From: Allen Hoover
Sent: Friday, August 15, 2008 3:39 PM
To: ac27.comments
Subject: Comment on proposed rules relating to facsimile submissions

I agree generally with the concept of encouraging the use of EFS over other forms of filing. EFS is easier for support staff to use when filing documents with the Office, and provides a clearer electronic file wrapper for review of third party file histories. I have three comments on the Notice of proposed rulemaking:

(1) Rule 1.6 should contain an "emergency" clause for when EFS is unavailable. EFS is not always available. Sometimes EFS itself is not working, and sometimes EFS has problems with the practitioner's .epf certificate. Sometimes the practitioner will have a computer problem. The rule might specify that if a bona fide attempt is made to use EFS, but this attempt fails, facsimile may be used with a certification of the bona fide attempt.

If, in an emergency, EFS were not available, the Office would receive the communication in paper form anyway, probably by first class mail. I believe that facsimile would be more useful and reliable than first class mail in such cases.

(2) While this may be the present and future practice anyway, rule 1.52 should specify explicitly that any papers that do not correspond to the formal requirements will not affect the filing date of such paper. In the event a paper was filed that was deemed not to comply with the format rules, the applicant would be notified and given a period of time within which to submit a complying paper.

This is a particular issue for foreign-originated applications. Sometimes these arrive at the last minute and there is no time for re-typing or re-sizing the document. See existing 1.52(d)(1) for a similar provision concerning non-English filings.

There also are issues concerning the use of what the Notice calls "commercial" PTO forms. For instance, if a priority claim is made via a commercial ADS that does not comply with the font requirements, would there be issues as to the validity or timing of the priority claim?

(3) The Notice states that "it is recognized that Internet e-mail communications are not secure." Although the Office has a policy of disallowing email communications in patent applications, and likely will continue this policy, the Office should not issue blanket statements that such communications "are not secure." E-mail communications are deemed sufficiently secure by most lawyers and companies to be used to exchange attorney-client privileged information. The American Bar Association has endorsed the use of non-encrypted e-mail communications (see http://www.abanet.org/cpr/nosearch/99_413.pdf>).

Allen E. Hoover

Banner & Witcoff, Ltd.
10 S. Wacker Drive
Chicago, IL 60606
Tel 312-463-5000
Fax 312-463-5001