

From: Lester Rules
Sent: Saturday, September 13, 2008 10:03 AM
To: ac27.comments
Subject: Comments on RIN 0651-AC27, Docket PTO-P-2008-0022

September 13, 2008

Dear AC27-Comments

The following is responsive to, and makes reference to, the Notice of Proposed Rulemaking by the United States Patent and Trademark Office (the Office) that was published in the Federal Register on August 6, 2008 (RIN 0651-AC27). Please consider and respond to the following comments before implementing any new rules regarding **font size and facsimile transmission**.

Facsimile

1) The notice describes facsimile transmission as burdensome and expresses a preference for EFS-Web Filing. However, restricting the papers that can be filed by Facsimile places an undue burden on applicants.

EFS-Web requires that applicants have access to web connected computers and register and train themselves to use EFS web, including the burden of PKI certificates and all the rest. Additionally, asserting that EFS- Web is available as an alternative to facsimile transmission over looks the times that EFS-Web is not available, such as, for example the **outages** that occurred since the subject notice was published on August 6 including **August 11, August 13, August 28, September 4 (PAIR) and September 7**. Assertions made in the notice that transmission by mail is available overlooks the filing date and transportation disadvantages that are associated with mail delivery. Furthermore, papers delivered by mail must be a similar burdensome to the Office as facsimile transmissions since, according the Office practice, scanning and OCR are required for those documents as well.

If the asserted benefits to the applicants and availability of EFS-Web were real, then those advantages alone would drive the number of facsimile filings down to a level that the Office would not find burdensome. Clearly applicants see an advantage to facsimile filing, at least some of the time. Clearly the Office is discounting or overlooking these advantages in this proposed rule making.

It is respectfully submitted that rather than forcing applicants to use EFS-Web, the Office should make E-filing less burdensome and more reliable than faxing. Please note, that this is not a suggestion that facsimile filing be made

less reliable than it now is.

2) The assertion that image quality of faxes is quite low when printed and viewed would appear to indicate a problem with the facsimile or printing equipment that the Office is using. Furthermore, the Office can reject illegible submissions under 37 CFR 1.52 without additional rule making.

3) Scanning equipment used to make documents ready for EFS-Web filing is just as likely to be faulty or of poor quality as scanning equipment used to send facsimile transmissions. Indeed, it is respectfully submitted that in some instances the same scanner or multi-purpose device is used for .pdf file generation and facsimile transmission **Accordingly, the assertion that an image quality issue is the fault of scanning equipment does not seem to be solved by relying on EFS-Web.**

4) If the scanners and OCR technology used by the Office further compromise quality, **that would seem to be a problem of the Office that is equally applied to mail transmission**, which the Office points to in the subject rule making as an acceptable alternative to facsimile transmission.

5) If an area of the Office receiving a document can't recognize what type of correspondence has been received, that would seem to be a training or routing issue at the Office and not a reason to further inconvenience and limit the choices of the applicants.

6) How can it not be possible to route correspondence to the appropriate area? Surely, it must always be marked with an Examiners name or an application serial number. That should be enough to make it possible to route. If it is possible to route and isn't routed in a timely manner, that would appear to be a training or personnel problem at the Office and not a reason to further inconvenience and limit the choices of the applicants. If Office personnel lose pages of documents on a regular basis, this would seem to be a problem of training or management.

7) It is the Offices choice to scan documents. The fact that the Office prefers electronic documents to paper is not a reason to limit the choices of applicants. Furthermore, there is no reason that a faxed document needs to be printed in order to scan it. Faxed documents are received in electronic image form and can be manipulated and routed in that form. If the Office systems don't allow for that, it is an equipment/management issue at the Office and not a reason for further limit applicants choices.

8) Contrary to the assertions of the Office it is not appropriate to burden applicants with the costs of computers, internet connections and EFS-Web training all to avoid having process the occasional fax. **If EFS-Web is the boon to applicants that the Office professes, then the number of fax transmissions the Office receives should fall off to an insignificant amount by market forces instead of growing to the burdensome number of over 240,000 a year.**

9) The notice asserts that documents are faxed to the wrong number within the Office. If the Office has promulgated a confusing number of facsimile numbers and classified those numbers in a confusing manner, perhaps the Office should instead centralize facsimile reception, scanning and routing, rather than reducing applicant choices and services to applicants.

10) **EFS-Web is not, contrary to the assertions of the notice, available 24 hours a day 7 days a week.** EFS-Web is often unavailable due to both scheduled and unscheduled outages. as evidence, **see the 5 outages listed above that have occurred in the 5 and a half weeks** since the publication of the subject notice. Furthermore, applicants equipment and/or internet service providers can suffer outages. Accordingly it is inappropriate to eliminate the ability to transmit documents by facsimile.

