Guidelines for Communications Between IP Firms

Standardising e-mail communications between IP firms by following these golden rules helps achieve clear and safer communication and better case management.

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Disclaimer

This paper proposes basic guidelines for exchanging communications between IP firms to standardise procedures, reduce workload, and ameliorate the risk of miscommunication.

The “rules” herein do not imply any obligation on IP attorneys, agents or lawyers and merely reflect recommendations approved by the Executive Committee of FICPI. They are subject to change at any time.

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The 9 golden rules

1. Confirmation of Receipt
When sending orders or instructions that involve a deadline, always request confirmation of receipt by the recipient and monitor for receipt of proper confirmation within the applicable deadline. If no confirmation is received, reminders should be sent until such a confirmation is received or the sender should call the recipient. If it is unclear whether the confirmation of receipt was sent by a person or was automatically generated, a request for clarification should be sent to the recipient.

A recipient should only confirm receipt if further handling of an instruction is under control.

2. Email Addresses to Use
When sending new orders where a deadline is involved, preferably general e-mails should be used instead of or in combination with personal e-mails.

If no general e-mail is available, the sender should address the e-mail to at least two persons, and the recipient should endeavour to establish a general e-mail.

3. Subject Field
The subject field should be used to convey summarized essential information:

(a) the nature of the content (e.g. “NEW ORDER”, “INSTRUCTIONS”, “FOR INFORMATION”, etc.)

(b) the nature of the matter (“PATENT”, “TRADEMARK” etc.)

(c) any known deadline or applicable time limit, and/or if the matter is URGENT

(d) the sender’s and recipient’s reference, if available.

4. Use the Name of the Firm
Using “our ref.” and “your ref.” may become confusing in successive exchanges. Preferably at least one of the correspondents should use the name of the firm or company or an abbreviation thereof (e.g., “ficpi ref.”).

5. Separate Cases Into Unique E-mails
Use of a single e-mail to convey instructions to multiple cases should be avoided. If, however, a single e-mail is used in this manner, the multiple

1. An automatic confirmation of receipt of an e-mail by a recipient’s computer server should be treated with caution. Such automatically generated messages do not necessarily mean a person has actually received and read the e-mail.

2. E.g., the recipient can add their own reference to a confirmation of receipt in order to make it clear that it is not a mere automatic response.

3. E.g., it is essential to resist the temptation to send a quick confirmation of receipt (e.g. from a smart phone) before an instruction has been properly recorded in the recipient’s records system and double checked. Until then, there is a chance that the instruction will be forgotten or delayed until after the applicable deadline. A new order should first be entered into the recipient’s computer system and double checked for appropriate control, and only then should receipt of the order be confirmed to the sender.
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Golden rules (cont’d)

cases should be clearly marked. Instructions sent at the same time on two or more different cases may look like duplicates. Take care to ensure they are visually differentiated in some way.

6. Use Important Information in Body of Email
Important Information (e.g. filing deadlines) should be included in the body of an e-mail, rather than only in attached files⁴.

If not included in the subject field, any relevant deadline(s) should be stated conspicuously at the beginning of the body of the e-mail.

7. Attachments
Attachments should be used to communicate the following elements.

(a) Proposed amendments, which should preferably:

• Be provided in an editable form (.doc) to facilitate use of the amended text and preparation of any corresponding translation without introducing transcription errors
• If formatting is important, include a second copy of the document in a PDF format, which will be unaffected by the program used by the recipient
• Amendments should be clearly identified, preferably with new text being underlined and deleted text being struck through, e.g. as in “tracked changes” in Microsoft Word
• If it would be helpful, provide an additional clean copy
• For newly added passages, specific basis in the original disclosure should be indicated
• Files should contain the date in their names⁵.

(b) Detailed arguments⁶ for responding to official actions, which should likewise be provided in an editable form.

(c) An XML file with relevant data for the case⁷ where applicable.

(d) Other documents.

