

NEIFELD IP LAW PLLC
9112 Shearman Street
Fairfax, Virginia 22032-1479

Tel: 1-703-415-0012
Fax: 571-281-0045
Web: <http://www.Neifeld.com>
Email: general@Neifeld.com

December 14, 2021

Re: Notice of Proposed Rulemaking, “Date of Receipt of
Electronic Submissions of Patent Correspondence,”
PTO–P–2017–001, published at 86 FR 69195 (12/7/2021).

To: United States Patent and Trademark Office, Department of Commerce (hereinafter “PTO”)

Dear PTO:

I am a patent attorney in private practice. I have a great deal of experience in communicating with the USPTO, in prosecuting patent applications, and in representing parties in PTAB proceedings.

Pursuant to the announcement, I am submitting these comments to “<https://www.regulations.gov/commenton/PTO-P-2017-0011-0001>”. My comments follow.

My comments are in response to the Notice of Proposed Rulemaking, “Date of Receipt of Electronic Submissions of Patent Correspondence,” PTO–P–2017–001, published at 86 FR 69195 (12/7/2021) (herein after “Notice”).

The Summary of the Notice states:

The USPTO proposes to amend the patent rules of practice to provide that the receipt date of correspondence officially submitted electronically by way of the Office electronic filing system is the date in the Eastern time zone of the United States (Eastern Time) when the USPTO received the correspondence, rather than the date on which the correspondence is received at the correspondence address in Alexandria, Virginia. This is because the USPTO is expecting to provide physical servers for receiving electronic submissions in locations that are separate from the USPTO headquarters in Alexandria, Virginia. This proposed change will ensure consistency and predictability with respect to correspondence receipt dates as the date of receipt accorded to correspondence submitted electronically will not depend upon the location of USPTO servers. The USPTO is also proposing to amend the patent rules of practice to make other clarifying changes regarding the receipt of electronic submissions, including providing a definition for Eastern Time. These changes will harmonize the patent rules with the trademark rules and provide clarity regarding the date of receipt of electronic submissions.

The Notice proposes to amend 37 CFR 1.6(a)(4). The current rule 1.6(a)(4) reads,

emphasis added:

§ 1.6 Receipt of correspondence. (a) Date of receipt and Priority Mail Express® date of deposit. Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows: ... (4) Correspondence may be submitted using the Office electronic filing system only in accordance with the Office electronic filing system requirements. Correspondence submitted to the Office by way of the Office 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.

The proposed amended rule 1.6(a)(4) reads, emphasis added:

§ 1.6 Receipt of correspondence. (a) Date of receipt and Priority Mail Express® date of deposit. Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows: ... (4) Correspondence may be submitted using the Office electronic filing system only in accordance with the Office electronic filing system requirements. Correspondence officially submitted to the Office by way of the Office electronic filing system will be accorded a receipt date, which is *the date in Eastern Time when the correspondence is received in the Office*, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.

The “Supplementary Information” section of the Notice explains that:

Under current 37 CFR 1.6(a)(4), the receipt date of correspondence submitted to the USPTO by way of the Office electronic filing system is “the date the correspondence is received at the correspondence address for the USPTO set forth in 37 CFR 1.1 when it was officially submitted.” Current 37 CFR 1.1 sets forth an Alexandria, Virginia, correspondence address for the Office. The USPTO’s physical servers that receive electronic submissions are currently located in Alexandria, Virginia. However, in order to enhance resiliency, the USPTO is in the process of providing servers in Manassas, Virginia, and in the future may provide servers outside of the Eastern time zone. Once the USPTO begins receiving electronically submitted patent correspondence at locations other than Alexandria, Virginia, the language in current 37 CFR 1.6(a)(4) that defines the date the correspondence is received at Alexandria, Virginia, as the receipt date would be inapplicable. Thus, the USPTO is proposing to revise 37 CFR 1.6(a)(4) to specify that the *receipt date of correspondence that is officially submitted electronically by way of the Office electronic filing system is the date in Eastern Time when the USPTO received the correspondence*, regardless of the physical location of the USPTO server that receives the correspondence. Other clarifying changes regarding the receipt date of electronic submissions, including providing

a definition for Eastern Time, are also proposed.

In addition, the changes will align the patent rules with the Legal Framework for the Patent Electronic System, available at www.uspto.gov/patents/apply/filing-online/legal-framework-efs-web and in the Manual of Patent Examining Procedure (MPEP) section 502.05, subsection I. The Legal Framework already indicates that the time and date of receipt of an application filed via the Office electronic filing system is the local time and date (Eastern Time) at the USPTO headquarters in Alexandria, Virginia, *when the USPTO received the submission*. The date of receipt is recorded after the user clicks the “SUBMIT” button on the “Confirm and Submit” screen. This is the date shown on the Electronic Acknowledgement Receipt. *Similarly, follow-on documents filed in a patent application after the initial filing of the application are also accorded the date when the document is received at the USPTO as the date of receipt under existing practice. See MPEP section 502.05, subsection I.C.*

With respect to patent correspondence, any references to the Office electronic filing system in this Notice (including in 37 CFR part 1) include EFS-Web and Patent Center. Patent Center is a new tool for the electronic filing and management of patent applications. Patent Center is currently in the Beta phase but is available for all users. Once fully developed, Patent Center will replace EFS-Web and the Patent Application Information Retrieval (PAIR) system. Users of Patent Center Beta are required to abide by the Legal Framework for the Patent Electronic System to the extent applicable and are expected to abide by the Patent Electronic System Subscriber Agreement. See the Patent Center Beta Release Guidelines available at www.uspto.gov/patents/apply/patent-center. In the future, as Patent Center gets closer to full development, the Legal Framework for the Patent Electronic System will be revised to expressly refer to and more specifically cover electronic submissions via Patent Center.

