



AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

241 18th Street, South, Suite 700, Arlington, VA 22202 Phone: 703.415.0780 – Fax: 703.415.0786 – www.aipla.org

October 6, 2008

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Mail Stop Comments - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Comments on Proposed Rule: Changes to Practice for Documents
Submitted to the United States Patent and Trademark Office
73 Federal Register 45662 (August 6, 2008)

Dear Under Secretary Dudas:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments regarding the Notice of Proposed Rulemaking (the “Notice”) proposed by the U.S. Patent and Trademark Office (PTO) regarding “Changes to Practice for Documents Submitted to the United States Patent and Trademark Office.”

AIPLA is a national bar association whose more than 16,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

The PTO proposes to limit the types of correspondence that may be submitted to the Office by facsimile, and to establish a penalty of not giving a receipt date to a paper that is facsimile transmitted to the PTO in contravention of the new limitations. The proposed rules would

establish an increased minimum font size for papers submitted to the PTO for a patent, patent application, or reexamination proceeding. The PTO also clarifies its practices under EFS-Web.

The proposed rules generated a substantial amount of diverse comments. Among practitioners who already use the EFS-Web and the proposed 12 point font, there was little concern. However, even some of these practitioners regretted the potential loss of a facsimile option when the EFS-Web is suddenly unavailable because of system disruption or local loss of internet access. The majority of AIPLA commentators were concerned about the adverse impact on their ability to serve their clients, and about the overall costs that are likely to be incurred by both applicants and the PTO if these proposed changes are adopted.

Under each of the headings used in the Notice, general comments are provided in addition to comments, suggestions and requests for clarification addressed to specific proposals.

Facsimile Transmission

The proposed rules would limit the types of correspondence that could be submitted to the PTO in order to receive a filing date. Although this basic principle is not new (e.g., a new patent application could never receive a filing date if submitted by facsimile - at least not without a petition), the proposed rules would withdraw some opportunities for facsimile transmission that exist today. The substitution of the proposed complex system of limitations and exceptions will lead to increased costs for some applicants and the PTO in dealing with the consequences of adopting the proposed limitations. Errors will be made with increased frequency, requiring correction and wasting valuable resources for practitioners and the PTO.

There are concerns about the PTO's justification for limiting facsimile transmission. The PTO indicates that terminating the use of facsimile transmission in most cases where it is now permitted is appropriate because of the possibility of low-quality images, the use of a wrong

facsimile transmission number by some practitioners, the need for the PTO to print the transmitted correspondence, process and scan the paper, and update the IFW, and the availability of EFS-Web. 73 Fed. Reg. at 45663. However, AIPLA strongly suggests that adoption of the complex limitations proposed is neither necessary or desirable given the facts that (1) the PTO now has the authority to request a new copy of any paper that is not legible; (2) confusion over an appropriate facsimile transmission number may be due to the failure to post a listing of such numbers in an easily accessible location, or the possibility that a designated machine is not always operational; and (3) many organizations now use facsimile handling systems that convert the facsimile signal directly into a file that can be transmitted electronically. Such a system could be adopted by the PTO.

Some of the strongest concerns over the proposed limitations on facsimile transmission were voiced by solo practitioners, by those in small firms, or by those practicing in relatively small towns away from large cities who still largely rely on facsimile transmission for much of their correspondence with the PTO. Even those transitioning to the EFS-Web system are more comfortable with moving to a new system with the knowledge that they have a familiar and proven system as a back-up. The PTO deserves credit for providing an EFS-Web system that has attracted wide-spread use in a relatively short period of time. As noted in the Notice, filings by EFS-Web have increased from about 28% in October 2006 to about 70% in the middle of January 2008. This is a remarkable achievement. However, it also strongly suggests that, while the number of practitioners using facsimile transmission is steadily decreasing, its use has not been abandoned by most practitioners as an emergency back-up, and by some practitioners who continue to use facsimile transmission on a routine basis to service a small client base that is most vulnerable to change and increased costs.

The complexity of the proposed facsimile limitations suggests a lack of appreciation for the burdens placed on applicants, on over 30,000 registered practitioners, and on their support staff who try to comply with PTO regulations without incurring the costs of time and money for remedial action (e.g., petitions to waive a rule or revive an abandoned application) when a mistake is made. For example, the proposed rules would link permissible use of facsimile transmission to what would not be permitted to be submitted via EFS-Web (Proposal § 1.6(d)(1)(viii)). According to the PTO:

“applicants and other parties, prior to determining whether to submit documents via facsimile transmission, would need to review the current version of the Legal Framework for EFS-WEB to determine what is permitted to be submitted via EFS-Web or some other Office electronic system and thus not permitted to be facsimile transmitted.”

