



DRAFT GUIDELINES FOR COMMUNICATIONS BETWEEN IP FIRMS

This paper suggests basic guidelines for exchanging communications between IP firms in order to try to standardise procedures, reducing the workload and also the risk of miscommunication

ANNEXES:

1. Clean version of draft guidelines amended after the meeting
2. Amended text side-by-side with notes from the workshop

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ANNEX 1

Disclaimer: the rules below do not imply any obligation on IP attorneys, agents or lawyers, and merely reflect recommendations approved by the Executive Committee of FICPI and are subject to changes at any time.

1. Golden rules:

(a) when sending orders or instructions that involve a deadline, always request **confirmation** of receipt by the recipient and monitor proper confirmation within the applicable deadline¹. If no confirmation is received, reminders should be sent until such a confirmation is finally received or the sender should call the recipient. If it is not clear whether the confirmation was sent by a person or was automatically generated, a request for clarification should be sent to the recipient².

(b) a recipient should only confirm receipt if further handling of an instruction is reasonably under control³.

2. 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.

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

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

(a) as to the nature of the content (e.g. "NEW ORDER", "INSTRUCTIONS", "FOR INFORMATION", etc.),

(b) as to the nature of the matter ("PATENT", "TRADEMARK" etc.),

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

(d) the senders and recipient's reference, if available.

3.1 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.").

3.2 Use of a single e-mail to convey instructions to multiple cases should be avoided. If however it is used in this manner, the multiple cases should be clearly marked.

4. Other essential information should preferably be provided in the **body** of the e-mail, rather than in annexed files⁴.

¹ An automatic confirmation of receipt of an e-mail by a recipient's computer server should be taken with reserve. Consider that possibly such a message does not necessarily mean that a person has actually received and read the e-mail.

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

³ E.g., avoid sending a quick confirmation of receipt from a smart phone only for formal purposes, if there is a chance that the issue will be forgotten or delayed beyond the applicable deadline. Ideally a new order should first be entered into the recipient's computer system for appropriate control, and only then receipt of the order should be confirmed.

⁴ I.e., avoid e-mails which content only refers to enclosed files (E.g.: "Please refer to the enclosed files" or "Please find enclosed our instructions"). Specially for access by the recipient through smart phones, visualization of the content of annexes is troublesome.



4.1 If not informed in the subject field, any applicable deadline should be informed in a clear manner at the beginning of the body of the e-mail.

5. Annexed files should be used to convey:

(a) Proposed **amendments**, which should preferably:

- (i) be on a textual format (.doc or .pdf), rather than in image format, for facilitating recovery of amended text and preparation of corresponding translation;
- (i.a) if formatting is important, use a textual pdf that will not be affected by the program used by the recipient;
- (ii) have amendments duly marked, preferably with new passages being underlined and cancelled passages stricken as in tracked changes in Microsoft Word;
- (ii.b) if considered appropriate, provide an additional clean copy;
- (iii) for passages newly added, basis on initial disclosure should preferably be indicated;
- (iv) files should contain the date in its name⁵.

(b) Detailed **arguments**⁶ for responding to official actions, which should likewise be provided in textual form;

(c) When applicable and available, an **XML** file with **relevant data** of the case⁷;

(d) Other documents.

5.1 Whenever appropriate annexes should be listed in the body of the e-mail.

5.2 Password protection of annexes should be used only if absolutely necessary.

6. In connection with new orders for PCT national entries:

(a) senders should use international standards to indicate relevant information directly on the heading of the body of the e-mail. E.g.:

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

(a.1) Alternatively, senders should provide a link to the PCT files in WIPO's website.

(b) recipients should seek ways automatically to capture bibliographic information either from the sender or as made available by WIPO for published PCT applications⁸.

Annex: sample of communication

⁵ E.g., "amendments Nov 3 2014.doc"

⁶ If arguments concern patentability of claims, arguments should refer to each independent claim.

⁷ The content of XML files is easily extractable in an automatic manner to feed a recipient's computer system. The content may include, e.g., bibliographic data of a patent or trademark application, information about an applicable deadline and the kind of service ordered (new filing, request for examination, payment of a renewal fee etc.)

⁸ 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 national phase of the above application in Brazil.

Renewal fees: please control and inform us about deadlines for paying renewal fees.

