

Via USPS tracking number 9405830109355062677736

Mark O. Polutta, Senior Legal Advisor
Office of Patent Legal Administration
USPTO
P O Box 1450
Alexandria, VA 22313-1450

January 24, 2024

Dear Mr. Polutta:

I write to you on behalf of the over seven hundred members of the Patent Practice listserv, a group of patent practitioners before the USPTO. I am writing to you because you are listed as a contact person for further information about the following Federal Register notices:

- 86 FR 29571, June 2, 2021, *Submitting Patent Applications in Structured Text Format and Reliance on the Text Version as the Source or Evidentiary Copy*
- 86 FR 66192, November 22, 2021, *Setting and Adjusting Patent Fees During Fiscal Year 2020*
- 87 FR 25226, April 28, 2022, *Filing Patent Applications in DOCX Format*
- 87 FR 77812, December 20, 2022, *Extension of Period To Allow Submission of a PDF With a Patent Application Filed in DOCX Format*
- 88 FR 37036, June 6, 2023, *Extension of the Option for Submission of a PDF With a Patent Application Filed in DOCX Format*

In this letter, I request your clarification as to the metes and bounds of the “ongoing safeguard” that is mentioned in the June 6, 2023 Notice, said to stem from the filing of an “applicant-generated PDF of the application” in a DOCX-filed US patent application. The Notice says the applicant-generated PDF will “safeguard the applicant should any conversion discrepancies have taken place.”

By way of background, the Notices cited above permit a patent applicant to select from three possible filing paths for patent applicants in the USPTO:

- **Legacy PDF.** An applicant that pays the non-DOCX surcharge is thereby enabled to carry out a patent application filing in the PDF format that applicants have used over the past two decades.
- **DOCX without applicant-generated PDF.** A first filing path that permits the applicant to avoid the need to pay the non-DOCX surcharge is the filing of the patent application in DOCX format, without also filing an applicant-generated PDF.

- **DOCX with applicant-generated PDF.** A second filing path that permits the applicant to avoid the need to pay the non-DOCX surcharge is the filing of the patent application in DOCX format, accompanied by an applicant-generated PDF.

Having identified and enumerated these three filing paths for patent applicants in the USPTO, our attention naturally turns to the need for an applicant to make an informed judgment as to which of the three filing paths to select. One of the important factors informing this judgment is, of course, the availability or unavailability of procedures for obtaining correction in the event that the owner of a patent discovers a discrepancy between what was filed and what the USPTO issued in the resulting US patent. It appears, from the above Notices, that there are striking differences among the three filing paths as to correction procedures available, and striking differences as to *when*, in the life of a particular patent application or issued patent, any correction procedures are available. It also seems a bit unclear, from the above Notices, precisely *which* correction procedures are available for the third path (“DOCX with applicant-generated PDF”), and the timing as to when, in the life of an issued US patent, one or another of the available correction procedures is available.

Legacy PDF. As we understand it, nothing about the above-cited Federal Register notices has any effect on the procedures by which an owner of a US patent which was obtained through the legacy PDF filing path may obtain a correction of a USPTO mistake in the granted US patent. And as we understand it, nothing about the above-cited Federal Register notices has any effect on the timing of the availability of those procedures for correction of a USPTO mistake in a granted US patent. Patent owners have by now accumulated more than twenty years of experience with the Certificate of Correction process. It appears that this familiar Certificate of Correction process will continue unchanged in its availability throughout the term of an issued US patent.

Could you kindly confirm that this is so, or if it is not so, could you kindly point out where in any of the above-cited Federal Register notices the reader may find the language, if any, that affects the procedures or the timing of the availability of the procedures?

DOCX without applicant-generated PDF. The June 2, 2021 Notice says:

Specifically, the USPTO now considers the DOCX documents filed by applicants to be the authoritative document, otherwise referred to as the source or evidentiary copy of the application, for purposes of determining the content of the application as originally filed, should a discrepancy be discovered. ... Applicants should not expect to have a request to correct the electronic record granted if the request is based on the source or evidentiary copy and it is filed more than one year after submission of the document.

