ONE HUNDRED SIX PATENT PRACTITIONERS

By USPS 9405503699300267384737

June 7, 2022

Andrew I. Faile
Acting Commissioner for Patents
USPTO

Dear Acting Commissioner Faile:

This letter comes to you from one hundred and six patent practitioners, most of whom are members of the *EFS-Web listserv*. The *EFS-Web listserv* is a group of users of the USPTO's patent e-filing systems, and the group include over five hundred attorneys and agents registered to practice before the USPTO. The signers of this letter, directly or through their law firms or corporations, have collectively prosecuted more than fifty thousand US patents to issuance in the past ten years. The signers of this letter, directly or through their law firms or corporations, have collectively paid more than one hundred twenty-five million dollars in fees to the USPTO in the past ten years. Our chief communication goal in this letter is to help you and your colleagues at the USPTO appreciate the profound inadequacy of the "temporary" Auxiliary PDF approach set forth in the USPTO's Federal Register notice of April 28, 2022 (*Filing Patent Applications in DOCX Format*, 87 FR 25226).

It is important for us to state at the outset that this letter does not try to address, and does not address, the most fundamental question, namely whether DOCX is an appropriate format for the USPTO to use for the purpose of receiving newly filed US patent applications in character-based form. While we do generally support USPTO's goals of receiving character-based information from patent applicants and patent practitioners, we emphasize that signing of this letter is *not* intended as an indication to the USPTO that the signer endorses or approves of DOCX as a

patent application filing format. This letter is directed only to pointing out two specific and profound misunderstandings on the part of the USPTO about what would be required in a "protective PDF" filing approach, if such an approach were to have any hope of meaningfully reducing the harms and risks that will befall applicants and practitioners in a DOCX patent application filing environment.

In summary, the two profound misunderstandings on the part of the USPTO inherent in the approach set forth in the April 28, 2022 Federal Register notice present themselves in the following two points:

- The approach set forth in the notice contemplates that any petition asking for a correction of a USPTO error in the rendering of a DOCX-formatted US patent application (based upon a comparison of the USPTO's rendering with the applicant's protective PDF document) would be filed on or before December 31, 2022. This is absolutely unacceptable. The opportunity for the filing of such a petition absolutely must be available to the applicant for at least as long as the life of the granted patent plus the statute of limitations period.
- The approach set forth in the notice contemplates that the provision of a protective PDF document would only be available in the special case of a DOCX-formatted US patent application having a filing date on or before December 31, 2022. The approach contemplates that for any DOCX-formatted US patent application having a filing date after December 31, 2022, the applicant would *not be permitted* to provide a protective PDF document. This is absolutely unacceptable. The opportunity for the provision of a protective PDF document along with the filing of a DOCX-formatted US patent application must be preserved for however long the USPTO chooses to require the filing of US patent applications in a DOCX format.

Having summarized the two chief misunderstandings that permeate the April 28, 2022 Federal Register notice, we will now provide some background and will then discuss the two misunderstandings in greater detail.

When WIPO first introduced XML filing (character-based filing) for PCT applications, some of the signers of this letter were among the very first to carry out such XML filings of PCT applications. From the very beginning of WIPO's initiative for XML filing of PCT applications, WIPO was sensitive to the concerns of applicants as to whether mistakes might occur in the rendering or processing of the XML version of a PCT patent application. From the very beginning of the initiative, WIPO provided rules so that an applicant could file a protective version of the patent application. In the PCT rules, this protective version is termed a "pre-conversion format" document. The applicant is not forced by the patent office to adopt any particular fonts or word processor formats, and is not, for example, required to use Microsoft Word or any particular variant of a DOCX format. The applicant is able to use whatever word processor the applicant prefers and trusts. The protective version filed by the applicant (the "pre-conversion format" document) is permitted to be in whatever document format the applicant trusts to be authoritative.

The PCT rules provide for a correction procedure before the International Bureau. The natural question is how much time is available to the applicant to detect such problems and to carry out such corrections according to that procedure? The Treaty and rules of the PCT give the International Bureau jurisdiction over the procedural aspects of a PCT application for only a limited time, namely until thirty months after the priority date. As a consequence, this is the amount of time available to the applicant for such corrections before the IB. We wish the time available could be longer, but we recognize that the IB has only this limited thirty-month period within which to grant such corrective relief. (The applicant would also have the prospect of pursuing corrective relief at later times in the national or regional phase, or in court proceedings.)

