

# Getting Signed Up for Access to the Patent Office Status of Your Pending US Patent Applications



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**H**ow often have you telephoned the Patent Office to find out something about a pending patent application? When you do, you can hear the keys click as the Patent Office employee types in your application number on a Patent Office computer system. "It's in publication", you may learn, or "the file is with the Examiner". "It says here we received the formal drawings," you may be told, or "the Notice of Allowance was mailed yesterday."

How would you like to be able to get such information yourself, without having to call the Patent Office on the telephone, at any hour of the day or night? Now you can, through a new service called PAIR (Patent Application Information Retrieval).

Our firm was one of the first to use PAIR, and in this article we share what we have learned about using PAIR. It's a lot of work getting set up to use PAIR, but the results justify the trouble.

**Getting set up to use PAIR.** To use PAIR, you have to do three things:

1. get a "customer number" (also called a "payor number") from the USPTO,
2. get your customer number associated in the records of the USPTO with each of your pending and issued patent files,
3. obtain a PAIR cryptographic certificate from the Patent Office associated with your customer number and load special certificate software into your computer.

This article describes in detail how you complete these two steps.

When you've done these two things, you can use your web browser to visit a special page on the web site of the USPTO called the PAIR page. You can type in an application number or your attorney docket number and obtain detailed information about your patent application, including the location of the file within the Patent Office, the name of the examiner, the group art unit, and the complete file contents history. A portion of a typical report may be seen in Fig. 1. (See Fig. 1 at <http://www.patents.com/images/pair3.jpg>.)

Such reports can be extremely helpful. If there is a question whether a particular paper has been received by the Patent Office, the file contents history may confirm its receipt. If you need to contact the Examiner on a case but haven't received anything from the Patent Office identifying the Examiner, the PAIR report will tell you who the Examiner is. If the client calls asking why they haven't yet received a first office action, you can tell them exactly what has happened in the application thus far. Finally, if you are doing a routine docket status check to see why you have heard nothing from the Patent Office, the PAIR page may tell you of some item of correspondence which was lost in the mail on its way from the Patent Office to you. In such a case, the early warning provided by PAIR may save you from a Notice of Abandonment.

**Getting a customer number.** Getting a customer number is easy. You obtain Form PTO/SB/125 ("Request for customer number") from <http://www.uspto.gov/web/forms>, complete the form, and send it to the Patent Office. Within a few weeks you will be told your new customer number and will receive small bar-code stickers which you can use on future filings with the Patent Office, for example when filing a new patent application.

Before submitting Form PTO/SB/125, check to see whether your firm already has a customer number. Long before the PAIR system was set up, there were good reasons to get a customer number. If you change your mailing address (and if you have been using customer numbers with each of your patent filings), then you can simply update the mailing address associated with your customer number and the address change will apply automatically to all of your patent files. This saves your having to file change-of-address papers in each of your patent files. (Unfortunately, there is no similar "customer number" system in the Trademark Office.)

The customer number is also very handy for inventor's power of attorney ("POA") forms. Instead of having to list lots of PTO registration numbers on the POA form, you can simply list the customer number. The inventor is thus granting his or her power of attorney to all of the attorneys and agents associated with the customer number. When a new attorney or agent joins the firm, you simply add that person's PTO registration number to the customer number (using Form PTO/SB/124) and the registration number will automatically be associated with each application number that is associated with the customer number.

Yet another benefit to the use of a customer number is that it reduces the opportunities for typographical errors by the Patent Office. If you don't provide a customer number when filing a patent application, then the Office of Initial Patent Examination (OIPE) has to hand-type your entire mailing address, which could lead to an incorrect address or Zip code. If, however, you provide your customer number when filing a patent application, then the OIPE simply scans the customer number bar code and your correct address which is already on file will be used with the patent application.

**Getting your files associated with the customer number.** The best way to get a file associated with a customer number is to use the customer number when the application is first being filed. But if you have only now obtained a customer number, you need to get it associated with your pending files. The routine way of get-

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ting a pending patent application file associated with your customer number is to complete and submit Form PTO/SB/122, available from the “forms” web site mentioned previously. Similarly you can get an issued patent associated with your customer number by completing and submitting Form PTO/SB/123. There is also a Form PTO/SB/121 which can be used to request this change for many applications and patents through the same form.

Forms 121, 122, and 123 each have a place where a mailing address can be typed. You might be tempted to provide both a mailing address and the customer number. But what we have found is that it is better not to provide any mailing address at all on these forms, but only to provide the customer number. If you provide both a mailing address and the customer number, there is the risk that the Patent Office will ignore the customer number and key in the mailing address instead.

It is important not to confuse Form PTO/SB/123 with Form PTO/SB/47. The latter form relates only to “fee” communications under 37 CFR sec. 1.363.

If you have many files that need to be associated with your customer number, there is an unpublicized and better way to do this than preparing and filing lots of paper forms. You prepare a spreadsheet in a specified format containing the application serial numbers and filing dates, and send the spreadsheet to the Patent Office on a floppy disk. The Patent Office uses the spreadsheet to update its records, and sends you a printout showing which files were updated and which were not. It is important that you check the printout carefully and follow up on any files that did not get updated with your customer number. For example, you might have gotten digits transposed in your spreadsheet, or the power of attorney may be missing from an application.

