment System (EPAS) or the Electronic Trademark Assignment System (ETAS). Information regarding EPAS is available at: <http://epas.uspto.gov>. Information regarding ETAS is available at: <http://etas.uspto.gov>.

16. Submissions that are not associated with a patent application or reexamination proceeding.

If any of the documents listed above is submitted via EFS-Web, the document will not be accorded a date of receipt and it will not be considered officially filed in the USPTO. Furthermore, no benefit will be given to a certificate of transmission under 37 CFR 1.8 on the document.

*B3. What is the official record of documents submitted via EFS-Web?* When the USPTO successfully receives documents filed in accordance with the EFS-Web requirements, the USPTO will convert the PDF files submitted by users into Tagged Image File Format (TIFF) image files and then store the TIFF image files in the Image File Wrapper (IFW) as part of the official record, except for color and grayscale drawings which are stored in the Supplemental Complex Repository for Examiners (SCORE) as part of the official record. In addition, certain submissions may be filed as ASCII text files (e.g., sequence listings or computer program listings), which are stored in SCORE as part of the official record. 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 Acknowledgement 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.

*See also Legal Framework for the Use of the Electronic Filing System*, 1286 *Off. Gaz. Pat. Office* 113, 114 (Sept. 14, 2004). The original documents

submitted via EFS-Web (e.g., applications and reexamination proceeding documents) are stored exactly as filed in an independent location. *See* section I of this notice for more information on ASCII text documents and section H on color and grayscale drawings. Submissions for pre-grant (eighteen-month) publication are forwarded to the Pre-Grant Publication Division and are not stored in IFW or SCORE as part of the official record of the patent application. *See* section G for more information on publication requests.

*B4. How are applications filed via EFS-Web counted for application size fee purposes?* For patent applications filed under 35 U.S.C. 111 (including provisional applications, utility and design nonprovisional applications, and reissue applications), the paper size equivalent of the specification (including claims) and drawings of an application submitted via EFS-Web will be considered to be seventy-five percent (75%) of the number of sheets of paper present in the specification (including claims) and drawings of the application when entered into IFW after being rendered by EFS-Web for purposes of determining the application size fee required by 37 CFR 1.16(s). *See* 37 CFR 1.52(f)(2) and MPEP § 607. The paper size equivalency under 37 CFR 1.52(f)(2) for EFS-Web filings does not apply to national stage submissions. *See* MPEP § 1893.01(c).

Any sequence listing in compliance with 37 CFR 1.821(c) or (e), and any computer program listing in compliance with 37 CFR 1.96, submitted via EFS-Web will be excluded when determining the application size fee required by 37 CFR 1.16(s) if the listing is submitted in ASCII text as part of an associated file of the application. *See* 37 CFR 1.52(f)(2) and sections I2 and J3 of this notice. Sequence listing or computer program listings submitted as PDF files would not be excluded.

*B5. Can fee payments be submitted via EFS-Web?* Yes, non-registered and registered users may submit the filing fees (e.g., the basic filing fee, search and examination fee, and excess claims fee) using the online fee payment in EFS-Web at the time of filing a patent application or request for reexamination. Only registered users may submit payment of fees in a previously filed application or reexamination proceeding. EFS-Web permits users to electronically submit the payment of fees with a credit card, USPTO deposit account, or electronic fund transfer. Users may also provide authorizations to charge fees to a deposit account with the documents

being submitted electronically via EFS-Web (e.g., a fee transmittal letter or form). However, users should not submit a credit card charge authorization including the Credit Card Payment Form (PTO-2038) electronically via EFS-Web, because the electronic submission automatically will be loaded into the application file in IFW, and the credit card information may become part of the record of an application file that is open to public inspection.

When the online fee payment in EFS-Web is unavailable, a deposit account authorization transmittal (e.g., PTO/SB/17) may be included with the documents being submitted via EFS-Web. A credit card authorization transmittal (e.g., PTO-2038) may also be submitted by facsimile transmission to the USPTO Central Facsimile (571) 273-8300, or sent via Express Mail from the United States Postal Service (USPS) in accordance with 37 CFR 1.10.

Applicants must include the application number from the Electronic Acknowledgement Receipt to ensure that the fees are paid in the correct application. Facsimile submission of the basic national fee for national stage under 35 U.S.C. 371 is not accepted. Failure to timely pay the basic national fee prior to the expiration of 30 months from the priority date will result in abandonment of the international application. If applicant wishes to submit the application filing fees on the filing date of a patent application to avoid the surcharge, the payment of the filing fees must be submitted and received by the USPTO before midnight on the filing date of application. Failure to pay the fees on the filing date of the application will result in a surcharge.

When the online fee payment in EFS-Web is unavailable, the following types of submissions cannot be filed via EFS-Web, since online fee payment must accompany the submission:

(1) Petitions under 37 CFR 1.378(c) for auto-processing by EFS-Web; and

(2) Pre-grant publication submissions under 37 CFR 1.211 to 1.221 that require a fee.

### C. Electronic Acknowledgement Receipt and Date of Receipt

The Electronic Acknowledgement Receipt establishes the date of receipt by the USPTO of documents submitted via EFS-Web. The electronic documents are itemized in the Electronic Acknowledgement Receipt, which will contain a full listing of the documents submitted to the USPTO as described by the user during the submission process, including the count of pages and/or byte sizes for each document. Thus, the

Electronic Acknowledgement Receipt is the electronic equivalent of the postcard receipt described in MPEP section 503.

The official application filing date will be noted on the Filing Receipt (37 CFR 1.54) after the submitted application parts are reviewed for compliance with 35 U.S.C. 111 (or for compliance with 35 U.S.C. 371 for entry into the U.S. national stage of an international application). The filing date is based on the dates indicated on the Electronic Acknowledgement Receipt assuming that, after review, the documents submitted are found to be entitled to an application filing date. Likewise the official reexamination filing date will be noted on the "Notice of \* \* \* Reexamination Request Filing Date," after Central Reexamination Unit (CRU) review for filing date compliance, and is based on the dates indicated on the Electronic Acknowledgement Receipt.

If the official version of any document received by EFS-Web is lost, damaged or rendered unreadable and if it cannot be recovered from the stored files received by electronic submission, then the user will be promptly notified. Such events are expected to be rare. In that situation, the user may have to resubmit any lost document and petition for the original filing date. The user would be required to present: (1) The Electronic Acknowledgement Receipt; (2) a copy of the missing files as submitted; and (3) a signed petition accompanied by a statement stating that the attached files are the same as those originally submitted and mentioned in the Electronic Acknowledgement Receipt for that application number (e.g., a petition under 37 CFR 1.53(e) or 37 CFR 1.182 with the appropriate petition fee under 37 CFR 1.17(f)).

