

CAMBRIDGE TECHNOLOGY LAW LLC

DAVID E. BOUNDY

686 MASSACHUSETTS AVE., SUITE 201, CAMBRIDGE, MA 02139

MAILING: P.O. BOX 590638, NEWTON MA 02459

PHONE: 646.472.9737

FAX: 978.443.4812

E-MAIL: DBOUNDY@CAMBRIDGETECHLAW.COM

[HTTP://WWW.CAMBRIDGETECHLAW.COM](http://WWW.CAMBRIDGETECHLAW.COM)

November 30, 2020

Via Email InformationCollection@uspto.gov

Kimberly Hardy

Office of the Chief Administrative Officer

United States Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

Re: Comment Request, *Initial Patent Applications* and *Patent Processing*, 0651-0031 and -0032, 85 Fed. Reg. 60967 and 60975 (Sep. 29, 2020)

Dear Ms. Hardy:

Several collections of information should be removed from these two information collection requests before they are submitted to OMB for review. For one collection of information, the PTO estimates its cost savings at about \$150,000 per year, while the public estimates burdens at nearly \$200 million per year. This collection of information cannot be justified. Further, the PTO acted unlawfully in promulgating the rules calling for several collections of information, and this triennial review is a good time to prune them:

- 37 C.F.R. § 1.16(u) (\$400 surcharge for non-DOCX filing): this collection of information creates burden of ***nearly \$200 million per year***, that is, over ***1000X*** the PTO's estimated cost savings. In the Final Rule notice,¹ the PTO admitted that its savings is only \$3.15 per filing. The Notice and comment letters, and materials provided with this letter, establish that the burden to the public is over \$400 per filing. The disproportionate shift of burden renders the DOCX collection of information unapprovable.
- At the time of the July 2019 NPRM, the PTO failed to perform the cost-benefit analysis and make the disclosures for the DOCX collection of information required by the Paperwork Reduction Act. Neither the August 2020 final rule notice nor the September 2020 ICR notice for comment make up for the deficiency. The August 2020 final rule notice doesn't respond to the comment letters as written; instead the public's comments

¹ Patent and Trademark Office, *Setting and Adjusting Patent Fees During Fiscal Year 2020*, 85 Fed. Reg. 46932, 46947 col.2 (Aug. 3, 2020).

are paraphrased into disingenuous parody, so that the PTO can evade its responsibility of direct and fair response to comment. The analysis in the Final Rule notice reflects both a complete lack of understanding of the technological issues involved and a refusal of the PTO to observe the legal requirements for collecting information. The procedural failures underlying the DOCX collection of information render it unapprovable.

- Various collections of information in the MPEP impose burden on the public above the requirements of validly-promulgated regulation (leaving way for valid exercise of the PTO's authority to interpret "genuine ambiguity" in statute or regulation. For example, the June 2020 revision to MPEP § 706.07(b) should be backed out, and MPEP § 706.07(b) should be returned to its 2019 state. If the PTO wishes to impose burden on the public or bind the public, it must act by rulemaking, not by guidance. Executive Order 13891 and a recent Department of Commerce regulation, 15 C.F.R. § 29.2, forbid the PTO from attaching binding weight to guidance. These collections of information should be removed from the ICR request (and from the MPEP).

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I. The DOCX rule should be removed from the ICR request

A. The burdens are large and unaccounted for

Burdens of the DOCX collection of information (relative to today's PDF filing) include the following:

- Training, adjustment, and transition costs. Training and adjustment burden will be substantial. Not all DOCX documents authored by attorneys can be uploaded into PatentCenter—some just plain fail. Of documents that upload, many are vulnerable to error (see sections I.B.1 and I.B.2, below). I estimate this at 3 hours per attorney, and 10 hours per paralegal. Learning all the pitfalls and work-arounds will take many hours. This totals to about \$5 million in one-time burden for all attorneys, and about \$1.5 million per year for training for new attorneys and paralegals that enter the field.
- Interacting with inventors. Often, inventors provide information in forms that won't readily translate to the limited subset of DOCX supported by PatentCenter. For example, the inventor may use an equation software package or chemical structure software package that isn't within the PTO's subset. Today, it's easy to deal with this—we render it as a PDF and file it, and it works. Under the PTO's DOCX proposal, this will take a significant amount of work to get the document into PTO-approved form. I encounter this in about 5% of my applications. I estimate that this will take one to two hours extra for these 5% of applications, and about 8 hours extra for 1% of applications. My estimate comes to \$16 million per year. An Affidavit of Bradley Forrest estimates about \$16 million in burden per year for applications filed (see Exhibit A ¶ 13(a) and (c)), and many hundreds of millions of dollars of economic value for patent applications that can't be filed (see Exhibit A ¶ 13(b)).
- Word advanced features. Many attorneys (me, for instance) use advanced features of Word, such as bookmarks and cross-references, to ensure that a patent application is correct. Patent Center issues an error message for applications that use these features. It will take the attorney time to remove these features from an application. Each change risks introduction of error. I estimate that about 10% of attorneys use Word the way I do, and that this will add about half an hour to each filing. My estimate is that this will raise about \$10 million per year in burden. Mr. Forrest doesn't include this in his estimate.
- Reviewing will require about 15-60 minutes per submission. Under today's PDF filing regime, the WordProcessor-to-screen display and WordProcessor-to-PDF translations are performed by the very same software. Everyone can rely on "what you see is what you get," so there's no review time. In contrast, the PTO's DOCX-to-PDF rendering engine is different, and generates a different PDF, and sometimes erroneous (see section I.B.3 below). I estimate that on average, this will add half an hour, and risk of error—at 500,000 applications, this is \$100 million per year. Mr. Forrest estimates this at 15 minutes to two hours (see Exhibit A ¶ 13(d)); using a mean of half an hour gives the same \$100 million per year.

- When, despite all care, an error arises because the PTO's system renders a DOCX differently than the attorney's (I estimate 1/2% of applications), the burden will be in the range of 40 hours to obtain correction, totaling about \$40 million per year. In about half of those, no correction will be possible, so the burden will be the value of the patent application. If an average patent application is worth \$50,000 at filing, this will be about 50
- Mr. Forrest estimates that adding complexity to the PTO's filing system will raise additional failures and down-time for the PTO's systems, adding an hour to about 5% of applications (see Exhibit A ¶ 13(e)). That's \$10 million.
- The big cost will come if the PTO's different rendering into PDF is material to the patent. How can an applicant obtain a correction? The problem with DOCX is that the DOCX standard is a loose standard. It doesn't specify a single correct rendering of a DOCX into text. That means that *both* the one that the attorney expected is correct, *and* the one that the PTO will generate is also correct. If the PTO's is different than the attorney's, which one is more correct? How will an attorney prove what was intended to the PTO's satisfaction and obtain a correction? I estimate that for about 100 patent applications a year, error correction will cost \$10,000 to \$200,000. Mr. Forrest's estimate is for a smaller number of applications, but higher costs (see Exhibit A ¶ 13(a), (b), and (g)). Averaging our two estimates gives \$20 million per year.
- The PTO estimated that 20% of patent applicants don't use word processors that generate DOCX. NPRM, 84 Fed. Reg. 37413. The PTO has never estimated burden for them. $20\% \times 500,000 \times \400 is \$40 million. About 5% of this is double-counting against the above categories; call the total \$38 million.
- The first time that a patent application is damaged by the PTO's software, and a malpractice claim is filed, all malpractice coverage will go up by a significant amount. I expect malpractice claims (claims and cost to defend) to average \$3 million to \$20 million per year (see Exhibit A ¶¶ 14 and 15). Those costs will probably be around \$ 4 million per year.

The total burden of the DOCX information collection is about \$4,750,000 in one time startup costs, and about \$196 million in annual burden.

B. The technological analysis in the final rule notice reflects misunderstanding of the technological basics

The PTO in the Notice of Proposed Rulemaking² and Notice of Final Rule³ proceed from a fundamental misunderstanding of technology and the word “standard.” The PDF standard starts with a plain sentence: “The goal of PDF is to enable users to exchange and view electronic documents easily and reliably, independent of the environment in which they were created or the environment in which they are viewed or printed.”⁴ In contrast, even a brief reading of the two DOCX standards, ECMA-376⁵ and ISO/IEC 29500, show there is no similar sentence. In fact, the two DOCX standards have a number of sentences to the contrary: the DOCX standards explain that there are no guarantees that a document created on one word processor will appear the same to a user on another word processor, and the standards expressly consent to *inconsistency*.

1. What does the word “standard” mean? What do ECMA-376 and ISO/IEC 29500 mean and guarantee, and what do they not?

The main reason that DOCX is not a suitable form for submitting patent applications is that the DOCX standards are not intended to, and do not, assure interoperability. Like most other standards in computer science, the DOCX standards specify conditions on some parameters, and leave others open to vary in different implementations. Non-interoperable standards are more the rule than the exception in computer science. For example, the FORTRAN language has been “standardized” since 1958. The C programming language has been standardized de facto since the 1950s, and by an ANSI standard since 1990. But in neither case can a programmer take a FORTRAN or C program written for one computer and run it

² Patent and Trademark Office, *Setting and Adjusting Patent Fees During Fiscal Year 2020, Final Rule*, 84 FR 37398, <https://www.federalregister.gov/documents/2019/07/31/2019-15727/setting-and-adjusting-patent-fees-during-fiscal-year-2020> (Jul 31, 2019)

³ Patent and Trademark Office, *Setting and Adjusting Patent Fees During Fiscal Year 2020, Final Rule*, 85 FR 46932, <https://www.federalregister.gov/documents/2020/08/03/2020-16559/setting-and-adjusting-patent-fees-during-fiscal-year-2020> (Aug. 3, 2020), corrected at 85 FR 58282, <https://www.federalregister.gov/documents/2020/09/18/2020-20634/setting-and-adjusting-patent-fees-during-fiscal-year-2020> (Sep. 18, 2020)

⁴ ISO 32000 standard, available at https://www.adobe.com/content/dam/acom/en/devnet/pdf/pdfs/PDF32000_2008.pdf

⁵ Standard ECMA-376, Office Open XML File Formats, <https://www.ecma-international.org/publications/standards/Ecma-376.htm>

reliably on a computer from a different vendor. There are many dependencies⁶ that are left open to implementers. A program may be a “valid” program, in the sense that it will compile on the destination computer, but “valid” and “within the standard” is **no guarantee that it will run correctly**. It’s essentially impossible to write a commercially-important program that can be moved from one computer to another without substantial rework. The FORTRAN and C standards only guarantee some things, but not others. A “standard” does not guarantee interoperability. Only a fool assumes otherwise.

Another example is the gasoline octane standard. All gasoline sold in the United States conforms to multiple standards. But that doesn’t mean that all gasoline is interchangeable, or that your car will run well if you use gasoline that conforms to the “standard.” Like most other standards, the octane standards specify some characteristics of gasoline and not others. A “standard” does not guarantee interchangeability or interoperability. Only a fool assumes otherwise.

ECMA-376 and ISO/IEC 29500 leave many things open to implementation. ECMA-376 expressly states that there is no common set of features that are required to be implemented; all the standard guarantees is that *if* certain features are implemented, they will behave in a certain manner. Some implementations of DOCX are permitted to have features that will cause errors in others.⁷ ECMA-376 expressly states that a conforming implementation may reverse the characters of a DOCX: “This tool’s behavior would be to transform the title “Office Open XML” into “LMX nepO eciffO”.”⁷ Changing text, up to the point of rendering it unintelligible, is *entirely* within the standard! A Microsoft blog⁸ writes “One of the great things about ISO/IEC 29500 is its extensibility mechanisms - implementers can extend the file format while remaining 100% compliant with the standard.” That statement admits that while ISO/IEC 29500 is a standard, it’s not a standard that guarantees uniform interoperability—Microsoft intends that various vendors may add features that are incompatible with other vendors’. Another Microsoft page describes how extensions can be added to DOCX—with the result that one implementation

⁶ Issues that are left open by the FORTRAN and C standards include storage layout (big endian vs. little endian), underlying hardware arithmetic (32 or 36 or 64 bit words? IBM 370 floating point, Digital F and G floating point, IEEE 756 floating point, or 80-bit extended floating point)? Character set (ASCII or EBCDIC)? What operating system calls are available? For FORTRAN, does this compiler generate reentrant recursive code or not?

⁷ ECMA standard, Part 1, § 2.4 *Interoperability Guidelines*.

⁸ <https://blogs.msdn.microsoft.com/chrisrae/2010/10/06/where-is-the-documentation-for-offices-docxxlsxpptx-formats-part-2-office-2010/>

becomes incompatible with another.⁹ Among users, the non-interoperability among different implementations of DOCX is well known.¹⁰

2. The comment letters pointed out a number of failure points that DOCX will create

DOCX files cannot even be transferred reliably between Microsoft Word for Windows and Microsoft Word for Mac. Users that use Libre Office, Google Docs, or WordPerfect cannot reliably transfer documents to or from Microsoft Word. You have almost certainly observed it yourself: when you use the “previewer” in most email systems or web browsers to view a DOCX document, the document comes up differently than it does in your word processor. That non-uniformity exists between every pair of word processors. The problems are especially pronounced for equations and chemical structure diagrams. Even basic text can have the problem—standard fonts like Times Roman and Helvetica are available from different vendors, each with slight differences that will alter pagination in some cases. For one example, a patent attorney that uses Libre Office had an equation in a patent application:

$$f(u) = \cos(u)^3 \exp(0.2u)$$

Patent Center rendered it as follows.

$$f(u) = \cos(u)^3 \exp(10.2u)$$

Note that the PTO’s rendering system inserted a spurious digit “1” into the math equation. Because the DOCX standard leaves many behaviors unspecified, this may well be a correct rendering within the DOCX standard, and is almost certainly “correct” from Patent Center’s point of view. But it isn’t what was shown on the attorney’s computer.

One of the notice-and-comment letters¹¹ gave a number of examples of where a document appears differently when opened in different word processors. This letter pointed to

⁹ https://docs.microsoft.com/en-us/openspecs/office_standards/ms-docx/b839fef1-e1ca-4fa6-8c26-5954d0abbccd This page claims to be “updated frequently.” As retrieved on November 27, 2020, this page was updated on October 15. Any claim that DOCX is a standard

¹⁰ Abishek Batnagar, *Is DOCX really an open standard?* <https://brattahlid.wordpress.com/2012/05/08/is-docx-really-an-open-standard> attached as Exhibit B.

¹¹ Seventy-Three Patent Practitioners, *Comments on Setting and Adjusting Patent Fees During Fiscal Year 2020*, 84 Fed. Reg. 37398 (Jul. 31, 2019), https://www.uspto.gov/sites/default/files/documents/Comment_Seventy_Three_Patent_Practitioners_092719.pdf (Sep. 27, 2019). A host of errors in which other word processors were able to open the document, but changed the document in the process, are discussed at pages 18-19 and 48 to 81.

one case where WordPerfect entirely failed to open a DOCX produced on another word processor.¹²

The Affidavit of Bradley Forrest (Exhibit A) explains several situations in which variations among the handling of DOCX among different word processors has been observed to create costs.

On one of the patent law blogs, one person developed a test patent application in Libre Office and explained all the steps that had to be taken to get it to be accepted by Patent Center, as follows:¹³

I ... opened it with the latest version of Libre Office. [Libre Office] doesn't support paragraph numbering with leading 0s, so it automatically collapsed the paragraph numbers to have no leading zeros. ...

I saved that as a new file and uploaded it to Patent Center. Patent [C]enter gave me font error. I had to remove the text in an uncommon font ... and remove the wingdings. I tried again and got an error about bookmarks. I left the automatic item numbering but had to remove the automatically updating cross reference. With that, Patent center accepted the upload. It warned about paragraph numbering in improper format, figures in the specification, a claim not ending in a period (false error), word count in the abstract over 150 words (false error), document containing figures again, and line spacing not 1.5 or 2ouble spaced (false error).

If this were a real application, the changes that were required in order to get the application to be accepted by Patent Center would be fatal. It's not acceptable that this person had to "remove text," "remove the automatically updating cross reference" and the like! "Automatically updating cross-references" are crucial to correct patent applications; to remove them is to introduce error. And note all the other "false errors:" Patent Center isn't reliable software.

A number of the comment letters noted that DOCX simply cannot work for the purpose the PTO ascribes. See excerpts at Exhibit C. Each of these comments tells a consistent story: though DOCX is subject to "standards," that fact alone does nothing to guarantee interoperability, and does nothing to guarantee correct results when a DOCX is moved from one word processor to another.

Many of the comment letters point to objective empirical experience, several have experimental evidence in the letter itself: DOCX files cannot *reliably* be moved from one word processor to another. Any theoretical interoperability that the PTO might have inferred from the existence of standards (but that is not in the text of the standards documents themselves) is erroneous. The Final Rule notice is starkly silent in response.

Essentially all commenters agree that DOCX is covered by standards, and all assume that Patent Center's implementation is compliant with those standards. But the comment letters

¹² Seventy-Three Patent Practitioners, note 11 *supra*, at page 19.

¹³ <https://forum.napp.org/topic/1500-a-patent-center-docx-filing-experience/?tab=comments#comment-8875>

uniformly observe that “standards” don’t guarantee that Patent Center will accept all DOCX files and render them “correctly” from the user’s point of view. The PTO can speculate all it wants about the effect of “standards,” but the empirical evidence is clear that DOCX doesn’t work reliably. The ECMA and ISO/IEC standards are designed to allow a DOCX to appear differently on different computers, to take advantage of efficiencies that differ on different computers—in other words, the standard is designed to *not* work for the PTO’s purpose.

3. The Final Rule notice deflects the comments rather than answering them

The Final Rule notice fails to address the comments. The Supreme Court has stated that the notice and comment provisions of 5 U.S.C. § 553 “were designed to assure fairness and mature consideration of rules of general application.” *NLRB v. Wyman-Gordon Co.*, 394 U.S. 759, 764 (1969). The process helps ensure “that the agency maintains a flexible and open-minded attitude towards its own rules,” thereby ensuring that the opportunity to comment is “a meaningful opportunity.” *North Carolina Growers’ Ass’n, Inc. v. United Farm Workers*, 702 F.3d 755, 763 (4th Cir. 2012). These provisions afford an opportunity for “the agency promulgating the rule to educate itself before establishing rules and procedures which have a substantial impact on those regulated.” *Batterton v. Marshall*, 648 F.2d 694, 704 (D.C. Cir. 1980). Where comment letters point out a problem with an agency’s rule, and the agency’s response is tangential because it recharacterizes the comment and ducks the problem, rather than responding fairly to the comment, the agency’s action is arbitrary and capricious. *Lilliputian Systems, Inc. v. Pipeline and Hazardous Materials Safety Admin.*, 741 F.3d 1309, 1313-14 (D.C. Cir. 2014). Where “The public comments repeatedly draw the agency’s attention to the combined adverse effect of the challenged rules” and yet “time and again, the agency sidesteps this fundamental concern” the agency acts unlawfully. *Casa de Maryland, Inc. v. Wolf*, 2020 WL 5500165 at *26 (D. Md. 2020). An agency can’t “brush aside important facts.” *Non sequiturs* don’t meet the agency’s legal obligation to fairly respond to public comments. *Casa de Maryland*, at *27.

A typical response to comment is

Comment 59: Two commenters stated that there is no single DOCX standard to which Microsoft Word and the other word processors are all compliant.

Response: DOCX is a word-processing file format that is part of Office Open XML (OOXML), an XML-based open standard approved by the Ecma International® consortium and subsequently by the ISO/IEC joint technical committee.

For more information about the OOXML standard, please see:

- ECMA-376 at <http://www.ecma-international.org/publications/standards/Ecma-376.htm>
- ISO/IEC 29500 at <https://www.iso.org/committee/45374/x/catalogue/>
- NIST votes for U.S. Approval of OOXML at <https://www.nist.gov/news-events/news/2008/03/nist-votes-us-approval-modified-office-open-xml-standard>

The “Comment 59” paraphrase of the “comment” is inaccurate, and therefore the “response” adds nothing useful to the conversation. None of the comments in Exhibit C of this letter challenge the general proposition that DOCX is covered by the ECMA and ISO/IEC standards.

Rather, the comments note that the standards don't go far enough to cover the issues required for interoperability. The PTO's "response," that the standards exist and cover DOCX, has nothing to do with the actual comments, and doesn't address the underlying problem. Nowhere in either the NPRM or the Final Rule notice does the PTO ever aver that DOCX is reliably interoperable among DOCX word processors, only that standards exist. That proves nothing. The PTO never suggests it performed a series of experiments to contradict the experiments described in the comment letters. The Final Rule notice communicates neither an understanding of technology nor a good faith and open-minded approach to public comments.

Similarly, at 85 Fed. Reg. 46957, col. 2, the Final Rule notice reads:

DOCX is supported by many popular word-processing applications, such as Microsoft Word, Google Docs, Pages, and LibreOffice.

That comment is irrelevant, and only reflects a pattern of deflection by rewriting comments instead of replying directly to them. I reviewed all the comment letters, and not a single one even alleges that any of these programs cannot *open* a DOCX (though one comment¹⁴ showed an instance in which WordPerfect couldn't open a DOCX that was perfectly acceptable to other word processors). The comments all raise the same relevant question: when the same document is opened in different word processors, different word processors don't reliably show the same content. As the letters in Exhibit C explain, they don't. The Final Rule notice pointedly avoids addressing the relevant issue raised in the comment letters.

This is a pattern in the "response to comments" section of the DOCX section of the Final Rule notice—many of the "comment" paraphrases are no more than a parody of the author's original comment, and thus the "response" only irrelevant evasion.

C. The Final Rule is contrary to statute: it fails to discuss burden on the public

The Paperwork Reduction Act requires "[a]gencies ... to minimize the burden on the public to the extent practicable." "to minimize the burden on the public to the extent practicable. See 44 U.S.C. § 3507(a)(1)."¹⁵ By statute, the PTO was required to consult with the public to "evaluate the accuracy of the agency's estimate of the burden" and "minimize the burden of the collection of information on those who are to respond." 44 U.S.C. § 3506(c)(2)(A)(ii) and (iv). An agency must "take[] every reasonable step to ensure that the proposed collection of information ... [i]s the least burdensome necessary for the proper performance of the agency's functions" 5 C.F.R. § 1320.5(d)(1). An agency may seek to reduce costs to itself, but "shall not do so by means of shifting disproportionate costs or burdens onto the public." 5 C.F.R. § 1320.5(d)(iii).

¹⁴ Seventy-Three Patent Practitioners, note 11 *supra*, at page 19.

¹⁵ *Dole v. United Steelworkers of America*, 494 U.S. 26, 32 (1990).

The Final Rule notice is strikingly silent on burden *on the public*. The Final Rule notice only discusses cost saving for the PTO. For example, 85 Fed. Reg. at 46947, col. 2, and 46957, col. 2, read as follows:

time-consuming and costly step. Optical character recognition (OCR) of image-based filings costs the Office approximately \$3.15 per new submission. In addition to the initial submission, the use of image-based PDFs incurs many costs over the lifetime of an application. There are large costs associated with the USPTO's systems and personnel—from pre-examination, examination, and publication—due to the need to apply OCR to convert image-based PDFs into structured text that can be leveraged by downstream systems. The surcharge is applied not only to account for these inefficiencies, but also to address rising expenses. Encouraging text-based filings

Response: The use of image-based PDFs incurs many costs over the lifetime of an application. There are large costs associated with the USPTO's systems and personnel, from pre-examination, examination, and publication, due to the need to apply OCR to convert image-based PDFs into structured text that can be leveraged by downstream systems. The surcharge is applied not only to account for these inefficiencies, but also to address rising expenses.

Reducing costs is good, even if those costs are only \$3.15 per application. But reducing costs by \$3.15 by raising costs on the public by hundreds of dollars is not only foolish, it's illegal. 44 U.S.C. § 3507(a) (“An agency shall not conduct or sponsor the collection of information unless” it has followed the procedures of the Paperwork Reduction Act, which requires fair response to comments); 5 C.F.R. § 1320.5(d)(iii). The illegality is compounded by the PTO's evasive approach to responding to comments.

D. The PTO's pattern of deflection and falsehood suggests and inference of bad faith

As Carl Oppedahl (a patent attorney in Colorado, formerly a member of PPAC) wrote in his comment letter (see Exhibit C), a number of the Patent Office's statements are “disingenuous at best, and border[] on falsity.” That was the Notice of Proposed Rulemaking. The Final Rule notice is well over the border. When an agency excludes serious consideration of serious alternatives, and instead creates a record that demonstrates a single-minded commitment to a pre-ordained result, the agency rule is void. *Connecticut Light & Power Co. v. Nuclear Regulatory Commission*, 673 F.2d 525, 536 (D.C. Cir. 1982) (requiring an agency to accept alternatives).

For example, at 85 Fed. Reg. 46956, the Final Rule notice states:

To date, the Office has not received notifications of any issues resulting from the filing of applications in DOCX format. If there is an instance in which

This is a falsehood, and surrounding circumstances support an inference that it's an intentional falsehood. Carl Oppedahl's letter gives an example of an equation that was altered when Patent Center accepted a DOCX. This letter was sent to the Patent Office in August 2019. I am aware of a conference and email discussion between AIPLA and Deputy Director Peter in May 2020 that raised these issues.¹⁶ I contributed several "notifications of issues" that were reported through a group effort into IdeaScale in June and July (before publication of the Final Rule), and many more reported in August and September.¹⁷ For the Federal Register to report on August 3, 2020 to report "the Office has not received notification of any issues" is somewhat beyond reckless disregard for the truth. The goal of the falsehood would be to whitewash the PTO's refusal to address the facts raised in the Notice and Comment letters and various emails.¹⁸

¹⁶ Carl Oppedahl reported this conversation in his blog. See Exhibit D.

¹⁷ The non-responsiveness of the PTO and EBC to bug reports is addressed in several of Carl's blog posts. See Exhibit D. Far too often, EBC's response is some variation on "We won't fix it." See his posts, *USPTO's Ideascapade — where good ideas go to die* (Jun 16, 2020), *Dozens of bugs in PatentCenter remain unattended-to* (Sep 20, 2020) and *"We're unable to reproduce this issue" say the PatentCenter developers* (Sep. 23, 2020).

¹⁸ The Final Rule notice states:

format. If there is an instance in which an error occurs, the Electronic Business Center (EBC) should be contacted for investigation at 1-866-217-9197 (toll-free), 571-272-4100 (local), or *ebc@uspto.gov*. The EBC is open from 6:00 a.m. to 12:00 midnight ET, Monday through Friday.

Many people have "contacted EBC" about DOCX failures of Patent Center. EBC has been very little help. The non-responsiveness of EBC is described in several of Carl Oppedahl's articles (see Exhibit D). The non-responsiveness of EBC means that "contacts" to EBC are collections of information with no "practical utility." "Contacting EBC" is an unapprovable information collection.

