

Cantor Colburn Client Alert: USPTO Proposed Electronic Patent Issuance

Summary

The United States Patent and Trademark Office (USPTO) is proposing to implement electronic patent issuance. Under this change, the USPTO would no longer issue patents on paper; instead, it would issue patents electronically through its patent document viewing system. This would mean patents would issue sooner in electronic form, possibly with only two or three days' notice, and that physical copies would no longer be mailed to the correspondence address as part of the patent issuance process.

Background

Under the current patent issuance process, once the notice of allowance is mailed and the issue fee paid, an issue notification is sent to the applicant. The issue notification comes about three weeks prior to the issue date and informs the applicant of the patent number and issue date. Continuation and divisional applications can be filed up until the current patent application issues. Following the issue notification, a physical paper copy of the patent is prepared and mailed to the correspondence address. Physical paper copies of the patent, often called 'ribbon copies' for the gold seal and red ribbon affixed to the cover, are generally mailed on the issue date.

Proposed Rule

Under the proposed rule, the USPTO will no longer deliver or mail a physical copy of the patent. Instead, the USPTO would issue patents electronically through the patent document viewing system (i.e. Patent Center and Patent Application Image Retrieval (PAIR)). Patentees would have the option to order a paper presentation copy and certified copy of the patent. This rule is aimed at moving the USPTO towards full digitization of the patent application process.

What This Means to You

There are two major implications of this proposed rule: first, the time to file a child case (e.g., a continuation application, continuation-in-part application, and/or a divisional application) is reduced by two weeks; and second, the USPTO will no longer mail ribbon copies.

Beginning first with the reduction in the time to file the child case, patents will now issue within one week after the USPTO assigns a patent number. As a result, at most your attorney may have only two or three days' notice of when the patent will issue. This change is significant because applicants will lose a time buffer that many rely on to confirm an interest in filing a child

case and preparing and filing the child case. The best practice will be for applicants to file a child case as early as is possible, e.g., before the payment of the issue fee.

Next, the USPTO would no longer create and mail a ribbon copy of the patent. This rule would mean the USPTO would not mail a paper patent upon issuance, offer advance patent copies, or provide duplicate copies of the paper patents. Patentees would still be able to order copies online for a fee and would be able to print copies through the USPTO patent document viewing systems.

For Further Information and Assistance

Cantor Colburn's has substantial experience representing clients in intellectual property matters. Please do not hesitate to contact [David Bomzer](mailto:dbomzer@cantorcolburn.com) at dbomzer@cantorcolburn.com and +1 (860) 286-2929, ext. 1317 or your Cantor Colburn attorney with any questions you may have regarding this matter and your IP in general.

Associate Maggie Russell contributed to this alert.

Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.