The Electronic Acknowledgement 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. For example, if an applicant originally filed a specification and a set of claims and used the correct document descriptions for a specification and a set of claims, then the Electronic Acknowledgement Receipt will serve as *prima facie* evidence that the applicant filed the specification and set of claims on the original filing date. However, if the applicant actually filed two sets of claims, the Electronic Acknowledgement Receipt will not serve as *prima facie* evidence that the applicant filed a specification and a set of claims (even though the applicant used the document descriptions for a

specification and a set of claims). Note the Electronic Acknowledgement Receipt only indicates that the USPTO received what was actually sent, as opposed to what may have been intended to be transmitted. Users should exercise the same care in preparing and preserving a copy of a submission in electronic form as in paper.

*C1. What is the date of receipt of a follow-on document received by the USPTO through EFS-Web?* Follow-on documents filed in a patent application or reexamination proceeding after the initial filing of the application or request for reexamination will be accorded a receipt date, which is the date the follow-on document is received at the USPTO. See 37 CFR 1.6(a)(4).

A follow-on document required to be filed in the USPTO within a set period of time (e.g., a reply to an Office action) will be considered as being timely filed if the follow-on document is submitted in compliance with the procedure set forth in 37 CFR 1.8(a):

(1) The follow-on document is submitted via EFS-Web prior to expiration of the set period of time in accordance with the requirements for EFS-Web; and

(2) The document includes a certificate of transmission stating the date of transmission and signed by a person that has reasonable basis to expect that the document would be transmitted on or before the date of transmission. See 37 CFR 1.8(a)(1)(i)(C) and (ii). However, the certificate of transmission practice under 37 CFR 1.8 does not apply to the documents listed in 37 CFR 1.8(a)(2) (e.g., a document filed for the purpose of obtaining an application filing date).

*C2. What is the date of receipt of an application submitted via EFS-Web?* 35 U.S.C. 111(a)(4) states in part (emphasis added):

The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

Thus, the filing date of an application is the date of receipt of the application in the USPTO. Further, the USPTO is located in the Eastern Standard Time zone. Accordingly, the date of filing of an application officially submitted through EFS-Web will be the date in the Eastern Standard Time zone when the USPTO received the submission. As such, the submission's "date of receipt," as shown on the Electronic Acknowledgement Receipt, is the Eastern Standard Time date that the documents are fully, successfully, and officially received at the USPTO, after

the user clicks the SUBMIT button on the Confirm and Submit screen. *See* 37 CFR 1.6(a)(4). This date is controlling for filing date purposes of a newly filed application. There is no “certificate of transmission” practice for new application filings (37 CFR 1.8). This applies by analogy to reexamination proceedings.

To be very specific, 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.

For example, if an applicant in California officially files a patent application with the USPTO through EFS-Web by clicking on the SUBMIT button at 1 p.m. Pacific Time in California on May 1, that application would be officially received by the USPTO at 1 a.m. Eastern Standard Time on May 2. Accordingly, the application would receive a filing date of May 2. However, the applicant could alternatively file the application using Express Mail from the USPS in accordance with 37 CFR 1.10 in which case the applicant would have until midnight on May 1 in his or her local time zone to file the application and obtain a filing date of May 1.

*C3. Can users file documents during non-business hours via EFS-Web?* Hours of operation of EFS-Web will be clearly provided in the EFS-Web instructions when users log on to the system. The USPTO will post information on any scheduled down time due to system maintenance in advance. Users may file patent documents electronically during the hours of operation of EFS-Web every day of the week, including weekends and holidays. If the submission is successfully received (even on a Saturday, Sunday or Federal holiday within the District of Columbia), the USPTO will assign that receipt date to the submission.

If a transmission is attempted during a down time, the USPTO cannot accept it and will, if possible, transmit back a notice that the USPTO is not accepting submissions. No Electronic Acknowledgement Receipt will be sent. Instead a notice will advise the user to use alternative filing methods, such as Express Mail from the USPS in accordance with 37 CFR 1.10 or hand delivery of paper to the USPTO, to establish the filing date. Note that applications filed under 37 CFR 1.53, and reexamination requests, cannot be submitted by facsimile transmission (37 CFR 1.6(d)(3) and (5)), and that certificate of mailing procedures do not

apply to new applications and reexamination requests (37 CFR 1.8(a)(2)(i)(A) and (D)). Users are strongly advised to transmit their electronic filings sufficiently early in the day to allow time for alternative paper filing when transmission cannot be initiated or correctly completed.

*C4. What if the applicant electronically files an application via EFS-Web, and on that same day, realizes that the applicant has inadvertently omitted a document from the application?* One advantage of filing a patent application via EFS-Web is that applicant (who is a registered user) may view the submission in PAIR and file a document directly into the application on the same day as the filing date of the application. In certain situations, applicant may correct an error by filing a missing item(s) on the same day as the filing date of the application. Applicant, however, may wish to file another new application in other certain situations.

The following examples describe implications raised when applicant inadvertently omits an item when filing an application electronically via EFS-Web:

1. *Oath or Declaration*—Applicant may file an executed oath or declaration on the same day as the filing date as the application via EFS-Web. The oath or declaration will not be considered late and thus a surcharge for filing a late oath or declaration will not be required.

2. *Filing Fees*—Applicant may file the filing fees (e.g., the basic filing fee, search and examination fees, application size fee, or excess claims fee) on the same day as the filing date of the application via EFS-Web. The fees will *not* be considered late and thus a surcharge for filing the filing fees will *not* be required.

3. *Nonpublication request*—Since 37 CFR 1.213(a)(1) requires any nonpublication request to be filed with the application, applicant cannot simply file the nonpublication request to correct the error. If applicant does not wish to have the application publish, applicant must file: (a) a new application with a nonpublication request; and (b) in the initial application, a petition for express abandonment to avoid publication under 37 CFR 1.138(c) and fee under 37 CFR 1.17(h) in sufficient time to permit the appropriate officials in the Pre-Grant Publication Division to recognize the abandonment and remove the application from the publication process.

