

Efficient Use of the USPTO's Electronic Systems

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ABSTRACT

Whether in your personal life you are a technology forerunner (e.g., bought a flat panel HDTV a few years ago) or are a slow follower (e.g., you still have a VCR instead of a DVD player), there comes a time when you need to embrace new technology, especially in the business world. Even if you still like to listen to records, not CDs, you probably do not use a typewriter to draft patent applications. Whether you work at a law firm or in-house, it is time to embrace the new USPTO's technology to help you manage patent prosecution and portfolios. But how do you use all of the USPTO's electronic systems to make your job easier? This article discusses how to use the USPTO's PAIR, EFS and EPAS systems to manage your prosecution portfolio efficiently.

CUSTOMER NUMBER

The customer number is the foundation of the USPTO's electronic systems. Without a customer number, a practitioner can only use the public PAIR system. To use all of the USPTO's electronic systems to their maximum potential, it is important to understand the customer number concept.

The customer number includes a correspondence address and a list of practitioners of record. Both patents and patent applications can be associated with a customer number. In effect, the customer number is a way to group patents and applications together and associate them with administrative information, such as a correspondence address.

Whenever any administrative change is made to the customer number, it affects all the patents and applications associated with the customer number. This avoids the need to send in a separate document for each case. For example, when practitioners join or leave a law firm or company, someone listed on the customer number can add or delete, respectively, the appropriate practitioner. The customer number allows for an easy method to keep the practitioners of record current, thus, avoiding the problem of having patents where no one currently at the firm or company is a practitioner of record. In addition, if the name of the law firm or company changes, the name can be changed simultaneously for all patents and application associated with the customer number. The same holds true for changing the correspondence address associated with the customer number, which may happen if the law firm or company moves offices.

By using a customer number, individual letters for each case do not need to be mailed into the USPTO for any of the situations just discussed. Instead, these changes can be performed by faxing in a form, or, as explained below, on-line through the private PAIR system. This saves office supplies and administrative time.

A customer number can be obtained by any practitioner.¹ To associate already existing patents or patent applications to a customer number, the upload spreadsheet is used.² Multiple patents and applications are entered into the spreadsheet and a practitioner of record of all the listed cases signs the accompanying paperwork. For new applications, the applications can be associated with the customer number when filing by having the inventors sign a declaration appointing the practitioners of record associated with the customer number.

But why go through any trouble to associate your cases with a customer number? Whether you are an in-house attorney or work in a law firm, customer numbers can help you manage your cases. For attorneys at law firms, I suggest having a customer number for each of your clients. If your client has in-house practitioners, you may want to add the in-house attorneys to the

customer number for the respective client. This allows the in-house practitioners to have access to the file history through private PAIR. This saves the time and expense of sending copies of all action items and your responses to your client. Instead, you can just notify them that USPTO has posted the office action or response on PAIR.

From an in-house attorney standpoint, you will want each of your outside counsel to set up a customer number that lists their practitioners and any in-house practitioners. Besides allowing an in-house practitioner to view the file history through private PAIR, it allows the in-house practitioner, as a practitioner of record, to change correspondence information or the customer number associated with the application in case the firm no longer handles the case.

PAIR³

The Patent Application Information Retrieval system (PAIR) is the USPTO's database for application and patent status information. PAIR displays the file history of the patent or application. Recent cases have the entire file history, whereas some older cases only list the actions taken in the file but do not have electronic copies of the actions. For applications filed or pending on or after June 30, 2003, the electronic image wrapper on PAIR is the official record at the USPTO.⁴ PAIR is available everyday for all but one hour early in the morning.⁵

In addition, PAIR displays administrative data, such as filing date, application number, first named inventor, examiner, practitioner(s) of record, the correspondence address and maintenance fee information (e.g., when due, how much, if the fees were paid) for each case. In addition, links to published documents and continuity files (e.g., divisionals) are included.

Since applications generally are confidential until published, the USPTO has two types of PAIR systems: a public PAIR and a private PAIR. Public PAIR includes information for public applications and patents. Anyone can access any public PAIR file by logging into the public PAIR website.⁶ Through public PAIR, the public can immediately view the file history of patents without waiting for a file history order to be delivered. Although you can see the file history, it may be more convenient to order a file history since each item listed in PAIR (e.g., each amendment) is a sepa-

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rate document and thus, the file history on PAIR is not easy to view. Even if you do not have access to private PAIR, you can access your cases that are in the public domain through public PAIR.

All cases available in public PAIR are viewable in private PAIR. Thus, patents not associated with your customer number are viewable in private PAIR. But private PAIR also includes confidential applications associated with customer number(s) associated with your PKI certificate.

