

selection, OAS will proceed with the selection process as follows. When the OAS receives the preferred selection from one party, it will notify the other party that it has fourteen (14) days in which to submit its selections. If that party fails to respond within the deadline, the first party's choice will be honored unless prohibited by the collective bargaining agreement. Where both parties respond, the name that has the lowest combined number will be appointed. If, within fourteen (14) days, a second panel is requested, and is permitted by the collective bargaining agreement, the requesting party must pay a fee for the second panel.

(e) The OAS will make a direct appointment of an arbitrator only upon joint request or as provided by paragraphs (c)(3) or (d) of this section.

(f) A direct appointment in no way signifies a determination of arbitrability or a ruling that an agreement to arbitrate exists. The resolution of disputes over these issues rests solely with the parties.

6. Amend the Appendix to 29 CFR Part 1404 by removing "\$100" and adding "\$150" in its place.

**Michael J. Bartlett,**

*Deputy General Counsel.*

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## DEPARTMENT OF COMMERCE

### Patent and Trademark Office

#### 37 CFR Parts 1, 2, and 3

[Docket No. PTO-P-2008-0022]

RIN 0651-AC27

#### Changes to Practice for Documents Submitted to the United States Patent and Trademark Office

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Notice of proposed rulemaking.

**SUMMARY:** The United States Patent and Trademark Office (Office) is proposing to revise the rules of practice to limit the types of correspondence that may be submitted to the Office by facsimile. The Office is also proposing an increased minimum font size for use on papers submitted to the Office for a patent application, patent or reexamination proceeding. The proposed changes will improve the legibility of documents in the Office's files of patent applications and reexamination proceedings.

**DATES:** Written comments must be received on or before October 6, 2008. No public hearing will be held.

**ADDRESSES:** Comments should be sent by electronic mail over the Internet addressed to [AC27.comments@uspto.gov](mailto:AC27.comments@uspto.gov). Comments may also be submitted by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Raul Tamayo, Legal Advisor, Office of Patent Legal Administration (OPLA). Although comments may be submitted by mail, the Office prefers to receive comments via the Internet.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal.

The comments will be available for public inspection at the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, currently located at Room 7D74 of Madison West, 600 Dulany Street, Alexandria, Virginia and will also be available through anonymous file transfer protocol (ftp) via the Internet (address: <http://www.uspto.gov>). Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or a telephone number, should not be included in the comments.

#### FOR FURTHER INFORMATION CONTACT:

Hiram H. Bernstein ((571) 272-7707), Senior Legal Advisor, or Raul Tamayo, Legal Advisor, ((571) 272-7728), Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy, directly by telephone, or by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of the Office of Patent Legal Administration.

For information regarding reexamination issues, contact Stephen Marcus ((571) 272-7743) or Kenneth Schor ((571) 272-7710), Senior Legal Advisors, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy.

**SUPPLEMENTARY INFORMATION:** The Office is proposing to revise the rules of practice in title 37 of the Code of Federal Regulations (CFR) for facsimile transmissions of correspondence, and the minimum font size required to be used. The Office is specifically proposing revising §§ 1.6, 1.52, 1.366, 2.195, 3.24, and 3.25.

## I. Background

The number of patent applications and patent-related correspondence received by the Office has increased substantially over the last few years, and submissions are expected to continue to increase in the next few years. Processing paper is extremely labor-intensive and subject to error and misfiling, particularly as the Office must sort through several thousand pieces of patent correspondence that are received on a daily basis. Although the Office has made substantial changes in an attempt to accurately and efficiently process the increased number of correspondence received, the Office believes that it should make further changes in its business practices to improve its handling of patent correspondence.

## II. Facsimile Transmission

In 1988, the Office, due to widespread use of facsimile transmission and the resulting time saved in correspondence between applicants and the Office, established a trial program to accept facsimile transmission of certain correspondence. In light of the success of the trial program, a policy on acceptance of facsimile transmissions was incorporated into the rules of practice. See *Changes in Signature and Filing Requirements for Correspondence Files in the Patent and Trademark Office*, 58 FR 54494 (October 22, 1993). Facsimile transmission of correspondence has grown to over 240,000 pieces of patent correspondence per year sent to the Office's central facsimile number. While the number of facsimile transmissions in any one application may be small, the overall number of facsimile transmissions represents a significant processing burden on the Office.

The advantage of facsimile transmitting patent and assignment correspondence has been the quick submission of such correspondence to the particular area of the Office concerned with promptly acting on them. The advantage, however, is not exclusive to facsimile transmissions. EFS-Web offers this advantage as well as others not available with facsimile transmission. For example, EFS-Web submissions are "soft scanned" (*i.e.*, electronically uploaded) directly into the official application file, so multiple Office employees can simultaneously view the document(s). Furthermore, when documents are submitted via EFS-Web, the Office's electronic system sends an auto-generated message notifying the appropriate area which treats the type of documents submitted. Additionally, EFS-Web offers

applicants the opportunity to review the content of their submissions after the "soft scanning" process is complete.

It should be recognized that correspondence received by the Office via facsimile are often of low image quality when printed and viewed. The low image quality is not so much dependent upon the type of printer used by the Office when receiving and printing the transmitted correspondence, but rather is dependent upon the quality of the machine used by an applicant in generating the facsimile transmission. When the Office scans these low image quality correspondence into the Office's official application file called the Image File Wrapper (IFW), the image quality can be further compromised.

In addition to low image quality, a number of other adverse consequences, from the Office's perspective, exist when applicant submits patent and assignment documents via facsimile. For example, a number of applicants are not meticulous in determining the specific facsimile transmission number to which a correspondence should be sent. Under the current rules, receipt by the Office via any facsimile transmission number may suffice to represent a completed, effective transmission. However, the area of the Office needing to act on the errant transmission would not be aware of its receipt, and the area receiving it may not immediately recognize what type of correspondence has been received, or where the correspondence should be forwarded for prompt action. Such circumstances cause unnecessary delays and add unnecessary costs to the processing of errant correspondence. In some instances, routing errant correspondence to the correct area of the Office is not possible or is not done in a timely manner (e.g., the paper copy becomes misplaced before the proper forwarding area can be determined, or the proper forwarding area is not readily identifiable by the receiving area), thereby forcing the applicant to rely on a transmission receipt via a petition alleging that the correspondence was timely submitted. Additionally, even where the facsimile transmission is sent to the designated transmission number, the Office must print the transmitted correspondence, process the paper, scan the possibly low-quality image, and update the IFW. All of these steps are additionally time-consuming and costly.

Accordingly, the Office believes that given: (1) The costs and quality concerns regarding facsimile transmitted correspondence; and (2) the newly upgraded EFS-Web electronic filing system, which offers the same

benefit of quick submission to the particular area of the Office that needs to act on the correspondence, it is now appropriate to terminate the use of facsimile transmissions as a method for filing most correspondence intended to become part of the file record of a patent application, patent or reexamination proceeding. Specifically, correspondence that can be submitted via EFS-Web would no longer be accepted via facsimile transmission. For example, a petition to withdraw a patent application from issue per 37 CFR 1.313 would no longer be accepted via facsimile transmission and would need to be submitted via EFS-Web.

Similarly, it is also appropriate to eliminate facsimile transmission of other types of correspondence that can be submitted via certain other electronic systems of the Office. Specifically, any type of patent or trademark correspondence that can be submitted via the Office's Electronic Patent Assignment System (EPAS) (discussed in Manual of Patent Examining Procedure (MPEP) § 302.10), and Electronic Trademark Assignment System (ETAS) (discussed in Trademark Manual of Examination Procedure (TMEP) § 503.03(a)), such as assignment documents submitted for recording in Assignment Services Division, would no longer be permitted to be submitted via facsimile transmission. While such documents are intended to become part of the official assignment records, they are not intended to become part of the official patent or trademark file to which they relate.

