EFS Filing Expands Beyond pdf Format

By Rick Neifeld, Neifeld IP Law, PC,

I.   Introduction

Since inception, the USPTO's Electronic Filing System, EFS-Web, or just EFS, has only allowed document filing in pdf format (with limited exceptions).

Today, September 12, 2017, the USPTO announced expansion of the EFS filing options beyond pdf, into docx format. Upon review, I find the following to be the most significant issues raised by the ability to file docx documents. I have highlighted in red what I believe to be most relevant to EFS users.

II.   Option to File Text Portions of an Application in docx Format

The USPTO's guidance in "Quick Start Guide DOCX Intake.pdf" states:

3.3.1 Attach Application Parts – Specification, Claims and Abstract
        Application Parts (specifically Specification, Claims, and Abstract) may be submitted in text format. These documents must be attached individually, and filers are limited to 3 .docx files.
        Please note, when attaching individual files, page numbering must be consecutive starting with 1, compliant with 37 C.F.R. § 1.52 (b).
        Preliminary amendments (see 37 C.F.R. § 1.115) may not be submitted.

III.   Formal Issues

The USPTO's guidance in "Quick Start Guide DOCX Intake.pdf" states:

        The following items within a document will generate a warning message, viewable at the time of upload and on the acknowledgement receipt:
        • Track changes*
        • Comments*
        • Bookmarks*
        • Hidden Items*
        • Continuous line numbering*
        • Text decorations*
        • Unused invalid fonts*
        • Unnecessary document properties*
        • Abstract word count over 150
        • Unsupported OLE Objects (Supported OLE Objects include Visio.Drawing.11, Equation.DSMT4, ACD.ChemSketch.20, ChemDraw.Document.6.0, Equation.3)

An asterisk indicates the system will automatically make changes to the document. Please review the generated files prior to submission.

The following items will generate an error message and you will not be able to continue unless it is corrected:
- Duplicate application parts
- Invalid Page Size – cannot exceed Letter or A4
- Contains Content control
- Contains Custom XML
- Invalid font

IV.   Automatic Document Description Detection

The USPTO's guidance in "Quick Start Guide DOCX Intake.pdf" states:

4.1 DOCX Key Words for Section Headers
        EFS-Web can automatically detect the document description of the attached DOCX if the following key words are used: [See appendix 4 of the quick start guide]

V.   Conclusion

The option to file text documents of an application in docx format opens up some interesting possibilities. However, there will be a learning curve, as users become aware of the unspecified automatic changes and new formal requirements applicable to docx documents.