

Before the
OFFICE OF MANAGEMENT AND BUDGET
Washington, DC

Notice of Information Collection)	
Being Submitted to the)	
Office of Management and Budget)	
for Review and Approval)	
)	OMB Control No: 0651-0032
Patent and Trademark Office)	
)	
Initial Patent Applications)	
)	
Published at 85 FR 76538 11/30/2020)	

TO:
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**COMMENTS OF NEIL R. ORMOS ON
INFORMATION COLLECTION SUBMISSION TO OMB**

SUMMARY

Neil R. Ormos submits these comments in response to the notice published at 85 FR 76538 of the Patent and Trademark Office's Information Collection submission to the OMB under Control No. 0651-0032. By this submission, the Patent and Trademark Office (PTO) is requesting a three-year extension (the "clearance period") of a currently-approved information collection regarding Initial Patent Applications.

Because the collection would impose unwarranted burdens on the public, including users of the Patent and Trademark Office ("PTO"), it should not be approved.

In addition, the PTO, in its own rulemaking proceedings, has not correctly compared the burdens of compliance with its proposed or adopted rules with the alleged benefits of those rules, and has failed properly to address comments received from users of the PTO as to those burdens. The PTO has also failed to incorporate in its submissions in this OMB proceeding (to the extent PTO's submissions can be understood by commenter) many of the burdens and costs imposed by both its information collection practices and the collection-related rule changes the PTO has adopted that will become effective during the 36-month clearance period. The PTO has either misrepresented the burdens by underestimating them, or has not presented and accounted for them with candor in its submissions. Therefore, the PTO's estimates of the burdens and their impact on PTO users and the public are not reliable. For these additional reasons, the collection should not be approved.

DISCUSSION

DOCX FILING

One example of unwarranted burden is the imposition by rule of a fee/surcharge regime intended to force users to file applications in a particular computer file format.

The PTO has adopted a rule requiring filing of new applications via the PTO's electronic filing apparatus in what is commonly called the "DOCX format", subjecting filers who do not comply to a \$400 surcharge. The PTO has acknowledged that it would save an amount less than \$20 per patent application by obtaining filings in this format instead of the "PDF" format that has been used

for many years. Public comments from numerous PTO users in the PTO rulemaking proceeding have called attention to the burdens and risks associated with filing in DOCX format. As one example, a group of patent practitioners filed an extensive comment detailing their concerns in the PTO rulemaking proceeding:

https://www.uspto.gov/sites/default/files/documents/Comment_Seventy_Three_Patent_Practitioners_092719.pdf

Although users may effectively liquidate those burdens and risks by paying the \$400 surcharge, subjecting users to a \$400 surcharge to mandate behavior that saves the PTO less than \$20 is an unwarranted burden. Even if the PTO may be authorized to recover its costs from users, that authorization does not appear to extend to penalizing users via a *surcharge* that far exceeds the cost that would be saved by the agency if the user complied. Moreover, not all users will themselves be fully aware of the burdens, costs, and risks associated with compliance, some of which are not obvious, because most users do not have processes in place to measure them.

OTHER UNWARRANTED BURDENS

Other examples of unwarranted burdens include PTO internal procedures, implemented through forms and information technology, that are more restrictive than required by rules or statute. For example, the PTO has in the past adopted a rule that requires that priority claims in applications be presented in a bibliographic information document called an Application Data Sheet (ADS). As a part of its internal practices, the PTO requires that the priority claims be listed in reverse chronological order, but this requirement is not provided by the rule. Applicants who file an ADS that complies with the rules may nonetheless be required by the PTO to undertake burdensome efforts to file a revised ADS that

conforms to the PTO's internal practice. To the extent the PTO imposes restrictions that are required by neither statute nor rule, those restrictions are unwarranted burdens on PTO users and the public.

In addition, the PTO's electronic systems, which are integral to its information collection practices, impose on users and the public additional burdens and restrictions that are not explicitly required by statute or rule. To the extent PTO's submissions in this OMB proceeding can be understood by commenter, it appears that the PTO has not recognized or accounted for these burdens.

For example, the PTO's current public-facing PAIR and EFS-Web online systems (the "legacy online systems"), through which external users interact with the PTO regarding their applications, including for such functions as filing new applications, receiving information on the agency's actions on the applications, responding to the agency's actions, and filing other papers in connection with the applications, frequently exhibit malfunctions.

Examples of the malfunctions have included unexpected and unannounced periods of system *down time* (often not even acknowledged by the PTO), inability for the user to log in, new and unannounced incompatibilities with particular web browsers, the failure promptly to deliver confirmation or to display evidence of a user's filing of a document, arbitrary rejection of attempts to file documents that comply with published system requirements (sometimes because an unpublished requirement is being enforced), and the intermittent failure of the systems to display information normally expected by users to be visible.

