

COMMENTS TO THE USPTO ON E-COMMERCE SOFTWARE

**Submitted by: The National Association of Patent Practitioners
Louis J. Hoffman, Board Member and Chair, Government Affairs Committee
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INTRODUCTION

The National Association of Patent Practitioners (NAPP) is a nonprofit trade association for patent agents and patent attorneys. NAPP has approximately 450 members in 13 countries. The practices of the practitioner members are focused primarily on patent prosecution, namely practice before the USPTO. As part of NAPP's mission, we aim to create a collective nationwide voice to address issues relating to patent-prosecution practice. Additional information about NAPP can be found at www.napp.org.

The following comments are submitted in an effort to assist the United States Patent & Trademark Office (USPTO) in its laudatory efforts to promote electronic commerce. Don Levin, Director of the E-Commerce Division at the USPTO, spoke to NAPP's annual meeting in Las Vegas in the summer of 2007, and NAPP membership greatly appreciated his comments and the work that the division is doing in promoting online tools to facilitate patent prosecution. At the meeting, Mr. Levin solicited suggestions for further improvements, and his sincere desire to better serve the public struck a positive chord in many NAPP members. Thereafter, much discussion has occurred on the NAPP mail list identifying problems and concerns or areas of improvement. The below suggestions were compiled by the author noted above from comments by members who posted requests or complaints on the mail list.

NAPP welcomes the opportunity to assist and hopes that the USPTO will seriously consider the comments of NAPP and its interested members, and revise the electronic facilities accordingly. NAPP would be happy to help USPTO in its work and could be available to answer questions, comment on software design, beta test releases, or any other way that the USPTO would find of use.

SUGGESTIONS

The following suggestions are not in any particular order of priority. They are roughly grouped according to various areas of electronic commerce tools on the USPTO cite (EFS, PAIR, etc.). They are numbered merely to allow for unique identification in case reference is needed to this document.

1. Mistake expunging: Allow EFS users to delete, completely and with no consequences (including fees), within a 24-hour period, a recently uploaded case. This would be useful to allow applicants to avoid cluttering PTO records with incorrect filings where the mistake is noticed quickly. This happens with some frequency, for such reasons as a misindexed file, wrong selection of a particular uploaded document (which might be confidential or for a different client), or various other clerical errors. It is now very difficult to delete anything from an official file.

2. Notice of wrong coding: Generate an automated notice (preferably through email) letting the EFS filer know when a document filed has been re-coded by the PTO clerk. This allows the filer to know when the PTO had changed the coding. If the code change is incorrect because of PTO clerical error, the notice allows the filer to object before the mistakenly changed coding causes problems within the PTO. If the code change is correct because the PTO clerk caught an error by the EFS filer, then the notice would permit the EFS filer to understand the correct coding, which would make the same kind of error in coding less likely in future filings, particularly by the same law firm, EFS filer, or staff person who made the error.

3. EFS refunds: Allow for automated requests for refund of fees through EFS request menus, to avoid present practice of forcing requesters to write up a separate paper from scratch to make a request. At a minimum, this could be done for certain common types of refund requests. Better, this could allow a request for refund for any fee paid through the EFS system, merely by identifying the fee (such as by date or other identifier, already used in EFS, and fee code), checking a multiple-choice box (e.g., radio button or drop-down menus) giving common reasons (with a blank box for typing, in case none of the common choices apply), with a place to add comments.

4. Correlating supplemental, related non-electronic documents: In some cases, filers now will avoid using EFS entirely because one piece of a multi-document filing cannot be done electronically. For example, a filer may need to file an application that includes a CD with a program code appendix. Or a filer may wish to send to the PTO a paper check prepared by a client, rather than paying by credit card or deposit account. Presently, filers facing such situations will elect to bypass EFS entirely. PTO could encourage further use of EFS by

allowing the EFS filer to file those portions of the application or other filing that can be filed electronically (which may be most of the filing) and check an EFS box indicating that it is desired to deliver a non-electronic document (at a minimum, a document of certain sorts, at a maximum, any document the filer wishes). Checking the box could cause EFS to assign a unique transaction number or other identifier, which the filer could include with the related, non-electronic document or item being delivered, allowing PTO to cross-reference them easily. The filer could be warned that the correlated, delivered document must be delivered on the same day by hand or using mail certification process appropriate for the situation to ensure the correct filing date. Or, the mail-delivery rule could be adjusted to give the date for any document delivered within a reasonable time if identified through the EFS system.

