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I've been an IP paralegal for 40 years, since January 1982. I've seen many law changes in the PTO during this time, some good and some bad. However, the proposed rule to require submission of a patent in DOCX format (37 CFR 1.16(u)) is the worst yet. The proposed process will require us to submit a patent application in MS Word (or other word processing) format, then the system converts it into PDF. We then need to check a box to agree that THAT PDF version is the legal version of the application. There is no way that I would click that "agree" box as that would be practicing law. So, I would then need to save the filing package and get the attorney to read the PTO-created PDF copy of the application - word for word - to verify that it is correct. The burden that this rule would impose is extraordinary and unfair, causing us to increase our time per application by several hours – for both the paralegal and the attorney. Personally, I think that it is just another way for the PTO to charge us an additional \$400 per application, which would be the fee to bypass the DOCX submission and submit in PDF format.

The problem is that the conversion from DOCX to PDF is not always accurate; as a matter of fact, there are almost always problems with the format of such a conversion as well as frequent errors in the text. (The PTO has indicated that there are never conversion errors - they are wrong.) During the review of the PTO-created PDF, the attorney would find the errors, send them to me and I would then need to re-upload another copy of the application (which would be the same document that I originally uploaded, as the error wasn't in the original document, but only in the PTO-created PDF). The system would then re-convert it into PDF; the attorney would read it, find the same error, I would re-load the document into DOCX, which would re-convert it into PDF, my attorney would read it, find the same problem, etc, etc.

So, how is this fair? The solution isn't actually that difficult. Change the rule to allow us to submit a PDF copy of the application AS WELL AS the DOCX copy and remove the requirement that we agree that the PTO-CONVERTED PDF is the legal copy. That way, when there are problems during prosecution, or during subsequent litigation, we can point to the PDF copy that WE submitted as the overriding copy. There, problem fixed.