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Re: Comments in response to “Patent and Trademark Office Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; DOCX Submission Requirements, published at 88 FR 37029 (6/6/2023) (hereinafter the “Request.”)

To: Federal Rulemaking Portal: <https://www.regulations.gov>

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My comments in response to the Request follow.

I am a patent attorney practicing before the Patent and Trademark Office (herein after the “PTO”). I have substantial experience with filing documents using the PTO’s various online filing systems, including the USPTO’s online filing systems “EFS-Web” and “Patent Center” for filing patent applications. Both systems provide the option for filing the specification, claims, and abstract of a patent application as either PDF documents or DOCX documents. My comments are informed by my study of and actual use of the USPTO filing systems, the USPTO’s publications in the FR and on the USPTO.gov website regarding its filing systems, specifically including all such publications referring to filing in “DOCX” and filing in “PDF.”

The Request states:

As specified in § 1.16(u), the fee is due for any application filed under 35 U.S.C. 111 for an original patent—except design, plant, or provisional applications—where the specification, claims, and/or abstract do not conform to the USPTO requirements for submission in the DOCX format.

RESPONSE: That statement contains an erroneous assertion of fact. Specifically the statement “the DOCX format” assumes there is only one “DOCX format.” In fact, there are over fifty different “DOCX” formats. Each one of Microsoft’s 49 revisions of its original MS-DOCX file format by default saves an file open in Microsoft Word in a file having a file name extension “.DOCX.”

In the FR publication of the Final Rule for rule 37 CFR 1.16(u), the PTO erroneously stated that “DOCX” is “part of” the OOXML public standard for word processing documents. That statement was also incorrect. The OOXML standard does not require that word processing documents meeting the standard have a “.docx” extension or in any other way rely upon the

sequence of characters docx. Instead, that standard contains in a few non-normative examples the recitation “docx.” Those are examples only, and form no part of the OOXML standard. This is significant because the PTO’s rule promulgation for 37 CFR 1.16(u) contains no other identification of what the PTO means by “DOCX.”

It appears to me from review of the PTO’s records regarding its DOCX initiative that the PTO changes from its initial “Text2PTO” initiative in 2012 through today that the PTO misunderstood DOCX to mean a single file format which it is not, and to refer to a single public standard which it does not.

The requests states:

As specified in § 1.16(u), the fee is due for any application filed under 35 U.S.C. 111 for an original patent— except design, plant, or provisional applications—where the specification, claims, and/or abstract do not conform to the USPTO requirements for submission in the DOCX format. Therefore, the fee is due for nonprovisional utility applications filed under 35 U.S.C. 111, including continuing applications, that are not filed in the DOCX format.

RESPONSE: That statement omits the critical qualifying information that the USPTO has not defined the “USPTO requirements for submission in the DOCX format.” The reference to “DOCX format” does not define that requirement because, as noted “DOCX” does not define a single file format. Nor has the USPTO otherwise notified the public of what those requirements are. Specifically, the PTO has not specified the singular DOCX file format the PTO uses to read the DOCX file provided by the applicant. Accordingly, an applicant can not know if their file saved in one of the dozens of file formats resulting in a file having the file extension “.docx” will result in the PTO software recognizing from that file the information the applicant saved in that file.

The Request states:

The USPTO then expanded the ability to file patent applications in the DOCX format in EFS-Web to all users in September 2017. In 2018, the USPTO launched the Patent Center and conducted the Patent Center Text Pilot Program from June 2018 through April 2020. All applicants have been able to file applications in the DOCX format in the Patent Center since April 2020.

RESPONSE: That statement critical omits critical qualifying information. Specifically, it omits the critical fact that the PTO does not allow an applicant to file the DOCX document the applicant prepares. Instead, the PTO filing systems implementing rule 1.16(u) open and revise an applicants DOCX file, save that work as a new DOCX file, and allow the applicant the opportunity only to file that revised application. Consequently, the PTO software interprets content of the applicant’s DOCX file based upon the PTO’s DOCX file reader software, which may change the contents as a result of the difference in file formats used by the applicant’s file writing software, and the PTO’s file reading software to write and read, respectively, the applicant’s DOCX file. Moreover, the PTO has admitted in the public record that its software does modify the information contained in the applicant’s original DOCX document, for example by removing text highlights, paragraph

number, and meta data.

In summary, while it is true that the PTO allows the filing of patent applications in both EFS-Web and Patent Center in DOCX format, it is NOT true that the PTO allows the applicants to file the “DOCX” files prepared by the applicants that disclose their inventions.

The Request states:

The items in this proposed new information collection relate solely to the impacts of the § 1.16(u) non-DOCX filing surcharge fee on the filing of nonprovisional utility applications under 35 U.S.C. 111, including continuing applications. In particular, this proposed new information collection accounts for the § 1.16(u) non-DOCX filing surcharge fee itself, as well as an additional 30 minutes of time to accommodate the (I) extra review that some respondents may undertake as they start to become more familiar with the DOCX format and (ii) submission of the back-up applicant-generated PDF that some respondents will opt to submit.

