

# EFS-Web: An Electronic Filing Tool Providing the Segue into the “Electronic” Age for IP Law Firms

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After having beta tested every electronic patent filing solution ever offered by the United States Patent and Trademark Office (USPTO), Oblon, Spivak, McClelland, Maier & Neustadt, P.C. was somewhat skeptical that their latest version, EFS-Web, would fit our needs. Its predecessors were cumbersome, training intensive and ill suited to the workflow of a large intellectual property firm. So when we were invited to offer our input and feedback at the Electronic Filing Forum Design Review meetings in March 2005, we didn't expect an end product that would readily meet the needs of a large firm and its many clients. But that is what we found with EFS-Web.

EFS-Web is successful where other electronic patent filing tools were not by allowing users the option of applying as much or as little “technology” as desired. Submissions are made in “PDF” format – simple image files that can be captured by scanning or generated by converting text files. A firm with tech-savvy clients can readily accept and use the electronic documents that clients typically send via a paper

or e-mail. However, for those clients who may not be as far along in their office technology, the usual paper copy received via fax or paper mail can easily be scanned into the requisite form for electronic submission. Everybody gets an even chance to play on this field.

As one of the USPTO's biggest customers, we were looking for an electronic filing tool that could be efficiently integrated into our existing workflow. While training is still certainly a prerequisite for use of the EFS-Web tool, it is simple enough for a small firm to readily incorporate into their practice while being functional enough to satisfy the needs of a large firm. We have experienced the requisite learning curve, but this time the Office put their resources to good work by making training and outreach a high priority. The results allowed a fairly seamless integration of the e-filing product into our existing infrastructure.

EFS-Web is a highly-functional tool that has allowed this firm to efficiently convert many of its paper filings into electronic submissions. As of the writing of this article, Oblon, Spivak, McClelland, Maier & Neustadt, P.C. has made over 10,500 submissions via EFS-Web, including 3,246 patent applications.


For our clients and our firm, some of the benefits associated with EFS-Web include:

- Instant Electronic Acknowledgment with Serial Number
- Immediate Availability of Application in Private PAIR
- Increased Accuracy of Bibliographic Data in PAIR
- Discount on Application Size Fee

Resulting efficiencies and benefits have included the elimination of Advance Serial Number Card correspondence, allowing us to reassign several employees to more productive roles. We have also been able to streamline workflow processes in several areas, improving the processing and turnaround time of client correspondence as well as enabling the consolidation of other correspondence.

Many of our clients asked whether we would be participating in the e-filing program and were happy to hear that our firm is already there. This has helped us to maintain our edge as a leading Intellectual Property Law Firm.

EFS-Web has proven to be a great segue for us into the “electronic” age; coupled with our current participation in Phase II of the e-office action pilot we find ourselves readily positioned to easily accommodate those clients who want only e-correspondence.

The conversion from a paper to an electronic environment is difficult and is limited by the extent to which the other participants in the business can accommodate this process. Prior to EFS-Web, the desire to go “paperless” in the patent world was encumbered by the necessity of producing paper filings and processing PTO paper Actions. With EFS-Web, e-Office Actions and PAIR, the Office has demonstrated its willingness to be a valuable and helpful partner in our electronic evolution. 

## Dechert Client Advanced Analogic Technologies Receives Full Defense Verdict in International Trade Commission Patent Case

Dechert LLP client Advanced Analogic Technologies Incorporated (Nasdaq: AATI) (AnalogicTech), a Sunnyvale, Calif.-based developer of power management semiconductors for mobile consumer electronic devices, announced today that Administrative Law Judge Sidney Harris of the U.S. International Trade Commission (ITC) issued a decision in AnalogicTech's favor in a patent dispute initiated by Milpitas, Calif.-based Linear Technology Corporation (Nasdaq: LLTC) in March 2006.

In this case (ITC Investigation No. 337-TA-564), Linear had asserted that certain of AnalogicTech's charge pump products and switching regulator products infringed U.S. Patent Nos. 6,411,531 and 6,580,258, respectively. Judge Harris found against Linear and decided that Dechert's client, AnalogicTech, did not violate Section 337 of the Tariff Act. This full defense victory is a significant win for AnalogicTech, especially because the '258 patent has been asserted against other companies in the industry and this is the first judicial decision on that patent.

Judge Harris found that all of the asserted claims of the '531 patent were either invalid, not infringed, or both. Judge Harris also found that Linear had not established a “domestic industry” with respect to the '531 patent. As to the '258 patent, Judge Harris found one patent claim invalid and found that all claims were not infringed by AnalogicTech's switching regulator products.