

# **LEGAL FRAMEWORK FOR PATENT ELECTRONIC SYSTEM**

September 11, 2025

## **Introduction–Scope of Document**

This legal framework defines the USPTO patent electronic filing system requirements in accordance with 37 CFR 1.6(a)(4), and provides guidance on the background statutes, regulations and policies that support the United States Patent and Trademark Office’s (USPTO or Office) Patent Electronic System. The Patent Electronic System currently comprises Patent Center. Patent Center includes both the USPTO patent electronic filing system, which is a web-based patent application and document submission system, and the USPTO’s web-based means for electronically viewing the status of, and documents filed in or associated with, patent applications and proceedings. Documents such as assignments for recordation and complaint letters are not part of the application file and are not filed via Patent Center. Patent Center replaced EFS-Web and the Patent Application Information Retrieval (PAIR) system. This legal framework also discusses the two-step authentication process now in place for accessing Patent Center, including its public searching, viewing and training mode functionalities. This legal framework is provided as a reference for applicants, patentees, parties in reexamination proceedings, attorneys, and agents.

This legal framework is effective on September 11, 2025, and supersedes all prior versions of the legal framework, including as printed in Manual of Patent Examining Procedure (MPEP) section 502.05, Ninth Edition, Rev. 01.2024 (January 2024). The MPEP will be revised in due course. The following is a brief summary of the major differences introduced by this legal framework:

1. Section B is revised to state that registration is required to use the Patent Electronic System. Section B is also revised to clarify that third-party papers are prohibited from being filed in applications via the Patent Electronic System unless specifically authorized and the special dedicated electronic interface, if provided, is used so that information is not directly placed into the application file.
2. Section C is revised to clarify that the USPTO may specify an alternative electronic filing procedure, for new applications, national stage submissions under 35 U.S.C. 371, and/or other patent filings, during an unplanned outage of Patent Center if designated by the Director. If an alternative procedure is not specified, applicants should follow the procedure for filing applications previously set forth. *See Filing Patent Applications Electronically During Designated Significant Outages of the United States Patent and Trademark Office Electronic Business Systems*, 83 FR 44264 (August 30, 2018).
3. Section D is revised to clarify that patent applications filed in DOCX format will be validated and applicants will be provided useful feedback concerning the

format of their applications. Applications filed in DOCX format avoid the non-DOCX surcharge.

4. Section E is revised to specify that users may complete the verification process by mailing in the paper verification form, by completing the ID.me verification process, or other process designated by the Director.
5. Section L is rewritten to provide that applications filed on or after July 1, 2022 that disclose a nucleotide and/or amino acid sequences as defined in 37 CFR 1.831, including applications claiming benefit of, or priority to, an application filed before July 1, 2022, containing sequence listing, must contain a computer readable sequence listing in XML format (“Sequence Listing XML”) in accordance with 37 CFR 1.831 through 1.835.
6. Section O is added to provide that effective May 24, 2024, Plant applications including drawings or photographs, fees, and follow-on documents may be filed via the Patent Electronic System.

**DATES: Applicability Date:** The updated legal framework applies to all users of the USPTO’s Patent Electronic System as of September 11, 2025.

### **Contact Information**

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

Inquiries regarding IT policy for U.S. national patent applications may be directed to Mark Polutta, Senior Legal Advisor (telephone 571-272-7709; e-mail at [mark.polutta@uspto.gov](mailto:mark.polutta@uspto.gov)), or Gena Jones, Senior Legal Advisor (telephone 571-272-7727; e-mail at [eugenia.jones@uspto.gov](mailto:eugenia.jones@uspto.gov)), both with the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patents.

Inquiries regarding IT policy for international applications filed under the Patent Cooperation Treaty (PCT), and filing of national stage applications, may be directed to Tamara Graysay, Special Program Examiner (telephone 571-272-6728; e-mail at [tamara.graysay@uspto.gov](mailto:tamara.graysay@uspto.gov)), and inquiries regarding IT policy for international design applications may be directed to Boris Milef, Senior Legal Examiner (telephone 571-272-3288; e-mail at [boris.milef@uspto.gov](mailto:boris.milef@uspto.gov)), both with the Office of International Patent Legal Administration, Office of International Patent Cooperation.

## **Legal Framework**

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### **A. General Information on the Patent Electronic System**

The USPTO has developed a new electronic filing and viewing system, Patent Center, to modernize its patent application filing and viewing systems. Patent Center utilizes web-based interfaces to enable users to submit patent documents directly to the USPTO in Open XML Format (DOCX) for the specification (including the claims and the abstract) of a new utility nonprovisional, provisional, design, or plant application, or national stage entry under 35 U.S.C. 371. The submission of documents in Portable Document Format (PDF) is also supported.

The Patent Electronic System currently comprises Patent Center, which replaces both EFS-Web and PAIR. The Patent Electronic System is accessible via the USPTO website. As used herein, “Patent Electronic System” encompasses the “USPTO patent electronic filing system” as used in 37 CFR and in Federal Register notices. “Patent Electronic System” also encompasses the USPTO’s web-based means for electronically viewing the status of, and documents filed in or associated with, patent applications and proceedings. The Patent Electronic System is distinct from the Patent Trial and Appeal Case Tracking (P-TACTS) system used by the Patent Trial and Appeal Board (PTAB) to file documents in contested cases and trials.

Registration is required to use the Patent Electronic System. *See* section E for details on registering. This represents a change from the past practice of permitting unregistered users to file patent applications and view patent applications in the Patent Electronic System.

Users may use the Patent Electronic System to access and file documents securely in a variety of applications and proceedings, including domestic and international patent applications, applications for international registration of industrial designs, reexamination requests and proceedings, and supplemental examination requests and proceedings. The term “users” includes anyone who accesses the Patent Electronic System, including inventors, third parties (who may submit some papers such as third-party submissions via a dedicated interface), practitioners, and practitioner-sponsored support staff. For purposes of readability, the term “application” is used in this document to represent any and all of the possible types of patent applications and proceedings, except where specifically noted otherwise. Users also may use the Patent Electronic System to submit payments of most patent fees including patent application filing fees.

In particular, users may use the web-based interfaces of the Patent Electronic System to submit documents in DOCX or PDF formats directly to the USPTO unless otherwise indicated in this framework. Sections L, M, and N of this framework provide further information on file formats, other than DOCX and PDF, that are supported by the Patent Electronic System. Users need not provide a duplicate copy of any document filed through the Patent Electronic System unless the USPTO specifically requires the filing of a duplicate in a particular situation. Users may file a copy of a DOCX application as an auxiliary PDF, which currently does not count towards the application size fee. *See* 87 Fed. Reg. 25226 (April 28, 2022), 87 Fed. Reg. 77812 (December 20, 2022), and 88 Fed. Reg. 37036 (June 6, 2023).

The USPTO provides users with various web-based fillable forms. Information entered on web-based fillable forms provided by the Patent Electronic System will be automatically loaded into the USPTO databases. When users submit information using a USPTO web-based fillable form, such as the Application Data Sheet (ADS) (not a scanned image (PDF) of a document), the information will directly load into the USPTO databases, which will increase accuracy and facilitate faster processing. Users may also submit via the Patent Electronic System, USPTO-created PDF fillable forms available on

the USPTO.gov website or user-created PDF forms, which will not automatically load into the USPTO databases.

Users may also use the Patent Electronic System to submit web-based documents (for example, ePetitions). These documents are auto-processed and granted or approved immediately upon submission if the submissions meet all requirements. Such a submission is generated based on the information entered into the Patent Electronic System. The submission and the USPTO's acceptance of the submission will be loaded into the USPTO's Electronic Repository, currently the content management system (CMS), if the submission is approved. If the submission does not meet all requirements, it will not be loaded into CMS.

The USPTO.gov website provides additional information about the Patent Electronic System, such as instructions, guidelines, frequently asked questions, and tutorials. Users may contact the Patent Electronic Business Center (Patent EBC) for assistance with the Patent Electronic System as well as for information on becoming a registered user, two-step authentication, and customer numbers.

## **B. Legal and Document Policies**

This Legal Framework sets forth the USPTO's policies concerning documents submitted electronically using the Patent Electronic System, including domestic and international patent applications, applications for international registration of industrial designs, reexamination requests and proceedings, and supplemental examination requests and proceedings, as well as follow-on documents for such applications, requests, and proceedings. Applicable regulations will be interpreted consistent with this framework for any document submitted electronically using the Patent Electronic System.

### *B1. Types of Patent Applications and Documents Permitted to be Filed via the Patent Electronic System.*

#### **a. Filings Permitted by Registered Users.**

Registered users (*see* section E) may file the following applications, requests for reexamination, and other documents via the Patent Electronic System:

1. Provisional patent applications filed under 35 U.S.C. 111(b).
2. Nonprovisional utility patent applications filed under 35 U.S.C. 111(a), which can include other papers such as Track One requests.
3. Nonprovisional design patent applications filed under 35 U.S.C. 171.
4. Plant applications under filed under 35 U.S.C. 161.

5. International applications filed under the PCT in the United States Receiving Office (*see* 35 U.S.C. 361).

6. Submissions to enter the national stage under 35 U.S.C. 371.

7. International design applications filed under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (*see* 35 U.S.C. 382).

8. Requests for *ex parte* reexamination under 35 U.S.C. 302 for utility or design patents, as a new submission (i.e., not in the patent file).

9. Requests for supplemental examination under 35 U.S.C. 257 for utility, design, or plant patents, as a new submission (i.e., not in the patent file).

10. Petitions to make special based on age under 37 CFR 1.102(c), requests for Patent Prosecution Highway, and requests for Prioritized Examination under 37 CFR 1.102(e).

11. Reissue applications.

12. Initial applications for patent term extension, initial applications for interim patent term extension, subsequent applications for interim extension and requests for interim patent term extension under 35 U.S.C. 156. *See* 88 Fed. Reg 13028 (March 2, 2023).

13. Authorized third-party requester papers in a reexam, e.g., requests for reexamination, third-party petitions under 37 CFR 1.515(c), third-party replies under 37 CFR 1.535 and other authorized oppositions to patent owner petitions.

14. Third-Party Preissuance Submissions under 35 U.S.C. 122(e) and 37 CFR 1.290 for utility, design, or plant patent applications using a dedicated electronic interface. By using the dedicated electronic interface the information is not directly placed into the application (see section I).

15. Citation, by third-parties, of prior art and written statements in patent files under 35 U.S.C. 301 and 37 CFR 1.501 for utility applications using a dedicated electronic interface. By using the dedicated electronic interface, the information is not directly placed into the patent file (see section I).

16. Designation of a fee address prior to issuance of a Notice of Allowance, based on the information entered into the Patent Electronic System. This waiver does not apply to uploading a fee document into Patent Center.

This is not intended to be an exhaustive list; generally, all documents filed in a patent application may be filed via the Patent Electronic System except those listed in section B2.

b. Filing of Documents after the Initial Submission of the Application (“follow-on” documents).

Follow-on documents are any documents filed after the initial submission of the application, request for reexamination, or request for supplemental examination. Follow-on documents include but are not limited to the following: amendments, information disclosure statements (IDSs), replies to Office actions and notices, declarations, evidence, petitions, and terminal disclaimers. 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 that they are authorized to file via the Patent Electronic System, 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 the Patent Electronic System.

Any follow-on document must be signed in accordance with 37 CFR 1.33(b) and it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number, e.g., 07/123,456), or the serial number and filing date assigned to that application by the USPTO, the international application number of the international application (PCT), or the international registration number of the international design registration. *See* 37 CFR 1.4, 1.5 and 1.33(b).

Only registered users may file follow-on documents via the Patent Electronic System. Parties who are not registered users may file follow-on documents by mail (see 37 CFR 1.8 for timely filing by first class mail), Priority Mail Express® from the USPS in accordance with 37 CFR 1.10, or hand-delivery. Regardless of the means of submission, users must have authorization to act under 37 CFR 1.32 or 37 CFR 1.34.

