

PUBLIC SUBMISSION

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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

Document: PTO-P-2018-0031-0015
Comment James Ryley

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General Comment

To Whom it May Concern,

There are two major issues with the proposed rule that I would like to address, both surrounding the requirement of DOCX format.

First, the \$400 surcharge for filing in non-DOCX format seems absurdly high given that, by the USPTO's own figures, it currently costs, if I recall correctly, \$2.37 to OCR a patent application submitted in PDF format. How is a \$400 surcharge to avoid a cost of \$2.37 justified?

Second, moving to DOCX is simply not justifiable from a technical perspective. With PDF, what you see is what you get. With DOCX, this is not necessarily true. In fact, it is common for characters in a DOCX file to get corrupted when moving between versions of software (even different versions of Word, to say nothing of software like OpenOffice or LibreOffice), between different operating systems, and between computers that do not have the same fonts installed.

I have personally seen instances (as have my colleagues) where I open a DOCX file from someone else and some of the characters appear as boxes or question marks. Generally, this means that a special character was used but that character is not available on the current system. I have seen this happen even when the "Embed fonts in file" option is checked; it does not work 100% of the time.

How does the USPTO plan to address this problem? It seems that PTO's solution is to dump the

responsibility onto the practitioner, because as I understand the proposal, even when submitting in DOCX, the authoritative document will still be the PDF that the USPTO systems generate from the DOCX. It will be up to the practitioner to check that PDF for accuracy.

This means that, particularly in fields where formulas or special characters are used, every single time a DOCX is uploaded, the practitioner would have to scrutinize the resulting PDF for any potential mistakes. Given that even a single character changing (e.g., when it changes a unit or a quantity and is not easily recognized as a typographical error) can change the meaning of the specification and claims, this promises to be a painstaking, error-prone process taking hours of time and therefore costing the public hundreds of dollars per filing.

There is also the issue of professional liability. What practitioner wants to take responsibility for the fact that the PTO's DOCX to PDF conversion process may have non-trivially changed the document submitted?

Overall, the burden this proposal places on the practitioner is far, far higher than reasonable, and far, far higher than any savings that the PTO might enjoy. The proposed \$400 surcharge is similarly out of line.

If the PTO has diligently investigated this matter and has facts to support that the DOCX to PDF conversion process will work flawlessly 100% of the time, has numbers to support why a \$400 surcharge is appropriate if not filing with DOCX, and can explain why there would be no burden on the practitioner if this proposal is implemented, I would very much like to see that information.

Sincerely,
James Ryley