Likewise, the Final Rule notice says (85 Fed. Reg. at 46985, col. 2):

U.S.C. 3501–3549). The collection of information involved in this Final Rule have been reviewed and previously approved by the OMB under control numbers 0651–0012, 0651–0016, 0651–0020, 0651–0021, 0651–0031, 0651–0032, 0651–0033, 0651–0059, 0651–0063, 0651–0064, 0651–0069, and 0651–0075. In addition, updates to the aforementioned information collections as a result of this Final Rule have been submitted to the OMB as non-substantive change requests.

This is a falsehood. The only two Control Numbers where this DOCX collection of information would have been “reviewed and approved” are 0651-0031 and -0032, and neither has a relevant filing in the relevant time period.¹⁹

OMB Control Number History				
OMB Control Number:0651-0031				
ICR Ref. No.	Request Type	Date Received By OIRA	Conclusion Date	Conclusion Action
201910-0651-004	No material or nonsubstantive change to a currently approved collection	10/11/2019	10/29/2019	Approved without change
201802-0651-002	No material or nonsubstantive change to a currently approved collection	03/15/2018	04/03/2018	Approved without change
201712-0651-005	No material or nonsubstantive change to a currently approved collection	12/11/2017	12/13/2017	Approved without change
201711-0651-013	Revision of a currently approved collection	11/17/2017	12/11/2017	Improperly submitted and continue

OMB Control Number History				
OMB Control Number:0651-0032				
ICR Ref. No.	Request Type	Date Received By OIRA	Conclusion Date	Conclusion Action
202003-0651-002	No material or nonsubstantive change to a currently approved collection	07/13/2020	09/16/2020	Approved without change
201908-0651-004	No material or nonsubstantive change to a currently approved collection	10/08/2019	10/29/2019	Approved without change
201712-0651-019	No material or nonsubstantive change to a currently approved collection	12/15/2017	12/21/2017	Approved without change
201712-0651-012	No material or nonsubstantive change to a currently approved collection	12/11/2017	12/13/2017	Approved without change
201711-0651-009	Revision of a currently approved collection	11/17/2017	12/11/2017	Improperly submitted and continue

¹⁹ Office of Information and Regulatory Affairs, OMB Control Number History for 0651-0031 and -0032, <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0031> and <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0032> The ICR in 0651-0031 for October 2019 ICR 201910-0651-004 <https://www.reginfo.gov/public/do/DownloadDocument?objectID=95682501> was reported to OMB as “no material change or nonsubstantive change” and included only fee adjustments. Just for good measure, I looked at 0651-0043 (financial transactions) too—nothing: None have any mention of “docx” or § 1.16(u).

The falsity of the claim of “reviewed and previously approved” in the NPRM was pointed out in one of the comment letters.²⁰ Yet it’s repeated in the Final Rule. We all make false statements by accident. But when a false statement is repeated after it’s pointed out, the fair inference is that the falsehood is intentional. The goal of the intentional falsehood would be to evade oversight by OMB under the Paperwork Reduction Act.

The Final Rule notice reads (85 Fed. Reg. 46956 col. 2):

examination and maintaining the quality of patents issued. According to surveys conducted by the USPTO, the majority of applicants use word-processing software, such as Microsoft Office and LibreOffice, to author applications in DOCX format. These

There’s no obvious way for these parties to avoid the \$400 fee. In the NPRM, the PTO acknowledged that the affected population would be about 20% of the total. NPRM, 84 Fed. Reg. 37413. In other words, the PTO knew the cost balance perfectly well: it knew it was raising costs on 20% of the patent filing public by \$400 in order to save itself \$3.15 per application. An agency rule is invalid when the agency failed to consider total balance of costs and benefits on all parties—agencies can’t carve out minorities and not care about effects on them.²¹

Under the Paperwork Reduction Act, the PTO is required to estimate “burden” on the minority that doesn’t use DOCX. The PTO was reminded of this in one of the comment letters.²² Neither Executive Order 12866 nor Executive Order 13771 nor the Paperwork Reduction Act have exceptions for rules invokeable on an agency’s say-so, that the rule affects only a minority of members of the public, no matter what the costs are on that minority. The fair inference is that the PTO used this sleight-of-hand to avoid disclosing roughly \$40 million of burden to OMB.

The Final Rule notice reads (Fed. Reg. 46970, col. 1):

²⁰ Seventy-Three Patent Practitioners, note 11 *supra*, at pages 12, 22, and 23.

²¹ *Public Citizen v. Mineta*, 340 F.3d 39, 57–58 (2d Cir. 2003); *Mid-Tex Electric Cooperative Inc. v. Federal Energy Regulatory Comm’n*, 773 F.2d 327, 357-60 (D.C. Cir. 1985).

²² Seventy-Three Patent Practitioners, note 11 *supra*, at page 20.

Response: Guidance in OMB Circular A-4, Regulatory Analysis, and concerning RIAs provides that fees to government agencies for goods or services are considered transfer payments. The fee adjustments concern increases of fees for USPTO services, which are transfers, not costs. The non-DOCX surcharge fee is based on the services provided by the USPTO to patent applicants and, consequently, qualifies as a transfer payment under OMB's guidance. As noted in response

This is a falsehood. Circular A-4 reads “the revenue collected through a fee, surcharge *in excess of the cost of services provided*, or tax is a transfer payment.” First, misquotation from Circular A-4 is hard to explain as anything other than an intentional lie. Second, while \$396.85 of the DOCX surcharge is fairly characterized as a “transfer payment,” \$3.15 isn’t. Third, the PTO characterized *the entire DOCX rule* and the entire fee-setting as a “transfer payment.” Since the PTO’s fees are calibrated to costs of services provided, the fee-setting portion of the rule isn’t remotely a transfer payment. The PTO used this lie, apparently, to evade the work required by Executive Orders 12866 and 13771, and to evade oversight by OMB.²³

Both OMB and SBA review agency rules on an *ex parte* basis—for some reviews, the public has no notice or participative role; in others, the public can file one round of comment letters, but the agency has an *ex parte* opportunity to change its position and offer alternative explanations and evidence on an entirely *ex parte* basis. All attorneys working on this rule and information collection review should be aware of Rule of Professional Responsibility 3.3:²⁴

Rule 3.3: Candor Toward the Tribunal

(a) A lawyer shall not knowingly:

- (1) make a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the lawyer;
- (2) fail to disclose to the tribunal legal authority in the controlling jurisdiction known to the lawyer to be directly adverse to the position of the client and not disclosed by opposing counsel; or

²³ More examples of falsehoods calculated to evade review by OMB and by the Small Business Administration are described in David Boundy, *An Administrative Law View of the PTAB's 'Ordinary Meaning' Rule* (January 30, 2019), Westlaw Journal Intellectual Property 25:21 13-16 (Jan 30 2019), available at <https://ssrn.com/abstract=3326827>.

²⁴ American Bar Association, Model Rule of Professional Responsibility 3.3, https://www.americanbar.org/groups/professional_responsibility/publications/model_rules_of_professional_conduct/rule_3_3_candor_toward_the_tribunal

(3) offer evidence that the lawyer knows to be false. If a lawyer, the lawyer's client, or a witness called by the lawyer, has offered material evidence and the lawyer comes to know of its falsity, the lawyer shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal. A lawyer may refuse to offer evidence, other than the testimony of a defendant in a criminal matter, that the lawyer reasonably believes is false.

(b) A lawyer who represents a client in an adjudicative proceeding and who knows that a person intends to engage, is engaging or has engaged in criminal or fraudulent conduct related to the proceeding shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal.

(c) The duties stated in paragraphs (a) and (b) continue to the conclusion of the proceeding, and apply even if compliance requires disclosure of information otherwise protected by Rule 1.6.

(d) In an ex parte proceeding, a lawyer shall inform the tribunal of all material facts known to the lawyer that will enable the tribunal to make an informed decision, whether or not the facts are adverse.

Lack of candor—merely avoiding the truth—has consequences for the individual lawyers involved. An extended pattern of apparently-intentional falsehood has bigger consequences.

Rule 3.3(b) requires cure. There are two options. (i) If the PTO wishes to proceed further with the DOCX rule, the PTO is required to provide a candid (that is, truthful and complete) disclosure of “all material facts” to OMB (under Executive Orders 12866 and 13771, and the Paperwork Reduction Act) and to the Small Business Administration (under the Regulatory Flexibility Act), and rewind this rule for a “do over” that complies with all requirements of law. Alternatively, (ii) Rule 3.3(c) would be satisfied if the PTO publishes a Federal Register notice stating that the DOCX rule is irrevocably withdrawn, and the PTO will work with the patent bar to identify a better solution that meets both the PTO's needs and the public's.²⁵ In that case, the proceeding will be “terminated” and Rule 3.3 will be satisfied.

Mistakes happen. While there's no “oops” exception to notice-and-comment requirements, *American Wild Horse Preservation Campaign v. Perdue* 873 F.3d 914, 924 (D.C. Cir. 2017), there's a certain amount of room for human error and differences of judgment. But this Final Rule notice is well outside that bound.

²⁵ Such a better solution was suggested in several of the comment letters, for example, Seventy-Three Patent Practitioners, note 11 *supra*, at page 13. Since September 2019, I've done further investigation, and have learned of “accessible PDF” which seems to solve everyone's problem in a consistent and reliable way. I hope we can start a conversation on that. My email address and phone number are in the page footer.

E. Multiple procedural lapses make the DOCX information collection unlawful and ineligible for approval

An agency is required to do the following, for essentially every rule (“rule” in the broad sense of 5 U.S.C. § 551(4), whether a C.F.R. regulation or in guidance, 5 C.F.R. § 1320.3(c)(1), § 1320.3(c)(4)) that calls for the collection of paperwork from the public:²⁶

- Before promulgating the rule, confer with members of the public to get a fair assessment of the likely costs and benefits.
- As part of the notice-and-comment process for any C.F.R. regulation, and as part of notice-and-comment for updates to major guidance documents, assemble cost estimates, and disclose them to OMB in a filing, and get OMB approval.
- Every three years, repeat the consultation and OMB filing process.
- If the agency skips these steps, the rule is unenforceable. 44 U.S.C. § 3507(a), § 3512.

The PTO was required to do the following to promulgate the DOCX rule, and didn’t:

<p>Before the Notice of Rulemaking, the PTO was to “consult with members of the public”²⁷ to evaluate the following, so that initial burden estimates could be proposed in the Notice of Proposed Rulemaking:²⁸</p> <p>(i) whether the proposed collection of information is necessary for the proper performance of the functions of the agency;</p> <p>(ii) the accuracy of the agency’s estimate of the burden;</p> <p>(iii) how to enhance the quality, utility, and clarity of the information to be collected; and</p> <p>(iv) minimize the burden of the collection of information on those who are to respond.</p>	<p>In contacted several of the relevant committee chairmen at ABA, AIPLA, and IPO that that would have been the likely contacts. None remember <i>ever</i> being contacted by the PTO concerning the DOCX rule, let alone during the process of formulating the rule.</p>
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²⁶ *Dole v. Steelworkers*, note 15 *supra*, 494 U.S. at 33.

²⁷ The requirement to “consult with members of the public” before a Notice of Proposed Rule Making (NPRM) is not literally in the text of the statute, but arises out of the interdependencies between required steps, and the practical reality that the PTO has no internal sources of objective compliance cost information, and can only obtain objective cost information by conferring with the public. For information collection requests contained in a proposed rule, 44 U.S.C. § 3507(d)(1)(A), 5 C.F.R. § 1320.5(a)(3) and § 1320.11(b) require that an agency submit an ICR to OMB “as soon as practicable, but no later than the date of publication of a notice of proposed rulemaking in the Federal Register.” An agency also is required, by 44 U.S.C. § 3507(a)(1)(D)(ii)(V) and 5 C.F.R. § 1320.5(a)(iv), to publish a notice in the Federal Register “setting forth ... an estimate of the burden that shall result from the collection of information.” § 3506(c)(1)(A)(iv) and § 1320.8(a)(4) require that any burden estimate submitted to the OMB Director, including those under § 3507(d)(1)(A), be “objectively supported.”

²⁸ 44 U.S.C. § 3506(c)(2) and 5 C.F.R. § 1320.8(d)(1).

<p>The PTO was required to submit this rule to the Director of OIRA, with “objectively supported” estimates, no later than the time of a Notice of Proposed Rulemaking.²⁹ As part of this submission, the PTO was required to must certify, and provide a record in support of the certification,³⁰ that:</p> <ul style="list-style-type: none"> (a) the information to be collected “is necessary for the proper performance of the functions of the agency”;³¹ (b) the agency is not seeking “unnecessarily duplicative” collection of “information otherwise reasonably accessible to the agency”;³² (c) the agency “has taken every reasonable step to ensure that the proposed collection of information ... is the least burdensome necessary”;³³ and (d) the regulations are “written using plain, coherent, and unambiguous terminology.”³⁴ 	<p>Required disclosure/discussion is not in the NPRM, and nothing is at the OMB web site in the months leading up to the July 2019 Notice of Proposed Rulemaking.</p>
<p>A Notice of Proposed Rulemaking required the following:</p> <ul style="list-style-type: none"> (e) the Notice must be accompanied by disclosure of the PTO’s assumptions, factual data and bases, and analyses;³⁵ (f) the Notice must present (or be accompanied by) the PTO’s burden estimates, and permit a 30- or 60-day comment period for the burden estimates under the Paperwork Reduction Act;³⁶ (g) the Notice of Proposed Rulemaking must be accompanied by either a certification of “no substantial economic impact” on small entities or an Initial Regulatory Flexibility Analysis;³⁷ (h) because information disseminated in a Paperwork Reduction Act submission to OMB or a Notice of Proposed Rulemaking is “influential” information, the PTO must observe OMB Information Quality Guidelines and the PTO’s own Information Quality Guidelines.³⁸ 	<p>There is no discussion whatsoever of burden in the NPRM, no disclosure of any data relevant to burden in the fee setting web site, and no record of any relevant filing at the OMB web site.</p> <p>No supporting data for the PTO’s assertions relative to the DOCX rule is on the web site.</p>

²⁹ Reading 44 U.S.C. § 3507(d)(1) and § 3506(c)(2)(A) together. Strikingly, several of the PTO’s Notices of Proposed or Final Rule Making in 2006–2008 stated that the PTO refused to make a Paperwork filing with OMB, for reasons that have no grounding in any statute or regulation.

³⁰ 44 U.S.C. § 3506(c)(3) and 5 C.F.R. § 1320.9.

³¹ 44 U.S.C. § 3506(c)(3)(A) and 5 C.F.R. § 1320.5(d)(1)(i) (“ To obtain OMB approval of a collection of information, an agency shall demonstrate that it has taken every reasonable step to ensure that the proposed collection of information: (i) Is the least burdensome necessary for the proper performance of the agency’s functions...”).

³² 44 U.S.C. § 3506(c)(3)(B) and 5 C.F.R. § 1320.5(d)(1)(ii).

³³ 44 U.S.C. § 3506(c)(2)(A)(iv) and 5 C.F.R. § 1320.5(d)(1)(i).

³⁴ 44 U.S.C. § 3506(c)(3)(D) and 5 C.F.R. § 1320.9(d).

On or before the date of publication of the Federal Register notice of a final rule: (i) the PTO must submit the rule to OMB for another round of review under the Paperwork Reduction Act, with a 30-day public comment period. ³⁹ A wise agency completes this step before publishing a final rule notice for a controversial rule. (j) The PTO must certify “no substantial economic effect” on small entities or provide a Final Regulatory Flexibility Analysis. ⁴⁰	The PTO didn’t do either of these.
In the Federal Register notice of a final rule: (k) The PTO must explain its response to all comments from OMB or the public, and the reasons any comments were rejected; ⁴¹ (l) The final rule notice must include supporting explanation and factual data sufficient to satisfy <i>State Farm</i> criteria for “arbitrary and capricious.” ⁴²	

In the Final Rule notice, the word “burden” is not used a single time in a relevant context. The word “cost” is used repeatedly, but only in phrases like “costs to the Office,” never (in the

³⁵ E-Government Act of 2002, Pub.L. 107-347 (Dec. 17, 2002), § 206(d), codified in notes to 44 U.S.C. § 3501 (“To the extent practicable, as determined by the agency in consultation with the Director [of OMB], agencies shall ensure that a publicly accessible Federal Government website contains electronic dockets for rulemakings under [5 U.S.C. § 553]. ... Agency electronic dockets shall make publicly available online ... other materials that by agency rule or practice are included in the rulemaking docket under [5 U.S.C. § 553(c)]”); *Owner-Operator Independent Drivers Ass’n v. Fed Motor Co.*, 494 F.3d 188, 199–203 (D.C. Cir. 2007) (rule invalid when agency failed to disclose the data and assumptions on which it based its cost-benefit analyses).

³⁶ 44 U.S.C. § 3506(c)(2)(B) and 5 C.F.R. § 1320.8(d)(1). Notice of the rule and the agency’s estimates must be provided to OMB and published in the Federal Register no later than the Notice of Proposed Rulemaking or other notice of the rule, then the agency must allow 30 days for comments, and then OMB has up to 60 days to approve or disapprove. 5 C.F.R. § 1320.11(b), (c) and (h) (collections of information in proposed rules and final notices).

³⁷ 5 U.S.C. §§ 603 and 605.

³⁸ The Information Quality Act is embodied in Public Law 106-554 § 515, codified in notes to 44 U.S.C. §§ 3504 and 3516. The PTO bound itself to this statute in its Information Quality Guidelines, <http://www.uspto.gov/web/offices/ac/ido/ifoqualityguide.html>.

³⁹ 5 C.F.R. § 1320.11(h).

⁴⁰ 5 U.S.C. §§ 604 and 605.

⁴¹ The requirements for fair or robust responses to comments arise under the Paperwork Reduction Act, 44 U.S.C. § 3507(a)(1)(B) and § 3507(d)(2)(A) and (B); 5 C.F.R. § 1320.5(a)(1)(ii) and § 1320.11(f); the Administrative Procedure Act (5 U.S.C. § 553); and the Regulatory Flexibility Act.

⁴² *Motor Vehicle Manufacturers’ Ass’n of the U.S. v. State Farm Mutual Automobile Insurance Co.*, 463 U.S. 29, 52 (1983).

DOCX section) in a phrase like “costs to applicants.” For example, comment 46 was directed to costs and burdens to applicants, response 46 ignores the question and discusses only costs to the Office:

Comment 46: Multiple commenters opposed the \$400 surcharge for filing in non-DOCX format, suggesting it was unreasonable given the USPTO’s own cost figures, to apply optical character recognition (OCR) to convert a patent application submitted in PDF format. One commenter stated that the proposed benefits do not appear to justify the costs of the rule, and there does not appear to have been consideration of approaches that reduce burdens and maintain flexibility and freedom of choice for the public.

Response: The use of image-based PDFs incurs many costs over the lifetime of an application. There are large costs associated with the USPTO’s systems and personnel, from pre-examination, examination, and publication, due to the need to apply OCR to convert image-based PDFs into structured text that can be leveraged by downstream systems. The surcharge is applied not only to account for these inefficiencies, but also to address rising expenses.

The Final Rule notice couldn’t be clearer: the PTO violated the Paperwork Reduction Act by entirely ignoring burden on the public. The “disproportionate shift of costs or burdens onto the public,” 5 C.F.R. § 1320.5(d)(iii), is facially apparent.

F. The PTO erred hiding its data

An agency errs when it relies on data it kept hidden from the public. One oft-cited decision from the D.C. Circuit explains:

In order to allow for useful criticism, it is especially important for the agency to identify and make available technical studies and data that it has employed in reaching the decisions to propose particular rules. To allow an agency to play hunt the peanut with technical information, hiding or disguising the information that it employs, is to condone a practice in which the agency treats what should be a genuine interchange as mere bureaucratic sport. An agency commits serious procedural error when it fails to reveal portions of the technical basis for a proposed rule in time to allow for meaningful commentary.

Connecticut Light & Power Co. v. Nuclear Regulatory Commission, 673 F.2d 525, 530 (D.C. Cir. 1982); *also Home Box Office, Inc. v. FCC*, 567 F.2d 9, 54 (D.C.Cir.1977) (“[e]ven the possibility that there is here one administrative record for the public and this court and another for the [agency] and those ‘in the know’ is intolerable”); *Hanover Potato Products, Inc. v. Shalala*, 989 F.2d 123, 129-130, n.9 (3d Cir. 1993) (agency erred when it denied public access to “the true record” by hiding part of it: “We believe a regulated party automatically suffers prejudice when members of the public who may submit comments are denied access to the complete public record.”).

In the Final Rule notice, the PTO admits it relied on a secret “yearlong study:”

Comment 55: One commenter wrote that instead of DOCX, applicants could upload most of their submissions as text-based PDFs. The commenter further stated that, currently, the USPTO's computer systems degrade files to flatten them to unstructured bitmaps. The commenter contends the problem is caused by the USPTO.

Response: The USPTO conducted a yearlong study of the feasibility of processing text in PDF documents. The results showed that searchable text data is available in some PDFs, but the order and accuracy of the content could not be preserved. With DOCX, the Office is able to use the text directly and pass it on to USPTO downstream systems, which results in increased data accuracy and a more streamlined patent process.

This “study” was never mentioned in the July 2019 Notice of Proposed Rulemaking. There’s no mention of it on the PTO’s rulemaking web site, no disclosure of the study methodology, etc.

First, the existence of this sentence in the Final Rule notice violates multiple laws. If there was any such “yearlong study,” the PTO was required to make it public, as part of the materials available during the notice and period:

- The Administrative Procedure Act, 5 U.S.C. § 553, requires fair “notice” of all supporting materials for rules, so that the public’s right to comment is more than “bureaucratic sport.” *Connecticut Light*, 673 F.2d at 530.
- The E-Government Act of 2002 required disclosure in the agency’s electronic docket. See footnote 35.
- The PTO can’t rely on a “yearlong study” that it hasn’t made available to the public to permit vetting for “quality, objectivity, utility, and integrity.” How was the “study” conducted? What alternatives were considered, what variables were studied and formed the basis for any conclusion, what was the null hypothesis, what was the conclusion, at what confidence level? The PTO violated the Information Quality Act⁴³ and the PTO’s own Information Quality Guidelines.⁴⁴ The PTO promised not to rely on secret information; the PTO broke both the law and a promise to the public.

⁴³ Public Law 106-554 § 515, codified in notes to 44 U.S.C.A. §§ 3504 and 3516.

⁴⁴ U.S. Patent and Trademark Office, Information Quality Guidelines, <http://www.uspto.gov/web/offices/ac/ido/ifoqualityguide.html>.

Reliance on this secret “yearlong study” was unlawful. Courts invalidate rules that an agency promulgates over this kind of “serious procedural error.” *Gerber v. Norton*, 294 F.3d 173, 181-84 (D.C. Cir. 2002); *Hanover Potato*, 989 F.2d at 129-130.

Second, if any such “yearlong study” was actually conducted, it was a really poor study. For all that appears in the Final Rule notice, it may have been a study designed to reach one and only one outcome. Secondly, it appears to have disregarded “accessible PDF,” a text-based PDF form that solves the problems mentioned in the Final Rule notice, and solves the problems raised in the public comment letters. The PTO is fully aware of “accessible PDF”—the PTO’s web site refers to “accessible PDF” several times,⁴⁵ as the PTO’s preferred format for documents the PTO submits to courts. If the PTO’s “yearlong study” didn’t address “accessible PDF,” then that study fails Information Quality and may not be relied on.

Third, it appears that the “yearlong study” asked the wrong question, or at least a different question than the PTO asked the public to comment on. The Notice of Proposed rulemaking explained the problems with “image-based” documents, and suggested that “text-based” or “structured text” documents are the solution. E.g., 84 Fed. Reg. 37413-14, col. 1-3. The issue as the PTO framed it was the issue the public commented on, by suggesting text-based PDFs. Now the PTO is changing position—“text-based” submissions aren’t good enough, they have to be DOCX text based documents. The Final Rule notice never explains the change of position.

Fourth, Response 55 only discusses its costs to the PTO. There’s not a single word of consideration of burden on the public—for example, the word “burden” is never used a single time in any relevant context in the Final Rule notice. Why was there no “yearlong study” of burden on the public? That violates the Paperwork Reduction Act, as discussed in section I.C of this letter. Absence of any study of burden on the public was unlawful.

If the PTO had set out on an Easter egg hunt for falsehoods to tell and laws to break, it’s hard to see what more the PTO could have packed into this rule. The collection of information should be removed from the ICR request and 37 C.F.R. § 1.16(u) should recede to its 2019 form.

II. Various provisions of the MPEP that conflict with 15 C.F.R. § 29.2 and Executive Order 13891 should not be included in any request for clearance and should be backed out from the MPEP

In September, the Department of Commerce issued new regulations, 15 C.F.R. part 29, as implementing regulations for Executive Order 13891. Among the new regulations that bind the PTO are the following:

⁴⁵ <https://e-foia.uspto.gov/Foia/DispatchFCAServlet?SupremeCourtResults=true>; <https://e-foia.uspto.gov/Foia/DispatchABServlet?RetrieveAll=true>

§ 29.2 Procedures for issuing guidance documents.

(a) The Department will indicate prominently that each guidance document does not bind the public, except as authorized by law or as incorporated into a contract.

(b) The Department will comply with Executive Orders 12866, 13563, 13609, 13771 and 13777 in issuing guidance documents.

(c)(1) For a significant guidance document, as determined by the Administrator unless the Department and the Administrator agree that exigency, safety, health, or other compelling cause warrants an exception from some or all requirements, the Department will:

(i) Provide a period of public notice and comment of at least 30 days before issuance of a final guidance document, and a public response from the Department to major concerns raised in comments, [immaterial exceptions];

(ii) Seek approval on a non-delegable basis by the Secretary or by a Department component head appointed by the President, before issuance; and

(iii) Submit the significant guidance document for review by OIRA under Executive Order 12866 before issuance.

In a parallel course of events, the Administrative Conference of the United States issued [recommendations](#) in August 2019 (that is, over a year ago):

1. An agency should not use an interpretive rule to create a standard independent of the statute or legislative rule it interprets. That is, noncompliance with an interpretive rule should not form an independent basis for action in matters that determine the rights and obligations of any member of the public.

2. An agency should afford members of the public a fair opportunity to argue for modification, rescission, or waiver of an interpretive rule. ...

4. An agency should prominently state, in the text of an interpretive rule or elsewhere, that the rule expresses the agency's current interpretation of the law but that a member of the public will, upon proper request, be accorded a fair opportunity to seek modification, rescission, or waiver of the rule.

A year after Executive Order 13891, a year after the ACUS recommendations, and two months after Commerce's regulations, there's no apparent effort to implement any of the three. For example, a google search "13891 site:uspto.gov" gives exactly zero relevant hits.

The following collections of information should be removed from the ICR request:

- The PTO has a number of guidance documents not incorporated into the MPEP relating to Application Data Sheets. *E.g.*, *Important Information for Completing an Application Data Sheet (ADS)*, <https://www.uspto.gov/patent/forms/important-information-completing-application-data-sheet-ads> and *Understanding the Application Data Sheet (ADS): Little Things Make a Big Difference*, <https://www.uspto.gov/sites/default/files/documents/ADS%20Follow-UP%20info%20chat%20june.pdf> that go above the requirements stated in 37 C.F.R. § 1.79. For example, these guidance documents (and the practice in Office of Initial Examination) require that benefit/priority claims must be in reverse chronological order.