*B2. Types of Patent Applications and Documents **Not** Permitted to be Filed via the Patent Electronic System.*

The following is a list of submission types that are **not** permitted to be filed using the Patent Electronic System:

1. Applications and follow-on documents where the filer is not a registered user. Parties who are not registered users may file applications and follow-on documents by mail (see 37 CFR 1.8 for timely filing of certain follow-on papers by first class mail), Priority Mail Express® from the USPS in accordance with 37 CFR 1.10, or hand-delivery. Regardless of the means of submission, users must have authorization to act under 37 CFR 1.32 or 37 CFR 1.34.

2. Third-party inquiries, petitions, or papers, unless specifically authorized by this Legal Framework and filed in the manner required by the Patent Electronic System interface. *See* B1 discussed previously.

For example, a third party may file a citation of prior art and written statements in patent files under 37 CFR 1.501 or a Third-Party Preissuance Submission under 37 CFR 1.290 via the Patent Electronic System; however, the filer must select the appropriate option identifying the type of submission or the submission will be improper. Third-party filing of papers directly into an application, patent, or reexamination is not permitted under the regulations or this Legal Framework. The USPTO considers any third-party inquiry or submission in an application that is not provided for in 37 CFR 1.290 to be inappropriate. A third-party is someone other than the named applicant or someone who represents the named applicant. Any third-party paper improperly entered into an application will be removed. Any third-party paper directly submitted in an application after pre-grant (18 month) publication, will be treated as a protest and removed from the application. Some examples of third-party papers that may not be filed via the Patent Electronic System or in paper include: inquiries into the timing of future actions on an application; petitions, disputes over ownership; disputes over inventorship in an application; requests to change inventorship, correspondence address, a power of attorney; and statements under 37 CFR 3.73. As used in this paragraph, the term “third party” does not refer to a requester for reexam in accordance with MPEP 2212 or MPEP 2612.

Registration as a user of the Patent Electronic System does not confer authorization to file documents in applications, reexamination proceedings, or supplemental examination proceedings in which the user does not already have authorization to act. Authorization to act comes from being an applicant pursuant to 37 CFR 1.42 or a practitioner of record or acting in a representative capacity pursuant to 37 CFR 1.32 and 1.34, respectively. Only the applicant, a practitioner of record, or a person acting in a representative capacity for the applicant is permitted to file papers in an application or proceeding unless specifically authorized under this framework (*see* section E).

Note further that the Patent Electronic System may not be used by third parties to file papers that have no right to entry in an application or proceeding under USPTO rules and procedures. For example, a third party is prohibited from filing a demand that the USPTO withdraw an application from issue under 37 CFR 1.313 on the basis of unpatentability of a claim, and may not attempt to use the Patent Electronic System to evade this prohibition.

3. Correspondence concerning registration to practice.

4. Certified documents as specified in 37 CFR 1.4(f). *See also* 37 CFR 1.6(d)(2).



5. Certified copies of priority documents are not effective if filed via Patent Electronic System. An example of such a submission is a certified copy of a foreign application filed pursuant to 35 U.S.C. 119 and 37 CFR 1.55 or a certified copy of an international application filed pursuant to 35 U.S.C. 365 and 37 CFR 1.78(d)(7).

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

7. Documents filed in contested cases and trials before the PTAB, except as the PTAB may expressly authorize. *See also* 37 CFR 1.6(d)(7).

8. Documents filed in contested cases and trials before the PTAB, which are governed by 37 CFR part 41, subpart D and part 42, respectively. For example, petitions for *inter partes* review, post grant review, covered business method patent review, and derivation proceedings cannot be filed via the Patent Electronic System, but instead are filed electronically via the P-TACTS at [ptacts.uspto.gov/ptacts/ui/home](http://ptacts.uspto.gov/ptacts/ui/home). *See also* 37 CFR 1.6(d)(3), 1.8(a)(2)(i)(B) and (C).

9. Correspondence filed in connection with a disciplinary proceeding under 37 CFR part 11. *See also* 37 CFR 1.6(d)(3) and 1.8(a)(2)(iii)(A).

10. Maintenance fees submitted under 37 CFR 1.366 that are not submitted with a petition under 37 CFR 1.378. Patent owners may pay electronically using the Patent Maintenance Fees Storefront at [fees.uspto.gov/MaintenanceFees](http://fees.uspto.gov/MaintenanceFees). *See* MPEP 2510 for information regarding the proper methods for submitting maintenance fees.

11. Assignment documents under 35 U.S.C. 261, which may be electronically filed using the Assignment Center. Information regarding Assignment Center is available at [assignmentcenter.uspto.gov](http://assignmentcenter.uspto.gov).

12. Submissions that are not associated with a patent, patent application, international design application, reexamination proceeding, or supplemental examination proceeding.

13. Notices of appeal to a court, district court complaints, or other complaints or lawsuits involving the USPTO. *See* 37 CFR 90.2 and 90.3, and MPEP 1216 for instructions on how to properly serve and/or file such documents seeking judicial review of a decision by the PTAB.

If a document or submission listed previously is submitted via the Patent Electronic System, the document or submission will not be accorded a date of receipt and it will not be considered officially filed in the USPTO. Furthermore, no benefit of the date of filing via the Patent Electronic System will be given to a certificate of transmission under 37 CFR 1.8 for the document or submission.

### *B3. Processing of Certain Types of Papers Filed Electronically.*

Registered users may use the Patent Electronic System to submit web-based documents such as ePetitions and eTerminal Disclaimers. These ePetitions and eTerminal Disclaimers are auto-processed and granted or approved immediately upon submission if the ePetition or eTerminal Disclaimer meets all of the requirements. See the ePetition Resource Page at [www.uspto.gov/patents-application-process/applying-online/epetition-resource-page](http://www.uspto.gov/patents-application-process/applying-online/epetition-resource-page) for a list of ePetitions. Examples include Request for Withdrawal as Attorney or Agent of Record and Petitions to Withdraw from Issue after Payment of the Issue Fee.

Registered users may sign into the Patent Electronic System and provide information in web-based interfaces. An ePetition or eTerminal Disclaimer document is generated by the Patent Electronic System based on the entered information. The generated document may be reviewed prior to submission to ensure accuracy. This document and a decision granting the ePetition or an approval letter approving of the eTerminal Disclaimer will be placed into the application file if the ePetition is granted or the eTerminal Disclaimer is approved respectively. If the ePetition or eTerminal Disclaimer does not meet all of the formal requirements, it will not be accepted for submission and will not be placed into the application file.

See the ePetition Resource Page for a list of petitions that may be auto-processed when submitted by registered users.

### *B4. The Official Record of Documents Submitted via the Patent Electronic System.*

When the USPTO successfully receives documents filed in accordance with the Patent Electronic System requirements, the USPTO may convert the files submitted by users into a different format for storage as part of the official record, in addition to those drawings which are stored in the USPTO's Electronic Repository or content management system (CMS), as part of the official record (i.e., color and grayscale drawings and drawings submitted in design applications). The USPTO may scrub certain metadata. *See* 85 FR 46932 (August 3, 2020). DOCX files are converted to PDF, but the authoritative document is the DOCX file. *See* 86 FR 29571 (June 2, 2021). The USPTO will also store JPEG drawing files successfully received in international design applications in accordance with the Patent Electronic System requirements in the USPTO's Electronic Repository as part of the official record. In addition, certain submissions filed as ASCII plain text files (e.g., sequence listings or computer program listings) or XML files are stored in the USPTO's Electronic Repository as part of the official record. Accordingly, the official record for the patent, patent application, international design application, reexamination proceeding, or supplemental examination proceeding comprises:

1. ASCII text documents and drawings stored in the USPTO's Electronic Repository as previously set forth;

2. Converted versions of all other original documents as stored in the USPTO's Electronic Repository;

3. The Electronic Acknowledgement Receipt and the electronic payment receipt, both of which contain information entered via the Patent Electronic System graphical user interface (GUI) data collection interfaces; and

4. Documents stored in the USPTO's Electronic Repository in international design applications generated from XML data received from the International Bureau.

The original documents submitted via the Patent Electronic System (e.g., applications, and reexamination and supplemental examination proceeding documents) are stored exactly as filed in an independent location. Section L of this framework provides more information on XML and ASCII text documents, sections K and M2 provide more information on color and grayscale drawings, and section N provides information on international design applications. Submissions for pre-grant publication using the option in the existing submissions menu are forwarded to the Pre-Grant Publication Division and are not placed in the application or stored in the USPTO's Electronic Repository as part of the official record of the patent application. Section G includes more information on publication requests. Section O provides information about plant patent applications.

*B5. Treatment of Internally Inconsistent Information Submitted via the Patent Electronic System.*

When filing a new application via the Patent Electronic System, the Patent Electronic System requires the input of certain application data. This includes the type of application being filed (e.g., nonprovisional application under 35 U.S.C. 111(a), U.S. national stage application under 35 U.S.C. 371, international application (PCT), or international design application), the title of the application (unless the application is an international design application), the name of an inventor or applicant, and a correspondence address. In addition, other application data, such as a docket number, may be provided.

The USPTO will treat the indicated application type as an instruction to treat the submission as that application type, and the submission will be routed to the appropriate area of the USPTO for processing based on this instruction. Where the submission includes conflicting indications as to the type of application being filed, the USPTO will treat the submission in accordance with the applicable U.S. rule (*see e.g.*, 37 CFR 1.495(g)). If there is no provision under the U.S. rules to resolve such conflict, the USPTO may treat the submission in accordance with the indication provided in the Patent Electronic System. Where conflicting indications are present, a petition under 37 CFR 1.182 may be required to change the USPTO's treatment of the submission to an application type consistent with an indication provided in the submission.

In the case of other conflicting information in the submission, the conflict will be resolved in accordance with the applicable regulations. For example, inventorship will be

determined in accordance with the provisions of 37 CFR 1.41. Where no correspondence information is included in the submission, or the correspondence information was not made in accordance with the applicable regulations, the USPTO may use the application data furnished through the Patent Electronic System for purposes of correspondence until corrected by the applicant. For example, the USPTO may use the correspondence address associated with a customer number entered through the Patent Electronic System rather than an address furnished in an unsigned paper in the new application submission. A petition under 37 CFR 1.182 may be required to correct inconsistencies in the international application number indicated in the submission to enter the national stage under 35 U.S.C. 371, for example, where there is an inconsistency between the international application number entered on the data entry screen of the Patent Electronic System and the international application number indicated in the submitted documents.

*B6. Determination of the Paper Size Equivalent for Applications Filed via the Patent Electronic System for Application Size Fee Purposes.*

See 37 CFR 1.52(f)(2) and MPEP 607 for the paper size equivalency for application size fee purposes. The paper size equivalency under 37 CFR 1.52(f)(2) for Patent Electronic System filings does not apply to the application size fee under 37 CFR 1.492(j) for national stage submissions under 35 U.S.C. 371. *See* MPEP 1893.01(c).

*B7. Submission of Fee Payments via the Patent Electronic System.*

Only registered users may submit the filing fees (e.g., the basic filing fee, search fee, examination fee, and excess claims fee) using the online fee payment in the Patent Electronic System at the time of filing a patent application, request for reexamination, request for supplemental examination, or any related fee for a post grant submission (e.g., Certificate of Correction). Only registered users may submit payment of fees in a previously filed application, reexamination proceeding, or supplemental examination proceeding.

The Patent Electronic System permits users to electronically submit the payment of fees with a credit/debit card using a credit card interface, 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 the Patent Electronic System (e.g., a fee transmittal letter or form PTO/SB/17). However, users should not submit a credit/debit card charge authorization including the Credit Card Payment Form (PTO-2038) electronically via the Patent Electronic System, because the electronic submission will be loaded automatically into the application file, and the credit/debit card information may become part of the record of an application file that is open to public inspection.

A credit/debit card charge authorization transmittal (e.g., PTO-2038) may be submitted by facsimile transmission to the USPTO Central Facsimile (571) 273-8300, or sent via Priority Mail Express® 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 a national stage application 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 for purposes of the U.S. national phase.

