

September 30, 2019

Via E-Mail

ATTN: Brendan Hourigan
Mail Stop—Office of the Chief Financial Officer
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
fee.setting@uspto.gov

Re: Notice of proposed rulemaking – 84 FR 37398
“Setting and Adjusting Patent Fees During Fiscal Year 2020”

Dear Mr. Hourigan:

Our firm, Patterson Thuente Pedersen, P.A., is a mid-size IP boutique firm in Minnesota that has been an active participant in the patent profession for almost three decades and has been involved in the submission of many comments in response to USPTO rulemaking.¹

We are writing in response to the proposed Non-DOCX Application Filing Surcharge Fee of \$400 as detailed in the Notice of proposed rulemaking.² We are concerned about the timing of this proposal in light of the current state of the electronic submission system, and about the suitability of DOCX as a sole submission format.

We recognize the importance of accurately searchable patent data. Rather than imposing a surcharge fee as proposed for failure to submit a DOCX file as a way to encourage applicants to provide searchable text documents, we suggest a modified approach that would allow applicants an alternative option of filing a record copy of their application as a PDF document with a DOCX file. The DOCX file could be submitted or generated as an electronically searchable copy of the application.

¹ The comments submitted in this letter are made by the firm as a member of patent profession; however, these comments should not be attributed to any of our clients.

² *Setting and Adjusting Patent Fees During Fiscal Year 2020*, 84 FR 37398, July 31, 2019, as available at <https://www.federalregister.gov/documents/2019/07/31/2019-15727/setting-and-adjusting-patent-fees-during-fiscal-year-2020>.

The purported benefits of the DOCX format are questionable.

The DOCX format may not be the ideal approach for ingesting searchable data from submission to the Office. The proposed rule lists a number of supposed benefits of DOCX files, including that DOCX filing “improves document identification by automatic detection, allows for greater reuse of content, and provides improved searching for patent applications and submissions,” as well as enabling the Office to save approximately \$3.15 in OCR costs per application.³ These benefits are not particular to the DOCX file format, and are instead common to any text representation of a submitted document.

This is especially true given that neither EFS-Web nor Patent Center seem to be making use of any special “structured text” features of DOCX files. For example, while DOCX files support outlines, bookmarks, and other means of labeling sections within a document, EFS-Web relies on the presence of certain keywords to locate section headers⁴ — the tools are simply searching the text data for section headers such as “What is claimed is,” or “BRIEF DESCRIPTION OF THE DRAWINGS” to find the various application sections. This can be done with a .TXT (plain-text) file, or any other document that includes a text-based representation of the content.

PDF documents already contain text.

One format that natively supports text-based content is the Portable Document Format (PDF). Evidence for this exists in the current EFS-Web PDF submission guidelines, which require uploaded PDF documents to include embedded fonts for any text data.⁵ Currently, when practitioners upload PDF documents that include text data, the text is stripped by the online conversion process. The resulting “submitted” document then includes only image data. It is likely that this unnecessary PDF-to-image conversion is driving much of the OCR expense currently faced by the Office.

To be sure, many practitioners may upload PDFs without text data included. This can be addressed at the time of submission by automatically checking the PDF filed to determine if text data is included and requiring payment of the surcharge only when no text data is found. Ideally, this could be checked, like the presence of embedded fonts, after upload and before submission.

PDF documents are as secure as DOCX files.

Maintaining text data in PDFs will not introduce any security risks not already introduced by use of DOCX files. Macro viruses, and other similar embedded security risks are present in any file format that supports the inclusion of code to be executed by the viewing tool. Just as PDFs support the ability for embedded JavaScript code, DOCX files can include macros in Visual Basic for Applications (VBA), or executable data in Object Linking and Embedding (OLE). The

³ *Id.* ¶ 119, <https://www.federalregister.gov/d/2019-15727/p-119>.

⁴ *Quick Start Guide, Text Intake in EFS-Web*, 15 (September 2017), <https://www.uspto.gov/sites/default/files/documents/Quick%20Start%20Guide%20DOCX%20Intake.pdf?MURL=SubmitDOCX>.