4. *Drawings*—Applicant may file the missing drawings as a preliminary amendment on the same day as the filing date of the application. The

drawings will be considered as part of the original disclosure of the application. *See* 37 CFR 1.115(a)(2). If the application was filed with the “wrong drawings,” a preliminary amendment could be filed on the same day as the filing date of the application adding the correct drawings and deleting the “wrong drawings.” An amendment adding new drawings and deleting the “wrong drawings,” filed on a day after the filing date of the application may raise new matter issues.

5. *Claims*—Applicant may file claims as a preliminary amendment on the same day that applicant filed the application papers and such claims will be considered as part of the original disclosure of the application. Please note that the application will not be entitled to a filing date until applicant files at least one claim in the application.

6. *Part of the specification*—Applicant may file the missing portion of the written description as a preliminary amendment on the filing date of the application. Such amendment will be considered as part of the original disclosure.

If applicant files another new application to correct an error in the first application, applicant will have filed two applications. Applicant may continue to prosecute the first application that has the error or abandon the first application by filing a declaration of express abandonment. Please note that any fees paid in the first application will not be refunded or applied to the second application. Applicant may request refund of the search fee and any excess claims fees (but not the basic filing fee, examination fee, and application size fee) paid in the first application if the application was filed under 35 U.S.C. 111(a) on or after December 8, 2004, and the applicant files a petition for express abandonment in accordance with 37 CFR 1.138(d).

*C5. Are there any legal consequences of the USPTO's accepting electronic patent applications on Saturday and Sunday?* Applicants may file patent applications electronically during the hours of operation of EFS-Web every day of the week, including weekends and holidays. EFS-Web will provide applicants with the opportunity to receive a filing date on any day of the week, including Saturday, Sunday, and Federal holidays. In addition, 35 U.S.C. 21(b) states:

When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action

may be taken, or fee paid, on the next succeeding secular or business day.

Further, 35 U.S.C. 119(e)(3) states:

If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

Thus, under United States law, applicants will be permitted to take action on the next business day when the last day for taking action falls on a weekend or Federal holiday, regardless of the mode or form of filing.

However, Article 4 of the Paris Convention addresses the priority period and in Article 4(c)(3) it states:

If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

Further, as stated above, the USPTO is capable of accepting electronic patent application filings every day of the week, including weekends and holidays, through EFS-Web. Thus, applicants are cautioned to consider possible adverse consequences regarding the determination in other countries of priority periods under Article 4(C)(3) of the Paris Convention when filing international applications with the United States Receiving Office. Specifically, the ability to file applications electronically on weekends and holidays in the USPTO may result in loss of priority rights in foreign jurisdictions designated in international applications filed with the United States Receiving Office, if applicants elect, in accordance with 35 U.S.C. 21(b) or 119(e)(3), to file an international application on the next succeeding business day in the event that the twelve-month Paris Convention priority period set out in Article 4(C)(1) falls on a Saturday, Sunday, or Federal Holiday. In such circumstances, other patent offices may deny the priority claim on the basis that the international application was not timely filed if their national law strictly incorporates the provision of Paris Convention Article 4(c)(3) and considers the USPTO to be open for the filing of applications on weekends and holidays. For this reason, applicants may prefer not to rely upon the "next business day" provisions of 35 U.S.C. 21(b) and 119(e)(3) when filing international applications with the USPTO, and instead file the international application before the Paris Convention twelve-month priority period has expired.

#### D. Proper Usage of EFS-Web

Users should follow the instructions and guidelines for EFS-Web provided on the USPTO Web site. Before clicking the SUBMIT button, the user should check whether the correct documents have been attached to the submission, and whether the information related to the submission has been entered correctly. Once the user clicks the SUBMIT button on the Confirm and Submit screen, the submission will be electronically sent to the USPTO. A submission is officially filed at the USPTO when the documents are received by the USPTO (Eastern Time). Use of EFS-Web in a manner significantly in violation of the instructions and guidelines for EFS-Web provided on the USPTO Web site and in this notice may result in non-entry of the submission or failure to accord a filing date in the event the USPTO does not fully, successfully, and officially receive all of the elements necessary to obtain a filing date for an intended submission. Furthermore, electronic files submitted via EFS-Web must be free of executables, worms, viruses, or any other type of potentially malicious content. Please note that 18 U.S.C. 1030 imposes a duty on users not to intentionally cause damage to a federal government system.

*D1. Filing documents as PDF Files via EFS-Web:* EFS-Web accepts standard PDF documents up to 25 megabytes for each file, and 60 electronic files per submission. See section 14 of this notice for more information. PDF files created from scanned documents and submitted via EFS-Web must be created using a scanning resolution no lower than 300 dpi. Lower resolution scans have significantly delayed processing and publication of applications, e.g., resubmission has been required for documents failing to comply with the legibility requirements. See 37 CFR 1.52(a)(1)(v) and (a)(5) regarding document legibility requirements.

In addition, because the PDF format is so feature-rich, certain PDF features are currently not supported by the USPTO systems. For example, PDF documents with multiple layers must be flattened prior to submission to ensure that the complete document is received by the USPTO and readable to the examiner or other deciding officials. If a document contains layers that are marked as "invisible", the invisible layers will be lost when the document is processed by the USPTO, and thus the official records in IFW will not contain the information on the invisible layers. Furthermore, if a user uses the PDF comments or annotations to enter the information on

a form, only the blank form without the PDF comments and annotations will be processed. Therefore, the complete document will not be officially filed at the USPTO and the user cannot rely on the Electronic Acknowledgement Receipt as evidence that the completed form was filed at the USPTO. Users are encouraged to check the contents of their submissions for completeness and accuracy via PAIR.

Users must follow the PDF Guidelines for EFS-Web and PDF Creation for EFS-Web (available on the USPTO Web site at <http://www.uspto.gov/ebc/portal/tools.htm>) 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.

*D2. Entering information on EFS-Web Screens:* EFS-Web collects information from on-screen entries made by the user through the EFS-Web graphical user interface (GUI) data collection screens. Through these data collection screens, the user provides the USPTO with information regarding the electronic submission, such as the type of application being filed, the application number of the application in which a follow-on document is being submitted, or the type of document being submitted. The USPTO systems (e.g., EFS-Web, IFW, etc.) will use the information entered by the user on the EFS-Web screens to automatically: (1) Assign the application number, create the application, and process the application, if a new patent application is being filed; (2) upload the follow-on document into the application file specified by the user; or (3) message the deciding official based on the document description selected by the user. Therefore, providing incorrect information regarding the submission could lead to: (1) An incorrect type of application file being created; (2) a delay in processing the document; (3) filing a document in an incorrect application; or (4) the deciding official not recognizing the document in sufficient time to avoid publication, to withdraw the application from issue, or to avoid the abandonment of the application.