If an 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 ET on the filing date of the application. Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 may be used to make the payment. See section C2 of this framework. The previous paragraph discusses alternative methods that may be used instead of the Patent Electronic System to pay the fees. Failure to pay the fees on the filing date of the application will result in a surcharge.

When the online fee payment in the Patent Electronic System is unavailable, submissions that require concurrent online fee payment, such as ePetitions, may not be filed. However, submissions that do not require concurrent online fee payments, such as those that do not require payment of fees or those that require fees which may be taken from a deposit account, can still be filed.

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

The Electronic Acknowledgement Receipt establishes the date of receipt by the USPTO of documents submitted via the Patent Electronic System. 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. The Electronic Acknowledgement Receipt is the electronic equivalent of the postcard receipt described in MPEP 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 of an application filed under 35 U.S.C. 111 via the Patent Electronic System 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 *Ex Parte* Reexamination Request Filing Date,” and the official supplemental examination filing date will be noted on the “Notice of Supplemental Examination 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 the Patent Electronic System 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 such situations, the user may have to resubmit any lost document and petition for its 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 1.182 with the appropriate petition fee under 37 CFR 1.17(f)).

The Electronic Acknowledgement Receipt, which includes a listing of the documents submitted and their file size, and the statement accompanying the petition under 37 CFR 1.53(e) or 1.182 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 during original submission does not match the document originally submitted. 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 a specification and set of claims on the original filing date. However, if the applicant actually filed two sets of claims and used an improper document descriptor to identify one set of claims as the specification without actually filing a specification, 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). 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. Users may take screen shots of the acknowledgement receipt during the filing process as evidence of any failure by the USPTO.

*C1. The Date of Receipt of a Follow-on Document Received by the USPTO Through the Patent Electronic System.*

Follow-on documents filed through the Patent Electronic System in an 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 also 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 the Patent Electronic System prior to expiration of the set period of time in accordance with the requirements for the Patent Electronic System; and

2. The document includes a certificate of transmission (e.g., form PTO/SB/92) 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 (a)(1)(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. The Date of Receipt of an Application Submitted via the Patent Electronic System.*

The time and date of receipt of an application filed via the Patent Electronic System is the local time and date in USPTO headquarters in Alexandria, Virginia. Accordingly, the date of receipt of an application officially submitted through the Patent Electronic System will be the date in the Eastern 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 Time zone date that the documents are fully, successfully, and officially received at the USPTO, after the user submits the documents via the user interface. *See* 37 CFR 1.6(a)(4). This date is controlling for filing date purposes of a newly filed application. The "certificate of transmission" practice set forth in 37 CFR 1.8(a)(1) does not apply to new application filings, as set forth in 37 CFR 1.8(a)(2).

For example, if an applicant in California officially files a patent application with the USPTO through the Patent Electronic System by submitting the application files at 10 p.m. Pacific Time in California on May 1, that application would be officially received by the USPTO at 1 a.m., local time (i.e., Eastern Time) on May 2. Accordingly, the application would receive a filing date of May 2. However, the applicant could alternatively file the application using Priority Mail Express® from the USPS in accordance with 37 CFR 1.10, in which case the applicant would have until midnight on May 1 in the applicant's local time zone to file the application and obtain a filing date of May 1.

### *C3. Hours of Operation for Filing via the Patent Electronic System.*

Hours of operation of the Patent Electronic System will be clearly provided in the Patent Electronic System 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 the Patent Electronic System 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, i.e., the Patent Electronic System is unavailable, 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 Priority Mail Express® 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, international applications (PCT), international design applications, reexamination requests, and requests for supplemental examination 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, copies of the international application and the basic national fees necessary to enter the national stage as specified in 37 CFR 1.495(b), and reexamination requests (37 CFR 1.8(a)(2)(i)(A), (D), and (F)). 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. Filing New Applications During an Unscheduled Outage of the Patent Electronic System.*

The USPTO will post a notice on its website of any designated significant unplanned outage of the Patent Electronic System. The notice will indicate the dates during which alternative filing methods are available.

During a designated significant unplanned outage of the Patent Electronic System, the USPTO may specify an alternative electronic filing procedure for new applications, national stage submissions under 35 U.S.C. 371, and/or other patent filings. This alternative electronic filing procedure may be specified on the Patent Related Notices page of the USPTO's website, or in any manner deemed appropriate by the Director of the USPTO. The alternative electronic filing procedure may be an entirely new procedure specified at the time, or may be the same as or similar to one that has been previously utilized. *See Filing Patent Applications Electronically During Designated Significant Outages of the United States Patent and Trademark Office Electronic Business Systems*, 83 FR 44264 (August 30, 2018). *See* section D1. An application filed during a designated significant unplanned electronic business system outage which complies with the alternative electronic filing procedure will be considered to have been filed by the USPTO's electronic filing system, and thus will not incur the fee required by section 10(h) of the Leahy-Smith America Invents Act for a patent application not filed electronically and will not incur the 37 CFR 1.16(u) non-DOCX surcharge.

During the dates indicated as a designated significant unplanned outage, applicants may file new applications, national stage submissions under 35 U.S.C. 371 submitted with the basic national fee necessary to enter the national stage, reexamination requests, and



requests for supplemental examination by either hand-delivery to the USPTO or Priority Mail Express® from the United States Postal Service (USPS) in accordance with 37 CFR 1.10, to establish the filing date or national stage submission date. New applications, national stage submissions under 35 U.S.C. 371 submitted with the basic national fee necessary to enter the national stage, reexamination requests, and requests for supplemental examination cannot be submitted by facsimile transmission, and certificate of mailing procedures under 37 CFR 1.8 do not apply to these items.

For additional information regarding national stage submissions under 35 U.S.C. 371 where the Patent Electronic System is available but the online payment system or internal databases are not available to permit payment online or filing of the national stage submission, see section M.

*C5. Inadvertent Omission of Documents Filed in a New Application via the Patent Electronic System.*

One advantage of filing a patent application electronically is that a registered user may view the submission in the Patent Electronic System and file a document directly into the application file 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 a new application in other situations.

The following examples describe scenarios raised when applicant inadvertently omits an item when filing an application under 35 U.S.C. 111 electronically via the Patent Electronic System.

1. Oath or Declaration—Applicant may file an executed oath or declaration on the same day as the filing date as the application via the Patent Electronic System. The oath or declaration will not be considered late, and 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 the Patent Electronic System. The fees will not be considered late, and a surcharge for filing the filing fees will not be required.

3. Nonpublication request—Because 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 the 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 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)(1). If the application was filed with the “wrong drawings” (i.e., drawings not related to the application filed), 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,” without raising new matter issues. 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.

6. Part of the specification—Applicant may file any 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 attempts to correct an error in a first application by filing a second application, the error will remain uncorrected in the first application and 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 petition for express abandonment. *See* MPEP 711.01. Please note that any fees paid in the first application will not be applied to the second application. Applicant may request a refund of the search fee and any excess claims fees (but not the basic filing fee, examination fee, and application size fee, if any) paid in the first application if the application was filed under 35 U.S.C. 111(a) and the applicant files a petition for express abandonment in accordance with 37 CFR 1.138(d). Further, in accordance with 37 CFR 1.59(a), information forming part of the original disclosure will not be expunged from the application file. *See* MPEP 724.05(IV).

*C6. Legal Consequences of the USPTO’s Accepting Electronic Patent Applications on Saturday, Sunday, and Holidays.*

Applicants may file patent applications electronically during the hours of operation of the Patent Electronic System every day of the week, including weekends and holidays. The Patent Electronic System 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 the fee paid, on the next succeeding secular or business day.

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

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 within the District of Columbia, regardless of the mode or form of filing.

However, Article 4 of the Paris Convention addresses the priority period. Article 4(C)(3) 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.

As previously stated, the USPTO is capable of accepting electronic patent application filings every day of the week, including weekends and holidays, through the Patent Electronic System. Thus, applicants filing international applications with the United States Receiving Office or international design applications with the USPTO as an office of indirect filing 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. Specifically, the ability to file applications electronically on weekends and holidays in the USPTO could potentially result in loss of priority rights in foreign jurisdictions designated in either international applications filed under the PCT with the United States Receiving Office or international design applications filed with the USPTO as an office of indirect filing if applicants choose to avail themselves of 35 U.S.C. 21(b) or 119(e)(3). In such circumstances, other patent offices may deny the priority claim on the basis that the international application or international design application was not timely filed if their national law strictly incorporates the provision of Paris Convention Article 4(C)(3) such that it considers the USPTO to be open for the filing of applications on weekends and holidays. For this reason, applicants should consider whether to rely upon the “next business day” provisions of 35 U.S.C. 21(b) and 119(e)(3) when filing international applications or international design applications with the USPTO, and instead file the international application or international design application before the Paris Convention priority period has expired.

#### **D. Proper Usage of the Patent Electronic System.**

Users should follow the instructions and guidelines for the Patent Electronic System provided on the USPTO.gov website. Before making a submission, 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 confirms

and submits the documents, 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 (the local time and date in Alexandria, VA, which is located in the Eastern Time zone). *See* 37 CFR 1.6(a)(4) and section C2 of this framework. Use of the Patent Electronic System in a manner in violation of the instructions and guidelines for the Patent Electronic System provided on the USPTO website and in this framework 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 the Patent Electronic System must be free of executables, worms, viruses, or any other type of potentially malicious content. Please note that under 18 U.S.C. 1030 users may not intentionally cause damage to federal government computers.

Users may review and check their electronic submissions before submitting the documents to the USPTO. After submitting the documents via the Patent Electronic System, the system will display a page that states the USPTO has received the user's submission and for new applications provides an application number. Users of the Patent Electronic System will receive an Electronic Acknowledgement Receipt (which can be printed or saved) of a successful submission received by the USPTO on their device, usually within a few minutes. Users are strongly encouraged to keep a copy of the Electronic Acknowledgement Receipt. *See* section C of this framework for more information. A copy of the receipt is entered into the application file and may be obtained by accessing the Documents tab of the Documents & Transactions section of the Patent Electronic System. 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* MPEP 503. Most documents submitted via the Patent Electronic System will be viewable by the registered user within an hour after the USPTO receives the documents, if the user has associated the application with the user's customer number. This provision will enable registered users to check the contents of their applications for completeness and accuracy of their electronic submissions. Users may also choose to receive an emailed acknowledgment containing limited information such as the application number.

*D1. New non-provisional applications should be filed in DOCX format.*

On January 17, 2024, the USPTO implemented a surcharge for utility non-provisional applications filed under 35 U.S.C. 111 in which the specifications, claims, and abstract are submitted in a format other than DOCX (structured text). *See* Setting and Adjusting Patent Fees During Fiscal Year 2020, 88 Fed. Reg. 36956 (June 6, 2023). This surcharge applies to filings that are submitted in an electronic document, such as a PDF, that is not saved in the DOCX format. In accordance with 37 CFR 1.115(a), a preliminary amendment that is present on the filing date of an application is part of the original disclosure of the application. Thus, if a preliminary amendment to the specification, claims, and/or abstract is filed on the same day as the application, the amendment must

be in DOCX format to avoid the non-DOCX surcharge. A preliminary amendment filed after the filing date of the application will not incur the non-DOCX surcharge because it is not part of the original disclosure of the application and thus is not required to be in DOCX format. The non-DOCX surcharge also applies to filings that are submitted non-electronically, in addition to the existing paper filing surcharge, except as discussed in section C4 of this framework. XML generated from DOCX files complies with the World Intellectual Property Office (WIPO) Standard ST.96.

Preliminary validation is performed on DOCX documents at the time of upload. The Patent Electronic System may immediately detect and supply the applicant with useful error and warning messages, allowing for adjustments to patent applications earlier in the process. “Text ornaments” (“printers’ ornaments”), or text decorations, may be automatically removed as they may not be presented in a form that allows direct reproduction of readily legible copies. *See* 37 CFR 1.52. A warning will be provided to users upon removal.

