

Ms. Marcie Lovett, USPTO ([InformationCollection@uspto.gov](mailto:InformationCollection@uspto.gov))

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Ms. Lovett:

I'm a registered practitioner, no 42527, and I'm responding to the FR notice on page 32298 of the FR (vol. 81, no. 99). However, my comments pertain not to any of the forms listed in the FR notice but to forms not on the notice and/or to their processing by the PTO, including form letters issued by the PTO which do not explain alleged defects in formal aspects of applications.

The first comment is specifically with respect to form PTO/SB/08a-EFS-Web (the information disclosure statement in which applicants make publications known to the Office). When one fills this form and attempts to submit it, if there are no US patent documents listed on the form, the Office's electronic filing system (EFS) gives a warning message to the effect that "if there are no US patent documents, then the office will have to manually enter the documents listed". This statement is incorrect, as the office never enters a list of cited references. This warning message is thus confusing and should be removed, or replaced with a message along the lines of "There are no US patent documents listed; did you mean to include any of these?"

The second comment concerns form AIA/14, the application data sheet (ADS). This form, and the Office's processing of it, is a source of incredible amounts of wasted time. The idea behind the form is a good one: to have applicants provide data about the application (inventors, assignees, applicants, priority and benefit data) in a way that can be automatically uploaded into the Office's computer systems and thus save the Office the time of inputting that information itself from the applicant-provided form, while at the same time reducing errors that might occur as the office inputs that data itself. To this end, the USPTO provides a fillable PDF form that, if used by the applicant and uploaded through EFS, is supposed to be automatically read by the USPTO's computers and the information thus automatically inputted into the system.

There are, however, several difficulties with the form and how it the Office treats it. First, with respect to claims to the benefit of earlier-filed US applications, neither the 35 USC nor 37 CFR require that this information be listed on the ADS in a particular order. All that is legally required is that the information be provided. And presumably, in this day and age it would not take much in the way of computer-programming acumen to write a program that could take the prior application benefit information from the ADS and order it in chronological or reverse chronological order, or align the chain(s) of benefit claimed in the event that the benefit of more than one earlier application is claimed. Indeed, as shown below, the ADS itself says nothing about the *order* in which benefit claims are to be listed:

### Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) or indicate National Stage entry from a PCT application. Providing benefit claim information in the Application Data Sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.  
When referring to the current application, please leave the "Application Number" field blank.

Prior Application Status			<input type="button" value="Remove"/>
Application Number	Continuity Type	Prior Application Number	Filing or 371(c) Date (YYYY-MM-DD)
Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the <b>Add</b> button.			<input type="button" value="Add"/>

Yet, in practice, if the benefit claims are not listed in a particular order – an order not set forth in the statute or rules or even spelled out on the ADS itself – the benefit claims won't be recognized by the Office's computer or by the humans who are still involved in the processing of incoming applications. That's not only ridiculous and wasteful, it's *ultra vires* and a dereliction of the PTO's duty.

If one then receives a filing receipt with incomplete or incorrect benefit information and wishes to get the Office's oversight corrected (or even if it's the applicant's fault for inputting wrong information or omitting information), one has to jump through the hoops of filing a corrected ADS. The Office has for some reason decided to make this an art form unto itself: a corrected ADS is supposed to show new or changed material in underline and deleted material in ~~strike through~~, and unchanged material doesn't need to be marked. This, presumably, is in order to allow the Office to more easily identify the changes. But the fillable pdf form provided by the Office doesn't facilitate this marking, making it rather difficult to provide the required mark-ups. In fact, it's easier for an applicant to make up his own ADS in MS Word, and use that for subsequent corrected versions, than to use the Office-provided fillable pdf form. That MS Word form, of course, can't be read by the Office's computers, thus necessitating more work on the part of the Office, and providing more opportunities for mistakes to enter the PTO's records. Why can't the Office simply provide a fillable pdf that facilitates the mark-ups that the Office asks for? Or why can't the office allow applicants to mark-up ADS forms in a different way, e.g. by highlighting added words in one color and highlighting deleted words in other color?

Even if one provides such a marked-up ADS, it often happens that the person processing it will say it wasn't correctly filled out because not everything is properly underlined or crossed-out. At which point the applicant must start the process again. In other words, the Office spends more time making sure the form was (in its view) properly filled out, rather than addressing the underlying issues.

Another problem is in the filling of ADS forms for the filing of continuation applications. Typically, the inventor and applicant information remains unchanged, so that the only difference in the ADS from that of the parent case is the additional line in the benefit claim information concerning the benefit claim to the parent application. Thus the easiest way to provide an ADS in a continuation is to take the ADS from the parent case and add the additional benefit claim to the parent application. But the fillable pdf provided by the Office only allows one to do this at the bottom of the benefit claims section, and despite this being perfectly legal under the Office's own rules, the Office won't process such a benefit claim, as it wants the newest benefit claim to come at the top of the section. (Again, this bit of information is nowhere to be found in the statute, rules or on the ADS itself.) Thus the applicant must re-do the entire

benefit claims section in order to comply with the Office's *ultra vires* requirement. That's a waste of time, particular if there are many benefit claims.

