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FACSIMILE COVER SHEET

Attention: Lynne G. Beresford

Date: January 2, 1996

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From: N. Scott Pierce, Esq.

Subject: Response to Request for Comments Concerning Modifications of Express Mail Provisions

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Attention: Lynne G. Beresford

Dear Ms. Beresford:

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In response to the Patent and Trademark Office (PTO) request for comments concerning modification of **express** mail provisions, as set forth in 1180 O.G. 122-126 (November 28, 1995), the Boston Patent Law Association ("BPLA") submits the attached.

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cc: Peter M. Dichiaro, Esq.
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Gregory D. Williams, Esq.
DPLA.102/C\MISC

Sincerely,



N. Scott Pierce

**COMMENTS OF THE BOSTON PATENT LAW ASSOCIATION
CONCERNING MODIFICATION OF
EXPRESS MAIL PROVISIONS**

The Patent and Trademark Office (PTO) requested comments concerning the proposed modification of 37 C. F. II. §1.10 "Filing of correspondence by Express Mail." Notice of Proposed Rulemaking, 1180 O.G. 122-126 (November 28, 1995). The Boston Patent Law Association (BPLA) submits the following response.

The BPLA objects to the proposal rule modification of §1.10. The objection is limited to aspects of the proposed rule which alter the standard of "deposited with the United States Postal Service." The proposed rule establishes the date of deposit as the "date in" as recorded by the Postal Service, without regard to actual deposit. This change requires that Express Mail correspondence be handed to a Postal Service employee, and a legible and correct "date in" notation be made by a Postal Service employee at that time. If this newly required procedure is not followed, one risks loss of a filing date. The proposed change represents both a change in practice as to what constitutes "deposited" with the Postal Service, and a change in the availability of proofs of deposit.

The BPLA does not object to aspects of the proposed rule which permit acceptance of materials sent by Express Mail as of the "date in" as recorded on the Express Mail label, absent an Express Mail Certificate. The BPLA objections address the inconvenience that will result from application of the proposed rule, its employment of the subjective standard of "legibility," and the lack of a timely determination of proper mailing that will be inherent in filing documents by Express Mail under the proposed rule.

1. Inconvenience

As stated in the PTO comments accompanying the proposed rule (1180 O.G. at 124), under the proposed rule, persons choosing to use an Express Mail Box, and who, hence, will not oversee a Postal Service employee receive the mail, may not later argue for the benefit of a § 1.10 filing date if the "date in" on the Express Mail is improperly filed or not clearly marked. As codified in § 1.10(b), this effectively eliminates the use of Express Mail Boxes for filing by Express Mail. A prudent attorney is necessarily required to travel to a Post Office. In most instances, this requires the burden of travel beyond presently available Express Mail Boxes. After 5:00 p.m., this likely requires travel to evermore distant Post Offices which remain open to later hours.

As further inconvenience, the proposed rule requires the responsible attorney to attempt to personally supervise the procedures of a Postal Service employee. Such supervision will be required, whether the Express Mail is taken to a Post Office or picked up at a law office as a service of the Post Office. Supervision can be expected to particularly delay the Postal Service employee at the point of Express Mail pick-up and may, further, conflict with that employee's work schedule and responsibilities.

Where, previously, the responsibility for patent prosecution wrts limited to inventors, their representatives, **and** the PTO, **the new rule** includes Postal **Service** employees **as necessary participants in the** patenting process. Neither **the** inventors, **nor** their representatives, nor the PTO **can purport to exercise** any **real control or supervision over** Postal Service employees.

II. Subjective Standard

Under **subparagraphs** (a) and (b) of the **proposed rule**, **and** contrary to **the current § 1.10(c)**, legibility and **accuracy** of the "date in" as recorded **by the Postal Service** employee is determinative of the date accorded by the Patent Office, **despite the** presence of a Certificate of Mailing by Express Mail. The person filing a paper by Express Mail must review the "date in" as entered **by the Postal Service employee**. This, again, **presumes that the Postal Service employee** is **prepared** to cooperate in such review. After review, if the **person** mailing by Express Mail is dissatisfied with the penmanship, **a clarification** of the "date in" must **be obtained**. **There is** clearly the potential for those seeking to obtain clear "date in" Express Mail receipts **to fail to obtain** them, despite **the** greatest diligence. Under such **circumstances**, a **prudent** practitioner would be required to prepare duplicate papers and resubmit **them** -- time permitting.

III. No Timely Determination of Mailing

Under the **present** rule, an **attorney or agent** who **has** properly **prepared papers** and **timely** deposits them with the Postal **Service** -- either in an Express Mail **Box** or at a Post Office -- is assured that such papers **will be held to have been** filed **with the PTO as of** the date of such delivery, unless more than a reasonable **time has elapsed** between the **certificate date** and the Patent and Trademark Office receipt date, **or other** questions regarding the **date of** deposit are present. This is **true** even if later petitions **and proofs** of deposit are required. Under the proposed rule, **timely** deposit with the United States **Postal Service, alone**, will be insufficient. There **will** not be effective deposit without a proper "date in" notation. Further, a **final** determination of **timely** "deposit" cannot be established **without a PTO adjudication** limited to **label** legibility, **and** exclusive of attorney diligence. **This review** will, in **almost every** instance, be long after substantial rights have **been** irretrievably **lost**.

*** ACTIVITY REPORT ***
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RECEPTION OK

TX/RX NO. 9229

CONNECTION TEL

CONNECTION ID

START TIME 01/02 16:43

USAGE TIME 01'35

PAGES 4

RESULT OK