Additional aspects of the proposed rule making would require applicants, third party requesters, and patent owners: (1) To utilize a facsimile transmission number identified by the Office for a particular type of correspondence, *i.e.*, the submission must be transmitted directly to the area of the Office appropriate to receive the transmission at its identified transmission number (as opposed to transmission to any other facsimile transmission number, such as a facsimile transmission number identified for a different type of correspondence), or otherwise the transmission would not be effective (see § 1.6(d)(3)); and (2) to limit each submission made via facsimile transmission to one application or other matter before the Office, except for a single submission of multiple patent maintenance fee payments or requests for refunds thereof. The submission for a single application or other matter may address more than one issue with more than one piece or type of correspondence in regard to the single

application or matter if each correspondence can be properly submitted via facsimile.

While this Notice proposes to restrict facsimile transmissions of correspondence directed to the Office, nothing in the proposed rule making is intended to curtail the ability of the Office to utilize facsimile transmissions for its outgoing correspondence as it deems appropriate, such as replies to certain inquiries from applicants.

### III. EFS-Web

The Office's Web-based electronic filing system (EFS-Web) went into full operation on March 17, 2006, and is supported by the LEGAL FRAMEWORK FOR EFS-WEB (<http://www.uspto.gov/efc/portal/efs/legal.htm>), which identifies what documents may be submitted via EFS-Web. The rules of practice were amended so that EFS-Web submissions would be treated analogously to submissions filed via First-Class Mail or facsimile transmissions with a certificate of mailing or transmission. See *Changes to Facilitate Electronic Filing of Patent Correspondence*, 72 FR 2770 (January 23, 2007); 1315 *Off. Gaz. Pat. Office* 57 (February 13, 2007) (final rule). EFS-Web is easy to use as correspondence can be submitted to the Office at the click of a button, and EFS-Web is available twenty-four hours a day, seven days a week. An increasing amount of patent-related correspondence has been filed via EFS-Web. In particular, the percentage of utility, plant, reissue, national stage applications, and requests for continued examination (RCE) filed via EFS-Web has dramatically increased from approximately 28% in the first week in October 2006 to approximately 70% in the second week in January 2008.

As discussed above in item II, "Facsimile transmission," increased use of EFS-Web would increase efficiency and improve the quality of the images in the IFW used for prosecution and publication purposes. Additionally, system delays caused by paper processing and scanning would be much reduced.

With EFS-Web being available for the submission of patent correspondence twenty-four hours a day, seven days a week, patent applicants, owners, and third party requesters in reexamination proceedings (both *ex parte* and *inter partes*) are provided easy and convenient access to a system for submitting their patent correspondence. Shortly after patent correspondence is officially submitted to the Office via EFS-Web, the Office receives the correspondence and issues an

acknowledgment receipt. The acknowledgment receipt contains the "receipt date," the time the correspondence was received at the Office (not the local time at the submitter's location), and a full listing of the correspondence received. Accordingly, an acknowledgment receipt is the legal equivalent of a post card receipt described in MPEP § 503, with the added convenience of being automatically generated. In contrast, a return receipt for correspondence transmitted to the Office's central facsimile number is only automatically generated when (1) the sender's facsimile number is properly programmed in the sending facsimile machine and (2) the sender's facsimile machine is capable of receiving a return facsimile transmission immediately following receipt of the original transmission.

For the filing of patent applications, the official filing date will continue to be stated on the filing receipt under § 1.54(b), which is sent to applicants after the submitted application parts are reviewed for compliance with the filing date requirements. Under § 1.6(a)(4), patent correspondence filed via EFS-Web is considered to have been filed on the date the Office receives the submission (regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia). Thus, by using EFS-Web, applicants and other EFS-Web users (e.g., practitioners) can, in a short period of time, ensure that they have received a "date certain" for any submission made via EFS-Web.

Correspondence submitted by facsimile transmission is received in paper form and is considered paper correspondence (although it has an electronic transmission component), while EFS-Web transmissions are electronic transmissions that remain in electronic form after receipt. Critical data concerning patent correspondence submitted via EFS-Web is entered into the automated systems much sooner than if the correspondence was received in paper in that the electronic document of an EFS-Web submission is directly available in the IFW system (by "soft scanning"), while the printed paper for a facsimile submission requires manual handling and scanning of the paper in order to make such documents available in the IFW system.

Continued increases in the amount of patent correspondence encourage the Office to change its business approach for serving its users. With EFS-Web, users are provided with better quality, as well as improved accuracy of the information submitted to and processed

by the Office, while using fewer resources, thus reducing the time required for processing and handling. Users have greater assurance that the content of the IFW is accurate. Submitting correspondence via EFS-Web provides a level of consistency, accuracy, quality and predictability that a paper-based facsimile transmission cannot provide. EFS-Web users have repeatedly stated that they are satisfied with the ease of access and use of EFS-Web, and appreciate the automatic generation of the acknowledgment receipt after they officially submit their correspondence to the Office. Accordingly, the need for the submission of patent correspondence to a central facsimile number or a facsimile number for a particular type of correspondence is greatly reduced.

The Legal Framework for EFS-Web permits submission of all types of correspondence that are not specifically excepted. See Item XXXIII. Documents Policy, in the legal framework document at <http://www.uspto.gov/ebc/portal/efs/legal.htm>. The following is a non-exclusive list of correspondence types that are identified in the legal framework document as currently not permitted:

1. Correspondence concerning Registration to Practice submitted under § 1.4(e).
2. Certified copies submitted under § 1.4(f).
3. Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter.
4. Submissions in contested cases before the Board of Patent Appeals and Interferences, except as the Board may expressly authorize.
5. Papers filed in contested cases before the Board of Patent Appeals and Interferences, which are governed by § 41.106(f).
6. Correspondence filed in connection with a disciplinary proceeding pursuant to 37 CFR part 10.
7. Submissions that are not associated with an application or a reexamination proceeding.
8. Third party papers under § 1.99.
9. Protests under § 1.291.
10. Public use hearing papers under § 1.292.
11. Maintenance fees submitted under § 1.366.

Although a main purpose of the proposed changes to the facsimile transmission rules is to prohibit submission by facsimile transmission of those types of correspondence that can be submitted via EFS-Web, the Office is proposing to also terminate the ability of third parties to submit correspondence

via facsimile transmission that cannot be submitted via EFS-Web, as third party submissions under § 1.99, protests under § 1.291, and public use hearing papers under § 1.292 are all ill-suited for facsimile transmission.

Assignment documents submitted for recording under 35 U.S.C. 261 are also barred from submission via EFS-Web by item 7 (even though related to an application or a patent), but they may be electronically filed using the Electronic Patent Assignment System (EPAS) or the Electronic Trademark Assignment System (ETAS). Hence, there is no continued need to submit assignments for recording via facsimile transmission. Information regarding EPAS is available by sending an e-mail to [epas@uspto.gov](mailto:epas@uspto.gov). Information regarding ETAS is available by sending an e-mail to [etas@uspto.gov](mailto:etas@uspto.gov).

EFS-Web permits registered users to file both new submissions and follow-on documents. Some examples of papers that may be submitted via EFS-Web and therefore would no longer be able to be submitted by facsimile transmission are: (1) Amendments; (2) information disclosure statements; (3) petitions, including petitions to withdraw an application from issue, petitions for express abandonment to avoid publication, and maintenance fee related petitions; (4) requests for continued examination; (5) papers in *ex parte* or *inter partes* reexamination proceedings; (6) Design continued prosecution application (CPA) filings; (7) refund requests related to an application or a reexamination proceeding; (8) papers submitted to the U.S. Receiving Office; (9) papers submitted in regard to a pre-appeal or an appeal conference or an appeal to the Board of Patent Appeals and Interferences; and (10) status inquiries related to the issuance of the next Office action on the merits or the issuance of a decision on petition.

