

SLW Institute Guide to Virtual IP Webinar Series

Electronic and Digital Signatures: Obtaining Signatures When Attorneys and Inventors Are Working From Home

SLW INSTITUTE
Building Extraordinary IP Assets



Today's Presenters...



Andre Marais
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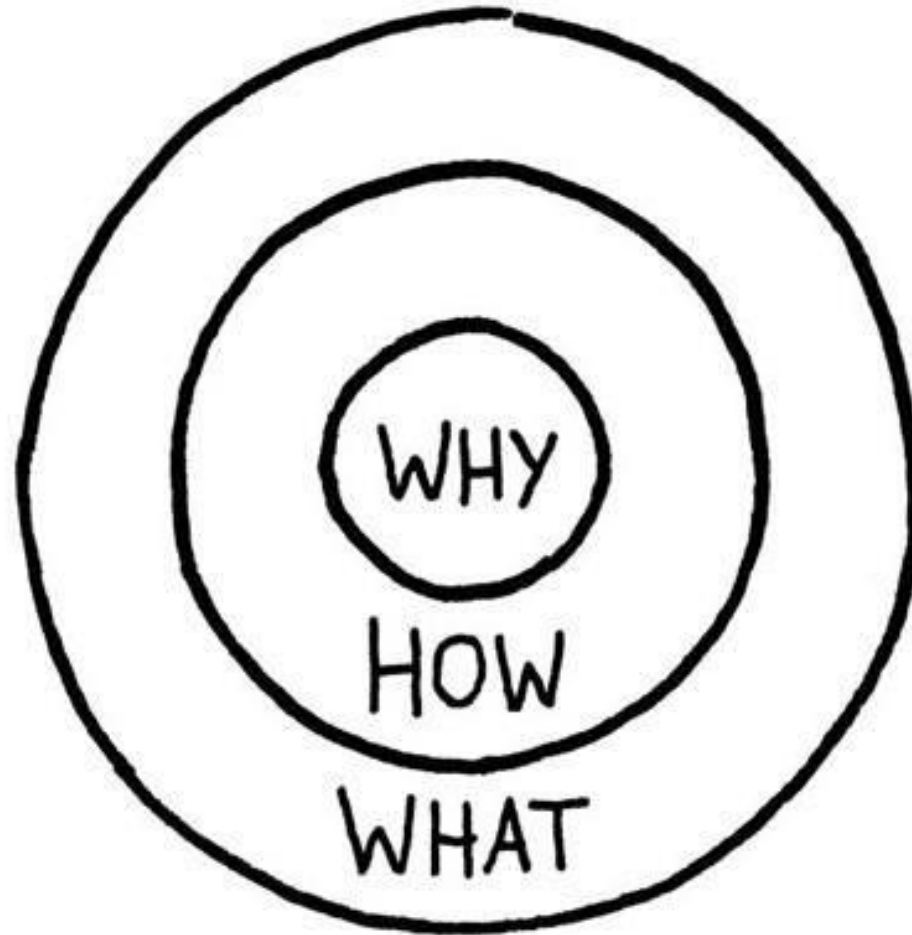


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Principal
Schwegman Lundberg & Woessner

START WITH THE WHY



Who and What

| SIGNED DOCUMENT | PATENT OFFICE/ COUNTRY | COURT (LEGALITY AND ENFORCEABILITY)/COUNTRY |
|----------------------------|--|--|
| PATENT OFFICE TRANSMITTALS |  | |
| IP TRANSFER AGREEMENTS |  |  |
| POWERS OF ATTORNEY | | |

Agenda

- **USPTO Requirements** (Peter Rebuffoni)
- **Electronic Signature Setup and Workflows** (Peter Rebuffoni)
- **Electronic and Digital Signatures: IP transfer Agreements** (Mike Lynch and Andre Marais)
- **Q & A**



USPTO's
requirements for
electronic
signatures
[\(37 C.F.R.
1.4\(d\)\(2\)\)](#)

An S-signature is a signature inserted between forward slash marks, but not a handwritten signature.

An S-signature includes **any signature made by electronic or mechanical means**, and any other mode of making or applying a signature not covered by a handwritten signature.

The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation.

USPTO's
requirements for
electronic
signatures
(cont.)

[\(37 C.F.R.
1.4\(d\)\(2\)\)](#)

The signer's name must be:

- (A) Presented in printed or typed form preferably immediately below or adjacent the S-signature, and
- (B) Reasonably specific enough so that the identity of the signer can be readily recognized.