⁵ *EFS-Web PDF Guidelines*, <https://www.uspto.gov/patents-application-process/applying-online/EFS-Web-pdf-guidelines>

DOCX uploading tools provided by EFS-Web and Patent Center should support stripping such content out of both PDF and DOCX uploads.

The DOCX submission process is significantly more time-intensive for practitioners.

The proposal references, but does not cite, a USPTO survey indicating that “over 80 percent of applicants author their patent applications in DOCX format in the normal course of business.”⁶ Almost every tool capable of creating a file in DOCX format, however, provides a simple way to save, convert, or export a corresponding PDF. Even if a DOCX file is authored in a tool that doesn’t have PDF export capabilities, a number of third-party tools at various price points include this capability. The conversion to PDF is, for most patent applicants, essentially seamless.

Submission in DOCX does not eliminate the need for a PDF to be created. During the September 24, 2019, Patent Quality Chat regarding DOCX filing, Mr. Richard Fernandez indicated that submitted DOCX files are converted to PDF in order to “support downstream systems.”⁷ When submitting in PDF format, using tools that have been validated by the applicant for fitness of use, the applicant can review the PDF document *prior* to uploading. This ability is lost with DOCX filings, where the applicant is required to accept any changes made by the USPTO’s conversion software, and agree that the created PDF will become the final submission. Applicants, therefore, are being required to perform an additional review of a document created by tools that they have not chosen and cannot have the opportunity to test. This greatly increases the burden of application submission.

It is not clear which goals of the eCommerce Modernization initiative that supposedly support a requirement for submission of DOCX files cannot also be met simply by using the data already provided in many PDF documents.

Electronic submissions should include a both a record and a search copy of the document.

We appreciate that the DOCX format does provide benefits for authoring documents for submission that include searchable text and other structured content.⁸ Regardless of which format(s) are supported however, we suggest an alternative approach to the current electronic submission regime, in which applicants are required to submit both a record copy *and* a searchable copy at the time of filing.

The applicant should be required to certify that the content of the searchable copy is materially identical to the content of the record copy. Where applicants choose to upload *only* a searchable

⁶ Proposed Rule ¶ 117, <https://www.federalregister.gov/d/2019-15727/p-117>.

⁷ In particular, it was mentioned that examiners review the documents in PDF format. Event details available at: <https://www.uspto.gov/about-us/events/patent-quality-chat-webinar-filing-structured-text-docx-smarter-way-file-0>, slides available at: https://www.uspto.gov/sites/default/files/documents/Quality_Chat_9_24_2019.pdf.

⁸ We look forward, for example, to the Office promulgating regulations and practices for how the submissions of documents including embedded content such as video, hyperlinks, and the like can be accommodated by the Office in the future.

copy (for example, in DOCX format) the already-existing electronic submission tools can generate a record (PDF) copy to be approved prior to submission. Those applicants who submit *only* a record copy without searchable text can be issued a missing parts requirement to subsequently provide a searchable copy but are still granted a provisional filing date based on the record copy of the application as submitted. A summary is provided in the table below.

Acceptable submission combinations		
Record document	Search document	Fee
Applicant-provided PDF	DOCX	No
USPTO-generated PDF	DOCX	No
Applicant-provided PDF	None	Yes
Applicant-provided PDF with embedded text		No

This approach provides a balance between the needs of the Office for searchable documents, the needs of applicants for the ability to control the content of submissions, and the needs of the patent system as a whole for a single, record, copy of a submission that can be relied upon through prosecution and future activities.

By requiring applicants to certify that the searchable copy is materially identical to the record copy, the Office and the public are able to rely on the accuracy of the searchable copy, and ideally the record copy will almost never need to be consulted. The existing penalties under 35 U.S.C. and 37 C.F.R. for improperly made certifications will act to discourage fraudulent or negligent inconsistencies. If, however, some error in conversion does occur the applicant can provide proof, as saved in the electronic submission system, of what was submitted.⁹ As an additional measure, applicants can be encouraged to disclose the tool(s) used to create the record or search copies at the time of submission. The burden of assuring the accuracy of submissions can, appropriately, continue to rest with the applicant without stripping the applicant of the ability to validate the conversion tools used.