Another issue with the ADS concerns the mailing address and residence information of the inventor. The form asks for both of these pieces of information, but the Rules only require residence information if it differs from the mailing address. Yet if one fails to provide complete information in both sections (see below), the Office will bounce the ADS as being incomplete, necessitating a response on the part of the applicant. Again, the Office's failure to abide by its own rules results in significant wastes of time. See the file history of USSN 14/716513 for an example of a case where this occurred (a complete mailing address for inventor Yotam Almagor was provided but the residence information did not indicate a country; under the PTO's own rules, this should have been a non-issue; see notice mailed September 18, 2015 and subsequent correspondence of September 18, December 7 and December 14, 2015).

### Inventor Information:

Inventor 1 <span style="float: right;">Remove</span>				
Legal Name				
Prefix	Given Name	Middle Name	Family Name	Suffix
Residence Information (Select One) <input checked="" type="radio"/> US Residency <input type="radio"/> Non US Residency <input type="radio"/> Active US Military Service				
City		State/Province	Country of Residence	
Mailing Address of Inventor:				
Address 1				
Address 2				
City		State/Province		
Postal Code		Country		
All Inventors Must Be Listed - Additional Inventor Information blocks may be generated within this form by selecting the <b>Add</b> button.				Add

Another area of concern is the failure of the Office to clearly communicate perceived defects in ADSes. Often we'll receive letters from the Office telling us that something is wrong with our application, but not clearly stating what the problem is. This is a problem with the form letters used by the Office, specifically the OPAP. A fellow practitioner, Carl Oppedahl, recently blogged with great clarity about one such difficulty here: <https://blog.oppedahl.com/?p=1606> so I'll merely refer you to that blog post. But the fact that the OPAP is apparently staffed primarily by people fresh off the boat for whom English is not their mother tongue, that none of these people (save about 3 or 4 senior-level staff) have their own telephones or email addresses, and that applicants must call a *different* branch of the Office, viz. the inappropriately named "Application Assistance Unit" (it's the applicant who's in need of assistance, not the application) to have someone *try* to explain what the alleged problem is with the file is incredibly inefficient and wasteful of everyone's resources. The AAU often has no idea what the alleged problem is and thus advises "solutions" that OPAP subsequently rejects, necessitating another round of paper-pushing.

Another problem, albeit minor but still dumb: in the benefit claim section of the ADS, one indicates that status of the prior application at the time of filing the present application. Thus if I file a continuation application, I'll indicate that the parent application is pending. Now, if the continuation is filed shortly

before the parent case issues as a patent, then by the time the PTO issues a filing receipt for the continuation, the parent case has matured into a patent. In such cases, the PTO will note on the filing receipt that the continuation is a continuation of case XX/YYYYYY, with a little asterisk noting that “information provided by the applicant is inconsistent with the Office’s data” or something like that. But the filing receipt doesn’t specify the alleged inconsistency, leading some applicants to wonder what the inconsistency is and to spend time chasing it down. But often there’s no inconsistency; the only change is that in the time it took the Office to process the new application and issue a filing receipt, the parent case status went from “pending” to granted. Why on earth does the Office makes statement about inconsistencies when there are none? In the situation I just described, the information provided by the applicant WAS consistent with PTO info at the time the information was provided. Why doesn’t the PTO look at THAT?

And another issue: when filing by EFS, the applicant must manually enter certain information at the start of the process, regarding the first named inventor and application title and, if the application is a PCT national stage filing, the number of the PCT application. The problem is that the Office regards that initially-inputted information as controlling rather than what is on the ADS, as is required by law. I once made a typo in the PCT number and the office said that I had entered someone else’s application in to the national stage, even though the inventor and title I provided didn’t match, and even though the information in the ADS was completely consistent with that inventor and title and completely inconsistent with the PCT that the Office chose to regard as having entered the national stage. See USSN 14356890. The Office demanded a petition to accord the correct filing information, even though that information was provided, as required by law, on the initially filed ADS.

A similar problem exists with regard to checking benefit claims: the office doesn’t do it. This can result in the Office publishing applications that were not meant to be published. The following blog post provides details of such a case: [http://www.iliplaw.com/americaisrael\\_patent\\_law/2016/03/up-yours-inventor-uspto-improperly-publishes-abandoned-application-or-why-doesnt-anyone-at-the-uspto.html](http://www.iliplaw.com/americaisrael_patent_law/2016/03/up-yours-inventor-uspto-improperly-publishes-abandoned-application-or-why-doesnt-anyone-at-the-uspto.html).

Thanks for reading.

Dan Feigelson