There is an easy way to determine whether a particular application file is already associated with a customer num-

ber in the records of the USPTO. Simply look at your mailing address on any official paper from the USPTO regarding that file, such as a filing receipt or office action. If the file is associated with a customer number, the customer number will appear above the first line of the mailing address.

**Getting a PAIR certificate.** To get a PAIR cryptographic certificate, you need to obtain a certificate application form, which you complete and physically deliver to the Patent Office. To get the form, write to pair.project@uspto.gov. (At the time of writing, the application form was not available on the web site of the Patent Office, but it may have been posted there subsequently.) The form has a space where your customer number is to be provided, thus you can't submit this form until after you have obtained your customer number.

After the Patent Office has received and reviewed your certificate application form, you will receive three things: a CD-ROM with encryption software (called

“USPTO/Direct”), an email message with a “reference number”, and a telephone call providing an “authorization code”. You use the CD-ROM to install the USPTO/Direct software on your computer. Then you run USPTO/Direct and select “Add new user/profile”. You enter the reference number and authorization code (and you select a password) and the software sets up a “profile”. This profile is stored on your computer and is used during subsequent PAIR activity. (Your computer has to be connected to the Internet during the process of adding a new profile, because the USPTO/Direct software needs to communicate with a server at the Patent Office to add the profile.)

Once you have created the profile, gaining access to PAIR is easy. You run the USPTO/Direct software, select “log in”, and enter your password. Your browser is opened automatically to the USPTO web site. Select “Patent Application Information Retrieval.” If the USPTO/Direct software is working correctly, you will see “You have reached the secure access site” and will be offered search options “Customer Number Search” and “Attorney Docket Number Search”. (Visitors to this web page who don’t have a PAIR certificate see a different page with fewer search capabilities.)

**Things to do once you have gotten access to PAIR.** After you have completed all of the steps described above, you can use PAIR. But there are a number of things you should do to make sure your files are correctly set up within the Patent Office.

First, use “Customer number search” to generate and print out a list of all of your application files. Compare this list carefully with your own records, such as a pending-file list from your docketing software. If your experience is like that of our firm, you will find that many of your application files are missing from the customer number search report. Even though our firm had been working for over a year to get our customer number associated with each of our pending files, there were still dozens of files which simply had our firm mailing address but which did not have our customer number associated with them. In dozens of cases we had submitted Form PTO/SB/122 ask-

ing that our customer number be associated with the file (and received a return post card evidencing that Form PTO/SB/122 had been received) and yet even after a year the form had not been acted upon. None of these files turned up in the customer number search, and we had to file papers in each such file asking for a second time (or in some cases, a third time) that the customer number be associated with the file.

Yet another cross-check which you should perform is to identify applications and patents which are listed in the customer number search but which are not in your docketing system or for which you do not have a physical file. This may catch a docketing mistake if some file has never been docketed. When we did this cross-check, we found two files which had been transferred to other patent firms but which were still listed in the records of the USPTO as being handled by our firm. In each case this prompted us to remind the new firm to file its power of attorney so that there was a clear record of who was responsible for the application.

Still another check to perform is a study of the “attorney docket number” information yielded in the customer number search. If the “attorney docket number” field is blank for a file, or contains erroneous information, then you should write to the USPTO asking that the attorney docket number be corrected in the USPTO’s files. When we did this check, we found several files that had been transferred to us from other firms but which still had the old firm’s docket number listed. This prompted us to get the docket numbers updated so that correspondence to us from the Patent Office would show our docket numbers.

**What to do when you file a new application.** It should be clear from the foregoing discussion that it is extremely important, when filing a new patent application, to get your customer number on the file from the very beginning. The best way to file a US patent application is, of course, using the PrintEFS software. (You can obtain the PrintEFS software at <http://www.uspto.gov/printefs/> .) The PrintEFS software has a field where the customer number can be entered and this ensures that the customer number will be

properly associated with the application file by the Patent Office.

If you file a provisional application using Form PTO/SB/16 (Provisional application cover sheet), place your customer number bar code on the form but do not provide a mailing address. (It is better to use the bar code than to type the customer number since the bar code can be scanned and avoids risk of error by the USPTO in entering the customer number.)

Similarly, when you file a non-provisional application using Form PTO/SB/5 (Utility patent application transmittal), do not provide a mailing address in box 17 but merely provide your customer number bar code.

The reason for omitting the mailing address is the same as discussed above in connection with Forms PTO/SB/121, 122, and 123, namely that if you provide both a mailing address and the customer number, there is the risk that the Patent Office will ignore the customer number and key in the mailing address instead.

When you prepare a Power of Attorney to be signed by an inventor, use the customer number rather than listing the PTO registration numbers for the reasons described above. In Form PTO/SB/1 or 81, simply apply the customer number sticker to the form rather than typing in a list of registration numbers.

The one remaining type of filing is the entry into the US national phase using Form PTO-1390. This form does not have an explicit place where a customer number sticker may be applied, and our experience is that when the application is passed from the PCT designated/elected office to the OIPE, there is easy way to tell OIPE that you want the customer number associated with the file. We have been told by personnel in the PCT elected/designated office, however, that it is possible to use the customer number sticker at the lower left corner of the second page of Form PTO-1390, and that this will permit OIPE to know that the applicant wants the customer number associated with the file.

We have found the Pair system to be a convenient and useful service of the Patent Office, and we think you will, too. 