To log into private PAIR, a Public Key Infrastructure (PKI) certificate is needed.⁷ Only registered patent practitioners, independent inventors, and limited recognition practitioners can obtain a PKI certificate.⁸ However, others, such as paralegals and administrative assistants, can use private PAIR by using someone else's PKI certificate if they are under the direction and control of the PKI certificate owner.

One or more customer numbers may be associated with your PKI certificate. To associate a customer number to your PKI certificate, the customer number needs to be listed on the certificate action form⁹ submitted to the USPTO.

Private PAIR includes some additional features than public PAIR. Through private PAIR, a list of all applications and patents associated with your customer number can be viewed. The number of cases listed on each page of the report is limited. Therefore, when searching for a specific application number only the page being viewed is searched. Unfortunately, there is no way to export the numbers on all pages so that the data can be manipulated. For example, it

would be useful if the data could be exported into an excel spreadsheet.

In addition, private PAIR allows you to look at a single case and view USPTO correspondences before they you receive them by mail. This is very useful when the three month deadline in response to a final office action is approaching and the practitioner sent in an after final (37 CFR §1.116) amendment. While you might not receive the response to the amendment before the three-month deadline, it is likely the response is on PAIR. This enables the practitioner to respond to the Examiner's response without having to pay an extension fee. Thus, the PAIR system increases the transparency to the USPTO's processing of the application. This increased transparency may increase communication between the practitioner and the Examiner because both parties can view the same information in almost real time. Remember that the PAIR system is the official file folder for many pending applications.

Furthermore, the PAIR system enables a practitioner to see what communications the USPTO mailed for a particular customer number. This is most useful for a solo practitioner who knows that he will have to respond to all the communications for the given customer number. The solo practitioner can use this feature if he is going on vacation and wants to ensure no case is unintentionally abandoned or he does not want to incur late fees. If many practitioners are prosecuting the cases associated with the customer number, it is difficult to determine whose has responsibility for each communication and therefore this feature may

not be useful. There is no way to sort a single practitioner's cases if a customer number includes multiple practitioners.

ELECTRONIC FILING SYSTEM (EFS)

EFS allows for the electronic filing of new application and other correspondences. In general, the submitted uploads pdf documents into the EFS system. Usually, this requires a conversion of the documents from word into pdf. While the practitioner needs to sign the appropriate documents, legal personnel (e.g., assistants) submit the papers through EFS. There are at least two methods for the practitioner to sign.

Under the first method, the practitioners can sign by electronic signature wherein the practitioner types his name between forward slashes. This is termed an S-signature. The practitioner needs to perform the typing himself and cannot instruct someone else to do so on his behalf.¹⁰ When using this approach, the office should establish a method to prevent mixing different copies of the paperwork. One way to avoid a mix-up is to have the legal personnel load all of the documents on the website and notify the practitioner afterwards. The practitioner then reviews the documentation and electronically signs the necessary paperwork, if correct. If correct, the practitioner either submits the documents himself or instructs the legal personnel to do so.

The second method involves the practitioner signing the document in ink. Afterwards, the document is scanned into pdf format and filed on the USPTO website. Some attorneys prefer this method

because they are uncomfortable with electronic signatures.

Once the documents are submitted, they should appear in private PAIR within an hour. My office's experience is that they are present within 15 minutes. This efficient process saves administrative time that used to be spent going to the post office or the USPTO to file new applications. Also, the cost of express mailing and postcards are saved for all correspondences. If an office files 350 patents per year, the annual cost savings of postage and supplies is over \$5,000 dollars. The cost savings is even greater because of the time savings of electronic filing and the cost savings on mileage if the time and mileage reimbursement saved from post office of USPTO visits is included.

ELECTRONIC PATENT ASSIGNMENT SYSTEM (EPAS)

The EPAS system allows a non-practitioner or practitioner to record an assignment electronically. The system is especially useful when recording an assignment for a large number of patents or applications (e.g., spin offs, mergers, etc.).

Serial numbers for applications (U.S. or PCT applications with the U.S. as a receiving office) or patent numbers are entered into the system. Be careful to avoid forward slashes or commas, as the system will accept the entries and charge the associ-

ated deposit account. However, the recordal will not occur unless the numbers are reentered and you pay the assignment fee for each patent or application again. Associated documents need to be uploaded to the system and the system converts them to tiff files, if necessary. Anyone who has authorization to charge the deposit account on behalf of someone who is listed on the deposit account (e.g., a legal personnel) can record the assignment. The practitioner does not have to submit the assignment. In addition, if future assignments will have the conveying party or receiving party the same, a form may be created in EPAS and reused to save time and minimize errors.

