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December 23, 2020

To: Office of Information and Regulatory Affairs, OMB, Executive Office of the President,  
via  
[https://www.reginfo.gov/public/do/PRA/icrPublicCommentRequest?ref\\_nbr=202011-0651-006](https://www.reginfo.gov/public/do/PRA/icrPublicCommentRequest?ref_nbr=202011-0651-006)

Re: Comments respecting the “non-DOCX” surcharge for  
initial patent applications, in response to:

**TITLE: Initial Patent Applications**  
OMB Control 0651-0032  
ICR Ref 202011-0651-006

Dear OMB:

I am a patent attorney with about 30 years of experience in preparation and filing of initial patent applications and filing and prosecution of other proceedings in the United States Patent and Trademark Office (herein after “Agency”).

I also from time to time teach courses touching upon the filing mechanisms, regulatory requirements, and legal underpinnings therefore. See generally <https://neifeld.com/advidx.html> for a list of related publications.

My comments are limited to Agency’s “non-DOCX” surcharge for initial patent applications. The Agency had published “Setting and Adjusting Patent Fees During Fiscal Year 2020,” Docket No. PTO–P–2018–0031, RIN 0651–AD31, at 85 FR 46932, Vol. 85, No. 149, 8/3/2020. This is a final rule, promulgating the “non-DOCX” surcharge for initial patent applications. See 37 CFR 1.16(u). The Agency will apply this surcharge to any initial patent application not filed in “DOCX” format

The Agency failed to consider that “DOCX” is not a reliable cross-platform file format. The non-DOCX surcharge presumptively favors use of Microsoft Word instead of other software, for preparation and filing of initial patent applications. Hence surcharge favors products of one vendor, Microsoft Corporation, over all others.

In response to Comment 59, the Agency stated that:

Response: DOCX is a word-processing file format that is part of Office Open

XML (OOXML), an XML-based open standard approved by the Ecma International consortium and subsequently by the ISO/IEC joint technical committee. For more information about the OOXML standard, please see: •ECMA-376 at <http://www.ecma-international.org/publications/standards/Ecma-376.htm> •ISO/IEC 29500 at <https://www.iso.org/committee/45374/x/catalogue/> •NIST votes for U.S. Approval of OOXML at <https://www.nist.gov/news-events/news/2008/03/nist-votes-us-approval-m>

Comment 59 reads:

Comment 59: Two commenters stated that there is no single DOCX standard to which Microsoft Word and the other word processors are all compliant.

The Agency's response to Comment 59 did not address the concern raised in Comment 59.

Here is an example illustrating that concern. Create the character, Arab script, 14.3, which displays as (“ = ”) when generated in WordPerfect, and save the file using WordPerfect in “docx” format, and close the file. Open the same file using Microsoft Word. The resulting file shows “\$” instead of “ = ”. Consequently, a character saved in a “docx” format in one word processing program does not display as the same character in Microsoft Word.

The *consequence* of this failure to faithfully reproduce characters saved in “docx” format in one word processing program when opened using another word processing program are far reaching. It means that a user cannot trust documents produced in non Microsoft Word programs from faithfully reproducing characters when opened in Microsoft Word. This is magnified for patent application initial filings because failure to disclose the invention in the initial filing will result in loss of rights in most situations. Patent application initial filings cannot be filed again at a later date to avoid mistakes upon filing and therefore defective filings showing the wrong characters are not correctable error.

This difference in display in WordPerfect and Word means that the underlying definitions in the different word processing programs are different. And this means that patent applicants cannot rely upon non-Microsoft Word programs, for initial patent application filings. This is because everyone presumes that the Office Open XML “standard” cited by the Agency, is a standard based upon Microsoft Word. And therefore it is only Microsoft Word generated “docx” documents that a user can rely upon to be faithfully reproduced by the USPTO after being filed with the USPTO.

This concern has two detrimental consequences.

First, it imposes costs upon those that do not rely upon Microsoft Word. These are costs in the time required to visually review non-Microsoft Word generated documents once opened in Microsoft Word to ensure the characters entered upon initial generation of the document are reproduced in Word, or the costs of learning to use and purchase Microsoft Word, and the cost of using Microsoft Word in lieu of whatever word processor program a user is currently proficient

in.

Second, these costs also include the societal cost of promulgating the monopolistic power of Microsoft Word.

In summary, the Agency has promulgated a penalty for not using and being proficient with Microsoft Word, at the expensive of competing word processing products, which harms the public.

I estimate the additional cost to prepare each initial patent application using a non Microsoft Word program, compared to using Microsoft Word, at \$200, that is, at about one half hour of patent attorney review time.

Assuming 20 percent of patent applications are initially prepared in non Microsoft Word, and assuming 300,000 applications annually, that imposes an annual cost on the public of \$60,000,000.

Very truly yours,

Richard Neifeld,  
President, Neifeld IP Law, PC

A handwritten signature in black ink, appearing to read 'Rick Neifeld', written over the typed name and title.

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