Correspondence submitted via EFS-Web should be intended to become part of the official file record. Generally, EFS-Web submissions are automatically made part of the official file record, except for pre-grant publication submissions (*i.e.*, amended republications, amended first publications, voluntary publications), which must be submitted via EFS-Web but are not made part of the official file record if submitted properly. Maintenance fee payments, refunds of such payments, and related papers would continue to be able to be submitted via facsimile transmission. See the preamble discussion in regard to § 1.6(d)(2)(i). Related papers would include a petition to transfer a maintenance fee payment from the

“wrong” patent where the fee had not previously been paid (and therefore payment could be applied thereto) to the right patent (where the maintenance fee had not already been paid). Where a maintenance fee has already been paid, payment of an additional maintenance fee will result in an automatic refund. Maintenance fee payers should consult <https://ramps.uspto.gov/eram/patentMaintFees.do>.

Types of reexamination proceeding correspondence that may be submitted via EFS-Web when the correspondence is intended to become part of the official file in a reexamination proceeding are: (1) An original request for *ex parte* or *inter partes* reexamination; (2) any corrected request for *ex parte* or *inter partes* reexamination submitted in response to either a Notice of Failure to Comply with Reexamination Request Filing Requirements or a Decision vacating the filing date that was accorded to a previously-submitted request for reexamination; (3) all follow-on prosecution papers (including appeal papers) filed by either the patent owner or a third party requester in any reexamination proceeding (including papers that are submitted together with a petition to expunge the papers from the record); (4) notices of prior or concurrent proceedings and decisions pursuant to MPEP sections 2282 and 2686; and (5) petition papers filed by the patent owner or third party requester that are directed to any reexamination proceeding.

Types of application correspondence not intended to become part of the official file record and currently not permitted to be submitted via EFS-Web would be able to continue to be submitted via facsimile transmission, unless specifically excepted, until such time that the Legal Framework for EFS-Web is amended to permit such type of correspondence to be submitted via EFS-Web. Some examples of correspondence that are not intended to be part of the official application or patent file record and therefore are not permitted to be submitted via EFS-Web and would be able to continue to be submitted via facsimile transmission are:

(1) Proposed amendments for examiner review, such as in regard to an upcoming interview;

(2) an inquiry as to whether a 35 U.S.C. 371 national stage application, or a 35 U.S.C. 111(a) continuing application of a PCT application has been filed for a particular PCT application (which inquiry is obviously not intended to become part of an application file but only seeks to

ascertain whether an application has been filed); and

(3) orders for copies of application, patent, and reexamination files.

Any proposed amendment submitted by facsimile transmission would not be part of the official file record, but must be made part of the official file record, when such amendment is referred to in another correspondence (e.g., interview summary) that is part of the official file record (whether referred to by applicant or the examiner).

Correspondence directed to a reexamination proceeding that is not intended for entry into the record of the reexamination proceeding is considered to be an “unofficial paper,” and must not be submitted via EFS-Web. A patent owner or third party requester who desires to submit correspondence to be treated as an “unofficial paper” in an *ex parte* reexamination proceeding may expedite consideration of the correspondence by contacting the Central Reexamination Unit (CRU) ((571) 272-7705) for instructions on how to submit the “unofficial paper” via transmission to a facsimile machine designated for such purpose in the CRU.

Examples of an “unofficial paper” that a party to an *ex parte* reexamination proceeding may submit via facsimile transmission are: (1) A courtesy paper identifying issues to be discussed that is submitted prior to a permitted interview with the examiner; (2) a paper submitted for review by Office personnel (in rare instances where such is permitted, and the Office has been contacted for permission to submit the paper for review) to determine the formal sufficiency of the paper; and (3) a paper submitted to obtain examiner review of a proposed amendment intended to overcome an examiner rejection. Any such proposed amendment that is submitted unofficially, and as such is not part of the official file record, must be made part of the official file record, when such proposed amendment is referred to in a paper that is part of the official file record (whether referred to by a party to the reexamination proceeding or by the examiner or other Office official). Where there are two parties to the *ex parte* reexamination proceeding, an “unofficial paper” submitted to the Office by one party need not be served on the other party to the reexamination proceeding, since such a paper is not considered to have been “filed” in the reexamination proceeding within the meaning of the rules (e.g., §§ 1.510(a), 1.550(f), 1.903 or 1.913) because an “unofficial paper” is a paper not intended to become part of the official record.

It is to be noted that an “unofficial paper” (i.e., an *ex parte* communication) directed to an *inter partes* reexamination is strictly prohibited. Interviews are not permitted in *inter partes* reexamination, and the submission of a proposed amendment would constitute an impermissible interview. It is also noted that no correspondence is to be submitted directly to any examiner in *inter partes* reexamination irrespective of the delivery method.

The Office will presume that application correspondence submitted via EFS-Web is intended to be an “official paper” whereas correspondence that could be submitted via EFS-Web but is instead submitted via facsimile transmission will be presumed an “unofficial paper” (i.e., a paper not to be made part of the official file record). For example, an amendment to the application proposed by applicant and facsimile transmitted to an examiner for discussion during a scheduled interview would be considered an “unofficial paper.” Conversely, for an amendment submitted by EFS-Web, the Office will presume that the amendment should be part of the application file record, and the amendment will automatically become part of the application file record.

A status inquiry regarding the issuance of an Office action on the merits, unlike an inquiry regarding the presence of a PCT filing (above), will be made part of the file record. See MPEP § 203.08. Accordingly, use of facsimile transmission would not be permitted for status inquiries regarding the issuance of Office actions. Rather, a status inquiry submitted via EFS-Web, which is directed to the Technology Center where the application is docketed and not to the examiner, would be appropriate.

In view of the linkage of what would be permitted as a facsimile transmission to what would not be permitted to be submitted via EFS-Web, applicants and other parties, prior to determining whether to submit documents via facsimile transmission, would need to review the current version of the Legal Framework for EFS-Web, <http://www.uspto.gov/ebs/portal/efs/legal.htm>, to determine what is permitted to be submitted via EFS-Web or some other Office electronic system and thus not permitted to be facsimile transmitted.

As it is noted in the Legal Framework for EFS-Web, except for the initial filing of an application, use of a public key infrastructure (PKI) certificate for follow-on submissions is required. See

Item X of the legal framework. The process for obtaining a PKI certificate requires the completion of some paperwork, though the Office believes that the process is not unduly burdensome. However, should an applicant not wish to obtain a PKI certificate, the types of correspondence that would no longer be allowed to be submitted to the Office by facsimile transmission would still be able to be submitted by hand-carry, U.S. Postal Service first class mail using a § 1.8 certificate of mailing, or the U.S. Postal Service "Express Mail Post Office to Addressee" service as set forth in § 1.10 along with the benefits and protections currently contained therein.

The Legal Framework for EFS-WEB does not permit a simple text file larger than 25 megabytes. See Item XV of the legal framework. However, a text file of more than 25 megabytes may be broken up into multiple text files that can be submitted together. There is a limitation of 60 files that can be submitted in one submission. Where there are more than 60 files to be submitted, additional submissions may be made on the same day. See Item XVI of the legal framework. These types of very large submissions would probably not be appropriate for a facsimile transmission due to the quantity of sheets that must be handled at both the transmitting and receiving machines.

Similarly, where filing sequence listings, tables related to sequence listings, or both are submitted for international applications in the U.S. Receiving Office, the applicant may partition an oversized file into multiple files, each of which is smaller or equal to 25 megabytes. See Item XIX. C. of the legal framework.

Electronic forms of transmission, such as EFS-Web, EPAS, ETAS, and facsimile transmission have historically been subject to disturbances in service ("down time") from time to time. However, providing notice as to down time is far faster in the EFS-Web environment than with an isolated and infrequently attended facsimile machine. The Office is continuing to address the need for fast notification of any disruption in the EFS-Web system. (See Item XXVIII. of the Legal Framework for EFS-WEB.)

