



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No.: PTO-P-2023-0025]

Extension of the Option for Submission of a PDF With a Patent Application Filed in DOCX Format

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is continuing to modernize and streamline its patent application systems to support robust and reliable patent rights, speed the issuance of patents, and reduce the costs and barriers of global patent protection. The submission of patent applications in DOCX format facilitates the USPTO's ongoing efforts. The USPTO previously announced that, for a temporary period, it was providing patent applicants with the option to submit an applicant-generated PDF version of an application along with the DOCX file(s) when filing the application in Patent Center. This temporary period was scheduled to end on June 30, 2023. In response to stakeholder requests, the USPTO is extending the option until further notice.

DATES: *Duration:* The option to submit an applicant-generated PDF of a patent application along with the validated DOCX file(s) when filing an application in Patent Center, as discussed in this notice, is being extended until further notice.

FOR FURTHER INFORMATION CONTACT: Mark O. Polutta, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7709; or Eugenia A. Jones, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7727.

For technical questions about submitting documents in DOCX format, please contact the Patent Electronic Business Center (EBC) at 1-877-217-9197 (toll-free), 571-

272-4100 (local), or ebc@uspto.gov. The EBC is open from 6 a.m. to midnight ET, Monday-Friday.

SUPPLEMENTARY INFORMATION: Filing in DOCX format eliminates the need for patent applicants to convert structured text to PDF format, improves patent application quality by providing content-based validations prior to submission, provides automated document indexing, allows for future reuse of content, and improves searches for patent applications. DOCX format is also necessary for planned, upcoming USPTO efforts to automate more of the patent application process, including the pre-examination of the application to ensure it is in good condition for examination by a patent examiner.

In April 2022, the USPTO announced that, for a period of time ending December 31, 2022, it was providing patent applicants with the option to submit a back-up, applicant-generated PDF version of the application along with the DOCX file(s) when filing an application in Patent Center. *See* Filing Patent Applications in DOCX Format, 87 FR 25226 (April 28, 2022) (April 2022 Notice). The goal of providing such an option was to encourage more applicants to begin filing patent applications in DOCX format. In particular, the USPTO anticipated that allowing applicants to submit a back-up PDF version of the application—without incurring additional fees—for a temporary period would encourage applicants to file in DOCX while ensuring that if any discrepancies were discovered, the back-up version could be used to correct the discrepancies. In December 2022, the USPTO extended this temporary period through June 30, 2023. *See* Extension of Period To Allow Submission of a PDF With a Patent Application Filed in DOCX Format, 87 FR 77812 (December 20, 2022).

In response to stakeholder requests, the USPTO is extending, until further notice, the option to submit an applicant-generated PDF of the application along with the validated DOCX file(s) when filing an application in Patent Center.

The April 2022 Notice stated that the “applicant-generated PDF . . . will not

become part of the permanent record unless a petition is filed requesting the USPTO to correct the record in view of the applicant-generated PDF” and that “[i]n the absence of such a petition, the USPTO will dispose of the applicant-generated PDF, and all copies thereof, after a retention period of at least three years after the patent grant or abandonment of the application.” However, in view of stakeholder requests, the USPTO will now keep copies of the applicant-generated PDF as part of the permanent record, regardless of whether a petition is filed. For example, for granted patents, the USPTO will keep copies of the applicant-generated PDF for at least 25 years after the patent grant before transferring it to the National Archives and Records Administration.

With the changes detailed above, patent applicants choosing to submit an applicant-generated PDF with the validated DOCX file(s) when filing an application in Patent Center will have an ongoing safeguard should any unexpected conversion discrepancies occur during the filing process. The USPTO reminds applicants that the option to submit an applicant-generated PDF version of the application is not available for applications filed via EFS-Web. Applicants are also reminded that they can file test submissions through the Patent Center Training Mode to practice filing in DOCX. Information on filing application documents in DOCX and a link to the DOCX training sessions are available at www.uspto.gov/patents/docx.

As discussed in the April 2022 Notice, patent applicants who choose to submit an applicant-generated PDF with the validated DOCX file(s) when filing an application in Patent Center will not have to pay additional fees, such as an application size fee, as a result of filing the applicant-generated PDF and, on petition, will be able to rely on the applicant-generated PDF if a discrepancy occurs during the filing process. To avoid incurring additional fees for the PDF, applicants must follow the process for submitting an applicant-generated PDF (Auxiliary PDF) set forth in the quick reference guide available at

www.uspto.gov/sites/default/files/documents/Aux_PDF_QRG_Final_2022.docx. The USPTO will continue to waive the petition fee under 37 CFR 1.17(f) for a petition under 37 CFR 1.182 that relies on an applicant-generated PDF that was filed in Patent Center as the source to make a correction to the record.

For more information regarding the filing of an applicant-generated PDF in Patent Center, including the options available for making corrections to the record, please review the guidance in the April 2022 Notice.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and

Director of the United States Patent and Trademark Office.

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