

# THE UPSIDE DOWN PATENT FILING FIASCO, THE REAL STORY\*

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## I. OVERVIEW

The PTO refusal to accept a fax filed upside down has generated a fair degree of commentary. A copy of the PTO refusal to accept the upside down transmittal is found as an appendix to this paper. Apparently, there are a large number of incidents where a fax is sent “upside down” to the PTO. In a normal situation, the reader of the fax simply turns the sheet upside down to read it. Here, however, the fax was sent to an automatic reader which cannot decipher upside down text. Thus, the upside down fax was met with the following response shown at the beginning of this section.

An unusually large number of comments were sent concerning the PTO action; representative comments are quoted. *See § II, Comments from The List.* As confirmed by a well placed source, what *actually* happened was that the PTO twenty-two years ago failed to update software designed to read upside down faxes or – worse yet – may have tried to reinvent the wheel and develop its own software that now, twenty-two years later, the PTO still has yet to fix. *See § III, What Actually Happened.*

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The lesson to be learned from the upside down fax snafu is far more serious in terms of the macroscopic operation of the PTO: There are serious glitches in the IT system that go back more than a quarter-century to the Quigg-Manbeck era that have never been fixed and which create tremendous impediments to the Kappos Administration's quest to right the ship. *See* § IV, *Policy Implications*.

## **II. COMMENTS FROM *THE LIST***

Considering the fact that comments are always maintained without identification of the source and generally not repeated in further postings to *The List*, it is rare to have more than a handful of comments about any posting. Here, however, there was an unprecedented number of responses. Here is a sampling:

A senior policy maker/lawyer/lobbyist for one of the major corporate players sounded a conciliatory tone: “This does sound ridiculous, but I can see that if someone at the PTO has to rotate an unpredictable number of images to append to electronic file wrappers, it could take an enormous amount of time when aggregated over many thousands of documents per month that they receive.” But, he added that, “[o]f course, it would be good for them to find an automated solution for this....”

A comparative patent expert from the Middle East commented: “I suppose the next step is to reject a fax because someone at the USPTO doesn't like my personal appearance. Or because the fax was written in English, which is not a language the Examiner understands.”

A senior patent litigator with a half century of practice asked “Did you mean from left to right - as per an Arabic transmission?” He then must have sighed, adding: “Oh for the long ago good old days when there was some sort of common sense in the PTO.”

A Northwest Coast patent attorney noted that “[g]ood help is hard to find..... Or maybe the person needs further training on how to turn a fax right-side up!”

A leading academic from the West Coast exclaimed: “That's it, I'm filing a patent on a method of document inversion that facilitates the comprehension of otherwise unintelligible data.”

A retired Commerce Department official put it succinctly: “Amazing!”

While most comments were sympathetic to the plight of the new Administration, there is a hard core of folks who have had so many difficulties with arbitrary actions in the past that the reaction is instantly hostile. One said he will complain and send this example to the OMB. Another expressed frustration with arbitrary policies: “And you think people should give the Patent Office leeway, and time for reform? The MPEP makes no provision for whether a fax is right side up or upside down, and no point of law or administrative procedure was cited for their failure to accept the filing. This is pure pigheaded contempt for law and common sense; unfortunately, that is a situation encountered with some regularity at the PTO.”

Another wrote: “No problem. Rip off head of reader, turn upside down, place back on neck.” Or: “[O]ur tax dollars at work. twin that with the (in)famous patent on a method for swinging a swing . . .”

### **III. WHAT ACTUALLY HAPPENED**

A respected journalist well known to this writer provided the following explanation which was subsequently confirmed by a well placed source within the Administration: The journalist explained:

“This is much more than you want to know about faxing. But it used to be my business, and I think I know what's going on here.

“The applicant went to a fax machine and fed in some paper and dialed the PTO's fax number. The phone number doesn't lead to a fax machine, it leads to a ‘fax server’ (23 year old technology; what the letter refers to as ‘electronic fax’). The fax server takes in what comes over the phone line and turns it into a TIFF file.

“The TIFF file is an image, not text. To get it into text, either a human has to look at the image on a screen and retype everything or the fax server will automatically initiate a ‘TIFF-to-text conversion’ program. I suspect the latter happened, the program tried to convert the upside-down page, and found no English letters or words. So it automatically generated this letter in response. I doubt any human ever looked at the application before the return letter was sent.

“You might ask why the program didn't automatically invert the image and try again. That fax server add-on feature is probably 22 year old technology. So the real point here is that the PTO's technology is either very, very old or they wrote the program themselves and didn't code for the inversion.

“So it's probably wrong to assume some petty human didn't take the time to rotate it. The automated system just couldn't handle it. Not an excuse -- poor technology resulting in customer abuse is no more defensible than poor customer service by humans. Just an explanation.”

#### **IV. POLICY IMPLICATIONS**

Upside down faxes are just the very smallest tip of the IP iceberg at the Office. Massive pendency delays are created by routine filing of “paper” and the waste created by a need to scan this paper into electronic form. The antiquated systems of today are simply inexcusable and represent blame that must be shared by Messrs. Quigg, Manbeck, Lehman, Dickinson, Rogan and Dudas – the several patent leaders of the past quarter century. It is incredible to realize that the Japanese patent system required electronic filing of papers *twenty (20) years ago*. The arrogance and waste of the previous Administrations that sought to reinvent the wheel and come up with an “American” solution when off the shelf solutions were available is difficult to countenance. The electronic mess that is manifested by today’s IT system faces the Kappos Administration as a huge challenge, one that must be dealt with but which cannot be surmounted overnight.

Yet, the problems are not insurmountable. First, adequate funding is needed to purchase the off the shelf solutions that can now be more readily obtained than a generation ago. Second, but more importantly, a fresh approach must be taken to IT that focuses on *solutions*: A new leadership is needed for IT that will focus on such *solutions* as opposed to rationalizing a failed past. Third, the patent community must do more than pay lip service of support for the Kappos Administration and go to bat on the Hill for the funding initiatives so desperately needed as opposed to nit-picking whether the Director should have authority to set fees.

# Wegner, The Upside Down Patent Filing Fiasco, the Real Story

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USPTO 2/3/2010 11:39:31 AM PAGE 2/005 Fax Server  
O:SUBMITTER COMPANY:Faxed to Submitter's Fax Number



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February 03, 2010

Submitter

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Your request to record a document in the United States Patent and Trademark Office was received via electronic fax on February 02, 2010, at 04:18 PM.

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