A patent practitioner ([§ 1.32\(a\)\(1\)](#)), signing pursuant to [§§ 1.33\(b\)\(1\)](#) or [1.33\(b\)\(2\)](#), must supply his/her registration number either as part of the S-signature, or immediately below or adjacent to the S-signature.

Proper and Improper S-Signature Examples



/John A. Inventor/

John A. Inventor

Marsha A. Inventor

Marsha A. Inventor

/Joe Q. Attorney/

Joe Q. Attorney, Reg. No. 999999



Marsha 😊 Inventor

Marsha A. Inventor

//Joe Q. Attorney//

Joe Q. Examiner, Reg. No. 999999

Electronically
submitted
correspondence
[\(37 C.F.R.
1.4\(d\)\(3\)\)](#)

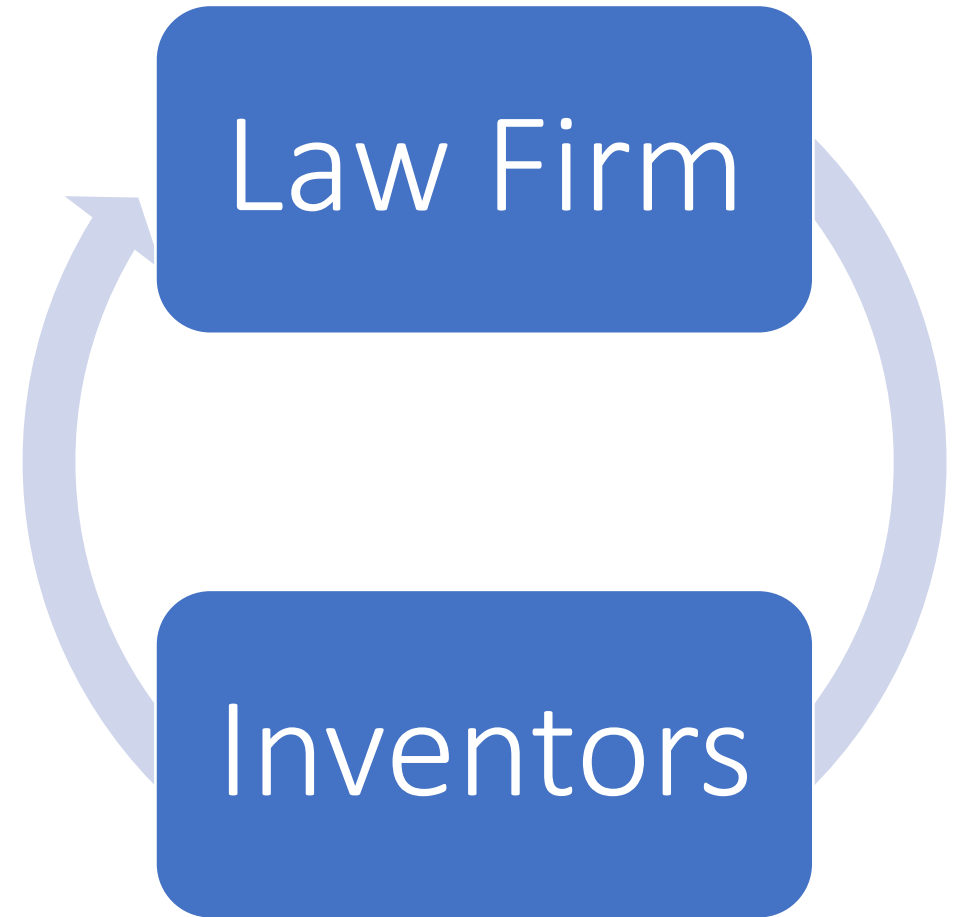
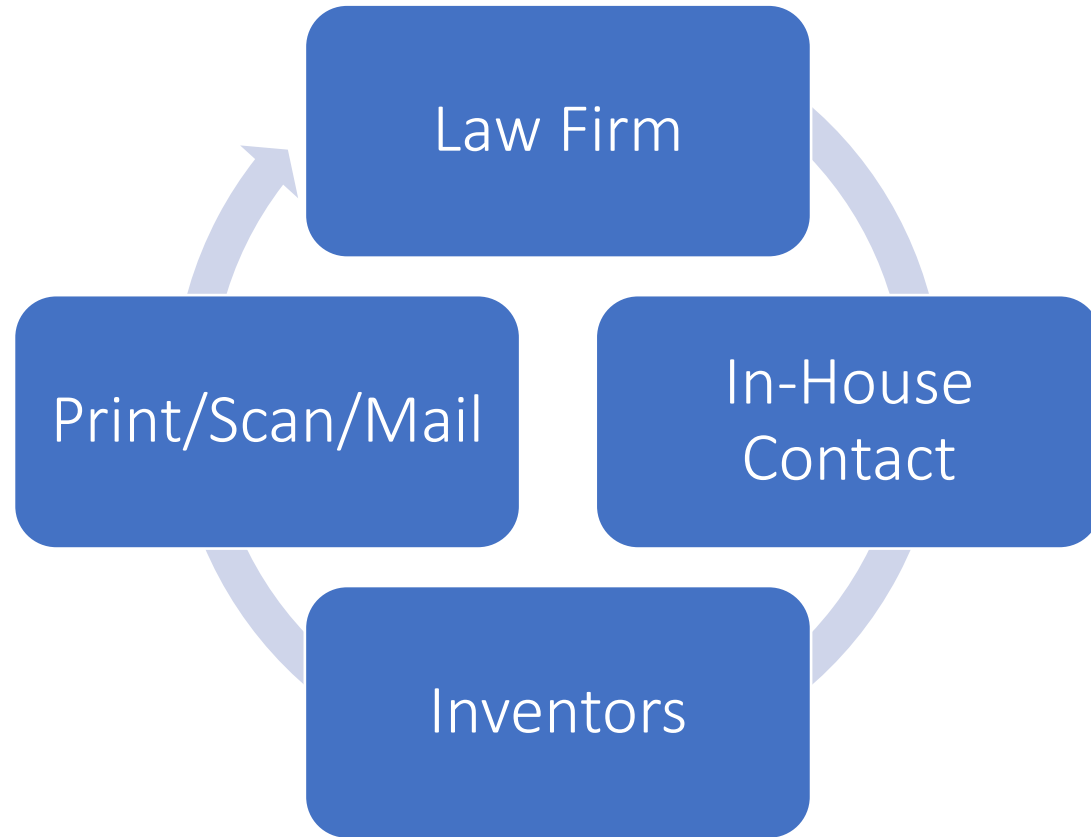