RESPONSE: This statement implies that “extra review that some respondents may undertake” will be unnecessary after applicants “become more familiar with the DOCX format.” That implication is not true. This is, in part, because the extra review is caused by the PTO’s implementation of reading and writing the applicant’s DOCX file using software using a file format that is secret-to-the-PTO and therefore can cause changes to the informational content of a DOCX file written with a different file format. And because the PTO admittedly changes other things about the contents of the application. Those potential changes in content required the applicant to conduct a review of the PTO’s DOCX file for each application, before committing (as required by the PTO’s online filing interface) to filing of the PTO’s revised DOCX file.

This statement also asserts that “the (I) extra review that some respondents may undertake as they start to become more familiar with the DOCX format and (ii) submission of the back-up applicant-generated PDF that some respondents will opt to submit” amounts to 30 minutes. The 30 minutes is speculative, and ignores certain factors.

Specifically, the assertion that the extra time for DOCX filing (relative to PDF filing) amounts to 30 minutes fails to account for reviewing and revising a DOCX file that fails the PTO’s validations. A validation failure halts the filing process mid-stream, requiring the applicant revise the DOCX file, and start the filing process over.

How to revise a DOCX that failed validation is often opaque. The PTO provides no straightforward way to do that. Instead, the filer must figure out what the PTO’s error and warning messages mean in the context of the DOCX file format. And then find a way to revise the DOCX without changing the information content and yet avoiding the validation failure. This activity is not something the results in a rapid learning curve on how to fix. This is because many filers receive draft application documents from third parties, such as inventors and foreign patent law firms, in many various forms. Many of the intricacies of the file format options in the received drafts affect whether the drafts will fail the PTO’s DOCX validation requirements. Therefore, a significant percentage of attempts to file DOCX now fail. And because application filers receive applications to file from many different sources, it is unrealistic to expect those sources to learn

and adopt DOCX file formats and configurations to meet the PTO filing systems' validations rules.

Furthermore, each attempt to review and fix a validation error, is in addition to the time for reviewing the PTO's generated DOCX file against the DOCX file the applicant uploaded for filing. This is the review to confirm identity of content of the PTO generated DOCX to the applicant uploaded DOCX, when there are no validation errors, that is, when the PTO filing system allows one to proceed to filing.

In summary, the PTO's inference that the excess review time resulting from DOCX filing (relative to PDF filing) will diminish over time is unjustified, and the PTO's estimate of 30 minutes for review, fails to account for the fraction of DOCX filed applications that the PTO's online filing system rejects for failing PTO filing system validations.

The Request states:

...The USPTO expects the DOCX format adoption rate to steadily increase as the public more fully comprehends the nature of, and how to comply with, the format. Thus, the USPTO expects the number of respondents that will pay the non-DOCX filing surcharge fee to decrease by the first renewal of this collection.

RESPONSE: I do not share the PTO's expectation. Instead, I expect the adoption rate for DOCX will stagnate about where it is now.

Moreover, the PTO's factual basis for this statement of its expectation is also flawed. This is because the public cannot "more fully comprehend[] ... the format" because the PTO has not specified "the format." The PTO has not specified which of the many file formats writing files with the filename extension ".docx" is "the" file format to which the PTO refers.

The two factors (1) the PTO reading the applicant's file and writing a new file based thereupon, intentionally changing certain content in the PTO's newly written file, and (2) requiring the applicant to proceed to filing with that revised file, make the PTO's current requirements for filing in DOCX format unreliable. Specifically, the applicant cannot know if the revised file reflects the same informational content, and therefore the applicant must review the revised DOCX file, for each application, prior to agreeing to allow the PTO to file the PTO-revised DOCX file.

The public recognizes the risk inherent in allowing the PTO to tamper with a DOCX file generated by the applicant. Therefore, the public's need to review the PTO's revised DOCX against the applicant's uploaded file, will remain indefinitely. Therefore, the time required to review the PTO generated DOCX file and the need to conduct that review, will not decrease "as the public more fully comprehends the nature of, and how to comply with, the format."

Applicant's will weigh the total costs in terms of time and risk, to filing in DOCX format. The time costs include the time cost for the review noted in the Request, but in addition the time costs for attending to validation rejections of DOCX files. There are additional costs due the possibility of a failure to spot an error generated by the PTO DOCX file in that review process, thereby resulting in filing of something other than the invention intended by the applicant and (for patent practitioners who make up the vast majority of filers) cost of the loss in good will, reputation, and potential malpractice resulting from such an error.

The applicant will weigh those total costs against the \$400 surcharge for non-DOCX (that is PDF) filings. Consequently, do not share the PTO's expectation that DOCX adoption rate will

substantially increase over time.

The Request states:

Additionally, the USPTO expects the frequency and amount of any extra review time to decrease as respondents become more comfortable with the DOCX filing process.

For the reasons noted above, “the frequency” of review will remain constant, indefinitely. Each filing will require review of the PTO generated DOCX file, before filing. Further, PTO’s identification of extra time for DOCX filings fails to account for the extra time associated with uploaded DOCX files that fail the PTO filing systems’ validations.

Very truly yours,  
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