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Via E-mail: fee.setting@uspto.gov

Brendan Hourigan, Director
Office of Planning and Budget
Mail Stop--Office of the Chief Financial Officer
United States Patent and Trademark Office
P.O. Box 1450
Alexandria VA 22313-1450

Re: Notice of Proposed Rulemaking
Setting and Adjusting Patent Fees During Fiscal Year 2020
84 Fed. Reg. 37398 (July 31, 2019)
Docket No. PTO-P-2018-0031

Dear Mr. Hourigan:

I am one of the signers of a comment regarding the above-referenced rulemaking proceeding ("NPRM"), earlier filed on behalf of a group styled as "Fifty Patent Practitioners". I write separately to supplement and amplify the Fifty Patent Practitioners comment. This supplemental comment should not be taken as a waiver or repudiation of the Fifty Patent Practitioners comment.

In this comment, I use the term "Author" to refer broadly to inventors, applicants, practitioners, and their various legal, technical, and other assistants, who may be involved at any point in the chain of steps from initially describing technical subject matter in any form to filing a corresponding patent application in the PTO.

I. THE PROPOSED DOCX FILING RULE/PENALTY WOULD IMPOSE
MUCH LARGER COSTS TO AUTHORS THAN THEY WOULD SAVE THE PTO

The proposed rule offers Authors an expensive dilemma: file applications in DOCX format or pay a \$400 penalty for filing in PDF format.

Either choice transforms the PTO's admitted-to-be-small cost of converting a PDF-format filing into text form, into large costs for the Author, which large costs the PTO appears not to have analyzed and the PTO certainly has not acknowledged.

Even for Authors who use DOCX authoring tools in the ordinary course of business, filing in DOCX format involves significant cost in time and risk. Other commenters have furnished examples of defective conversion of DOCX-format documents by a PTO online filing system and of inconsistencies among various software packages used to author and process DOCX-format documents. Although not detailed in the NPRM, during the filing process, the PTO's online filing system purports to "generate" a PDF version that will "become the final submission", instructs the filer to review a specimen of the generated PDF, and coerces the filer's agreement to "accept any changes made by the conversion" and that the PDF "will become the final submission". As noted in other comments, although the PTO asserts that the DOCX format is subject to standards, the standards do not fully specify the behavior of software the interprets files in DOCX format, and the PTO has not identified in the NPRM the conversion software it will use in a way that would allow Authors to use such software as a reference implementation. Moreover, even the various software packages that process documents in DOCX format furnished by the originator of the format do not behave identically. Accordingly, even for Authors who use DOCX authoring tools, regardless of the particular DOCX authoring or processing software being used by the Author, the author must carefully inspect the PTO's "generated" PDF specimen to compare it to the Author's own document. This careful inspection takes significant time, perhaps tens or hundreds of minutes for a larger application, which time imposes a real cost on Authors. There is significant risk that, even if the filer exercises a high degree of care, they will not successfully find all defects in the PTO's conversion during manual inspection of the PTO's specimen, which may cause a loss of patent rights, or may increase the cost of prosecution.

Also, although again not detailed in the NPRM, the PTO has separately announced that various characteristics of an otherwise-valid DOCX-format document, including the presence of several features apparently supported by "office" software suites used to author and process DOCX-format document, can cause the document to be rejected by the PTO's online filing system. Modifying a document to conform to the incompletely-specified requirements of the PTO's online filing systems can take significant time--perhaps tens of minutes or several hours. In addition to the direct cost of making these changes, there is significant risk that the document cannot successfully be modified under some circumstances. For example, when is necessary to file an application on an emergency basis late in the day of an impending filing deadline, it may not be possible to make the modifications necessary to satisfy the PTO's online filing systems in the time remaining after the documents have been uploaded and

rejected. It may then even be impossible successfully to convert the document into PDF and upload it in that format.

Attention is drawn to the PTO's failure in the proposed rules to define the behavior of its systems. Although the PTO alleges in the NPRM that files in DOCX format are subject to two published standards, it is unclear how those standards may be relied upon, or even relevant, as the PTO has omitted in its proposed rules to provide that any DOCX file complying with those standards shall be accepted, and the PTO also has omitted to provide a mechanism by which a filer aggrieved by the rejection of or the defective PTO conversion of a standards-compliant DOCX file may obtain redress. The undersigned believes that DOCX files conforming to the standards can nonetheless be rejected by the PTO's online filing systems. Because the PTO does not specify the behavior of its systems in the proposed rules, all filers are subject to the risk that whether any DOCX file--even one that fully compliant with published standards therefor--is accepted by the PTO's online filing systems is at the absolute caprice of the PTO and its systems and software vendors.

