

U.S. PATENT AND TRADEMARK OFFICE, NO MORE PAPER?

BY MARY M. MOYNE

In March 2006, the United States Patent and Trademark Office (USPTO) launched its new electronic filing system, EFS-Web. This system enables the filing of new U.S. provisional and non-provisional utility patent applications, design patent applications and national filings. The system also allows the electronic filing of other patent documents such as amendments and responses in pending patent applications. In October 2006, the USPTO expanded its EFS-Web system to facilitate the filing of new international applications under the Patent Cooperation Treaty (PCT) as well as other correspondence relating to pending International PCT applications. The USPTO expects that in the future, the EFS-Web system will be used by a majority of patent agents and patent attorneys to file new patent applications. So far it appears that the EFS-Web system is living up to the USPTO's expectations. In the first 6 months since EFS-Web became operational, the electronic filing of new U.S. patent applications has risen 33%.

The USPTO has long sought to become a paperless organization. In 1998, the USPTO successfully established its Trademark Electronic Application System (TEAS). Today, over 90% of all initial trademark documents are filed electronically, with over 30% of all applications being completed electronically. In 2000, the USPTO launched its first patent electronic filing system. However, the system required the use of special software to draft the patent applications. Using the software was cumbersome and complicated. The system

was not well received and by 2005 only about 2% of all patent applications were filed using this system.

Establishing a successful electronic patent filing system is a necessary step in the USPTO's goal of becoming a profitable paperless organization. The USPTO handles over 200 million patent documents each week. In addition, the USPTO is the single largest receiver of overnight mail in the United States. Currently, most patent applications are filed by overnight Express Mail to ensure that the filing date of the

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application is the date that the application is mailed. Opening and manually sorting this mail is a very time consuming and expensive task. Furthermore, to enable the patent documents to be managed electronically, all paper documents received by the USPTO must be converted to digital images. Scanning of the numerous patent documents is also a time consuming and expensive task. It also leads to

the possibility of errors due to the scanning process. Enabling patent filers to submit patent documents and particularly patent applications in electronic form would eliminate the need for the USPTO to manually sort and scan the documents; thus saving the USPTO time and money and reducing the possibility of errors.

Several key qualities of patent applications make establishing a successful electronic filing system for patents a difficult task. Filing a patent application requires the execution and filing of multiple forms as well as the drafting of the patent application. Different

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patent filers use different forms and different software to draft the patent application. Therefore, the system needed to be flexible. In addition, in the U.S., patent applications are held in secrecy for at least 18 months after the filing date. Therefore, any transmission of new patent applications must be secure. Finally, in many patent application filings, the filing date is very important. In fact, if a critical date is missed in filing a patent application, an applicant could be barred from obtaining a patent on an invention. Therefore, it is crucial that users of the electronic patent filing system have confidence that the filing of the application is successful on the date filed. Creating a secure system which is flexible and easy to use and which can be confidently used by patent filers has been a challenge. However,

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early results show that the USPTO has successfully met this challenge with its EFS-Web system.

The EFS-Web system is a web-enabled electronic filing system which allows users to file patent applications and other patent documents using a web interface at the USPTO website. Since the system is web enabled, it can be accessed by anyone via the internet. The EFS-Web system allows users to format documents using a Portable Document Format (PDF) writer. PDF is an application standard supported by many vendors. Thus, the application, drawings, and any associated patent documents can be authored and drafted as before without the need for specialized training or special software. Users are given the option of using their own forms or using automated forms provided by the USPTO. The automated forms can be auto loaded into the USPTO database which reduces the possibility of errors due to scanning of the documents. The automated forms also reduce the workload of the USPTO. Once the patent documents are in the proper PDF format, the documents are uploaded to the USPTO via a standard web-based screen which enables a user to quickly and easily submit documents directly to the

USPTO. The EFS-Web system verifies and validates the files before submission and notifies the user of any errors in the file format or missing information in the forms when the USPTO automated forms are used. The system also enables a user to calculate and pay the fees associated with filing the patent application on-line. Such fees can be paid using a credit card or a special USPTO deposit account set up by the user.