By using the EPAS system, a reel and frame number is received faster than by mailing the documents. I have received a facsimile with the reel and frame number as fast as the next day, but usually within 5 days. All patents and applications submitted at the same time will receive the same reel and frame number. This can be convenient for tracking IP acquisition events. For example, a practitioner can submit all the patents and applications from an acquisition of company A's portfolio at the same time so that everything acquired from this company is on a given reel and frame number.

CONCLUSION

A practitioner can use the USPTO's EPAS, EFS and PAIR systems to efficiently

manage their portfolio and communicate with the USPTO. While it takes some effort to set up the systems since a customer number and PKI certificate is needed, the time and costs savings in the long run outweigh the set-up costs. Furthermore, several options of how to best utilize these tools was provided to aid in how to best utilize the systems for a specific practice. **IP**

ENDNOTES

1. To obtain a customer number go to: <http://www.uspto.gov/ebc/portal/infocustomer-number.htm>.
2. The upload spreadsheet and instructions can be found at <http://www.uspto.gov/ebc/downloads.html>.
3. http://www.uspto.gov/ebc/pair_help.htm is a good help website for the PAIR system.
4. See *Notification of United States Patent and Trademark Office Patent Application Records being Stored and Processed in Electronic Form*, 1271 Off. Gaz. Pat. Office 100 (June 17, 2003).
5. PAIR is not available from 4:30 AM to 5:30 AM EST.
6. The public PAIR website is located at <http://portal.uspto.gov/external/portal/pair>
7. The private PAIR website is located at <https://sportal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>.
8. To obtain a PKI certificate follow the instructions at <http://www.uspto.gov/ebc/portal/infocustomer-number.htm>.
9. The certificate action form is located at: www.uspto.gov/ebc/documents/certificateaction-form.pdf.
10. 37 C.F.R. § 1.4(d)(2)

CANTOR COLBURN WELCOMES SIX NEW ASSOCIATES

The Atlanta Office of Intellectual Property Boutique Cantor Colburn, LLP is pleased to announce the addition of six associates: Ms. Michelle Henderson, Mr. Kunicki "Nick" Lockett, Mr. Duane Minley, Mr. John Young, Mr. Mikki Murray, and Mr. Blaine Page. Cantor Colburn, LLP has offices in Hartford, Detroit, and Atlanta. The Atlanta office, which opened in March 2005, has been steadily expanding and serves both national and regional clients.

Ms. Michelle Henderson received her law degree from Emory University and her B.S. in Chemical Engineering from the Georgia Institute of Technology. Prior to joining Cantor Colburn, Ms. Michelle Henderson was affiliated with Conley Rose, P.C. and has extensive experience in the areas of semiconductor fabrication, petroleum engineering, polymeric and catalytic materials, and process controls. Ms. Henderson was a past recipient of the Robert P. Watson Award, an American Intellectual Property Law Association writing competition.

Mr. Kunicki "Nick" Lockett received his Electrical Engineering and law degrees from the University of Alabama. Mr. Lockett was formerly associated with Staas and Halsey and has a broad range of prosecution experience in the electrical, electromechanical, and electro-optical arts. Mr. Lockett previously worked as an Examiner in the Patent and Trademark Office.

Mr. Duane Minley received a B.S. in Electrical Engineering from Tuskegee University and his law degree from the University of Georgia. Mr. Minley was formerly associated with Sughrue Mion PLLC, and has extensive experience in the electrical and mechanical arts includes telecommunications, optical recorders, medical devices, and computers. Mr. Minley is a member of Georgia Bar.

Mr. John Young received a B.S. in Electrical Engineering from University of the District of Columbia, an M.S. in electrical engineering from George Washington University, and his law degree with District of Columbia School of Law. Mr. Young was formerly a Primary Examiner after having spent over seven years at the Patent and Trademark Office. Mr. Young was formerly associated with Staas and Halsey.

Mr. Mikki Murray received a B.S. in Interdisciplinary Science from Morehouse College, a B.S. in Mechanical Engineering from Georgia Institute of Technology, and a law degree from the George Washington University Law School. Mr. Murray was previously associated with Sonnenschein, Nath & Rosenthal, LLP and has a broad range of experience that includes licensing, opinion work, and counseling clients with respect to their patent portfolios.

Mr. Blaine Page received a B.S. Chemical Engineering from the University of Maine and a law degree from Franklin Pierce Law Center, where he was an Editor of IDEA-The Journal of Law and Technology. Mr. Page recently passed the Georgia State Bar and is registered to practice before the Patent and Trademark Office.