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Setting and Adjusting Patent Fees

Comment On: PTO-P-2018-0031-0001
Setting and Adjusting Patent Fees During Fiscal Year 2020

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Comment Kilpatrick Townsend and Stockton LLP

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General Comment

On behalf of Kilpatrick Townsend and Stockton LLP, a firm that files over 3,000 US patent applications per year on behalf of our client, we object to the proposed \$400 surcharge for filing applications in non-DOCX format. See attached for full comment.

Attachments

Comment_DOCX_20190930

This comment is submitted on behalf of Kilpatrick Townsend and Stockton LLP, a firm that files over 3,000 US patent applications per year on behalf of our clients.

We object to the proposed \$400 surcharge for filing applications in non-DOCX format. The USPTO's DOCX filing process is unreliable, and the USPTO requires that applicants who upload DOCX files bear the risk of errors introduced by the USPTO in the process of validating and converting the DOCX files to PDF. Applicants can avoid that risk by generating and uploading their own PDF files. The proposed surcharge amounts to fining applicants who refuse to take an unnecessary risk.

The unreliability of the USPTO's DOCX filing process has been documented repeatedly by patent practitioners. (See, e.g., comments by Carl Oppedahl in response to this Notice of Proposed Rulemaking.) In view of this evidence, prudent practitioners do not trust the DOCX process.

Current USPTO policy compounds the problem by shifting the risk of unreliability to applicants. The USPTO does not treat the DOCX files that applicants upload as the official version of the application (and apparently does not even save them for the record). Instead, the USPTO performs a validation process that *alters* the DOCX file, then converts the altered DOCX file to PDF. This PDF, which may contain errors introduced by the USPTO, becomes the official version of the application, and applicant is held responsible for verifying that the USPTO's validation and conversion processes did not introduce any errors or loss of content. This is unlike the PDF filing process, where the files applicant uploads become the official version.

This policy gives rise to multiple issues, including the following:

(1) Patent rights may be lost due to errors made by the USPTO, not applicant. This is not a fair result.

(2) The DOCX filing process is inefficient. As competent practitioners, we closely proofread our applications prior to uploading files to EFS-Web. Because we bear the risk of USPTO error, the DOCX filing process requires a *second* close proofreading after the PDF is generated. In addition, an efficient workflow for preparing and filing applications dictates that the time for close proofreading is before documents are uploaded to the USPTO, not in the middle of the filing process.

(3) The USPTO's validation and conversion processes alter the uploaded DOCX files in ways that are outside the filer's control. When a filer finds an error in a USPTO-generated PDF (such as an altered equation or chemical formula), the cause may not be apparent, and the filer may be unable to correct the error. The filer must then give up on DOCX filing and revert to uploading PDFs that are generated by the filer without the USPTO's error-prone conversion process.

While we appreciate the USPTO's desire to streamline its operations, we do not believe it is reasonable for the USPTO to impose a surcharge on applicants for refusing to use an unreliable process that puts their patent rights at risk.