

From: Dever, Chad
Sent: Monday, October 06, 2008 1:35 PM
To: ac27.comments
Cc: Reimer, Leah
Subject: Cantor Colburn LLP's response to the proposed font size rule change

Dear Under Secretary Dudas,

Please find attached response to the proposed rule change appearing in the Federal Register Vol. 73, No. 152, at pp. 45662-671 dated Wednesday, August 6, 2008.

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October 6, 2008

The Honorable Jon Dudas:
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Attn: Raul Tamayo
Legal Advisor
Office of Patent Legal Administration (OPLA).

Dear Under Secretary Dudas:

The following comments are presented in response to the U.S. Patent and Trademark Office ("Office") request for public comment concerning the proposal to revise the rules of practice relating to, *inter alia*, the font size requirements in documents submitted to the Office appearing in the Federal Register Vol. 73, No. 152, at pp. 45662-671 (73 Fed. Reg. 152) dated Wednesday, August 6, 2008.

Cantor Colburn LLP is a law firm specializing in intellectual property law with offices in Hartford, Connecticut; Alexandria, Virginia; Troy, Michigan; and Atlanta, Georgia. We generally agree with the Office's proposed mandatory minimum font size of the equivalent of 12 point Times New Roman font.

We would like some clarification of the proposed rule changes with respect to super- and subscripts. Further, we respectfully request that the new rule include a mandatory minimum of the equivalent of 10 point Times New Roman font for (1) footnote text and numerals; and (2) chemical and mathematical formulae and equations and tables. We strongly believe that a 10 point font requirement for these particular items will be sufficiently legible to be easily read and to be readily captured by OCR. We further believe that the 10 point font requirement will significantly reduce the length and greatly enhance the general readability of the document.

Section 1.52(b)(2)(ii) is proposed to be amended to correspond to the amendment of PCT Rule 11.9(d) by requiring a text lettering style having

capital letters, which capital letters must be no smaller than 0.28 cm. (0.11 inch) high (e.g., a font size of 12 point in Times New Roman). The Office noted that , in the absence of a mandatory minimum font size, “[s]ome practitioners and applicants...have adopted a continuing practice of submitting documents that are not readily legible, e.g., entire specifications with a font size as small as 6 point.” 73 Fed. Reg. 152, 45666.

Cantor Colburn LLP wholeheartedly agrees that “[f]ont size as small as 6 point does not have sufficient clarity to permit electronic capture by use of digital imaging and optical character recognition (OCR)...” *Id.*

In view of the significant problems facing the Office by applicants’ use of unusually small font size, and the recent amendment of PCT regulations (effective April 1, 2007, PCT Rule 11.9(d) was revised from “all text matter shall be in characters the capital letters of which are not less than 0.21 cm high” to “all text matter shall be in characters the capital letters of which are not less than 0.28 cm high”), the Office proposed increasing the mandatory minimum font size. *Id.*

While we agree in principle with the proposed changes to eliminate “applicants’ use of unusually small font size,” we are concerned that the current changes would inadvertently eliminate the use of “usual” small font sizes, e.g., 9 point and 10 point Times New Roman font, that have been used in certain circumstances without incident by many practitioners.

Superscripts and Subscripts

The Office has stated that

Specialized usage of the type font in a word processing program, such as “2nd”, super and subscripts, etc., must comply also with the minimum font size requirements. In other words, the normal font size produced by the program for these specialized characters when the program is set to comply with the capital letter requirement must be maintained.

Id. at 45669.

We understand this statement to mean that the automatic super- and subscript fonts generated when using a compliant font, such as 12 point Times New Roman, is in compliance with proposed rule 1.52(b)(2)(ii). Thus the rules prohibit altering the normal super- and subscript font sizes.

Please confirm that the normal super- and subscript fonts generated when using a compliant font, such as 12 point Times New Roman, is in compliance with the proposed rule.

