

NEWS ALERT**INTELLECTUAL PROPERTY****Electronic Signatures and Patent Documents**

By Elizabeth A. Galletta and Stephen N. Kulhanek | February 11, 2021

Electronic signatures are becoming increasingly more common as many companies shift to work-from-home scenarios in response to the COVID-19 pandemic. Although electronic signatures are generally accepted under the United States Patent and Trademark Office ("USPTO") rules and the U.S. Federal and State laws, many foreign jurisdictions do not accept electronic signatures for patent assignment documents.

Documents Filed at the USPTO

The USPTO permits the use of electronic signatures for all documents filed using the EFS-web platform or via facsimile. 37 C.F.R. § 1.4(d)(2). This includes documents such as inventor declarations, information disclosure statements, powers of attorney, etc. Under regulation 1.4(d)(2), the appropriate electronic signature for documents filed at the USPTO is the "S-signature," which requires the signing party inserting their name between a pair of forward slashes (e.g., "/Jane Smith/").

Patent Assignments Filed in the United States

The USPTO does not assess the validity of patent assignment documents, which are not filed using the EFS-web platform. Patent assignment documents are assessed and interpreted according to federal and state law. In most scenarios, electronic signatures are governed by (1) the federally enacted Electronic Signatures in Global and National Commerce Act ("ESIGN"), and (2) the Uniform Electronic Transactions Act ("UETA"). Under the ESIGN and UETA, electronic signatures are afforded the same legal effect as handwritten signatures. Electronic signatures are defined as "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." 15 U.S.C. § 7006; UETA § 2(8). Therefore, intent is a critical element when assessing the validity of electronically signed documents. If the parties intend to effect assignment with an electronic signature, the electronically signed assignment should be valid under both federal and state law. Because intent is an important element in assessing the enforceability of electronically signed documents, including language in the patent assignment stating that all parties agree to using electronic signatures (such as the "S-signature") should further validate the assignment.

Patent Assignments Filed in Foreign Jurisdictions

Foreign jurisdictions may have different requirements for signing legal documents and many foreign jurisdictions do not accept electronically signed patent assignments. These jurisdictions include, but are not limited to, the European Patent Office, China, Japan, Korea, Taiwan, Mexico, Eurasia, Guatemala, El Salvador, Honduras, Nicaragua, Costa Rica, Panama, Columbia, Dominican Republic, Argentina, Chile, Peru, Malaysia, Indonesia, Philippines, Vietnam, and Thailand.

Conclusion

Although electronically signed patent assignments are acceptable for U.S.-filed patent applications, it is recommended to obtain wet signatures from all parties for patent assignments if there is a chance of filing the patent application internationally.

Murtha Cullina's Intellectual Property Practice Group can assist with any questions regarding using electronic signatures in patent documents and other questions pertaining to patent matters. Please direct any questions to:

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