Although all filing Authors are affected by the aforementioned costs and risks, patent practitioners who would file in DOCX format to comply with the proposed rule will incur additional risks arising from the professional liability and practitioner regulation regimes to which they are subject. For example, a practitioner could, as a result of a conversion defect that was not discovered while inspecting the PTO's PDF specimen, or some other problem peculiar to using the PTO's online filing system to file in DOCX format, be deemed by a regulator or tribunal to have violated a rule of practice or to have failed to satisfy a duty of care, even if a represented applicant loses no substantive rights.

In the NPRM, the PTO states that, "[b]ased on a USPTO survey, over 80 percent of applicants author their patent applications in DOCX in the normal course of business." That leaves a sizable fraction, and absolute number, of applicants who do not author their patent applications in DOCX in the normal course of business.

Although even Authors who use DOCX authoring tools in the normal course of business to produce their patent applications or predecessor documents are affected by to the aforementioned costs and risks when filing in DOCX format, Authors who use other types of authoring tools, which use formats other than DOCX ("non-DOCX authoring tools"), to create and process patent applications or predecessor documents, and who seek to file in DOCX format in compliance with the proposed rule, are subject to the additional costs and risks of converting or re-authoring documents into DOCX format. Some authors use non-DOCX authoring tools for highly-specialized features, such as particular facility for handling mathematical or chemical equa-

tions. Some authors use non-DOCX authoring tools for compatibility with other systems, such as those used in academic publishing. While some non-DOCX authoring tools may provide for programmatic conversion or export of a document into DOCX format, such conversion can be involve significantly greater technical difficulty and occurs with less fidelity than does conversion into a printable rendition such as PDF. Other commenters have noted imperfect compatibility in the behavior of, and the printable renditions produced by, the various word-processing programs that create and process DOCX-format documents. Those imperfections persist even among word-processing programs that use a roughly-similar document model, and even after about a decade of strong effort by word-processing-program developers to achieve compatibility. Non-DOCX authoring tools, which use document models different from the word-processing document model, present format conversion problems that are even more difficult and can result in even less fidelity in the converted document. The content in some of the non-DOCX systems can not be identically represented in a DOCX-format document. Obviously, if programmatic conversion from a non-DOCX document to a DOCX is not possible or is unsatisfactory, the document can be re-authored using, e.g., a conventional word processing program, but re-authoring is expensive, time-consuming, and involves additional risk of error.

The existing online filing regime, where PDF files are accepted without a penalty, serves Authors who use non-DOCX authoring tools well, because virtually all document authoring tools in modern use can produce a printable rendition of the document, in the form of a PDF document or a virtual equivalent, reliably. That function is frequently exercised. The what-you-see-is-what-you-get nature of the PDF format allows users to manually or programmatically compare the conversion result to the original. Frequent users of non-DOCX authoring systems are familiar with their operation, likely know the limitations (if any) of conversion into PDF format, know where to look for defects in the PDF file, and have many opportunities during the development and revision of the document to view a conversion result and notice defects. (This is different from comparing the PTO's DOCX-to-PDF conversion specimen with an original DOCX document upon upload for filing, where users do not directly operate the PTO's conversion software, have limited practical opportunities to see the conversion results (and any defects therein) on early revisions of the document, and have limited time to inspect and approve the conversion result.)

The proposed DOCX filing rule imposes significant direct and indirect costs on all filers, regardless of whether the filer submits an application in DOCX format or submits in PDF format and pays the \$400 penalty.

The cost of reviewing the PTO's DOCX to PDF conversion specimen might reasonably range from \$60 to \$1000.

The cost of modifying a DOCX file that the PTO's online systems have rejected might reasonably range from \$150-\$1800.

The cost of converting a document from a non-DOCX authoring system into a DOCX-format authoring system might reasonably range from \$60-\$3000.

And the various additional risks from the proposed rule--conversion defects that are not discovered, rejected filings, loss of rights, professional liability, and practitioner regulation--also impose significant costs. All of these risks cost something: additional practitioner and assistant time spent in checking and then double-checking filings; shifting tasks from lower-cost assistants to higher-cost practitioners, inventors, and managers; additional cost for insurance or liability reserves; reduced willingness of practitioners to accommodate emergency filings; and so on.

The PTO states, "[t]he Office converts image-based filings (e.g., PDF documents) into text-based format for internal processing. [...] Optical character recognition of image-based filings costs the Office approximately \$3.15 per new submission." That's about 1/75th the cost of the basic filing fee and less than 1/400th the real cost to submit an application.

It is inconceivable that any applicant or practitioner undertaking to comply with the proposed DOCX filing rule in the course of gainful employment in the United States could do so at a cost less than \$3.15.

Thus, in the NPRM, in order avoid a \$3.15 cost, the PTO proposes a rule that would imposing much greater costs on all filers, and for PDF filers, proposes a penalty of more than 100 times the PTO's cost.

The PTO has not appropriately analyzed or acknowledged these costs in the NPRM.