It will be noted that WIPO's way of incentivizing the applicant to provide a character-based patent application (here, XML) is nice to applicants: WIPO offers a *filing fee reduction* (here, 100 Swiss Francs, or about $107 at current exchange rates). This contrasts with the approach of the USPTO, which is instead to try to bring about the desired applicant behavior by means of a *penalty* (here, $400). It will also be noted that the actual avoided cost to the USPTO when it does not have to carry out OCR (optical character recognition) on a patent application is, by USPTO's

own admission, only $3.15 per document. It seems to us that it is "friendlier" if an Office uses a filing fee reduction rather than a penalty as its way of trying to get what it wants.

The USPTO first started pushing its DOCX initiative upon the practitioner community some three years ago. From the very outset, the practitioner community repeatedly urged the USPTO to take WIPO's example and to permit the applicant to file a protective version of the patent application along with the DOCX-formatted version of the patent application. A certain letter of ***Seventy-Three Patent Practitioners*** to Brendan Hourigan of the USPTO, dated September 17, 2019, specifically recommended that the USPTO adopt WIPO's "protective version" approach. (Many signers of the present letter were also among the seventy-three signers of that previous letter.) It is disappointing that it has taken more than two years of advocacy to bring about any change at all, and as set forth in this letter, it is disappointing that the "protective filing" approach now contemplated by the USPTO nonetheless falls far short of the WIPO approach.

It is extremely important to note that under the PCT rules, the protective document is preserved in perpetuity, meaning that the protective filing would be available for use in any later proceeding before a national or regional patent office, or in a court. This stands in contrast to the offensive approach contemplated in the April 28, 2022 Federal Register notice, namely that for most US patent applications filed in DOCX format, the protective PDF, and "all copies thereof", would be "disposed of" three years after issuance of the US patent.

By way of further background, a related problem with the DOCX e-filing approach is the problem of ethical and professional responsibility for the practitioner. Under USPTO's rules the patent practitioner is required to obtain a signature of the inventor on a Declaration of Inventorship. The Declaration calls for the inventor to have reviewed the subject patent application as part of the signing process. This review will necessarily have been linked to some human-readable document that was reviewed by the inventor. That human-readable document is not the same document as the DOCX file that the practitioner later uploads to the USPTO e-filing system (at some time after the inventor has reviewed the patent application and has signed the Declaration). That human-readable document is some human-readable rendering of that DOCX file, using whatever software happened to be employed by the practitioner at that time.

According to USPTO's approach, the authoritative document for USPTO purposes is not, however, the same as whatever human-readable document the inventor saw back when the inventor was getting ready to sign the Declaration of Inventorship. According to USPTO's approach, the authoritative document is that DOCX file *as rendered into human-readable form at some later time* by some later version of the USPTO's own proprietary DOCX rendering engine. The simple flow of time, if nothing else, makes clear that it will have been impossible for the inventor to have seen that later human-readable rendering of the DOCX file, a rendering that will have taken place by means of USPTO proprietary software that may well have changed since the software version that was in use by the USPTO at the time of the signing by the inventor of the Declaration of Inventorship. From this it follows that the USPTO puts the practitioner into what may be charitably described as a difficult position when suggesting that the previously signed Declaration of Inventorship may be filed in the application.

If the rendered PDF that the inventor saw at the time of signing of the Declaration of Inventorship could be filed with the DOCX patent application, as the protective version of the patent application, this would go a long way towards making a clear record of what it was that the inventor was reviewing when the inventor was getting ready to sign the Declaration of Inventorship. The need for preservation of such a clear record applies equally to DOCX-formatted US patent applications filed *on any date*, regardless of whether that date happens to be on or before December 31, 2022, or happens to be after December 31, 2022.

There is another background aspect of the protective PDF filing approach that requires discussion. The April 28, 2022 Federal Register notice invites the practitioner community to trust the USPTO in its upcoming evaluation of its "temporary" protective PDF filing program, saying:

> As December 31, 2022, approaches, the USPTO will evaluate whether there is a need to extend the temporary period beyond December 31, 2022, and will inform the public of any extension of the temporary period.