Correspondence permitted via the Office electronic filing system may be signed by a graphic representation of a handwritten signature or a graphic representation of an S-signature when it is submitted via the Office electronic filing system.

Original handwritten signatures remained a requirement under 37 CFR 1.4(e)(1) and (2) for certain correspondence with the and certain payments **Office of Enrollment and Discipline** by credit card.

However, in March 2020, the USPTO [indicated](#) it considers the effects of COVID-19 to be an "extraordinary situation" within the meaning of 37 CFR 1.183 for affected patent and trademark applicants, patentees, reexamination parties, and trademark owners. Therefore, the USPTO waived the requirements of 37 CFR 1.4(e)(1) and (2) for original handwritten signatures.

Signature Workflows – In office vs. working from home



Signing pitfalls in work from home environment

- **Hardware** – Lack of basic office environment hardware (printer, scanner, fax, etc.); or to employer-approved hardware
- **Software** – PDF programs on signer home computers can vary widely from view only to full Acrobat
- **Mail** – Limited access to mailing supplies (postage, envelopes) and limited access to postal services
- **Difficulty reaching** or following up with signers
- **Errors** in signed documents lead to lengthy additional cycles obtaining corrected documents
- **Delays** in obtaining signatures can lead to delays in getting documents on file with the PTO



Advantages of electronic signature software

- **Ease of signing** – No hardware or mailing supplies required. Software requirements (web browser) nearly universally available, including signing from smartphone
- **Multiple signing options** (draw, insert stamp, stylized type) allow for customized signature which can be stored for later reuse
- Built in **signature workflows** can be set up for S-Signature compliance, limiting errors and reducing additional signature cycles
- **In-house contacts** can help coordinate or can be copied on items sent for signature
- **Speed** from start to finish – race to the Patent Office
- **Audit reports/certificates of completion** can be retrieved/stored for verification of signing details
- Jobs out for signature can be shared with **backups** for follow-up and retrieved/followed-up with as needed
- **No additional costs** to companies – Signers don't need seats in order to execute documents; in-house coordinators can be added to workflows to facilitate signing without additional seats



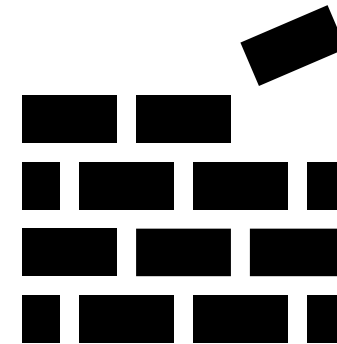
Electronic signature software considerations