#### *D2. Filing documents as PDF Files via the Patent Electronic System.*

The Patent Electronic System accepts standard PDF documents up to 25 megabytes for each file and a limited number of electronic files per submission. For international design applications, the Patent Electronic System can accept more electronic files in a single submission, subject to certain conditions. Section L4 of this framework contains more information. PDF files created from scanned documents and submitted via the Patent Electronic System 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, certain PDF features are currently not supported by the USPTO systems. Where a PDF uses features that are not supported by the Patent Electronic System, the complete document may not be officially filed at the USPTO, in which case the user cannot rely on the Electronic Acknowledgement Receipt as evidence that the completed document was filed at the USPTO. Users are encouraged to check the contents of their submissions for completeness and accuracy.

Users must follow the PDF guidelines for the Patent Electronic System and PDF Creation for the Patent Electronic System (available on the USPTO website) to create and submit PDF files to ensure that all of the information in the PDF files is successfully received and processed by the USPTO.

#### *D3. Entering Information using the Patent Electronic System.*

The Patent Electronic System collects information from on-screen entries made by the user through data collection interfaces. Through these data collection interfaces, 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. When filing a new application, USPTO systems will use the information entered by the user on the interfaces to automatically assign the application number, create the application, and process the application. When filing a follow-on document, the USPTO system will upload the follow-on document into the application file specified by the user; or message the deciding official based on the document description selected by the user. Providing incorrect information regarding the submission could lead to, for example: (1) an incorrect type of application file being created; (2) a delay in processing the document; (3) a document being filed in an incorrect application; and/or (4) the deciding official not recognizing the document in sufficient time to take the requested action.

a. Filing a new application or post-grant filing.

When a user is submitting a new application or post-grant filing via the Patent Electronic System, the user is required to select the application type (e.g., design, plant, utility, provisional, nonprovisional, reexam or reissue) being filed on the electronic interface. 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. Submissions will be filed and routed in accordance with the user's selection. Therefore, it is important for the user to select the correct application type on the electronic interface and to review the Electronic Acknowledgement Receipt and the application file using the Patent Electronic System after the submission is completed.

b. Follow-on documents.

When a user submits a follow-on document (e.g., a reply to an Office action or notice) in the Patent Electronic System, the user is required to enter the correct application number, control number or proceeding 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 and the intended application could become unintentionally abandoned for failure to reply to the Office action or notice; this also applies to reexamination proceedings and supplemental examination proceedings. Therefore, it is important for the user to enter the correct application number and confirmation number on the Patent Electronic System screen when filing any follow-on documents. Furthermore, there is no provision which permits, as a matter of right, filing a follow-on document as a new application and subsequently moving the document to a different application.

After the submission of the follow-on document is completed, the user should check the Patent Electronic System to review the application file and check whether the follow-on document has been filed in the correct application. Checking the application file would

also help the user to discover other filing errors, such as filing a wrong document or omitting a portion of the document. If a document was submitted in the wrong application, applicant should promptly file the document in the correct application.

Documents filed via the Patent Electronic System are considered to be correctly filed in an application if they are matched with the application number given by applicant for the electronic filing, even if the identifying information in the heading of the papers is directed toward a different application. *See* MPEP 724.05(III). To expunge a document unintentionally submitted in the wrong application, applicant may file a petition under 37 CFR 1.59(b). *See* MPEP 724.05(II). When applicant has improperly filed a follow-on document in the wrong application with inconsistent information and desires to have it placed in the file of the intended application, a petition under 37 CFR 1.182 may be filed in the intended application to move the document from the incorrect application to the intended application, however this may cause a patent term adjustment reduction. Alternatively, applicant may refile the document in the correct application.

#### c. Document indexing.

When a user submits an application or a follow-on document in an application using the Patent Electronic System, the user must currently select from the list of document descriptions to specify the files being submitted electronically. Based on the document description selected by the user, a document code is assigned and, when necessary, 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, internal USPTO 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.

More information on document indexing is available on the USPTO.gov website. It is important for users to select the correct document description and check the application file via the Patent Electronic System after the submission is completed.

#### *D4. Refunds for Fees Paid via the Patent Electronic System Due to System Malfunction.*

The USPTO will grant refunds to users when, due to a malfunction within the Patent Electronic System, the 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. Users should contact the Patent EBC if there are any issues associated with their submissions.

## **E. Security and Authentication.**

The Patent Electronic System, including the search and viewing system within Patent Center, utilizes a two-step authentication paradigm requiring each individual registered user to have a unique USPTO.gov account. USPTO.gov accounts are limited to natural persons and cannot be obtained by non-natural persons. USPTO.gov accounts are based on email address, and each account uses the email address as the account name or user ID. USPTO.gov accounts can be created and managed through the MyUSPTO homepage (*my.uspto.gov*). Note that users of Financial Manager system may already have an existing USPTO.gov account.

A practitioner must be a registered user to sponsor support staff individuals. The sponsored support staff individual for practitioners must obtain their own credentials and be sponsored by the practitioner who directs and controls the non-practitioner's work. As USPTO.gov accounts are limited to natural persons, practitioners may not sponsor automation or Artificial Intelligence based tools as a support staff individual to obtain an account. *See* Guidance on Use of Artificial-Intelligence-Based Tools in Practice Before the United States Patent and Trademark Office, 89 FR 25609 (Apr 11, 2024). Credentials must only be used by the person to whom they are registered and assigned. Sharing of credentials is not permitted. When a sponsoring relationship no longer exists (e.g., the practitioner or the sponsored support staff individual are no longer at the same firm) the sponsoring practitioner must remove the sponsorship.

More information about the authentication process and user accounts may be found on the USPTO web site at *www.uspto.gov/patents/apply/patent-center/legal-information-and-guidance*.

### *E1. Persons Who May Access the Patent Electronic System.*

Inventors, applicants, and patent practitioners, i.e., patent attorneys and agents registered to practice before the USPTO, may become registered users of the Patent Electronic System. The term “registered user” as used in this Legal Framework refers to a user who has: (1) created a USPTO.gov account; and (2) established identity verification for that USPTO.gov account to the satisfaction of the Director. Approved identity verification procedures currently include the Patent Electronic System Verification Form (Verification Form) and the Online Patent Electronic System Verification Service (Online Verification) available on the USPTO website. The USPTO currently uses ID.me to conduct online identity verification of users but may choose to use a different service in the future.

The list of approved identity verification procedures is within the discretion of the Director. Additionally, the list of approved identity verification procedures may be different for different types of Patent Electronic System accounts. For example, the identity verification procedures approved for patent practitioners may be different than those approved for inventor accounts (i.e., *pro se* accounts). The creation of a registered



user account does not establish permanent access to the Patent Electronic System as a matter of right; a user or all users may be required to complete renewed, additional, supplemental, or enhanced identity verification.

The term “identity verification” as used in the Legal Framework means establishing the identity of a natural person. A person may not use the credentials of another to access the Patent Electronic System. A patent practitioner may sponsor other individuals who get their own credentials to access the Patent Electronic System so as to access information and file documents on behalf of that patent practitioner. See section E2 of this framework for more information on sponsorship.

Only registered users may use the Patent Electronic System. Registration is not required to use the Open Data Portal (ODP). The ODP provides status information about, and permits users to view, application files that are available to the public in accordance with the provisions of 37 CFR 1.11 and 1.14. Nonpatent literature (NPL) documents are not able to be viewed using ODP and only the patent applicant is able to use the Patent Electronic System to view a NPL document in their application. For information on access to patent application files generally, *see* MPEP 103, 104, and 1128.

Additional security measures may be established for accessing the Patent Electronic System, for filing documents using the Patent Electronic System, or both. These additional security measures may include two-step authentication, entry of a confirmation code specific to an application, a security mechanism configured to distinguish between human access and bot access, or other security mechanisms as determined appropriate by the Director.

The USPTO may immediately revoke an account, including a registered user account, at any time without prior notice if:

1. the account is used in a manner that does not comply with this Legal Framework, the laws, regulations or policies of the USPTO, or the Patent Electronic System subscriber agreement;
2. the identity information corresponding to the account is falsified, incorrect, or not updated;
3. the USPTO knows or suspects that the account has been compromised;
4. there is unauthorized use such as gaining access, or attempting to gain access, to nonpublic information or inadvertently disclosed nonpublic information;
5. the account is used to view another applicant’s unpublished application without authorization;
6. there is a refusal to destroy, cease dissemination, and/or retrieve any dissemination of any inadvertently disclosed or other nonpublic documents;

7. the account is associated with any activities or operations that cause a denial or decrease of services to other accounts;
8. the account is used to make an improper submission through the Patent Electronic System (*see* section B of this framework);
9. there is a lack of filing activity; or
10. for any reason the USPTO deems necessary.

*E2. Authorization to File Documents, Access Information, and Pay Fees Through the Patent Electronic System.*

Registered users are permitted to access and file follow-on documents in applications in which they are acting on behalf of the applicant and in reexamination and supplemental examination proceedings in which they are acting on behalf of the owner.

Documents submitted through the Patent Electronic System must be signed in accordance with 37 CFR 1.4, 1.33(b), and 11.18. Registered users who are joint inventors, or who represent less than all inventors or less than all applicants, may access their applications, but may not file documents lacking the signatures of all applicants unless specifically authorized under this framework. A sponsored support individual may file documents that are properly signed by the practitioner who directs and controls that individual's work. Such a sponsored support individual, who is not an authorized party to sign the documents, is not responsible for the contents of the documents submitted. For all submissions through the Patent Electronic System, the person who signs the documents (e.g., the applicant or a patent practitioner who is representing the applicant) is responsible for the contents. For example, the documents may be electronically signed or ink signed by the applicant or patent practitioner of record in accordance with 37 CFR 1.4(d). The sponsored support individual who serves the ministerial function of pickup and delivery of documents may submit the signed documents electronically via the Patent Electronic System under the direction and control of the patent practitioner, but must use their own credentials. (Ink-signed documents can be electronically scanned and then e-filed.) Sponsored support staff must not use a practitioner's credentials. This sponsored support individual may also view and retrieve documents from the Patent Center Workbench under the direction and control of that practitioner.

It also should be noted that the sponsored support individual could pay the fees associated with the submission in the Patent Electronic System process. This is comparable to the paper practice in which law firms designate individuals to pay fees.

Note: Users are advised that the USPTO may revoke a user's Patent Electronic System account if the user makes an improper submission through the Patent Electronic System (*see* section B of this framework). *See also* section 5 of the -Patent Electronic System

Subscriber Agreement- (available at [www.uspto.gov/patents/apply/patent-center/legal-information-and-guidance](http://www.uspto.gov/patents/apply/patent-center/legal-information-and-guidance)).

### *E3. Patent Electronic System Subscriber Agreement.*

The Patent Electronic System subscriber agreement (November 2018) explains that a holder of a Patent Electronic System account must update changes in the information in their Patent Electronic System Verification Form (Verification Form) within thirty (30) calendar days of the change. Information may be updated by submitting a new Verification Form, limited information may be updated by contacting ID.me or other designated service, and additionally, some information can be updated on the account holder's USPTO.gov account profile.

A Patent Electronic System account holder may only use the account for applications for which the account holder has authorization to access. Unauthorized use, such as attempting or gaining access to nonpublic information or inadvertently disclosed nonpublic information, may lead to immediate revocation of the Patent Electronic System account. A Patent Electronic System account holder may only use the account for securing communication with the USPTO, and must not share their Patent Electronic System account log-in credentials with others.

A Patent Electronic System account holder who is a practitioner may grant sponsorship to a reasonable number of practitioner support individuals (including contractors) to work on the practitioner's behalf under the practitioner's direction and control. A sponsoring practitioner must take reasonable steps to ensure that the access of each sponsored practitioner support individual is consistent with the tasks assigned to that individual. Such reasonable steps include removing sponsorship where appropriate, including where the individual leaves the practitioner's organization or the contractor's organization or when the contractor is no longer under contract to the practitioner or the practitioner's organization. A sponsoring practitioner can use the Sponsorship Tool of the Patent Center Sponsorship Page to identify the people who have already been sponsored and to add and delete names.