73 Fed. Reg. at 45665.

It is respectfully submitted that the patent system and applicants deserve a far simpler approach to communicating with the PTO. The facsimile transmission limitations should not be adopted as proposed.

Proposed § 1.6(d)(1):

The section sets forth the general principle that facsimile transmission will not be available for correspondence listed in this section, including correspondence referenced in other sections for which EFS-Web is available and that could change without any change in the language of this rule. Many practitioners commented on the unnecessary complexity that this adds to the efforts to communicate with the PTO. To avoid this complexity and the adverse consequences associated with noncompliance, many practitioners will be encouraged to return to the practice of mailing papers to the PTO, a practice that is contrary to the goals of the PTO. This section would also prohibit facsimile transmission of correspondence in cases before the Board of Patent Appeals and

Interferences (Board). For practices unique to the Board, these limitations should also appear in Part 41.

One of the assumptions in these proposed facsimile limitations is that if correspondence is permitted to be filed by EFS-Web, then facsimile would not be a recognized form of communication. Several practitioners commented that the EFS-Web is periodically unavailable, and that the alleged ease of use of EFS-Web is overstated. Even for Washington area firms, the ability to timely file a document may be severely compromised when EFS-Web is suddenly unavailable at the 11th hour. Until greater reliability of EFS-Web is achieved, and practitioners are given a longer period of time to transition to that system, facsimile transmission should remain a viable alternative to communicate with the PTO.

Proposed § 1.6(d)(2):

This section would make mandatory that a facsimile transmission be limited to a single application or other matters before the Office, except for the payment of maintenance fees and requests for refunds thereof. In its commentary, the PTO has suggested that proposed amendments to claims in related applications that are to be discussed in the same upcoming interview should, nevertheless, be separately transmitted. 73 Fed. Reg. at 45,667. This example is not understood. If these are amendments for applications, they would not be permitted to be filed by facsimile under the proposed rules, but if these are unofficial discussion papers for the interview that are not made part of the record in either file, it is not clear why the proposed amendments would need to be separately transmitted. Clarification is required.

This section also would require that facsimile transmissions be sent to specific facsimile transmission numbers that will be identified by the PTO for that type of correspondence. The PTO expects to provide a Web page that would contain this information. This is a reasonable approach

and should facilitate the proper handling of documents when filed by facsimile transmission. The success of this approach, however, is highly dependent on the clarity of information and guidance provided regarding the various types of correspondence and their associated unique facsimile numbers, and will require that each number be maintained in working order. Several practitioners suggested providing a general number that could be used when a correspondence-specific number was not available or the web information was not available.

Proposed § 1.6(d)(3):

Great concern was expressed over the provisions of this section that would treat any paper or fee filed in contravention of the new facsimile limitations as: (1) not being given a receipt date; (2) not operating as an effective paper to toll any period for reply; and (3) that could be discarded by the PTO without notification to the sender. These consequences were viewed as an excessive penalty, and clearly unnecessary to correct the mistakes that inevitably will occur following the implementation of the proposed facsimile limitations. The PTO currently has suitable procedures for addressing situations where facsimile transmissions sent to the PTO are not associated with the correct file. See 37 C.F.R. § 1.8(b). These procedures should be retained when mistakes are made under the proposed rules, if such rules are adopted.

An applicant who uses facsimile transmission when not authorized, or uses the wrong facsimile number, should not be penalized by a holding of abandonment for such minor errors that will undoubtedly occur. This is particularly true if the PTO does not even intend to notify the applicant that the filing was improper, as proposed. Consider a situation where a paper is faxed to the wrong number, but is nevertheless associated with the proper file (as occurs in most cases today through only reasonable efforts by PTO staff) and is acted on by the examiner who later grants the patent. The validity or enforceability of this patent should not be subject to challenge simply because a paper was faxed to the wrong number. The PTO should reconsider and withdraw

this penalty, and provide a system that would include the information and service that will provide incentives for practitioners to use the system correctly, and minimize any additional work for the PTO.

EFS-WEB

The PTO commentary for these proposed rules makes reasonably clear the intended link between EFS-Web and facsimile transmissions. Papers intended for placement in official files or for use in applications or reexamination proceedings can generally be submitted by EFS-Web. Exceptions to this general principle are third party submissions under § 1.99, protests under § 1.291, and public use hearing papers under § 1.292.

On the other hand, papers that are considered unofficial and are not intended to become part of the public record are not to be submitted via EFS-Web, but such papers can be submitted via facsimile transmission if properly identified as “unofficial” papers (proposed § 1.6(d)(2)(iv)). It is not clear why any paper filed by any party, including a third party, should be considered “unofficial” in a reexamination proceeding, particularly in the high percentage of reexamination proceedings involving a patent in litigation. Transparency of these important proceedings should be a high priority. The PTO should reconsider its policy and practice regarding unofficial papers in reexamination proceedings, at least those involving a patent which is the subject of ongoing litigation.

