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February 3, 2022

Mr. Andrew Hirshfeld
United States Patent and Trademark Office
Commissioner for Patents, Performing the
Functions and Duties of the Under Secretary
of Commerce for Intellectual Property and
Director of the United States Patent and
Trademark Office.

VIA ONLINE SUBMISSION

**Re: IPLAC US Patents Committee Comments on Electronic
Patent Issuance, Response to Docket No. PTO-P-2021-
0007**

Dear Mr. Hirshfeld:

The Intellectual Property Law Association of Chicago (“IPLAC”) appreciates the opportunity to provide comments to the United States Patent and Trademark Office (“USPTO”) in response to the proposed “Notice of Proposed Rulemaking: Electronic Patent Issuance” as originally published on December 15, 2021 in the Federal Register (FR Doc. PTO-P-2021-0007).

Founded in 1884, IPLAC is the country’s first and oldest bar association devoted to intellectual property matters. Located in Chicago, a principal locus and forum for the nation’s authors, artists, inventors, scholarly pursuits, creativity, research and development, innovation, patenting, and patent litigation, IPLAC is a voluntary bar association including several hundred members with interest in the areas of patents, trademarks, copyrights, and trade secrets and the legal issues they present. Its members include attorneys in private and



corporate practices before federal bars throughout the United States, the USPTO, and the U.S. Copyright Office. IPLAC offers the following comments and suggestions regarding the proposed administrative updates to the general requirements for admission to the examination for registration to practice in patent cases before the USPTO.

A. IPLAC Agrees with the Electronic Issuance Proposal

IPLAC respectfully agrees with the USPTO's proposal to issue patents electronically through its patent document viewing systems¹ and supports the USPTO's efforts to establish an electronic processing system for patent applications from beginning to end. Such efforts will reduce overall patent processing time and align with digital age tenets² by decreasing paper waste associated with printed documents and the resources for processing and handling such documents. Anecdotally, many IPLAC members' larger clients today store printed patents in a designated storage area³; once stored, these physical copies are never again referenced. Adopting electronic issuance of patents will therefore allow reduction of several costs patentees face, including organizational, storage, and shipping costs.⁴

Further, the time for a patent's issuance will decrease to a period within one week, instead of three weeks,⁵ after the patent number and issue date are assigned.⁶ This will

¹ See Patent and Trademark Office; Electronic Patent Issuance, 86 Fed. Reg. 71,209 (Dec. 15, 2021).

² See Jindou Lee, *Paper in a digital world: Time to eliminate the inefficiency and waste*, CIO: The voice of IT leadership (Dec. 12, 2016), <https://www.cio.com/article/236811/paper-in-a-digital-world-time-to-eliminate-the-inefficiency-and-waste.html>.

³ See Courtenay C. Brinckerhoff, *USPTO To Propose Paperless Patents*, Foley & Lardner LLP (Dec. 13, 2021), <https://www.foley.com/en/insights/publications/2021/12/uspto-to-propose-paperless-patents> (noting that the firm has clients who does not want it to forward ribbon copies to them).

⁴ *Unnecessary Printing of Ribbon Copies*, MR. IP L. (Oct. 20, 2020), <https://www.mriplaw.com/blog/819a05aublg8bvy8tttd21c572k37b6-mnda5>.

⁵ Patent and Trademark Office; Electronic Patent Issuance, 86 Fed. Reg. 71,209 (Dec. 15, 2021).

⁶ See Brinckerhoff, *supra* note 3.



likely lead to a longer active patent term, which many patentees may prefer over receiving a printed copy.

Other major intellectual property offices, such as the China National Intellectual Property Administration,⁷ have also implemented similar procedures and now only electronically issue patents.

Further, the current printed patent practice is somewhat duplicative with other options to obtain paper copies of patents from the USPTO and is merely commemorative.⁸ For example, patentees may obtain presentation copies if they want to publicly display their patents or celebrate their achievements.⁹ If patentees want a self-authenticating document for litigation purposes, they can obtain certified copies of the patent from the USPTO.¹⁰ Most importantly, implementing this Rule would not change the costs to obtain presentation and certified copies of patents.¹¹

While the proposed change will shorten the window to file continuing applications, Quick Path Information Disclosure Statements, and petitions to withdraw an application from issue, IPLAC thinks that a two-week shortened time period is minor, and that applicants will quickly adjust their allowance and issuance practices to account for the new timeline. Thus, IPLAC agrees with and supports the USPTO's proposed change to implement electronic patent issuance and change current patent procedures.

⁷ Aaron Winger, *China Patent Office to Cease Issuing Paper Patent Certificates*, China IP Law Update (Jan. 31, 2020), <https://www.chinaiplawupdate.com/2020/01/china-patent-office-to-cess-issuing-paper-patent-certificates/>.

⁸ Patent and Trademark Office; Electronic Patent Issuance, 86 Fed. Reg. 71,209 (Dec. 15, 2021).

⁹ Michael Kella, *A Helpful Guide to Ribbon Copies, Certified Patents, Patent Plaques, and More*, Harness IP L. (June 18, 2020), <https://www.harnessip.com/blog/2020/06/18/a-helpful-guide-to-ribbon-copies-certified-patents-patent-plaques-and-more/>.

¹⁰ *Id.*

¹¹ Patent and Trademark Office; Electronic Patent Issuance, 86 Fed. Reg. 71,209 (Dec. 15, 2021).



B. IPLAC Proposes Giving Applicants the Option to Order Printed Paper Patents

By discontinuing the printing, assembling, and mailing of printed paper patents upon issuance, the USPTO will likely save significant funds and resources. IPLAC believes that most applicants/patentees would expect some sort of decrease in the issue fee payment amount commensurate with these savings. However, IPLAC thinks that some small entities and individual inventors prefer the current printed paper patent over a presentation copy. In particular, the heavy card-stock paper booklet with the cover and seal carries a certain commercial and sentimental value over a presentation copy. Therefore, IPLAC suggests that the USPTO adopt one of the following two proposals:

A) If the issue fee payment amount is not reduced, then the USPTO should provide an option to order a printed paper patent after issuance free of charge; or

B) If the issue fee payment amount is reduced, then the USPTO should still provide the option to order a printed paper patent after issuance, perhaps for a small fee.

C. IPLAC Proposes Presenting Applicants Electronic Issuance of Certificates of Correction in Addition to Issued Patents

Certificates of Correction are printed and shipped bearing the gold seal similar to issued patents. Therefore, IPLAC recommends the USPTO simultaneously come out with corresponding changes to issue electronic seal copies of certificates of correction in a fashion similar to or compatible with electronic letters patents¹².

¹² See Manual of Patent Examining Procedure 1485.I.



IPLAC thanks the USPTO for considering these comments and welcomes any further dialogue or opportunity to support the U.S. Patent and Trademark Office.

Respectfully submitted,

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