What is unfortunate is that the USPTO has not earned the trust of the practitioner community in this area, and has indeed put itself in a position of lack of trust as to its veracity in reporting of

DOCX problems. The most striking example arose during an earlier phase of the USPTO's DOCX filing initiative, as will now be described. In the above-mentioned letter from ***Seventy-Three Patent Practitioners*** to Brendan Hourigan of the USPTO, dated September 17, 2019, the signers reported many issues resulting from the filing of applications in DOCX format. It will be recalled that on August 3, 2020, the USPTO published a Federal Register notice entitled *Setting and Adjusting Patent Fees During Fiscal Year 2020* (85 FR 46932). It was astonishing to see the following sentence at page 46958:

> To date, the USPTO has not received notifications of any issues resulting from the filing of applications in DOCX format.

This statement by the USPTO in the August 3, 2020 Federal Register notice was false. The USPTO had received notification of many issues resulting from the filing of applications in DOCX format, in the letter dated September 17, 2019 from ***Seventy-Three Patent Practitioners*** to Brendan Hourigan of the USPTO. The USPTO lied.

This puts the practitioner community in the position of having to wonder whether the USPTO can really be trusted to carry out its "evaluation" as described in the April 28, 2022 Federal Register notice in a truly open and candid way.

A remaining concern is the USPTO's history of setting fees to disincentivize activities that the USPTO prefers would not take place. We worry that the USPTO might set fees so as to discourage requests for correction under DOCX filing initiative. We feel that any USPTO procedure for handling corrections relating to USPTO's rendering or processing of the character-based file as compared with the protective PDF (for example by petition or certificate of correction) must be free of any fee cost to the applicant or patent owner.

Having provided some background, we will now discuss in some detail the two chief misunderstandings that permeate the April 28, 2022 Federal Register notice.

The first misunderstanding permeating the April 28, 2022 Federal Register notice relates to the question of ***how soon*** the applicant or practitioner would be required to somehow detect a

USPTO mistake and to act upon it. The approach set forth in the notice contemplates that any petition asking for a correction of a USPTO error in the rendering of a DOCX-formatted US patent application (based upon a comparison of the USPTO's rendering with the applicant's protective PDF document) would be filed on or before December 31, 2022. This is absolutely unacceptable. The opportunity for the filing of such a petition absolutely must be available to the applicant for at least as long as the term of the granted patent plus the statute of limitations period.

It is, frankly, insulting that the USPTO proposes in the April 28, 2022 Federal Register notice that such corrections be rendered impossible for most of the life of the patent due to a proposed discarding of the protective PDF document "and all copies thereof" a mere three years after issuance of the patent. Again, as mentioned above, the WIPO approach preserves the protective document in perpetuity. This permits a patent owner to make reference to that protective document in a later proceeding, if necessary, before a national or regional patent office, or before a court. The WIPO approach avoids the insult of any discarding of the protective document "and all copies thereof".

If the USPTO were to have any hope of getting "buy-in" from the practitioner community, the USPTO would need to appreciate that the malpractice lawsuit against the practitioner arising out of the practitioner's having risked the client's interests by filing a patent application in USPTO's DOCX format will happen only after the USPTO mistake gets discovered, and that the discovery of the USPTO mistake may well only happen at litigation time. The correction procedure must thus be available at litigation time. Putting things as plainly as possible, ***cutting off the availability of the correction procedure at any time earlier than litigation time negates any possibility of "buy-in" from the practitioner community.***

The second misunderstanding permeating the April 28, 2022 Federal Register notice relates to the question of whether it is acceptable for the provision of protective PDF files to be a "temporary" thing. The approach set forth in the notice contemplates that the provision of a protective PDF document would only be available in the special case of a DOCX-formatted US patent application having a filing date on or before December 31, 2022. The approach

contemplates that for any DOCX-formatted US patent application having a filing date after December 31, 2022, the applicant would not be permitted to provide a protective PDF document. This is absolutely unacceptable. The opportunity for the provision of a protective PDF document along with the filing of a DOCX-formatted US patent application must be preserved for however long the USPTO chooses to require the filing of US patent applications in a DOCX format.

What must be emphasized is that there is no reason to think that some limited amount of test filing between now and December 31, 2022 will be of any predictive value at all regarding things that might go wrong after December 31, 2022. There are actually many reasons to doubt that the limited experience between now and December 31 would be of any value at all.

A first reason to attach little or no predictive value to test filings between now and December 31, 2022 is that the proprietary DOCX rendering engine used by the USPTO *after December 31, 2022* will surely have non-identical software in it, as compared with the proprietary DOCX rendering engine used by the USPTO *on and before December 31, 2022*. This means that there will be things that can go wrong after December 31, 2022 regarding USPTO's proprietary DOCX rendering engine that no one could have learned about from *any amount of testing* prior to December 31, 2022.

