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Sent: Monday, August 18, 2008 9:52 PM
To: ac27.comments
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Subject: Comment on proposed changes to Fax submittal rules

These are comments on the Notice of Proposed Rulemaking, entitled "Changes to Practice for Documents Submitted to the United States Patent and Trademark Office", printed at 73 FR 45662 et. seq.

Initially, I was astonished to read in the above Notice that the PTO prints received faxes onto paper and then re-scans them into the IFW. Software has been available for many years for receiving faxes directly into PDF files. Numerous fax machines now come with such software for free. Often, in fact, the software will automatically perform OCR even before the PDF is delivered to the operator. If the Office were to use this kind of software, the steps of printing and scanning, and all the problems they cause as described in the Notice, can be trivially eliminated.

Also, the Notice relies on an assumption that EFS is (or is becoming) a better substitute for faxing documents into the PTO. We use EFS all the time, and we agree that EFS is an effective and economical way to submit documents. However, there are times when the simplicity of faxing a document cannot be beat. EFS unavoidably requires a series of sometimes complex steps to properly create, upload and submit documents, most of which can be easily bypassed when faxing. For example, when faxing there is no need to struggle to use the correct embedded fonts. Also handwritten markings (on drawings being modified, for example, or on signed Declarations with handwritten notations initialed in the margin), are very hard to get into a format for EFS. For these and other kinds of documents, faxing is by far the easiest, quickest and most reliable method of submission. It would be a shame to lose that option.

Still further, faxing should remain available merely because it offers another route through the PTO mailroom, differing from the route taken by EFS-uploaded documents. There have been times when we have submitted materials by EFS and no action seems to have been taken by the PTO. We then submit a document by fax, merely directing the Office's attention to the prior EFS-submission, and all of a sudden the PTO takes appropriate action. It is as if the EFS submission failed to generate the appropriate workflow, or it did and then the workflow got lost somewhere. The faxed document, by passing through different hands, was able to jog the workflow back into operation. Again, it would be a shame to lose the faxing option, for this reason as well.

Finally, even if the Office does implement this proposed rule, I would suggest strongly that faxing should remain a permitted alternative on any day in which EFS goes down. EFS does go down periodically, sometimes for long periods of time, and the Office cannot assume that this can be completely prevented in the future. In Korea, we have experienced difficulties where their EFS counterpart was down at a critical juncture and there was no fax alternative. The effort that goes into unwinding an EFS outage can be enormous. Therefore, I strongly suggest that the fax alternative remain available at least on any day in which EFS goes down.

If EFS truly is a better option than faxing, then I would suggest that practitioners will transition from fax to EFS submittals naturally. There is no need to deny practitioners the option of fax submittal merely because EFS is better. If practitioners continue to submit certain documents by fax, then the PTO should see that as an indication that EFS is actually *not* better, at least for those kinds of documents. That is, rather than eliminating fax transmission as an option for most

submissions, the Office should continue on its positive path of constantly improving and simplifying EFS. Practitioners will then transition to EFS naturally.

Thank you

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