Each of the practitioner-sponsored support individuals must have their own USPTO.gov account and must not share accounts with other support individuals. Each sponsored practitioner support individual must only be: an employee of the practitioner or an employee of practitioner's organization; an individual under contract to the practitioner or the practitioner's organization; or an employee of a contractor under contract to the practitioner or the practitioner's organization. A practitioner may not sponsor an individual who has previously been found to have violated the USPTO Patent Electronic System Subscriber Agreement.

A practitioner may only sponsor practitioner support individuals that work under their direction and may not sponsor any other individuals or organizations, including a company, a group, a client, another practitioner (*see* 37 CFR 11.1), or an invention

promoter (*see* 37 CFR 4.2(a)), to become users of the Patent Electronic System. A sponsoring practitioner is responsible for verifying the identity of any person who is sponsored as stated in the Patent Electronic System Access Document. A sponsoring practitioner may only sponsor a reasonable number of practitioner support individuals to work under their direction for whom the sponsoring practitioner can maintain proper control.

A sponsoring practitioner must take reasonable steps to ensure compliance by each sponsored practitioner support individual with the requirements set forth in the subscriber agreement, including the restrictions on the software use in section 6 of the Patent Electronic System Subscriber Agreement and the restrictions on the export (including deemed export) of technology and software included in patent applications in section 7 of the Patent Electronic System Subscriber Agreement. If a sponsored practitioner support individual is not a U.S. citizen, their access to the technology and software constitutes an export under the Bureau of Industry and Security (BIS) regulations (*see* 15 CFR 730.5).

A sponsored practitioner support individual's access to the Patent Electronic System may not extend beyond those duties performed under the direction and control of a sponsoring practitioner.

A sponsored practitioner support individual may only use their Patent Electronic System account to access, in an authorized support capacity, customer numbers and application information associated with their Patent Electronic System profile in accordance with the laws, regulations, and USPTO policies including this Legal Framework. A sponsored practitioner support individual may only use or rely on their Patent Electronic System accounts for communication with the USPTO in compliance with the laws, regulations, and policies of the USPTO.

More information about the Patent Electronic System subscriber agreement is available on the USPTO website.

A law firm should promptly remove any practitioner or practitioner support individual who leaves the firm from the list of practitioners associated with the law firm's Customer Number. A practitioner leaving a law firm can also remove themselves from the law firm's Customer Number. Practitioner-sponsored support individuals may remove sponsorship for themselves from a sponsoring practitioner.

Practitioners are reminded that the USPTO Rules of Professional Conduct include the confidentiality of information as specified in 37 CFR 11.106. It is the responsibility of the practitioner to ensure that the sponsorship of practitioner support individuals and the maintenance of customer numbers is consistent with the USPTO Rules of Professional Conduct.

A practitioner may be required to review, confirm, or renew sponsorship(s) at a designated interval or as deemed necessary. A practitioner's ability to sponsor

practitioner support individuals may be limited or removed based on a determination that the subscriber agreement has been violated, as deemed necessary, or at the discretion of the Director.

## **F. Signatures.**

Signatures included in image attachments submitted via the Patent Electronic System are governed by the requirements of 37 CFR 1.4(d).

If the signer is submitting an application through the Patent Electronic System, the signer may apply either a handwritten signature in compliance with 37 CFR 1.4(d)(1), an S-signature in compliance with 37 CFR 1.4(d)(2), or an electronic signature in compliance with 37 CFR 1.4(d)(4). Alternatively, correspondence submitted through the Patent Electronic System may be signed by a graphic representation of a handwritten signature as provided for in 37 CFR 1.4(d)(1) or a graphic representation of an S-signature as provided for 37 CFR 1.4(d)(2). *See* 37 CFR 1.4(d)(3). Follow-on documents, such as responding to a Notice to File Missing Parts of Nonprovisional Application or an amendment filed in an application, must also be signed in accordance with applicable requirements. *See* 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 via the Patent Electronic System, a signed transmittal form or a signed application data sheet (ADS) is recommended for identification purposes, and any nonpublication request and certification that accompanies the application must be signed. The correspondence address must be set forth in either an ADS or clearly set forth in another paper submitted with the application, which must be signed. *See* 37 CFR 1.33(a).

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). *See* 37 CFR 1.4(d)(5). Note that 37 CFR 1.4(d)(5) requires a person to insert their own signature in a document. *See* MPEP 502.02.

## **G. Submission of Pre-Grant (Eighteen-Month) Publication Requests via the Patent Electronic System.**

The Patent Electronic System enables registered 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). When filing pre-grant publication requests via the Patent Electronic System, the appropriate form-fillable application data sheet (form PTO/AIA/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” option on the user interface in the existing submissions menu. It is not

sufficient for a user to submit a document via the Patent Electronic System requesting amended publication, redacted publication, voluntary publication, or republication without also selecting the “Pre-Grant Publication” option in the existing submissions menu.

While the USPTO may publish certain amendments in the pre-grant publication, to be entitled to have the patent application publication be based upon a copy of the application (specification, drawings, and the application data sheet and/or the inventor’s oath or declaration) as amended, applicant must supply such a copy via the Patent Electronic System as previously set forth. *See* 37 CFR 1.215(c).

#### **H. Submission of Supplemental Examination Requests via the Patent Electronic System.**

Patent owners may submit a request for supplemental examination via the Patent Electronic System. When filing a new request for supplemental examination, the patent owner should select the filing option, “Post grant,” and then select “Request for Supplemental Examination.” Any paper(s) that are to be filed in an existing supplemental examination proceeding and any paper(s) that are to be filed in a reexamination proceeding ordered as a result of a supplemental examination proceeding may be filed by a registered user by: (1) selecting “Existing submissions” (e.g., a proceeding that has already been assigned a control number); (2) selecting “Documents/Fees for an existing application/proceeding;” and (3) entering the assigned control number and confirmation number for the proceeding. Please note that the interface may be updated in the future, and users may check with the Patent Electronic Business Center for assistance in using the PES interface.

#### **I. Filing of Third-Party Preissuance Submissions and Citation of Prior Art and Written Statements in Patent Files Filed via the Patent Electronic System.**

Registered users may submit a third-party preissuance submission for any non-provisional utility, design, or plant application, including any continuing application; the submission must comply with 37 CFR 1.290 to be entered. The application may be pending or abandoned and need not be published. To submit a third-party preissuance submission, the option “Filed third-party preissuance submission” under the “Existing submissions” menu must be selected. Select the “File third-party preissuance submission” and enter the Application Number and Confirmation Number. The Confirmation Number can be obtained by viewing the application in the Patent Electronic System. This places the submission in a segregated area separate from the application file. After review by appropriate USPTO personnel, the submission may be placed in the application file for consideration by the examiner.

Registered users may submit a prior art and/or written statement submission for entry into a patent file under 37 CFR 1.501. To be entered, the submission must be filed during the

period of enforceability of the patent. A submission into a patent file under 37 CFR 1.501 cannot be filed via the Patent Electronic System in design or plant patents. To submit a 37 CFR 1.501 submission, select “Prior Art Submission into Patent File under 37 CFR 1.501” and enter the Application Number and Patent Number. This places the submission in a segregated area separate from the patent file. After review by appropriate USPTO personnel, if it is compliance with 37 CFR 1.501, the submission will be placed in the patent file.

#### **J. Submission of Interim Copies of Foreign Priority Documents Filed via the Patent Electronic System.**

Interim copies of foreign priority documents as provided for in 37 CFR 1.55(j) may be submitted via the Patent Electronic System in (i) applications filed under 35 U.S.C. 111(a), except for national stage applications under 35 U.S.C. 371. *See* 37 CFR 1.55 for details regarding claims for foreign priority, including the timing for submitting interim copies. *See also* MPEP 215 et seq.

The following are Frequently Asked Questions (FAQs) regarding interim copies of foreign priority applications:

1. If an applicant submits an interim copy of a foreign priority application, will the applicant still need to provide a certified copy of the foreign priority document? How will an interim copy submission be reflected in the USPTO’s records?

Yes. If an applicant files an interim copy of a foreign priority application in compliance with 37 CFR 1.55(j), the applicant must provide a certified copy of the foreign priority document before patent grant in order to perfect the priority claim. An interim copy of a foreign priority application will be entered into the application in which it was filed and labeled as “Interim copy of Foreign Priority Document.”

2. Are there any special instructions for filing an interim copy of the foreign priority application?

Yes. Main parts of the interim copy of the foreign priority application, i.e., Abstract, Drawings, Specification, Claims, and, where applicable, Sequence Listing or Computer Program Listings, along with the separate cover sheet required by 37 CFR 1.55(j), may be filed as a single PDF file via the Patent Electronic System (or as a single paper document). The PDF file will be placed in the application, and applicants must select the document description “Interim copy of Foreign Priority Application” to index this document when filing online.

Application parts that were filed in a foreign patent office only as XML or plain text computer files, such as a Sequence Listing, lengthy Table(s), or Computer Program Listing appendix, may be filed on optical disc. If an XML or TXT file is filed on optical disc, the optical disc must be labeled as “XML File of Interim Copy of Foreign Priority

Application” or “Text File of Interim Copy of Foreign Priority Application” along with (1) the country code and application number of the foreign priority document, (2) at least two pieces of identifying information for the application (e.g., application number, docket number, title, etc.) in which the interim copy of the foreign application was filed, and (3) if multiple optical discs are submitted, a label indicating their order (e.g., “1 of X”).

The file name of each file must begin with the country code and application number of the foreign priority application of which it is a part (any punctuation or space in the application number must either be omitted or replaced with a dash “-” or underscore “\_” character); e.g., “EP111838637\_SequenceListing.txt” or “EP\_11183863\_7\_Table 2.” Where an original file must be split into multiple parts, the file name for each part should indicate the order, for example, EP111838637\_SeqList\_part1of2.txt and EP111838637\_SeqList\_part2of2.txt.

#### **K. Submission of Photographs and Drawings via the Patent Electronic System.**

For drawings, color drawings and photographs submitted in U.S. patent applications, *see* MPEP 608.02 and 37 CFR 1.84.

For drawings submitted in international applications (PCT), *see* MPEP 1825 and PCT Rule 11.13.

For drawings submitted in international design applications, *see* MPEP 1503.02 and 37 CFR 1.152.

Color drawings may be accepted in national stage applications. *See* MPEP 1893.03(f). Note that, because color drawings are not permitted in international applications (PCT), color drawings and color photographs filed in a national stage application under 35 U.S.C. 371 will be treated as an amendment and will be objected to if they introduce new matter.

Note that the Patent Electronic System may convert color drawings into black and white for placement within the application file. The examiners also have access to the color drawings in the applications.

##### ***K1. Types of Photographs and Drawings Permitted to be Filed via the Patent Electronic System.***

Black and white line drawings may be submitted via the Patent Electronic System in the types of applications and proceedings listed in section B1 of this framework.

Only black and white photographs, and black and white line drawings, may be submitted via the Patent Electronic System in international applications (PCT).

##### ***K2. Document Description for Photograph and Drawings.***



Users must select the correct document description when submitting photographs and drawings via the Patent Electronic System. 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 (PCT) and national stage applications under 35 U.S.C. 371; and (iv) reexamination proceedings for utility patents. These drawings will be converted into a different format and placed in the application file.

b. Black and white line drawings in design applications, including reissue design patent applications, international design applications, and reexamination proceedings for design patents. These drawings will be stored in a content management system, and a black and white copy will be placed in the application file along with a placeholder sheet indicating storage in a content management system.

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 and design patent applications under 35 U.S.C. 111(a), including reissue utility and design patent applications; (iii) national stage applications under 35 U.S.C. 371; (iv) international design applications; (v) reexamination proceedings for utility patents and design patents; and (vi) supplemental examination proceedings. These drawings will be stored in a content management system, and a black and white copy will be placed in the application file along with a placeholder sheet.

b. Black and white photographs and grayscale drawings in international applications (PCT). These drawings will be stored in a content management system, and a black and white copy will be placed in the application file along with a placeholder sheet.