Footnotes

The Office has stated that

Additionally, applicants also need to be aware that as a word processing program may normally set a footnote numeral and the text of a footnote to be smaller than the required 0.28 cm. capital letter height to be used in the main text, applicants must adjust the font size of the footnote accordingly to meet the requirements of the rule.

Id.

It is unclear to us what footnotes the Office is referring to. We believe that the Office is referring both to footnotes used as legends for tables in specifications as well as to footnotes used in other communications such as Responses to Office Actions, Appeal Briefs, and Interference Briefs.

We respectfully submit that setting a mandatory minimum of the equivalent of 10 point Times New Roman font for footnote numerals and text would accomplish the legibility goals of the proposed rule changes while maintaining the traditional look of footnotes that are designed to be set apart from the main text. In addition, we respectfully submit that increasing the mandatory minimum font size for footnotes will result in over-long documents.

While we strongly agree that 6, 7, and even 8 point font are not sufficiently legible, we respectfully submit that 9 point and certainly 10 point font are both clearly legible. As the Office indicates, word processing programs generally default footnote text and numerals to a smaller font size, typically 9 point or 10 point font. As this is the standard default setting for programs

such as Microsoft Word, we believe this is a “usual” small font. The traditional 9 or 10 point default settings for footnotes further indicates that the majority of users and readers find that this size font is legible.

The interference rules indicate that the Office believes a footnote font size as small as 9 point would be legible. *See e.g.*, 37 CFR § 1.653(g) (“The record may be produced by standard typographical printing or by any other process capable of producing a clear black permanent image. All printed matter except on covers must appear in at least 11 point type on opaque, unglazed paper. Footnotes may not be printed in type smaller than 9 point.”)

Therefore, we respectfully request that the new rules include a mandatory minimum of the equivalent of 10 point Times New Roman font for footnote text and numerals.

Chemical And Mathematical Formulae And Tables

The Office does not directly address the font size in chemical and mathematical formulae and tables, except to note that attempts to resize a document may result in “substantive errors in the document, particularly where tables, charts, formulas, and drawings are concerned.” 73 Fed. Reg. 152, 45666. 37 CFR § 1.58(c) provides, *inter alia*, that “[c]hemical and mathematical formulae and tables must be presented in compliance with § 1.52 (a) and (b)...” Thus, the changes to Rule 1.52(b) will impact Rule 1.58(c).

As stated above, we believe that a 10 point Times New Roman font is legible. Chemical and mathematical formulae generally include a number of characters that may also include subscripts and superscripts (*e.g.*, R_1 or x^2). The 12 point font requirement may result in some formulae, especially longer chemical structures or mathematical expressions, becoming unduly long and therefore difficult to read.

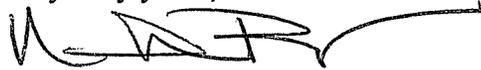
Similarly, tables that include a large amount of data would also become cumbersome and difficult to read if they had to comply with the 12 point font requirement. For example, a large table may run across several pages if the data were presented in 12 point Times New Roman font, but would fit into a single page if the data were presented in 10 point font.

In *KSR*, the Supreme Court re-affirmed the importance of unexpected results and secondary considerations in determining the patentability of an invention. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007) (“The fact that the elements worked together in an unexpected and fruitful manner supported the conclusion that Adams’s design was not obvious to those skilled in the art.”). Therefore, it is expected that applicants will submit greater amounts of data to support a finding of nonobviousness. We believe that a 10 point Times New Roman font will ensure the readability of these data without creating unduly long documents.

Therefore, we respectfully request that the new rules include a mandatory minimum of the equivalent of 10 point Times New Roman font for chemical and mathematical formulae and tables.

We appreciate the opportunity to provide comment on the proposed rules and are grateful for this Office’s consideration of our response.

Very truly yours,



Leah M. Reimer, Ph.D.
for Cantor Colburn LLP