Font Size

The PTO proposes to increase the minimum acceptable font size to 12 Point in Times New Roman to improve the legibility of documents supplied to the PTO and permit ready and reliable electronic capture by use of digital imaging and optical character recognition. The PTO has clarified that the proposed font size requirement does not apply to pre-printed information on

forms provided by the Office or the copy of the patent submitted on paper in double column format as the specification in a reissue application or request for reexamination. Proposed § 1.52(a)(3).

This particular proposal evoked considerable concern for a variety of reasons. No one questions the desirability of creating a record of legible documents in PTO files. Some concern was expressed over a lack of clarity as to when the new requirement would apply. In addition, some commenter's questioned whether applicants' forms that are equivalent to those of the PTO (exempted from the new requirements in the proposed rules) should also be exempted, particularly when the PTO retains the authority to request a replacement document for any document submitted that is not legible.

Proposed § 1.52(b)

This proposed section identifies the papers and documents filed in patent applications and reexamination proceedings that would be subject to the new font size requirements. However, the commentary leaves most readers with more questions than answers. For example, the new requirement appears to apply to "other papers submitted during prosecution of an application or a reexamination proceeding." Proposed § 1.52(b). This is reasonably clear for papers actually drafted for submission in a patent application or reexamination proceeding, but what about other papers typically submitted, such as:

(1) documents submitted in an IDS? The commentary at 73 Fed. Reg. at 45668 states that the requirements are applicable to IDS listings and any other IDS requirements such as a concise explanation or translation (but not the actual non-English language document). The message in the underlined passages is not consistent and is confusing.

(2) documents from a court proceeding involving the same patent in reexamination or a foreign counterpart involved in an opposition proceeding?

(3) documents submitted from a parent application in a continuing application - e.g., declarations from the inventor(s) or others under 37 C.F.R. §§ 1.131 or 1.132? Do these have to be reexecuted for the continuing application if they do not comply?

(4) documents submitted in support of patentability - e.g., patents, published application, or non-patent literature?

(5) documents from a court or other evidence submitted to support a petition under 37 C.F.R. § 1.47, for example?

(6) records or other documents submitted in support of affidavits/declarations under 37 C.F.R. §§ 1.131 or 1.132, or petitions such as a petition to revive or accept late payment of a fee?

Clarification of the papers subject to this requirement is requested. The PTO is urged to limit the new font size requirement, if adopted, to papers that are actually prepared for submission in the relevant files.

Proposed § 1.52(b)(2):

This is the section that proposes to limit the minimum font size to 12 point in Times New Roman. It is also understood that the proposed minimum would apply to footnotes, superscripts, subscripts and other specialized characters. 73 Fed. Reg. at 45669. If properly understood, this is likely to cause considerable noncompliance when applied in the context of chemical formulae and structural representations. If larger fonts are used in such structures and representations, it is likely to make some structures and reaction schemes less readable, and may complicate the PTO's ability to publish this information. The PTO should not require that chemical structures and representations be subject to the 12 point font minimum limitation, if adopted.

The requirement that all forms, except unaltered PTO forms, must comply with the proposed minimum font size requirement was of significant concern to many practitioners. According to some, the reason PTO forms are not used is that many are not provided in computer fillable versions that can save entered data for each form. Several firms reported that they have sets of forms that will have to be redeveloped to be compliant with the new minimum font size requirement. Such an exercise is not only costly, but seemingly unnecessary where the noncompliant text is standard, and often tracks a similar presentation on standard PTO forms. The PTO acknowledges that use of smaller fonts on PTO forms “keeps the forms from being too long and makes them more usable.” 73 Fed. Reg. 45669. The same considerations should prevail when applied to applicants’ forms. The PTO should exempt not only its own forms from this new requirement, but also forms used by applicants to present the same information provided in PTO non-compliant forms. It should be sufficient if the applicant provided information complies with the proposed 12 point minimum, without requiring that every character on the form comply.

If the PTO adopts either the new facsimile limitations or the minimum font size requirements as proposed, it is requested that sufficient time be provided for practitioners to adapt their systems and forms (particularly font size) to the new requirements. Some practitioners have estimated that a minimum of six months would be required to redesign their library of forms (up to 120 in one case) to be in compliance. It is respectfully submitted that such a burden and cost should not be necessary if the proposed regulations would focus only on information provided that is unique to each application or reexamination proceeding.

We appreciate the opportunity to provide these comments on the proposed Changes to Practice for Documents Submitted to the Patent and Trademark Office, and would be pleased to answer any questions our comments may raise.

Sincerely,

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Q. Todd Dickinson
Executive Director
AIPLA