### *K3. Additional Requirements.*

For color drawings in utility patent applications, a petition filed under 37 CFR 1.84(a)(2) explaining why the color drawings are necessary is required. *See* MPEP 608.02. Pursuant to 37 CFR 1.84(a)(2)(ii), only one set of such color drawings is necessary when filing via the Patent Electronic System. The document code for the petition is “PET.OP”. For color

drawings in design application pursuant to 35 U.S.C. 171 and plant applications pursuant to 35 U.S.C. 161, no petition is required.

The Patent Electronic System supports the use of black and white, color, or grayscale images within the DOCX or PDF document. However, grayscale or color images filed as “drawings—other than black and white line drawings” in a utility patent application will be electronically converted to black and white images when placed in the application file. 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 in the printed patent, images must be scanned at a minimum resolution of 300 DPI. Furthermore, the Patent Electronic System is only capable of displaying portrait orientation. Users should not submit landscape-oriented drawings via the Patent Electronic System because the system will automatically convert the image to portrait, which may cause the images to be distorted during viewing.

For international design applications, the Patent Electronic System supports the use of black and white, color, or grayscale images within a JPEG document. To obtain sufficient image quality for purposes of WIPO publication of the international registration and any subsequent U.S. patent that may issue thereon, image resolution should be 300 DPI. In addition, the images should have at least a one-pixel border and preferably a border of between 1-20 pixels. Section N includes further information concerning reproductions in international design applications.

## **L. XML Files, Text Files, and File Limits.**

### *L1. Biotechnology Sequence Listings, Large Tables, or Computer Program Listing Appendices Submitted as ASCII Text or XML Files via the Patent Electronic System.*

Large tables and computer program listing appendices may be submitted as ASCII text files with a “.txt” extension (e.g., “computer.txt”) for applications filed under 35 U.S.C. 111, national stage applications under 35 U.S.C. 371, reexamination proceedings, and supplemental examination proceedings. A sequence listing may similarly be submitted as an ASCII text file in accordance with 37 CFR 1.821 through 1.825, if the application filing date is before July 1, 2022. Applications with an actual filing date on or after July 1, 2022 that disclose nucleotide and/or amino acid sequences as defined in 37 CFR 1.831, including applications claiming benefit of, or priority to, an application filed before July 1, 2022, containing a sequence listing, must contain a computer readable sequence listing in XML format (“Sequence Listing XML”) in accordance with 37 CFR 1.831 through 1.835. Sequence listings in ASCII text or PDF format will not be accepted in applications with a filing date on or after July 1, 2022. Sequence listings in XML format will not be accepted in applications with a filing date before July 1, 2022. More information on the sequence listing requirement may be found on the USPTO webpage at [www.uspto.gov/patents/apply/sequence-listing-resource-center](http://www.uspto.gov/patents/apply/sequence-listing-resource-center).

The read-only optical disc practice of 37 CFR 1.52(e) remains a filing option. The electronic filing of international applications (PCT) is discussed in section M of this framework. (Note: All references to ASCII text in this document refers to ASCII plain text only.)

As discussed at MPEP 608.05, users may submit the following document types (specified in 37 CFR 1.77(b)(5)) as ASCII text or XML files via the Patent Electronic System provided the specification contains a statement in a separate paragraph that incorporates by reference the material in the ASCII text or XML file identifying the name of the file, the date of creation, and the size of the file in bytes:

1. A computer program listing (*see* 37 CFR 1.96);
2. A sequence listing, submitted under 37 CFR 1.821 for applications filed before July 1, 2022, or submitted under 37 CFR 1.831 for applications filed on or after July 1, 2022; 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. A table page is a page printed on paper in conformance with 37 CFR 1.52(b) and 1.58(c).

If the “Sequence Listing” required by 37 CFR 1.821(c) or “Sequence Listing XML” required by 37 CFR 1.831(a) was submitted in an international application (PCT) and published as part of the international application for which national stage is entered under 35 U.S.C. 371, then incorporation by reference of the material in this sequence listing into the specification is not required.

If the applicant amends an application to add or replace a sequence listing in ASCII text format (in compliance with 37 CFR 1.821 - 1.825) or XML format (in compliance with 37 CFR 1.831 - 1.835), the specification must be amended to contain an incorporation by reference statement of the sequence listing. *See* 37 CFR 1.825 and 1.835.

Section M5 of this framework contains more information on the sequence listing in international applications (PCT) and national stage applications under 35 U.S.C. 371.

#### *L2. How XML and ASCII Text Files Are Counted for Application Size Fee Purposes.*

Any sequence listing submitted as an XML file in compliance with 37 CFR 1.831(a) or as an ASCII text file in compliance with 37 CFR 1.821(c) via the Patent Electronic System 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)(2). Any computer program listing submitted as an ASCII text file via the Patent Electronic System that is otherwise in compliance with 37 CFR 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)(2).

Regarding a table submitted as an ASCII text file via the Patent Electronic System 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). Each table should be submitted as a separate text file. Further, the file name for each table should indicate which table is contained therein.

*L3. The Size Limit for XML Files, ASCII Text Files, and other files.*

The quantitative file size limits listed in this framework are subject to change, and users may contact the Patent Electronic Business Center for the most up-to-date limits.

The size limit for submission of a sequence listing in XML or ASCII text format via the Patent Electronic System is One hundred (100) megabytes. Because this size limit is based on technical limitations of the Patent Electronic System, it may change over time. If a user wishes to submit a sequence listing that exceeds these limitations, it is recommended that the user file the application without the sequence listing using the Patent Electronic System to obtain the application number and confirmation number, and then file the sequence listing on optical disc in accordance with 37 CFR 1.52(e) on the same day by using Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 or by hand-delivery, in order to secure the same filing date for all parts of the application. Note: a submission of a sequence listing in electronic form of 300 MB or more in size is subject to the fees set forth in 37 CFR 1.21(o) in view of the graduated fees for large sequence listings. A sequence listing may not be partitioned into multiple files for filing via the Patent Electronic System as the system is not currently capable of handling such submissions. The sequence listing must be in a single, separate XML file for applications filed on or after July 1, 2022. The sequence listing must be a single ASCII plain text file for applications filed prior to July 1, 2022. For additional information related to the submission of sequence listing XML and ASCII text files that exceed the size limit of the Patent Electronic System, *see* 37 CFR 1.824(b)(2) and 1.834(b)(2).

DOCX files are limited to 10 megabytes. For nearly 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 optical disc via Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 on the date of the corresponding electronic 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 on paper and include the electronic copies on optical disc in accordance with 37 CFR 1.52(e), however, submission of the application on paper would be subject to the non-electronic submission surcharge. 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 the Patent Electronic System. 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”).

See section N of this framework for additional information concerning file size limits for reproductions submitted in international design applications.

*L4. Limits on the Number of Electronic Files That May Be Included in a Single Patent Electronic System Submission.*

The Patent Electronic System places limits on the number of electronic files that may be submitted at one time. This limit is subject to change. Accordingly, if an application file includes more files than the current limit, it is recommended that the user submit fewer files in an initial filing via the Patent Electronic System at which time the application will be assigned an application number. 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.

*L5. Complex Work Units May Be Submitted Electronically via the Patent Electronic System.*

Complex work units (such as chemical structure drawings, mathematical formulae, and three-dimensional protein crystalline structure data and table data) may be submitted as ASCII text files via the Patent Electronic System for applications filed under 35 U.S.C. 111, national stage submissions under 35 U.S.C. 371, reexamination proceedings, and supplemental examination proceedings. Complex work units cannot be submitted as ASCII text files in international applications (PCT).

**M. New International Applications (PCT), New National Stage Submissions, and Associated Documents.**

The term “international application (PCT)” as used in this framework refers to an international application filed under the PCT. The term “national stage submission” as used in this section of the framework refers to an international application (PCT) designating the United States where a submission has been made to enter the U.S. national stage under 35 U.S.C. 371.

*M1. New International Applications (PCT) Filed Under the PCT with the United States Receiving Office.*

The Patent Electronic System enables users to electronically file international applications (PCT) with the United States Receiving Office (RO/US). The required page size for international applications (PCT) filed via the Patent Electronic System in PDF

format is A4 (29.7 cm x 21 cm). *See* PCT Rule 11.5. Section M7 contains more information about follow-on submissions during the international phase.

a. The Request: The Patent Electronic System permits users to submit zip files created by PCT-SAFE or ePCT.

A zip file created using PCT-SAFE or ePCT will contain the PCT Request and a fee calculation sheet in PDF format, which are placed in the application file by the USPTO. Note that PCT-SAFE software is no longer supported by WIPO and will not generate the Request form currently in use. Users of ePCT may create and electronically sign using an S-signature the PCT Request, including the Declaration of Inventorship, for the purposes of filing via the Patent Electronic System with the United States Receiving Office. PCT-SAFE and ePCT users may create a zip file containing a validated PCT Request which will entitle the applicant to a reduction of the international filing fee when the PCT-SAFE or ePCT zip file is included in a new international application (PCT) filed with the United States Receiving Office via the Patent Electronic System. *See* Use of WIPO's ePCT System for Preparing the PCT Request for Filing as Part of an International Application with the USPTO as Receiving Office, 81 FR 27417 (May 6, 2016). Alternatively, if the applicant chooses not to use PCT-SAFE or ePCT to create the PCT Request and fee calculation sheet, the applicant may use Form PCT/RO/101 (or equivalent) for the Request and include the PDF file in the Patent Electronic System submission.

b. Other Documents.

All other documents including application parts (e.g., description [excluding any sequence listing part], claims, drawings and abstract) and accompanying items must be separately prepared as PDF files and attached to the Patent Electronic System submission.

Section M5 of this framework provides more information on sequence listings.

More information regarding filing international applications (PCT) is available on the USPTO website ([www.uspto.gov/patents/basics/international-protection/patent-cooperation-treaty](http://www.uspto.gov/patents/basics/international-protection/patent-cooperation-treaty)).

*M2. Specific Requirements for Drawings or Photographs.*

a. International Application (PCT).

Drawings submitted in international applications (PCT) are required to comply with PCT Rule 11.13, which does not permit color drawings. Furthermore, there is no provision for photographs within the PCT Regulations. Nevertheless, black and white photographs will be accepted where it is impossible to represent in a drawing what is to be shown (e.g., crystalline structures). Color photographs are not permitted in international applications (PCT) (*see also* section K1).

The United States Receiving Office may invite the applicant to correct any defects in the drawings or photographs if they do not comply with PCT Rule 11.13.

b. National Stage Submission.

Because color drawings and color photographs are not permitted in international applications (PCT), color drawings and color photographs filed in a national stage application will be treated as an amendment and will not be entered if they introduce new matter. *See* 37 CFR 1.121(d) and (f). In addition, a grantable petition to accept color drawings or color photographs is required to accept such an amendment. *See* MPEP 1893.03(f). Section K1 includes more information regarding petitions to accept color drawings.

*M3. Specific Requirements Pertaining to New National Stage Submissions, Including the Payment of the Basic National Fee.*

a. Payment of the Basic National Fee.

The basic national fee is required in order for an international application (PCT) to enter the national stage under 35 U.S.C. 371. *See* 37 CFR 1.495. Users are permitted to submit the basic national fee with the national stage submission under 35 U.S.C. 371 via the Patent Electronic System using the USPTO payment page.

If the payment system is unavailable, the Patent Electronic System will not permit users to make payment using the interactive payment interface. The applicant may pay the basic national fee by either (a) including a written authorization to charge the fee to a deposit account together with the national stage submission under 35 U.S.C. 371, (b) hand-delivering the fee payment, or (c) sending the payment via Priority Mail Express® from the USPS in accordance with 37 CFR 1.10. To avoid abandonment of the application, the basic national fee must be furnished no later than expiration of thirty months from the priority date. *See* 37 CFR 1.495(b). Applicants may not submit the basic national fee via facsimile transmission. *See* 37 CFR 1.6(d)(3) and 1.8(a)(2)(i)(F).

For more information on fees associated with national stage submissions under 35 U.S.C. 371, *see* MPEP 1893.01(c).

b. Validation.

