

## THIRTY-ONE PATENT PRACTITIONERS

By Priority Mail 9405503699300264124305

Drew Hirshfeld  
Commissioner for Patents  
USPTO  
P O Box 1450  
Alexandria, VA 22313-1450

February 22, 2020

Dear Commissioner Hirshfeld:

In this letter, the undersigned patent practitioners ask that the USPTO discontinue its present practice of intentionally and actively aging PDX and DAS retrieval requests. We ask instead that going forward, the USPTO retrieve priority documents from PDX and DAS *at the time that the applicant requests such retrieval*. We also ask that USPTO *discontinue the PDX system*, so that going forward, priority document retrieval from the EPO can take place through the DAS system. We suggest that Form PTO/SB/38 be reformatted so that the boxes for the important information (application number, DAS access code, filing date, Office of first filing) be large enough to permit text to be entered in a font that is easily read by the human eye even after the form has been degraded in the e-filing process. Finally, we ask that USPTO *become a Depositing Office* with respect to international patent applications (PCT applications) that have been filed at the RO/US (the receiving office of the USPTO).

Most of the signers of this letter are patent practitioners belonging to the EFS-Web Listserv ([https://oppedahl-lists.com/mailman/listinfo/efs-web\\_oppedahl-lists.com](https://oppedahl-lists.com/mailman/listinfo/efs-web_oppedahl-lists.com)), an online community of users of the USPTO's patent-related e-commerce systems. The signers of this letter, and/or their firm or corporation, have between them filed more than thirty thousand patent applications at the USPTO in the past ten years and have paid more than forty million dollars in fees to the USPTO in the past ten years.

***Discontinue aging of retrieval requests.*** It is USPTO's present practice to age the attempted retrieval of an electronic certified copy of a priority document until "the U.S. application is docketed to a patent examiner." (MPEP §215.01.) USPTO has never explained why it ages such requests. This aging of the attempted retrieval is extremely harmful to patent applicants for many reasons.

One harm flowing from this aging is that almost always, the aging means that the attempted retrieval happens only after the expiration of the crucial “4 and 16” date, the date by which the applicant is obligated to have provided a certified copy of the priority document to the USPTO. If the retrieval attempt fails, for example due to some real or imagined defect in the applicant’s retrieval request, then the consequence is that it is too late to correct the defect. The further consequence is that the application’s priority claim will be lost. (In some cases it is possible to attempt to remedy a lost priority claim by petition, but such a petition incurs government fees, and the petition can be carried out only if certain representations can be made about the delay involved.)

In contrast, if the USPTO were to carry out the retrieval *at the time that the applicant requests it*, then if there were to be some real or imagined defect in the retrieval request, there would very often still be time for the applicant to correct the defect prior to the expiration of the crucial 4 and 16 date. This averts the loss of the priority claim.

Another harm flowing from this aging is that with the aging, the applicant is forced to maintain dockets for months or years, having to check periodically to see whether the USPTO might have carried out the retrieval in the days or weeks that have passed since the last check. This is wasteful of applicant resources that could have been given to other aspects of the application process. On the other hand, if the USPTO were to carry out the retrieval *at the time that the applicant requests it*, then the successful retrieval of the priority document would permit the applicant to clear the docket and it would permit the applicant to discontinue the periodic checks to see whether the USPTO had eventually carried out the retrieval.

Still another harm flowing from this aging is that it puts many applicants in the position of feeling that they have little choice but to file an “Interim Copy” in every application that they file. This is harmful because there is a non-negligible risk of accidentally filing the wrong document, thereby unintentionally risking disclosure of confidential material to the public. Even if the applicant avoids accidentally filing the wrong document, there is a further non-negligible risk of the applicant accidentally failing to satisfy the requirements of MPEP § 215.02(b) for a “separate cover sheet” containing certain information and “magic words”, and other “magic words” that must be provided on the document itself, for the document to serve as an Interim Copy. Finally even if the applicant manages to satisfy the requirements of MPEP § 215.02(b) so that the correct document is filed and is able to serve as an Interim Copy, the applicant will have incurred the non-negligible time cost and money cost of carrying out the filing. Nearly all filings of Interim Copies would be completely unnecessary if only the USPTO were simply to carry out the retrieval *when asked to do so* rather than aging the request until after the crucial 4-and-16 date.

In any application in which an Interim Copy is filed, this not only harms the applicant but also, we imagine, imposes costs upon the USPTO. One way that it likely imposes costs upon the USPTO is that we imagine the USPTO feels compelled to carry out some at least cursory review as to form with respect to each and every document that gets filed in each and every patent application. The review may include looking for blank and illegible pages as well as screening for scandalous or otherwise improper subject matter, and checking to see if the filer

has filed a credit card payment form. In any case where the USPTO relieves the applicant of the need to file an Interim Copy, this likewise relieves the Office of the need to review that Interim Copy as to form.

Patent Examiners are required to review each of the certified copies and Interim Copies as part of the examination process, to determine whether or not Box 4 or Box 12 should be checked as an acknowledgment of the provision of a certified copy of a priority document. In any case where the USPTO relieves the applicant of the need to file an Interim Copy, this likewise relieves the Examiner of the need to review that Interim Copy for purposes of Box 4 or Box 12. In any case where the applicant inadvertently files an Interim Copy that is a copy of the wrong document, this makes a lot of work for the Examiner who must then insert and complete a number of form paragraphs in an Office Action, communicating the mistake to the applicant. If on the other hand the USPTO retrieves the electronic certified copy *when asked to do so*, then the applicant need not file the Interim Copy at all, and thus there is not the risk of the wrong document being filed as an Interim Copy, and there is not the risk of the Examiner having to spend time and energy reacting to the wrong document having been filed as an Interim Copy.