The rules of practice in trademark cases already provide that filing dates of electronic submissions are based on Eastern Time. See 37 CFR 2.195(a). Therefore, it is unnecessary to amend the trademark rules of practice.

MPEP section 502.05, subsection I.C., first paragraph, reads as follows.

C. Electronic Acknowledgement Receipt and Date of Receipt

The Electronic Acknowledgement Receipt *establishes the date of receipt* by the USPTO of documents submitted via EFS-Web. The electronic documents are itemized in the Electronic Acknowledgement Receipt, which will contain a full listing of the documents submitted to the USPTO as described by the user during the submission process, including the count of pages and/or byte sizes for each document. Thus, the Electronic Acknowledgement Receipt is the electronic equivalent of the postcard receipt described *in MPEP § 503*.

MPEP 503, in relevant part regarding postcards and itemization, reads as follows:

If a self-addressed postcard is submitted with a patent application, that postcard will be provided with both *the receipt date* and application number prior to returning it to the addressee. The application number identified on such a postcard receipt is merely the preliminary assignment of an application number to the application, and should not be relied upon (e.g., with respect to foreign filings) as necessarily representing the application number assigned to such application. *** It is important that the return postcard itemize all of the components of the application. If the postcard does *not itemize each of the components of the application*, it will not serve as *evidence that any component which was not itemized was received* by the United States Patent and Trademark Office (USPTO)

And MPEP 503 also states in relevant part regarding “EFS-Web” that:

For applications filed via EFS-Web, after the Office receives a successful submission, an Electronic Acknowledgement Receipt is sent to the person filing the application. 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 submitted. *The Electronic Acknowledgement Receipt is the electronic equivalent of a postcard receipt.* See MPEP § 502.05.

My comments on the foregoing follow.

Comment 1: The Notice is ambiguous

The Notice states “With respect to patent correspondence, any references to the Office electronic filing system in this Notice (including in 37 CFR part 1) include EFS-Web and Patent Center.”

This definition of “the Office electronic filing system” fails to specify whether it applies to the many other Office electronic filing systems in addition to EFS-Web and Patent Center. Does it? If it does not, why then does the notice refer to “the Office electronic filing system” instead of EFS-Web and Patent Center?

Comment 2: The Notice is inconsistent with the statute regarding filing dates for patent applications.

35 USC 111(a)(4) defines the filing date of a patent application. It states:

35 U.S. Code § 111 - Application (a) In General - (4) Filing date.— The filing date of an application shall be the *date on which a specification, with or without claims, is received* in the United States Patent and Trademark Office.

The statute does not state that the filing date is the date “after the user clicks the ‘SUBMIT’ button on the ‘Confirm and Submit’ screen.” The statute does not state that the filing date is “the date shown on the Electronic Acknowledgement Receipt.”

The USPTO admits to operation and control of servers that “receive electronic submissions” on its behalf. The most reasonable interpretation of the statute in view of these facts is that the filing date for an application “shall be the date on which a specification, with or without claims, is received” by such a server. And not some subsequent time.

Obtaining a filing date is of critical importance to any patent applicant because the date determines what is and what is not available as prior art to defeat the right to the patent. And obtaining a filing date is of critical importance to any patent applicant seeking the benefit of an earlier filing date pursuant to 35 USC 119(e) and 120, of a prior filed United States patent application, or the right to priority pursuant to 35 USC 119(a)-(d), to a prior filed foreign application. And there is a public policy implied by cases such as *Dubost v. U.S. Patent and Trademark Office*, 85-761, 777 F.2d 1561, ___, 227 USPQ 977, 979 (Fed. Cir. 11/22/1985), followed by statutory amendment expressly defining the filing date to be the date “on which a specification, with or without claims, is received .” Subverting that statutory requirement, for the convenience of the PTO, is improper.

Does this distinction matter? Yes, it does. When the PTO’s servers, or the Internet connection between an application filer’s computer system is not responsive, after documents have been received by the USPTO server, the PTO server may fail to recognize that a filer has clicked “‘SUBMIT’ button on the ‘Confirm and Submit’ screen”; and the USPTO server may delay generating “the date shown on the Electronic Acknowledgement Receipt.”

Most practitioners have personal knowledge of failures of instances when the PTO’s servers, or the Internet connection between an application filer’s computer system is not responsive. And many of these instances occur after documents have been (1) uploaded and (2) itemized by specifying their numbers of pages and descriptions. By that time, the documents have been received in the USPTO. This time occurs prior to when the PTO server gets around to acknowledging receipt, and prior to when the filer presses a “submit” button.

The PTO can of course take an EAR as a prima facie proof of the date. The PTO cannot enforce a rule that undermines the statute, and the PTO should not promulgate MPEP instructions to PTO staff that are inconsistent with the statute.

Very truly yours,
/RichardNeifeld/
Richard Neifeld,
Neifeld IP Law, PLLC

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