There can only be one national stage application under 35 U.S.C. 371 for an international application designating the United States. *See* 35 U.S.C. 363. For any new national stage submission under 35 U.S.C. 371 filed via the Patent Electronic System, the system automatically checks internal databases to verify that no previous national stage submission has been made for the particular international application (PCT) referenced in the new national stage submission. Patent Electronic System users should confirm that the correct international application (PCT) number is entered on the data entry screen to

ensure that the correct international application (PCT) is initialized as a national stage application. If the system finds a previous national stage submission has been made, the user will be given a warning message and an opportunity to verify, and correct if necessary, the referenced international application (PCT) number. If the international application number is correct and the user believes the prior initialization of a national stage application to be in error, the user may proceed to submit the national stage submission via the Patent Electronic System. However, the submission will be initialized as national stage application only after a determination is made by the Office that initialization is proper. Until initialization occurs, the application contents will not be viewable in the Patent Electronic System, and the submission of follow-on documents and online payment through the Patent Electronic System will not be possible. Accordingly, the applicant may wish to consider filing the submission via the Patent Electronic System as a utility nonprovisional application under 35 U.S.C. 111(a) while clearly indicating in the submission that the submission is a national stage submission under 35 U.S.C. 371 (preferably, by including 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) and an application data sheet identifying in the domestic benefit section that the application is a national stage application under 35 U.S.C. 371). Pursuant to 37 CFR 1.495(g), such a submission will be treated as a national stage application under 35 U.S.C. 371. *See* section B5.

If the internal databases are unavailable, the Patent Electronic System cannot complete the verification, and thus the Patent Electronic System will not permit a new national stage submission under 35 U.S.C. 371 to be filed. In such case, the user may file the submission via the Patent Electronic System as a utility nonprovisional application under 35 U.S.C. 111(a) while clearly indicating in the submission that the submission is a national stage submission under 35 U.S.C. 371. As indicated above, such a submission will be treated as a national stage application under 35 U.S.C. 371 pursuant to 37 CFR 1.495(g). Alternatively, applicants may send a new national stage submission by hand-delivery or by Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 to timely submit documents and fee(s) for national stage entry. Applicants may not file either a copy of the international application or the basic national fee necessary to enter the national stage as specified in 37 CFR 1.495(b) via facsimile transmission. *See* 37 CFR 1.6(d)(3) and 1.8(a)(2)(i)(F).

#### c. Transmittal Letter.

It is recommended that applicants 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 the Patent Electronic System at this time.



#### d. Application Data Sheet.

An application data sheet (ADS) is recommended for new national stage submissions.

#### e. Initial Processing.

If a timely submission to enter the national stage of an international application (PCT) 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. *See* Section B5 regarding the correction of inconsistency in the international application (PCT) number indicated in the submission to enter the national stage under 35 U.S.C. 371, and the treatment of a submission containing conflicting indications between an application under 35 U.S.C. 111 and a submission to enter the national stage under 35 U.S.C. 371.

#### *M4. Specific Requirements for Nucleotide and Amino Acid Sequence Listings in National Stage Applications.*

A national stage submission must contain a sequence listing as a part of the description of the application where a nucleotide and/or amino acid sequence that is required to be included in a sequence listing is disclosed. *See* 37 CFR 1.821 - 1.825 and 37 CFR 1.831 - 1.835. The international filing date (IFD) of the national stage submission determines the sequence rules that apply for the lifespan of the application. If the IFD of the international application (PCT) that entered national stage is before July 1, 2022, submission of a sequence listing in ASCII text format can fulfill the sequence listing requirements set forth in both 37 CFR 1.821(c) and 1.821(e). Although a sequence listing in PDF format can, alternatively, fulfill the sequence listing requirement of 37 CFR 1.821(c), this is not recommended because a sequence listing in ASCII text format would nonetheless be required under 37 CFR 1.821(e). If the IFD of the international application (PCT) that entered national stage is on or after July 1, 2022, submission of a sequence listing in XML format is required under 37 CFR 1.831(a).

Where the international application (PCT) has been published at the time of national stage submission, any sequence listing submitted in the international application (PCT) in compliance with PCT Rule 5.2 will be communicated by the International Bureau to DO/EO/US and a copy should not be submitted via the Patent Electronic System. Similarly, where the international application (PCT) contained a sequence listing submitted in compliance with PCT Rule 5.2 and was originally filed with the USPTO as receiving Office, a copy of the sequence listing should not be submitted via the Patent Electronic System with the national stage submission. If the PCT application is neither published by the International Bureau nor filed with RO/US, then applicant needs to provide a copy of the international application at entry into national stage (express request). A sequence listing filed with the international application (i.e., on the international filing date) is considered as part of the description of the international

application. Therefore, the copy of the international application needed from applicant at entry into national stage necessarily includes a copy of said sequence listing. It is not necessary to amend the general information part of the sequence listing submitted in the international application (PCT) to include the national application number.

Where the international application (PCT) is not in compliance with PCT Rule 5.2, applicant must file a sequence listing with the national stage submission, in compliance with 37 CFR 1.821-1.825 or 37 CFR 1.831 - 1.835. The description of the national stage application must be amended to add or replace the sequence listing. *See* 37 CFR 1.825 or 1.835.

If a sequence listing in XML format submitted in the international application (PCT) in compliance with PCT Rule 5.2 contains non-English language-dependent free text, an English translation of the sequence listing is required under 37 CFR 1.495(c)(1) and (5).

The size limit for submission of a sequence listing in XML or ASCII text format via the Patent Electronic System is One hundred (100) megabytes. If a user wishes to submit a sequence listing file that exceeds 100 megabytes, it must be transmitted on optical disc in accordance with 37 CFR 1.52(e) by using Priority Mail Express® from the USPS in accordance with 37 CFR 1.10, or by hand-delivery, in order to secure the same filing date for all parts of the application. *See* 37 CFR 1.824 and 1.834. Note that the surcharge for sequence listing of at least 300 MB, as per 37 CFR 1.21(o), applies to a sequence listing contained in a national stage submission whether this sequence listing was communicated by the International Bureau, contained in an international application (PCT) originally filed with the USPTO as receiving Office, or submitted during the national stage.

#### *M5. Specific Requirements for Nucleotide and Amino Acid Sequence Listings in International Applications (PCT).*

##### a. Sequence Listing.

Under PCT Rule 5.2(a), where the international application contains disclosure of one or more nucleotide and/or amino acid sequences as defined in paragraph 6 of Annex C of the Administrative Instructions under the PCT (AI Annex C), a sequence listing must always be included as a separate part of the description. When filing a new international application (PCT) on or after July 1, 2022 using the Patent Electronic System, the sequence listing part of the description must be submitted as a single file in Extensible Markup Language (XML) format that is compliant with WIPO Standard ST.26, as set forth in AI Annex C. This file will serve both as the sequence listing part of the description under PCT Rule 5.2 and the sequence listing used for the purpose of international search under PCT Rule 13<sup>ter</sup>.1(a). Accordingly, a statement that the information recorded in electronic form furnished under Rule 13<sup>ter</sup> is identical to the sequence listing as contained in the international application or to the effect that the

sequence listing does not go beyond the disclosure in the international application as filed is not needed. If the sequence listing XML file exceeds 100 megabytes in size, *see* Section M5(b). The sequence listing XML file will not be taken into account when calculating the international filing fee for excess sheet count. *See* Section M5(c).

A sequence listing furnished via the Patent Electronic System after the international filing date (IFD) for the purposes of international search under PCT Rule 13*ter*.1 or international preliminary examination under PCT Rule 13*ter*.2 may only be filed in ASCII text format if the IFD of the international application (PCT) is before July 1, 2022, and may only be filed in XML format if the IFD of the international application (PCT) is on or after July 1, 2022. If this later-furnished sequence listing in ASCII text format is identical to a sequence listing in PDF format that was submitted on the IFD and forms part of the international application, as indicated in Box No. IX of the Request form, then it must be accompanied by a statement that the information recorded in electronic form furnished under Rule 13*ter* is identical to the sequence listing as contained in the international application. In other situations, including where the IFD is on or after July 1, 2022, this later-furnished sequence listing must be accompanied by a statement to the effect that the sequence listing does not go beyond the disclosure in the international application as filed.

*See* 87 FR 30806 (May 20, 2022). *See* 37 CFR 1.821 through 1.825 for applications filed before July 1, 2022.

#### b. File Name and Size Limits.

The file name of a sequence listing in XML format submitted in an international application (PCT) must be named as \*.xml, where “\*” is one character or a combination of characters limited to an upper- or lowercase letter, number, hyphen (a.k.a. hyphen-minus; Unicode code point U+002D), and underscore (a.k.a. low line; Unicode code point U+005F), and the name does not exceed 60 characters in total, excluding the extension. No spaces or other types of characters are permitted in the file name. *See* 37 CFR 1.834(a). The file name of a sequence listing in ASCII text format submitted in an international application (PCT) must be named as \*.txt, where “\*” is one character or a combination of characters limited to an upper- or lowercase letter, number, hyphen (a.k.a. hyphen-minus; Unicode code point U+002D), and underscore (a.k.a. low line; Unicode code point U+005F), and the name does not exceed 60 characters in total, excluding the extension. No spaces or other types of characters are permitted in the file name. *See* 37 CFR 1.824(a). In addition to the file name requirements imposed by rule, technical considerations may necessitate further restrictions on the characters used in a filename. *See* [www.uspto.gov/patents/apply/applying-online/files-be-submitted-naming-pdf-files](http://www.uspto.gov/patents/apply/applying-online/files-be-submitted-naming-pdf-files) for current file naming conventions. *See* 37 CFR 1.824(a).

One hundred (100) megabytes is the size limit for sequence listing text and XML files submitted via the Patent Electronic System. Sequence listing files must not be partitioned

into multiple files for filing via the Patent Electronic System as the electronic filing system is not currently capable of handling such submissions.

In the situation where applicant needs to file a sequence listing that is over one hundred (100) megabytes as part of a new international application (PCT), the sequence listing XML file can only be provided via read-only optical disc. *See* 37 CFR 1.52(e). Applicant may use the Patent Electronic System to file the international application (PCT) without the sequence listing to obtain the international application (PCT) number and the confirmation number, and then file the sequence listing on read-only optical disc on the same day by using Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 or by hand-delivery, in order to secure the same filing date for all parts of the international application (PCT). However, the optical disc containing the sequence listing filed via Priority Mail Express® from the USPS or hand-delivered must not contain PDF files and must fully comply with the guidelines for filing a sequence listing on electronic media as set forth in 37 CFR 1.52(e), 1.824(b) and 1.834(b). The check list of the PCT Request provided via the Patent Electronic System together with the international application (PCT) should indicate that the ST.26 sequence listing XML forms part of the description is being filed separately on physical data carrier(s), providing in Box No. IX the number and type of carrier(s) used to contain the sequence listing XML file. The sequence listing must be in a single XML file and must comply with the provisions of 37 CFR 1.834(b)(2).

In the situation where applicant needs to file a sequence listing that is over one hundred (100) megabytes in an existing international application (PCT), applicant may file the sequence listing on read-only optical disc by using Priority Mail Express® from the USPS in accordance with 37 CFR 1.10, wherein the “date accepted” would be considered as the filing date, or by hand-delivery. A later-filed sequence listing may only be filed in ASCII text format if the IFD of the international application (PCT) is before July 1, 2022, and may only be filed in XML format if the IFD of the international application (PCT) is on or after July 1, 2022. The optical disc containing the sequence listing must not contain PDF files and must fully comply with the guidelines for filing a sequence listing on electronic media as set forth in 37 CFR 1.52(e), 1.824(b) and 1.834(b). The transmittal letter that accompanies the optical disc should identify the international application (PCT) to which it relates and indicate the reason for the submission.

c. Fee Determination for International Applications (PCT) Containing a Sequence Listing.

The only acceptable format for submission of a sequence listing in a new international application (PCT) filed on or after July 1, 2022 is as an XML file in compliance with AI Annex C. Accordingly, the sequence listing XML file does not contribute to the sheet count when recorded in the check list of the Request form, even though it is part of the description of the international application (PCT). The calculation of the international filing fee for an international application (PCT) that includes a sequence listing, when filed via the Patent Electronic System or submitted on optical disc, should not take into

account the submission of a sequence listing in XML format. Furthermore, the surcharge for a very lengthy sequence listing of at least 300 MB, as per 37 CFR 1.21(o), does not apply to an international application (PCT) during the international phase.