*1. Follow-on documents:* When a user submits a follow-on document (e.g., a reply to an Office action or notice) via EFS-Web, the user is required to enter the correct application number and confirmation number of the application in which the follow-on document is being filed. Providing the incorrect application number and confirmation number pair will result in filing the follow-on document in the wrong application. Therefore, it is important



for the user to enter the correct application number on the EFS-Web screen when filing the follow-on document.

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.

**2. Filing a new patent application:** When a user is submitting a new patent application via EFS-Web, the user is required to select the application type (e.g., design, utility, provisional or nonprovisional) being filed on the EFS-Web screen. Only document descriptions and fee codes pertinent to the selected application type will be available for the submission. The system will also automatically generate the application number based on the user's selection. For example, if the user indicates that the submission is a provisional application by selecting the EFS-Web radio button for a provisional application, the application will be assigned a provisional application number, provisional application fees will be collected or required, and the application will be further processed as a provisional application. Furthermore, the application will not be assigned to an examiner for examination and will not be published because the submission is processed as a provisional application. Therefore, it is important for the user to select the correct application type on the EFS-Web screen, and review the Electronic Acknowledgement Receipt and the application file using PAIR after the submission is completed.

**3. Document indexing:** When a user submits a patent application or a follow-on document in a patent application using EFS-Web, the user must select from the list of document descriptions to specify the files being submitted via EFS-Web. For instance, when the user is filing a patent application, the submission must be separated into appropriate sections: specification, claims, abstract, and drawing; and when the user is filing an amendment, the user must select the appropriate type of amendment: amendment after non-final, amendment after allowance, preliminary amendment, and amendment after final. Based on the document description selected by the user, a document code is assigned and a message regarding the document submitted to the USPTO will be forwarded to the appropriate

organization for processing, and to the appropriate official for consideration. Furthermore, the IFW and PAIR systems use the document code for identifying the document maintained in the application file. Therefore, accurate document indexing is important to facilitate efficient processing and proper consideration of the document by the USPTO. For example: (a) If the user indicated an after-final amendment as a non-final amendment, the processing of such amendment may be delayed and the examiner may not have sufficient time to consider the amendment before the time period expires; (b) if the user selects the "Pre-Grant Publication" radio button on the EFS-Web data collection screen for submitting a substitute specification filed in response to a non-final Office action, the submission will be forwarded to the publication branch rather than processed into IFW and forwarded to the examiner for consideration; and (c) if the user selects "drawings—only black and white line drawings" for submitting color drawings in a utility application rather than "drawing—other than black and white line drawings", the color drawings would not be processed as color drawings, and would be maintained as black and white drawings in IFW.

More information on document indexing is available on the USPTO Web site at <http://www.uspto.gov/ebc/portal/infodocuments.htm>. It is important for users to select the correct document description, and check the application file via PAIR after the submission is completed.

**D3. Under what conditions will the USPTO allow refunds for fees paid via EFS-Web?** The USPTO will grant refunds to users when, due to a malfunction with the EFS-Web system, the EFS-Web system has misled a user into paying a fee in error. If it cannot be determined that a malfunction occurred, but rather it seems to be a user error, no refund will be given. The users should contact the Patent EBC if there are any issues associated with their submissions.

### E. Security and Authentication

The USPTO requires PKI certificates to meet federal government computer system authentication guidelines as defined by the National Institute of Standards and Technology (NIST) and the Office of Management and Budget (OMB). The required evaluation of EFS-Web and PAIR determined that level three authentication was needed; this is met by the USPTO's PKI.

Only a PKI certificate holder (or the designated employee under the

certificate holder's direction and control) can submit follow-on documents. This preserves confidentiality, and is consistent with power of attorney and correspondence regulations. In order to obtain a PKI certificate, the user must be a registered practitioner (i.e., an attorney or agent) or an inventor, and complete the appropriate paperwork (e.g., review the PKI subscriber agreement and complete the certificate action form, available on the USPTO Web site). Once the user has a PKI certificate, the user can authenticate himself or herself to the USPTO through the EFS-Web sign-on. This will generate a secure, encrypted connection with the USPTO.

For users that do not have, or do not wish to use, a PKI certificate to authenticate to the USPTO, they may still submit new application filings only via a non-authenticated workflow. The user would go to the EFS-Web page and choose to submit without a PKI certificate as a non-registered user, which would generate a Transport Layer Security (TLS) connection for the session, thus allowing secure data transmission to the USPTO. Non-registered users have the same level of protection for filing as a registered user, but are limited to submission of initial filings. This practice minimizes the risk of improperly-filed third party submissions and other documents. Non-registered users may file follow-on documents by mail (with a certificate of mailing in accordance with 37 CFR 1.8), Express Mail from USPS in accordance with 37 CFR 1.10, or hand delivery.

**Note:** Users are advised that the USPTO may revoke a user's digital PKI certificate if the user makes an improper submission through EFS-Web. See section B and paragraph 4 of the "United States Patent and Trademark Office Public Key Infrastructure Subscriber Agreement" located at [<http://www.uspto.gov/ebc/documents/subscribersagreement.pdf>].

**E1. PKI Subscriber Agreement:** A PKI certificate holder may designate a single employee of the holder's organization, or a single employee of a contractor, who may use the holder's USPTO certificate under the holder's direction and control in compliance with the PKI subscriber agreement. Accordingly, a practitioner who is a PKI certificate holder, or the designated employee acting under the direction and control of the practitioner, may file documents signed by either the practitioner or another practitioner via EFS-Web, in compliance with the PKI subscriber agreement. Filing of a document that is unauthorized to be filed via EFS-Web (e.g., a third party submission under 37

CFR 1.99 or a protest under 37 CFR 1.291) is inconsistent with the subscriber agreement and the rules and policies of the USPTO. Thus, the certificate holder, and designated employee acting under the direction and control of the certificate holder, must make sure that document being submitted is authorized to be filed via EFS-Web, regardless of whether the document is signed by the practitioner exercising the direction and control or by another practitioner.

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.

**E2. Under what authority does an authorized assistant of the digital certificate holder submit signed documents?** 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.