- Database and document security
- Document output
 - How will it interact with electronic filing systems (EFS, EPAS, Patent Center (beta))?
- Ability to generate audit trail/certificate of completion
- Integration with existing software/workflows (i.e. Outlook, SharePoint, Box, OneDrive, etc.)
- Ease of use – Preparer and signer, including mobile use
- Ease of configuration
 - Can it be customized? Does it need to be?
- Compliance with applicable rules and regulations
- Pricing models – Number of users vs. Number of transactions
- Customer Support



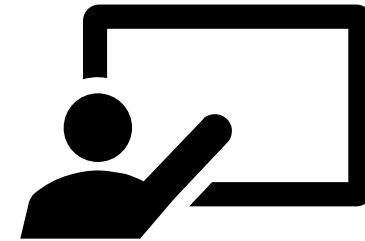
Software Setup – Administrator

- Set document security / password for editing signed PDFs
- Configure settings to integrate related software
 - Outlook Add In, SharePoint page, or OneDrive for uploading documents
 - Box for archival of signed documents and audit logs
- Access to accounts – contingency sharing
- Template creation
 - Inserting document text tags into standard or dynamic forms
 - Creating client-specific workflows that include a client coordinator or with specific messaging
 - Brand communications to help identify sender to recipients



Software Setup – User Rollout

- Test document preparation/sending/signing across multiple interfaces (desktop, tablet, mobile) to understand the signer experience and troubleshoot issues prior to user rollout
- Identify points of change to existing workflows
- Pre-load and save user signature/initials
- Internal Training
 - S-signature and electronic/digital signature requirements before patent offices
 - Document creation and tagging
 - Document sending and setting follow-up reminders
 - Extracting signed documents and how to prepare certified or protected PDFs for patent office filing
 - Archival procedures for signed documents/audit logs



Subjective "Truths" Learned

- Invariably, when an **inventor signature** is urgently needed, he/she cannot find a pen, is not near a computer, is out of printer ink cartridges, and/has no access to a post office box.
- Attorneys **always** want their electronic signature to look exactly like their handwritten signature.
- Document signers have a remarkable and uncanny ability to **creatively execute** documents.
- Once familiar with utilizing electronic signature software, preparers and signers of documents have at no point **waxed nostalgic** for the days of mailing and faxing signature pages.



Types of Signatures



Electronic Signatures

Electronic sound, symbol or process, attached to or logically associated with a contract or other record and executed or adopted by a person with the intent to sign the record - 15 USC 7006 (ESIGN Act)



Digital Signatures

Encrypted digital certificate to authenticate identity

Tiers of Electronic Signatures



Tier 1: Simple Electronic Signature

Data attached to/associated with other electronic data
Means of authentication
Easy to Use



Tier 2: Advanced Electronic Signatures (AES)

Linked to and capable of identifying the signatory
Tamper-sealed
Moderately easy to use



Tier 3: Qualified Electronic Signature (QES)

3d-party verification and token
Attached to record only via use of a “secure signature creation device”

Considerations for Legal Validity



INTENT



CONSENT



ATTRIBUTION



ASSOCIATION

Legal - US

Common Law

- Contract formation based on offer, acceptance, consideration

Legislation

- E-SIGN - Electronic Signatures in Global and National Commerce Act
- UETA - Uniform Electronic Transactions Act

ESIGN

Does not specify technology or form of the signature

ELECTRONIC SIGNATURE— The term 'electronic signature' means an electronic sound, symbol, or process, attached to or logically associated with a contract or other record and executed or adopted by a person with the intent to sign the record.

Permissive--No specified procedures / formalities

...with respect to any transaction in or affecting interstate or foreign commerce:

(1) a signature, contract, or other record relating to such transaction may not be denied legal effect, validity, or enforceability solely because it is in electronic form;

(2) a contract relating to such transaction may not be denied legal effect, validity, or enforceability solely because an electronic signature or electronic record was used in its formation.

UETA

CONSENT--may be determined from context, circumstances, and parties actions

ATTRIBUTION -- An electronic record or electronic signature is attributable to a person if it was the act of the person. The act of the person may be shown in any manner, including a showing of the efficacy of any security procedure applied to determine the person to which the electronic record or electronic signature was attributable.

The effect of an electronic record or electronic signature attributed to a person ... is determined from the context and surrounding circumstances at the time of its creation, execution, or adoption, including the parties' agreement, if any...

US Assignment Considerations

Enforceability of an assignment is generally a matter of state law

ESIGN is not limited to persons in the US (just as with other assignments)

But given the prevalence of other electronic signature laws in other countries, a conflict of law issue could arise re signatures of non-US based inventors

Though ESIGN and UTEA are (generally) uniform...

States may apply different standards for consent or attribution (security) and/or the proofs required (consent mechanism, audit trail, etc.)

