

Slashes and USPTO S-Signatures

Robert J. Rose¹

It makes no difference whether [the telegraph] operator writes with a steel pen an inch long attached to an ordinary penholder, or whether his pen be a copper wire a thousand miles long. Nor does it make any difference that in one case common record ink is used, while in the other case a more subtle fluid, known as electricity, performs the same office.²

As early as 1869 in the seminal case of *Howley v. Whipple*, the inevitability of electronic signatures in legal documents was recognized. Fast forward to the year 2000, and we see the adoption of the federal E-SIGN Act³ which provides:

Notwithstanding any statute, regulation, or other rule of law . . . with respect to any transaction in or affecting interstate or foreign commerce . . . a signature, contract, or other record relating to such transaction may not be denied legal effect, validity, or enforceability solely because it is in electronic form.⁴

DocuSign, the largest of several dozen worldwide corporations offering electronic signature services, claims more than 200 million users in 18 countries.

¹ Law Office of Robert Rose, Escondido, California. Member, State Bar of California and United States Patent and Trademark Office. See www.rosepatents.com

² *Howley v. Whipple* (48 N.H. 487)

³ The Electronic Signatures in Global and National Commerce Act, 15 U.S.C. §§ 7001 et seq.

⁴ 15 U.S.C. § 7001(a)(1).

Indeed, if you have bought real estate or entered into a contract within the last decade you will be aware of electronic signatures.

The devil, however, is in the details.

While we recognize the future, in legal affairs we seem stuck in the past. As lawyers, we know that electronic signatures are now a reality, but we don't have the time to find out how they work, and besides, a handwritten "blue-ink" signature works so why change things?

The irony here is that while United States Patent and Trademark Office regulations allow for electronic signatures (which are called "s-signatures"⁵ in USPTO practice) because of an ambiguous rule and misinterpretation by the USPTO staff and practitioners, the use of s-signatures has been encumbered in a seeming anachronism. Specifically, while it should be the vanguard of new technology, the US Patent Office seems to require that electronic signatures be in the form:

/John Doe/

where the surrounding forward slashes, or virgules, are entered by the signer. This is astonishing to clients, and all but renders electronic signing services difficult and cumbersome to use.⁶

This comment argues that USPTO Rules properly interpreted, and in view of existing USPTO regulations, allow the practitioner to prepare forms for signature which include the slashes such that when the client signs the document the electronic signature will appear between the slashes.

⁵ 37 C.F.R. § 1.4(d)(2)

⁶ One can request the client to create a special form for signature which includes the slashes, but few if any clients have the interest, time, or experience to do this.

21st Century Strategic Plan Changes

We begin with the initial authorization for electronic signatures when dealing with the USPTO. This was contained in the Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan (2004).⁷ That final rule revised the rules of practice in title 37 of the Code of Federal Regulations (CFR), and among many other changes, Section 1.4(d)(2) was rewritten to provide for the signing of correspondence by use of an S-signature.

In the introductory Discussion of Specific Rules the USPTO explained:

The S-signature must be placed between two forward slashes. This is consistent with the rule adopted in the Trademark Office, and the international standard. See PCT Annex F, section 3.3.2. . . . the Office will only interpret the data presented between two forward slashes as an S-signature.⁸

Here we see two important clues to interpretation: the S-signature is distinct from the surrounding slashes (only the data between the slashes is the s-signature), and it was intended to harmonize procedure with PCT practice.

What then follows is an ambiguous comment, which foreshadows the current confusion:

The person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (e.g., /Dr. John P. Doe, Jr./).⁹

The language has a latent ambiguity. It could be (and has been) interpreted as requiring that the slashes be inserted by the person signing the correspondence.

⁷ Final Rule published at 69 Fed. Reg. 56482 (Sept. 21, 2004)

⁸ *Id.* at 56484.

⁹ *Id.* at 56485.

Yet, the language can equally, if not more plausibly, be interpreted as words of placement, explaining where the s-signature must be placed.

Another clue to interpretation is the USPTO response to Comment 3:

Comment 3: One comment suggests clear demarcation of electronic signature (now referred to as an S- signature) by statement rather than use of back-slashes, etc.

Response: The comment is not adopted. The comment proposal requires analysis of text beyond simple inspection of a document for the presence or absence of a signature. It is not clear from the comment what is a “clear” statement of signature or how typing a statement that a typed name is a signature can be less burdensome than typing slashes. Further, the signature format employing slash characters is the standard adopted by the PCT and the Office intends to be consistent with international standards.¹⁰

From this it is evident that that the slashes are not part of the s-signature, but rather are indicia of where the s-signature is to be located. The goal of harmonization was repeated in the Discussion immediately thereafter:

The Office will not adopt any changes with respect to permitting a format that does not include slashes so as to be consistent with the PCT standard for electronic signatures and which can be readily identified as an S-signature.¹¹

The text of final Rule 1.4(d)(2) became:

(2) S-signature. An S-signature is a signature inserted between forward slash marks, but not a handwritten signature as defined by § 1.4(d)(1). An S-signature includes any signature made by electronic or mechanical means, and any other mode of making or applying

¹⁰ *Id.* at 56487.

