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Comment on USPTO Submission to OMB Regarding DOCX Submission Requirements

This comment is submitted on behalf of Kilpatrick Townsend & Stockton LLP, a national law firm that files over 3,000 US patent applications per year on behalf of clients ranging from individuals and startups to Fortune 500 companies.

As patent attorneys and agents, our first duty is to protect our clients' interests. When we prepare patent applications for our clients, we strive to make sure that the text is complete and accurate because we know that even small errors can render a patent worthless. We count on the USPTO to create a record that accurately reflects the text we intended to file.

We object to the USPTO's proposed surcharge of \$400 per application, which is intended to induce applicants to begin electronically filing text portions of patent applications¹ in DOCX format (the "DOCX filing process") rather than continuing the longstanding practice of electronically filing applications in PDF format (the "PDF filing process"). The PDF filing process accurately captures the text we intend to file and makes that text a part of the record. The DOCX filing process does not. Thus, while the DOCX filing process may further certain efficiencies within the USPTO, it fails to adequately safeguard applicants' interests.

The DOCX filing process does not create an accurate record of the text of patent applications.

Patent applications are important legal documents that are required to clearly and accurately set forth the claimed subject matter. An applicant cannot meet this requirement if the USPTO alters the text of an application without placing the applicant's original text in the record.

The DOCX filing process is known to make substantive changes to application text. After an applicant uploads a DOCX file, the USPTO executes an automated validation process that checks for unacceptable features in the DOCX file.² In some cases, the validation process alters the DOCX file to remove or replace such features, which may change document content.³ After validation, the possibly-altered DOCX file is converted to PDF. This PDF, which may not

¹ The "text portions" of a patent application are the specification, claims, and abstract.

² A partial list of unacceptable features is available from the USPTO at https://www.uspto.gov/sites/default/files/documents/DOCX_Feedback_Errors_and_Warnings.pdf.

³ *Id.* (noting that certain content items are removed or converted to acceptable items).

reflect the text that the applicant uploaded, becomes the record copy of the application. Applicants cannot predict or control the behavior of the USPTO's validation and conversion processes, and these processes make alterations that are substantive, not merely cosmetic.⁴ Thus, the DOCX filing process subjects applicants to a risk that the text of the record copy of the application differs from the text that the applicant uploaded. The PDF filing process carries no such risk.

Our firm has investigated the DOCX filing process, by filing applications of our own and by learning from reported experiences of other individuals and organizations. We have concluded that we cannot ignore the risk that the DOCX filing process will introduce substantive changes into our clients' applications. We have developed internal processes that mitigate the risk but cannot completely eliminate it.⁵

The USPTO underestimates the added burden on applicants of DOCX filing.

Our risk-mitigation processes for DOCX filing add significant new burdens, both pre-filing and post-filing. The USPTO estimates the time burden of DOCX filing at 0.5 hours per application.⁶ In our experience, the burden is considerably higher.

Pre-filing, preparing a DOCX file for upload to the USPTO requires more steps than preparing a PDF file for upload. We draft most of our applications in Microsoft Word, leveraging efficiency-enhancing features such as dynamic fields, bookmarks, and cross-referencing. With our existing systems, PDF filing has low overhead. Once an application is ready for filing, we can produce a PDF file ready for upload to the USPTO simply by issuing a "print" command.

For DOCX filing, additional pre-upload preparation is required. Because the USPTO's list of unacceptable DOCX features includes many of the efficiency-enhancing Word features we rely on, we spend time removing efficiency-enhancing features while the file is still under our control, a process that is more time-consuming than printing a Word document to PDF. Then we verify that removal of these features did not substantively alter the document content. Compared to PDF filing, our pre-filing process for DOCX filing requires approximately an additional **0.5 hour** for every application we file.

⁴ Examples of substantive alterations include: plain text being removed from specification; characters and symbols in formulas being replaced with meaningless box characters; and corrupted text layouts that obscure meaning. Fitch Even, "Terrifying Tales of the USPTO's DOCX Filing System," presented May 23, 2023, recording available via <https://register.gotowebinar.com/register/8857091059641828953> (submission of form required to view).

⁵ Given that DOCX is a proprietary format, not a standard, we also doubt that the USPTO can improve its processes to the point where the risk to applicants is eliminated, at least not without requiring all applicants to use Microsoft Word. This sort of favoritism toward one private entity would be inappropriate.

⁶ 88 F.R. 37039, 37041 (June 6, 2023). Table 2 estimates a burden of 0.5 hours per application at an average rate of \$435/hour.

Post-filing, DOCX filing imposes additional quality-control burdens. The USPTO's PDF filing process does not alter document content. The PDF filing process rarely goes wrong; when it does, the damage is readily apparent. Accordingly, post-filing quality control requires only a brief inspection of the image file wrapper to make sure the files we uploaded were not corrupted or damaged during the USPTO's imaging process.