The documents submitted through EFS-Web must be signed in accordance with 37 CFR 1.4, 1.33(b), and 11.18. If the designated employee is an assistant who is not an authorized party to sign the documents, the designated employee is not responsible for the contents of the documents submitted. Instead, the person who signs the documents (e.g., the inventor or a registered practitioner who is representing the inventor) is responsible for the contents. For example, the documents may be electronically signed or ink signed by the applicant or attorney of record. The assistant who serves the ministerial function of pickup and delivery of documents may submit the signed documents electronically via EFS-Web under the direction and control of the certificate holder. (Ink signed documents can be electronically scanned and then e-filed.) The assistant may also view and retrieve documents from Private PAIR under the direction and control of the certificate holder in compliance with the PKI subscriber agreement.

In the submission process, the assistant who is using the holder's certificates to submit the documents through EFS-Web is required to specify certain "locator information" so the

documents can be associated with the proper application file in the IFW system. That locator information may include the application's title, first named inventor, docket number, application number, confirmation number, correspondence address and filing date, all if available. The type of application (e.g., 35 U.S.C. 111(a), national stage application under 35 U.S.C. 371, international application) and information necessary for the payment of fees are not considered to be locator information. The "locator information" is entered on submission to assure that the documents are placed in the proper file, and do not constitute a signed submission of bibliographic data on behalf of the applicant or reexamination party. 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.

It also should be noted that the assistant could pay the fees associated with the submission in the EFS-Web process. This is comparable to the paper practice in which law firms designate individuals to pay fees.

#### **F. Signature Policy**

Signatures, other than handwritten signatures meeting the standard of 37 CFR 1.4(d)(1), included in image attachments submitted via EFS-Web are governed by the S-signature requirements of 37 CFR 1.4(d)(2) (*See also Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan*, 69 FR 56481, 56486 (Sept. 21, 2004), 1287 *Off. Gaz. Pat. Office* 67 (Oct. 12, 2004)).

If the signer is submitting an application through EFS-Web as PDF files, he or she should apply either a handwritten signature in compliance with 37 CFR 1.4(d)(1) or an S-signature in compliance with 37 CFR 1.4(d)(2) before scanning the document or converting it to a PDF file. Any follow-on documents, such as an amendment filed in an application, must also be signed in accordance with 37 CFR 1.33(b). Even though a new patent application is entitled to a filing date if it complies with all the statutory requirements set forth in 35 U.S.C. 111(a) or (b), it is noted that when filing a new application by EFS-Web, a signed transmittal form or a signed application data sheet (ADS) is recommended for identification purposes, and any nonpublication request and certification that accompany the application must be signed.

A legible electronic image of a handwritten signature inserted, or copied and pasted by the person signing the correspondence into an application document may be considered to be an acceptable signature. The legible image of the handwritten signature of the person signing the correspondence must be inserted by the person. Additionally, the signature must be surrounded by a first single forward slash mark before the electronic image and a second single forward slash mark after the electronic image. That is, the legible electronic image of a handwritten signature must be enclosed between two single forward slashes and the signer's name is indicated below or adjacent the signature as per 37 CFR 1.4(d)(2). The slashes may be inserted into the document prior to the insertion of the signature.

The presentation to the USPTO (whether by signing, filing, submitting, or later advocating) of any document constitutes a certification under 37 CFR 11.18(b) (or former 37 CFR 10.18(b)). See 37 CFR 1.4(d)(4).

#### **G. May pre-grant (eighteen-month) publication requests be submitted via EFS-Web?**

Yes, EFS-Web enables users to electronically submit pre-grant publication requests for amended publication, redacted publication, early publication, voluntary publication, or republication under 37 CFR 1.215, 1.217, 1.219, and 1.221(a) via EFS-Web. When filing pre-grant publication requests via EFS-Web, the form-fillable application data sheet (PTO/SB/14) is required to be used for fulfilling the bibliographic data requirements. An electronic submission for voluntary publication, amended publication, republication (37 CFR 1.221(a)) or redacted publication must be submitted as a "Pre-Grant Publication" by selecting the "Pre-Grant Publication" radio button on the EFS-Web data collection screen. It is not sufficient for a user to submit a document via EFS-Web requesting amended publication, redacted publication, early publication, voluntary publication, or republication without also selecting the "Pre-Grant Publication" radio button on the EFS-Web data collection screen.

#### **H. May photographs and color drawings be submitted via EFS-Web?**

The USPTO prefers black and white line drawings as prescribed in 37 CFR 1.84(a)(1) when applicants are required to submit drawings in patent applications. As stated in 37 CFR 1.84(a)(2) and (b), photographs and color drawings are not ordinarily



permitted in utility and design patent applications, but the USPTO will accept photographs and color drawings in utility or design patent applications, if they are the only practicable medium for illustrating the claimed subject matter. The photographs and color drawings submitted in utility or design patent applications must be of sufficient quality such that all details in the photographs and drawings are reproducible in black and white in the printed patent.

Drawings submitted in international applications are required to comply with PCT Rule 11.13, which does not permit color drawings. Furthermore, there is no provision for photographs. Nevertheless, black and white photographs will be accepted where it is impossible to present in a drawing what is to be shown (e.g., crystalline structures). Color photographs are not permitted in international applications.

The USPTO may object to the drawings and photographs, and require corrections or deletions if they do not comply with 37 CFR 1.84 or PCT Rule 11.13. Additionally, since color drawings are not permitted in international applications, color drawings and color photographs filed in a national stage application will be treated as an amendment and will be objected to if they introduce new matter.

#### *Types of Photographs and Drawings Permitted to be Filed via EFS-Web:*

Black and white line drawings may be submitted via EFS-Web in the types of patent applications and proceedings listed in section B1 of this notice. However, photographs, color drawings, grayscale drawings, and other drawings that are not black and white line drawings may be submitted via EFS-Web in only the following types of applications and proceedings:

1. Nonprovisional design patent applications, including reissue design patent applications;
  2. Provisional applications under 35 U.S.C. 111(b);
  3. Nonprovisional utility patent applications under 35 U.S.C. 111(a), including reissue utility patent applications; and
  4. U.S. national stage applications under 35 U.S.C. 371; and
  5. Reexamination proceedings for utility or design patents.
- Only black and white photographs may be submitted via EFS-Web in international applications.

