

Another Trap for the Unwary, Patent Center, the Legal Framework, and DOCX

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## **I. Introduction**

A long time ago the PTO stood up the web based EFS-Web, for electronic submission of documents into the official files for US patent applications. The patent bar has been using that system for about two decades. Millions of documents have been filed using EFS-Web.

Along the way, the PTO promulgated a Legal Framework for Electronic Submissions using EFS-Web. See my prior articles summarizing the Legal Framework:

["Certificates of Transmission and Priority Mail Express within the Legal Framework for USPTO Electronic Submissions" Rick Neifeld, June 14, 2021.](#)

["Review of Legal Framework for Electronic Filing System-Web \(EFS-Web\), 74 FR 55200-211 \(2009\)" Rick Neifeld, October 27, 2009.](#)

The Legal Framework provides an important safeguard to users that file documents using EFS-Web. Specifically, it states that in case the USPTO loses, mangles, or changes anything the applicant submits, a copy of the Electronic Acknowledgment (EAR) for what the applicant filed, showing the name of the file submitted, and a copy of the file having that name, are prima facie evidence that the file was previously submitted. Because of that statement, filers have rested comfortably that, so long as they kept their EAR and the file submitted, they avoided risk of loss due to PTO losing, mangling, or changing anything the submitted file.

And then came "Patent Center." As many know, Patent Center refers to the USPTO's new electronic filing system that is set to supercede EFS-Web. And eventually the USPTO will retire EFS-Web, leaving only Patent Center for electronic submission of US patent applications.

The PTO has been pushing the public to use Patent Center for the last few years, despite Patent Center's many known deficiencies, such as those posted on the Oppedahl Law Firm's Patentcenter Trouble Tickets List, located here: <https://patentcenter-tickets.oppedahl.com/>

Patent Center is, among other things, a mode of Electronic Filing. So logically the Legal Framework for electronic filing applies, because Patent Center is just another mode of Electronic filing. Or, so one would assume.

## **II. The USPTO's Current Legal Framework Does Not Apply to Patent Center**

The most recent revision to the USPTO's Legal Framework is dated October 23, 2019 and appears here:

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<sup>1</sup>My thanks to Brian Siritzky, for his review of a draft of this paper and confirmation of factual statements.

## LEGAL FRAMEWORK FOR PATENT ELECTRONIC SYSTEM

Buried on page four of this version of the Legal Framework, is the statement "The submission of documents through Patent Center is not addressed by this Legal Framework, but instead will be addressed by a separate Legal Framework."

This means the Legal Framework does not apply to any document submitted using Patent Center. This means that the Legal Framework's safeguard that the EAR and file named in the EAR serve as prima facie evidence of authenticity of a previously submitted document do not apply to any document submitted using Patent Center.

### **III. The Additional Risk of Loss For Filing DOCX Documents in Patent Center**

If the PTO converts a DOCX file submitted in Patent Center to produce a different DOCX file and saves that different DOCX file into the official file for an application, then the filer cannot, later in time, rely upon their original DOCX file and the EAR for that filing as proof of prior submission.

If the PTO converts a DOCX file submitted in Patent Center to produce a PDF file and saves that PDF file into the official file for an application, and that PDF shows images that are substantively different from the images the filer sees when viewing their DOCX file, then the filer cannot rely, later in time, upon their original DOCX file and the EAR for that filing as proof of prior submission of that DOCX file.

Users report that Patent Center converts a DOCX file submitted in Patent Center to produce a different DOCX file and saves that different DOCX file into the official file for an application.

Users report that Patent Center produces a PDF file and saves that PDF file into the official file for an application, in response to a user filing a DOCX file in Patent Center for that application.

### **IV. The PTO's Hash Values Are Not What You Think**

A hash function applied to a file provides a value, that is a hash value. Hash values depend upon the content of a file to which the hash function is applied. Files that are not exactly identical are overwhelmingly likely to produce different hash values (when the same hash function is applied to them).

Patent Center provides a hash value, in response to a file being submitted using Patent Center.

Users report that the hash value they obtain from Patent Center for a file submitted in Patent Center is not the same hash value they obtain when applying the hash function for their file on their computer. And I personally confirmed this fact. In other words, the file that Patent Center uses to generate the hash value is not the file the user submitted to the PTO, using Patent Center.

Consequently, the hash value that Patent Center provides for a submitted file, *cannot* be used as evidence to prove that a file the user resubmits to the PTO (in case the PTO lost,

mangled, or changed anything in the submitted file) is the same file the user previously submitted.

I note that the PTO said quite the opposite in promulgating its non-DOCX filing surcharge rule (rule 37 CFR 1.16(u)). In fact, in responding to comments expressing concern over the PTO's generated hash value, see comment 70, at 85 FR 46960, upper left column, the PTO assured the patent bar that:

The message digest (hash) is generated to ensure non-repudiation of the DOCX. The benefit of this generated message digest to *the applicant* is that they can verify that the submitted DOCX is identical to the file in *their* records.

What this means in simple English is that the PTO promised that the hash value, what the PTO refers to as "message digest (hash)," would be the result of applying the hash function to the file the user submitted. So that the user could prove to the PTO, that the document the user stored on the user's own computer system was the same document previously submitted to the PTO. If needed, to effect a correction to whatever mangled version of the document the PTO stored in the PTO's official file.

Sadly, users report that Patent Center, in fact, mangles DOCX documents submitted into it, and then generates a hash of that mangled document. In some cases, the mangling may not substantively change the information, but in other cases it may. In any case, the hash value that Patent Center provides cannot "ensure non-repudiation" of the document the user filed. Because that value a hash value of the mangled document and therefore it overwhelmingly likely not the hash value obtained by applying the same hash function to the document the user actually originally filed using Patent Center.

And as many now understand, unlike PDF, DOCX does not claim to maintain image fidelity. And it is image fidelity, what one sees to be the electronic document, that is the information the document conveys to humans. Many different computer programs can save files with the extension ".DOCX." However, they do not all display, that is, generate the same image, when rendering such a file. So what information any particular ".DOCX" file conveys depends upon both the software program used to save it and the software program used to render it. Different programs may result in different images for the same ".DOCX" file.

#### **IV. Summary And Conclusion**

When using Patent Center to submit documents, the EAR does not provide prima facie evidence that a file having the name appearing in an EAR is identical to the previously submitted file. When filing documents in Patent Center, the documents Patent Center stores in the official file and the hash values that Patent Center provides for those documents are not the documents submitted by the application and the hash values that will be generated from the document the filer submitted are not the same as the hash values provided to the filer by Patent Center. Therefore, there is currently no way to "ensure non-repudiation" of a document filed using Patent Center. And particularly for DOCX documents filed using Patent Center, because Patent Center is known to mangle DOCX documents. The inability to "ensure non-repudiation" may result in the loss of a filing date, in case Patent Center mangles a new application, and that risk is increased for

applications filed as DOCX documents. Thus, using Patent Center to file new applications, and doing so using DOCX files, presents a foreseeable risk of loss of rights.