From this language, what we understand is that even now, after the publication of the Notices that came after June 2, 2021, if an applicant follows the path of “DOCX without applicant-generated PDF”, then the sole available procedure for correcting a USPTO rendering discrepancy is the filing of a petition, and we further understand that to have a prospect of grant, such a petition must be filed within a year of the filing of the patent application.

Could you kindly confirm that this is so, or if it is not so, could you kindly point out where in any of the above-cited Federal Register notices the reader may find the language, if any, that offers any other procedure, or that extends the timing of the availability of the procedure?

We note that it is uncommon for a US utility patent to issue within one year of the filing of its patent application. This prompts us to observe that it appears that the owner of a US patent that was obtained through the “DOCX without applicant-generated PDF”, and that issued more than a year after its filing date, would find it impossible to obtain a correction of a USPTO mistake in the granted US patent due to DOCX rendering.

Could you kindly confirm that this is so, or if it is not so, could you kindly point out where in any of the above-cited Federal Register notices the reader may find the language, if any, that offers any procedure for such correction for such a US patent that issued more than a year after its filing date?

DOCX with applicant-generated PDF. This brings us to the question of the metes and bounds of the “ongoing safeguard” said to be provided by the applicant-generated PDF. We find the above-cited Notices to be a bit unclear as to the procedure or procedures that would be available to the owner of a US patent that was obtained through the “DOCX with applicant-generated PDF” path, for correction of a USPTO mistake in the granted US patent due to DOCX rendering.

Our best guess as to the combined effect of the above-cited Notices is that one procedure available to such a patent owner would be a petition requesting correction of the patent, *with the request being based on the applicant-generated PDF.*

We note that such a petition differs from the petition that would be used for an application that had been filed following the path of “DOCX without applicant-generated PDF” since in such an application, the request would be based solely on “the source or evidentiary copy” which is defined as “the DOCX document[] filed by [the] applicant[.]”

In contrast, for the owner of a US patent issuing from an application that was filed using the “DOCX with applicant-generated PDF” path, we guess that the request *could be based on the applicant-generated PDF.*

But what we cannot quite discern, from the Notices, is the timing of the availability of a correction request that is *based on the applicant-generated PDF.* We specifically ask for your clarification as to when this procedure is available to a patent owner. Is this correction request procedure limited to one year from the filing date (as is the case for the application filed in DOCX without an applicant-generated PDF)? Or is this correction request procedure available at all times during the term of the issued US patent?

Likewise what we cannot quite discern, from the Notices, is the range of procedures available for the owner of a US patent issuing from an application that was filed using the “DOCX with applicant-generated PDF” path. As mentioned above, we guess that one available procedure is the filing of a petition, with the petition based on the applicant-generated PDF. Is it also the case, however, that another available procedure is a simple request for Certificate of Correction, based on the applicant-generated PDF? Is it the case that this procedure of “Certificate of Correction, based on the applicant-generated PDF” is available to the patent owner at all times during the term of the US patent?

Why the USPTO’s prompt clarification is needed. As you will appreciate, the correction procedure for an issued patent granted on an application filed using the first path (“Legacy PDF”) appears to be well understood, clear in its operation, and predictable in its function and outcomes. Applicants are able to rely upon more than twenty years of experience with this filing path and its correction procedure.

In contrast, the correction procedure or procedures for an issued patent that was obtained through the third path ("DOCX with applicant-generated PDF") seem less clear. The lack of clarity, from the Notices, extends not only to the question of **which** procedures are available, but also to the question of **when** (if at all) during the life of an issued patent the procedures are available. I am sure that you will share my sense that until the USPTO were to provide such clarification, many and perhaps most patent applicants are likely to choose the first path ("Legacy PDF") given that its correction procedure has been well understood for more than twenty years.

We look forward to your prompt clarification on these points, relating to the Notices cited above.

Sincerely,

/s/ 

on behalf of the members of the Patent Practice listserv

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