Applicants and other users are reminded to always check the availability of EFS-Web at the time a transmission is to be attempted. If EFS-Web is unavailable, recourse is to use first class mail with a certificate of mailing pursuant to § 1.8, or Express Mail pursuant to § 1.10, depending on the type of correspondence being submitted and based on the actual

receipt date desired. The unavailability of EFS-Web (e.g., due to an EFS-Web system failure, or an interruption in a user's internet service provider) will not permit use of facsimile transmission based on an argument that the correspondence was not permitted to be submitted via EFS-Web.

#### IV. Font Size

The Office needs to receive application specifications and other papers that are legible and can be easily read by examiners and other Office personnel. In addition, the public will benefit when applications that have been published or otherwise opened to public inspection are legible. A key attribute of legible text is an appropriate font size of the text. Previously, the Office was neither able to define the preferred font size as the mandatory minimum font size of text in view of limitations imposed by Patent Cooperation Treaty (PCT) obligations and implementing regulations, nor had the Office believed that mandatory rules would be needed in order that all correspondence received by the Office be readily legible. Some practitioners and applicants, however, have adopted a continuing practice of submitting documents that are not readily legible, e.g., entire specifications with a font size as small as 6 point.

Font size as small as 6 point does not have sufficient clarity to permit electronic capture by use of digital imaging and optical character recognition (OCR) in accordance with § 1.52(a)(1)(v). Accordingly, the results of the Office's electronic capture of the unusually small font by OCR are often unsatisfactory. The accuracy of OCR conversion is inversely proportional to the size of the text being electronically captured and it has been found that electronic capture by use of OCR of applications with smaller font sizes contain more errors, which must then be corrected, thus wasting time and resources on the part of both the Office and the applicant. The Office experiences significant difficulties when trying to publish applications and patents with specifications having unusually small text. Some applications are not even capable of being electronically captured by OCR as the text is too small. Errors in electronic capture may not be caught immediately and may delay issuance of a patent or, if not identified by the Office, represent problems with enforcement of any patent that should issue.

The practice of using an unusually small font size has expanded to other papers, such as remarks, amendments, and maintenance fee payments. When

requested to resubmit the paper with a larger font, some strong resistance has been encountered based on the lack of a regulatory requirement defining the minimum font needed by the Office to process and read the paper. The Office anticipates moving forward with a plan to OCR all amendments and remarks submitted by applicants. This plan would be adversely impacted by the continued submission of such papers with unusually small font size.

Some practitioners argue that the Office should be capable of adjusting the font size to produce any text size that it desires. The Office, however, cannot automatically resize the document. Attempts to change the parameters of the document received may introduce substantive errors in the document, particularly where tables, charts, formulas, and drawings are concerned.

In view of the significant problems facing the Office by applicants' use of unusually small font size, and the recent amendment of PCT regulations (effective April 1, 2007, PCT Rule 11.9(d) was revised from "all text matter shall be in characters the capital letters of which are not less than 0.21 cm high" to "all text matter shall be in characters the capital letters of which are not less than 0.28 cm high"), the Office needs to and can now eliminate such practice.

Accordingly, it is proposed to: (1) Increase the mandatory minimum font size where the font must have capital letters no smaller than 0.28 cm (0.11 inch) high (e.g., a font size of 12 point in Times New Roman); (2) establish that the newly proposed font size requirement applies to prosecution papers (specification, including the claims and abstract, drawings, and oath or declaration, reexamination request, any amendments or correction(s)) and any remarks, petitions, requests, affidavits or other papers submitted during prosecution of an application or a reexamination proceeding; (3) clarify that the proposed font size requirement does not apply to pre-printed information on paper forms provided by the Office or the copy of the patent submitted on paper in double column format as the specification in a reissue application or request for reexamination; and (4) clarify that papers submitted electronically that are to become part of the patent application or reexamination file must be readily legible.

#### Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Parts 1, 2, and 3, are proposed to be amended as follows:

Section 1.6(a)(1) is proposed to be amended to add a descriptive title, and to update the reference to facsimile transmissions to paragraph (d)(1) of § 1.6 from the current reference to § 1.6(a)(3).

Section 1.6(a)(2) is proposed to be amended to add a descriptive title.

Section 1.6(a)(3) is proposed to be amended to add a descriptive title, and to add a reference to paragraph (d)(1) of § 1.6 and the correspondence permitted by that section to be submitted via facsimile transmission.

Section 1.6(a)(4) is proposed to be amended to add a descriptive title.

Section 1.6(a)(5) is proposed to be newly added to set forth current practice that non-facsimile electronic transmission of patent-related correspondence other than correspondence filed via the Office's patent-related electronic systems (e.g., EFS-Web, and EPAS) may not be used for submission of correspondence to the Office intended to become part of the official file record (e.g., Image File Wrapper) for an application, patent, or reexamination proceeding, or other matter before the Office, except as expressly authorized by the Board of Patent Appeals and Interferences (BPAI) in cases before the BPAI, or applicant when consistent with the Office's express policy on internet usage. *See* Internet Usage Policy, 64 FR 33056 (June 21, 1999).

The prohibition includes e-mail, and additional forms of Internet-based transmission other than the Office patent electronic systems, i.e., EFS-Web, and EPAS. E-mail may continue to be used for inquiries, such as questions regarding patent practice and procedure directed to *PatentPractice@uspto.gov*. Communications by the Office via the Internet are governed by the published Internet Usage Policy. *See* MPEP § 502.03. As it is recognized that Internet e-mail communications are not secure, the Office will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122 without a written authorization by the applicant. Current internet (e-mail) policy covers both incoming correspondence to the Office from applicant and outgoing correspondence to applicant from the Office. A copy of the e-mail correspondence is required to be made of record in the file, even though such correspondence can only be directed towards communications other than those under 35 U.S.C. 132 or which otherwise require a signature.

Section 1.6(d) is proposed to be amended by deleting material duplicative of material in current § 1.6(a)(3), relating to the receipt date accorded facsimile transmissions. Additional material present in § 1.6(d) would be placed in amended paragraphs (d)(1)–(3), leaving § 1.6(d) with only the introductory title.

Additionally, § 1.6(d) and paragraphs (d)(1)–(9) are proposed to be amended to change facsimile transmission practice from the existing practice that facsimile transmission is generally accepted but for some limited exceptions set forth in current paragraphs (d)(1)–(9), to the proposed practice that facsimile transmission would generally not be accepted for most types of correspondence in view of the availability of EFS-Web for submission of most types of correspondence. Accordingly, new paragraphs (d)(1)(i)–(vi) would continue to prohibit the specific types of correspondence that are currently prohibited in current paragraphs (d)(1)–(6) (paragraphs (d)(7) and (8) are currently reserved and do not recite prohibitions). The prohibition set forth in proposed (d)(1)(iii) would not contain the exception in current § 1.6(d)(3) and thus would result in the prohibition of the facsimile transmission of continued prosecution applications. While the prohibition proposed in (d)(1)(vi) only prohibits facsimile transmissions of correspondence in secrecy order applications that are directly related to the secrecy order, § 1.6(d)(viii) would also prohibit facsimile transmission of correspondence that is not directly related to the secrecy order but can be submitted pursuant to § 1.6(a)(4) (EFS-Web).

Newly proposed § 1.6(d)(1)(vii) would prohibit facsimile transmission of correspondence for cases before the Board of Patent Appeals and Interferences (BPAI), except as the BPAI may expressly authorize. This would expand the current facsimile transmission prohibition now limited to contested cases before the BPAI of current § 1.6(d)(9).

Newly proposed § 1.6(d)(1)(viii) would prohibit facsimile transmission of the type of correspondence that could be submitted via EFS-Web, as would be set forth in the Legal Framework for EFS-WEB. This would include most types of patent correspondence for applications (including reissue and provisional applications), patents (including Certificates of Correction pursuant to §§ 1.322 and 1.323, and inventorship correction pursuant to § 1.324), and reexamination proceedings (both *ex parte* and *inter partes*).