⁴ I.e., avoid e-mails in which the body of the email only refers to attached files (e.g., “Please refer to the attached letter” or “Please find attached our instructions”). Viewing attachments on a smart phone or other hand-held type device is often troublesome.
⁵ E.g., “amendments 3 Nov 2014.doc”
⁶ If arguments concern the patentability of claims, the arguments should deal with each independent claim.
⁷ The content of XML files is easily extractable in an automatic manner by a recipient’s computer system. The content may include, e.g., bibliographic data of a patent or trade mark application, information about an applicable deadline and the type of service requested (e.g., new filing, request for examination, payment of a renewal fee etc.)
Golden rules (cont’d)

Attachments should be listed in the body of the e-mail.

Password protection of attached documents should be used only if absolutely necessary.

8. New Orders for PCT Entries
In connection with new orders for PCT national/regional entries:

(a) Senders should use WIPO’s INID codes to indicate pertinent bibliographic information in the body of the e-mail, preferably at or towards the top (see also 4.1 above). e.g.

(10) International Publication Number
(21) International Application Number
(22) International Filing Date
(30) Priority Data
(43) International Publication Date
(54) Title
(71) Applicant
(72) Inventor

Alternatively, senders should provide a link to the PCT files in WIPO’s website.

(b) Preferably, recipients should capture automatically bibliographic information from materials provided by the sender or from WIPO.

9. Avoiding Premature Lapsing
In order to avoid premature lapsing of a case due to possible communication failure, if applicable a recipient should be expressly instructed to the effect that in the absence of instructions to the contrary, an application should be kept in force.

Please see following page for a sample communication.

9. E.g., using bibliographic data in XML format. See:
   http://www.wipo.int/patentscope/en/data/forms/pct_biblio.jsp (subscription of bibliographic data in XML format)
   http://patentscope.wipo.int/search/en/search.jsf (e.g., look into the “Documents” folder: International Application Status Report or Initial Publication with ISR)
Sample communication

From: michaelmaus@ipsenderfirm.com
To: mail@ipfirm.com
Cc: johndoe@ipfirm.com

Subject: NEW ORDER, PATENT, PCT, 30-month deadline: 2 February 2014, IPSENDERFIRM ref: P100000

Ref.: National phase of

| (10) International Publication Number: | WO/2013/019268 |
| (43) International Publication Date: | 07.02.2013 |
| (21) International Application Number: | PCT/US2012/000001 |
| (22) International Filing Date: | 03.01.2012 |
| (30) Priority Data: | 61/462,760 02.08.2011 US 13/136,657 08.08.2011 US |
| (71) Applicant: | IP HOLDINGS, LLC [US/US]; 5408 NE 88th St. #A-101 Vancouver, WA 98665 (US) |
| (72) Inventor: | ORTEGA, Steve; (US) |
| (54) Title: | TRAY STAND |

Dear Sirs,

Please enter the above-referenced PCT application into the national phase in Brazil.

Renewal fees: We will instruct you to pay applicable renewal fees at the appropriate times. Please provide us with timely reminders of upcoming renewal deadlines and let us know the due date for payment of the first renewal fee. If this falls within three (3) months of the deadline for national phase entry, please treat this letter as an instruction to pay the first renewal fee.
Request for examination: Please let us know the deadline for requesting substantive examination of this application, and send us timely reminders of that date. If the deadline falls within 3 months of the deadline for national phase entry, please treat this letter as an instruction to request examination and to pay the corresponding fee(s).

Kindly let us know any other documentation or information will be required to complete entry of this application into the national/regional phase in your country.

IN THE ABSENCE OF INSTRUCTIONS FROM US TO THE CONTRARY PLEASE KEEP THIS APPLICATION IN FORCE.

Please confirm safe receipt of this e-mail and attachments by return.

Yours faithfully,

Michael Maus

Enclosures:

XML file with bibliographic data
PCT specification
Power of attorney

[End of document]