Conspicuous by its absence in the April 28, 2022 Federal Register notice is any commitment or promise by the USPTO that its DOCX rendering engine as it existed on or prior to December 31, 2022 will be maintained by the USPTO with *no changes whatsoever*, in perpetuity, on and after January 1, 2023. Yet if USPTO's customers are to be asked to accept that the availability of the protective "Auxiliary PDF" filings will end on December 31, 2022, then this could only conceivably be acceptable if the USPTO were to make exactly such an irrevocable promise.

A second reason to attach little or no predictive value to test filings between now and December 31, 2022 is that practitioners with applications containing difficult subject matter (for example math formulas, chemical formulas, Greek letters, other special characters, and tables) have already stated their intention to avoid at all costs any use of the USPTO's DOCX system for as long as possible (indeed perhaps never using it even after the penalties come into force) so as to

avoid malpractice risks. Few if any such applications will get filed as DOCX applications between now and December 31, 2022. The only filers who will file DOCX between now and December 31, 2022 are those whose applications are the simplest possible applications, containing no risky material of any kind. Such applications will be of no help at all in discovering subtle defects in USPTO's design of its proprietary DOCX rendering engine. The absence of identified rendering mistakes and artifacts will in no way mean that the USPTO's proprietary DOCX rendering engine is free from defects.

A ***third reason*** to attach little or no predictive value to test filings between now and December 31, 2022 is that there will be no opportunity for members of the public to scrutinize the DOCX files and the USPTO's rendering of those files. The applications involved will nearly all be secret! They will generally not yet have been published by December 31, 2022. This means that the only parties who would have any ability to catch or detect the defects that urgently would need to be detected are (a) the applicant itself, and (b) the USPTO. The USPTO, however, has no incentive at all to try to find defects in its own systems promptly, and indeed on the present timetable, has every incentive to foot-drag any uncovering of defects until after December 31, 2022 so as to lock in place the end of the "temporary" availability of the protective "Auxiliary PDF" filings. This leaves only the applicant to try to detect rendering errors and artifacts. There is simply no way for the rest of the patent community to have any confidence level as to the extent to which the handful of brave DOCX applicant filers will be successful at managing to detect the USPTO's rendering errors and artifacts early enough to be able to "blow the whistle" soon enough to deflect the otherwise-seemingly-inevitable end of the "temporary" availability of the protective "Auxiliary PDF" filings.

A ***fourth reason*** to attach little or no predictive value to test filings between now and December 31, 2022 is that maybe there will be so few such filings that an absence of reported USPTO rendering errors will mean nothing. Indeed given that most of the applications filed between now and December 31 will be less than 18 months old, they will be secret, and it will be impossible for members of the public to independently evaluate whether the number of test filings will have been sufficient to permit any conclusions at all to be drawn from the absence of reported rendering errors.

Again as mentioned above, the USPTO's track record for veracity about reporting DOCX problems is poor. As described above, on September 17, 2019, ***Seventy-Three Patent Practitioners*** wrote a letter to Brendan Hourigan of the USPTO, notifying the USPTO of issues with DOCX filings, and on August 3, 2020, the USPTO published a Federal Register notice containing a false statement that "[t]o date, the USPTO has not received notifications of any issues resulting from the filing of applications in DOCX format." This suggests that it would be better simply to eliminate the "temporary" nature of the protective PDF filing approach and instead leave it in place.

In summary, this letter does not try to address, and does not address, the most fundamental question, namely whether DOCX is an appropriate format for the USPTO to use for the purpose of receiving newly filed US patent applications in character-based form. We do generally support USPTO's goals of receiving character-based information from patent applicants and patent practitioners. But this letter is *not* intended to endorse or approve of DOCX as a patent application filing format. This letter is directed only to pointing out two flaws in the April 28, 2022 Federal Register notice, namely that the availability of a protective PDF filing needs to last as long as there is any DOCX penalty, not ending on December 31, 2022, and that the availability of a correction procedure that makes use of a protective PDF filing needs to last at least as long as the term of a patent plus its statute-of-limitations period. We hope that USPTO can follow the suggestions set forth in this letter regarding the April 28, 2022 Federal Register notice, and we look forward to productive dialogue with the USPTO going forward.

Very truly yours,

Carl Oppedahl

for One Hundred Six Patent Practitioners

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Very truly yours,

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