*M6. Limitations Concerning Computer Program Listings and Tables Related to a Sequence Listing in International Applications (PCT).*

a. Computer Program Listings.

There is no provision for computer program listings in ASCII text file in international applications (PCT).

b. Tables Related to a Sequence Listing.

Tables related to sequences or a sequence listing, if necessary, must be contained within the numbered sheets of the description of the international application (PCT), and must not be included in the drawing part. Such tables will be taken into account when calculating the application sheet count, and excess sheet fees may be required. 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 (PCT).

*M7. Follow-on Submissions for International Applications (PCT).*

Follow-on submissions filed via the Patent Electronic System on the same date on which the international application (PCT) was filed will form part of the international application (PCT). Note that follow-on submissions of PDF documents may change the number of pages in the international application (PCT) and therefore may affect the international filing fee. Where a sequence listing in XML format is submitted on the same date on which the international application (PCT) is filed, it will form the sequence listing part of the description, but will not contribute to the sheet count of the international application (PCT).

A follow-on submission to correct a defect in the international application (PCT) as filed, including but not limited to a defect in the sequence listing part of the description of the international application (PCT), must comply with the applicable PCT provisions (e.g., PCT Rule 20, 26, 26bis, or 91). In general, the opportunity to correct mistakes in the international phase is limited, particularly in Chapter I of the PCT. *See* MPEP 1800 for further information. The provisions for amending U.S. national applications (e.g., 37 CFR 1.121) do not apply to international application (PCT) in the international phase.

Where the sequence listing filed with the international application (PCT) is found to be defective, a sequence listing to be used only for the purpose of international search and/or examination may be filed via the Patent Electronic System to the USPTO in its capacity as International Searching Authority (ISA/US) or International Preliminary Examining

Authority (IPEA/US). Similarly, the Patent Electronic System may be used to submit a sequence listing in ASCII text format (for an international application (PCT) having an international filing date before July 01, 2022) or XML format (for an international application (PCT) having an international filing date on or after July 01, 2022) in response to a requirement made by the ISA/US or IPEA/US under PCT Rule 13*ter*. See also 37 CFR 1.821(h) and 1.835(e). Such sequence listing will not form part of the PCT international application as set forth in PCT Rule 13*ter*.1(e).

*M8. Policy of Annex F of the PCT Administrative Instructions (AI Annex F).*

The Patent Electronic System employs a Web-based approach to document submission which is different from the AI Annex F “wrapped, bundled and signed package” approach. Thus, the Patent Electronic System does not meet the AI Annex F requirements. See Annex F of the PCT Administrative Instructions located at [www.wipo.int/pct/en/texts/](http://www.wipo.int/pct/en/texts/).

**N. International Design Applications and Associated Documents.**

The term “international design application” as used in this framework refers to an application for international registration of an industrial design filed under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (“Hague Agreement”). The term “Rule” as used in this section refers to the “Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement”.

*N1. New International Design Applications Filed Through the USPTO as an Office of Indirect Filing.*

The Patent Electronic System enables registered users to electronically file new international design applications through the USPTO as an office of indirect filing. The following documents should be included in new international design application submissions:

a. Official form (Form DM/1).

Applicants filing international design applications through the USPTO are required to present the international design application on the official form established by the International Bureau (i.e., Form DM/1, entitled “Application for International Registration”) or on any form having the same form and content as the official form. Form DM/1 is available on the website of the International Bureau at [www.wipo.int/hague/en/forms/](http://www.wipo.int/hague/en/forms/). The DM/1 form includes boxes for providing information concerning the applicant, applicant’s entitlement to file an international design application, the creator, product identification, designations of Contracting Parties, priority claim, description, and other relevant information.

Users should use the document description “Application for International Registration (DM/1 or equivalent)” for a DM/1 form (or equivalent) submitted via the Patent Electronic System. For new international design application submissions, the Patent Electronic System will check for the presence of the document description for the DM/1 form when upload and validation functions are performed and, if not present, will alert the user that the DM/1 form is not indicated as being attached. The Patent Electronic System will not block submission of a new international design application based on the missing document description. If the DM/1 form document description is present, the Patent Electronic System will prompt the user to verify that the DM/1 form indicates applicant’s entitlement to file the international design application through the USPTO as an office of indirect filing. The USPTO will not transmit an international design application to the International Bureau if applicant’s entitlement to file the application through the USPTO is not indicated in the submission.

b. Reproductions.

Reproductions of industrial designs are required in international design applications and may be submitted as drawings, photographs, or a combination thereof, and may be in black and white or in color. *See* Rule 9 and Part Four of the Administrative Instructions for the Application of the Hague Agreement. Reproductions may be submitted through the Patent Electronic System as PDF or JPEG files as set forth in the next paragraphs. Technical requirements regarding image files, such as resolution, minimum and maximum image size, border width, etc., are also set forth on the website of the International Bureau at [www.wipo.int/hague/en/hague\\_file\\_renew.html](http://www.wipo.int/hague/en/hague_file_renew.html).

Reproductions may be submitted as single-page PDF or JPEG files by uploading the file(s) using the “Reproductions” section of the upload documents screen. Each image file attached through the “Reproductions” section should contain only one view of the design. The “Reproductions” section will prompt the user to assign a design and view number to each file uploaded via this section. Alternatively, applicants may upload reproductions as PDFs (including multi-page PDFs) using the same upload documents section used to upload other documents. However, uploading reproductions via the “Reproductions” section, rather than general upload documents section, may help to avoid incurring additional per-page publication fees that might otherwise be required by the International Bureau. The Patent Electronic System provides a warning to users about the possibility of incurring additional per page publication fees where reproductions are not uploaded using the “Reproductions” section. In accordance with the technical requirements set forth by the International Bureau, the Patent Electronic System will not permit submission of any PDF or JPEG file via the “Reproductions” section that exceeds a file size of two megabytes. For JPEG submissions, the Patent Electronic System will provide warnings where requirements pertaining to image resolution and minimum and maximum dimensions have not been satisfied; the Patent Electronic System does not check color mode or border size for JPEG images. For PDF submissions via the “Reproductions” section, the Patent Electronic System will not permit submission of any

PDF file that is more than one page. In addition, the Patent Electronic System does not check color mode, border size, resolution, or maximum or minimum dimensions of the reproduction (other than certain minimum and maximum page size dimensions) for PDF images. It is the responsibility of applicants to ensure that reproductions satisfy all applicable requirements.

Users uploading reproductions should use the document description “drawings – only black and white line drawings” or “drawing – other than black and white line drawings,” as appropriate. The Patent Electronic System will provide a warning to users where a new international design application does not contain an indication that at least one reproduction is attached.

#### c. Annexes.

An international design application may be accompanied by annexes submitted for the purpose of complying with certain national law requirements that may be applicable to a designated Contracting Party, for example, the requirement for an inventor’s oath or declaration where the United States is designated. Annex forms specific to particular Contracting Parties are available on the website of the International Bureau at [www.wipo.int/hague/en/forms/](http://www.wipo.int/hague/en/forms/). Users uploading Annexes to the Patent Electronic System should use the document description “Annex(es) to DM/1 or equivalent.”

More information regarding filing international design applications is available on the USPTO website at [www.uspto.gov/patents/initiatives/hague-agreement-concerning-international-registration-industrial-designs](http://www.uspto.gov/patents/initiatives/hague-agreement-concerning-international-registration-industrial-designs)

### *N2. International Design Application Fees Required by or Payable Through the USPTO as an Office of Indirect Filing.*

#### a. Transmittal fee.

International design applications filed through the USPTO as an office of indirect filing are subject to payment of a transmittal fee. *See* 37 CFR 1.1031(a). Users are permitted to submit the transmittal fee via the Patent Electronic System using the USPTO payment page. The USPTO will not transmit the international design application to the International Bureau if the transmittal fee has not been paid to the USPTO. *See* 37 CFR 1.1045. Applicants are cautioned that an international design application not received by the International Bureau within six months from the date the international design application is received by the USPTO will not be entitled to a filing date as of the date of receipt by the USPTO. *See* Rule 13.



b. International fees payable to WIPO.

Certain international design application fees payable to the International Bureau may be paid through the USPTO as an office of indirect filing, provided such fees are paid no later than the date of payment of the transmittal fee. *See* 37 CFR 1.1031(c). Applicants are not required to pay such fees through the USPTO but rather may pay such fees directly to the International Bureau. Furthermore, any payment of such fees through the USPTO must be in U.S. dollars. Because all payments made to the International Bureau must be in Swiss currency, the U.S. dollar amount collected may, when converted to Swiss currency, be different than the required Swiss currency amount. Accordingly, applicants are cautioned that paying such fees through the USPTO may still result in a requirement by the International Bureau to pay additional amounts where the conversion from U.S. dollars to Swiss currency results in the International Bureau receiving less than the prescribed amounts. *See* 37 CFR 1.1031(d).

International fees payable to WIPO include the prescribed fees set forth under Rule 12(1) (i.e., the basic fee, standard designation fee(s), individual designation fee(s), and publication fee) and Rule 11(2) (fee for a description exceeding 100 words). The “Calculate fees” screen does not provide for individual selection of these fees but rather provides for input of one lump sum in Swiss francs. The screen includes a link to the WIPO Hague System Fee Calculator ([www.wipo.int/hague/en/fees/calculator.jsp](http://www.wipo.int/hague/en/fees/calculator.jsp)) where users can input the appropriate data concerning their international design applications, and the WIPO Fee Calculator will determine the total amount of fees required in Swiss francs. Users can then copy and paste this amount into the “International Fees Payable to WIPO (CHF)” field of the Calculate fees screen, and the Patent Electronic System will calculate the U.S. dollar amount based on current exchange rates. The Patent Electronic System will only permit payment of the international fees that are payable to WIPO until 12 midnight Eastern Time of the date of payment of the transmittal fee required under 37 CFR 1.1031(a).

*N3. Follow-on Submissions in International Design Applications.*

In accordance with the requirements of this framework, only registered users may file follow-on submissions via the Patent Electronic System in international design applications.

Where an international design application was filed with the USPTO as an office of indirect filing, the USPTO will generally not forward communications to the International Bureau received after transmittal of the application to the International Bureau has been effected. Thus, for example, where the International Bureau has sent an invitation requiring compliance with a requirement under the Hague Agreement, the applicant must file any reply to that invitation directly with the International Bureau to avoid abandonment or other loss of rights under the treaty. *See* 37 CFR 1.1045.

The available document descriptions and fees that may be paid through the Patent Electronic System will differ depending on the stage of processing of the international design application. After transmittal of the international design application to the International Bureau has occurred, the document descriptions and fees that may be paid through the Patent Electronic System include those that would be relevant for U.S. national processing and examination. Follow-on submissions filed after transmittal of the international design application to the International Bureau but prior to WIPO publication of the international design application designating the United States will generally be presumed to have been intended for consideration by the USPTO acting as an examining office for the application. Accordingly, action by the Office on any such submission will generally be taken after receipt of the WIPO publication of the international design application designating the United States.

No follow-on submission or fee payment is required from the applicant to initiate examination of an international design application that designates the United States. Upon receipt by the Office of the WIPO publication of an international design application designating the United States, the Office will prepare the application file for examination. Registered users may, in accordance with this framework, file follow-on submissions in the international design application via the Patent Electronic System relevant to U.S. national processing and examination. Reproductions amended pursuant to 37 CFR 1.121 may be submitted via the Patent Electronic System as either PDF or JPEG electronic files. Section N1 contains more information on JPEG file size limits.

#### **O. Plant Applications and Associated Documents.**

Effective May 24, 2024, the Patent Electronic System was updated to provide for designating an application as a plant application and payment of plant application filing fees. Plant patent applications including drawings or photographs, fees and follow-on documents may be filed via the Patent Electronic System. Only one set of color drawings is necessary when filing via the Patent Electronic System.