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U.S. PATENT
AND
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19 December 1995

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Attn . : Lynn G. Beresford

Sir:

Re: Comments On Proposed Rulemaking
37 CFR 1.10

These comments are directed to the proposed revision of 37 CFR 1.10 which would eliminate the provision for according an earlier correspondence filing date based upon a "Certificate of Mailing by Express Mail" and would limit such a benefit to those dates which one is able to document by means of a 'date in" notation on an "Express Mail" label.

The purpose for this revision, as set out in the introduction to the "Notice of Proposed Rulemaking", is ostensibly to alleviate the danger of "loss of substantive rights" occasioned by a "omitted or deficient" Certificate of Mailing by Express Mail prescribed under the present rule. On the contrary, however, the proposed rule would greatly increase the risk of such loss of rights by removing from the practitioner control of the key element in establishing the

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otherwise available earlier filing date, namely, designation of the mailing deposit date.

Whereas it is now within the practitioner's power and interest, and with full knowledge of its importance, to provide a proper and sufficient Certificate of Express Mailing, one's substantive rights would, under the proposed rule, be entirely at the pleasure of, according to the Notice, a "disinterested third party" -- the postal clerk who is not trained in, and is thus not sensitive to, the depth of those rights which are dependent upon a clear and precise insertion of the "date in" notation **on the** Express Mail label. However, within the ordinary course of the clerk's duties, the "date in" notation simply marks the beginning of the term for "next day service", the failure of which risks only a refund of postage paid.

This danger is not merely perceived, it is real. This is supported by the fact that, upon first reading the Notice, we withdrew six Express Mail labels at random from our patent application files in order to examine the "date in" notations. Of those representative samples, five showed no year, the partial date on one was illegible (the Customer Copy is the third level carbonless copy) , one bore **no date at all**, and one was the "Finance Copy" (with presumed date numbers lying outside the "date in" block) rather than the "Customer Copy".

This problem which the revised rule engenders would be exacerbated in a corporate environment, such as ours. Although, as the Notice suggests, a sole PTO practitioner or a PTO-specialized firm may have cognizant, trained personnel who can deliver Express

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Mail to the Postal Service and oversee preparation of the essential "date in" receipt (we question, however, the degree of such oversight which would be applied by one who would neglect to affix a sufficient Express Mail Certificate), the corporate PTO department does not enjoy that capability and can only, at best, knowledgeably apply the prescribed Express Mail Certificate. This results from the fact that after having left that department and entered the general corporate mail stream, Express Mail parcels are relegated to the care of a second "disinterested party" who is assigned to deliver the parcels to the Post Office and who will ultimately interface with the Postal Service counterpart at the critical point where the essential "date in" receipt notation is created and upon which the "substantive rights" of concern entirely depend.

If the PTO rulemakers believe that the interests of practitioners' clients would be well served by placing in the hands of unknowing and uncaring persons the creation of receipts essential to the preservation of substantive rights of those clients, so be it. However, please do not deprive the attentive practitioner of the ability to establish within one's own bailiwick, by means of the current Express Mail Certificate, evidence sufficient to likewise preserve those rights.

To this end, we earnestly request that any revision to the Rules not withdraw the current provision for use of the Certificate, but only add the alternative provision which would enable reliance upon a "date in" notation on the Express Mail label. We believe that such alternative provisions would serve the intended purpose of the rule change by providing a means for