Newly proposed paragraph (d)(1)(ix) would prohibit facsimile transmission of the type of correspondence permitted to be submitted via the Office's patent-related electronic system for assignments to be recorded, EPAS.

Newly proposed paragraphs (d)(1)(x)–(xii) would prohibit the facsimile transmission of third party papers under § 1.99, protests under § 1.291, and public use hearing papers under § 1.292 even though such papers may not currently be submitted via EPS-Web. The exclusions of third party papers and protests from EPS-Web submission, even though these papers are intended to become part of the Official file, was based on the need to use a PKI certificate for follow-on submissions, which a third party filing a paper under §§ 1.99 or 1.291 would not generally either have access to or would be given access to by the applicant. The Office is committed to working on a solution that would permit the filing of such papers via EPS-Web. As such papers can be massive or frequently have detailed drawings, it would not be in the interest of the parties submitting such papers to continue to use facsimile transmission.

Section 1.6(d)(2) would be directed at setting forth the requirements for facsimile transmission for the types of correspondence not prohibited in § 1.6(d)(1).

Section 1.6(d)(2)(i) would make mandatory that a facsimile transmission be limited to a single application or other matters before the Office (e.g., patents and reexamination proceedings), except for the payment of maintenance fees pursuant to § 1.366 and requests for refunds thereof. For example, while an applicant may need to submit the same type of document for more than one application file, such as proposed amendments to claims in related applications that are to be discussed in the same upcoming interview, the proposed amendments for each application must be separately transmitted. The payment of maintenance fees in multiple patents would be exempt from this proposed requirement. Maintenance fee payments would continue to qualify for facsimile transmission as they may not be submitted via EPS-Web.

Where a small entity assertion pursuant to § 1.27 is required to support payment of a small entity maintenance fee or a request for a maintenance fee refund, the payment or request for refund with the accompanying small entity assertion may be facsimile transmitted. Similarly, where, for example, the assignee is separately submitting a small entity assertion to support payment of a maintenance fee,

and an annuity company is the party making the small entity payment, the assignee may facsimile transmit the § 1.27 small entity assertion. It should be noted, however, that small entity assertions can be submitted via EPS-Web and the Office recommends that EPS-Web be used to ensure that the assertion becomes part of the patent file. For small entity fees other than maintenance fees, such as an issue fee in an application, which can be submitted via EPS-Web (as well as the small entity assertion), the fee and the supporting small entity assertion cannot be facsimile transmitted. It is only in situations where the fee payment, *i.e.*, a maintenance fee payment, cannot be submitted via EPS-Web, that the small entity assertion for the payment (which would not otherwise be permitted to be facsimile transmitted) can also be facsimile transmitted. The facsimile transmission must be made to a facsimile number identified by the Office as appropriate for maintenance fee payments and refunds thereof.

Section 1.6(d)(2)(ii) would set forth requirements set forth in current § 1.6(d) for identifying the application or matter before the Office for which the transmitted correspondence is intended. Section 1.6(d)(2)(ii) continues to advise the use of sufficient information to identify the application or matter before the Office for which the correspondence is intended as part of the sender's identification on the required cover sheet. The inability to be able to readily ascertain the appropriate application or other matter for the transmission may result in: A delay in acting on the paper, or discarding of the paper without notice to the sender if the Office cannot reasonably determine to which application or other matter the paper is directed.

Section 1.6(d)(2)(iii) would require that permitted facsimile transmissions must be sent to the specific facsimile transmission number identified by the Office for that type of correspondence. In the case of reexamination proceedings, contacting the CRU for the transmission number would be required. For applications, the Office would provide a Web page that would contain the usable transmission numbers and identification of types of correspondence that can be facsimile transmitted, as well as a link to EPS-Web for the submission of types of correspondence that cannot be facsimile transmitted but can be transmitted via EPS-Web. Therefore, the central facsimile number would no longer be usable since the rules as proposed to be amended would require that the transmission for any remaining use

must be sent directly to the area of the Office needing to receive the transmission at its identified transmission number. Office forms for which facsimile transmission would no longer be appropriate, such as the express abandonment forms PTO/SB/24, PTO/SB/24a, and the PTO/SB/24b, and the issue fee payment form PTOL-85, Part B, would have the facsimile transmission information removed.

Section 1.6(d)(2)(iv) would require that each unofficial correspondence transmitted by facsimile include a conspicuous marking that identifies it as an "unofficial paper" (correspondence that could be submitted via EPS-Web but is instead submitted via facsimile transmission). Unofficial papers, regardless of whether they are properly marked as such, will not be entered into the record of the application or reexamination proceeding unless expressly permitted by rule or Office policy. Further, any of these unofficial papers submitted via facsimile without the required conspicuous marking may be *discarded without consideration of the paper and without notification to the sender that the paper has been discarded without consideration*. This requirement for conspicuous marking of facsimile transmitted papers and the discarding of unmarked or mis-marked papers would act to discourage applicants, patent owners, and third party requesters from attempting to file official papers via facsimile, instead of via EPS-Web.

Section 1.6(d)(3) would set forth the consequences resulting from: (1) Transmitting correspondence to a number other than the specific facsimile transmission number identified by the Office for that type of correspondence; (2) facsimile transmission of correspondence not permitted to be submitted by facsimile transmission; or (3) facsimile transmission of an "unofficial paper" without the conspicuous marking required in (d)(2)(iv). The consequences would be equally applicable to any copy of such correspondence created by the Office (*e.g.*, paper copies made directly from the facsimile transmission or copies made from scanning the paper copy of the transmission). The consequences would be that such correspondence: (1) Would not be given a receipt date; (2) would not operate to be an effective paper (*e.g.*, will not be considered a reply to the Office action, or a request for action by the Office); and (3) could be discarded by the Office without notification to the sender. When the Office discards submitted material it is without notification to the submitter, unless such notification is specifically

provided for by rule or Office policy. The specific provision in the rule of lack of notification to the sender would be added merely to reinforce the concept of lack of notification.

For example, an otherwise timely reply submitted by facsimile transmission to an outstanding first Office action would not be effective to toll the time period for reply as this type of correspondence would no longer (after implementation of the rule revision) be permitted to be submitted by facsimile transmission. Additionally, applicant could not simply later affirm the prior submission of the reply within the period for reply and rely on the previously submitted facsimile transmission of the reply. A new reply would need to be timely submitted to avoid abandonment.

Current § 1.6(f), relating to a petition remedy where the facsimile transmission of a continued prosecution application (CPA) was not received by the Office, would be canceled and reserved.

Section 1.52(a) is proposed to be amended to remove the italics. Sections 1.52(a), (a)(1) and (a)(2) are proposed to be amended to remove "United States Patent and Trademark" for conformity with the use of "Office" in the remaining sections of § 1.52.

Section 1.52(a)(5) is proposed to be amended to contain only a descriptive title.

Section 1.52(a)(5)(i) would contain the language of current 1.52(a)(5).

Sections 1.52(a)(5)(ii) would be an added paragraph intended to clarify that submissions must be presented in a form that is readily legible to the Office after receipt thereof by the Office.

Section 1.52(b) would be amended to address a problem involving the font size used for specifications and prosecution papers.

Section 1.52(b) is proposed to be amended by removing the italics and simplifying the recitation of the papers that are subject to the rule. Sections 1.52(b)(1) and (b)(2) would be expanded to cover application and reexamination papers other than just the specification and amendments or corrections. These sections would be applicable to cover sheets, remarks, petitions, requests, affidavits, or other papers submitted in support of prosecution of the application or the reexamination proceeding. These sections would also be applicable to IDS listings and any other IDS requirements such as a concise explanation or a translation of a non-English language document (but not the actual non-English language document). "Amendment" covers all types of amendments, including

amendments to the claims, specification and the drawings. "Amendment" covers amendments made at any time during prosecution of the patent application or reexamination proceeding (e.g., amendments under §§ 1.111, 1.115, 1.116, 1.312, 1.530, 1.941, etc.).