Because failure to perform certain acts by certain deadlines can result in abandonment of an application and irretrievable loss of patent rights, and the

filings often require payment of fees, these malfunctions are not mere inconveniences where a user can simply make a duplicate filing or wait a week, or even a day, for the problem to be cleared. If an attempt to file a document does not immediately produce an expected confirmation or other reliable evidence of filing, a practitioner or other member of the user's staff may need to request, by telephone or e-mail, that PTO personnel take special action to make the confirmation or evidence available, and obtaining the confirmation or evidence can sometimes require extensive efforts, including significant personnel time and involving considerable delay. These incidents impose significant, harmful, and unwarranted burdens on PTO users, and the PTO does not appear to have recognized or accounted for them.

Further, the PTO has developed a new system, called PatentCenter, which is intended to replace the functions now provided by the legacy PAIR and EFS-Web systems. The PTO has made PatentCenter available for use on a trial basis. It is believed that the PTO intends to retire the legacy systems, and to impose PatentCenter as the only online means of performing the relevant functions, during the 36-month clearance period.

Trial users have observed that some important functions provided by the legacy systems are not available in PatentCenter at all, and many others of the functions provided by the legacy systems are either difficult to access, or more difficult to use, in PatentCenter. Whether these functions deemed by users to be important or even essential to doing online business with the PTO are removed entirely, or are simply made more difficult to find and use, to the extent these changes have not been justified by the PTO, the changes impose unwarranted

burdens on PTO users and the public. The PTO does not appear to have recognized or accounted for them.

Moreover, trial users have reported literally **dozens** of problems they believe to be *critical* in connection with PatentCenter. At least 48 *critical* problems have been published as of the date of this comment. This does not count many other items identified by users and characterized as *feature requests*. Many problems and feature requests have been voiced by informal groups of users who gather via e-mail discussion lists, and have been collected and posted for tracking by volunteers at a web site operated independent of the PTO by a prominent patent practitioner:

<https://patentcenter-tickets.oppedahl.com/>

Almost all of the problems have also been reported to the PTO via the PTO's advertised official feedback channel.

It is believed that, as to most of these items, the PTO has neither corrected the problems nor acknowledged the reports.

The PTO's failure promptly to correct user-reported problems in PatentCenter is an unwarranted burden on users and the public. The PTO's failure even to **acknowledge** the PatentCenter problem reports furnished by users via the PTO's advertised feedback channel is a further unwarranted burden on users and the public. It is believed that the PTO's failure usefully to communicate with users reporting problems was a principal motivation for the creation of the independent PatentCenter Tickets web site. That a busy patent practitioner went to the effort of creating such a web site, and volunteers have donated time and effort to post and

maintain the information on that site and, in parallel, to furnish the information to the PTO via its advertised feedback channel, demonstrates some of the burdens imposed on PTO users in connection with the PTO's PatentCenter development and user feedback practices. These burdens are unwarranted. The PTO does not appear to have recognized or accounted for these burdens in its submission.

THE PTO'S SUPPORTING STATEMENT IN THIS
OMB PROCEEDING APPEARS TO MISREPRESENT
OR LACK CANDOR AS TO IMPORTANT
INFORMATION BEARING ON BURDENS

The PTO filed a Supporting Statement on 30 November 2020 that either misrepresents, or lacks candor, as to important information bearing on burdens essential to determining whether these burdens arising from PTO information collection practices are warranted.

For example, the PTO states,

EFS-Web is a web-based document submission system that allows customers to file nearly all of the documents covered under this information collection through their standard web browser without downloading special software, changing their documentation preparation tools, or altering their workflow processes. Customers may create their documents using the tools and processes that they already use and then convert those documents into standard PDF files that are submitted through EFS-Web to the USPTO. The fillable PDF forms, including the Application Data Sheet form (PTO/SB/14) and the Provisional Application for Patent Cover Sheet (PTO/SB/16), that can be submitted through EFS-Web may be downloaded from the USPTO website and do not require special PDF creation software. [...]

Although the PTO's Supporting Statement claims that "EFS-Web [...] allows customers to file nearly all of the documents covered under this information collection through their standard web browser without downloading special software, changing their documentation preparation tools, or altering their workflow processes. Customers may create their documents using the tools and processes that they already use and then convert those documents into standard PDF files that are submitted through EFS-Web [...]," **this will no longer be true** once the DOCX submission requirements become effective during the 36-month clearance period. To the extent users may continue to use their existing software and workflow processes without alteration, they will be required to pay a \$400 penalty. (The PTO calls this fee a *surcharge*, but as explained above, the extreme degree to which the surcharge exceeds the agency's claimed benefit of compliance makes it, effectively, a penalty for non-compliance.)

The PTO has reason to know of its own final rule announcing the imposition of a requirement to file in DOCX format and the \$400 penalty for non-compliance. And the PTO has been informed by users, in of-record rulemaking filings, of costs and other burdens they expect they will incur as a result of the requirement. That the PTO's Supporting Statement fails to acknowledge either the change or the burdens arising therefrom is either a misrepresentation or lack of candor as to these burdens and costs.