There's no such requirement in the regulation. Similarly, these two guidance documents create the confusing situation that an ADS filed on day 2 of a patent application's life must be very different than an ADS filed on day 1. These two guidance documents are deeply flawed, and create tens of millions of dollars of costs for the public when surprise rules are asserted.

- These two guidance documents should be withdrawn.
- The Office of Initial Examination should be instructed that they may enforce the C.F.R. regulations as written, and no more.
- These collections of information should be withdrawn from the ICR request.
- The June 2020 revision to the MPEP revised MPEP § 706.07(b) in a way that creates substantial burdens. The new burden is explained in Julie Burke, Michael Spector, and William Smith, *Newly Created First Action Final Rejection Policy Adds Needless Complications to Patent Prosecution*, IP Watchdog (Sep 22, 2020), attached as Exhibit E. Notice and comment was required under Executive Order 13891 § 4(A); the PTO ignored the law. The revision to the MPEP created new burden and required information collection procedures under the Paperwork Reduction Act, 5 C.F.R. § 1320.10; the PTO ignored the law. This collection of information should be removed from the ICR request, and the MPEP should recede to the 2018 version.
- MPEP § 1207.04, by granting examiners the authority to abort an appeal and reopen prosecution without the protections that favor appellants in 37 C.F.R. § 41.39(b). 37 C.F.R. § 41.39(b) is the deal that was negotiated fair and square between the PTO and the public, and has the imprimatur of notice-and-comment rulemaking. MPEP § 1207.04 underwent none of the procedures that give it force of law, and it's inconsistent with regulation. MPEP § 1207.04 should be removed from the MPEP and removed from the ICR request.
- MPEP § 2144.03(C) states "To adequately traverse such a finding, an applicant must ... [state] why the noticed fact is not considered to be common knowledge or well-known in the art." That's incorrect, both as a matter of patent law and as a matter of administrative law. The burden of proof is on the examiner. The operative regulation is 37 C.F.R. § 1.104(d)(2), which permits an applicant to traverse by simply "calling for" evidence. it has never been lawful for an agency to attenuate a regulation that favors the public by creating carve-outs in guidance documents, *Perez v. Mortgage Bankers' Ass'n*, 575 U.S. 92, 101 (2015) (the APA mandates that "agencies use the same procedures when they amend or repeal a rule as they used to issue the rule in the first instance."); *Berkovitz v. U.S.*, 486 U.S. 531, 536 (1988) (when "a federal statute, regulation, or policy specifically prescribes a course of action for an employee to follow" and that course runs in favor of the public, then "there is no discretion in the conduct" to go any other way).
- A survey of my colleague patent attorneys leads to an estimate that the PTO's misuse of guidance imposes excess costs on the public of close to **\$2 billion per year**. I wrote an article explaining some examples, David Boundy, *Agency Bad Guidance Practices at the Patent and Trademark Office: a Billion Dollar Problem*, 2018 Patently-O Patent Law

Journal 20 (December 6, 2018), Available at <https://ssrn.com/abstract=3258040> The collections of information in that article should be removed.

Each of these collections of information should be removed from the ICR request, and the MPEP should recede to the version before the amendments discussed above.

III. Stepping back for the big picture: the real problem is the PTO's serial, willful, and pervasive defiance of administrative law

A. General problems

Sections I and II lay out several examples of the PTO's neglect of the basics of administrative law (the Administrative Procedure Act, the Paperwork Reduction Act, the Regulatory Flexibility Act, several Executive Orders, etc.). There are dozens more. The PTO's predictable deviations from administrative law—and consequent lack of predictability in day-to-day behavior is *profoundly* expensive—patent attorneys estimate *\$2 billion per year* in excess costs.⁴⁶ Though I have no way to know the subjective motivations of any of the individuals involved, many patent attorneys have noticed a *remarkable* correlation between the PTO's misuse of guidance and principles of law whose enforcement would reduce the PTO's fee collections.

1. The PTO's legal machinery understands the Patent Act, but senior career staff have no understanding that procedural law is important. Several senior PTO employees have put it this bluntly—procedural law won't be implemented or enforced. One of the PTO's senior-most administrative patent judges told me when I asked about a plain-word black-letter *statutory* requirement, literally these words: “Mr. Boundy, aren't you putting form over substance?” Another (who is now top 20 career staff) told me some years ago, “That's just procedure. Let's talk about something that matters.” As you will see below, the Deputy Commissioner for Patent Examination Policy (who is the lawyer that most affects costs for patent applicants) has refused on multiple occasions to implement the Administrative Procedure Act, several executive orders, and the like.
2. **Stated policy to refuse to implement executive orders.** In 2011, I petitioned for implementation of Executive Order 12866 and the *Good Guidance Bulletin*. The decision on this petition was issued by the (now Deputy) Commissioner for Patent Examination Policy Robert Bahr, who refused on behalf of the entire PTO to implement the Executive Order. In Deputy Commissioner Bahr's view, because Executive Order 12866 and the *Good Guidance Bulletin* are not *judicially* enforceable, he has no obligation to implement them. See § III.B of this letter.

⁴⁶ David Boundy, *Agency Bad Guidance Practices at the Patent and Trademark Office: a Billion Dollar Problem*, 2018 Patently-O Patent Law Journal 20 (December 6, 2018), <https://ssrn.com/abstract=3258040>, available in Westlaw at “2018 Patently-O Pat. L.J. 20” attached as Exhibit A.

3. **Refusal to enforce examiner-facing guidance.** PTO guidance has a multitude of statements that fit the *Accardi* principle: “if an applicant does x, the examiner must y” or “the Office will y” (where y is procedurally favorable to the applicant). Despite clear law on the point, if a patent applicant does x, there’s no guarantee that y will happen. When the guidance rule is inconvenient or would reduce the PTO’s fee collections, exceptions appear. PTO supervisory staff, to the senior-most career staff, is *adamant* that promises made in guidance are not enforceable. I have a number of decisions signed by the Deputy Commissioner for Patent Examination Policy (the highest official to decide petitions), stating his personal refusal to honor the Supreme Court’s *Accardi* decision or to enforce the PTO’s guidance.
4. **Rules (non-interpretative)** against the public are promulgated as guidance, not regulation, and then enforced as if having force of law.
5. **Clash between regulation and guidance.** The PTO has regulations that run in favor of applicants to provide procedural rights. The PTO also has guidance that creates carveouts from those regulations—not *interpretations* of ambiguity, but free-standing carveouts that directly clash with the regulation. These are amended from time to time, with no notice-and-comment.
6. **Enforced against the public.** The PTO regularly enforces guidance against the public as if it had force of law.
7. **Amendments.** The PTO regularly amends its public-facing guidance to impose immense costs (nine figures and up) without the protections of the Administrative Procedure Act, Paperwork Reduction Act, *Good Guidance Bulletin*, etc. These amendments originate in the Office of the Deputy Commissioner for Patent Examination Policy.

In 2013, IEEE-USA (the professional association for electrical and electronic engineers, and similar technical professionals) assembled a list of administrative law problems that patent attorneys observe at the PTO. I have attached that as Exhibit B to this letter—many of the principles would be useful starting points for expansion of Part 29.

B. Non-implementation of similar Executive Orders as a matter of PTO policy

In 2010, I petitioned for implementation of several specific points of Executive Order 12866 and the *Good Guidance Bulletin*. The (now Deputy) Commissioner refused, and suggested that if I don’t like it, I should complain to the Department of Commerce General Counsel.

7. The PTO should implement the President's *Bulletin for Agency Guidance Practices*.

A significant portion of the petition addresses whether the USPTO guidance and other informational documents (e.g., MPEP and memoranda to the Patent Examining Corps) complies with Executive order 12866 (Sept. 30, 1993) (Regulatory Planning and Review)⁵ and the Office of Management and Budget (OMB) Bulletin on Good Guidance Practice. The USPTO fully complies with Executive Order 12866 and the Bulletin on Good Guidance Practices. Furthermore, a petition in a particular patent application is not the proper forum for requesting that the Office issue general guidance. However, it is noted that Section 11 of Executive order 12866 expressly indicates that: “[t]his Executive order is intended only to improve the internal management of the Federal Government and does not create any right or benefit, substantive or procedural, enforceable at law or equity, against the United States, its agencies or instrumentalities, its officers or employees, or any other person.” See *Executive Order 12866 of September 30, 1993; Regulatory Planning and Review*, 58 Fed. Reg. 51735 (Oct. 4, 1993). The Bulletin on Good Guidance Practice is a bulletin issued by OMB in a Federal Register notice entitled *Final Bulletin for Agency Good Guidance Practices*, published at 72 Fed. Reg. 3432 (Jan. 25, 2007). Similar to Executive order 12866, the Final Bulletin for Agency Good Guidance Practices expressly indicates that “[t]his Bulletin is intended to improve the internal management of the Executive Branch and is not intended to, and does not, create any right or benefit,

⁵ Executive order 12866 (Sept. 30, 1993) was amended by Executive order 13258 (Feb. 26, 2002), Executive order 13422 (Jan. 18, 2007), and Executive order 13497 (Jan. 30, 2009).

substantive or procedural, enforceable at law or equity, against the United States, its agencies, or other entities, its officers or employees, or any other person.” See *Final Bulletin for Agency Good Guidance Practices*, 72 Fed. Reg. at 3440. Any person may bring issues of alleged non-compliance on the part of the USPTO with Executive order 12866 or the Final Bulletin for Agency Good Guidance Practices to the attention of the Department of Commerce or the Office of Management and Budget by sending inquiries, comments, or complaints regarding USPTO guidance documents via email sent to guidance@doc.gov with the word “GUIDANCE” in the subject heading, or by mail to:

Department of Commerce
Office of General Counsel
ATTN: Guidance Herbert C. Hoover Building
14th & Constitution Avenue, NW, Room 5876
Washington, DC 20230



Robert W. Bahr
Senior Patent Counsel

Acting Associate Commissioner for
Patent Examination Policy

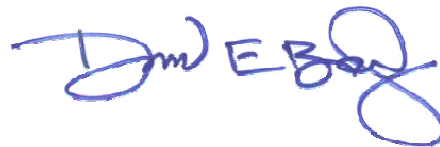
This reluctance to follow presidential directive is not isolated to me; it's known to the public. For example, in a 2011 notice and comment proceeding on the PTO's regulatory practices, a former regulatory economist from OMB/OIRA wrote as follows:⁴⁷

My general message is unambiguous and uncomplicated. The USPTO is a longstanding, serial violator of established regulatory principles. This is the product of a bureaucratic culture that treats presidential direction as interference, is adamantly opposed to basing regulatory decision-making on informed analysis, and has serious difficulty adhering to the rule of law. Each of these deficiencies is by itself a likely reason for bureaucratic failure, but in combination, they make success virtually impossible. Correcting them requires a radical change in the organization's culture.

An important step forward would be for the Director to appoint a qualified individual charged with reforming the Office's culture and to delegate to this person both the responsibility and the authority to make it happen. Tasks would include replacing counterproductive existing internal systems with modern ones designed and implemented to ensure that the Office complies with statutory requirements (e.g., the Administrative Procedure Act, the Paperwork Reduction Act, and the Regulatory Flexibility Act³) and presidential directives (e.g., Executive Orders 12866 and 13563, OMB's Bulletin for Good Guidance Practices, OMB's Information Quality Guidelines, and OMB Circular A-4⁴). Systems need to be established to ensure that rule-writing staff do not backslide at a later date. At a minimum, a number of personnel reassignments no doubt would be necessary.

In past notice and comment letters, I have offered suggestions and reforms that would, I believe, reduce costs by *billions* for the public—and by reducing uncertainty and randomness, would likely reduce costs for the PTO as well. I look forward to further discussions.

Very truly yours,



⁴⁷ <https://www.uspto.gov/sites/default/files/patents/law/comments/belzer14apr2011.pdf>

Attachments:

Exhibit A Affidavit of Bradley Forrest

Exhibit B Abishek Batnagar, *Is DOCX really an open standard?* from <https://brattahlid.wordpress.com/2012/05/08/is-docx-really-an-open-standard>

Exhibit C Excerpts from Notice and Comment Letters in response to *Setting and Adjusting Patent Fees During Fiscal Year 2020*, Notice of Proposed Rulemaking, 84 Fed. Reg. 37398 (Jul. 31, 2019)

Exhibit D Carl Oppedahl, various blog postings on the unreliability of DOCX in Patent Center

- Carl Oppedahl, “We’re unable to reproduce this issue” say the PatentCenter developers, <https://blog.oppedahl.com/?p=6548> (Sep. 23, 2020)
- Carl Oppedahl, *What happens if you file using a DOCX file*, <https://blog.oppedahl.com/?p=6538> (Sep. 22, 2020)
- Carl Oppedahl, *If only the PatentCenter developers had looked at ePCT*, <https://blog.oppedahl.com/?p=6217> (Jul 11, 2020)
- Carl Oppedahl, *How should USPTO interact with its PatentCenter beta testers?*, <https://blog.oppedahl.com/?p=6227> (Jul. 11, 2020)
- Carl Oppedahl, *Getting USPTO to fix things that are broken in PatentCenter: EBC trouble tickets*, <https://blog.oppedahl.com/?p=6225> (Jul 11, 2020)
- Carl Oppedahl, *Dozens of bugs in PatentCenter remain unattended-to*, <https://blog.oppedahl.com/?p=6534> (Sep. __ 2020)
- Carl Oppedahl, *USPTO’s Ideascale — where good ideas go to die*, <https://blog.oppedahl.com/?p=6123> (Jun. 16, 2020)
- Carl Oppedahl, *Still concerned about DOCX?*, <https://blog.oppedahl.com/?p=6073> (May 27, 2020)
- Carl Oppedahl, *An open letter to the Commissioner for Patents*, <https://blog.oppedahl.com/?p=5825> (Apr. 13, 2020)
- Carl Oppedahl, *Who was a beta-tester of ePave?* <https://blog.oppedahl.com/?p=5796> (Apr. 2, 2020)
- Carl Oppedahl, *An example of alpha-testing PatentCenter*, <https://blog.oppedahl.com/?p=4720> (Sep. 1, 2019)
- Carl Oppedahl, *If there was any doubt that USPTO does not really support non-Microsoft DOCX files*, <https://blog.oppedahl.com/?p=4704> (Aug. 28, 2019)
- Carl Oppedahl, *USPTO fails to support DOCX from non-Microsoft word processors*, <https://blog.oppedahl.com/?p=4638> (Aug. 9, 2019)

United States Patent and Trademark Office re Comment Request, *Initial Patent Applications and Patent Processing*, 0651-0031 and -0032, 85 Fed. Reg. 60967 and 60975 (Sep. 29, 2020)

- Carl Oppedahl, *The problem with USPTO's proposed non-DOCX penalty*, <https://blog.oppedahl.com/?p=4623> (Aug. 5, 2019)

Exhibit E Julie Burke, Michael Spector, and William Smith, *Newly Created First Action Final Rejection Policy Adds Needless Complications to Patent Prosecution*, IP Watchdog, <https://www.ipwatchdog.com/2020/09/22/newly-created-first-action-final-rejection-policy-adds-needless-complications-patent-prosecution/id=125456/> (Sep 22, 2020)

Exhibit F David Boundy, *Agency Bad Guidance Practices at the Patent and Trademark Office: a Billion Dollar Problem*, 2018 Patently-O Patent Law Journal 20 (December 6, 2018), Available at <https://ssrn.com/abstract=3258040>

Exhibit A

Affidavit of Bradley Forrest

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
and
OFFICE OF INFORMATION AND REGULATORY AFFAIRS OFFICE OF
MANAGEMENT AND BUDGET

AFFIDAVIT OF BRADLEY A. FORREST

I, Bradley A. Forrest declare that the following is true and correct:

Background and Experience

1. I am a registered patent attorney (Reg. No. 30,837) in private practice. I have been practicing in the field of intellectual property, with emphasis on patent or related matters, for over 38 years. My practice has included work at Rosemount, Inc., IBM Corporation, and at a relatively small law firm that grew into one of the largest patent prosecution boutique law firms in the country. I have also worked with and for in-house practitioners in corporations.

2. I have prosecuted thousands of patent applications for scores of different clients, directly and through oversight of several patent attorneys.

3. I have drafted such patent applications using many different word processing programs, including EasyWriter, DisplayWrite, Word Perfect, and Microsoft Word to name a few.

4. I have written many computer programs prior to becoming a patent attorney, including a computer simulation for detecting targets from a moving air vehicle.

5. I have investigated DOCX standards, tested the Patent Center Beta system with respect to filing applications by submitting DOCX versions of contrived patent applications, discovered errors, and provided direct feedback to USPTO programmers. The contrived applications have included equations, chemical formulas, pseudocode, and other text and images in applications saved in DOCX format.

6. While I am current Chair of the AIPLA Relations with the USPTO Committee, I am not writing on behalf of AIPLA. I am Chairman and General Counsel of Schwegman Lundberg & Woessner, P.A. I am writing on my own behalf and on the behalf of my law firm.

7. I have presented on DOCX filing in multiple national webinars and have had in person and electronic meetings with the USPTO programmers, attorneys, Directors, and the head of the Office of Enrollment and Discipline regarding the operation of the Patent Center DOCX filing functions from technical, legal, and ethical perspectives.

8. The estimates I give below are based on my experience as a patent attorney with different word processors over the years, my observations of the work of lawyers in our firm and where their efficiencies and inefficiencies arise, my observations of how my firm's employees interact with their software tools, and my experience as a programmer.

Opinion: Estimates of costs for using DOCX as filing vehicle for U.S. patents based on personal observation and informed by others within my firm.

9. My investigations have shown that different systems render (display) the same DOCX file differently. The DOCX standard permits different systems to determine how to display DOCX files and display them differently, sometimes in ways that adversely affect expression of technical details of inventive concepts. I have empirically observed occurrences of differences, and differences that affect such expression.

10. Different systems within my firm have displayed the same DOCX file differently.

11. The tendency of different systems to display the same DOCX file differently introduces potential for errors in the drafting and filing of applications that can drastically affect the enforceability and hence value of patents. One wrong word or formula can change a \$100M patent into a valueless patent, in fact, a patent that's no more than a malpractice liability.

12. My current process for obtaining inventor signatures on formal documents is to provide a PDF of the application I drafted to the inventor for approval. This PDF is then what is filed electronically, ensuring that what the inventor reviewed is in fact, what was filed.

13. Under today's procedure, I know that the PDF I generate and that I send to my inventor for review is exactly the document that the PTO will receive. In contrast, if DOCX becomes the filing medium, then the following difficulties and burdens will arise:

(a) In some cases, first drafts of patent applications incorporate material written by the inventors. Clients and inventors use all different word processors. Because the DOCX standard allows integration with a variety of third-party tools, some inventors use tools for creating equations and chemical formulas and similar diagrams that are other than the tools on the PTO's approved list for acceptance. Under today's PDF filing regime, this just works. Text, equations, chemical formulas, and diagrams render into a fixed form in a PDF, and the meaning is uniform and reliable to all readers. These applications are filed by a paralegal without change. The PTO accepts them and deals with them reliably. In contrast, under the PTO's proposed DOCX rule, I will have to convert these inventors' applications to the PTO's approved forms, for example to convert equations from the form provided by the inventor into the PTO's selected narrow choice of tools or as images I create by using a snapshot tool and pasting into a Word document. The selection and pasting creates additional work, substantial risk of error, and significant time for review to detect errors and find workarounds to prevent the error from compounding and compromising rights. I estimate that for about 5% of applications I draft, this will add an hour of inventor and attorney time. I estimate that for 1% of applications, this may not go smoothly, and it will add several hours of inventor and attorney time. For about 1 in 1000 to 10000, the conversions will introduce errors, and the cost of correcting those errors, if error correction is possible at all, will be staggering (see paragraph 13(g) of this Affidavit).

(b) In some cases, inventors send their initial draft of technical description, or their reviews of attorney-prepared drafts, at the last minute. Attorneys have very little time for review. Because DOCX introduces nonuniformity and randomness, there will be additional risks, and attorneys will be left with the untenable choice of accepting risk of error, vs. delaying past an immovable deadline. Trying to handle unreliable software systems in a hurry is a recipe for error. I estimate that this kind of last-minute crush arises in about 2% or more of applications. I expect that for some small number of inventions per year, the attorney will

inform the client that it's too late, and it's just tough luck, because the attorney won't have time to cover the additional risk, and the inventor will simply be left with nothing. Attorneys that accept the risk of acting in a rush will be a major contributor to the extraordinary burden of attempting error correction.

(c) Sending a DOCX file of the application to the inventor for review may result in the DOCX file rendering differently on the inventor's computer display than it renders on my display. Uploading the DOCX file may result in a different rendering of the DOCX file on the USPTO system and hence a different PDF version being created. I cannot be sure that what the inventor reviewed matches what ends up being filed. The use of different word processing programs may accentuate the likelihood of a mismatch. Implementation of DOCX may render files slightly differently (or sometimes a lot differently). An inventor reviewing a DOCX file may see something different on their screen than I saw on mine. It will take time for the inventor and for me to resolve these differences if we even realize there are differences. I estimate that for up to 2% of applications, this may add an hour of communications between the attorney and inventor, as the two of us try to figure out why we're each seeing different things and try to work out the differences.

(d) The USPTO Patent Center system indicates that by submitting the USPTO rendering I agree that it will become the document of record. I cannot do that without taking significant time to proof the PDF that is created by the USPTO system that will become the document of record. Upon storing the PDF that I proofed, the USPTO may further reduce the resolution of the stored PDF to 300x300 dots per inch. Storing at this reduced resolution can result in elements of the application, such as exponents in an equation, becoming unreadable. I estimate that this will add between 15 minutes and two hours per application for review and changing the draft of the application to remove DOCX features that render differently on the PTO's web site than on my computer. When something doesn't go right on a computer, it's very time consuming to diagnose exactly what the problem is, identify which perfectly-correct use of Word on my computer is leading to an error on the PTO's, and identify a work-around that avoids the problem. In addition, companies that develop and maintain word processing software provide updates that can change the way DOCX files are rendered, injecting unexpected errors that will take time to recognize and fix.

(e) The USPTO has made great strides in increasing the reliability of their software-based systems. However, problems do occur. My firm is regularly confronted with

some PTO subsystem being unavailable. Under today's electronic filing system using PDF files, the PTO's software has minimal opportunities to inject errors into PDF based application. Every additional conversion or complexity introduced using DOCX files adds risk. Adding additional software layers to the PTO's filing workflow will add failures, which adds cost. I estimate that adding additional complexity will add about an hour for up to 5% of patent filings, because of PTO system failures.

(f) Today, under the PDF filing regime, I use a paralegal to electronically file PDFs of applications that I and the inventor(s) have reviewed and signed off on. I can absolutely trust the paralegal's work because a PDF has only one correct rendering and cannot change. In contrast, under a DOCX filing regime, I cannot assume that the USPTO rendering of the DOCX file will match what the inventor(s) approved. Thus, the only alternative would be to have the inventor(s) share screens during the DOCX filing process. This is impractical in many cases due to the number of inventors, the effort of coordinating such real time review, and the time it would take multiple people to review and proof a patent application for a second time. Since we can't trust that the PTO system will render a DOCX file the same way our computers do, we may need to have every application finally reviewed by the inventor personally during the filing process. That will take, on average, 10-30 minutes (depending on the complexity of the application). In many cases, filing may have to be done by me, as the lawyer, rather than by the paralegal. My law firm uses a fixed fee for paralegal time for filing, but I will have to bill my hourly rate if client budgets permit. Such cost will quickly greatly exceed the \$400 penalty for not filing using DOCX.

(g) No matter how much care we take, because the PTO's rendering of DOCX's will inevitably occasionally differ from the rendering we see at our law firm. Rendering errors will occur under DOCX that do not occur under our use of PDFs for electronically filing applications. When differences arise between the PTO's rendering and what the lawyer and inventor thought they were submitting, the costs of error correction, if even possible, will be staggering. The problem is that there is no single canonically "correct" rendering of a DOCX file into text or image, and thus no reliable way to referee a disagreement. Many aspects of DOCX are left to individual implementations, and vary depending on whether one is using Word for Windows, Word for Mac, WordPerfect, Libre Office, Google Docs, etc. The standard permits each implementation to do something different, and they all may do so. Because there is no single standard definition of a "correct" rendering, I will argue in a petition to correct the document of record that what I submitted should be accepted by the PTO to read

the way it read on my computer, and the PTO will likely deny the petition and insist that the document should read the way it reads on the PTO's computers. In some cases, we'd have to sue to get a correction—but the outcome of that case is extremely uncertain. I am told that costs for an APA suit against an agency for this kind of issue are between \$100,000 and \$300,000. I estimate that if DOCX finds wide use, nationally there may be several such petitions and possibly law suits per year.

14. In my role as Chairman and General Counsel of my law firm, I have conferred with our malpractice insurance agents. They are concerned with the use of DOCX files for electronically filing patent applications for many of the reasons described above and have stated that anything that increases risk will result in higher malpractice insurance premiums. Unless I can develop a process that ensures the resulting document of record matches what the inventor(s) signed off on, I cannot recommend adoption of use of the Patent Center DOCX filing process. Though my firm has not made a final decision, we have tentatively concluded that if the PTO goes ahead with requiring DOCX, our firm can't accept the risk, and we will continue to file applications in PDF format. This will result in an increase of \$400 per application filed.

15. I have less expertise to predict this from personal knowledge, but I would not be surprised if DOCX filing caused malpractice premiums to rise by up to 5% or more. A single mis-rendering by the PTO of a single valuable patent application could create several million dollars in liability, possibly raising malpractice insurance premiums for all. I expect that DOCX filings may result in erroneous filing for 1 or more in 1000 applications, with more errors likely for attorneys that do not use Word. Some percentage of those errors may substantively impair the application and mature into malpractice claims (including the cost of defending suit) of over \$1 million each.

16. In the September 29 ICR Federal Register notice, I observed no line item identifying burden for the DOCX surcharge. Similarly, at Table 8, 85 Fed. Reg. 46946, the PTO estimates that the incremental cost of the DOCX rule is zero. These estimates fail to take into account that not all applicants will likely convert from PDF based electronic filing to DOCX based electronic filing. Those that don't convert will be required to pay the \$400 non-DOCX

filing charge. I believe that the PTO's estimate is entirely unrealistic. On the information I have available to me in November 2020, I believe that a significant percentage, such as for example 20% to 70% of applicants will decide that the extra time and malpractice risks of DOCX filing are unacceptable, and will opt to file using PDF and pay the \$400 fee rather than accept the costs and risks of DOCX filing. This is between 100,000 and 350,000 applications per year, times \$400 each. This totals \$40-\$140 million per year.

