

**From:** Gray, Rhonda E.

**Sent:** Monday, October 06, 2008 12:38 PM

**To:** ac27.comments

**Subject:** August 06, 2008, Notice of proposed rulemaking regarding Changes to Practice for Documents Submitted to the United States Patent and Trademark Office (USPTO)

In response to the August 06, 2008, Notice of proposed rulemaking regarding Changes to Practice for Documents Submitted to the United States Patent and Trademark Office (USPTO), Sughrue Mion, PLLC submits the attached comments for consideration.

*Rhonda E. Gray - Programmer/Analyst*

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October 6, 2008

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Commission for Patents  
P.O. Box 1450  
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Attention: Raul Tamayo, Esq.  
Legal Advisor  
Office of Patent Legal Administration

Dear Mr. Tamayo:

In response to the August 06, 2008, Notice of proposed rulemaking regarding Changes to Practice for Documents Submitted to the United States Patent and Trademark Office (USPTO), we submit the following comments:

**Elimination of Facsimile Transmissions**

The USPTO has proposed eliminating facsimile transmissions for most communications (see proposed 37 CFR 1.6(d)(1)). However, facsimile transmissions are necessary in view of constant interruptions to the EFS-Web server. Recent experience over the past two months shows that EFS-Web has been unavailable at least during the afternoons and/or evenings of August 11, 12, 21, 27, 28, September 2, and 25, 2008. Even for Washington area firms, the ability to hand carry documents to the USPTO or a US Post Office is not always an available alternative when EFS-Web is suddenly unavailable at the 11<sup>th</sup> hour. Until a more reliable performance is achieved, the USPTO must reconsider eliminating facsimile transmissions since facsimile transmissions are a necessary alternative for filing.

**Requirement for a Minimum of 12 Point Text - Consistency for USPTO Forms**

The USPTO has proposed that all text must be no smaller than 12 point Times New Roman font size and that lines must be 1½ or double spaced except when using pre-printed



forms “provided by the Office” (see proposed 37 CFR 1.52(b)(2)). However, the pre-printed forms provided by the USPTO currently **DO NOT** adhere to the proposed font size and line spacing requirements.

In order for these pre-printed forms to be used, they must be manually filled in on typewriters. Manual completion of pre-printed forms is inefficient, subject to errors and inconsistent with electronic processing, completion and filing. Thus, many of the pre-printed forms, well over 150, have been customized by individual firms and are fill-able automatically from a database or by operators, but use the smaller fonts found in the pre-printed documents. All of these customized forms will have to be changed.

#### **Requirement for a Minimum of 12 Point Text - Few Fill-able USPTO Forms**

Most USPTO forms are **NOT** provided in a computer fill-able version that can save entered data for each form. For example, the Application Data Sheet (SB/14) allows users to save entered data; however, other forms like the Utility Patent Application Transmittal (SB/05) do NOT allow the user to save information inserted into the form. Accordingly, as already noted, many firms have created customized fill-able versions of each USPTO form that avoid this deficiency. However, these forms use a font size consistent with the pre-printed PTO forms.

Before the USPTO finalizes the font size and line spacing requirements discussed above, the USPTO should provide fill-able forms that can save entered data for each available form.

#### **Requirement for a Minimum of 12 Point Text - No Text Wrap in Fill-able USPTO Forms**

Some of the USPTO’s fill-able forms are deficient in that they do not provide operators an ability to view all text in certain columns because they do not wrap text to subsequent lines. For example, Patent Prosecution Highway Form SB/20-JP has this wrap text deficiency. If the



USPTO does require the font size and line spacing requirements discussed above, the USPTO should modify their fill-able forms so that text wrapping is available in every appropriate column before implementation of the rule.

#### **Impact on Existing Customized Document Suites - Adequate Time to Implement**

If the font size and line spacing requirements are implemented, users who have invested substantial sums and operator hours to create electronically fill-able customized forms will be required to revise those forms to meet the new requirements. The USPTO should provide sufficient notice so that users are able to conform existing modified documents to meet the new requirements. It is estimated that approximately one person year, meaning six months for a two person staff, would be required. Alternatively, the rules should not go into effect until all USPTO forms adhere to the font size and line spacing requirements or until the USPTO can provide a fill-able version that *can save entered data* for each form.

#### **Impact on Existing Customized Document Suites - Substantial Costs Will Be Incurred**

For a medium size firm having 70-100 practitioners, the cost for implementation of the new rules would require one of the following three alternatives:

- Initially, approximately \$200,000 in time and labor for two people to redesign all existing firm customized forms to meet the new font size and line spacing rules (at a cost of \$115 per hour, 7 days a week for one year). This cost does not include time and labor that would otherwise be spent on developing/maintaining forms to adhere to new or updated PTO forms. This would be the primary option.



- Initially, approximately \$70,000 for an Acrobat software license for each user that would permit modification of pre-printed forms . This would be a secondary option which would be client driven.
- Initially, approximately \$20,000 to provide an additional 50 typewriters to permit typing in the data to USPTO pre-printed forms. Additional costs would be incurred by a firm on an annual basis due to lower efficiencies and higher errors. Additional costs also would be incurred by the USPTO in dealing with corrected errors. This is the least favored option.

You may direct any comments or questions to Rhonda E. Gray, Program Analyst,  
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Sughrue Mion, PLLC