Section 1.52(b)(2)(ii) is proposed to be amended to correspond to the amendment of PCT Rule 11.9(d) by requiring a text lettering style having capital letters, which capital letters must be no smaller than 0.28 cm. (0.11 inch) high (e.g., a font size of 12 point in Times New Roman). The requirement for a nonscript font lettering style means utilization of a commercially available nonscript font in its commercially available form. Altering the font from its commercially available form (e.g., by changing the look of the characters or the automatic spacing between the characters) may not be in compliance with the rule. Compliance with the proposed font size and style requirements should not impose much difficulty as the Office has suggested their use for a number of years. The recitation of font size in terms relative to a type font having capital letters of a minimum size permits the normal and expected deviation for non-capital letters and numbers that a commercially available font complying with the required font size would utilize. It should be noted that utilizing capital letters that meet the 0.28 cm. requirement and then reducing the font size of the non-capital letters and numbers would not present a text lettering style within the rule. Further, by altering the line height to fit more characters per page, one runs the risk of presenting correspondence that is unreadable by Office personnel or presents a problem for optical character recognition in the electronic capture operation, which would require re-submission of the correspondence in compliant form. Specialized usage of the type font in a word processing program, such as "2nd", super and subscripts, etc., must comply also with the minimum font size requirements. In other words, the normal font size produced by the program for these specialized characters when the program is set to comply with the capital letter requirement must be maintained. Additionally, applicants also need to be aware that as a word processing program may normally set a footnote numeral and the text of a footnote to be smaller than the required 0.28 cm. capital letter height to be used in the main text, applicants must adjust the font size of the footnote accordingly to meet the requirements of the rule.

*Forms:* Sections 1.52(a) and (b) do not apply to applicant's use of the Office's pre-printed forms (that may contain smaller font size). Section 1.52(a)(3), which is reproduced in the rules section to provide context, is not proposed to be changed. Office forms have been exempt and continue to be exempt from font size requirements as: (1) The information in lower font size is standardized information, such as required of the Office by statute under the Paperwork Reduction Act, form number, etc., but is not required information that applicant must supply; (2) it is common practice for agencies to place this standardized information in a smaller font size, and doing so keeps the forms from being too long and makes them more usable by the public; and (3) the Office does not need to process such information when an Office form is submitted. Commercial forms that are subject to § 1.52(b), e.g., an application data sheet pursuant to § 1.76, must comply with the font size requirement. An Office form that has been altered in any way is considered a commercial form and must comply with the requirements of § 1.52. Such form must also have its OMB approval removed. Therefore, an applicant desiring to use a compact form (e.g., cover or transmittal sheet) that meets the requirements of § 1.52 should consider using an Office form in its original, unaltered state. Office-generated fillable forms containing the font size built into the form by the Office would comply with font size requirements.

The strictness of the proposed rule and its application by the Office results from the Office's need to efficiently process, read, and publish the text. It is emphasized that should the Office encounter difficulty in reading or electronically capturing the font for any portion of text, a substitute paper will be required.

As the Office intends to strictly enforce the font size requirement, in a rare instance where applicant believes some variation should be permitted, a petition under § 1.183 would be required.

Section 1.366 is proposed to be amended to add paragraph (h) that would require maintenance fee payments, when submitted in paper, by mail or facsimile transmission (which would continue as such type of correspondence may not be submitted via EFS-Web), to comply with §§ 1.52(a) and (b). Failure to comply with the format requirements of § 1.52 would not jeopardize the date of payment but would require a new submission in a compliant format.

Section 2.195(d) is proposed to be amended to prohibit facsimile transmission of the type of correspondence that can be submitted via the Office's electronic trademark system for assignments to be recorded, ETAS.

Section 3.24(a) is proposed to be amended by inserting a reference in the title to EPAS as the electronic form of submission of patent assignment documents to be recorded.

Section 3.24(b) is proposed to be amended as a conforming amendment to § 1.6(d)(1)(ix), which would only permit patent-related assignments to be submitted via EPAS and no longer via facsimile transmission. Accordingly, the reference to facsimile transmissions in the title would be deleted. Material relating to return of recorded documents would be transferred to newly added paragraph (c).

Section 3.24(c) is proposed to be added to highlight current material related to the non-return of patent documents submitted for recording, so that original documents would not be submitted. The rule is also proposed to be amended to delete "recorded" to clarify that any document submitted for recording will not be returned whether or not it is recorded.

Section 3.25 is proposed to be amended by inserting a reference in the title to ETAS as the electronic form of submission of trademark assignment documents to be recorded.

Section 3.25(c) is proposed to be amended as a conforming amendment to § 2.195(d), which would only permit trademark-related assignments to be submitted via ETAS and on paper and no longer via facsimile transmission. Accordingly, the reference to facsimile transmissions in the title would be deleted. The phrasing of the rule is also proposed to be amended so that it is consistent with the analogous rule for patent assignment documents.

Material relating to return of recorded documents would be transferred to newly added paragraph (c)(3). Section 3.24(c)(3) is proposed to be added to highlight current material related to the non-return of trademark documents submitted for recording, so that original documents would not be submitted. The rule is also proposed to be amended to delete "recorded" to clarify that any document submitted for recording will not be returned whether or not it is recorded.

#### *Rule Making Considerations*

##### *A. Administrative Procedure Act*

This notice proposes changes to the rules of practice to limit the submission

of correspondence by facsimile transmission in patent prosecution matters, and assignments to be recorded. The notice also proposes changes to the rules of practice to increase the size of the minimum font used on papers submitted to the Office for patent applications, patents or reexamination proceedings. The changes being proposed in this notice do not change the substantive criteria of patentability and do not effectively foreclose the applicant's opportunity to make a case on the merits. Applicants, when no longer able to submit most types of patent prosecution or assignments to be recorded by facsimile transmission, may still rely on mail delivery in all instances and may almost always utilize an electronic system provided by the Office for filing submissions. Therefore, these rule changes involve interpretive rules, or rules of agency practice and procedure. *See Bachow Communs., Inc. v. FCC*, 237 F.3d 683, 690 (DC Cir. 2001) (rules governing an application process are "rules of agency organization, procedure, or practice" and exempt from the Administrative Procedure Act's notice and comment requirement); *see also Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995) ("It is extremely doubtful whether any of the rules formulated to govern patent or trademark practice are other than 'interpretive rules, general statements of policy, \* \* \* procedure, or practice.'") (quoting C.W. Ooms, *The United States Patent Office and the Administrative Procedure Act*, 38 Trademark Rep. 149, 153 (1948)). Accordingly, prior notice and opportunity for comment is not required pursuant to 5 U.S.C. 553(b)(A) (or any other law), and thirty-day advance publication is not required pursuant to 5 U.S.C. 553(d) (or any other law). Nevertheless, the Office is seeking public comment on changes contemplated to these rules of practice to obtain the benefit of such input prior to adopting changes to the rules of practice.

#### B. Regulatory Flexibility Analysis

As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) are required. *See* 5 U.S.C. 603. Nevertheless, for the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that the changes proposed in this notice will not have a significant economic impact on

a substantial number of small entities. *See* 5 U.S.C. 605(b).

The primary impact of the changes proposed in this notice are that: (1) Certain documents may no longer be submitted to the Office via facsimile transmission; and (2) certain documents submitted to the Office must have a minimum font size, namely a font that has capital letters no smaller than 0.28 cm (0.11 inch) high (*e.g.*, a font size of 12 point in Times New Roman). The elimination of the availability of facsimile transmission will not have a significant economic impact because these documents may be submitted to the Office via EFS-Web or via the USPS by first class mail. The requirement that documents submitted to the Office must have a minimum font size will not have a significant economic impact because the current rules of practice require that such documents be "[p]resented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition" (37 CFR 1.52(a)(1)(v)), and set forth that font size below the proposed minimum font size generally does not comply with this pre-existing requirement of the rules of practice. In addition, the overwhelming majority of the documents to which this provision applies are created using word processors, and it will not have a significant economic impact to change the font size on a word processor. Therefore, the changes proposed in this notice will not have a significant economic impact on a substantial number of small entities.