17. In the Notice of Proposed Rulemaking, the PTO estimated that about 20% of patent applicants don't use word processors that generate DOCX. 84 Fed. Reg. at 37413. I am not aware of the PTO having provided an estimate of the burden for those filers in determining how to create a DOCX file from such word processor. In 2020, users that don't already use Microsoft Word today have reasons to not switch, so I estimate that very few will convert to DOCX filing absent their finding a suitable additional conversion program. Therefore about 20% of all applications (that is, almost 100,000 applications per year) may incur the \$400 fee. The total cost is approximately \$40 million per year.

18. I believe the PTO's statement that "To date, the Office has not received notifications of any issues resulting from the filing of applications in DOCX format." 85 Fed. Reg. 46956, col. 2 is misleading. A great number of issues have been pointed out by beta testers, perhaps while using the beta test mode. Some of these issues were reported before August 3, 2020, and many more since. For example, I communicated errors arising from the testing I performed as described in paragraph 5 of this Affidavit. Thus, the statement gives the false impression that all is well. While PTO programmers are working to fix reported errors, given the nature of the DOCX standard as described above and the potential for word processor updates to create more errors over time, the risk will remain, as does the additional burden.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001.

Respectfully submitted,

Dated: November 30, 2020

By: *Bradley A. Forrest*

Exhibit B

**Abishek Batnagar, *Is DOCX really an open standard?* from
[https://brattahlid.wordpress.com/2012/05/08/
is-docx-really-an-open-standard](https://brattahlid.wordpress.com/2012/05/08/is-docx-really-an-open-standard)**



MAY 8, 2012 BY ABHISHEK BHATNAGAR

Is DOCX really an open standard?

It is hard to believe that even in 2012 we struggle with standards as common as those of documents, presentations and spreadsheets. The de facto formats of these of course are those used by Microsoft Office (docx, pptx, xlsx (collectively called **OpenXML** or **OOXML**)), which causes a growing number of Libre and Open Office users such as myself much chagrin.

Like everyone else, the majority of office files I receive in my inbox belong to one of the OOXML category, and invariably as I edit and return the document to the owner, they complain that I have in some way corrupted or changed the elements within because of my choice of software, which is usually true. Then they berate me for being using “crappy” open source software and in one case, for being an “anti-Microsoft hippy”.

Let’s be clear, I am not an anti-Microsoft hippy. Like many of you, I run Linux and under a normal scenario, do not have access to Windows, so running MS Office is really not an option. Even if it were, I would detest having to pay for it. So for the simple reason of including myself and the millions of others who use the various open office suites out there, I request that you stop using OOXML formats, at least until Microsoft truly supports them in MS Office.

I’ve been angrily told before that OOXML or OpenXML is indeed an Open Format, which is technically correct. But there’s more to the story than that. If there weren’t, Libre and Open Office would have built perfect support for it a long time ago. They realize that not fully supporting Microsoft formats is one of the key repellers to new users for their base, so they would not not implement OOXML by choice.

The real reason that these software do not fully support OOXML is because there is a

difference between the OOXML specification, and OOXML implementation in MS Office. To understand why, you have to familiarize yourself with three standards:

- ECMA 376
- ISO/IEC 29500 Transitional
- ISO/IEC 29500 Strict

ECMA is a **private** international standards organization much like the better known ISO. The difference between the two is that ECMA is made out of companies, while ISO is made out of countries. There is certainly a need for both them in the technology market.

ISO along with another consortium called OASIS adopted the ODF (Open Document Format) back in 2006 to solve the document standardization crisis. This is the format that is used by Libre and Open office, along with most other open office suites. Such a format becoming successful would of course threaten Microsoft's already established monopoly in the Document market, which at the time ran on closed formats such as doc, ppt, and xls. So in 2007, they decided to create their own open standard with ECMA called OpenXML or OOXML, otherwise known as ECMA-376. This was the new “XML based” replacement for ODF, which of course seemed unnecessary to ISO and was initially rejected. But with the use of some muscle, Microsoft got the proposal fast-tracked in ISO even though reportedly 20 out of the 30 countries involved were not interested in passing it. This however didn't stop the ISO secretariat Lisa Rachjel from pushing it through anyway after deciding “to move Open XML forward after consulting with staff at the International Technology Task Force”.

REPORT THIS AD



REPORT THIS A

So ISO had a new incoming standard, but specific clauses of it still met resistance. To solve this problem, it was proposed that OOXML be split into two sub-standards, namely **ISO 29500 Transitional**, and **ISO 29500 Strict**. The Strict version was that which was accepted by ISO, and the Transitional version was fairly granted to Microsoft to allow them to slowly curb out older features from the closed source days. Nothing wrong with this, its only fair to their users.

However, the problem arose when Microsoft decided not to fully implement the Strict version of the standard in Office 2010. As published my Microsoft [here](#) and stated by Wikipedia [here](#):

Microsoft Office 2010 provides read support for ECMA-376, read/write support for ISO/IEC 29500 Transitional, and read support for ISO/IEC 29500 Strict.

What this means is that when you save a document in MS Office 2010 or prior in any of the 'X' formats, you are not saving them in the advertised OpenXML format. This document will hence NOT be properly readable by other software such as Libre and Open Office and they will make changes to the document when they are opened and saved within them. The problem hence lies with the former, not the latter.

But, to be fair, we should note that we have been [promised](#) full ODF support in the upcoming Office 15. [Alex Brown](#) has an excellent post on this subject with more details about the gap between the promises Microsoft made in 2008 to what they actually delivered in 2010. Hopefully they won't follow suit and actually keep their promises this time. I am actually genuinely excited to find out.

Lately there has been a shift towards the usage of PDF, especially when it comes to documents that do not need to be edited such as resumes, essays, and reports. The reason for the change of course is an organic realization that PDF is a **no-bullshit** format that works consistently and predictably across all platforms. While PDF is not exactly an



I would still prefer to see ODF win the battle, but if this happens, then at least their will be much fewer reasons to complain. Plus, Libre Office developers won't be jerked around as much in trying to play catch up to an always moving target.

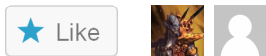
Anyway in the meanwhile, please save your documents in ODF when you use Microsoft Office.

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REPORT THIS A

JANUARY 20, 2014 AT 6:58 AM

In Higher Ed, I am pushing to get universities to understand the issue here and to focus on the open standard. If MS plays games here and not implement the strict standard, then they seem open, yet preclude others from fair competition. I appreciate your great article.



raj

MAY 20, 2014 AT 6:58 PM

very very good @jacquesdup. Thumbs up for your efforts.

We ALL definitely need to actively push libreoffice(ODF standard), only then interoperability will be solved in true sense.

Pingback: [Free Software, Open Specifications and Why We Should Care | help/Use](#)



raj

MAY 20, 2014 AT 6:48 PM

i use linux , and i hate to use wine or virtualbox to use MsOffice on top of it. I fully use libreoffice and ODF formats only for myself.

HENCE,

i FORCE my contacts to install libreoffice on their PC, by emailing them .odt(or other ODF format) documents only. I do not hit “send” button of my mailbox, with a .docx as an attachment: This is my strict policy, come whatever.

Even if others email me a .docx , i import it in libreoffice, then reformat it slightly to accomodate for importing errors in format, and then make the changes and “save the document in .odt” and then email it back. When the contact me back , on how to open it , i



REPORT THIS A

Whenever i am supposed to give a talk or invited for a talk, i specially inform them to have libreoffice installed on their presentation room/board room PC(which are connected to projector), to have any presentation delivered by me

I actively evangelise them to see the benifits in switching to open format fully .

slowly and slowly ,others have seen benifits and many in my contact have switched “fully” to libreoffice.

REPORT THIS AD



raj

MAY 20, 2014 AT 6:53 PM

but i will still accept the fact that: libreoffice “impress” 4.2 , by default, does NOT make as BEAUTIFUL presentation as Microsoft Powerpoint 2013.

The templates provided with impress(or even available on website), are still amateurish, do not look professional.

the default arrows etc made with impress are not as good as powerpoint.

This is a MAJOR issue , we need to address it in libreoffice impress.



REPORT THIS A

I enjoyed your post, but a correction needs to be made:

“While PDF is not exactly an open format, Adobe does provide free and consistent specifications for all to implement it as they please.”

PDF has been an ISO standard since 2008, so I’m not sure how that would classify as “not exactly open”? Other than that, good read.



Abhishek Bhatnagar

FEBRUARY 25, 2015 AT 10:31 PM

It’s true that PDF was submitted to ISO in 2008, but Adobe has intentionally muddled the game here a bit. Technically it is open, yes, but it doesn’t quite carry the spirit of being open. This post from 2014 explains more: http://www.planetpdf.com/enterprise/article.asp?ContentID=Is_PDF_an_open_standard



PhoenixofMT

MAY 5, 2015 AT 10:06 AM

Would love to use LibreOffice, but when I import my work instruction to try it out I find that LO does not support centering a section vertically on the page. My title pages are centered this way, and importing breaks them.

A little searching turns up this bug report

https://bugs.documentfoundation.org/show_bug.cgi?id=36117&redirected_from=fdo

where we see this has been a problem for over 4 years (more that 1 at the time of this article.) Seriously? Does the ODF just not support vertical alignments? I have to basically turn my document into a web page with frames just to center text on the first page?



**Dan****JANUARY 7, 2016 AT 5:50 AM**

I am using Softmaker Office 2012, which only supports ODT 1.0 and 1.1. Unfortunately some of my colleagues use LibreOffice which defaults to ODT 1.2 Extended. Now I can't open password protected ODT files because 1.2 Extended uses AES-256 instead of 1.0/1.1's Blowfish. So much for interoperability.

Pingback: [The \(DOC\)X-files | Sound Bytes from the ADS](#)

Pingback: [Der einzige Arbeitnehmer mit Desktop Linux – Steinzone Blog](#)

Pingback: [Which File Formats Should You Use With Linux? – FOYAK](#)

REPORT THIS AD

Pingback: [old: #ooxml is not a standard https://brattahlid.wordpress.com/2012... | Dr. Roy Schestowitz \(罗伊\)](#)

Pingback: [Quels formats de fichiers devez-vous utiliser avec Linux? - Moyens I/O](#)

REPORT THIS A

Exhibit C

**Excerpts from Notice and Comment Letters
in response to *Setting and Adjusting Patent
Fees During Fiscal Year 2020*, Notice of
Proposed Rulemaking, 84 Fed. Reg. 37398
(Jul. 31, 2019)**

The Intellectual Property Owners Association (IPO) wrote⁴⁸:

Moreover, IPO is concerned about inconsistencies in word processing software and the various DOCX formats in the word processing programs that can create and save in DOCX format, including Microsoft Word 2007 and higher, Google Docs, Apache OpenOffice, Apple Pages, and LibreOffice. IPO members have reported issues when uploading DOCX files that are not prepared in Microsoft Word. Many IPO members or their clients reside or perform some portion of business operations outside the US, and the originally drafted document may not have been written in DOCX or in the USPTO-preferred Microsoft Word processing software program. In the Proposed Rules, the USPTO claims that over 80% of applicants draft their patent applications in DOCX. IPO wishes to understand where this data originated and submits that this does not eliminate document integrity issues with the USPTO receiving DOCX filings properly.

IPO members have had issues with formatting when uploading DOCX files. Testing has demonstrated that properties such as page count, integrity of chemical structures and/or mathematical formulae, special characters or symbols, diagrams, and merged table fields may delete or alter technical document content in a concerning way during the upload process and PALM conversion process into the Image File Wrapper. As a result, IPO is concerned about the potential for introducing inconsistencies between DOCX content rendered by an applicant's word processor and the content that ultimately makes its way into the electronic file wrapper of a patent application. This concern is the reason the USPTO requires fonts to be embedded in PDF

The ABA wrote⁴⁹:

It is reported that filing DOCX documents can result in changes to the underlying text,² particularly in the case of mathematical formulae or chemical structures. The Section

⁴⁸ Intellectual Property Owners Association, *Re: Setting and Adjusting Patent Fees During Fiscal Year 2020*, https://www.uspto.gov/sites/default/files/documents/Comment_IPO_093019.pdf (Sep. 30, 2019)

⁴⁹ American Bar Association, Intellectual Property Law Section, *Re: Comments in response to the Notice of Proposed Rulemaking entitled: Setting and Adjusting Patent Fees During Fiscal Year 2020*, https://www.uspto.gov/sites/default/files/documents/Comment_ABA_S IPL_093019.pdf (Sep. 30, 2019)

Carl Oppedahl, a patent attorney in Colorado who is a former member of PPAC, wrote⁵⁰:

USPTO inaccurately characterizes DOCX as if one could be sure that any word processor will implement DOCX in the same way as any other word processor. For example, USPTO says:

There are several word processors that can create and save in DOCX format, including Google Docs, Microsoft Word 2007 or higher, Office Online, LibreOffice, and Pages for Mac.

That statement is disingenuous at best, and borders upon falsity given that there is no single unambiguous DOCX format. A more accurate statement would be:

There are several word processors that can create and save documents in variants of DOCX formats, including Google Docs, Microsoft Word 2007 or higher, Office Online, LibreOffice, and Pages for Mac.

Dr. James Ryley wrote⁵¹:

Second, moving to DOCX is simply not justifiable from a technical perspective. With PDF, what you see is what you get. With DOCX, this is not necessarily true. In fact, it is common for characters in a DOCX file to get corrupted when moving between versions of software (even different versions of Word, to say nothing of software like OpenOffice or LibreOffice), between different operating systems, and between computers that do not have the same fonts installed.

I have personally seen instances (as have my colleagues) where I open a DOCX file from someone else and some of the characters appear as boxes or question marks. Generally, this means that a special character was used but that character is not available on the current system. I have seen this happen even when the "Embed fonts in file" option is checked; it does not work 100% of the time.

⁵⁰ Carl Oppedahl, *Comment On: PTO-P-2018-0031-0001 Setting and Adjusting Patent Fees During Fiscal Year 2020*, https://www.uspto.gov/sites/default/files/documents/Comment_Carl_Oppedahl_081219.pdf (Aug. 12, 2019)

⁵¹ James Ryley, *Comment On: PTO-P-2018-0031-0001 Setting and Adjusting Patent Fees During Fiscal Year 2020*, https://www.uspto.gov/sites/default/files/documents/Comment_James_Ryley_082919.pdf (Sep. 18, 2019)

A group of Seventy-Three Patent Practitioners⁵² wrote:

measurements in today's cars are an metric, that does not mean that any two alternators from different manufacturers are interchangeable. ECMA-376 and ISO/IEC 29500 are relatively "loose" standards—they leave a lot of room for implementations to differ (after all, Microsoft, the sponsor of the standard, did not want the choices it made in 2007 to be permanent lock-ins). DOCX files cannot even be transferred reliably between Microsoft Word for Windows and Microsoft Word for Mac. Users that use LibreOffice, or WordPerfect cannot reliably transfer documents to or from Microsoft Word. The problems are especially pronounced for equations and formulas. Even basic text can have the problem—standard fonts like Times Roman and Helvetica are available from different vendors, each with slight differences that will alter pagination in some cases. Even in an environment where all software is provided by Microsoft, the result is not reliable in this respect—using different versions of Word *on the same computer*, this letter changed in length by half a page (See Exhibit B).

The law firm of Kilpatrick Townsend and Stockton (one of the larger IP firms on the west coast) wrote⁵³:

The unreliability of the USPTO's DOCX filing process has been documented repeatedly by patent practitioners. (See, e.g., comments by Carl Oppedahl in response to this Notice of Proposed Rulemaking.) In view of this evidence, prudent practitioners do not trust the DOCX process.

Current USPTO policy compounds the problem by shifting the risk of unreliability to applicants. The USPTO does not treat the DOCX files that applicants upload as the official version of the application (and apparently does not even save them for the record). Instead, the USPTO performs a validation process that *alters* the DOCX file, then converts the altered DOCX file to PDF. This PDF, which may contain errors introduced by the USPTO, becomes the official version of the application, and applicant is held responsible for verifying that the USPTO's validation and conversion processes did not introduce any errors or loss of content. This is unlike the PDF filing process, where the files applicant uploads become the official version.

This policy gives rise to multiple issues, including the following:

(1) Patent rights may be lost due to errors made by the USPTO, not applicant. This is not a fair result.

(2) The DOCX filing process is inefficient. As competent practitioners, we closely proofread our applications prior to uploading files to EFS-Web. Because we bear the risk of USPTO error, the DOCX filing process requires a *second* close proofreading after the PDF is generated. In addition, an efficient workflow for preparing and filing applications dictates that the time for close proofreading is before documents are uploaded to the USPTO, not in the middle of the filing process.

⁵² Seventy-Three Patent Practitioners, note 11 *supra*, at 14.

⁵³ Kilpatrick Townsend and Stockton LLP, Comment letter https://www.uspto.gov/sites/default/files/documents/Comment_Kilpatrick_Townsend_and_Stockton_093019.pdf (Oct. 1, 2019)

(3) The USPTO's validation and conversion processes alter the uploaded DOCX files in ways that are outside the filer's control. When a filer finds an error in a USPTO-generated PDF (such as an altered equation or chemical formula), the cause may not be apparent, and the filer may be unable to correct the error. The filer must then give up on DOCX filing and revert to uploading PDFs that are generated by the filer without the USPTO's error-prone conversion process.

While we appreciate the USPTO's desire to streamline its operations, we do not believe it is reasonable for the USPTO to impose a surcharge on applicants for refusing to use an unreliable process that puts their patent rights at risk.

The law firm of Patterson Thunte Pedersen, P.A. writes⁵⁴:

The purported benefits of the DOCX format are questionable.

The DOCX format may not be the ideal approach for ingesting searchable data from submission to the Office. The proposed rule lists a number of supposed benefits of DOCX files, including that DOCX filing "improves document identification by automatic detection, allows for greater reuse of content, and provides improved searching for patent applications and submissions," as well as enabling the Office to save approximately \$3.15 in OCR costs per application.³ These benefits are not particular to the DOCX file format, and are instead common to any text representation of a submitted document.

This is especially true given that neither EFS-Web nor Patent Center seem to be making use of any special "structured text" features of DOCX files. For example, while DOCX files support outlines, bookmarks, and other means of labeling sections within a document, EFS-Web relies on the presence of certain keywords to locate section headers⁴ — the tools are simply searching the text data for section headers such as "What is claimed is," or "BRIEF DESCRIPTION OF THE DRAWINGS" to find the various application sections. This can be done with a .TXT (plain-text) file, or any other document that includes a text-based representation of the content.

⁵⁴ Patterson Thunte Pedersen, *Re: Notice of proposed rulemaking – 84 FR 37398 "Setting and Adjusting Patent Fees During Fiscal Year 2020"*, https://www.uspto.gov/sites/default/files/documents/Comment_Patterson_Thunte_Pedersen_093019.pdf (Sep. 30, 2019).

Neil Ormos, an attorney in California, writes⁵⁵:

changes made by the conversion, and that the PDF will become the final submission". As noted in other comments, although the PTO asserts that the DOCX format is subject to standards, the standards do not fully specify the behavior of software that interprets files in DOCX format, and the PTO has not identified in the NPRM the conversion software it will use in a way that would allow Authors to use such software as a reference implementation. Moreover, even the various software packages that process documents in DOCX format furnished by the originator of the format do not behave identically. Accordingly, even for Authors who use DOCX authoring tools, regardless of the particular DOCX authoring or processing software being used by the Author, the author must carefully inspect the PTO's "generated" PDF specimen to compare it to the Author's own document. This careful inspection takes significant time, perhaps tens or hundreds of minutes for a larger application, which time imposes a real cost on Authors. There is significant risk that, even if the filer exercises a high degree of care, they will not successfully find all defects in the PTO's conversion during manual inspection of the PTO's specimen, which may cause a loss of patent rights, or may increase the cost of prosecution.

Also, although again not detailed in the NPRM, the PTO has separately announced that various characteristics of an otherwise-valid DOCX-format document, including the presence of several features apparently supported by "office" software suites used to author and process DOCX-format documents, can cause the document to be rejected by the PTO's online filing system. Modifying a document to conform to the incompletely-specified requirements of the PTO's online filing systems can take significant time--perhaps tens of minutes or several hours. In addition to the direct cost of making these changes, there is significant risk that the document cannot successfully be modified under some circumstances. For example, when it is necessary to file an application on an emergency basis late in the day of an impending filing deadline, it may not be possible to make the modifications necessary to satisfy the PTO's online filing systems in the time remaining after the documents have been uploaded and

⁵⁵ Neil Ormos, *Re: Notice of Proposed Rulemaking Setting and Adjusting Patent Fees During Fiscal Year 2020*, https://www.uspto.gov/sites/default/files/documents/Comment_Neil_Ormos_093019.pdf (Sep. 30, 2019)

rejected. It may then even be impossible successfully to convert the document into PDF and upload it in that format.

Attention is drawn to the PTO's failure in the proposed rules to define the behavior of its systems. Although the PTO alleges in the NPRM that files in DOCX format are subject to two published standards, it is unclear how those standards may be relied upon, or even relevant, as the PTO has omitted in its proposed rules to provide that any DOCX file complying with those standards shall be accepted, and the PTO also has omitted to provide a mechanism by which a filer aggrieved by the rejection of or the defective PTO conversion of a standards-compliant DOCX file may obtain redress. The undersigned believes that DOCX files conforming to the standards can nonetheless be rejected by the PTO's online filing systems. Because the PTO does not specify the behavior of its systems in the proposed rules, all filers are subject to the risk that whether any DOCX file--even one that fully compliant with published standards therefor--is accepted by the PTO's online filing systems is at the absolute caprice of the PTO and its systems and software vendors.

Judith Szepesi, an attorney in Silicon Valley, writes⁵⁶:

I have drafted patent applications in Microsoft Word, LibreOffice, LaTeX, GoogleDocs, PowerPoint, Notepad, Apple Pages, and physical paper which was scanned for submission. Each of these approaches has a simple way to produce a PDF, while maintaining all text, special characters, equations, and formulas.

However, converting between these formats can cause issues. Requiring us to convert a patent application from LaTeX to DOCX for submission is likely to introduce errors especially into complex equations, tables, and other formatted text. Similarly, conversion from Pages will sometimes introduce errors in the special characters and formatting. PowerPoint does not have a way to convert, so we would need to cut and paste elements individually into a Word Document. This would be time consuming and error prone. Additionally the manual review and comparison of the DOCX to the original document is time consuming, and thus expensive.

⁵⁶ Judith Szepesi, Comment email, https://www.uspto.gov/sites/default/files/documents/Comment_Judith_Szepesi_083019.pdf (Aug. 30, 2019)

Exhibit D

**Carl Oppedahl, various blog postings on the
unreliability of DOCX in Patent Center**



Ant-like Persistence®

(<https://blog.oppedahl.com>)



“We’re unable to reproduce this issue” say the Patentcenter developers (<https://blog.oppedahl.com/?p=6548>)

23rd September, 2020 (<https://blog.oppedahl.com/?p=6548>) (<https://blog.oppedahl.com/?author=1>)

Sorry folks but it's like trench warfare in World War I to make even micro-progress with getting the Patentcenter developers to fix seemingly simple defects in Patentcenter.

Regular readers of my blog are used to the idea that often I will put an image at the top right of my blog article. The image is intended to catch your attention and motivate you to click the “continue reading” link to read the rest of the article. This image shows you the blank page that you might later see to your horror in IFW after you upload a perfectly good PDF file to Patentcenter.

I've been engaged in what seems like trench warfare for months now to try to get the Patentcenter developers to fix this. Today's blog article provides an actual PDF file that anybody who wishes to, can use to reproduce this issue.

The presenting problem is poorly programmed Patentcenter. (Yes, alliteration!)

In ePCT, if you upload a file to ePCT that you are getting ready to e-file, the ePCT system will let you preview the file and will let you see what the file would look like after the ePCT carries out whatever conversions or changes it might do to the file. You as the practitioner can click on the preview and you can see for yourself what would happen if you click “submit”. And guess what? ePCT tells the truth. The preview actually faithfully tells you what would happen. If it is going to be blurry or unreadable or if it is going to get smooshed in the e-filing process, you will get fair warning by looking at the preview.

For over a decade now, practitioners have been complaining that EFS-Web does exactly the opposite. EFS-Web will mangle or ruin a file, and the “preview” that EFS-Web displays before you click “submit” will never give even the slightest hint or suggestion of the harm that might befall the file when you click “submit”.

When USPTO started alpha-testing the successor to EFS-Web, namely Patentcenter, many of the alpha-testers (including yours truly) pounded the table over and over again and told the Patentcenter developers that it was super important for them to talk to the WIPO people and learn from them how to do a “preview” that would give fair warning. The impression that the alpha testers got is that there was some sort of “not invented here” problem in the mindset of the USPTO people. Maybe there was a fear of losing face by having to ask some other patent office for advice. Maybe there was some institutional distrust of the notion that anybody who works at a patent office other than the USPTO could possibly know better than a USPTO person how to do something. But for whatever reason, when Patentcenter launched in 2018 in alpha test, its “preview” was just as bad as the EFS-Web “preview” telling you absolutely nothing about the violence that it might cause to the file after you click “submit”.

The alpha testers told the Patentcenter developers again and again, “do the preview like ePCT does the preview”. The Patentcenter developers ignored it. Patentcenter moved forward into beta test. The beta testers told the Patentcenter developers again and again, “do the preview like ePCT does the preview”. The Patentcenter developers ignored it.

On June 8, 2020, I was e-filing something as a beta tester in Patentcenter, and it was the worst I had ever seen. Patentcenter did not merely blur the image that I e-filed. It converted the image into a blank sheet of paper. See above right for an example of such a blank sheet of paper. Imagine that this might be an important document in a filing package in Patentcenter. Imagine that it is an important figure. Imagine that whatever is on this page is



(https://blog.oppedahl.com/wp-content/uploads/2020/09/57380_1070945.png)
click to enlarge

necessary for you to get a filing date. And you preview it before clicking "submit", and in the preview screen it looks fine. And you click "submit" and later to your horror you find out that Patentcenter has made it into a blank sheet of paper.

So this is what prompted me to post a blog article on June 8, 2020 (blog article (<https://blog.oppedahl.com/?p=6112>)). This is what prompted me to add this to the Patentcenter trouble ticket list on June 8, 2020 (see trouble ticket list (<https://patentcenter-tickets.oppedahl.com/>)) as trouble ticket CP27. On July 1, 2020, I joined several Patentcenter beta testers in a conference call with the Patentcenter developers and we discussed this trouble ticket list, which included trouble ticket CP27 which dated from three weeks earlier. But what we heard from the USPTO people is that they had given us one phone call and that was the limit, and that going forward we should simply do like everybody else and post our bug reports to Ideascale. On July 4, 2020, Richard Schafer posted this trouble ticket CP27 to Ideascale, and it got logged as "idea number 520".

USPTO then ignored this trouble report even in Ideascale for the rest of July and all of August and most of September. On September 20, 2020 I was doing continued beta testing of Patentcenter and I e-filed another PDF that got changed into blank pages after I clicked "submit". This one happened to be a three-page PDF and so what I eventually saw to my horror in IFW was three blank pages. So on September 20, 2020 I posted another blog article (<https://blog.oppedahl.com/?p=6534>) entitled *Dozens of bugs in Patentcenter remain unattended-to*. In that blog article I reported that this conversion to blank pages had happened again and that it was clear that USPTO had not fixed the defect in Patentcenter.