5. IFW views of drawings: The present Adobe-based image file wrapper system shows landscape-oriented drawings in portrait mode. Information has come to our attention that perhaps the system available to PTO examiners, which uses a different display interface, shows drawings in their correct orientation (landscape drawings are shown in landscape orientation). But that is not the case for the IFW system available through PAIR, which is inconvenient to the public.

6. Practitioner OED filings: Allow EFS-registered practitioners to update with the OED address and phone number information (and maybe even attorney/agent status). Present practice requires a “snail-mailed” change-of-address form sent to “Mail Stop OED” and a month delay before the information is updated.

7. Correlation between “attorney/agent tabs” and “customer number” addresses: There is a quick and easy means for practitioners to update their address/phone number data by correcting “customer number.” However, changes entered in the customer number do not necessarily cause correspondingly changed information to the same information in the “attorney/agent” tab of each application assigned to that customer number, or do so only after an unacceptably long lag. Information from EBC suggests that it is a manual process to update the various assigned applications. This should be automated to avoid work for the EBC and errors in mailing out actions.

8. Credit card charge memos: When a credit card is used to charge a PTO fee, the charge memo (which appears on the credit card statement) typically shows the phrase “government service,” a generic phone number, and a date (which, by the way, is often a few days after the EFS submission). This causes problems for active practitioners, because there are many fees of the same size, so it is sometimes difficult to figure out which charge has been entered to which application. To allow better association with clients, which would make it easier for practitioners to use the EFS system, develop a way to include a transaction

identifier that would appear on the credit card charge. If this is not possible, at a minimum, the charges should say "patent office" or "USPTO" (instead of "government service") and include the correct date.

9. "Response due by" column: Private PAIR has a data table under the tab "Application by Customer," which has a "status" column listing the most recent office actions for applications assigned to a given customer number. The status column can be clicked to order the applications by office action mail date. Add a new column called "response due by" or the like. This could be automatically populated by the PTO's system based on the type of action (e.g., a restriction requirement is one month, an office action or notice of allowance is three months, a notice of missing parts is two months), in nearly all cases. Because the PTO encodes the type of actions, it would be simple to have the computer calculate the due date. Including such a column would allow practitioners to sort the table by due date by clicking on the title bar. This would also allow for fewer docketing errors and reduce petitions related to abandonment/revival or fee errors for extensions, substantially reducing PTO clerical work.

10. "Back" button: In private PAIR, the "back" button does not work, at least without refreshing the page. It should work normally, as in nearly all web-based applications.

11. Eliminating list re-sorting: The list of applications should remain sorted as the practitioner last requested, at least for the same session. Presently, the list is displayed every time at the default position, and the sort request is ignored. For example, if the list is sorted by most recent status date, and the practitioner clicks on the first application, then clicks the tab accessing the list a second time with the intent of viewing the second application, the practitioner finds that the list has been resorted in ascending serial number order (the default) and must click the status tab (actually twice, because the first click goes in ascending order from oldest, not reverse order from newest as most people prefer), and wait for the list to redraw, before the second application can be clicked. This is a huge annoyance that consumes much time, particularly when the PTO website is slow to respond. The problem is compounded by the fact that the "back" button doesn't work properly.

12. "Fees due" column: Show on the "Applications by Customer Number" list in PAIR the amounts of fees paid and the amounts of fees still due. At least, entries in the "transaction list" or IFW should identify the amounts of fees paid or indicated due in a missing parts notice, not just indicate that fees have been paid (so that it is not required to click on the fee calculation to know how much has been paid or is being requested).

