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Comments of HYMAN IP LAW on the Non-DOCX Filing Surcharge Fee Proposal

I write as one with over 30 years of experience as a patent lawyer, first in the government at the National Institutes of Health, later as a partner in a large, IP-focused law firm, and currently as a practitioner in two IP boutiques, including as principal of my own firm, HYMAN IP LAW.

I strongly oppose the USPTO's attempt to require the filing of non-provisional applications in the DOCX format instead of in the pdf format currently used.

The USPTO (the "Office") has tried to position the change as a convenience for practitioners, on the ground that the most common error practitioners receive regarding their submissions is an "embedded font" error. If that was true when EFS first introduced the ability to submit applications as pdfs, it is not true any longer and provides no support for the change in submission formats. Even I, an older, non-digital native, quickly learned how to convert documents to pdfs that do not raise "embedded font" errors, and discussions with other practitioners have not revealed any for whom this is a current concern. Thus, the Office's "practitioner convenience" rationale does not support the proposed change in practice.

With regard to cost, the USPTO's announcement asserts that, as many applicants and their representatives already prepare their applications in a word processing format, filing in a .docx format rather than converting the document to a pdf will save time, and therefore money. As noted above, however, it is simple and quick to convert word-processed documents to pdfs. And, given the many problems in assuring the accuracy of documents filed in .docx when converted by the Office, as painstakingly laid out by Carl Oppedahl in his several letters to the Office regarding this issue, I, like many practitioners, will file backup pdf copies of applications for as long as I can do so without incurring the Office's punitive non-docx filing surcharge. As I will be submitting applications in two formats rather than one, and then reviewing both in preview

form to verify that the document uploaded is the intended version, I will be incurring more cost, not less, with respect to each application so filed.

Which brings us to the Office's punitive non-docx filing surcharge. The Office's statutory authority in the AIA and the SUCCESS Act allow it to charge fees to recover its costs and fund its operations. The Office itself estimates the cost of converting pdfs to editable documents to be $3.19, but the proposed non-docx filing surcharge is $400, more than two orders of magnitude higher. I would have no problem if the Office charged a fee such as $10, or even $20, for applications submitted in pdf format, to ensure that the Office was able to cover its costs in OCR conversion of the pdf even if the application was submitted at the micro-entity rate. A fee that is more than 100 times the Office's own stated cost for such conversions, however, is clearly intended not to cover the Office's costs, but rather to force practitioners to the Office's newly preferred route of submission. This action-forcing surcharge appears to be unsupported by the Office's statutory authority for covering the costs of its operations, and will likely invite litigation.

The Office should reconsider both its .docx submission requirement, and the amount of the proposed surcharge, and should either withdraw the requirement or reduce the proposed non-docx filing surcharge to a level accurately reflecting the Office's costs.

Very truly yours,
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