This approach, in combination with updates to the electronic submission tools to retain text-data in PDF files and allow those files to be considered a submission of the searchable document, would also enable applicants to simply continue to submit PDF documents as is currently customary. The electronic submission tools can be configured to provide an error or warning where no text data is found in an uploaded PDF file. Submissions without appropriate text data can be afforded a filing date but a Notice of Missing Parts can be generated to give the applicant the option to either provide a searchable copy or pay a surcharge to cover the Office's costs of generating it.

⁹ A similar approach is currently supported for submissions containing drawings that are not black and white line drawings. While a converted black and white image is the most commonly accessed version, the original grayscale or color images are available in the Supplemental Complex Repository for Examiners (SCORE) database.

Our approach will help achieve the goals of the eCommerce Modernization (eMod) while enabling applicants to ensure the integrity of their submissions prior to upload. We urge the Office to consider this alternative to the requirement for DOCX-only submissions.

The Office’s DOCX submission tools are not ready for primetime.

The proposed rule indicates that the purpose of the surcharge is “[t]o encourage the filing of more applications in structured text.”¹⁰ Even if DOCX were the appropriate vehicle for structured text filing, the current state of DOCX submission support by the Office provides many disincentives for applicants to switch. If some of these disincentives were addressed, many applicants may be willing to voluntarily move to the DOCX format without the need for the penalty.

The DOCX submission process is only available for some submissions.

Neither EFS-Web nor Patent Center support the use of DOCX for any submission except for the Specification, Claims, and Abstracts of non-provisional utility patent applications. Application figures must still be submitted in PDF format, as must any amendments, responses to Office actions, or other “follow-on” submissions. This means that in order to use DOCX for submission, applicants must have an information technology and procedural infrastructure capable of supporting both DOCX and PDF formats.

The publicly available DOCX submission process is cumbersome.

Currently, for PDF submissions through EFS-Web a single, consecutively paginated, document can be uploaded and then split into Specification, Claims, and Abstract based on page numbers provided by the applicant. For DOCX submissions, applicants must not only manually create three separate documents, but they must also maintain consecutive page numbers across them. While this is supported in most DOCX authoring tools, it introduces a source of error because the page numbering must be based on data found in a separate file.

Similarly, numbering the paragraphs in the Specification is not currently required under 37 C.F.R. 1.52(b)(6) for submissions in PDF format, but it is required for DOCX submissions. While some authoring tools (such as Microsoft Word) do support adding paragraph numbering in the four-digit format required by the regulations, at least one noted free tool, LibreOffice, does not.

It is too soon to require a penalty of this size for Non-DOCX submissions.

Even assuming that no surcharge will be required until FY2021, applicants may not have sufficient time to transition to DOCX submissions given the current status of the two submission tools, EFS-Web and Patent Center.

¹⁰ Proposed Rule ¶ 117, <https://www.federalregister.gov/d/2019-15727/p-117>.

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EFS-Web is currently available to all applicants. Patent Center, which is intended to replace EFS-Web, is currently only available to a select group of alpha testers. Patent Center is not expected to enter a (still limited) beta test until sometime in calendar year 2020, and no timeframe has been provided for a universal release. The vast majority of applicants, especially those who do not have the resources to mitigate the risks inherent in early adoption, are therefore unable to use Patent Center, even in a testing capacity.

The proposed penalty of \$400 (for large entities) is also larger than the basic filing fee for utility patent applications and would result in a more than 23% increase in the fees due at filing.

Before such a large penalty is enacted for failure to use DOCX submissions, applicants must be granted more time to adapt their processes to take advantage of the new capability. The alternative approach of permitting submission of both a record copy and a searchable copy of an application as we suggest can provide a viable mechanism to help applicants transition to these new capabilities without prematurely penalizing applicants, especially in situations where the available tools may not be ready or able to accommodate special cases involving complicated submissions.

Sincerely,

Patterson Thuente Pedersen, P.A.

/Brad D. Pedersen/

Brad D. Pedersen, *Shareholder*

/Jay A. Erstling/

Jay A. Erstling, *Of Counsel*

/O. Jumi Kassim/

O. Jumi Kassim, *Staff Attorney*