¹¹ *Ibid.*

a signature not covered by either a handwritten signature of § 1.4(d)(1) or an Office Electronic Filing System (EFS) character coded signature of § 1.4(d)(3). Correspondence being filed in the Office in paper, by facsimile transmission as provided in § 1.6(d), with a signature in permanent dark ink or its equivalent, or via the Office Electronic Filing System as an EFS Tag(ged) Image File Format (TIFF) attachment, for a patent application, patent, or a reexamination proceeding may be S-signature signed instead of being personally signed (i.e., with a handwritten signature) as provided for in paragraph (d)(1) of this section. The requirements for an S-signature under this paragraph (d)(2) are as follows:

- (i) The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation, and the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S- signature (e.g., /Dr. James T. Jones, Jr./); and
- (ii) A registered practitioner, signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2), must supply his/her registration number, either as part of the S- signature, or immediately below or adjacent the S-signature. The number (#) character may only be used as part of the S-signature when appearing before a practitioner's registration number; otherwise the number character may not be used in an S-signature.
- (iii) The signer's name must be:
 - (A) Presented in printed or typed form preferably immediately below or adjacent the S-signature, and
 - (B) Reasonably specific enough so that the identity of the signer can be readily recognized.

PCT Annex F

Because the USPTO has insisted that the S-signature slashes were needed to harmonize practice with the PCT procedure, we next examine Annex F to the PCT Administrative Instructions, dealing with the Standard For The Filing And Processing In Electronic Form Of International Applications. Relevant to our inquiry is Section 3.3.2 relating to text string signatures:

To create this type of signature, an XML file must include the <text-string> element containing a text string that represents the user's

“wet” (ink) signature, enclosed in slash “/” characters, as shown in the example below:

/janedoe/

The text-string must be a string of characters which does not include the forward slash “/” character, and which is chosen by the user as its electronic signature. Valid examples include:

/John Smith/

/Tobeornottobe/

/1345728625235/

/Günter François/

The indication that the text-string may not include a slash, but must be sandwiched between slashes, is consistent with an interpretation of the 2004 amendments as recognizing that the signature is separate from the slashes.

USPTO Training Material

Following the adoption of the changes required by the 21st Century Strategic Plan, the USPTO prepared a Q&A for examiners on November 16, 2005.¹² Significant for our inquiry is Question and Answer B8:

B8. 37 CFR 1.4(d)(2)(i) provides that “the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature.” **Can a form be created that contains the slash marks (without any signature), or must the person signing the form also insert the slash marks?**

Forms may be created that contain the “/ /” (slash marks) in preparation for a signature to be added by the party actually signing the form. 37 CFR 1.4(d)(2) states in-part that an “S-signature is a signature inserted between forward slash marks” 37 CFR 1.4(d)(2)(i) provides in-part that the “S-signature must consist only of letters, or Arabic numerals, or both,

¹² The material was posted to the USPTO website, and is available today through use of the Wayback Machine, accessed on September 11, 2017, at: http://www.uspto.gov/web/offices/com/strat21/StratPlan_qnas.htm

with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation” **The slash marks are not defined as part of the S-signature.** The preamble of the final rule states that the “S-signature must be placed between two forward slashes” (69 Fed. Reg. at page 56484, right-hand column, second full paragraph). The slash marks are not the signature but an “indicia manifesting an intent to sign” (id .) Where, however, a party has inserted a signature on a form not containing the slash marks, a slash mark must be placed before and after the signature by the party who signed the form. To summarize, a party placing a typed name on a form without the slash marks does not indicate an intent to sign the form, and the addition of slash marks by another around the typed name would not be proper as it would be changing the intent of the appearance of the typed name on the form.

The significance of this instruction to Examiners cannot be over-emphasized. It shows the USPTO’s interpretation of its own rule, as explained to its own staff, and answers the direct question before us: “Forms may be created that contain the ‘/ /’ (slash marks) in preparation for a signature to be added by the party actually signing the form.”

Using these instructions, for example, a form could be prepared that had a signature line with the slashes prefixed, and the signatory’s name adjacent thereto:

Signature: / _____/

Signatory's Name: Donald Doe

This document could be loaded into the electronic filing service so that the indicated location for signing will be between the two slashes. The returned document would then look like:

Signature:  DocuSigned by:
4D5BEA22EC0D453...

2007 Guidance Letter

In January 2007, John Love, Deputy Commissioner for Patent Examination Policy sent a Clarification letter to the Technology Center Directors. In the letter he restates the 2004 Discussion found above in the Discussion of the Final Rule, and distinguishes between the S-signature itself, and the slashes which surround it. By its terms it was intended as a restatement and clarification of office practice, and does not purport to rescind or abrogate interpretations in the training material.

2009 Legal Framework for EFS-Web

The Legal Framework for EFS-Web is available today at the USPTO website and provides guidance on the background statutes, regulations and policies that support the Electronic Filing System - Web (EFS-Web) project. The document is provided as a reference for applicants, parties in reexamination proceedings, attorneys, and agents, as well as their employees using the system.¹³ It provides in important part:

F. Signature Policy

....

A legible electronic image of a handwritten signature inserted, or copied and pasted by the person signing the correspondence into an application document may be considered to be an acceptable signature. The legible image of the handwritten signature of the person signing the correspondence must be inserted by the person. Additionally, the signature must be surrounded by a first single forward slash mark before the electronic image and a second single forward slash mark after the electronic image. That is, the legible electronic image of a handwritten signature must be enclosed

¹³ Accessed September 11, 2017 at <https://www.uspto.gov/patents-application-process/filing-online/legal-framework-efs-web>

between two single forward slashes and the signer's name is indicated below or adjacent the signature as per 37 CFR 1.4(d)(2). **The slashes may be inserted into the document prior to the insertion of the signature.** (emphasis added)¹⁴

Conclusion

While the enabling Rule has a latent ambiguity, the USPTO current and historical interpretation documents clearly show that:

- (1) the slashes are necessary indica but are not part of the S-signature;
- (2) the slashes may be inserted in the document by the practitioner prior to the insertion of the signature;
- (3) Document signing services may be integrated into a workflow for electronic signature of documents to be submitted to the USPTO.

¹⁴ Accessed September 11, 2017 at <https://www.uspto.gov/patents-application-process/filing-online/legal-framework-efs-web#heading-6>