

reexamination proceeding. The electronic signature must be the signer's actual name or have the actual name additionally presented in printed or typed form. The electronic signature may be any combination of numbers and/or letters and may include a title. Appropriate punctuation and spaces may be used with the letters and numbers. The signer must present his or her family name entirely in capital letters in the signature if the actual name is used. Where the actual name is not used in the signature, the family name must be presented entirely in capital letters in the printed or typed form of the name. When the actual name of the signer is being provided as a printed or typed name, it must be clearly identified as the actual name of the signer. A practitioner signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2) must place the signer's registration number, either within or after the electronic signature. A number character (#) may only be used in a signature if it is prior to a practitioner's registration number that is part of the electronic signature. New paragraph (h) sets forth the procedure for resolving questions as to the veracity of the (electronic) signature, such as when there are variations in signatures, or where the signature and the printed or typed name does not clearly identify the person signing the document, or where more than one person has used the same signature.

The Office considered proposing a requirement that the order of the name in a signature be identified with the language such as follows: given name, middle name or initial, family name if the name is supplied in that order. Capitalizing only the family name without identifying the order is considered a simpler and less burdensome procedure for signing a document. Comments in favor of or opposed to this alternative are invited.

Section 1.4(d)(1)(iv)(A) sets forth the specific requirements of an electronic signature (e-signature), and when the Office will accept an electronic signature in patent-related documents. The phrase "electronically signed" documents includes documents that are created and signed in a word processor program and electronically fillable forms, such as declarations generated using the program Adobe Acrobat that have pre-printed standard language with an ability to add specific information such as a signature (e.g., similar to those provided on the Office's Internet Web site that can be completed and signed electronically). The proposed rule change is intended to facilitate movement of documents between

practitioners, applicants, and the Office. The proposed rule change does not permit the filing of Official correspondence by electronic mail (e.g., e-mail) messages over the Internet to the Office, but does permit submissions transmitted by facsimile. Pilot programs, such as the program at the Board of Patent Appeals and Interferences (BPAI) are not affected by this rule change (see standing orders at the URL: <http://www.uspto.gov/web/offices/dcom/bpai/standing2003May.pdf>). Electronically created documents that contain an electronic signature e-mailed from applicants to a practitioner, however, may be transmitted to the Office from a practitioner by facsimile transfer, or as a paper document. While it is not now permitted, the Office is considering expanding the means by which electronically created documents can be transmitted to the Office, such as by an e-mail attachment using the proposed signature requirements.

Paragraph 1.4(d)(1)(iv)(A) recites that electronic signatures may be utilized when the electronically signed document is: (1) Facsimile transmitted from a computer in its electronic form; (2) printed and then facsimile transmitted; or (3) printed on paper and hand or mail delivered to the Office. This paragraph also permits electronic signatures for documents submitted via the Office's Electronic Filing System (EFS). The EFS is not an e-mail system. This paragraph does not authorize delivery of documents to the Office by e-mail over the Internet.

Practitioners must take care when submitting a document intended to be unsigned by ensuring that there are no markings in a signature space or this could be determined to be indicia of a signature (either as a permanent ink signature or electronic signature).

The documents submitted under this provision may become records submitted in interference and other legal proceedings where authentication is required. Applicants and practitioners must recognize the differences in electronically created documents and paper documents for authentication purposes and take appropriate steps to be able to authenticate documents, if required. An issue with electronically created documents is that they may have embedded comments and track changes in the electronic document that are not always visible when a document is rendered using a different computer system or a different software version, or when printed to paper. Variations in how much of the embedded comments and track changes are rendered on a given computer may cause the document signer to see different

document content than the contents of the document that is submitted to the Office. Additionally, establishing a chain of custody may involve proving that a document viewed by the Office is, in fact, the same document executed by the signer.

The Office can only authenticate a document to the extent of what is contained in Office records. Office records will not contain any of the electronic communications between the applicant or practitioner filing a document and a third party. For example, the Office cannot authenticate from its records a document (e.g., a § 1.132 affidavit) prepared by a third party and including a third party signature that was submitted to an applicant or practitioner electronically for resubmission to the Office. Under these circumstances, the applicant or practitioner would need to be concerned about both establishing a chain of custody to address alteration and any attempted repudiation by a third party of his or her electronic signature. In establishing the authenticity of a document, the applicant or practitioner would be attempting to show that the date of execution of the document is earlier than the date of submission to the Office, and the document was unaltered from that earlier date until its submission to the Office. A chain of custody would need to be shown and proven. Therefore, electronically created documents may require additional procedures over what may be required for a document signed with an ink signature to address chain of custody and alteration issues. In addition, there must be procedures in place to address the issue that the particular document preparation software may have undergone frequent changes. Different versions of the same software program may store and display the document, as well as comments and changes to the document, differently, which gives rise to issues concerning alteration of the document. Accordingly, applicants and practitioners must be cognizant of these issues of changed document appearance and content and take appropriate steps to ensure that their records, if in electronic form, can be rendered and authenticated at some later time as being the unaltered electronically signed original document.

Paragraph 1.4(d)(1)(iv)(A) defines who can insert an electronic signature into an electronically created document. The proposed rule change requires that the signer "personally insert" his or her electronic signature by use of numbers and/or letters, with punctuation and spaces. To make the identity of the signer self-evident, the same electronic