



THINK FORWARD

Proposed Rule Changes by the USPTO Aim to Improve Large Data Submission by Patent Applicants

By [Rashad Morgan](#), [Alexis White](#)

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On May 26, 2021, the United States Patent and Trademark Office (“USPTO”) issued a notice of proposed rulemaking (“NPRM”) in the Federal Register to amend the rules of practice to permit the submission of physical media larger than compact discs for electronic versions of amino acid and nucleotide sequence information, information compiled in a large table, and information relating to a computer program listing. Because applications requiring large submissions of physical media are only a mere fraction of the total applications received by the USPTO yearly, the USPTO asserts that expanding the types of physical media that can be used in these submissions will have minimal impact on its processing of this data and on applicants in general. The USPTO also asserts that the proposed changes will harmonize the rules governing the submission of a “Sequence Listing,” a CRF of a “Sequence Listing,” “Large Tables,” and “Computer Program Listing Appendix.”

Currently, the USPTO patent electronic filing system permits submission of ASCII plain text files (.txt) for submission of a “Sequence Listing,” a CRF of a “Sequence Listing,” “Large Tables,” and a “Computer Program Listing Appendix.” Although a USPTO patent electronic filing system submission of such ASCII plain text files is preferred, system limitations of the USPTO electronic system impede accommodation of large ASCII text files. These large text files may be submitted on compact disc and their accompanying images are submitted in PDF form.

Due to the limited storage capacity of compact discs, the USPTO proposes to revise the rules to permit use of Digital Video Disc-Recordable (DVD-R or DVD+R) media. These higher-capacity read-only optical discs significantly reduce the number of physical media required to accommodate large files. For example, under the current rules, there are varying size limitations for submissions of ASCII plain text files, dependent upon the type of data being submitted (“Sequence Listing,” a CRF of a “Sequence Listing,” “Large Tables,” or a “Computer Program Listing Appendix”). These size limitations sometimes result in the data being broken up into multiple electronic submissions. Additionally, some of these file types are not capable of being broken up, and applicants must submit the information on read-only optical discs. In the case of Sequence Listings, this is especially true. Additionally, such files cannot be compressed and will further necessitate the submission of multiple optical discs. Use of multiple discs could increase chances of compromised data due to user error and result in delays in the prosecution process at the USPTO. These proposed changes to the rules will permit higher-capacity media as well as non-self-extracting file compression, allowing parties to submit material on a single disc without fear of compromising data integrity.

The proposal also contemplates the removal of reference to obsolete computer and operating system formats and will recite updated computer and operating formats, as well as their compatibilities. Additionally, the NPRM includes a proposal to amend the rules relating to the arrangement of the specification to clarify when an incorporation by reference statement is necessary when a patent

application relies on subject matter from an ASCII plain text file submitted on physical media. Moreover, revisions to the rules of practice relating to the form, content and submission requirements of “Sequence Listings” will continue to conform to WIPO Standard ST. 25, which governs the presentation of nucleotide and amino acid sequence listings in patent applications, and forthcoming WIPO Standard ST. 26, which takes effect on Jan 1, 2022, and will replace WIPO Standard ST. 25, requiring A “Sequence Listing” to be presented as a single file in eXtensible Markup Language (XML).

In conclusion, the proposed rule changes would provide Applicants with improved options for submitting large data to the USPTO while providing needed updates for advances in technology. Comments on the NPRM must be submitted by July 26, 2021, through the Federal eRulemaking Portal at www.regulations.gov to ensure consideration.

Key Takeaways

- USPTO proposed changes to the rules of practice will allow applicants to use higher capacity storage types to support larger physical media submissions
- Proposed rules will provide needed updates for advances in technology
- Revisions to the rules of practice will continue to conform to WIPO standards