

December 29, 2020

Paul J. Ray, Administrator
Office of Information and Regulatory Affairs
Office of Management and Budget
Executive Office of the President
Washington DC 20500

VIA INTERNET

RE: OMB CONTROL NUMBER: 0651-0032
ICR REFERENCE NUMBER: 202011-0651-006
TITLE: Initial Patent Applications

Dear Mr. Ray:

I am a Patent Agent licensed to practice before the United States Patent and Trademark Office. I have been in practice for over 18 years. I am writing to you to object to a rule that has recently been proposed by the Patent Office.

If implemented, proposed rule 37 C.F.R. § 1.16(u) will go into effect in January of 2022. The rule imposes a \$400 surcharge for filing a patent application in PDF form, as is the present practice by patent applicants in the Office. The Office proposes to impose the \$400 penalty for any filing that doesn't conform to the PTO's preference for documents created in Microsoft Word DOCX.

The problem with the DOCX requirement is that there is no uniform, reproducible way to render a DOCX into a final PDF document that has the exact same content as the DOCX source document. Moreover, besides MS Word, there are other well established software programs that create DOCX documents. At some point, every computer and every word processing software program will render something unpredictable, unexpected, and likely in error in a DOCX document. Such errors have been around for years; to this point, skilled computer programmers have not been able to render DOCX software from Microsoft or other vendors to perform free of errors.

The proposed rule further states that when an applicant files a patent specification in DOCX, the Office will convert the DOCX file to PDF on its computers. There is no way that the Office can guarantee that the PDF file it generates will be 100 percent free of any errors using its software. Even more outrageously, the Office burdens the Applicant and counsel with the task of inspecting the converted PDF document, and accepting the responsibility for the presence of any errors in the converted file.

I use Microsoft Word to produce DOCX documents for patent specifications, and I use a PDF conversion program created and sold by a leading PDF file conversion software company. When converting from DOCX to PDF, I have commonly observed conversion errors in complex text expressions such as chemical formulae and mathematical equations. These expressions are rendered as gibberish. As a workaround, I have printed the pages with equations or formulae from MS Word to paper, and scanned from paper to digital PDF, and loaded those pages into the PDF document before submission to the Office. If this proposed rule is implemented, I will embed images of the equations and formulae into the DOCX document,

rather than trust the Office's PDF conversion software, because the likelihood of error in the filing of the patent application in DOCX is unacceptably high.

Alternatively, with regard to the alternative of fully inspecting an Office-generated PDF file, the attorney/agent cost for pre-filing error checking and post-filing error correction (and malpractice insurance costs) will be well above the PTO's fee of \$400 per application. Thus it will be in my clients' best interest to continue to file PDF files that I have produced, and pay the \$400 surcharge.

In summary, the proposed rule proposed rule 37 C.F.R. § 1.16(u) will create immense unwarranted burden on the public, and should not be approved. I urge you to deny its approval.

Very truly yours,

A handwritten signature in black ink, reading "John M. Hammond". The signature is fluid and cursive, with a long, sweeping underline that extends to the right.

John M. Hammond P.E.
President, Patent Innovations LLC
Licensed Patent Agent
USPTO Reg. No. 52,986