

Subject: Re: Stakeholder meeting DOCX- David Boundy

From: David Boundy <DavidBoundyEsq@gmail.com>

Date: 2/2/2023, 6:11 PM

To: David Boundy <dboundy@potomaclaw.com>

CC: "Seidel, Richard" <Richard.Seidel@uspto.gov>, "Foley, Tamara" <Tamara.Foley@uspto.gov>, "Vidovich, Greg" <Greg.Vidovich@uspto.gov>, "Griffin, Steven" <Steven.Griffin@uspto.gov>, "Mallari, Patricia" <Patricia.Mallari@uspto.gov>, "Grier, Laura" <Laura.Grier@uspto.gov>, "richard@schafer-ip.com" <richard@schafer-ip.com>, "ormos-lists@ormos.org" <ormos-lists@ormos.org>, "Brian@siritzky.com" <Brian@siritzky.com>, "Brian@siritzkylaw.com" <Brian@siritzkylaw.com>, "davidboundyesq@gmail.com" <davidboundyesq@gmail.com>, "Carl Oppedahl" <carl@oppedahl.com>

Dear Mr Seidel -- attached is our thank-you letter, and a few observations to guide next steps. Thank you very much for a productive meeting. David

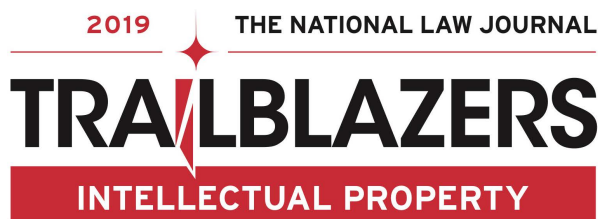
On Mon, Jan 30, 2023 at 4:54 PM David Boundy <dboundy@potomaclaw.com> wrote:

Dear Ms Siridavong and Mr Seidel --

Attached is a replacement of the two-page agenda we sent last week. This one has corrected URL hotlinks to the materials that would be useful for your review.

Thanks. Looking forward to our meeting.

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From: Siridavong, Minh <Minh.Siridavong@USPTO.GOV> on behalf of Seidel, Richard <Richard.Seidel@USPTO.GOV>

Sent: Thursday, January 26, 2023 4:47 PM

To: Foley, Tamara <Tamara.Foley@USPTO.GOV>; Vidovich, Greg <Greg.Vidovich@USPTO.GOV>; Griffin, Steven <Steven.Griffin@USPTO.GOV>; Mallari, Patricia <Patricia.Mallari@USPTO.GOV>; Grier, Laura <Laura.Grier@USPTO.GOV>; David Boundy <dboundy@potomaclaw.com>; richard@schafer-ip.com <richard@schafer-ip.com>; ormos-lists@ormos.org <ormos-lists@ormos.org>; Brian@siritzky.com <Brian@siritzky.com>; Brian@siritzkylaw.com <Brian@siritzkylaw.com>; davidboundyesq@gmail.com <davidboundyesq@gmail.com>

Subject: Stakeholder meeting DOCX- David Boundy

When: Wednesday, February 1, 2023 11:00 AM-11:30 AM.

David Boundy, DavidBoundyEsq@gmail.com
Carl Oppedahl, carl@oppedahl.com
Neil R. Ormos, ormos-lists@ormos.org
Brian Siritzky, Brian@siritzkylaw.com
Richard A. Schafer, richard@schafer-ip.com

Dear Mr. Seidel:

Thank you so much for making yourself and your colleagues available for yesterday's video conference. We very much appreciate your time and the Office's commitment to working with us.

We found the meeting very informative and positive, particularly the Office's consideration of a possible two-path filing approach, where *either* text-based PDF or DOCX (applicant's option) is accepted without penalty. As we said at the meeting, we believe this approach provides a workable solution to the issues we raised while giving the Office everything it needs.

You raised the issue of users who had already committed to the DOCX solution. We have no objection to the PTO providing options as long as at least one option satisfies our two principles (the uploaded file must be the authoritative document, and that document must satisfy "What I See Is What You Get" invariance).

You asked our views on a two-document approach, in which an applicant would file a PDF as the authoritative document, and a DOCX as an auxiliary. We indicated grave reservations, both practical and legal. Our investigations suggest that text-based PDFs should meet the PTO's needs for a fully-extractable text that can be reviewed to provide real-time feedback during filing. Further, our experience is that DOCX files are damaged when they move from an edition of Word for one alphabet to an edition for another. Thus, we suggest that text-based PDFs are almost certainly more reliably "internationalizeable" than DOCX files.

Because of time constraints, we didn't have time to discuss another common fact pattern that raises multiple issues with any filing regime that *requires* a DOCX (again, we have no objection to any regime that *permits* DOCX). Patent applications are often drafted by the inventor, corporate legal department, or foreign associate, and given to the U.S. attorney at the last minute only in PDF form as a *fait accompli*. Our colleagues in China, Israel, Japan, and Korea have learned that they *can't* send us DOCX files for filing, because (even if written in English), they break when opened on U.S. editions of Word. PDF solves those internationalization problems, so that's the most common way they send them. The U.S. attorney often has no real choice of format to file. The incompatibility among national versions of Word, and common practice, adds further impracticability to any requirement to obtain a DOCX, to file a DOCX, and to maintain consistency between entirely different forms of the same data for many years.

Time also limited our ability to discuss next steps. PDF/UA requires several properties of a PDF file. Some PDF writers don't implement them all, or don't have a single "PDF/UA" switch for all properties, but we have found that individual switches select for the properties important to the PTO's purposes, and they are widely implemented. We have found that various PDF writers ("Save As PDF" in Word, and "Print as PDF" from Adobe, CutePDF, PDF-XChange, and

perhaps others) have switch settings that yield PDFs that satisfy the PTO's text extraction and feedback needs (with full text, extractable in natural order, organized in paragraphs, with tagged section headings), even if that output may not be *fully* PDF/UA compliant in aspects unrelated to the PTO's needs. You should easily find those switch settings with minimal experimentation. We have further thoughts that might be useful, and we'll share those if you're interested.

It was left that you will be getting back to us (through David Boundy) in a few weeks for another meeting to explore these topics further. In the meantime, if you have questions, we will be happy to give you our thoughts and experience.

We appreciate your reminding us that the conference call was not directed to the April 3 expiration of the arrangement for filing auxiliary PDF files. However, we hope the USPTO will continue to extend its PDF accommodation past April 3 while we all work together to further our shared goals of providing applications' text to the USPTO.

Once again, thank you and your colleagues for meeting with us yesterday. And please pass our thanks on to the Director. We look forward to working with you to move this forward.