I sent a link to this blog article to quite a few people at the USPTO, including the Commissioner for Patents.

I am sure it is mere coincidence, and I am sure you will agree it is mere coincidence. But if you click on the Ideascale idea number 520 (direct link (<https://uspto-emod.ideascale.com/a/dtd/Patentcenter-converts-a-perfectly-good-PDF-into-a-blank-page-in/555838-31593>)), you might just for a moment think that it is more than coincidence that today, September 23, a nameless person at the USPTO called "eMod Moderator" posted a comment to idea number 520. This USPTO person wrote:

Thank you for providing your observation. We're unable to reproduce this issue. Please contact the EBC for assistance with specific application questions. Please visit the Patent Center information page for details on known issues and resolutions.

Isn't that something? Way back in June, or way back on July 1, they could have just asked which file it was and they could have looked at what I e-filed. But if they sit on it and wait until today, September 23, 2020 to respond to that trouble report from months earlier, the problem is I can't even recall exactly which of the dozen things I filed on or around June 8 was the thing that got changed to a blank page.

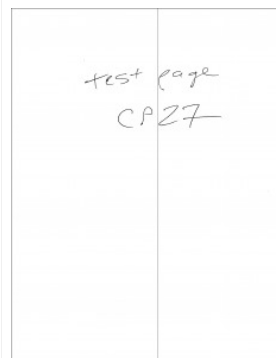
In my June 8, 2020 blog post I described it in extreme detail, with pixel counts and physical dimensions in inches and millimeters, all the way down to the metadata inside the PDF file. But no, they're unable to reproduce this issue. And anyway, they are going to count this as a closed trouble ticket. I am invited to contact somebody else, namely the Electronic Business Center, if I need help with a "specific application". But no they are not going to fix the problem generally.

You will note that "eMod Moderator", whoever he or she is, does not bother to ask if maybe I could provide a sample of the PDF file that was perfectly good when I previewed it in Patentcenter and that got converted to a blank page after I clicked "submit". You would think that if "eMod Moderator" was even a little bit interested in fixing the defect in Patentcenter, a defect that I reported on two different occasions, maybe he or she might want to reach out for more information. No. "eMod Moderator" makes clear to the Ideascale reader that "eMod Moderator" now considers this matter to be closed.

Nope. Not good enough.

So, eMod Moderator, here is a PDF file (<https://blog.oppedahl.com/wp-content/uploads/2020/09/image-43.pdf>) that you can use to "reproduce this issue".

Reproduced at right is a PNG export of the same image just so that you can see generally the content of this image — the handwritten words "test page CP27". But the file that we are really talking about is the PDF file linked two sentences earlier. If you download that PDF and look at its properties, you will see that it says this:



(https://blog.oppedahl.com/wp-content/uploads/2020/09/image-43-2.png)
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File Size: 24.29 KB (24,876 Bytes)
Page Size: 8.26 x 10.62 in

(https://blog.oppedahl.com/wp-content/uploads/2020/09/Clipboard01-7.png) If you calculate a SHA-512 hash of this PDF file that you just downloaded from my blog, you will find that it is:

A226318DD7107CC2337FACCEFDD0C67233AE5AD2BE255DE0A95EF7AB3885E5BA0E131181CA30F1515B4EB8DED876A14FC16E

Then if you feel like doing so, you can click here for a deep link in Patentcenter to one of my firm's really old patent files:

<https://patentcenter.uspto.gov/#!/applications/10709459/ifw/docs>
(<https://patentcenter.uspto.gov/#!/applications/10709459/ifw/docs>)

Look in IFW and you will see an Acknowledgment Receipt dated today, September 23, 2020. Scroll down and take a look at the SHA-512 hash listed there for a document that I e-filed earlier today:

DOCUMENT	MESSAGE DIGEST(S) (SHA-512)
image-43.pdf	A226318DD7107CC2337FACCEFDD0C67233AE5AD2BE255DE0A95EF7AB3885E5BA0E131181CA30F1515B4EB8DED876A14FC16E

(https://blog.oppedahl.com/wp-content/uploads/2020/09/Clipboard01-8.png)

Yeah. Guess what. It is impossible for the USPTO to deny that this is the very PDF that I e-filed in this very case earlier today.

You will note that the ack receipt reproduces this warning:

Warning: The page size in the PDF is too large. the pages should be 8.5 by 11 or A4. If the PDF is submitted, the pages will be resized.

Now we already knew the page size was not exactly 8.5 by 11 and it was not exactly A4. It was 8.26 by 10.62 inches. So we already knew Patentcenter did not tell the truth about the page size. It was not "too large". If anything it was "too small". But it was not much different from being the right size. It was within 4% of being the right size.

If this document were to be "resized" to make it 4% bigger (which would be a waste of time, actually), it would still be perfectly readable.

Now you already have this application open in Patentcenter. Go ahead and click on the other item in IFW that is dated today, September 23, 2020. You will get ... wait for it ... a blank sheet of paper.

Any reader of this blog can "reproduce this issue" effortlessly. Here's how you do it. Pick some ancient long-expired provisional patent application in your workbench. Download this PDF and use Patentcenter to create a submission package in that old application in your workbench. Preview it so that you can see what it looks like in Patentcenter before you click "submit". The words "test page CP27" will appear on your screen. Then click "submit". Then go look in IFW. You will see that Patentcenter converted it to a blank sheet of paper. Then just sit back and imagine how in a new case that you are filing today in 2020, a conversion to a blank sheet of paper might cost you a filing date or might cost you your career.

As I say, this is like World War I trench warfare. I am going to post a link to this blog article as a comment to Ideascale idea number 520. And we shall see if eMod Moderator is willing to click on the link and read this blog article and maybe do a test filing using the PDF that I have served up here on a silver platter.

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3 thoughts on ““We’re unable to reproduce this issue” say the Patentcenter developers”



Suzannah K. Sundby, Registration No. 43,172 says:

September 23, 2020 at 5:25 pm (<https://blog.oppedahl.com/?p=6548#comment-179526>)

Ah ha ha Ha... Hee hee ho hum. Probably, because the developers do not have registration numbers and therefore log into the system differently than us practitioners. That is, they do not likely have the same interface as we do.. as such, they do not “see” the plethora... let me say it again loud and clear... PLETHORA, read it... read it again... the issues are not ONE, not a few, but a PLETHORA of problems that have no rhyme or reason to, such that I won't touch Patent Center until absolutely forced to because I neither have the time to deal with the problems nor want to risk malpractice because of the problems. GET A CLUE USPTO PATENT CENTER DEVELOPERS. You are software peeps. You are not attorneys and agents who will risk the LOSS of their license and registration number. So when we PRACTITIONERS say there is a problem, believe it. THERE IS A PROBLEM.

The opinions expressed herein are my personal opinions and should not be attributed to be those of Canady + Lortz LLP, its clients, or any other person or entity.

[Reply](#)



Randall S. Svihla says:

October 5, 2020 at 3:34 pm (<https://blog.oppedahl.com/?p=6548#comment-179809>)

The preview that you see in EFS and presumably in Patentcenter is simply the PDF that you uploaded. Basically it just lets you confirm that you uploaded the correct PDF file and lets you click through it to make sure all the pages, are there, it is signed, etc. Neither EFS nor Patentcenter converts the uploaded file to the TIFF image that will be loaded into the image file wrapper until after you click submit.

Is it possible that the problem with the test page CP27 is that the handwritten text is not 100% black, but is some shade of gray? Maybe Patentcenter uses a more stringent thresholding method that EFS-Web to convert images to bitonal 100%/0% black/white images, and anything less than say 95% is converted to 0% white.

[Reply](#)



oppedahl says:

October 9, 2020 at 2:32 am (<https://blog.oppedahl.com/?p=6548#comment-179905>)

Again I will remind the USPTO that all they need to do is call up WIPO and WIPO can explain how they got it right in ePCT. In ePCT the preview **does actually show you before you click “submit”, what it will look like after you click “submit”**.

[Reply](#)

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What happens if you file using a DOCX file (<https://blog.oppedahl.com/?p=6538>)

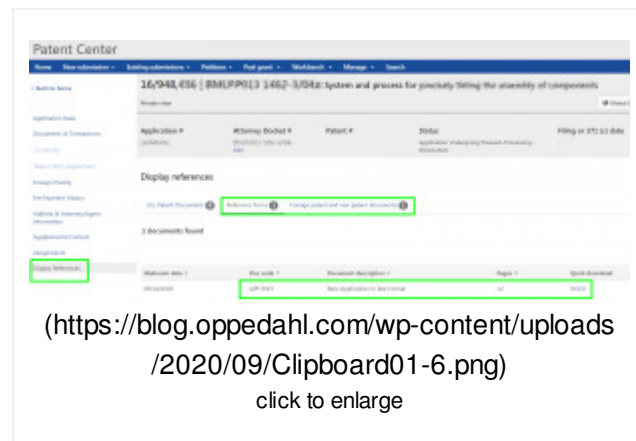
22nd September, 2020 (<https://blog.oppedahl.com/?p=6538>) (<https://blog.oppedahl.com/?author=1>)

Yet another oddity in USPTO's handling of a DOCX patent application file ... this DOCX file is now displayed in “Display References”. Not only that, it is displayed **in two different places** in “Display References”.

This is a case where we did what USPTO said they want us to do — we e-filed the patent application in Microsoft Word format. The USPTO can then open and use the word processor file using

Microsoft Word for its internal purposes. (USPTO says it wants the filer to file in “DOCX standard format” but the problem is that there is no such thing as “DOCX standard”. The USPTO renders the DOCX file using a proprietary rendering engine that I suspect it got from Microsoft, meaning that if you use a non-Microsoft product to create your DOCX file you are taking a big risk.)

Anyway in this case I took that risk. I used Libre Office to create my DOCX file. The way it works when you e-file at the USPTO is that during the e-filing session, the USPTO shows you how its proprietary rendering engine is going to render the DOCX file as a PDF, and then you as the filer have to click an adhesion contract agreeing that whatever it says in the PDF file, that PDF file controls, not the DOCX file. So if the proprietary rendering engine that USPTO uses were to change a math symbol into a smiley face, then you just clicked “yes” on an adhesion contract that says that what you filed on behalf of your client had a smiley face in it, not the math symbol. You as the filer are supposed to proofread the PDF file from the top to



the bottom before you click “submit”, to check for smiley faces.

I got lucky. No problems got injected into the PDF by USPTO’s proprietary rendering engine. I clicked “submit”.

I guess that’s not quite accurate. What I really mean is, in my quick review of the PDF during the ten minutes before I clicked “submit”, I *did not* see that any problems got injected into the PDF. Maybe later it will turn out that the rendering engine that USPTO uses injected some hard-to-notice aberration into the PDF, an aberration that I won’t notice until TYFNIL. But *as far as I could see* in my quick review before clicking “submit”, the adherence contract that USPTO made me sign did not burn me this time.

That’s the background, namely that this is a case where I did what USPTO says it wants everybody to do, namely I e-filed this new US patent application in Microsoft Word format rather than in PDF format. So now back to the main point of this blog post.

The main point is that I e-filed this new US patent application using Patentcenter. And then I did what I always do, I clicked around in Patentcenter to see if it all reached the USPTO the way it was supposed to. And look at the screen shot above. What you will see is that the 12-page DOCX word processor file that is my specification, claims and abstract, is listed under “Display References” in the “Reference Forms” tab. Not only that, the 12-page DOCX word processor file that is my specification, claims and abstract, is listed *a second time* under “Display References” in the “Foreign patent and non patent documents” tab. You can go to either of these tabs and you can go to “quick download” and click on the “DOCX” link and sure enough the word processor file will get downloaded to your computer. You will see the specification, claims, and abstract on your screen, rendered by your own word processor (assuming it knows how to open Microsoft-Word-formatted word processor files).

The “Reference forms” tab is the place where normally what you would expect to see is for example a Form 892 or a form SB08 or a Form 1449. But right now what you see under that tab is the Microsoft Word word processor file that is my specification, claims, and abstract.

Just joking, of course, but when the time comes for the Examiner to examine this case for novelty, the Examiner would necessarily look at the “non patent documents” tab to see what references the applicant has disclosed. And lo and behold there is a document that ... wait for it ... appears to ***absolutely render non-novel every character of my filed application, from the first page to the last page.***

You can’t make this stuff up. You could try, and you would fail. No way would you be able to make up a story that when you e-file a patent application, a copy of the text of the patent application itself get slotted into the official USPTO application file in the place where applicant-admitted applicant-disclosed prior art gets stored.

It is as if I had filed a document at the USPTO admitting that my spec, claims, and abstract count as a reference, maybe dating from more than a year before my filing date, that the Examiner ought to consider when determining whether my claims are novel.

Now of course I’m just joking. We can certainly count on the Examiner who sees this in the “Display references” section of Patentcenter to immediately say “well in my process of

examining these claims for novelty I can ignore this reference". We can certainly count on the Examiner to immediately say "there is no way the applicant would have e-filed this ... it must have been some USPTO mistake".

And of course TYFNIL we can certainly count on our adversary, the accused infringer, who sees this in the "Display references" section of Patentcenter, to immediately say "well I will just ignore this ... I won't try to use this to try to create some cloud of uncertainty as to whether this patent is invalid".

Right?

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In "non-DOCX penalty"

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6 thoughts on “What happens if you file using a DOCX file”



Richard Neifeld says:

September 22, 2020 at 9:15 am (<https://blog.oppedahl.com/?p=6538#comment-179493>)

Carl you said “The way it works when you e-file at the USPTO is that during the e-filing session, the USPTO shows you how its proprietary rendering engine is going to render the DOCX file as a PDF, and then you as the filer have to click an adhesion contract agreeing that whatever it says in the PDF file, that PDF file controls, not the DOCX file.”

The PTO has no authority to have “that PDF file control[.]” The statute controls. Specifically, the statute controls what is required for a filing date. The statute was amended back in the 1980s to define the filing date to not require payment of filing fees in response to the Commissioner of Patents’ decision that paying the fee was a condition of obtaining a filing date. Congress did not like that decision, and therefore changed the law. A consequence of that changes is the current version of 35 USC 111(a)(4), which reads “(4) Filing date.-The filing date of an application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.” You will note that “date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.” leaves no room for the USPTO to deny a filing date to what it “received.” Hence, what the USPTO “received”, not what it converted to pdf form, controls as to what subject matter and on what date, the filer is entitled to a filing date. Moreover, since the click-through requirement was not promulgated with notice and comment, it most certainly is not entitled to Chevron deference. And since it is contrary to the statute, it is entitled to neither Chevron nor Skidmore deference.

Reply



Richard Schafer says:

September 22, 2020 at 9:34 am (<https://blog.oppedahl.com/?p=6538#comment-179495>)

Besides, what is the reason why the PDF file should be the controlling copy, anyway? The whole justification for DOCX submissions is for the PTO to be able to use the text in the DOCX file. If the PDF converted from the DOCX file is going to control, then there’s no reason to insist on submitting anything but the PDF file. If they’re really going to use the DOCX file, then why even bother to create the PDF file? The logic of the system completely fails.

Reply



oppedahl says:

September 22, 2020 at 10:45 am (<https://blog.oppedahl.com/?p=6538#comment-179496>)

Oh that’s an easy question to answer.

The answer is that the USPTO knows perfectly well that there is not really any single DOCX standard, even though USPTO maintains the fiction in its public documents that there is a single DOCX standard. Given that there is not really

any single DOCX standard, then if USPTO were to permit the applicant to say “what controls is what was in my DOCX file” then the USPTO would risk the applicant being able to get away with saying “when you render the DOCX correctly using my word processor, you get this character C1 instead of the character C2 that the USPTO wrongly got when they used their proprietary rendering engine”. USPTO wants to be able to deny the applicant being able to point to its own word processor as being a legitimate way of rendering the DOCX file. So USPTO renders the DOCX file using its own proprietary rendering engine into a PDF and makes you agree to the adhesion contract that the USPTO-generated PDF rendering controls.

What’s particularly disingenuous about this is USPTO’s continued insistence that supposedly there is some single DOCX format, which is the underpinning of its notion that nobody should really object to being forced to agree to the adhesion contract.

The thing is if it were really true that there is truly some single DOCX standard, then no matter who was rendering the DOCX into PDF, no matter which word processor they might use, no matter which rendering engine they might use, they would always get the same PDF. In which case there would not really be any need to force the filer to agree to an adhesion contract at all.

Reply



Richard Schafer says:

September 23, 2020 at 8:15 pm (<https://blog.oppedahl.com/?p=6538#comment-179527>)

Carl, you may well be right. But I guess my question wasn’t clear enough. What I really am curious about is what justification (if any) has the *PTO* given for making the PDF the official document. They can’t admit to yours, because that would be the admission against interest that the DOCX idea is flawed. But has the PTO ever even been asked that question? I’m tempted to sign up for one of the patent center webinars and try to see whether they’ll answer the question, even though the webinar content itself is worthless.

Reply



Dan Feigelson says:

September 24, 2020 at 4:45 am (<https://blog.oppedahl.com/?p=6538#comment-179535>)

Hmm. I have yet to file a docx application, but when I get around to it, I’m going to include a sentence in the docx file that says something to the effect of, “This original docx file is the controlling document, and despite anything the USPTO may require me to click on in order to submit this file and thereby potentially reduce the filing fee, it is this docx document that is controlling, and not some USPTO pdf-rendered version thereof, since that ‘requirement’ is ultra vires. Furthermore, by rendering this

docx file into pdf format, the USPTO agrees that it is the docx format that controls.” Might be hard to get a court to enforce the second sentence, not quite as hard with the first, I suspect.

Reply



oppedahl says:

September 24, 2020 at 4:58 am (<https://blog.oppedahl.com/?p=6538#comment-179536>)

Yes in law school in contracts class I recall reading about “the battle of the forms”. Two entities on two sides of some transaction would each try to get in the last word by putting terms and conditions on the various pieces of paper that they would send to each other, the packing slips, the bills, the payment vouchers. Each one would hold out some hope that their document would control and that the terms and conditions that the other side had attempted to inject into the relationship would get nullified by the more recent document.

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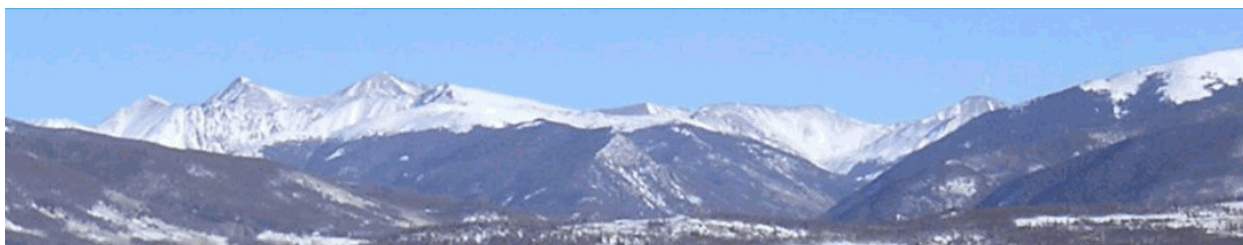
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If only the Patentcenter developers had looked at ePCT (<https://blog.oppedahl.com/?p=6217>)

11th July, 2020 (<https://blog.oppedahl.com/?p=6217>) (<https://blog.oppedahl.com/?author=1>)

Back in autumn of 2018, the alpha testers of Patentcenter told the Patentcenter developers, over and over again, please go and look at ePCT to see how they do it. Please look at the feature list for ePCT, said the alpha testers, and design your database structures so that you can implement the same features as in ePCT when the time comes.

It is now summer of 2020. Strikingly often, what we see is that twenty months later, a bug or missing feature that got reported to the USPTO in autumn of 2018 is still outstanding, and part of the bug report or missing feature report are words along the lines of "... and by the way a similar feature works correctly in ePCT."

Many of the beta testers of Patentcenter who belong to the Patentcenter listserv are people who in past lives worked as computer programmers, or have degrees in computer science, or otherwise know a thing or two about how to design systems like Patentcenter. And there are discouraging signs of places where our best guess is that USPTO implemented this part or that part of Patentcenter as a "flat file", rather than as a relational database or a linked list that would have been able to avoid some bug or would have been able to implement some feature. Such flat-file decisions in database design lead some of the beta testers to be rather pessimistic as to whether some limitations of Patentcenter are by now in 2020 so fundamental, so "baked in", that it will never be possible to overcome the limitations. Some of the beta testers feel disappointment that the Patentcenter developers manifestly declined in the early stages of Patentcenter to look at all at ePCT for any guidance or inspiration.

If you were to skim through the feature requests listed on the Feature Request page (<https://patentcenter-tickets.oppedahl.com/patentcenter-feature-requests/>), you would see that perhaps half of the requested features include words along the lines of "see the similar feature in ePCT" or "during alpha test we asked that this feature from ePCT be included in

Patentcenter” or “this feature works in ePCT but it does not work correctly in Patentcenter” or “this feature works in ePCT and it is supposed to work in Patentcenter but it is broken in Patentcenter”.

Here are examples of what happens when someone uses ePCT for the first time:

Until about 2 years ago, I used PCT Safe/Easy and refused to use ePCT. I reluctantly started using ePCT because eventually PCT Safe/Easy is going to be retired and no longer supported ... and primarily because (1) I got tired of having to check for updates and update PCT Safe/Easy every single time I filed a PCT (which one really must do), (2) ePCT checks the priority claim (at least the date) and I think a few other things, and (3) it never gets the page number count wrong (which your page numbers will be wrong if you forget to “recalculate” when using PCT Safe/Easy).

The first time, I used ePCT, it was scary, but was super easy.

The second time, I wasn't as scared, and it was super easy.

By the third time, I had no fears, and it was still super easy.

I've now prepared the PCT papers and zip file using ePCT for 20 PCT applications (19 filed the US/RO via EFS-web and one filed with the IB (my 4th time using ePCT) as the RO, when EFS-Web was broken ... and have to say that using ePCT hasn't become any easier because it was already as easy as easy can be. That is, it can't get any easier to use.

Also, one need not bother getting an ePCT code to then plug into the software to have the application associated with your WIPO account/workbench.

Just try it. You'll be glad you did.

This unsolicited testimonial came from one PCT user to another. The person who wrote this is a very smart, and very skeptical, patent practitioner who is never shy if she thinks there is something wrong with a software product or user interface design. In response, another PCT user wrote:

Same here. ePCT is the way software should be done. From the first time I used it. (Is anyone in Alexandria paying attention? Anyone? Yoohoo?)

This comment came from another very smart patent practitioner who is never shy if he thinks there is something wrong with a software product or user interface design. (These comments are drawn from the PCT listserv (https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com), which of course you should join if you have not already done so.)

Although it is far too late to do as much good as it could have done, it is not too late for the Patentcenter developers to look at ePCT to see how to do things right. That's one of the

things the Patentcenter developers should do right now.

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One thought on “If only the Patentcenter developers had looked at ePCT”



Ben Appelbaum says:

July 12, 2020 at 6:56 pm (<https://blog.oppedahl.com/?p=6217#comment-177796>)

So, what is the purpose of Patent Center again?

I'm supposed to be taking a USPTO session on its' beta-testing/training within the coming week.

From all of the comments I've seen about PatentCenter, just wondering if this will be an effort in futility.

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How should USPTO interact with its Patentcenter beta testers? (<https://blog.oppedahl.com/?p=6227>)

11th July, 2020 (<https://blog.oppedahl.com/?p=6227>) (<https://blog.oppedahl.com/?author=1>)

The USPTO is developing its Patentcenter system which it intends will eventually replace EFS-Web and PAIR. Eventually USPTO plans to shut down EFS-Web and PAIR and the only way that customers of the USPTO will be able to accomplish the functions formerly carried out through EFS-Web and PAIR will be by means of Patentcenter. From the outset, USPTO has said that one of its stated requirements for Patentcenter is that it must offer at least all of the functions of EFS-Web and PAIR.

Patentcenter is not yet released from beta test, and rightfully so, given that many features of EFS-Web and PAIR are not yet implemented in Patentcenter, and given that many things in Patentcenter do not work correctly or do not work at all. (See Patentcenter Trouble Tickets (<https://patentcenter-tickets.oppedahl.com/>) and Patentcenter Feature Requests (<https://patentcenter-tickets.oppedahl.com/patentcenter-feature-requests/>).) During beta test, a natural question is, in what way or what ways should the people at the USPTO who are responsible for developing Patentcenter interact with those beta testers?

The USPTO has made clear that it feels it should not have to respond in any direct way to any of the beta testers when they report bugs or missing features. The USPTO has made clear that it feels there are exactly three ways, and only three ways, in which beta testers should communicate bug reports or missing-feature reports to the USPTO:

- USPTO Ideascale
- opening of trouble tickets at the USPTO Electronic Business Center
- sending email to eMod@USPTO.GOV

That's it. Three one-way communications channels.

Reviewing the three mechanisms briefly —

- Ideascale, although well intentioned, has not worked and does not work. See my blog article USPTO's Ideascale — where good ideas go to die (<https://blog.oppedahl.com/?p=6123>). The large body of Patentcenter problem reports that alpha testers of Patentcenter posted to Ideascale in 2018 and 2019 that had never gotten fixed somehow got deleted from public view by the USPTO a few months ago. Why did USPTO delete that body of postings from public view? One can only speculate what the reason might be. To see my own Ideascale postings again, I actually had to file a FOIA request at the USPTO. You can see my alpha tester Ideascale postings in that blog article.
- Opening trouble tickets at the EBC has not worked and does not work. Although a small portion of Patentcenter bugs reported to the EBC have gotten fixed, most have not. I have filed a FOIA request asking for documents showing the disposition of the Patentcenter trouble reports that I reported to the EBC. (See blog article (<https://blog.oppedahl.com/?p=6225>).) Not once have I ever heard back with any disposition of even one of the trouble reports about Patentcenter that I opened at the EBC from the start of alpha testing (autumn 2018) to the present.
- Sending email to eMod@USPTO.GOV. A small portion of bugs and feature requests reported by email to this email address have gotten fixed or implemented. Most have not. Most alpha and beta testers who report bugs and feature requests to that email address never hear anything substantive back in response to any of those emails.

The three mechanisms are one-way. Some USPTO testers feel the phrase “black hole” is the most succinct way to characterize those three communications mechanisms.

Shortly after the USPTO released Patentcenter to beta testing by all users, a group of Patentcenter beta testers formed an email discussion group (a “listserv”) called the Patentcenter listserv. Anyone who wishes may join the listserv (https://oppedahl-lists.com/mailman/listinfo/patentcenter_oppedahl-lists.com). The listserv maintains three lists:

- Patentcenter Trouble Tickets (<https://patentcenter-tickets.oppedahl.com/>)
- Patentcenter Feature Requests (<https://patentcenter-tickets.oppedahl.com/patentcenter-feature-requests/>)
- Good things about Patentcenter (<https://patentcenter-tickets.oppedahl.com/good-things-about-patentcenter/>)

These users have repeatedly asked the USPTO, through channels both formal and informal, for four things:

- Asking that the Patentcenter developers pick one or two people from their developer team to subscribe to the Patentcenter listserv to follow the postings. This might sometimes permit those people to pass things along from the listserv to appropriate colleagues on the Patentcenter developer team.
- Asking that the Patentcenter developers formally adopt the trouble ticket page (<https://patentcenter-tickets.oppedahl.com/>) as a “to do” list for trouble ticket action by the developers.
- Asking that the Patentcenter developers formally adopt the feature request page (<https://patentcenter-tickets.oppedahl.com/patentcenter-feature-requests/>) as place for the developers to receive feature requests for Patentcenter.
- Asking that the Patentcenter developers report back to the listserv each time the developers clear a trouble ticket, referencing the trouble ticket number in the report.

