

January 2, 2006

The Honorable Jon Dudas  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

RE: Electronic Filing of International Patent Applications

Dear Mr. Under Secretary:

I am writing to express the support of the American Intellectual Property Law Association (AIPLA) for the efforts by the United States Patent and Trademark Office (USPTO) to develop a user-friendly system for electronically filing (e-file) patent applications in the USPTO and, specifically, to urge the acceptance of e-filed international applications in the US receiving Office under the Patent Cooperation Treaty (PCT). In the comments which follow, I address the following specific aspects of electronic filing of international applications:

- Acceptance of e-filed applications by the USPTO receiving Office;
- Selection of software and authoring tools;
- Standardization of filing formats;
- Provision of serial numbers and status information; and
- Elimination of the time-zone disincentive to e-file applications.

AIPLA is a national bar association whose nearly 17,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

According to published reports, the USPTO expects to receive nearly 50,000 international patent applications this year in its capacity as a receiving Office under the PCT. The ability to e-file these applications would offer advantages to both applicants and receiving Offices, including fewer errors in publications and searchable databases, improved clarity of published figures, immediate availability of serial numbers, and fee reductions. E-filing using the PCT-SAFE standard software is currently supported by numerous receiving Offices, including the EPO, Japan,

France, Australia, Spain, Finland, Great Britain, and the International Bureau of WIPO, but it is not accepted by the USPTO.

AIPLA urges the USPTO to make this e-filing option available at the US receiving Office as soon as it is practical to do so, and to implement e-filing in a user-friendly manner that takes into consideration the following:

Software: All of the receiving Offices that currently accept e-filed PCT applications have adopted the PCT-SAFE submission software as a standard. US applicants who now file PCT applications directly with the International Bureau are familiar and comfortable with this software. It would be needlessly burdensome for US applicants to be forced to acquire, maintain, learn, and use a different system for e-filing in the US receiving Office. Therefore, AIPLA urges the USPTO to permit e-filing international applications using the PCT-SAFE standard software.

Authoring tools: Applicants should be free to prepare and submit e-filed applications using any operating system and authoring tool that is capable of producing an acceptably formatted output. The USPTO has appropriately recognized this in the platform-neutral design of the trademark e-filing system (TEAS), which has quickly gained widespread acceptance among applicants. AIPLA urges the USPTO to take this same user-friendly approach with e-filed international patent applications, making it possible for applicants to e-file an application using the applicant's choice of operating system and authoring tools.

Formatting: After many years of constructive debate, WIPO, USPTO, JPO, EPO, and numerous other Offices agreed on a uniform format for e-filing patent applications. This format, as fully documented in Annex F of the Administrative Instructions under the PCT, permits an applicant to prepare a patent application and file it in many Offices without reformatting. This provides a significant time and cost saving for applicants; and Annex F has emerged as a clear benefit of international consultation and cooperation. Prior to August 18, 2004, it was also possible to e-file an Annex F-compliant national application in the USPTO, but that is no longer possible under either the ePave or the beta EFS-Web systems. AIPLA urges the USPTO to reconsider this step and permit e-filing of Annex F-compliant international applications.

Serial number and status information: Along with the ability to e-file international patent applications at the USPTO receiving Office, AIPLA also urges the USPTO to promptly provide serial numbers in response to such e-filed applications, and to make application status information available online to applicants throughout the international phase. This includes receiving Office, searching Authority, and preliminary examining Authority status information. At present, applicants can obtain status information only via telephone, placing an unnecessary burden on both applicants and Office personnel.

Time-zone disincentives: PCT Circular 1014, released on 7 February 2005, proposed revising Section 704 of the Administrative Instructions under the PCT to permit receiving Offices to consider e-filed international applications to have been received on the date prevailing, at the time when the transmission is completed, in a time zone specified by the Office or in the latest territorial time zone available to such Office. AIPLA would support such a revision. At present, the date of receipt of an international application which is filed electronically is based on the date

at the receiving Office at the time when the application is received. For US applicants, who currently can e-file an international application only with the International Bureau, this causes a substantial disadvantage because of the time differential between the United States and Switzerland. A similar, though lesser, disadvantage is visited on many US applicants who choose to e-file national applications at the USPTO. For example, an applicant in California must e-file an application by 9:00 pm Western Time, even though a paper application could be filed up to three hours later. The proposed change to the Administrative Instructions would obviate this problem for applicants who e-file international applications at the US receiving Office, by permitting the US Office to consider applications to have been received according to any time zone within US territory. Designating the western-most US time zone as the controlling time for e-filing an international application at the US receiving Office would eliminate the present disadvantage, provide a consistent standard for applicants, and encourage, rather than discourage, the practice of e-filing.

Electronic filing of patent applications is necessary for the efficient operation of both applicant offices and the USPTO. However, successful implementation of e-filing requires sensitivity to the increasingly global nature of patent activity. AIPLA very much supports e-filing initiatives and looks forward to the prospect of a smooth and rapid transition from paper to electronic filing of both national and international patent applications. We believe that the suggestions we have outlined will help hasten this transition.

Thank you for your continued efforts to make e-filing in the USPTO a reality. Please let us know if AIPLA can assist you in any manner as you pursue this initiative.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael K. Kirk". The signature is fluid and cursive, with the first name "Michael" being more prominent than the last name "Kirk".

Michael K. Kirk  
Executive Director  
AIPLA