Using the EFS-Web system provides a time and cost savings for the user. By using electronic filing, the user reduces the printing and copy costs and eliminates the mailing and courier costs associated with the filing of the patent application by regular or Express Mail. The user also has the added convenience of filing from a computer rather than going to a post office. However, the most important advantages to the user are the immediate confirmation of receipt of the application and patent documents and immediate assignment of an application number. In addition, for registered users, those users having a customer number and a Public Key Infrastructure (PKI) digital security certificate, the submitted documents are viewable within hours after filing using the USPTO's private Patent Application Information Retrieval (PAIR) system. Thus the user is able to view documents within hours of filing and make changes on the same day to correct any errors without missing a due date.

The EFS-Web filing system is a huge step forward for the USPTO in its goal of becoming a paperless organization. The USPTO has created an easy to use electronic patent filing system which provides the security and the immediate confirmation and access necessary to ensure widespread use by patent filers. The EFS-Web system will reduce the workload of the USPTO and save both time and money for the USPTO and its customers.



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WELL DESERVED RECOGNITION

On December 7th, the Lansing Regional Chamber of Commerce is hosting *A Celebration of Regional Growth Economic Development Luncheon*. At this luncheon regional businesses that have contributed to the economic growth and advancement of the Lansing region during the past year will be recognized. Fraser Trebilcock Davis & Dunlap, P.C. would like to congratulate: Demmer Corporation, Emergent BioSolutions, Gestamp US Hartech Corporation, Ingham Regional Medical Center, Liquid Web, Neogen Corporation, Sparrow Health System, Spartan Motors, Inc., and TechSmith Corporation for their successes.

ATTORNEY ACTIVITIES OF NOTE

■ Robert B. Nelson participated in a panel discussion entitled “Who’s Charge? The Public Interest and Regulatory Oversight” at the Annual Convention of the National Association of Regulatory Commissioners in Miami, Florida on November 15th.

■ John D. Miller and Steve L. Burlingame represented NextGen Group PLC, a UK based “Gene to Protein” company, in its acquisition of Proteomic Research Services Inc. of Ann Arbor, MI. John and Steve worked along side the UK firm of Mills Reeves in implementing the reverse triangular merger structure used for the acquisition. Mills Reeves contacted the firm as a result of Fraser Trebilcock Davis & Dunlap’s membership in the State Capital Global Law Firm Group (SCGLFG). SCGLFG member firms are located in the U.S. state capitals and in business markets and financial centers around the world. Member firm attorneys bring a broad range of skills and experience to your business. Member law firms practice independently and not in a relationship for the joint practice of law.

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GOLDEN NUGGET

Myth: A trustee can distribute trust property to the beneficiaries immediately after the grantor of the trust dies.

Fact: Only a foolish trustee would do this. The trust assets need to be identified and valued. Often an appraisal is necessary. The trustee also needs to take care of paying the grantor’s debts, final expenses and any death taxes. If the trustee distributes too early and is left with insufficient funds, the trustee is personally liable for those obligations. So, all of this takes time. It is also a Michigan Probate Code requirement to publish a notice to creditors in a local public newspaper, and the claims period runs for four months. It is usually unwise for a trustee to make any substantial distributions until after the claims period has expired. Furthermore, if there is a very large estate and a federal estate tax return is required, the trustee should only make partial distributions until final tax clearance is received from the IRS.

Interested in more information about Estate Planning and Probate issues? Sign up for Ryan Wilson’s free monthly *Golden Bullets*. It is available in print and email format. For a subscription call Mr. Wilson at 517/377-0897 or email him at rwilson@fraserlawfirm.com.

YULDASHEVA JOINS FRASER TREBILCOCK DAVIS & DUNLAP, P.C.

Aziza N. Yuldasheva has joined the law firm of Fraser Trebilcock Davis & Dunlap, P.C., as an associate. She will practice commercial litigation, insurance law, immigration and naturalization law. Ms. Yuldasheva earned her B.B.A. in International Business from Eastern Michigan University and her J.D. from Wayne State University. She is fluent in Russian and proficient in French and Ukrainian.

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