In the interest of brevity the undersigned practitioners have not attempted to enumerate all of the ways that USPTO's present practice of intentionally aging retrieval attempts until after the 4-and-16 date cause harm to applicants. Many other harms to applicants also flow from USPTO's present practice in this regard.

***Discontinue the PDX system.*** At the present time, the DAS system is used for all electronic priority document retrievals, with the sole exception of retrievals from the European Patent Office. As for retrievals from the EPO, the USPTO continues the use of a legacy system called PDX. The PDX system has no troubleshooting capabilities available to the applicant. In contrast, the DAS system provides many ways that an applicant can troubleshoot in the event that there is some difficulty with an attempted retrieval of a priority document. The PDX system offers no way for the applicant to independently confirm that any particular document is actually available to the USPTO. In contrast, the DAS system permits the applicant to obtain a Certificate of Availability for any particular document, that provides an assurance that the particular document is actually available to the USPTO. The PDX system offers no way for the applicant to monitor the retrieval process. In contrast, with DAS, the applicant is able to set up an "alert" that will let the applicant know if an Office has successfully retrieved a document from DAS.

Both the USPTO and the EPO already belong to the DAS system, as Depositing Offices and as Accessing Offices. If only the PDX system were to be discontinued, then USPTO and EPO would be able seamlessly to transition to the use of the DAS system for their priority document exchanges. This would greatly benefit applicants.

The signers of this letter imagine that USPTO itself would benefit from this change. At present, USPTO must provide money and staff and physical resources to support two exchange systems (PDX and DAS). Were USPTO to discontinue PDX, it is contemplated that

USPTO could save the money and staff and physical resources previously expended on the PDX system.

**Reformat Form PTO/SB/38.** It seems to the undersigned that Form PTO/SB/38 is extremely poorly designed. The boxes where an applicant is supposed to enter the important information (application number, DAS access code, filing date, Office of first filing) are very small, and this means that the applicant is forced to use a very small font. The USPTO e-filing system then degrades the image quality of all e-filed papers. The practical result is that it is very hard to read the important information on Form PTO/SB/38. This leads for example to failed retrieval attempts from the DAS system due to unreadable DAS access codes. It is suggested that the boxes for the important information be made bigger.

**Become a Depositing Office with respect to RO/US.** The international patent system under the Paris Convention offers the opportunity for an applicant to claim priority from an international patent application (PCT patent application). Most patent offices around the world have chosen to become Depositing Offices in the DAS system with respect to PCT applications filed in their Receiving Offices, including the patent offices of Australia, Brazil, Chile, China, Denmark, Finland, Georgia, India, Israel, Morocco, Netherlands, Norway, Spain, and Sweden. In addition, the European Patent Office, the Eurasian Patent Office, and the World Intellectual Property Office have chosen to become Depositing Offices in the DAS system with respect to PCT applications filed in their Receiving Offices, bringing the total to seventeen Offices at the present time. Conspicuous by its absence on this list is the United States Patent and Trademark Office. It is requested that the USPTO become a Depositing Office in the DAS system with respect to PCT applications filed in RO/US.

In summary, the undersigned patent practitioners ask that the USPTO discontinue its present practice of actively aging PDX and DAS retrieval requests. We ask instead that going forward, the USPTO retrieve priority documents from PDX and DAS *at the time that the applicant requests such retrieval*. We also ask that USPTO *discontinue the PDX system*, so that going forward, priority document retrieval from the EPO can take place through the DAS system. We suggest that Form PTO/SB/38 be reformatted so that the boxes for the important information (application number, DAS access code, filing date, Office of first filing) be large enough to permit text to be entered in a font that is easily read by the human eye even after the form has been degraded in the e-filing process. Finally, we ask that USPTO *become a Depositing Office* with respect to international patent applications (PCT applications) that have been filed at the RO/US (the receiving office of the USPTO).

We thank you for your consideration and cooperation.

Respectfully,

Leonard Agneta, Patent Alloy LLC

Andrew Berks, Ostrolenk Faber LLP

Robert A, Blaha, Smith Tempel Blaha LLC

Matthew J. Booth

David Boundy

Michael J. Brown, Michael J Brown Law Office LLC

J. Michael Buchanan, Cantor Colburn LLP

Brian Cronquist, VP Technology & IP, MonolithIC 3D Inc.

Michael Eddy

Gerry J. Elman

William Eshelman, Law Office of William Eshelman

Daniel Feigelson

Antoinette G Giugliano PC

John M. Hammond

Steven Hertzberg

Jeff Kapteyn

Karen King

Ashok Krishnan

Nenad M. Markovic

Rick Neifeld

Carl Oppedahl, Oppedahl Patent Law Firm LLC

Karen Dana Oster

Miriam Paton, Integral Intellectual Property Inc.

C. Dale Quisenberry

Scott Sample, Culhane Meadows Haughian & Walsh PLLC

Richard A. Schafer, Schafer IP Law

Brian Siritzky, PhD

Charles R. Szmanda, Ph.D.

Alan Taboada, Moser Taboada

Korbin Van Dyke, Van Dyke Consulting

Jeffrey L Wendt