Request for examination: please control and inform us about the deadline for requesting examination.

Let us know about any other necessary document or information.

Please confirm receipt of this e-mail and enclosures.

Best regards

Michael Maus

Enclosures:

XML file with bibliographic data

PCT specification

Power of attorney

[End of document]



ANNEX 2 – marked version	Arild's notes
<p>1. Golden rules:</p> <p>(a) when sending orders or instructions that involve a deadline, always request confirmation of receipt by the recipient and monitor proper confirmation within the applicable deadline⁹. If no confirmation is received, reminders should be sent until such a confirmation is finally received or the sender should call the recipient. <u>If it is not clear whether the confirmation was sent by a person or was automatically generated, a request for clarification should be sent to the recipient</u>¹⁰.</p> <p>(b) a recipient should only confirm receipt if further handling of an instruction is reasonably under control¹¹.</p> <p>2. 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.</p>	<p><u>Golden rule for communications:</u></p> <p>Always ask for confirmation of receipt and monitor this. Automatic confirmation of receipt should be taken with care. Recipient should only confirm when the handling is under control. Danny informed that automatic reading confirmations only means that it has been opened. It should be clear from the instruction letter that the confirmation of receipt has to be manual, such as by using a different reference than in the letterhead. Important that you first get the matter under control and then confirm.</p> <p>Robert said that he would confirm but state that it also has to be confirmed by the docketing handlers. How long you can wait for the confirmation depends on the deadline. Before acknowledging the content of the instructions make sure that the instructions are being processed. State if the confirmation of receipt has to be followed up by a further confirmation. Keep the original e-mail in the inbox and check if it has been handled before being removed.</p> <p><i>(IA: On the side of the recipient)</i> Make sure that the one receiving the instructions or questions really is capable of understanding it.</p> <p>Copy to a general e-mail address in addition to personal e-mail addresses. At least two persons should be addressed if personal e-mail addresses are used.</p>

⁹ An automatic confirmation of receipt of an e-mail by a recipient's computer server should be taken with reserve. Consider that possibly such a message does not necessarily mean that a person has actually received and read the e-mail.

¹⁰ E.g., the recipient can add his own reference to a confirmation of receipt in order to make it clear that it is not a mere automatic response.

¹¹ E.g., avoid sending a quick confirmation of receipt from a smart phone only for formal purposes, if there is a chance that the issue will be forgotten or delayed beyond the applicable deadline. Ideally a new order should first be entered into the recipient's computer system for appropriate control, and only then receipt of the order should be confirmed.



<p><u>2.1 If no general e-mail is available, the sender should address the e-mail to at least two persons, and the recipient should endeavor to establish a general e-mail.</u></p> <p>3. The subject field should be used to convey summarized essential information: (a) as to the nature of the content (e.g. “NEW ORDER”, “INSTRUCTIONS”, “FOR INFORMATION”, etc.), (b) as to the nature of the matter (“PATENT”, “TRADEMARK” etc.), (c) as to any known applicable time limit and/or if the matter is URGENT, and (d) the senders and recipient’s reference, if available.</p> <p><u>3.1 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.”).</u></p> <p><u>3.2 Use of a single e-mail to convey instructions to multiple cases should be avoided. If however it is used in this manner, the multiple cases should be clearly marked.</u></p> <p>4. Other essential information should preferably be provided in the body of the e-mail, rather than in annexed files¹².</p> <p><u>4.1 If not informed in the subject field, any applicable deadline should be informed in a clear manner at the beginning of the body of the e-mail.</u></p> <p>5. Annexed files should be used to convey: (a) Proposed amendments, which should preferably:</p>	<p>Establish a general e-mail address if not already there.</p> <p>The subject field should summarize essential information. Use a file reference if it is know, both your own and the recipient’s. Avoid duplication of the references.</p> <p>Instructions relating to more than one case should be clearly marked. If several similar e-mails are sent, make it clear that these are separate cases.</p> <p>Do not use “Our ref.” / “Your ref.”. “Instructor ref.” and “agent ref.” may not always be clear either. Maybe the name or acronym should be included.</p> <p>Important info should be in the body of the e-mail rather than in annexes. The deadline should be close to the beginning of the e-mail. Good idea to list examples of essential info.</p> <p>Password protection of documents should be used only when necessary.</p> <p>Annexes should be used for items such as proposed amendments. Us .doc or .pdf. If</p>
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¹² I.e., avoid e-mails which content only refers to enclosed files (E.g.: “Please refer to the enclosed files” or “Please find enclosed our instructions”). Specially for access by the recipient through smart phones, visualization of the content of annexes is troublesome.