As of the present time the USPTO has not done any of these four things, and instead, the USPTO has declined to receive beta tester communications by any means other than the original three mechanisms mentioned above.

If you were to look at the items listed on the trouble ticket page (<https://patentcenter-tickets.oppedahl.com/>) and on the feature request page (<https://patentcenter-tickets.oppedahl.com/patentcenter-feature-requests/>), you would see that many of the items were reported to the USPTO as long as twenty months ago using those three original mechanisms. The three original mechanisms just don't work.

I have tried to think of ways to help the USPTO understand why it should in fact pay attention to and communicate with the Patentcenter listserv rather than refusing to communicate with it. This prompted me recently to survey the membership of the Patentcenter listserv. At the time of the survey (which was by now a couple of weeks ago), the membership of the listserv was just over 160 Patentcenter beta testers. From the survey I learned that during the past ten years, this group of patent office customers had, personally or through their firms or corporations, filed well over **twenty thousand US patent applications and US national-phase entries**. I learned that during the past ten years, this group of patent office customers had, personally or through their firms or corporations, paid well over **sixty million dollars** in fees to the USPTO. Maybe these could be reasons why the USPTO should pay attention to, and communicate with, the Patentcenter listserv rather than refusing to communicate with it.

But I think patent practitioner Neil Ormos said much more clearly why the USPTO ought to make time to communicate with the listserv:

While I can understand that an Associate Commissioner's time is in high demand, I would hope that other PTO personnel would be more available to participate in a regular information exchange process with the Patentcenter interest group.

Big companies and government agencies often conduct market research panels through which consumers are asked to analyze and critique web sites and other service offerings. These research panels involve skilled facilitators and are quite expensive.

Here, Carl and his Patentcenter colleagues have done the work of assembling a panel of interested, competent users and organizing the feedback so as to be highly constructive, and are making it available at no cost. It would be a shame if the PTO did not take full advantage of this excellent resource.

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One thought on “How should USPTO interact with its Patentcenter beta testers?”

Pingback: Getting USPTO to fix things that are broken in Patentcenter: EBC trouble
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Getting USPTO to fix things that are broken in Patentcenter: EBC trouble tickets (<https://blog.oppedahl.com/?p=6225>)

11th July, 2020 (<https://blog.oppedahl.com/?p=6225>) (<https://blog.oppedahl.com/?author=1>)

Some readers are aware of a struggle that is going on right now between a group of Patentcenter beta testers and the people at the USPTO who are in charge of the design of Patentcenter. The Patentcenter beta users comprise a *listserv*.

The Patentcenter beta testers point to many bugs and missing features in Patentcenter that have been broken and missing since autumn of 2018 when alpha testing of Patentcenter began. They ask USPTO to communicate with the listserv. USPTO has refused to communicate with the listserv. See blog article How should USPTO interact with its Patentcenter beta testers? (<https://blog.oppedahl.com/?p=6227>)

USPTO has repeatedly said that there is no need for it to communicate directly with the listserv because its original alpha tester and beta tester feedback mechanisms are supposedly more than adequate. The three original mechanisms are:

- posting messages to USPTO's Ideascale
- opening of trouble tickets at the USPTO Electronic Business Center, and
- sending email to eMod@USPTO.GOV.

None of these mechanisms works even remotely well, from the point of view of the alpha testers and beta testers. I personally have reported many Patentcenter bugs to the EBC since the start of alpha testing in autumn of 2018, and not once did I ever hear back from the EBC about whether any bug got fixed or how a trouble ticket somehow got closed.

There had been a point a few weeks ago at which it seemed the USPTO was on the verge of making it possible to have some actual direct communication between USPTO's Patentcenter developers and the listserv. Since then, unfortunately, I have not heard further from the USPTO. Meanwhile, the Trouble Report list (<https://patentcenter-tickets.oppedahl.com/>)

maintained by the listserv continues to grow, and the Feature Request list (<https://patentcenter-tickets.oppedahl.com/patentcenter-feature-requests/>) maintained by the listserv continues to grow.

So the natural question that arises is, what might we as USPTO customers do to help the USPTO to understand that it is actually in the USPTO's interest to make time to communicate directly with the listserv? I realized that one possibility is that maybe the USPTO decisionmakers do not fully appreciate the depth of failure of the original three mechanisms in terms of getting bugs fixed and getting missing features implemented. Maybe if USPTO were to see an itemised report, listing one by one in an objective fashion, the many dozens of Patentcenter missing feature reports that were reported to the USPTO from autumn of 2018 to the present, that USPTO failed to implement? Maybe if USPTO were to see an itemised report, listing one by one in an objective fashion the many dozens of Patentcenter bug reports that were reported to the USPTO from autumn of 2018 to the present, that USPTO failed to fix?

The report would review bug reports and missing-feature reports that had been posted to Ideascale by alpha testers during alphatest. This is not easy to do because the USPTO has deleted those postings from public view — who can say why? I sent a FOIA request to USPTO and received a copy of all of my own alpha tester postings to Ideascale. If I were to make the time for it, I could work my way through the 75 pages of that document and itemize things, and generate some sort of report showing just how much of a failure the Ideascale mechanism has been in terms of getting Patentcenter bugs fixed and getting missing features implemented over the past 20 months. (You can see the 75-page FOIA response here (<https://blog.oppedahl.com/?p=6123>).)


The other thing would be to review all of the Patentcenter alpha test and beta test problems that I reported to the EBC from autumn 2018 to the present. I have reported dozens of bugs to the EBC. EBC opened many trouble tickets. Not once has anybody from the EBC gotten back to me in response to even one of those trouble tickets. I made a FOIA request to the USPTO asking for documents indicative of the Patentcenter trouble reports that I reported to the EBC from autumn 2018 to now, and documents indicative of how the USPTO somehow closed those tickets or otherwise addressed them. I heard back from the USPTO FOIA office that if I want these documents, I will have to send them a check for \$833.40. You can see the letter here (<https://blog.oppedahl.com/wp-content/uploads/2020/07/Fee-Estimate-.pdf>). I've just sent them the check and I am looking forward to seeing the results, which I suppose will show up in a couple of weeks. If I were to make the time for it, I could work my way through those documents as well, after they arrive, generating some sort of report showing just how much of a failure the report-to-EBC mechanism has been in terms of getting Patentcenter bugs fixed and getting missing features implemented over the past 20 months.

But imagine a different next few weeks or months. Imagine a future in which the Patentcenter developers, in a reversal of the previous digging-in of heels, might actually choose to communicate directly with the listserv. This would permit my energies to go toward a goal shared by the USPTO and by the listserv — making Patentcenter better. I would much rather direct my energies that way, rather than directing my energies toward generating detailed

objective reports showing the extent of failure of the old communications paths.

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One thought on “Getting USPTO to fix things that are broken in Patentcenter: EBC trouble tickets”

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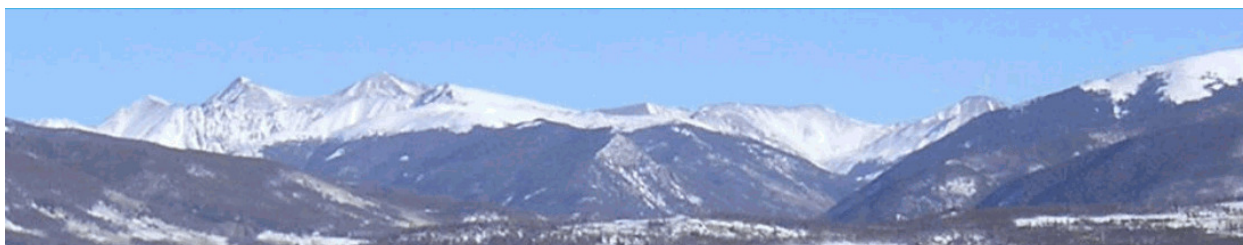
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Dozens of bugs in Patentcenter remain unattended-to (<https://blog.oppedahl.com/?p=6534>)

20th September, 2020 (<https://blog.oppedahl.com/?p=6534>) (<https://blog.oppedahl.com/?author=1>)

When the USPTO made Patentcenter available for alpha testing about two years ago, I was one of the alpha testers. As an alpha tester, I reported bug after bug to the USPTO. But I did not criticize the USPTO publicly. I was a good alpha tester, reporting the bugs *only privately* to the USPTO.

This went on for a year, and then USPTO quietly shifted from alpha testing to beta testing, and it meant that more users got added to the pool of testers. The beta testing was also a closed environment, just like the alpha testing. I was a good beta tester, continuing to report bugs *only privately* to the USPTO.

I think it is possible that my firm was the most diligent and prolific alpha- and beta-tester of Patentcenter during the closed alpha and closed beta testing phases. What makes me think this is:

- It appears that by the end of 2019, my firm had filed **fully half of all of the entries into the US national phase** from a PCT application that *anybody had filed* in Patentcenter (blog article (<https://blog.oppedahl.com/?p=6019>)).
- It appears that by April of 2020, my firm had filed **at least eight percent of all of the utility patent applications** that *anybody had filed* in Patentcenter (blog article (<https://blog.oppedahl.com/?p=5899>)).
- It appears that by April of 2020, my firm had filed **at least half of all of the design patent applications** that *anybody had filed* in Patentcenter (blog article (<https://blog.oppedahl.com/?p=5869>)).

To the USPTO's credit, it did fix perhaps one-third of the bugs that alpha- and beta-testers reported. But even now, two years later, many bugs that alpha- and beta-testers have reported to the USPTO have not gotten fixed.

This would not be so bad except that a few months ago the USPTO decided to release Patentcenter for beta testing by the general public. Anybody who wishes may now make use of Patentcenter.

And so as of that time I felt there is no need to keep bug reports private. I set up the Patentcenter listserv (https://oppedahl-lists.com/mailman/listinfo/patentcenter_oppedahl-lists.com), which is an email discussion group for beta testers of Patentcenter. I set up the Patentcenter trouble ticket (<https://patentcenter-tickets.oppedahl.com/>) web site.

What is disappointing is that many Patentcenter bugs that have been reported to the USPTO since it released Patentcenter for beta testing by the public have not been fixed. What is even more disappointing is that many Patentcenter bugs reported a year ago or even two years ago by beta- and alpha-testers have not been fixed.

Here is one example among dozens.

When you upload a PDF as part of your e-filing activity, your natural expectation about it might be:

If you upload it, and if you preview it in the e-filing system, and if it looks the way it is supposed to look, then you can safely click “submit” and it will look that way in IFW.

In ePCT, this is indeed how it works. If it is going to get degraded when you click “submit”, then the preview will show you what the degraded file would look like. This gives you fair warning. You can then set to work trying to figure out what to do differently so that the file will not get degraded so badly.

In Patentcenter, this is not how it works. A file containing gray scale might look perfectly normal to the human eye when previewed in Patentcenter. But it will get degraded badly after you click “submit”, and it might get degraded to the point of being unreadable.

Not only that, Patentcenter might convert it into blank pages.

I am not making this up. Blank pages. The preview will show normal pages that are not blank. And when you click “submit”, what will later turn up in IFW might be blank pages.

One thing that this means is that to protect yourself from malpractice liability when using Patentcenter, you have no choice but to go into IFW after you have e-filed a document, to view it and to see whether it has gotten converted into blank pages. And to see whether it has gotten blurred or degraded, perhaps to the point of unreadability.

This is not easy to do if, as has very often happened in recent weeks, you cannot see it at all in IFW until a day or two after the day that you e-filed it.

Which brings me to my disappointment at USPTO’s failure to attend to bugs that are being reported these days by the listserv community. Take a look at bug number CP27 (<https://patentcenter-tickets.oppedahl.com/>). This bug is the problem of Patentcenter converting a perfectly readable PDF file into blank pages. This bug got reported to the

USPTO on June 8, 2020. I blogged about it (<https://blog.oppedahl.com/?p=6112>) on June 8, 2020. Three weeks passed with no corrective action by the USPTO, so one of the listserv volunteers (Richard Schafer) cross-posted the bug report into Ideascale (direct link (<https://uspto-emod.ideascale.com/a/dtd/Patentcenter-converts-a-perfectly-good-PDF-into-a-blank-page-in/555838-31593>)) on July 4, 2020. Nobody from USPTO has responded in any way to this posting in Ideascale.

What prompted this blog posting today is a disappointing thing that happened yesterday when I e-filed a new patent application in Patentcenter. This time I got lucky and I was able to see the newly filed application in IFW right away instead of having to wait several days for it to be visible in IFW. And I was astonished to see that the USPTO ***had still not corrected the defect in Patentcenter*** that Patentcenter sometimes converts a PDF into blank pages.

Months have passed since this extremely serious bug got reported to the USPTO, and it has not been attended to even now.

As I say, in this case I got lucky. Instead of having to wait several days for the newly filed application to be visible in IFW, I was able to see this application right away in IFW. I clicked through the 120 or so pages of what I just e-filed, to see what damage Patentcenter had done to the various files that I had uploaded. Yes, many files were degraded but most of the degradations were modest enough to permit the pages to continue to be human readable. But three pages had gotten converted to blank pages. I then located the source PDF document and printed it to CutePDF and uploaded it and e-filed it again. This time Patentcenter did not convert it to blank pages. Because I was able to deal with this malfunction in Patentcenter on the same day that Patentcenter malfunctioned, I did not need to worry about losing a filing date due to the malfunction in Patentcenter.

But what is so very disappointing is that USPTO has seemingly paid no attention to this extremely serious bug report, even after some three months.

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7 thoughts on “Dozens of bugs in Patentcenter remain unattended-to”



David Boundy says:

September 20, 2020 at 6:55 am (<https://blog.oppedahl.com/?p=6534#comment-179448>)

Several aspects of the fundamental baked-in design of PatentCenter guarantee that it ***cannot possibly*** ever work reliably.

The first, most inviolable, no-questions-asked principle of a legal document filing system must be “what you file is what we get.” Bit-for-bit. Get your mitts off my bits. The federal court ECF system works that way — when you file a brief, you get a warning — “Did you do your redactions the right way? Have you flattened PDFs to single layer? We’re not going to fix it for you.” Then they take your bits exactly as you file them, and store exactly those bits. WIPO’s ePCT does that at least with the specification. They at least store the exact bits for the drawings, though they don’t (and can’t) guarantee that drawings will be rendered in the final publication exactly as filed (different resolutions, aliasing, etc.) But they come as close as humans can coerce machines to be.

The PTO takes the opposite view — what you file gets treated like input into a sausage factory.

Let’s look at the past. For the last 15 years, the PTO has recommended specific tools and specific settings that you “Print to PDF” — the result you get with the PTO’s settings is a text-form document that gets rendered to pixels by your rendering software. What does the PTO do with that? They convert your text-form document to a flat (fairly low resolution) bitmap! Within milliseconds, what you originally filed gets mangled to a degraded form! The difference between the letter “X” the Greek letter “X” or between the letter “x” and multiplication “ \times ” is gone. Not because of any necessary or inherent property of computers, but because the PTO ***threw it away*** as a matter of design choice.

Drawings submitted in vector form (and thus infinitely perfect at all resolutions, all rendering technologies, for all time) get downsampled to pretty low resolution.

Now let’s look at the future. The PTO, shedding the crocodile tears that “oh it’s so difficult to accurately OCR the flat bitmap back to text,” proposes that a year from now we’ll have to file .DOCX documents, which the PTO will convert to flat bitmaps, and then OCR back to text. Anybody with any experience in computers knows that

this **cannot possibly work** reliably. <https://brattahlid.wordpress.com/2012/05/08/is-docx-really-an-open-standard> (<https://brattahlid.wordpress.com/2012/05/08/is-docx-really-an-open-standard>) https://www.uspto.gov/sites/default/files/documents/Comment_Seventy_Three_Patent_Practitioners_092719.pdf (https://www.uspto.gov/sites/default/files/documents/Comment_Seventy_Three_Patent_Practitioners_092719.pdf) Any number of people have written to the PTO that the right solution to the OCR problem is “Stop degrading the text-based PDFs that people file. Use them. Just like WIPO. Just like the federal courts. Just like the EPO. Stop being an outlier.” How does the PTO react? By lying its ass off in the notice of Final Rule, by quite overtly rewriting the comments to “leave out the hard parts.”

Then comes Carl’s question today. The problem is that PatentCenter mangles the bits. The moron engineers working on PatentCenter think they know more about the bits than the bits do. That cannot be right. The design philosophy of PatentCenter must be “keep your mitts off my bits.”

Director Iancu, somehow the PatentCenter has become the mouse sticky trap for the dumbest software engineering in the western hemisphere. This is not just dumb. This is abject rejection of the basic science (information theory or Shannon Theory, depending on which grad school you went to) that governs computers.

Director Iancu, your goal has been predictability in proceedings? Then throw out this stupid PatentCenter. Maybe the right answer is to start over with WIPO ePCT, maybe not, but the right answer is unquestionably to throw this out, and start over with competent design foundations.

And then let’s look at the difference between the public comments and the Final Rule notice, and identify the people that rewrote the comments. That’s just plain illegal. Director Iancu, there are lawyers in your organization that need firing, and if you ask, I’ll help you identify them.

Reply



Richard Schafer says:

September 20, 2020 at 8:16 am (<https://blog.oppedahl.com/?p=6534#comment-179452>)

Carl, I can understand why the PTO might not have fixed the problem in 3 months, We don’t really know what is causing the problem, so we don’t know how complicated the fix is. But if the PTO is going to try to maintain the fiction that Ideascap is useful, someone needs to be tasked with at least review the Ideascap postings and acknowledging that the PTO will address the issue. Even better would be a response that not only says “We will fix this” but one that includes some identifier, ticket number, etc. that could be used for follow-up by the PTO’s customers. Every problem tracking system I’ve heard of in the past 40 years has had a way of communicating that kind of information not only to the development/maintenance staff responsible for fixing the problem but also to the person reporting the problem, and surely the PTO is tracking their problems internally with some sort of tracking system that could do this. Even if that doesn’t speed up the fix, confirming to the problem submitter that the problem report has been accepted at least lets us know someone is aware of it.

Reply

David Boundy (<http://www.CambridgeTechLaw.com>) says:

September 20, 2020 at 8:47 am (<https://blog.oppedahl.com/?p=6534#comment-179453>)

About 30 years ago, when I was a hotshot software engineer (MIT invited me in for a couple afternoons to guest lecture), I wrote an article that might be instructive — David Boundy, *A taxonomy of programmers*, ACM SIGSOFT Software Engineering Notes 16(4):23-30 (Sept 1991). <https://dl.acm.org/doi/10.1145/122552.122553> (<https://dl.acm.org/doi/10.1145/122552.122553>) (also available at a number of other web sites — I'll let you find them). It wasn't exactly groundbreaking, just a collection of wise maxims I had learned from mentors, and personal observations of what happens over time to software that starts with bad design foundations.

One observation was that you can **never** bugfix your way out of badly designed software. When you fix it here, that will destabilize something else over there. You're always straining against the limits, the concrete walls that were designed in from day one. You have to throw it out and start with sound design foundations.

Director Iancu, it'll be a *lot* less expensive for the PTO over time, and literally **billions** less expensive for the economy, to take the existing PatentCenter as a "lessons learned" dry run, throw it out, and start over.

Reply

David Boundy (<http://www.CambridgeTechLaw.com>) says:

September 20, 2020 at 8:52 am (<https://blog.oppedahl.com/?p=6534#comment-179454>)

About 30 years ago, when I was a hotshot software engineer (MIT invited me in for a couple afternoons to guest lecture), I wrote an article that might be instructive — David Boundy, *A taxonomy of programmers*, ACM SIGSOFT Software Engineering Notes 16(4):23-30 (Sept 1991). <https://dl.acm.org/doi/10.1145/122552.122553> (<https://dl.acm.org/doi/10.1145/122552.122553>) (also available at a number of other web sites — I'll let you find them). It wasn't exactly groundbreaking, just a collection of wise maxims I had learned from mentors, and personal observations of what happens over time to software that starts with bad design foundations. But it's apparently good enough that it has ended up in several universities' reading packets for their software engineering curricula.

One observation was that you can **never** bugfix your way out of badly designed software. When you fix it here, that will destabilize something else over there. You're always straining against the limits, the concrete walls that were designed in from day one. You have to throw it out and start with sound design foundations.

Director Iancu, it'll be a *lot* less expensive for the PTO over time, and literally **billions** less expensive for the economy, to take the existing PatentCenter as a "lessons learned" dry run, throw it out, and start over. Have your folks read the paper before beginning.

Reply**Ben Appelbaum says:**September 21, 2020 at 10:44 am (<https://blog.oppedahl.com/?p=6534#comment-179478>)

Do you think that sending this blog post to Director lancu would have any positive effect towards getting this mess resolved?

Reply**oppedahl says:**September 21, 2020 at 11:01 am (<https://blog.oppedahl.com/?p=6534#comment-179479>)

Yes that is a very good question. Until now I have not chosen to aim my communications that high. A couple of weeks ago I wrote privately to a person at a fairly high level. It went unanswered. Over the weekend I wrote privately to a person at a somewhat higher level, not as high as lancu.

If it drags on too long, I suppose what would have to happen is another open letter signed by ninety patent practitioners. Or one hundred ten patent practitioners. Something like that.

Reply

Pingback: "We're unable to reproduce this issue" say the Patentcenter developers - Ant-like Persistence (<https://blog.oppedahl.com/?p=6548>)

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USPTO's Ideascale — where good ideas go to die (<https://blog.oppedahl.com/?p=6123>)

16th June, 2020 (<https://blog.oppedahl.com/?p=6123>) (<https://blog.oppedahl.com/?author=1>)

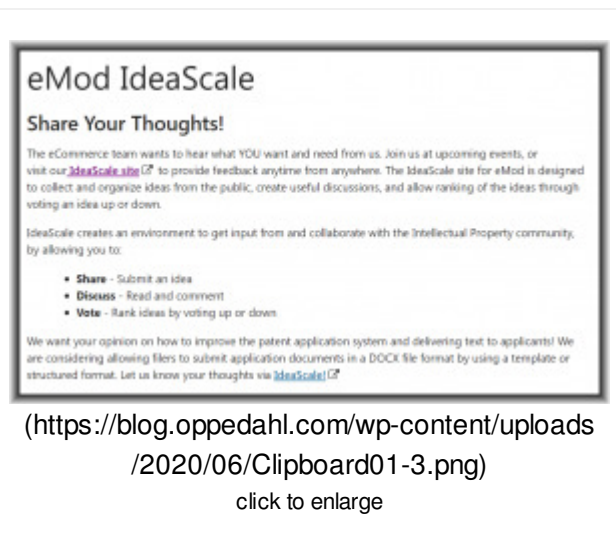
The alpha testers of Patentcenter began their work in summer of 2018, and immediately found many things that needed fixing in Patentcenter. This blog article describes the complete failure of USPTO's Ideascale system, which supposedly was to provide a way for the alpha testers to report the things that needed fixing.

It will be recalled that Patentcenter was and is intended by USPTO to eventually replace both Private PAIR and EFS-Web.

From this it is obvious that from the outset, one of the up-front design goals for

Patentcenter needed to be be “we need to work carefully through the feature list for Private PAIR and make sure that every feature available to a user in Private PAIR gets carried forward into Patentcenter”. Likewise it is obvious that one of the up-front design goals for Patentcenter needed to be be “we need to work carefully through the feature list for EFS-Web and make sure that every feature available to a user in EFS-Web gets carried forward into Patentcenter”.

So of course one of the contributions of the alpha testers in summer of 2018 was that they noticed right away some of the important features of EFS-Web and Private PAIR that were missing from Patentcenter. One example among dozens of others is “last forty acknowledgment receipts”.



Another contribution of the alpha testers was that they noticed programming errors, flaws, and bugs in Patentcenter.

Many of the alpha testers were active users not only of USPTO's systems but also of systems at other patent offices, and so were in a position to see examples of what other patent offices had gotten right and that USPTO had gotten wrong in its design of EFS-Web and in Private PAIR. Over and over again what an alpha tester of Patentcenter would encounter is some aspect of the ePCT system, for example, that was ideally designed from the user point of view and that in EFS-Web or in PAIR was poorly designed. Of course the natural reaction of the alpha tester was to hope that by communicating the "ideal design" to the USPTO early in the Patentcenter development process, the USPTO could avoid repeating the earlier design mistake and could get it right in Patentcenter.

By September of 2018 the list of missing features, bugs, and design mistakes had gotten quite long. Many of the problems with Patentcenter were the kinds of problems that could be fairly easily communicated in words, and in relatively few words. "Where are the last forty acknowledgments?" was easy to communicate. Other design mistakes in Patentcenter were the kinds of mistakes that can only be clearly communicated by live demonstrations. For example in the summer of 2018, the alpha testers kept running into this sort of problem:

- You are at a screen for uploading PDF files for later e-filing.
- You upload a PDF file.
- If you know where to click, there is a place where you can indicate "what it is" for example claims or drawings or remarks.
- Suppose you forget to indicate the document description and instead you just try to click the button to go to the next page? Will it be greyed out, due to the missing document description?
- No, it won't be greyed out. Patentcenter won't stop you. When you click, it will go to the next page, which is for paying fees.
- On the "fees" page, suppose that eventually you try to click the button to go to the next page? Will it be greyed out, due to the document description being missing from the previous page?
- No, it won't be greyed out. Patentcenter won't stop you. When you click, it will go to the next page, which is for clicking "submit".
- On the "submit" page, suppose that you try to click the button to submit. Will it be greyed out, due to the missing document description?
- No, it won't be greyed out. Patentcenter won't stop you. When you click, Patentcenter will make a guaranteed-to-fail attempt to do the submission. Only at that point, for the first time after three pages have come and gone, will Patentcenter for the first time gripe that there is no document description.

As you will appreciate, it is not easy to communicate this in words. The right way to communicate this to the developer of the software is by means of a shared desktop. The alpha user can share his or her desktop, and the participants can all watch as the e-filing process clicks through the several screens. And then when the process smashes into the brick wall after the filer clicks the "submit" button, everybody can clearly see what needs to be fixed.

Which is why, in the summer of 2018, I organized a Gotomeeting for the developers of Patentcenter. This was set for noon Eastern Time on Friday, September 21, 2018. I invited some of the alpha testers and I invited the USPTO people in charge of Patentcenter

development. The agenda was that we alpha testers were going to share our desktops and demonstrate for the USPTO people some of the click-path design mistakes in Patentcenter.