#### C. Executive Order 13132 (Federalism)

This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

#### D. Executive Order 12866 (Regulatory Planning and Review)

This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993), as amended by Executive Order 13258 (Feb. 26, 2002) and Executive Order 13422 (Jan. 18, 2007).

#### E. Executive Order 13175 (Tribal Consultation)

This rule making will not: (1) Have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal

governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

#### F. Executive Order 13211 (Energy Effects)

This rule making is not a significant energy action under Executive Order 13211 because this rule making is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

#### G. Executive Order 12988 (Civil Justice Reform)

This rule making meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

#### H. Executive Order 13045 (Protection of Children)

This rule making is not an economically significant rule and does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

#### I. Executive Order 12630 (Taking of Private Property)

This rule making will not effect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

#### J. Congressional Review Act

Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq.*), prior to issuing any final rule the United States Patent and Trademark Office will submit a report containing the final rule and other required information to the U.S. Senate, the U.S. House of Representatives and the Comptroller General of the Government Accountability Office. The changes proposed in this notice are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this rule making is not likely to result in a "major rule" as defined in 5 U.S.C. 804(2).

#### K. Unfunded Mandates Reform Act of 1995

The changes proposed in this notice do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. *See* 2 U.S.C. 1501 *et seq.*

#### L. National Environmental Policy Act

This rule making will not have any effect on the quality of environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. *See* 42 U.S.C. 4321 *et seq.*

#### M. National Technology Transfer and Advancement Act

The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are inapplicable because this rule making does not contain provisions which involve the use of technical standards.

#### N. Paperwork Reduction Act

This notice involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this notice have been reviewed and previously approved by OMB under OMB control numbers: 0651-0031, 0651-0032, and 0651-0059. The United States Patent and Trademark Office is not resubmitting the other information collections listed above to OMB for its review and approval because the changes proposed in this notice do not affect the information collection requirements associated with the information collections under these OMB control numbers. The principal changes proposed in this notice are to provide that: (1) Certain documents may no longer be submitted to the Office via facsimile transmission; and (2) certain documents submitted to the Office must have a minimum font size, namely a font that has capital letters no smaller than 0.28 cm (0.11 inch) high (e.g., a font size of 12 point in Times New Roman).

Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to: (1) The Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10202, 725 17th Street, NW., Washington, DC 20503, Attention: Desk Officer for the Patent and Trademark Office; and (2) Robert A. Clarke, Director, Office of Patent Legal Administration, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

#### List of Subjects

##### 37 CFR Part 1

Administrative practice and procedure, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

##### 37 CFR Part 2

Administrative practice and procedure, Trademarks.

##### 37 CFR Part 3

Administrative practice and procedure, Patents, Trademarks.

For the reasons set forth in the preamble, 37 CFR parts 1, 2, and 3 are proposed to be amended as follows:

#### PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 continues to read as follows:

**Authority:** 35 U.S.C. 2(b)(2).

2. Section 1.6 is amended by removing and reserving paragraph (f) and revising paragraphs (a) and (d) to read as follows:

##### § 1.6 Receipt of correspondence.

(a) *Date of receipt and Express Mail date of deposit.* Correspondence received in the United States Patent and

Trademark Office is stamped with the date of receipt except as follows:

(1) *Open for receipt of correspondence.* The United States Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (d)(1) of this section, or filed electronically under (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) *“Express Mail” stamp date.* Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as “Express Mail” with the United States Postal Service.

(3) *Receipt date of facsimile transmission.* Correspondence permitted by paragraph (d)(1) of this section to be filed by facsimile transmission to the United States Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the United States Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

(4) *Office electronic filing system (EFS-Web).* Correspondence may be submitted using the Office electronic filing system only in accordance with the Office's electronic filing system requirements. Correspondence submitted to the Office by way of the Office's electronic filing system will be accorded a receipt date, which is the date the correspondence is received at the correspondence address for the Office set forth in § 1.1 when it was officially submitted.

(5) *Non-facsimile electronic transmission of patent-related correspondence other than correspondence filed via the Office's patent-related electronic systems (e.g., EFS-Web, and Electronic Patent Assignment System (EPAS)).* Non-facsimile electronic transmission of patent-related correspondence other than correspondence filed via the Office's patent-related electronic systems may not be used for submission of correspondence to the Office intended to become part of the official file record for an application, patent, reexamination proceeding, or other matter before the Office, except as expressly authorized by:

(i) The Board of Patent Appeal and Interferences in cases before the Board of Patent Appeals and Interferences, or

(ii) Applicant pursuant to the Office's express policy for internet usage.

\* \* \* \* \*

(d) *Facsimile transmission.* (1) Facsimile transmission of correspondence to the Office is not permitted for:

- (i) Correspondence as specified in § 1.4(e);
- (ii) Certified documents as specified in § 1.4(f);
- (iii) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in §§ 1.8(a)(2)(i)(A) through (D) and (F), and § 1.8(a)(2)(iii)(A);
- (iv) Color drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.173, or 1.437;
- (v) A request for reexamination under § 1.510 or 1.913;

(vi) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application;

(vii) Cases before the Board of Patent Appeals and Interferences, except as the Board may expressly authorize;

(viii) Correspondence permitted to be submitted pursuant to paragraph (a)(4) of this section;

(ix) Correspondence permitted to be submitted via the Office's patent-related electronic system for recording assignments (e.g., Electronic Patent Assignment System (EPAS));

(x) Third party papers under § 1.99;

(xi) Protests under § 1.291; and

(xii) Public use hearing papers under § 1.292.

(2) A facsimile transmission of correspondence when not prohibited pursuant to paragraph (d)(1) of this section must:

(i) Be limited to a single application or other matter before the Office, except for payments of maintenance fees pursuant to § 1.366 or requests for refunds thereof;

(ii) Include a facsimile cover sheet with the sender's identification, which should contain sufficient identifying information of the application or other matter to which the transmission is intended, such as:

(A) The application number of a patent application;

(B) The control number of a reexamination proceeding;

(C) The interference number of an interference proceeding; or

(D) The patent number of a patent;

(iii) Be transmitted to the specific facsimile transmission number

identified by the Office for that type of correspondence; and

(iv) Include a conspicuous marking on each correspondence intended to be unofficial that identifies such correspondence as an unofficial paper.

(3) Transmission to a facsimile number other than that identified by the Office for the type of correspondence transmitted, facsimile transmission of a type of correspondence that is not permitted to be facsimile transmitted, or facsimile transmission of correspondence without the conspicuous marking pursuant to paragraph (d)(2)(iv) of this section, and any copy of such correspondence created by the Office:

(i) Will not be given a receipt date;

(ii) Will not operate to be an effective paper; and

(iii) May be discarded by the Office without notification to the sender.

\* \* \* \* \*

3. Section 1.52 is amended by revising the introductory text of paragraph (a)(1), paragraphs (a)(2), (a)(3), (a)(5), the introductory text of paragraph (b), (b)(1), and (b)(2) to read as follows:

**§ 1.52 Language, paper, writing, margins, compact disc specifications.**

(a) *Papers that are to become a part of the permanent Office records in the file of a patent application or a reexamination proceeding.* (1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent Office records in the file of a patent application or reexamination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:

\* \* \* \* \*

(2) All papers that are submitted on paper or by facsimile transmission, and are to become a part of the permanent records of the Office should have no holes in the sheets as submitted.

(3) The provisions of this paragraph and paragraph (b) of this section do not apply to the pre-printed information on paper forms provided by the Office, or to the copy of the patent submitted on paper in double column format as the specification in a reissue application or request for reexamination.

\* \* \* \* \*

(5) All papers submitted electronically to the Office must be:

(i) Formatted and transmitted in compliance with the Office's electronic filing system requirements; and

(ii) Readily legible to the Office after receipt thereof.