States may offer elevated weight to greater security mechanisms

Assignment proof may require an explanation of the audit trail, have a strategy for maintaining that data long term—in effect, it is part of the assignment

Consider using a more secure digital signature technology on an assignment than the PTO would accept on another document

Legal - International

EU: Electronic Identification and Trust Services Regulation (eIDAS)

UK: Electronic Transactions Act

Canada: Uniform Electronic Commerce Act (Canada)

China: Electronic Signature Law of the People's Republic of China

India: The Information Technology Act (IT Act)

Japan: Law Concerning Electronic Signatures and Certification Services

Many more (at least 40 countries have laws enabling electronic signatures)

International – Paris Convention

Electronic signatures could present a new consideration

Paris Convention Art. 4(A)(1) establishes the right of priority, and the potential transfer of that right to a successor in title:

Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

Though the Paris Convention is silent as to the governing law controlling perfection of the transfer

Other jurisdictions do not always defer to the law governing the initial transfer

Europe and the UK

EP: eIDAS permits use of electronic signatures in Europe, with three tiers of verification standards

BUT: the EPO will not accept an electronic signature on an assignment (though it will accept a scanned copy of a “wet” signature)

In a recent decision, the EPO Legal Division refused to accept an assignment with electronic signatures, stating:

This formal requirement for the validity of such an assignment formal requirement for the validity of such an assignment constitutes autonomous law, which supersedes national law applicable under Article 74 EPC in this respect. Hence, neither national law governing the regime of electronic signatures nor specific EPO provisions in this context are applicable. Moreover, the EPO has no means of verifying the authenticity of the electronic signature following a certain national regime.

UK: Electronic signatures are accepted on documents including patent assignments

BUT: POAs (and deeds) must be signed by a notary in the same room as the signer, complicating electronic signature use

China

Though the Electronic Signature Law has been in place since 2005, at the current time CNIPA allows only registered users of the e-filing system to use electronic signatures -- but not patent applicants / inventors

For many situations, a certified copy of an prior assignment executed with electronic signatures (before a claim for priority is made), and recorded in the USPTO may be accepted by the CNIPA examiners

India

India requires either of two forms of digital signatures

(1) E-signatures that combine a digital signature (such as an Aadhaar) authenticated with an asymmetric crypto system and hash function which envelop and transform the initial electronic record into another electronic record (e-KYC), verifiable by a public key

(2) Digital signatures that are generated by an asymmetric crypto-system and hash function, issued by an approved Certifying Authority (CA) in the form of a digital certificate

Assignment Use Cases / Uncertainty

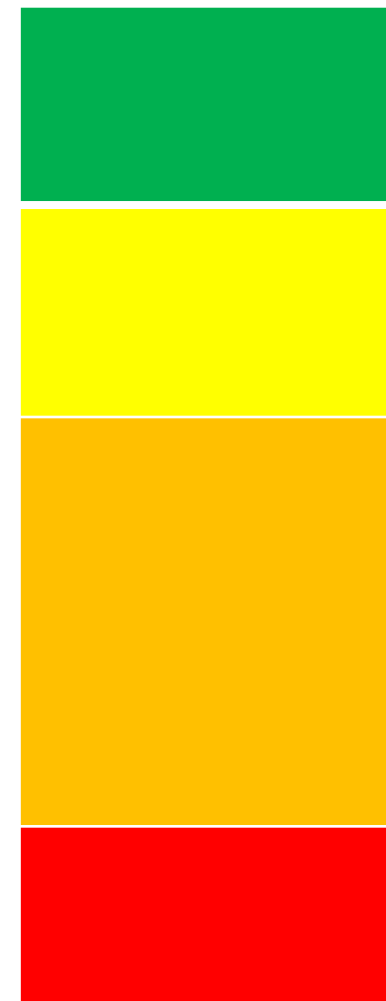
US application having all US-based inventors

Foreign filing of US application having all US-based inventors

Direct non-US filing of application

Any application having non-US based inventors

**Application filing in jurisdictions rejecting e-signatures
or having specific requirements**



Looking Forward

- **Wet Signatures are Still the Gold Standard**
- **Electronic signatures are increasingly accepted worldwide**
 - Though some major patent offices are lagging the trend
 - Non-uniformity of national requirements will always be an issue
- **An electronic signature assignment should suffice for US filings (and some non-US filings)**
- **If a wet signature assignment will be harder to obtain or be delayed:**
 - An electronic signature would likely be preferable to no express assignment
 - You can follow up with a ratification / confirmatory assignment when feasible

**Thank You For Your Interest.
Questions?**

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