The appointed time arrived. Alpha testers from the East Coast, from the West Coast, from Chicago, and from the mountains of Colorado were all logged in. We all had our USB headsets on and we were really looking forward to the opportunity to help the USPTO folks in charge of Patentcenter accomplish some of their alpha-testing goals.

A couple of minutes passed. We alpha testers discussed the weather. I imagine we all looked at our wristwatches. A couple more minutes passed. Where were the USPTO people? One of our alpha testers tried to call her contact at the USPTO. She reached only voice mail.

After a quarter of an hour, we gave up, puzzled.

We rescheduled the Gotomeeting for Thursday, October 11, 2018. Again the invitations went out. The attendees were to be the USPTO developers and some of the alpha testers. The day before the meeting, an email arrived letting us know that no, the USPTO people regretted to inform us they would be unable to make time for the Gotomeeting.

We continued our alpha testing. A few days later, an unsigned email came out from the USPTO to all of the alpha testers, informing us that there would be an online meeting a few days hence. The email provided a URL for logging in. Our feedback was very valuable, the email said. The day arrived, and we all logged in.

And the online meeting was configured so that the only communications were in a single direction. From the USPTO to the alpha testers. There was no opportunity for any communication from the alpha testers to the USPTO. All of the alpha testers were "on mute". It was impossible to provide any live feedback.

What eventually happened is that the USPTO developers told the alpha testers that their very valuable feedback should be provided to the USPTO by means of USPTO's Ideascale system.

Ideascale was, and is, a noble experiment. Unfortunately it is a noble experiment that failed. The idea of Ideascale is that participants in some group activity can post ... wait for it ... ideas! And then participants can "vote" to indicate which ideas are good ideas. This then permits ... in this case ... the Patentcenter developers at the USPTO ... to see which ideas are the good ideas and then the USPTO can implement those ideas.

So what happened in October of 2018 is that the USPTO set up a "Patentcenter Alpha" workgroup in the USPTO's Ideascale system. And the alpha testers were all set up as users in this Ideascale workgroup. The concept was that any time an alpha tester found a bug in Patentcenter, the alpha tester could post the bug report as an "idea" in Ideascale. Other alpha testers who ran into the same bug could click the "plus" button.

Likewise if an alpha tester were to identify some feature that was missing from Patentcenter (think of the "last forty ack receipts") the alpha tester could post this feature request as an "idea" in Ideascale. Other alpha testers, if they were to feel that this feature was actually

needed, could click the “plus” button.

Given that by autumn of 2018 the USPTO developers had made it very clear that they were never going to show up for a Gotomeeting, and were never going to answer emails, and were only going to permit the use of Ideascale as the sole mechanism for alpha tester contributions, the alpha testers all set to work methodically posting “idea” after “idea” in the system. Many hundreds of “ideas” got posted. Many hundreds of “plus” buttons got clicked.

By January of 2019 I had achieved the honor of being awarded some nine “badges” in USPTO’s Ideascale system, the most prestigious of which was the “Occupier” badge (blog article (<https://blog.oppedahl.com/?p=4023>)). What this means is that I had been logged in on Ideascale *more than any other user*. I am not making this up! Go to the blog article and see the screen shots that prove this. Other badges that USPTO had awarded to me in this system were the Candidate badge, the Warhol badge, the Judge badge, the Apprentice badge, the Marconi badge, and the Team Player badge.

Back then I was still sipping the Ideascale Koolaid and I concluded that blog article with a suggestion that users of EFS-Web and PAIR and Patentcenter ought to participate in Ideascale so as to promote the shared goals of the USPTO and its customers.

Now we fast forward to spring of 2020. During the intervening year and a half, the USPTO developers migrated from an alpha-test phase to a beta-test phase, still by invitation only. But by spring of 2020 the USPTO developers decided to throw open the doors and allow everybody to be a beta tester of Patentcenter.

My reaction in spring of 2020 was that Patentcenter was still not ready for prime time. Features that had been missing in summer of 2018, such as the *Last Forty Ack Receipts*, were still missing in spring of 2020. The click-path design mistake that if you had somehow overlooked the need to provide a document description for an uploaded PDF, Patentcenter would wait until three screens later and then spring it on you only when you click “submit” ... which had been a problem in summer of 2018, was still a problem in spring of 2020.

Which then prompted me in spring of 2020 to go back to Ideascale to look at the postings of the alpha testers of Patentcenter from summer of 2018 and autumn of 2018 and winter of 2018. How many of the bugs that we long-suffering alpha testers had reported back then had gotten fixed by the USPTO developers? How many of those bugs were still outstanding? How many of the features from EFS-Web and from PAIR that we reported as missing back then had been attended to by the USPTO developers? How many were still missing in 2020? How many user interface design mistakes that we reported back then had gotten fixed by the USPTO developers? How many were still outstanding in 2020?

I also figured it would be interesting to see the extent to which the “plus” voting mechanism had delivered on its promise. When a large number of alpha testers all clicked “plus” on some needed feature, did USPTO developers add the feature?

And I was gobsmacked to find that all of the postings of the alpha testers of Patentcenter from summer of 2018 and autumn of 2018 and winter of 2018 are gone! Deleted! I wrote to the USPTO developers to ask what happened to the “ideas” from the Patentcenter alpha testers,

and the answer I got was:

If your ideas were posted in the Patent Center Alpha campaign, those items have been archived but we as moderators still have access to them. We want to thank you for submitting your ideas. We value each idea and regularly review them for consideration.

Yeah, right. So I filed a FOIA request, asking for all of my Patent Center Alpha postings. USPTO provided a response letter (<https://blog.oppedahl.com/wp-content/uploads/2020/06/Full-Disclosure.pdf>) and a nearly unusable 55-page PDF (<https://blog.oppedahl.com/wp-content/uploads/2020/06/F-20-00131.pdf>). Here is what I found on a quick look through the 55-page PDF:

- Almost none of the bug reports that I reported during the alpha test got fixed.
- Almost none of the feature requests that I posted during the alpha test were acted upon.
- In general, if you compare the the ideas that got “plus” votes from other alpha users with the ideas that did not, *fewer* of the ideas that got “plus” votes were acted upon by USPTO people.
- As for the click-path design mistakes that I reported, *not one of them got fixed*.

Here is what one beta user of Patentcenter said recently about Ideascale:

... asking us to continue using broken ways of reporting things just doesn't make sense anymore. There are two big problems. One of the problems with things like Ideascale is ... that the issues we report aren't getting fixed. But the other big problem is that Ideascale and its ilk are black holes: whether the suggestion is brilliant or idiotic or is voted up or down by Ideascale users, there's never any feedback from the developers that lets anyone know they've even looked at the suggestion. If they would do something as simple as responding “we like that idea, and will put it on our to-do list” or “we will not make that change” (preferably with reasons why) that would be better than the nothing we see now. Human nature being what it is, people tend to stop reporting things if they get no response to those reports.

And another beta user reported this:

Bit late to the game here, but I can actually confirm that I have had one (1) IdeaScale submission implemented! It just... got un-implemented not long thereafter. I went back to look for the idea(s) I've submitted in IdeaScale to check the dates, and it looks like they deleted or hid most of the previous campaigns, which is its own flavor of interesting, but I was able to get dates for my (the?) one implemented idea from my email records and old filing receipts.

Putting the best face on it, the USPTO's Ideascale project was a noble experiment, albeit a failed experiment. It never fulfilled its promise. It is a place where good ideas go to die.

If you want to help USPTO in its effort to fix bugs in Patentcenter ... if you want USPTO to correct click-path design mistakes in Patentcenter ... if there are features from PAIR or EFS-Web that are missing from Patentcenter that you would like to report ... the only way I know to do it that has a chance of working is to join and participate in the Patentcenter listserv (<https://patentcenter-tickets.oppedahl.com/>).

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2 thoughts on “USPTO’s Ideascale — where good ideas go to die”

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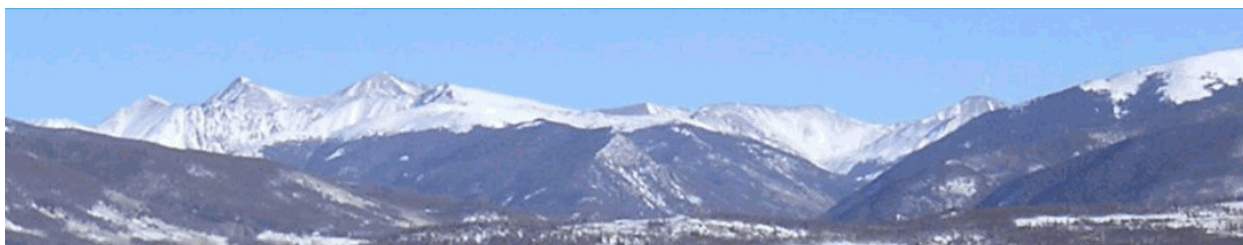
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Still concerned about DOCX? (<https://blog.oppedahl.com/?p=6073>)

27th May, 2020 (<https://blog.oppedahl.com/?p=6073>) (<https://blog.oppedahl.com/?author=1>)

A colleague today noted that by now more than a month has passed since the last time I griped about USPTO's DOCX activities in this blog. He wondered if perhaps my silence was an indication that I feel the USPTO people have somehow addressed my concerns about the DOCX situation.

Just so that there is no risk of any misunderstanding about this, no, it is not the case that anything that anyone at the USPTO has done has alleviated in any way my concerns about USPTO's DOCX plans.

Indeed to the extent that the most recent communications emanating from the USPTO have any affect on my sense of how things are going, my concerns are more grave and more pessimistic than before, in two different ways.

First, it had seemed to me for a long time that there was some decision group within the USPTO, some group of people, who had long ago unilaterally decided that it is going to be DOCX and it does not matter what practitioners or applicants think about it. And it had seemed to me that we can file all the comments we wish to the Notice of Proposed Rulemaking, and the decision had been made and the comments were not going to make any difference. And a first way that my concerns are more grave and more pessimistic is that as far as I can tell, the locked-in-place nature of this DOCX decision remains in place and if anything is now more locked-in-place than before.

Second, some of the communications seem to signal that there are people pretty high up in the USPTO who "just don't get it" when it comes to appreciating or understanding the point of view of the applicant or the point of view of the practitioner.

A recent letter from a high-up USPTO person to AIPLA said this:

Thank you for your thoughtful letter and for raising awareness of concerns related to DOCX filing. The USPTO is continuously improving our information technology (IT) to support mission critical needs, both internally and externally. We recognize that many applicants have concerns with the new way of filing patent applications, but believe the requirements are essential for integrity and security of the filing system.

We agree with the AIPLA member feedback that the document of record should be something that the applicant can be assured is the same in the USPTO as what the applicant submitted and filed. We are excited to report that this is built in the USPTO DOCX process. When an applicant submits a DOCX document, our systems generate a hash value based on all elements in that document. This hash value is displayed on the submission's Acknowledgement receipt. If the document is altered in any way, the hash value associated with that DOCX document will be different than the value printed on the Acknowledgement receipt. An applicant can independently verify that the DOCX document stored in our USPTO systems is the same document that they submitted, by downloading the DOCX document from Private PAIR or Patent Center and then computing the hash value of that document. That hash will match the hash on their receipt. There are a number of free online tools that can be used to calculate the hash value.

Regarding some AIPLA members' concerns that the DOCX file may still render differently in different environments, the USPTO DOCX process imposes restrictions such that documents appear the same on each computer. Plugins and additional settings are not allowed, with the exception of a few validated tools (e.g., ChemDraw, and the like). Fonts are also limited to a small set of commonly used fonts that do not have variation from machine to machine. In addition, we have tested many DOCX files from different sources and have not seen visual rendering errors.

Although rare, it is possible for a PDF file to render differently on different computers. When this has happened in the past, the USPTO has worked with the applicant to make sure the correct document is recorded in the patent application. The USPTO will continue to provide excellent customer service to our applicants.

Thank you for the suggestion of using text-based PDF as a solution for text filing. This was one of our initial considerations. The USPTO conducted a year-long exhaustive study looking into the feasibility of text-based PDFs. It was determined that although text data are available in some PDFs, the data could not be consumed in a reliable manner. The presentation of text data extracted from a text-based PDF cannot be preserved. For example, headers and footers can be mixed with the content of pages and tables can be lost. PDFs are not meant to store text data and are used as a display format. With DOCX, we are able to transform the document to an XML format which we can pass to our USPTO downstream systems. Furthermore, having this XML data available allows for future cooperation with international XMLization efforts.

We strongly discourage submitting the DOCX and applicant-generated PDF of the same file. This would be duplicative, which would cause confusion as to what would be

considered as the authoritative file. Direct submission of DOCX format ensures that submitted files from all applicants are converted to PDF by USPTO systems in a consistent manner.

We appreciate your interest in this important matter and your suggestions to improve the USPTO IT Systems. We look forward to future opportunities to continue to engage with you.

So let's try to set out the backdrop to this letter.

The general question is, TYFNIL, when it suddenly becomes extremely important to work out whether the thing in the middle of some math formula was a smiley face or a square root sign, and when the patent owner says it is supposed to be one thing and the accused infringer says it is supposed to be the other, how will the judge and jury decide who wins and who loses?

In the old days the answer would be, we look at the file wrapper and we look at the ink on the page of the patent application. Or we look at a PDF file that is pretty much the same thing as "ink on the page".

The regime that the USPTO proposes to force down the throat of the patent applicant is that unless you are willing to pay a \$400 penalty, at 11:45 PM when you upload a DOCX file to the USPTO e-filing system, the USPTO e-filing system will then use a proprietary rendering engine to render it into a PDF. And will then display the PDF on your screen, and with the remaining fifteen minutes between now and midnight it will be up to you to scrutinize the PDF from the top to the bottom to see if for example a smiley face got changed to a square root symbol. And there on the screen in front of you will be an adhesion contract that USPTO says you must sign. This is a click-wrap button that says:

The PDF(s) have been generated from the docx file(s). Please review the PDF(s) for accuracy. By clicking the continue button, you agree to accept any changes made by the conversion and that it will become the final submission.

Now as far as I can see, "the final submission" means "the final submission". If the USPTO's proprietary rendering engine changed the smiley face to a square root symbol, and if you clicked the continue button, then as far as I can see, you have agreed that the patent application as filed has a square root symbol in that position.

Meanwhile what did the USPTO person write to AIPLA? She pointed out that whenever you e-file anything in EFS-Web or in Patentcenter, of course the ack receipt lists a "hash" for each file that you uploaded. This is not news. It has been this way for many years. What she is getting at is that the idea of a hash function is that it makes it hard for the filer to play fast and loose as to what file exactly they uploaded. One whole point of a hash is that if you change even a single character in a file and calculate the hash of the file, the output of the hash function changes wildly. Another whole point of a hash is that if you were to set a goal of

creating a second file that is the same size as the first file, and that has different contents, but that yields the same output when passed through the hash function, in general you will not accomplish that goal.

What she is getting at is that TYFNIL you can bring in an expert who will say something like “I took this DOCX file and calculated a hash of it. And the hash matches what is in the ack receipt from ten years ago. And I rendered this DOCX file into human-readable form using <fill in blank with favorite word processor and version number>. Here is the ink on the page that I got.”

But meanwhile the adversary in litigation brings in an expert who says “this is the PDF from ten years ago that the USPTO generated on filing day, and on filing day ten years ago, the practitioner clicked on an adhesion contract agreeing on behalf of his client that the Office-generated PDF is the patent application of record.”

If those two PDFs don’t match, which one wins?

I have to say I think the judge and jury are likely to enforce the adhesion contract. And it won’t matter a bit what the outcome is of this exercise involving hash values from the ack receipt.

The notion that the USPTO person could think even for one second that pointing to the presence of hash values in the ack receipt would in any way alleviate the harm caused by USPTO’s adhesion contract ... this tells me that that USPTO person has no clue what it means to be an applicant or a practitioner. Or to be a litigant defending a patent in court.

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4 thoughts on “Still concerned about DOCX?”



Bob Leikes says:

May 27, 2020 at 6:08 pm (<https://blog.oppedahl.com/?p=6073#comment-176414>)

It seems to me that the problem is not docx, but rather the unwarranted shifting of the burden of checking the USPTO's pdf rendition on the day of filing. If an error is actually detected when reviewing the rendered pdf online, the applicant has no way to fix the error, so that the applicant would be forced to pay a penalty for not going through with the docx submission.

A more reasonable approach may be to treat the docx document as the official version, so that the applicant can obtain correction of the pdf rendition based on the docx version.

Reply



Bill says:

June 1, 2020 at 12:03 pm (<https://blog.oppedahl.com/?p=6073#comment-176472>)

Notwithstanding the OUTRAGEOUS situation

What about this work around? I would upload all pages of the spec ALSO as PDF drawings, and then one day later cancel them all in a preliminary amendment.

Then no one can say it wasn't all there including the equation with the Greek letter and NOT the smiley face.

I assume the USPTO has NOT yet limited the format for drawings.

I might even make a tool which automatically numbers them as Figs. 101, 102, etc [for each page of the spec]

My original filing would have 3 files — the .docx file they are forcing upon me, the REAL pdf of the REAL drawings, and my safety-net 'drawings' which is really the pdf of the original spec.

One day after filing, I would cancel Figs. 101-128 [e.g. for 28 page spec] in a preliminary amendment.

YES this is stupid, but patent practitioners have been circumventing stupidity for DECADES, especially post-Alice.

Thoughts?

Reply



oppedahl says:

June 1, 2020 at 12:12 pm (<https://blog.oppedahl.com/?p=6073#comment-176473>)

Yes clearly one feels the need to do some kind of workaround.
How about this. Chronologically prior to your nonprovisional filing that you really care about, you file the case as PDF as a provisional. Don't pay the filing fee. Get your application number and you know what date you filed it. Then in your nonprovisional, toss in a Miscellaneous Incoming Letter that contains a single sentence: Application number 62/xxx,xxx is hereby incorporated herein by reference.

Reply



Bill says:

June 1, 2020 at 12:17 pm (<https://blog.oppedahl.com/?p=6073#comment-176474>)

For US provisionals, I would ONLY file 'drawings'— if PAIR makes me file a spec, I would a one-page DOCX spec , something along the lines of
Jack and Jill went up the hill

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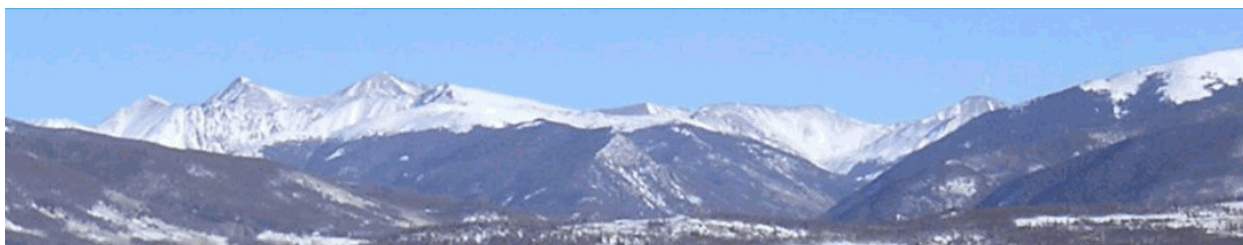
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An open letter to the Commissioner for Patents (<https://blog.oppedahl.com/?p=5825>)

13th April, 2020 (<https://blog.oppedahl.com/?p=5825>) (<https://blog.oppedahl.com/?author=1>)

What should the the USPTO do so that patent applicants and practitioners will be less reluctant to try filing with DOCX files?

The problem of course is that the e-filing regime which USPTO presently imposes is that when the filer uploads a DOCX file, the USPTO e-filing system (EFS-Web or Patentcenter) then renders the DOCX file into a PDF using USPTO's own proprietary rendering engine. The e-filing system then displays the PDF and presents an adhesion contract for a click-wrap signature by the filer. The filer is required to irrevocably agree that whatever appears in the PDF as rendered by the USPTO will control for all later purposes.

This e-filing regime is often played out at a time of day that is only a few hours or even just a few minutes prior to midnight on the day that the filer absolutely must get the patent application filed. Under such circumstances it is wholly unacceptable for USPTO to require that the filer proofread the entire PDF from the top to the bottom to see whether the USPTO's proprietary rendering engine might have rendered something incorrectly.

This e-filing regime presents an unacceptable malpractice risk for the patent practitioner.

This e-filing regime puts the patent practitioner in an untenable position regarding inventor workflow. The inventor is asked to review a draft patent application and to sign an inventor's oath or declaration based upon that draft patent application. The document reviewed by the inventor might be a word processor file in a format that is commonly understood by the inventor and the practitioner. Alternatively the document reviewed by the inventor might be a PDF file that was rendered by the practitioner. But later, at e-filing time, the practitioner uploads a DOCX file and the USPTO uses its proprietary rendering engine to render the DOCX file into a PDF file. And it is this PDF file which is the subject of the click-wrap adhesion contract. It is this PDF file, **which almost certainly is non-identical** to the PDF or

word processor rendering that was reviewed by the inventor, that USPTO intends will control.

What is untenable is that the practitioner is in the position of filing at the USPTO an inventor declaration that refers to a document or rendering that is known to be non-identical to the patent application actually being filed with that inventor declaration.

Everybody agrees that of course there are goals common to the applicant and to the patent office that are advanced whenever characters are provided rather than mere images.

For many years now, the patent community has suggested several ways to the USPTO by which the USPTO could greatly reduce or even eliminate these profound problems and risks from the existing DOCX e-filing regime. What is regrettable is that USPTO has ignored them all. For example many years ago the patent community pointed out to the USPTO the solution that had been arrived at in the PCT community, namely the filing of a “document in pre-conversion format”. You can read about this in Section 706 of the Administrative Instructions (<https://www.wipo.int/pct/en/texts/ai/s706.html>). This approach of course has the profound drawback of being “not invented here” from USPTO’s point of view.

The patent community has also pointed out that most patent applicants have for years been e-filing patent applications as PDF files *that do contain characters*. USPTO regrettably flattens such PDFs into pure-image TIF files when loading those PDFs into its IFW system. USPTO actively discards those characters. USPTO could get 80% of the way toward its character-capture goal simply by not discarding those characters.

As I say, these two approaches, the “pre-conversion format” approach and the “don’t discard the characters in the PDF” approach, have fallen on deaf ears at the USPTO. So today’s blog article offers yet another suggestion how USPTO could largely eliminate the risks and problems with USPTO’s DOCX e-filing regime.

The chief concern is the mistaken impression that there is some single unambiguous way that everyone in the world renders DOCX into human-viewable images, for example as PDF files. This mistaken impression is communicated by the oxymoron phrase “DOCX standard”. There is no “DOCX standard”. (The USPTO disingenuously and falsely refers to a “DOCX standard” but there is no such thing.)

This lack of any single unambiguous way that everyone in the world renders DOCX into human-viewable images only becomes a problem if a government agency selects some particular proprietary rendering engine and sets up a filing regime in which the rendering takes place **at e-filing time** and in which the user is required to agree **at e-filing time** to an adhesion contract that the images rendered by that proprietary engine control for later purposes. The combination of a rendering shortly before midnight on filing day, with an adhesion contract that the rendered images control, is absolutely unacceptable to applicants or to practitioners.

The single best way to eliminate this problem is for *USPTO to publish the source code for its rendering engine*. It’s as simple as that. Locate that body of source code, and with one or two mouse clicks, publish it on USPTO’s web site. That’s it. Then the problems all go away.

If for some reason the USPTO feels it cannot or will not publish that particular source code,

then USPTO should scrap that rendering engine and adopt an open-source rendering engine. Such an open-source rendering engine is available for example in the Libre Office software development platform.

If the rendering engine code is public, then applicants can see for themselves exactly how particular tags and markup will be rendered and in particular can see this ***well in advance of filing day***.

Ten years later in litigation, there would not be any opportunity for dueling experts to pretend to hold different views as to how a particular tag or markup would or would not have been rendered on filing day, because the open-source rendering engine would have been documented and date-stamped in the relevant software development platform.

So there's the answer, presented in this open letter to the Commissioner for Patents. Publish the source code for your DOCX-to-PDF rendering engine. Do that, and I can promise you that the patent filing community will join you in moving this DOCX e-filing initiative forward.

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5 thoughts on “An open letter to the Commissioner for Patents”



Bob L. says:

April 13, 2020 at 1:49 pm (<https://blog.oppedahl.com/?p=5825#comment-175303>)

Thank you for taking another run at resolving what I agree is an untenable way to treat applicants and their representatives. There are so many examples of USPTO initiatives that were implemented only to be withdrawn due to having been ill-conceived. Rather than serving taxpayers and the user community, such initiatives undermine their interest in a well-functioning system, even though that community supported the USPTO's effort to make the USPTO self-financed via fees that have increased substantially since I entered practice before the USPTO.

Reply



shalom says:

April 13, 2020 at 2:09 pm (<https://blog.oppedahl.com/?p=5825#comment-175305>)

While a large number of practitioners are able to read the code, i must admit that despite having a computer science degree, i cannot see myself reading the code, and comparing each file I read to the different tags, etc. For those that do not have extensive computer background, this is even less of an option.

i am fully for using text pdf's and having the office simply stop this insane docx demand.

yet another option is depositing a visual file, with a docx – for the office's convenience. The controlling document must be what I saw when I filed.

I also believe strongly that it is unfair and immoral of the Office to demand that after I read the application, the inventor read the application (all which may take significant time) that I must again read the document, and compare every iota prior to committing to the accuracy of the conversion that I have no way to control. It is extremely difficult to do, and moreover, extremely expensive for the client. And all for the Office to cover it's incompetence.

i believe that we should simply fight this whole messed up concept with each and every legal way open to us. We did something similar with the insane RCE/continuation regulations, and hopefully will succeed with this new insanity.

Reply



Dan Feigelson says:

April 19, 2020 at 5:04 am (<https://blog.oppedahl.com/?p=5825#comment-175552>)

Shalom, I'm with you. I'm not a programmer. Publishing source code or any

other kind of code won't help.

And Carl, this is not a case of "if at first you don't succeed, try suggesting something else". Several reasonable proposals have been made to the USPTO. The USPTO's deafness is no reason to put forth another *unreasonable* proposal.

WIPO already solved how to deal with pdfs: allow applicants to submit "pre-conversion" documents. But, yet again, the USPTO refuses to learn from anyone else.

Reply



Bill Eshelman says:

April 16, 2020 at 9:03 am (<https://blog.oppedahl.com/?p=5825#comment-175432>)

I agree with Shalom. I would have to undergo some serious training to be able to read the code and compare each document to the different tags, etc. If the current system (which I find works well) must be changed, the solution that had been arrived at in the PCT community, namely the filing of a "document in pre-conversion format" seems like a much better alternative.

Reply



oppedahl says:

April 16, 2020 at 9:14 am (<https://blog.oppedahl.com/?p=5825#comment-175433>)

The idea is not that each and every applicant and practitioner has to sit and read the source code.

The idea is that a few people sit and read it. And that it can be archived and USPTO commits to using that source code and not some other source code. That's all you need for the transparency to work.