II. PROPOSED DOCX FILING RULE/PENALTY IS MORE RESTRICTIVE THAN NECESSARY TO ACHIEVE EQUIVALENT CLAIMED BENEFITS

In the NPRM, the PTO states that it now converts image-based filings "into text-based format for internal processing". The PTO alleges these principal benefits of the proposed DOCX filing rule (paraphrased for brevity):

- (a) avoids the cost of OCR;

- (b) DOCX filing allows generation of XML that complies with WIPO Standard ST.96, for use by other systems;
- (c) text filing makes documents available to examiners in almost realtime[sic];
- (d) DOCX filing allows use of automated tools to analyze text, review formalities, generate claims trees, and compare documents;
- (e) applicant-supplied text improves results in automated presearch and future analytics;
- (f) DOCX submission enables automation of publication processes used for grants and pre-grant publications;
- (g) DOCX submission enables automation to assist in formalities reviews, classification, and routing.

What all of these alleged benefits have in common is not the DOCX format, but rather their reliance on the availability of text, corresponding to the specification, which can further be processed by PTO systems for the PTO's convenience (the "convenience text").

But there is no technical or operational reason the PTO must obtain the convenience text from a user-uploaded DOCX file that the PTO then converts into a PDF document, whereby the filer is coerced to agree, as a condition of filing, to accept any changes made in the conversion, and that the PTO's conversion specimen "will become the final submission", which process unnecessarily increases costs and risks for filers.

There are several alternative ways the PTO could obtain the convenience text from applicants so as to achieve all of the benefits alleged in the NPRM.

1. The PTO could extract the convenience text from PDF documents, which, as in current practice, are uploaded by filers, without penalty, and are intended to be the "official" filing artifacts. Almost all PDF files directly produced from word processing software contain extractable text. (The PTO states in the NPRM that more than 80 percent of filings use DOCX authoring tools; it's reasonable to extrapolate that a high fraction of non-drawing PDF files uploaded to EFS-Web could be directly produced by word processing software and could contain extractable text.) Many PDF files otherwise created also contain extractable text. As noted by other commenters, with one spurious exception

for a "fillable" form, the PTO historically has not used the extractable text already present in the PDF files uploaded via EFS-Web. Some filers have a practice of removing the extractable text. At least one motivation for doing so is that the PTO does not extract the text. This motivation could be avoided if the PTO, in consultation with users, announced a practice of using the extractable text in uploaded PDF documents.

2. The PTO could allow filers to directly upload both a PDF document, which, as in current practice, is intended to be the "official" filing artifact, and a separate file containing the convenience text, and extract the convenience text from the separate file. The convenience text file could be in DOCX format, in plain text format, or some other format that contains extractable text.
3. The PTO could allow filers to directly upload both a PDF document, which, as in current practice, is intended to be the "official" filing artifact, and a pre-conversion document in the original format of the filer's authoring system. The PTO could attempt to extract the convenience text from the PDF document and the pre-conversion document, and if the extracted text is unsatisfactory, the PTO could require the filer to submit the convenience text as a separate filing in a specified format such as DOCX or plain text.

Any of these options would be less restrictive, costly, risky, and otherwise burdensome to filers than would be the proposed rule. Filers would need not undertake the cost and risk of exhaustive comparison of the PTO's conversion specimen against their original document. Filers would also avoid the ancillary risks and costs arising therefrom, including the risk that the uploaded file might be capriciously rejected.

To the extent that the PTO does not usually undertake substantive examination until several months have elapsed after filing, the PTO should not require extractable text to be present until it is actually needed. Inasmuch as the PTO now considers a certified copy of a priority application to be timely if filed within the later of four months of filing and sixteen months of the claimed priority date, 37 CFR 1.55(f)(1), a similar period for filing extractable text would be appropriate.

It is believed by the undersigned that the PTO now allows filings in DOCX format in which which some content is not extractable text (e.g., DOCX files containing chemical or mathematical formulae represented as inline images rather than as structured text), and that the PTO has not proposed to change that practice in conjunction with the DOCX filing rule now under consideration. That the PTO now accepts and appears willing to continue to accept such DOCX filings indicates that the PTO and its processes can tolerate incomplete or imperfect text representations of the applica-

tion content, and therefore the PTO should require no more rigorous conformance of the convenience text to the "official" filing than it would for a DOCX filing. In particular, the PTO should not require a certification that separately-filed convenience text is identical to the "official" filing, or anything other than a good-faith representation by the filer that the "convenience text" is derived from the same source as the "official" filing.

CONCLUSION

The proposed DOCX filing rule imposes on filers costs (and risks) that are much greater than the PTO would save by implementing the rule. The PTO has not appropriately analyzed or acknowledged these costs and risks in the NPRM. The PTO could instead obtain usable text via other means that are less restrictive and less costly to filers, while still achieving all the benefits the PTO has alleged in the NPRM.

Respectfully submitted,

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