(b) The application (specification, including the claims and abstract,

drawings, and oath or declaration) or a reexamination request, any amendments or correction(s) to an application or patent undergoing reexamination, and any remarks, petitions, requests, affidavits or other papers submitted during prosecution of an application or a reexamination proceeding:

(1) Except as provided for in § 1.69 and paragraph (d) of this section, must:

(i) Comply with the requirements of paragraph (a) of this section; and

(ii) Be in the English language or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate; and

(2) Except for the specifications of reissue applications (but not amendments thereto made by a separate paper pursuant to § 1.173(b)) and specifications for patents for which reexamination has been requested (but not amendments thereto pursuant to § 1.530) and as provided for in §§ 1.821 through 1.825, must have:

(i) Lines that are 1½ or double spaced;

(ii) Text written in a nonscript font (e.g., Arial, Times New Roman, or Courier) lettering style having capital letters which must be no smaller than 0.28 cm (0.11 inch) high (e.g., a font size of 12 point in Times New Roman); and

(iii) Only a single column of text.

\* \* \* \* \*

4. Section 1.366 is amended by adding paragraph (h) to read as follows:

**§ 1.366 Submission of maintenance fees.**

\* \* \* \* \*

(h) Paper submissions of maintenance fee-related payments must comply with § 1.52(a) and (b).

**PART 2—RULES OF PRACTICE IN TRADEMARK CASES**

5. The authority citation for 37 CFR part 2 continues to read as follows:

**Authority:** 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

6. Section 2.195 is amended by adding a new paragraph (d)(6) to read as follows:

**§ 2.195 Receipt of trademark correspondence.**

\* \* \* \* \*

(d) \* \* \*

(6) Correspondence permitted to be submitted via the Office's electronic system for recording assignments (e.g., Electronic Trademark Assignment System (ETAS)).

\* \* \* \* \*

**PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE**

7. Section 3.24 is revised to read as follows:

**§ 3.24 Requirements for documents and cover sheets relating to patents and patent applications.**

(a) *For electronic submissions (e.g., Electronic Patent Assignment System (EPAS))*: Either a copy of the original document or an extract of the original document may be submitted for recording. All documents must be submitted as digitized images in Tagged Image File Format (TIFF) or another form as prescribed by the Director. When printed to a paper size of either 21.6 by 27.9 cm (8½ inches by 11 inches) or 21.0 by 29.7 cm (DIN size A4), the document must be legible and a 2.5 cm (one inch) margin must be present on all sides.

(b) *For paper*: Either a copy of the original document or an extract of the original document must be submitted for recording. Only one side of each page may be used. The paper size must be either 21.6 by 27.9 cm (8½ inches by 11 inches) or 21.0 by 29.7 cm (DIN size A4), and in either case, a 2.5 cm (one inch) margin must be present on all sides. The paper used should be flexible, strong, white, non-shiny, and durable.

(c) *Non-return of submissions*: The Office will not return documents submitted for recording. Therefore, original documents must not be submitted for recording.

8. Section 3.25 is amended by revising paragraph (c) as follows:

**§ 3.25 Recording requirements for trademark applications and registrations.**

\* \* \* \* \*

(c) *All documents*. (1) *For electronic submissions (e.g., Electronic Trademark Assignment System (ETAS))*: All documents must be submitted as digitized images in Tagged Image File Format (TIFF) or another form as prescribed by the Director. When printed to a paper size of either 21.6 by 27.9 cm (8½ inches by 11 inches) or 21.0 by 29.7 cm (DIN size A4), the document must be legible and a 2.5 cm (one inch) margin must be present on all sides.

(2) *For paper*: Only one side of each page may be used. The paper size must be either 21.6 by 27.9 cm (8½ inches by 11 inches) or 21.0 by 29.7 cm (DIN size A4), and in either case, a 2.5 cm (one inch) margin must be present on all sides. The paper used should be flexible, strong, white, non-shiny, and durable.

(3) *Non-return of submissions*: The Office will not return documents submitted for recording. Therefore, original documents must not be submitted for recording.

Dated: July 31, 2008.

Jon W. Dudas,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

[FR Doc. E8-18025 Filed 8-5-08; 8:45 am]

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**ENVIRONMENTAL PROTECTION AGENCY****40 CFR Part 63**

[EPA-HQ-OAR-2003-0121; FRL-8701-8]

RIN 2060-AO07

**National Emission Standards for Organic Hazardous Air Pollutants From the Synthetic Organic Chemical Manufacturing Industry for Process Vents, Storage Vessels, Transfer Operations, and Wastewater; and National Emission Standards for Hazardous Air Pollutants: Miscellaneous Organic Chemical Manufacturing**

**AGENCY**: Environmental Protection Agency (EPA).

**ACTION**: Proposed rule; amendments.

**SUMMARY**: On November 10, 2003, EPA promulgated national emission standards for hazardous air pollutants (NESHAP) for miscellaneous organic chemical manufacturing. The rule is referred to as the miscellaneous organic NESHAP or the MON. The MON incorporates by reference the wastewater tank requirements in the National Emission Standards for Organic Hazardous Air Pollutants From the Synthetic Organic Chemical Manufacturing Industry for Process Vents, Storage Vessels, Transfer Operations, and Wastewater, which EPA promulgated on April 24, 1994, and which is referred to as the hazardous organic NESHAP or the HON. In this action EPA proposes to amend the HON, and thereby, the MON, by adding an equivalent means of emission limitation for wastewater tanks. This action also clarifies and corrects technical inconsistencies that have been discovered in the MON.

**DATES**: *Comments*. Comments must be received on or before September 22, 2008.

*Public Hearing*. If anyone contacts EPA requesting to speak at a public hearing by August 18, 2008, a public hearing will be held on August 21, 2008.

**ADDRESSES**: Submit your comments, identified by Docket ID No. EPA-HQ-OAR-2003-0121, by one of the following methods:

- *www.regulations.gov*. Follow the on-line instructions for submitting comments.

- *E-mail*: [a-and-r-Docket@epa.gov](mailto:a-and-r-Docket@epa.gov).

- *Fax*: (202) 566-9744.

- *Mail*: U.S. Postal Service, send comments to: Air and Radiation Docket and Information Center, EPA, Mailcode: 2822T, 1200 Pennsylvania Ave., NW., Washington, DC 20460. Please include a total of two copies.

- *Hand Delivery*: In person or by courier, deliver your comments to: Air and Radiation Docket, EPA, Room 3334, 1301 Constitution Avenue, NW. Washington, DC 20004. Please include a total of two copies. Such deliveries are only accepted during the Docket's normal hours of operation, and special arrangements should be made for deliveries of boxed information. We request that a separate copy of each public comment also be sent to the contact person listed below (see **FOR FURTHER INFORMATION CONTACT**).

*Instructions*: Direct your comments to Docket ID No. EPA-HQ-OAR-2003-0121. EPA's policy is that all comments received will be included in the public docket without change and may be made available online at [www.regulations.gov](http://www.regulations.gov), including any personal information provided, unless the comment includes information claimed to be confidential business information (CBI) or other information whose disclosure is restricted by statute. Do not submit information that you consider to be CBI or otherwise protected through [www.regulations.gov](http://www.regulations.gov) or e-mail. The [www.regulations.gov](http://www.regulations.gov) Web site is an "anonymous access" system, which means EPA will not know your identity or contact information unless you provide it in the body of your comment. If you send an e-mail comment directly to EPA without going through [www.regulations.gov](http://www.regulations.gov), your e-mail address will be automatically captured and included as part of the comment that is placed in the public docket and made available on the Internet. If you submit an electronic comment, EPA recommends that you include your name and other contact information in the body of your comment and with any disk or CD-ROM you submit. If EPA cannot read your comment due to technical difficulties and cannot contact you for clarification, EPA may not be able to consider your comment. Electronic files should avoid the use of special characters, any form of encryption, and be free of any defects or viruses. For additional information