

New Pilot Program for Submitting Documents in Text Format in New Utility Patent Applications

I. Summary

The United States Patent and Trademark Office (USPTO) will be conducting a pilot program from June 2018 through November 2018, referred to as the Patent Center Text Pilot Program. Applicants participating in the alpha release of Patent Center will be able to submit new utility nonprovisional applications in text format by uploading and submitting a single DOCX file that contains the specification, including claims and abstract. Submission of these parts of the application in DOCX allows for certain errors to be detected and corrected by applicant prior to filing of the application, which will improve the data quality of the application. Applicants will also be able to subsequently access the DOCX files for their future convenience.

II. Background

In 2015, the USPTO began the eCommerce Modernization (eMod) Project which aims to improve the electronic patent application process for patent applicants by modernizing the USPTO's electronic filing and viewing systems. As part of the eMod Project, a new system called Patent Center is being developed and implemented in phases. Patent Center combines both electronic filing and viewing features into a unified system. Patent Center will eventually replace the current electronic filing system, EFS-Web, and the current viewing system, Patent Application Information Retrieval (PAIR). Patent Center provides many benefits including a single interface for filing and managing patent applications, and increased functionality. The alpha release of Patent Center began in March 2018 with a limited number of participants.

The USPTO conducted an eMod Text Pilot Program in EFS-Web and Private PAIR from August 2016 until September 2017, in which patent applicants participating in the pilot program submitted text-based documents in DOCX for the specification, including claims and abstract, of a new utility nonprovisional application. Applicants in the pilot program submitted three separate sections, namely (1) the specification excluding claims and abstract, (2) claims, and (3) abstract, in DOCX, and the USPTO created the corresponding PDF documents that were then submitted by applicant as part of the application filing. Since September 2017, all registered users of EFS-Web are able to submit a new utility nonprovisional application with the specification, including claims and abstract, in three separate sections in DOCX. Submission of the specification, including claims and abstract, in DOCX allows for certain errors to be detected and corrected prior to filing of the application, which will improve the data quality of the application. Compared to uploading a PDF, a DOCX file allows for content-based validation, such as claims validation for missing claim numbering or abstract validation for word count and paragraph

count. Structured text, such as mathematical equations and tables, are preserved which increases image and data quality. Document indexing is automatic because the system is able to determine the proper document code based on text patterns detected in the headings within the document. This helps improve the accuracy of the document code assignments. In the future, structured text will help build technical foundations to improve the publication process.

A Quick Start Guide on filing documents in DOCX via EFS-Web (titled “Quick Start Guide for Text Intake in EFS-Web”) is available on the USPTO website at <https://www.uspto.gov/submitdocx>.

The USPTO received feedback from users suggesting that applicants be permitted to submit a single DOCX file that contains the specification, including claims and abstract. Accordingly, the USPTO has decided to conduct another pilot program, namely the Patent Center Text Pilot Program to test this feature.

III. Details of the Patent Center Text Pilot Program

The Patent Center Text Pilot Program is scheduled to run from June 2018 through November 2018. The Patent Center Text Pilot Program is being incorporated into the alpha release of Patent Center and may be extended into the beta release of Patent Center with or without further notice. The USPTO may terminate the Patent Center Text Pilot Program at any time.

Uploading and Validation of DOCX file

Applicants participating in the alpha release (or the beta release, if applicable) of Patent Center will be able to submit new utility nonprovisional applications in DOCX by uploading and submitting a single DOCX file that contains the specification, including claims and abstract, in Patent Center. This will reduce the amount of work applicants need to do in order to submit the specification, including claims and abstract, in DOCX by eliminating the need for applicants to create three separate DOCX files for each of the three sections with consecutive numbering throughout the three files.

After the DOCX file is uploaded into Patent Center, the DOCX file will be validated and, if there are no errors or warnings (discussed in the above-mentioned Quick Start Guide), a corresponding PDF document will be generated. Applicant would then review the PDF document for accuracy and to confirm that the application is ready to be filed, and then complete the filing of the application. If there are any errors or warnings, Patent Center will inform the applicant in an auto-generated feedback document. Applicant would need to correct any errors and would also have the opportunity to make additional changes in view of any warnings. Once any errors are corrected and any additional changes are made, applicant would upload the revised DOCX file into Patent Center and, assuming no new errors have been introduced, a corresponding PDF

document will be generated. Applicant should then review the PDF document for accuracy to confirm that the application is ready to be filed. Applicant would then complete the filing of the application by submitting all necessary fees and documents including the single DOCX file and the corresponding PDF document in Patent Center. The single DOCX file will be split into three separate DOCX files (specification, claims, abstract) and the corresponding PDF documents will be generated, which will be accessible for viewing in Patent Center by applicant after filing of the application.

Waiver of Requirement for Consecutive Page Numbering

The USPTO has determined that it is not possible in this pilot program to reliably maintain consecutive page numbering for the entire specification. Current 37 CFR 1.52(b)(5), however, provides that, for applications other than reissue applications, “the pages of the specification including claims and abstract must be numbered consecutively, starting with 1.” Accordingly, for applications submitted via the Patent Center Text Pilot Program, the USPTO is hereby waiving the requirement in 37 CFR 1.52(b)(5) that the pages of the specification, including claims and abstract, be consecutively numbered starting with the number 1. The USPTO will permit each of the three separate sections in the form of the three separate PDF documents generated by the USPTO for the specification, including claims and abstract, to start with page number 1, rather than having consecutive page numbering extending throughout all three sections. It is suggested that applicants should provide consecutive page numbering in the single DOCX file even though that page numbering will not be maintained in the three separate DOCX files and the corresponding PDF documents generated by the USPTO.

Paragraph Numbering Requirement

Participants in the Patent Center Text Pilot Program are required to number the paragraphs of the specification (other than the claims or abstract) in accordance with the optional paragraph numbering format set forth in 37 CFR 1.52(b)(6). This is necessary in order to facilitate the making of amendments to the specification by replacement paragraph.

Additional Information

The USPTO will gather data and feedback from participants in the Patent Center Text Pilot Program and make a determination as to whether this feature should be implemented on a permanent basis. Regardless of whether this feature is made permanent, Patent Center will go into production after the conclusion of the beta release.

IV. Contact Information

If you would like to participate in the alpha release of Patent Center and the Patent Center Text Pilot Program, please send a request to eMod@uspto.gov. The USPTO will contact you and provide you with additional information regarding participation.

For further information regarding the eMod project, please see <https://www.uspto.gov/patent/initiatives/emod-ecommerce-modernization>.

Questions or comments may be sent to eMod@uspto.gov or directed to the Patent Electronic Business Center at 866-217-9197.

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