

Guidelines for Filing the Prosecution Histories and Technical References Accompanying Section 337 Complaints on DVD/CD Media

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Introduction

This document defines the technical requirements which must be met in order to submit the prosecution histories and technical references required by Commission Rules 210.12(c)(2) & (3) via electronic media, rather than as paper copies. This is an additional option for complainants to submit the required copies in electronic format; however, **this is not a requirement, only an option.**

When filing a Section 337 complaint, Commission Rule 210.12(c)(2) requires the complainant to submit “[o]ne certified copy of the U.S. Patent and Trademark Office prosecution history for each involved U.S. letters patent, plus three additional copies thereof.” 19 C.F.R. § 210.12(c)(2). **A complainant must always submit the original “seal” copy of a prosecution history as provided by the USPTO.*** However, a complainant may submit **the three additional copies** required by the Rule in electronic format. Similarly, Commission Rule 210.12(c)(3) requires a complainant to submit “[f]our copies of each patent and applicable pages of each technical reference mentioned in the prosecution history of each involved U.S. letters patent.” 19 C.F.R. § 210.12(c)(3). A complainant may submit all four required copies of the patents and technical references (collectively “technical references”) in electronic format. Listed below are the rules specifying the technical requirements which complainants must adhere to in order to submit these documents in electronic form.

Rules and Recommendations for Document Submission in Electronic Format

Rules for Preparing Document Files to be Submitted on Electronic Media:

The following rules are laid forth for complainants in preparing the copies of the prosecution histories and technical references as defined in Commission Rules 210.12(c)(2) & (3).

1. All files submitted as exhibits on the media must be in PDF format version 1.3 or higher. (Recommendation: Use Adobe Acrobat 7 Professional for conversion.)

* The U.S. Patent and Trademark Office currently issues certified copies of prosecution histories either as paper copies or on a CD. See http://ebiz1.uspto.gov/vision-service/Product_Services_P/msgShowProductSets?category=P.

2. PDF size must be <10 MB in size. Files larger than 10 MB must be broken into individual parts which are less than 10 MB. (Recommendation: use <=300 DPI on images inserted into documents.)
3. The following conversion settings should be used when converting files from standard word processing software to PDF format:

Converting Microsoft Word files to PDF

(Adobe PDF -> Change Conversion Settings):

Settings tab:

Required:

- a. Uncheck option "Attached source file to Adobe PDF"
- b. Uncheck option "Add bookmarks to Adobe PDF"
- c. Uncheck "Add links to Adobe PDF"

Recommended:

- d. Check "Enable accessibility and reflow with Tagged PDF"
(enables Section 508 compliance capabilities)
- e. Set compatibility to Acrobat 6 (PDF 1.5)
(Advanced Settings -> Compatibility)

Security tab:

Required:

- f. Uncheck "Require a password to open the document"

Converting files from WordPerfect to PDF (File -> Publish to PDF -> Document):

Required:

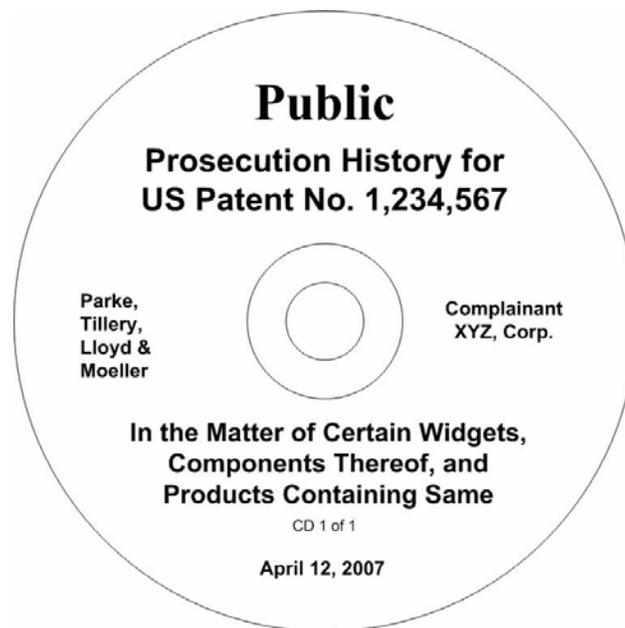
- a. Uncheck "Include hyperlinks"
- b. Uncheck "Generate bookmarks"

4. All files must have password protection disabled.
5. An Optical Character Recognition (OCR) should be run on each file containing text. Once the PDF is created, run Document -> Recognize Text using OCR, to extract any words that could be readable by a search engine.
6. Each file should be named for the document contained therein. In the case of a prosecution history, the file name should identify the patent and, if multiple files are used, indicate the order in which the files are organized (*e.g.*, "123 Patent Pros Hist Part 1"; "123 Patent Pros Hist Part 2"; etc.). In the case of technical reference, the file name should reflect the name of the reference (*e.g.*, "US Patent 1234567"; "Japan Patent 01-234567"; "Smith & Jones 1984 ISCC article"; etc.).

Preparing the Electronic Media:

All files created following the rules defined above must be transferred to electronic media following the guidelines defined below:

1. All files for each category of document must be copied onto separate DVD+R or CD media. A separate DVD/CD must be submitted for each prosecution history and for the technical references cited in each patent (i.e., for each patent at issue, there must be three DVD/CDs each containing one copy of the prosecution history and four DVD/CDs each containing one copy of the technical references).
 - a. If one CD cannot hold all of the required files, multiple CDs can be created, but the sequence of the CDs should be identified accordingly on the label (e.g., Disc 1 of 2). In cases where the files will not fit on a single CD, however, use of a DVD is preferred.
2. All files should be written at the root directory level of the DVD/CD. No subdirectories should be created on the disc.
3. A Table of Contents (TOC) file which lists the names of all files on the disc should be created and included on each disc.
4. Each disc should be labeled with the Title of the Investigation, Security Level, Document Type (e.g., Prosecution History), Party (e.g., Complainant XYZ Corp.), Firm (submitting the documents), and the Creation Date. An example is shown below:



- Any discs containing Confidential Business Information or Business Proprietary information should be clearly labeled as such.
5. Each DVD/CD should be checked to ensure it has been correctly created, labeled, and contains ONLY the desired content. It is the responsibility of the

complainant to ensure that the contents of the DVD/CD are correct and that DVD/CD is properly marked and labeled.

Delivery to Dockets:

The DVDs/CDs should be filed with Dockets at the same time that the complaint and other required exhibits and documents are filed.