*Document Description for Photograph and Drawings:* Users must select the correct document description when submitting photographs and drawings via EFS-Web. Selecting an incorrect document description may cause the

photographs and drawings to be processed in a quality that is not sufficient for examination and publication. Applicant must select:

1. "Drawings—only black and white line drawings" (document code "DRW") for the following:

- a. Black and white line drawings in: (i) Provisional applications under 35 U.S.C. 111(b); (ii) nonprovisional utility patent applications under 35 U.S.C. 111(a), including reissue utility patent applications; (iii) international applications and national stage applications under 35 U.S.C. 371; and (iv) reexamination proceedings for utility patents. These drawings will be converted into TIFF images and stored in IFW.

- b. Black and white line drawings, grayscale drawings, photographs, color drawings, and other drawings that are not black and white line drawings in design patent applications, including reissue design patent applications, and reexamination proceedings for design patents. These drawings will be stored in SCORE, and a black and white copy will be stored in IFW along with a SCORE placeholder sheet.

2. "Drawings—other than black and white line drawings" (document code "DRW.NONBW") for the following:

- a. Photographs, color drawings, grayscale drawings, and other drawings that are not black and white line drawings in: (i) provisional applications under 35 U.S.C. 111(b); (ii) nonprovisional utility patent applications under 35 U.S.C. 111(a), including reissue utility patent applications; (iii) national stage applications under 35 U.S.C. 371; and (iv) reexamination proceedings for utility patents. These drawings will be stored in SCORE, and a black and white copy will be stored in IFW along with a SCORE placeholder sheet.

- b. Black and white photographs, and grayscale drawings, in international applications. These drawings will be stored in SCORE, and a black and white copy will be stored in IFW along with a SCORE placeholder sheet.

*Other Requirements:* For color drawings, a petition filed under 37 CFR 1.84(a)(2) explaining why the color drawings are necessary is required. See MPEP § 608.02. The requirement for three (3) sets of color drawings under 37 CFR 1.84(a)(2)(ii) is not applicable to color drawings submitted via EFS-Web. Therefore, only one set of such color drawings is necessary when filing via EFS-Web.

EFW-Web supports the use of black and white, color, or grayscale images within the PDF document. However, grayscale or color images filed as

"drawings—other than black and white line drawings" in a utility patent application will be converted to black and white images when stored into IFW. The quality of black and white images may be degraded.

To obtain sufficient quality so that all details in the images are reproducible in black and white in the eighteen-month publication and the printed patent, images should be scanned at a minimum resolution of 300 DPI. Furthermore, PAIR is only capable of displaying portrait orientation. Users should not submit landscape oriented drawings via EFS-Web because PAIR will automatically convert the image to portrait, which may cause the images to be distorted during viewing.

## **I. Text Files and File Limits**

### *11. May biotechnology sequence listings, large tables, or computer program listing appendices be submitted as text files via EFS-Web?*

Yes, all of these types of documents may be submitted as ASCII text files with a ".txt" extension (e.g., "seqlist.txt") for national applications (other than international applications) and reexamination proceedings. The compact disc practice of 37 CFR 1.52(e) and 1.821 et seq. remains as a filing option. The filing of international applications via EFS-Web is discussed in section J of this notice.

Users may submit the following document types, as specified in 37 CFR 1.52(e), as ASCII text files via EFS-Web instead of on compact disc, provided the specification contains a statement in a separate paragraph that incorporates by reference the material in the ASCII text file identifying the name of the ASCII text file, the date of creation, and the size of the ASCII text file in bytes:

1. A computer program listing (*see* 37 CFR 1.96);
2. A sequence listing (submitted under 37 CFR 1.821); or
3. Any individual table (*see* 37 CFR 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, wherein a table page is a page printed on paper in conformance with 37 CFR 1.52(b) and 1.58(c).

The requirements of 37 CFR 1.52(e)(3)–(6) for documents submitted on compact disc are not applicable to computer program listings, sequence listings, and tables submitted as ASCII text files via EFS-Web. However, each text file must be in compliance with ASCII and has a file name with a ".txt" extension. Further, the specification must contain an incorporation-by-reference of the material in the ASCII

text file in a separate paragraph identifying the name of the ASCII text file, the date of creation, and the size of the ASCII text file in bytes similar to the requirements of 37 CFR 1.52(e)(5) for compact discs.

It is recommended that a sequence listing be submitted in an ASCII text file via EFS-Web rather than in a PDF file. 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 EFS-Web. 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/>.

If a user submits a sequence listing (under 37 CFR 1.821(c) and (e)) as an ASCII text file via EFS-Web in response to a requirement under 37 CFR 1.821(g) or (h), the sequence listing text file must be accompanied by a statement that the submission does not include any new matter which goes beyond the disclosure of the application as filed. In addition, if a user submits an amendment to, or a replacement of, a sequence listing (under 37 CFR 1.821(c) and (e)) as an ASCII text file via EFS-Web, the sequence listing text file must be accompanied by: (1) A statement that the submission does not include any new matter, and (2) a statement that indicates support for the amendment in the application, as filed. *See* 37 CFR 1.825.

Submission of the sequence listing in a PDF file is not recommended because applicant would still be required to provide the CRF required by 37 CFR 1.821(e) and the sequence listing in the PDF file will not be excluded when determining the application size fee. The USPTO prefers the submission of a sequence listing in an ASCII text file because as stated above, the text file will serve as both the paper copy required by

37 CFR 1.821(c) and the CRF required by 37 CFR 1.821(e). Any sequence listing in PDF format is treated as the paper copy required by 37 CFR 1.821(c). If applicant submits a sequence listing in a PDF file and a copy of the sequence listing in an ASCII text file, a statement that the sequence listing content of the PDF copy and the ASCII text file copy are identical is required. In situations where applicant files the sequence listing in PDF format and requests the use of the CRF of another application under 37 CFR 1.821(e), applicant must submit a letter and request in compliance with 37 CFR 1.821(e) and a statement that the PDF copy filed in the new application is identical to the CRF filed in the other application.

*12. How are text files counted for application size fee purposes?* Any sequence listing submitted as an ASCII text file via EFS-Web that is otherwise in compliance with 37 CFR 1.52(e) and 1.821(c) or (e), and any computer program listing submitted as an ASCII text file via EFS-Web that is otherwise in compliance with 37 CFR 1.52(e) and 1.96, will be excluded when determining the application size fee required by 37 CFR 1.16(s) or 1.492(j) as per 37 CFR 1.52(f)(1).