<p>(i) be on a textual format (.doc or .pdf), rather than in image format, for facilitating recovery of amended text and preparation of corresponding translation; (i.a) <u>if formatting is important, use a textual pdf that will not be affected by the program used by the recipient;</u> (ii) have amendments duly marked, preferably with new passages being underlined and cancelled passages <u>stricken as in tracked changes in Microsoft Word;</u> (ii.b) <u>if considered appropriate, provide an additional clean copy;</u> (iii) for passages newly added, basis on initial disclosure should preferably be indicated; (iv) <u>files should contain the date in its name¹³.</u></p> <p>(b) Detailed arguments¹⁴ for responding to official actions, which should likewise be provide in textual form; (c) When applicable and available, an XML file with relevant data of the case¹⁵; (d) Other documents.</p> <p><u>5.1 Whenever appropriate annexes should be listed in the body of the e-mail.</u></p> <p><u>5.2 Password protection of annexes should be used only if absolutely necessary.</u></p> <p>6. In connection with new orders for PCT national entries: (a) senders should use international standards to indicate relevant information directly on the heading of the body of the e-mail. E.g.:</p>	<p>formatting is important, use a textual pdf that will not be affected by the program used. In a .doc file formatting may be lost. Add the date in the name of the document if there are different versions on file. Headers and footers and line shift in a .pdf may be a problem in conversion. Both a .pdf and .doc may be a good idea. An image file should be sent if it important that it is not changed. Name the attachments, so that the recipient can check if they are all there.</p> <p>Mark amendments. Provide an additional clean copy if applicable.</p> <p>Should this be included? Inform the recipient of where support for amendments can be found in the specification, depending on the relevant country.</p> <p>Detailed arguments, with respect to each independent claim, should also be included in textual format.</p> <p>XML file: Basic data in XML can be extracted by a recipient.</p> <p>Ivan informed about a program developed by Dannemann that can automatically capture data from the WIPO database. Ivan also advised to repeat the critical information to the instructor. The recipient should seek ways to automatically capture info, e.g., by the instructor including a link to the case in the WIPO database.</p> <p>The agent needs some additional info that is not in the PCT file. Ivan said that the PCT info contains the critical info to avoid failure in filing. Danny suggested that we pick two or more important PCT data that are independent, e.g.,</p>
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¹³ E.g., "amendments Nov 3 2014.doc"

¹⁴ If arguments concern patentability of claims, arguments should refer to each independent claim.

¹⁵ The content of XML files is easily extractable in an automatic manner to feed a recipient's computer system. The content may include, e.g., bibliographic data of a patent or trademark application, information about an applicable deadline and the kind of service ordered (new filing, request for examination, payment of a renewal fee etc.)



<p>(10) International Publication Number (43) International Publication Date (21) International Application Number (22) International Filing Date (30) Priority Data (71) Applicant (72) Inventor (54) Title</p> <p><u>(a.1) Alternatively, senders should provide a link to the PCT files in WIPO's website.</u> (b) recipients should seek ways automatically to capture bibliographic information either as from the sender or as made available by WIPO for published PCT applications¹⁶.</p> <p>[7. Nomenclature for References: "Instructor," "Agent," "Applicant" In order to avoid confusion by using "our reference" and "your reference" when successive e-mails are exchanged, preferably they should be replaced by: —"Instructor ref." for the reference of the original sender of instructions, and —"Agent ref.:" for that of the local firm handling the case. Also an "Applicant ref." can be used if applicable.]</p> <p>Annex: sample of communication</p>	<p>the publication number and the application number and use these to check that the correct file is picked out.</p> <p>It is convenient to just send a link to the PCT file. However, a few fields should be given for checking purpose.</p> <p>Ivan showed an automatically generated letter based on WIPO file info. He also showed a user interface of the program to generate the letter/XML.</p> <p>To read the XML, the recipient has to have a program that can understand the same fields.</p> <p>Gustavo suggested that we interact with the industry to persuade them to adopt a standard for communication.</p>
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¹⁶ 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)