Font Size

11) The assertion of the notice that substantial numbers of papers are being filed at 6 point font sizes is simply not believable. If documents are being submitted at 6 point, it can only be to counteract the effect of burdensome page count limits instituted by the Office. **If the Office wants applicants to submit documents with a large font size, the Office should remove arbitrary page count limits.**

12) The notice complains that small fonts make it difficult to OCR documents. **However, the Office would not have to OCR documents if the Office would accept documents in the nearly universal formats of the popular word processing programs.** Furthermore, if the Office accepted documents in Word and/or WordPerfect formats instead of requiring of applicants the the extra steps of printing and scanning documents (printing to PDF not being entirely reliable) for EFS-Web submission then the Office could easily resize even 6 point texts to what ever size the Office felt appropriate.

13) The Office asserts that it has encountered strong resistance when asking that documents be resubmitted in a larger font. But, the Office does not explain why applicants are reluctant to comply with such a reasonable request even if there is no regulatory requirement to do so. Could it be that the Office has placed an unreasonable page limit on the documents in question and that complying with the request would require the payment of an excess page fee or the redaction of important arguments and the risk of loss of patent protection? Perhaps the Office should eliminate page arbitrary page limits, thereby solving the purported legibility problems.

Rule Making Considerations

A. Administrative Procedure Act

The assertion of the notice that the proposed rules "do not effectively foreclose the applicant's opportunity to make a case on the merits" made in the subject section of the proposed rule making is false or incorrect.

A number of documents submitted to the Office are under a strict page limit. For example, a Pre-Appeal Brief Request for Review is strictly limited to 5 pages. Accordingly, an applicant is often required to identify and convincingly argue that various portions of a 45 page Office action include clear errors in a very limited space. By additionally requiring that a 12 point font be used, the Office is effectively foreclosing the applicant's opportunity to make a case on the merits.

Accordingly, the APA does apply, prior notice and opportunity are required and the assertions made by the Office in this regard are false or incorrect.

B. Regulatory Flexibility Act

The assertion of the notice that the elimination of the availability of Facimilie transmission will have a significant economic impact is false or incorrect. The assertion that EFS-Web and USPS alternaives are available is not completely correct. **EFS-Web is often unavailable** without warning. Use of the USPS is associated with issues of transportation and limited hours of operation. In many instances, facsimile transmission would and currently does allow an applicant to meet a deadline that would otherwise be impossible to meet.resulting in the requirement to pay extension of time fees or abandonment

of applications.

The assertion of the notice that the requirement that documents submitted to the Office have a minimum font size will not have a significant impact because the current rules of practice require that such documents be presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic electrostatic, photo-offset and microfilming processes and electronic capture by use of digital imaging and optical character recognition, is absurd. **If cited 37 CFR 1.52(a)(1)(v) operated to prevent the filing of papers with a font size smaller than 12 point, then the Office would not feel it necessary to issue a font size rule.**

Moreover, **this absurd assertion is being made in the Federal Register in a font size far smaller than 12 point** in a publication that is successfully photocopied and scanned by many on a regular basis.

Furthermore, **this absurd assertion is being made by representatives of the U.S. Patent and Trademark Office, an organization that publishes at least hundreds of documents a week (on Tuesday and Thursday), each of which is in a font size far smaller than 12 point** and each of which is readily photocopied, scanned and processed through optical character recognition software.

Still furthermore, **that the Office finds that it is able to carve out an exception for its own forms, is clear evidence that the Office is able to scan text at a font size smaller than 12 point.**

For all of these reasons 37 CFR 1.52(a)(1)(v) DOES NOT operated to prevent the filing of papers with a font size smaller than 12 point and the proposed rules will have a significant economic impact.

D. Executive Order 12866

For the forgoing reasons the assertion that the rule making is not significant for the purpose of Executive Order 12866 is traversed.

F. Executive Order 13211

Since and inability to transmit papers by facsimile will lead to **extra trips to**

post offices, extra freight in the transport of mail and longer working hours to meet filing deadlines, the proposed rules would have a significant **adverse effect on the use of energy**. Therefore a statement of the energy effects is required under Executive Order 13211.

I. Executive Order 12630

As indicated above, when the font size limit is combined with a page limit it effectively reduces an applicants ability to make a persuasive argument and thereby runs the risk of taking property through the final rejection of applications that would otherwise be allowed. Alternatively, it will force applicants to **pay appeal fees** that would otherwise not have to be paid. **In either case, the rules amount to a taking of private property** and Executive Order 12630 applies.

For the forgoing reasons the proposed rules should not be implemented in whole or in part.

Thank you for your consideration.

Lester Rules