Further, the PTO's Supporting Statement appears to refer to certain aspects of its legacy systems, which legacy systems it intends to retire or replace within the 36-month clearance period, and some of which aspects are, even today, no longer applicable.

The PTO states:

Registered and unregistered users can file documents securely through EFS-Web, which is hosted on secure servers. The documents of registered user are protected using a Public Key Infrastructure (PKI) system and digital certificates which provide authentication and encryption security. For filers who are not registered, the documents are submitted to EFS-Web using Transport Layer Security (TLS) or Secure Socket Layer (SSL) protocol. [...]

The confidentiality, security, integrity, authenticity, and non-repudiation of patent applications submitted electronically through EFS-Web are maintained using PKI technology and digital certificates for registered users. Applications electronically filed by non-registered users are protected using TLS or SSL protocols. [...]

Patent applicants and/or their designated representatives can view the current status of their patent application through the Patent Application Information Retrieval (PAIR) system. Access to patent applications that are maintained in confidence under 35 U.S.C. Sec. 122(a) is restricted to the patent applicant and/or their designated representatives by the use of digital certificates, which maintain the confidentiality and integrity of the information transmitted over the Internet. The public can view the status and history information for published applications and granted patents via PAIR. For secure electronic access to PAIR, the USPTO employs digital certificates and PKI technology to permit only authorized individuals to access private patent application information and to maintain the confidentiality and integrity of the information as it is transmitted over the Internet. [...]

It is believed that the PTO no longer uses a PKI infrastructure for user log-in authentication. As best understood from PTO public announcements, user PKI credentials are no longer accepted for log-in authentication to the PAIR or EFS-Web legacy systems. Instead, the PTO has imposed a so-called *two-factor* authentication regime.

The PTO's failure to acknowledge this in its Supporting Statement is not just a trivial omission to mention an "under-the-hood" technical change, because authentication problems occasioned by the *two-factor* authentication regime impose significant burdens on users. Malfunctions of the PTO's *two-factor* authentication systems are frequently reported by users. Investigating and, where necessary, curing, problems with authentication can require extensive user effort and time.

Further, although it is believed that the PTO intends to replace the legacy EFS-Web and PAIR systems with the new PatentCenter system during the 36-month clearance period, the Supporting Statement does not mention this replacement. It acknowledges the existence of PatentCenter only peripherally in a statement dismissing a public comment from a PTO user directed to problems with the PTO systems' handling of embedded fonts.

The PTO has reason to know of its own plans to replace the legacy systems with PatentCenter. And it has been informed by users of costs and other burdens that they have already incurred in their trial use of PatentCenter and that they expect will incur if the legacy systems are retired without fixing the many critical issues users have reported. That the PTO's Supporting Statement fails to address the replacement of the legacy systems with PatentCenter or the burdens arising

therefrom is either a misrepresentation or lack of candor as to the burdens and costs.

AT LEAST SOME OF THE PTO'S CERTIFICATIONS
UNDER 5 CFR 1320.9 AND 5 CFR 1320.8(b)(3)
APPEAR TO BE ERRONEOUS OR WITHOUT BASIS.

As to at least some of the information collection practices for which the PTO seeks OMB clearance, several of the PTO's certifications under 5 CFR 1320.9 and 5 CFR 1320.8(b)(3) appear to be erroneous or without basis.

At least as to some of the information collection practices, the PTO's certification under paragraph (c) ("reduces burden on small entities") is incorrect or without basis, in that it appears that the burdens on small entities of using the PTO's electronic systems or of complying with its requirements will increase during the clearance period.

At least as to some of the information collection practices, the PTO's certification under paragraph (e) ("its implementation will be consistent and compatible with current reporting and recordkeeping practices") is incorrect or without basis, in that under current practice, a user can satisfy recordkeeping requirements by saving only a copy of what was transmitted to the PTO, whereas users complying with the PTO's DOCX filing requirement will be obliged to save not just what the user transmitted to the PTO, but also a PTO-processed version of what was filed, and to laboriously compare the two to ensure the PTO processing introduced no defects or conversion artifacts.

CONCLUSION

The information collection for which the PTO seeks OMB approval would impose an unwarranted burden on users and the public, and should not be approved.

The PTO has also failed to incorporate in its submissions in this OMB proceeding (to the extent they can be understood by commenter) many of the burdens and costs imposed by both its information collection practices and the collection-related rule changes the PTO has adopted that will become effective during the 36-month clearance period. The PTO has either misrepresented the burdens by underestimating them, or has not presented and accounted for them with candor in its submissions. Moreover, the PTO, in its own rulemaking proceedings, has not correctly compared the burdens of compliance with its proposed or adopted rules with the alleged benefits of those rules, and has failed properly to address comments received from users of the PTO as to those burdens. Therefore, the PTO's estimates of the burdens and their impact on PTO users and the public are not reliable.

For these additional reasons, the collection should not be approved.

Respectfully submitted,

/neil r. ormos/

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29 December 2020