Regarding a table submitted as an ASCII text file via EFS-Web that is part of the specification or drawings, each three kilobytes of content submitted will be counted as a sheet of paper for purposes of determining the application size fee required by 37 CFR 1.16(s) or 1.492(j). Each table should be submitted as a separate text file. Further, the file name for each table should indicate which table is contained therein.

*13. 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 CFR 1.10, or hand delivery, in order to secure the same filing date for all parts of the application. Alternatively, a user may submit the application on paper and include the electronic copy of the sequence listing text file on compact disc in accordance with 37 CFR 1.52(e). Sequence listing text files may not be partitioned into multiple files for filing via EFS-Web as the EFS-Web system is not currently capable of handling such

submissions. If the sequence listing is filed on a compact disc, the sequence listing must be a single document, but the document may be split using software designed to divide a file, that is too large to fit on a single compact disc, into multiple concatenated files. If the user breaks up a sequence listing so that it may be submitted on multiple compact discs, the compact discs must be labeled to indicate their order (*e.g.*, “1 of X”, “2 of X”).

For all other file types, 25 megabytes is the size limit. If a user wishes to submit an electronic copy of a computer program listing or table that is larger than 25 megabytes, it is recommended that the electronic copy be submitted on compact disc via Express Mail from the USPS in accordance with 37 CFR 1.10 on the date of the corresponding EFS-Web filing in accordance with 37 CFR 1.52(e) if the user wishes the electronic copy to be considered to be part of the application as filed. Alternatively, the user may submit the application in paper and include the electronic copies on compact disc in accordance with 37 CFR 1.52(e). Another alternative would be for the user to break up a computer program listing or table file that is larger than 25 megabytes into multiple files that are no larger than 25 megabytes each and submit those smaller files via EFS-Web. If the user chooses to break up a large computer program listing or table file so that it may be submitted electronically, the file names must indicate their order (*e.g.*, “1 of X”, “2 of X”).

*14. What is the limit on the number of electronic files that may be included in a single EFS-Web submission?* Sixty (60) electronic files is the file number limit per submission, as EFS-Web is not currently capable of accepting more than 60 electronic files in any one submission. Accordingly, if an application file is comprised of more than 60 electronic files, it is recommended that the user submit 60 or fewer files in an initial filing via EFS-Web at which time the application will be assigned an application number. Note that regarding the 60 electronic file limit per submission, an applicant may upload and validate in sets of up to 20 files each, with a limit of three sets of 20 files. If applicant chooses to divide a file into multiple parts using the multi-doc feature, each part is counted as one file. Then the user may submit any additional electronic files as follow-on documents later on the same day as the initial filing. This will allow all of the electronic files making up the application to receive the same filing date.

*15. May Complex Work Units be submitted electronically via EFS-Web?* Yes, under the Complex Work Unit Pilot Program, complex work units (such as chemical structure drawings, mathematical formulae, three-dimensional protein crystalline structure data and table data) may be submitted as ASCII text files via EFS-Web for national applications (other than international applications) and reexamination proceedings. Complex work units cannot be submitted as ASCII text files in international applications. More information is available on the USPTO Web site at <http://www.uspto.gov/web/patents/cwupilot.html>.

## **J. International Applications and Documents for International Applications**

*J1. May international applications filed under the PCT with the United States Receiving Office be electronically submitted via EFS-Web?* Yes, EFS-Web enables users to electronically file international applications under the PCT with the United States Receiving Office. Applicants are advised that EFS-Web may be used to file either: (1) International applications in fully electronic form; or (2) follow-on papers to previously filed international applications, regardless of the manner in which the international application was initially filed. The required page size for international applications filed via EFS-Web in PDF format is A4 (29.7 cm × 21 cm). See PCT Rule 11.5.

EFS-Web permits users to submit PCT-EASY.zip files created by PCT-SAFE when operated in the PCT-EASY mode. A PCT-EASY.zip file will contain the Request and fee calculation sheet in PDF format. All other documents or application parts (e.g., description, claims, drawings and abstract) MUST be separately prepared and attached as PDF documents, except for sequence listings. See section J3 of this notice for more information on sequence listings. PCT-SAFE permits users to create and electronically sign using an S-signature the PCT Request Form and the Declaration of Inventorship for the purposes of filing via EFS-Web with the United States Receiving Office. PCT-SAFE when operated in the PCT-EASY mode creates a validated PCT Request which will entitle the applicant to a reduction of the international filing fee. If applicant chooses not to use PCT-SAFE to create the Request and fee calculation sheet, the applicant may use Form PCT/RO/101 (or equivalent) for the Request and attach it as a PDF document. More information regarding filing international applications is

available on the USPTO Web site ([http://www.uspto.gov/ebc/portal/efs/dct\\_pct\\_file\\_new\\_tutorial.pdf](http://www.uspto.gov/ebc/portal/efs/dct_pct_file_new_tutorial.pdf)).

The term “international application” as used in this notice refers to an international application filed under the PCT where papers have not been submitted to enter the national stage under 35 U.S.C. 371. The term “national stage” as used in this notice refers to an international application where papers have been submitted to enter the national stage under 35 U.S.C. 371.

*J2. Entry in the U.S. national stage under 35 U.S.C. 371:* It is recommended that applicants continue to use the Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Submission Under 35 U.S.C. 371 (Form PTO-1390) when electronically filing documents for entry into the U.S. national stage under 35 U.S.C. 371. The PTO-1390 Form includes useful information that is not otherwise collected by EFS-Web at this time.

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements, Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt. For more information on fees associated with international applications entering the national stage under 35 U.S.C. 371, see MPEP § 1893.01(c).

*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?*

*a. Sequence Listing:* Under PCT Rule 5.2(a), the sequence listing part must always be presented as a separate part of the description. When filing an international application using EFS-Web, the sequence listing part of the description should preferably be submitted as a single ASCII text file with a “.txt” extension (e.g., “seqlist.txt”). 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. The sequence listing in an ASCII text file will not be taken into account when

calculating the application page count, i.e., no excess page fees will be required for the sequence listing in the text file.

Submission of the sequence listing part in a PDF file is not recommended because applicant would still be required to supply a copy of the sequence listing in an ASCII text file in accordance with AI Annex C, ¶40. When a sequence listing is filed in both a PDF file and an ASCII text file, the PDF copy of the sequence listing will be considered to form part of the application and the ASCII text file will be used for search purposes and will be transmitted to the International Bureau with the record copy. The pages of the PDF file that contain the sequence listing will be taken into account when calculating the application page count, i.e., excess page fees may be required for the PDF file.