For a DOCX filing, a brief inspection of the USPTO-generated PDF file is insufficient because of the possibility of substantive alteration, which can occur at the level of individual characters in a line of text. Post-filing quality control therefore requires a close proofreading of the USPTO-generated PDF file, on top of the pre-upload proofreading and preparation. At a typical rate of 10 pages per hour, proofreading a 30-page application adds a time burden of approximately **3 hours**.

In addition, if we discover USPTO-introduced alterations, we bear the additional burden of requesting correction. Since the USPTO has not provided a streamlined process for requesting correction, we would need to draft and submit an appropriate petition. The added burden per application is difficult to quantify in the absence of reliable data on the fraction of DOCX filings in which USPTO processing alters the application text.

Based on our experience, we estimate that DOCX filing carries an added burden to applicants of at least 3.5 hours per application, far larger than the 0.5 hours estimated by the USPTO. At the average hourly rate of \$435 applied by the USPTO,⁷ the burden on applicants would exceed \$1,000 per application. Even at a reduced proofreading rate of \$150/hour, the burden on applicants would typically exceed the proposed \$400 surcharge for "non-DOCX" filing. When these costs are combined with the risk of USPTO-introduced alterations going undetected, many applicants may opt to upload a PDF and pay the surcharge, thwarting the USPTO's goal of receiving more applications in DOCX format.

Counterbalancing this substantial added burden on applicants, the USPTO has estimated that its cost for extracting electronic text from an application submitted in PDF format is approximately \$3.15.⁸ The proposed \$400 "non-DOCX" surcharge is not justified by any cost savings to the USPTO.

The USPTO's "Auxiliary PDF" option provides insufficient protection against USPTO error.

As a temporary safeguard against USPTO-introduced errors in DOCX filings, the USPTO currently offers applicants the option to upload an applicant-generated PDF version of the application text (referred to as an "auxiliary PDF") along with the DOCX version, without incurring additional fees.⁹ Under current policy, if an auxiliary PDF is uploaded, the USPTO

⁷ *Id.*

⁸ 85 F.R. 46932, 46947 (August 3, 2020) "Optical character recognition (OCR) of image-based filings costs the Office approximately \$3.15 per new submission."

⁹ 87 F.R. 25226 (April 28, 2022) (initial announcement of auxiliary PDF option, available "on a temporary basis"). The fees waived by the USPTO include any applicable application size fees under 37

will make the auxiliary PDF available throughout the lifetime of the application (and eventual patent) and will allow applicants to refer to the auxiliary PDF to support requests to correct errors in the official application text generated from the DOCX file.¹⁰

While the auxiliary PDF practice temporarily alleviates some of our concerns, it does not solve the problems identified above. Applicants still bear the burden of detecting and correcting alterations made by the USPTO in converting DOCX files to PDF, and filing an auxiliary PDF does not relieve applicants of the substantial burden of post-filing proofreading.

In addition, the option to file an auxiliary PDF without paying additional fees is only available “until further notice.”¹¹ The USPTO could at any time announce that auxiliary PDFs will no longer be accepted unless applicants are willing to pay the non-DOCX surcharge and/or application size fees. If that happens, applicants will face a choice of paying extra fees or taking the risk that the USPTO will substantively alter their application text and leave applicants without a way to correct the record.¹²

A modified DOCX filing process would better protect applicants’ interests.

The content of a patent application must be defined and controlled by the applicant. The record copy must reflect the text the applicant uploaded, without alterations by USPTO processes. As discussed above, the DOCX filing process does not reliably capture what applicants upload and imposes significant additional burdens on applicants to detect USPTO-introduced alterations.

We recognize that providing applications in a structured text format (such as DOCX) would enhance operational efficiencies at the USPTO. We also understand that the USPTO has already invested significant resources in developing processes to operate on DOCX-formatted text, and we do not expect the USPTO to just walk away from its investment.

To protect the interests of applicants and the USPTO’s investment, we recommend a modification to the current DOCX filing process. Applicants would submit both a PDF version and a DOCX version of the same application text. The DOCX version would be used as an auxiliary document to facilitate internal USPTO processes, and incentives—possibly in the form of a discount on filing fees—could be offered to encourage submission of an “auxiliary DOCX.” But to protect applicants’ rights and avoid creating substantial new burdens, the application document of record must continue to be the applicant-generated PDF version, the content and format of which is entirely under applicants’ control.

C.F.R. §1.16(s), as well as the “non-DOCX” surcharge under 37 C.F.R. §1.16(u), if it takes effect before the waiver ends.

¹⁰ 88 F.R. 37036 (June 6, 2022).

¹¹ *Id.*

¹² If an auxiliary PDF is not filed, the only documents in the record are the USPTO’s validated DOCX file and the PDF generated from the USPTO’s validated DOCX file. There is no guarantee that either of these documents will accurately reflect what the applicant uploaded.

Conclusion

We believe the present DOCX filing process imposes unnecessary burdens and risks on patent applicants. We urge the USPTO to modify the process to better serve all applicants.