13. Office Action posting delays in PAIR: Many practitioners have noticed that office actions are not posted to PAIR promptly. Indeed, often they arrive in “snail mail” before they are posted on the PAIR site.

14. Status date changes: Dates sometimes change in PAIR with nothing new appearing in IFW. Often this is a harbinger of an action to appear later, but it is odd and confusing to see a date change with no reason apparent for why it has changed.

15. Inventor/Practitioners: An inventor who is not a registered practitioner can file papers alone without filing a power of attorney, and the “attorney/agent” tab remains blank. An inventor who is represented by another person who is a registered practitioner files a power of attorney, which causes the “attorney/agent” tab to be filled in. But there is a curious gap applicable to situations where the inventor is also a registered attorney or agent. In some instances, such an inventor wishes to have the “attorney/agent” tab completed and use the practitioner’s registration number. This may be the case for co-invented applications or other reasons. Presently, the only way to accomplish this is to file a useless and odd-looking power of attorney appointing yourself to practice. There should be some easier way to allow the inventor who is also a practitioner to file papers using a registration number, and correlate with a customer number, without having to file a power of attorney.

16. PAIR/Maintenance Fee integration: Clicking on the “fees” tab in PAIR, for an issued patent, links to a different page in the maintenance fee section, although the serial number and patent number is filled in, which is appreciated. (a) Despite the automatic population, clicking to request the various fee pages quite often results in an error, but multiple clicks will sometimes bring up the requested information. This is odd. (b) The information from the maintenance fee linked page should be ported to the PAIR “fees” tab, to allow the reader to see which fees have been paid and are due without leaving PAIR.

17. PAIR/Assignment integration: It should be possible to click on an “assignment” tab in PAIR and link to the assignment database search page (as with the maintenance fee link), or better yet have the assignment information appear on a tab in PAIR without leaving PAIR.

18. PAIR access: From PAIR, one can access a variety of other databases, including the maintenance fees (by clicking on the “fees” tab or the “full text and image” of the patent or publication by clicking on that tab. However, presently it is not possible to go in reverse. It should equally be possible to access PAIR from the other pages. Although this would be useful from the maintenance fee page, it would be especially useful from the patent/publication “full text and image” database, which is used in searching patents. If links are available from PAIR to

corresponding entries in the full text database, why can't the links be bidirectional?

19. Savable fillable forms: All fillable-form pdf's should be savable. The ADS fillable form is savable, but not others, such as the provisional cover sheet.

20. Most recent Adobe Reader compatibility: It is a big problem that EFS cannot work with the latest update to Adobe Reader (now version 8.0). We understand that changes cannot be made immediately, but there should be a very small gap between time Adobe releases a new version and the time EFS works with it. One person commented: "The USPTO must overcome their reliance on a specific outdated version of Adobe Reader. Either a PDF is written in a 'Portable Document Format' or it isn't. In fairness, I have worked closely enough with Adobe to know that their software is a moving target. But this should not preclude ability to properly exchange PDF files of a particular version, say PDF-1.4 (Acrobat 5), or PDF-1.5 (Acrobat 6)."

21. Non-Microsoft browsers: Better support for non-IE browsers, especially Firefox, would be appreciated. PTO should test its software using more than one browser.

22. EAST search tools: At the July 2005 NAPP meeting in San Francisco, John Doll expressed surprise at the fact that patent practitioners working outside of the USPTO's Public Search Room did not have access to the same search tools as patent examiners. He expressed a willingness to make those (EAST) search tools available. NAPP has heard nothing more on this issue. Providing access to an equivalent search system would be prudent and in keeping with an advancement of the USPTO's quality goals. This is particularly the case given the PTO's recent rules initiatives, such as the Accelerated Examination Program (AEP), the proposed IDS rules (apparently being finalized), and the rules requiring searches for applications having "too many" claims (presently suspended by the court case).