*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. If applicant submits tables related to a sequence listing in a text file, such tables will not be accepted as part of the international application. For more information, see *Sequence Listings and Tables Related Thereto in International Applications Filed in the United States Receiving Office*, 1344 Off. Gaz. Pat. Office 50 (July 7, 2009).

*c. File Size and Quantity Limits:* One hundred (100) megabytes is the size limit for sequence listing text files. Sequence listing text files must not be partitioned into multiple files for filing via EFS-Web as the EFS-Web electronic filing system is not currently capable of handling such submissions. For all other file types EFS-Web is currently not capable of accepting files that are larger than 25 megabytes. Additionally, a single EFS-Web submission may include no more than 60 electronic files. Note that regarding the 60 electronic file limit, an applicant may upload and validate in sets of up to 20 files each, with a limit of three sets of 20. If applicant chooses to divide a file into multiple parts using the multi-doc feature, each part is counted as one file. The need to submit unusually large sequence listings and/or numerous electronic files may prevent applicant from making a complete international application filing in a single EFS-Web

submission. Applicant may use EFS-Web to file part of the international application and to obtain the international application number and the confirmation number, and then file the remainder of the international application on the same day as one or more follow-on submissions using EFS-Web, in order to secure the same filing date for all parts of the international application. However, applicant is not permitted to file part of the international application electronically via EFS-Web, and then file the remainder of the international application on paper to secure a filing date of all parts of the international application.

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, or hand delivery, in order to secure the same filing date for all parts of the international application. However, USPS Express Mail and hand-carried submissions may not contain PDF files and must fully comply with the guidelines for filing a sequence listing on electronic media as set forth in MPEP § 1823.02, except that only one copy of the sequence listing is required, and applicant need not make any reference to AI Part 8 or AI § 801. The sequence listing must be a single document, but the document may be split using software designed to divide a file, that is too large to fit on a single compact disc, into multiple concatenated files. If the user breaks up a sequence listing into multiple concatenated files so that it may be submitted on multiple compact discs, the compact discs must be labeled to indicate their order (e.g., "1 of X", "2 of X").

*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. A sequence listing filed in a PDF file will be included in the page count of the international application. Therefore, the page count for an EFS-Web filed application containing both a PDF and text format sequence listing will be

determined by the number of pages of the PDF sequence listing.

*J4. Follow-on Submissions for International Applications:* As noted above, a sequence listing in an ASCII text file, as well as additional PDF files, may be submitted in one or more follow-on submissions, via EFS-Web. Such follow-on submissions will form part of the international application if filed on the same date on which the international application was filed. Note that follow-on submissions of PDF files (including, but not limited to, PDF sequence listings) may change the number of pages in the international application and therefore may affect the international filing fee.

EFS-Web may also be used to submit a sequence listing in an ASCII text file after the international filing date in response to a requirement under 37 CFR 1.821(h) and PCT Rule 13ter. Such sequence listing will not form part of the international application as set forth in PCT Rule 13ter.1(e).

*J5. Policy of Annex F of the PCT Administrative Instructions:* EFS-Web employs a Web-based approach to document submission which is different from the Annex F "wrapped, bundled and signed package" approach. Thus EFS-Web does not meet Annex F requirements. See Annex F of the PCT Administrative Instructions located at [<http://www.wipo.int/pct/en/texts/>].

Dated: October 21, 2009.

**David J. Kappos,**

*Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

[FR Doc. E9-25785 Filed 10-26-09; 8:45 am]

**BILLING CODE 3510-16-P**

## DEPARTMENT OF COMMERCE

### International Trade Administration

[A-570-949]

#### **Wire Decking from the People's Republic of China: Postponement of Preliminary Determination of Antidumping Duty Investigation**

**AGENCY:** Import Administration, International Trade Administration, Department of Commerce.

**EFFECTIVE DATE:** October 27, 2009.

**FOR FURTHER INFORMATION CONTACT:** Frances Veith or Trisha Tran, AD/CVD Operations, Office 8, Import Administration, International Trade Administration, U.S. Department of Commerce, 14th Street and Constitution Avenue, NW, Washington, DC 20230; telephone: (202) 482-4295 or (202) 482-4852, respectively.

## SUPPLEMENTARY INFORMATION:

### **Postponement of Preliminary Determination**

On June 25, 2009, the Department of Commerce ("the Department") initiated an antidumping duty investigation on wire decking from the People's Republic of China.<sup>1</sup> The notice of initiation stated that, unless postponed, the Department would issue its preliminary determination no later than 140 days after the date of issuance of the initiation, in accordance with section 733(b)(1)(A) of the Tariff Act of 1930, as amended ("the Act"). The preliminary determination is currently due no later than November 12, 2009.

On October 15, 2009, petitioners, AWP Industries, Inc., ITC Manufacturing, Inc., J&L Wire Cloth LLC, Nashville Wire Products Mfg. Co., Inc., and Wireway Husky Corporation (collectively, "Petitioners"), made a timely request, pursuant to 19 CFR 351.205(b)(2) and (e), for a 50-day postponement of the preliminary determination, in order to allow additional time for the Department to review respondents' sections C and D questionnaire submissions.<sup>2</sup> Because there are no compelling reasons to deny the request, in accordance with section 733(c)(1)(A) of the Act, the Department is postponing the deadline for the preliminary determination by 50 days.

An extension of 50 days from the current deadline of November 12, 2009, would result in a new deadline of January 1, 2010. However, since January 1, 2010, falls on a federal holiday, a non-business day, the deadline for the preliminary determination will now be due no later than January 4, 2010, the next business day. The deadline for the final determination will continue to be 75 days after the date of the preliminary determination, unless extended.

This notice is issued and published pursuant to section 733(c)(2) of the Act and 19 CFR 351.205(f)(1).

Dated: October 20, 2009.

**Ronald K. Lorentzen,**

*Acting Assistant Secretary for Import Administration.*

[FR Doc. E9-25852 Filed 10-26-09; 8:45 am]

**BILLING CODE 3510-DS-S**

<sup>1</sup> See *Wire Decking From the People's Republic of China: Initiation of Antidumping Duty Investigation*, 74 FR 31691 (July 2, 2009).

<sup>2</sup> See Petitioners letter regarding, "Wire Decking from the People's Republic of China - Request to Postpone the Preliminary Antidumping Duty Determination," dated October 15, 2009.