Reply

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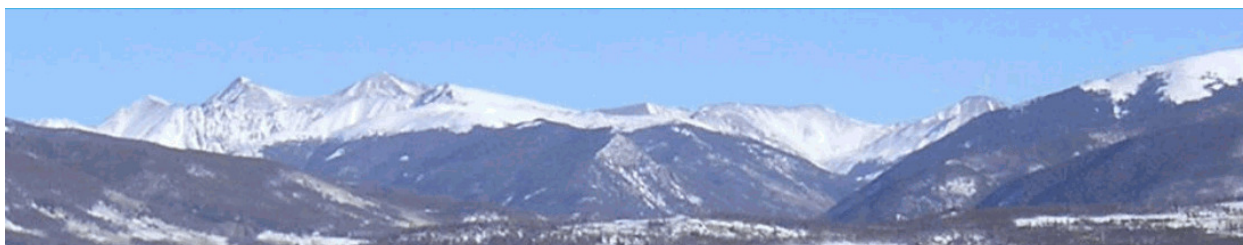
Website

☐ Notify me of follow-up comments by email.☐ Notify me of new posts by email.

This site uses Akismet to reduce spam. [Learn how your comment data is processed \(https://akismet.com/privacy/\)](https://akismet.com/privacy/).

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Who was a beta-tester of ePave? (<https://blog.oppedahl.com/?p=5796>)

2nd April, 2020 (<https://blog.oppedahl.com/?p=5796>) (<https://blog.oppedahl.com/?author=1>)

A member of the EFS-Web listserv asks if he can hear from people who used USPTO's XML patent application authoring and e-filing system back in 2002. Yes our firm was among the beta-testers of that system. This prompts the following blog article.

Yes of course we at Oppedahl Patent Law Firm LLC were among the beta-testers of USPTO's ill-fated XML e-filing system.

The impetus of course was Congress passing the law that said that USPTO had to start doing 18-month pubs. And this was going to cost the USPTO money. So USPTO figured, the way to fix that problem was to do some cost shifting. Force the applicant to hand in characters instead of images, so that USPTO could beat up Reed Publishing (the printing contractor) on the price for doing the 18-month pubs.

So USPTO developed ePave as the e-filing engine.

And developed a plug-in for WordPerfect for authoring XML.

And developed a plug-in for Microsoft Word for authoring XML.

All three were extremely poorly designed, staggering in the paucity of their quality. None of the three packages was ready even for beta test. None of the three should ever have been permitted out of alpha test (if USPTO even did alpha testing which I imagine they did not) in the condition that they were in.

Meanwhile EPO and WIPO developed their own XML authoring tools that were less bad. But unfortunately the USPTO developers went to great lengths to make it difficult to e-file using the not-invented-here authoring tools. The user had to go to a lot of trouble to fake out ePave so that it would not puke on an XML patent application that had been authored in the EPO or WIPO authoring tool. If I recall correctly it was necessary to create a ZIP file in one of the

bad (USPTO-developed) authoring tools, and then open up the ZIP file, and then use Notepad to perform microsurgery on the contents of some of the files inside the ZIP file, and then zip it up again. And then IIRC you had to password-protect the ZIP file with some password that only the USPTO knew.

Yeah, the USPTO-developed authoring tools would generate a ZIP file that was password protected with a secret password that only USPTO knew.

So as I recall what I had to do was use some software from a Russian company that did a brute-force attack on one of the USPTO's ZIP files. It took four days as I recall. And then eventually I came to know USPTO's password. Which I then published to the relevant listserv. And then it became possible to author using the less-bad authoring tools from EPO and WIPO. And you could then construct a ZIP file that you could then password protect using the not-secret-any-longer USPTO password, and it would fake out ePave so that you could e-file the patent application.

Anyway each of the bodies of software from USPTO was breathtakingly poorly designed. We at our firm would lose entire weekends trying to somehow get a patent application e-filed in ePave. The internal cost to our firm in terms of lost professional billings to do an ePave filing averaged I'd guess ten thousand dollars per application filed.

It was easy to see how much beta-test filing activity was going on, because the application numbers assigned in ePave came from a particular block of one thousand serial numbers. Normal postal service Express Mail filing of physical paper patent applications was maybe half a million patent applications per year back in those days, or maybe two thousand or so cases filed per day. Meanwhile our firm would e-file a case in ePave and then we would file another case in ePave a week later, and the serial number count might have increased only by one between our two filings. There was one three-month stretch where you could tell from the serial numbers generated in ePave that our firm had all by itself filed more than ten percent of all of the ePave cases during those three months.

You could also do the math easily enough. By the time that USPTO scrapped ePave, some number of patent applications had been filed — you could tell from the serial numbers how many that was. And you could make fairly educated guesses as to how much cash the USPTO had spent making ePave happen. And you could divide the one number into the other to find out how much money **per patent application** had been flushed down the toilet with this failed effort. It was something like two thousand dollars per serial number.

By the way, recall what the reason was for doing ePave. It was to capture characters instead of images, so that the 18-month pub would not cost so much money to make happen. The character capture that USPTO hoped to achieve was in two categories — the patent application itself, and the bib data. By bib data I mean bibliographic data. Who are the inventors, who is the applicant, what is our priority claim, what is our domestic benefit claim, what is the title. Two categories of information, both to be communicated in character form.

But that never actually came to pass. It never actually ever happened that any characters that were e-filed in ePave ever reached Reed Publishing for its 18-month-pub activities. During the limited time that ePave was being beta-tested, the flow path within the USPTO is that every

case that some poor hapless law firm lost a weekend to e-file in ePave got **printed out on paper at the USPTO** and was injected into the legacy workflow along with the cases that were being filed by Express Mail. I am not making this up.

We could tell this by looking in IFW at our ePave cases. They would have skewed pages, scuff marks on the pages, and a variety of other scanning artifacts in the IFW pages. And the 18-month pubs had misspelled words in them that would never have happened if USPTO had actually passed our XML characters to Reed.

When we were doing our ePave beta testing, as you may imagine it became clear with each passing day that the USPTO developers had only ever thought about how to handle 26 letters and nine numerical digits. It was more and more clear that the developers were absolutely clueless about Greek letters or simple math symbols. There were many times when we would prepare a case to be e-filed in ePave and some Greek letter would become a black rectangle or, must amusingly, a smiley face. There was one case I recall where some of our math symbols became the suits in playing cards – spades and clubs and hearts and diamonds.

At that time the chemistry community was working on a Chemistry Markup Language — a way to use XML to represent chemistry diagrams. And the mathematics community was working on a Math Markup Language. This was going to be a way to use XML to represent math formulas. The USPTO people were very vague about whether they would some day fashion some orifice in ePave that could receive patent applications that had ChemML and MathML stuff inside. In the near term we were using embedded images in our patent specifications in ePave as our way of providing math formulas and such.

USPTO had made no secret of its goals for adoption of ePave filing. So many percent of new US patent applications were to be filed through ePave within six months. Some much higher percentage of new US patent applications were to be filed through ePave after a year had passed. But even after a year of release and outreach, the penetration rate for ePave had not even reached one percent. (By the time ePave was shut down, our firm had single-handedly carried out fully six percent of all ePave filings that ever happened.) Eventually with a whimper, not a bang, ePave was quietly shut down. And about a year later, USPTO started beta-testing EFS-Web, which completely abandoned any hope of capturing characters from applicants.

Astonishingly not only did USPTO backtrack on capturing characters for the patent application itself in EFS-Web, but USPTO also punted on capturing characters for the bib data. To this day in 2020 there are plenty of EFS-Web filings where the bib data does not reach the USPTO as characters but instead reaches the USPTO only as images. So for example you the filer can go to the trouble of creating a Form AIA/14 (application data sheet), the kind that is over a megabyte in size, the kind with XML bib data inside. And if you e-file it in your **second** EFS-Web submission in a particular case instead of in your **first** EFS-Web submission in a particular case, it will not auto-load. It will get flattened to an image and USPTO people will hand-key it into Palm. I am not making this up, in 2020 USPTO flattens the character-rich ADS into images and passes the images into the paper-based workflow.

And in 2020 you can pay an issue fee in the super-clever EFS-Web character-based

web-based issue fee payment screen, and guess what, it will all get flattened into images and later the USPTO people will hand-key the stuff like the city where the assignee is located. One client of our firm, in Radom, Poland has an issued US patent that says the client is in a “Random” place. This even though we provided characters, darn it. And USPTO flattened the characters from our Form 85B into images and hand-keyed it.

What I find fascinating is that XML patent application filing is not dead even now in 2020. Right now in 2020 you can, if you wish, make use of a pretty darn good XML authoring tool provided by WIPO to author a patent application in XML, and you can upload it into ePCT for e-filing in the RO/IB, and if you do, they will give you a filing fee reduction of CHF 100 in addition to the other filing fee reductions that you might get for other aspects of e-filing. And then guess what? WIPO actually uses the characters to do the 18-month pub. Yes! I am not making this up.

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3 thoughts on “Who was a beta-tester of ePave?”



Brad says:

April 2, 2020 at 7:31 am (<https://blog.oppedahl.com/?p=5796#comment-174949>)

Been there done that. One of my first jobs out of college. I still have nightmares about getting a large application with lots of tables and formulas that all had to be manually coded in xml and then you hope they display correctly. We have come a long way from there but still have a ways to go.

Reply



Bob Leikes says:

April 2, 2020 at 9:23 am (<https://blog.oppedahl.com/?p=5796#comment-174951>)

There will probably be out of work software programmers available in the anticipated recession. Now might be the time for the USPTO to get a team together to fix this and other problems with its system.

Reply



Derek Freyberg says:

April 2, 2020 at 12:25 pm (<https://blog.oppedahl.com/?p=5796#comment-174955>)

And, if I recall correctly, ePave wasn't the first USPTO venture into character-based input; there was a time back in the late 1980s/early 1990s when they were looking at electronic character-based input of some sort.

I remember this because, back in the early 1980s I was visiting a Japanese patent law firm, and they were still using Japanese typewriters to file their paper applications. The reason why they could not use word processing was that there were no readily available printers that could print the kanji characters in high enough quality to be acceptable to the JPO – typing, because it used already-formed characters, was the only way. We in the US were of course already using word processing to write our applications: it was pretty primitive word processing, but there we were – we had the huge advantage that our character set was basically around a hundred characters, even including a Greek alphabet.

Move ahead a few years: the JPO was using online filing – all the attorney had to do was get the electrons to the JPO, and they took care of turning them into characters on screen or paper, as appropriate.

But the US was still on paper. Then came the first attempt at online character-based filing; and it was a complete fiasco.

And then ePave.

And then pdf, so basically we are still working on paper but just transmitting it as an image electronically.

And now they want .docx files, except that it's not any .docx files, and they still will convert them to image, maybe correctly, maybe not – at your risk.

I don't know where the USPTO gets its ideas on computerization from, but by and large they stink; and the implementation has been abysmal for 30-some years.

WHY?

And why is PPAC, AIPLA, ABA IP Section, IPO, and everyone else not screaming about it?

I'm old enough now for it not to affect me much; but surely we can do better.

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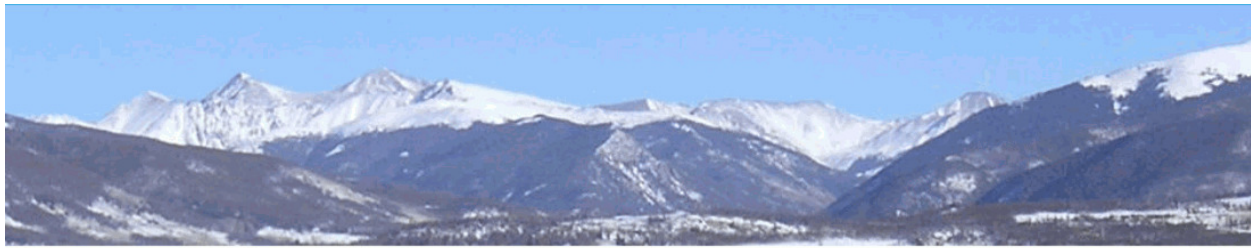
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An example of alpha-testing Patentcenter (<https://blog.oppedahl.com/?p=4720>)

1st September, 2019 (<https://blog.oppedahl.com/?p=4720>) (<https://blog.oppedahl.com/?author=1>)

(Update: It took eight days, but yes the EBC did eventually get this application fixed in IFW. Now we are able to see correctly in IFW what we actually filed in Patentcenter in this patent application. What a relief!)

In a previous blog article (<https://blog.oppedahl.com/?p=4718>) I applauded USPTO for doing real alpha-testing of its *Patentcenter* system with real revenue customers. And invited readers to recognize the contributions of the alpha testers themselves, who for more than a year now have been doing real patent filings in this system which will some day replace both EFS-Web and Private PAIR. Here is an example of what it is like to be an alpha tester.

When you are an alpha tester of *Patentcenter*, you try to pick and choose how to do things. Are you filing some patent application on the Last Possible Day? If so, then maybe you don't take the chance of filing it in *Patentcenter*, given that *Patentcenter* might bollix it up. On the other hand, do you have a couple of weeks left before the Last Possible Day? If so, then maybe this patent application is a good candidate for *Patentcenter* because then if it blows up, you could if necessary file the application all over again in EFS-Web and clean things up later.

So here is a case that I filed on Wednesday, August 28, 2019 in *Patentcenter*. I

Application Number	Status	Description	Date
100-000000	PAID	Patent of Invention	2019-08-28
100-000001	PAID	Patent of Invention	2019-08-28
100-000002	PAID	Patent of Invention	2019-08-28
100-000003	PAID	Patent of Invention	2019-08-28
100-000004	PAID	Patent of Invention	2019-08-28
100-000005	PAID	Patent of Invention	2019-08-28
100-000006	PAID	Patent of Invention	2019-08-28
100-000007	PAID	Patent of Invention	2019-08-28
100-000008	PAID	Patent of Invention	2019-08-28
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100-000061	PAID	Patent of Invention	2019-08-28
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100-000063	PAID	Patent of Invention	2019-08-28
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100-000068	PAID	Patent of Invention	2019-08-28
100-000069	PAID	Patent of Invention	2019-08-28
100-000070	PAID	Patent of Invention	2019-08-28
100-000071	PAID	Patent of Invention	2019-08-28
100-000072	PAID	Patent of Invention	2019-08-28
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100-000097	PAID	Patent of Invention	2019-08-28
100-000098	PAID	Patent of Invention	2019-08-28
100-000099	PAID	Patent of Invention	2019-08-28
100-000100	PAID	Patent of Invention	2019-08-28

(<https://blog.oppedahl.com/wp-content/uploads/2019/09/PAIRPrintServlet.png>)
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selected *Patentcenter* rather than EFS-Web as my filing path because the case is claiming priority from a foreign application dated September 21, 2018. This leaves some time to straighten things out if *Patentcenter* were to bollix things up.

And wow, did *Patentcenter* bollix things up! I filed the usual things. A specification, claims, abstract, drawings, inventor declaration, application data sheet. Oh and sort of as an afterthought I tossed in a Power of Attorney. I decided to take a walk on the wild side by e-filing the specification and claims and abstract by means of DOCX files generated by Libre Office. I then did what a patent filer always does. After e-filing the patent application, I looked in PAIR to see what I had just filed.

Imagine how you would feel if you had just filed a US patent application, and if this (above, right) is what you were to see in IFW. This is only the first of three pages of documents in IFW. The only thing in IFW, and it appears **forty times**, is the Power of Attorney. Nowhere in IFW can you see the specification, or the claims, or the abstract, or the drawings. Nowhere in IFW can you see the inventor declaration or the ADS.

Oddly yes the ADS did auto-load into Palm. The priority information is in Palm (and thus in PAIR). The inventor names, the applicant name, the fees that I paid, they are all visible in PAIR.

But I cannot see the e-filing ack receipt in IFW.

No, the only thing I can see in IFW is forty copies of the Power of Attorney.

I phoned up the EBC when I saw this. The EBC folks swear up and down that I really did e-file a spec and claims and abstract and drawings. They swear up and down that they can see these things in “their back-end system”. The EBC folks swear up and down that Real Soon Now it will get straightened out and I will be able to look in IFW and see what I actually e-filed.

Now today it is September 1, and still this is the only thing that can be seen in IFW. Two whole business days have come and gone, and the folks at the USPTO have not yet managed to get this patent application straightened out in IFW.

This is what it is like, sometimes, to be an alpha tester of *Patentcenter*.

Several dozen other firms also have been serving as alpha testers of *Patentcenter* for the past year or so. They have all encountered things that were this strange or were even stranger, when filing a patent application or responding to an Office Action or paying an Issue Fee. They take risks with their clients’ patent applications, they struggle with not-yet-ready-for-prime-time USPTO user interfaces and systems. They report bugs and defects. And you, dear reader, when you become a user of *Patentcenter*, you will benefit from the work of these many alpha testers.

As I mentioned in the previous blog article (<https://blog.oppedahl.com/?p=4718>), I know who many of the alpha testers are for *Patentcenter* but I am not comfortable naming them without their permission. If you are an alpha tester of *Patentcenter*, feel free to post a comment below to say so.

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If there was any doubt that USPTO does not really support non-Microsoft DOCX files (<https://blog.oppedahl.com/?p=4704>)

28th August, 2019 (<https://blog.oppedahl.com/?p=4704>) (<https://blog.oppedahl.com/?author=1>)

(Corrected September 1, 2019 to reflect that the telltale Microsoft Word file-type icons appear in the Patentcenter e-filing system, not in EFS-Web.)

USPTO presents patent practitioners with a choice of two filing paths — Microsoft Word and PDF. If you e-file a Microsoft Word file, then that's what USPTO wants. If you want to use a word processor other than Microsoft Word, then you face two possible paths. One path is that you save your patent application as a PDF. USPTO has proposed that you would have to pay a \$400 penalty for e-filing the PDF. The other possibility is to export your patent application in a DOCX format from your non-Microsoft-Word word processor. You would then upload the DOCX file to EFS-Web or to Patentcenter (in alpha-test), and EFS-Web or Patentcenter would render the file into a PDF. You would then be expected to proofread the PDF carefully to detect the corruptions (and there would often be corruptions, documented here (<https://blog.oppedahl.com/?p=4623>)) introduced by USPTO's failure to correctly handle DOCX files generated by word processors other than Microsoft Word. Here is the adhesion contract that EFS-Web or Patentcenter asks you to agree to:

The PDF(s) have been generated from the docx file(s). Please review the PDF(s) for accuracy. By clicking the continue button, you agree to accept any changes made by the conversion and that it will become the final submission.

Again, if you wished to avoid this malpractice risk, you need merely take either of two precautions:

- purchase and use Microsoft Word, or
- pay the \$400 penalty and submit a PDF format patent application.

The situation is that the rendering engine that USPTO uses to render a DOCX file into a PDF

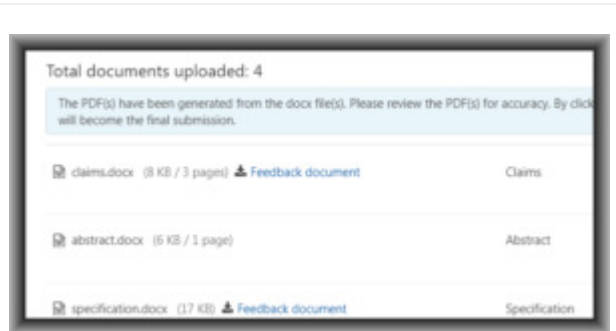
is the Microsoft Word rendering engine. So by definition, the PDF that is generated from the DOCX file will be error-free **if you used Microsoft Word** to generate your DOCX file. But if you used a word processor file other than Microsoft Word to generate your DOCX file, the rendering engine offers no assurance of rendering the document accurately.

USPTO disingenuously suggests that there is some uniform “DOCX standard” and that somehow all word processor files that have file names ending in “DOCX” will look the same when e-filed in EFS-Web or in Patentcenter, regardless of the particular word processor that was used to create the word processor file. This is factually false.

USPTO’s disingenuousness is highlighted by the icon that USPTO uses in Patentcenter to identify the type of file that the practitioner has uploaded. You can see it three times in this screen shot.



Yes, USPTO uses the Microsoft Word branded icon to identify the file type for the word processor file that the user has uploaded (that happens to have a “docx” file name extension). For this particular screenshot, the DOCX files that you see are files that I created using Libre Office. But did USPTO use a Libre Office branded icon for those files? No! USPTO used the Microsoft Word branded icon for those files. You can see it right there in the screen shot, three times.



(<https://blog.oppedahl.com/wp-content/uploads/2019/08/word-icon.png>)
click to enlarge

If USPTO were really dedicated to trying to accommodate users of word processors other than Microsoft Word, we would not be seeing the Microsoft Word icon three times in this screen shot.


There do exist plenty of truly generic icons for DOCX file types, but USPTO did not choose to use any of those truly generic icons. Here are some of them:



Let’s see whether someone at USPTO who is responsible for Patentcenter reads this blog and decides to take corrective action. Let’s see how long it takes for USPTO to change Patentcenter so that it uses an icon that is not Microsoft branded to identify the DOCX files that users upload to Patentcenter.

What would really be excellent is if USPTO were to stop using the Microsoft Word rendering engine in EFS-Web and Patentcenter to render DOCX files into PDF files. I think the responsible thing would be for USPTO to use (for example) the Libre Office rendering engine to render DOCX files into PDF files. I say this because I believe the Libre Office rendering engine actually comes much closer to complying with the relevant industry standards (ECMA-376 and ISO/IEC 29500) than does the Microsoft Word rendering engine.

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11 thoughts on “If there was any doubt that USPTO does not really support non-Microsoft DOCX files”



Scott says:

August 28, 2019 at 6:38 pm (<https://blog.oppedahl.com/?p=4704#comment-161150>)

Hi Carl, way to call out the USPTO for their still frustrating e-filing system and rules.

But I'm confused by the following from your post: "USPTO presents patent practitioners with a choice of two filing paths — Microsoft Word and PDF....USPTO has proposed that you would have to pay a \$400 penalty for e-filing the PDF."

Why would you have to pay a "\$400 penalty for e-filing the PDF"? Does the USPTO actually penalize you if you file a PDF created from a non-Microsoft Word document? That sounds insane.

Reply



oppedahl says:

August 29, 2019 at 2:46 am (<https://blog.oppedahl.com/?p=4704#comment-161162>)

Please read this notice of proposed rulemaking (<https://www.federalregister.gov/documents/2019/07/31/2019-15727/setting-and-adjusting-patent-fees-during-fiscal-year-2020>). USPTO proposes that if you file a US patent application in a format other than Microsoft Word format, you will have to pay a \$400 penalty.

Reply



James Lake says:

August 28, 2019 at 6:44 pm (<https://blog.oppedahl.com/?p=4704#comment-161151>)

I use MS Word and even with a Word docx file the pdf rendering in EFS creates errors in the document. No errors exist if I convert the docx file to pdf using the MS Word or Adobe Acrobat conversion tool.

Reply



oppedahl says:

August 29, 2019 at 2:43 am (<https://blog.oppedahl.com/?p=4704#comment-161161>)

Thank you for posting this comment. Can you please post a comment in the USPTO's rulemaking proceeding (<https://www.federalregister.gov/documents/2019/07/31/2019-15727/setting-and-adjusting-patent-fees-during-fiscal-year-2020>) stating this?

Reply



Dan Feigelson says:

August 29, 2019 at 3:58 am (<https://blog.oppedahl.com/?p=4704#comment-161166>)

Carl, it's not simply a matter of having MS Word. I know from experience that between Mac and PC versions of MS Word, there can be issues with what appears in the document. I also know that when I use Word's own pdf rendering (i.e. I do a "save as pdf" from Word), what comes out isn't degraded (so far), but that if I try to upload that pdf to EFS, EFS screams at me that it's not a pdf file. In order to comply with EFS requirements for pdfs, I have to use cutepdf to print the file to pdf format.

Also, even when I file in pdf, lots of times the image in the figures is degraded because of the software the PTO uses, which converts that pdf to some other useless (but bulkier) format.

This is a long-winded way of saying that the PTO is nuts if it thinks any practitioner is going to be prepared to risk his livelihood by relying on the PTO's rendering of the docx file to another format, even if that docx file was prepared using MS Word. But personally, I think the people at the PTO KNOW that practitioners will refuse to put their livelihoods on the line this way, and fully expect that by enacting this \$400 penalty, they're going to see a windfall, because in 99% of the cases they're going to collect their \$400. Ka-ching!

What really gets me is that, even if we believe the PTO, this is a case of the tail wagging the dog: they ostensibly want docx files to make it easier for Reedfax to set the patents for printing. But who said that the PTO needs to do its own typesetting and pagination? WIPO just republishes what we give them. Why can't the USPTO do the same? It could even ask us to provide searchable pdf files (the Israel PTO does), and make those available. But at least that way we practitioners would have control over the end product.

Reply



oppedahl says:

August 29, 2019 at 5:41 am (<https://blog.oppedahl.com/?p=4704#comment-161171>)

Thank you for posting the comment here. I do hope that you will also post a comment to the USPTO's notice of proposed rulemaking (<https://www.federalregister.gov/documents/2019/07/31/2019-15727/setting-and-adjusting-patent-fees-during-fiscal-year-2020>).

Reply



James Lake says:

August 29, 2019 at 9:09 am (<https://blog.oppedahl.com/?p=4704#comment-161183>)

When converting to pdf from MS Word, one may select "Options..." in the Save As dialogue box and check the box for "ISO 19005-1 compliant (PDF/A)". Using CutePDF is not necessary (though that is a great product). In my experience, EFS accepts the PDF/A without error notices and the result is fully searchable

and identical (so far) to the original docx. Something like that seems like a much better solution than the USPTO's mandated docx filing with the persistent errors introduced by their pdf conversion tool.

Reply



oppedahl says:

August 29, 2019 at 9:26 am (<https://blog.oppedahl.com/?p=4704#comment-161186>)

Thank you for posting. Keep in mind that if you e-file using that PDF, USPTO has in mind that you will have to pay a \$400 penalty.

Reply



Peter Kramer says:

August 29, 2019 at 7:55 pm (<https://blog.oppedahl.com/?p=4704#comment-161203>)

A client sent me docx drawings he made with non-Word program. When I converted to pdf using Word, the drawings were mangled. I then used PDFElement to convert the Word files to jpg and then using Word, created a blank document with margins set to zero, then inserted the jpg. That worked fine.

Reply



oppedahl says:

August 29, 2019 at 9:09 pm (<https://blog.oppedahl.com/?p=4704#comment-161205>)

Please post a comment to the USPTO's notice of proposed rulemaking (<https://www.federalregister.gov/documents/2019/07/31/2019-15727/setting-and-adjusting-patent-fees-during-fiscal-year-2020>).

Reply



Peter says:

August 30, 2019 at 9:26 am (<https://blog.oppedahl.com/?p=4704#comment-161220>)

Excellent post, Carl. However, from the comments of the readers I think that most patent attorneys assume that it is about them converting DOCX to PDF instead of the USPTO doing so. I think the \$400 penalty may sail through perhaps because of many attorneys not yet realizing what is ahead of them (and not realizing that it affects each and every patent application they now file as PDF).

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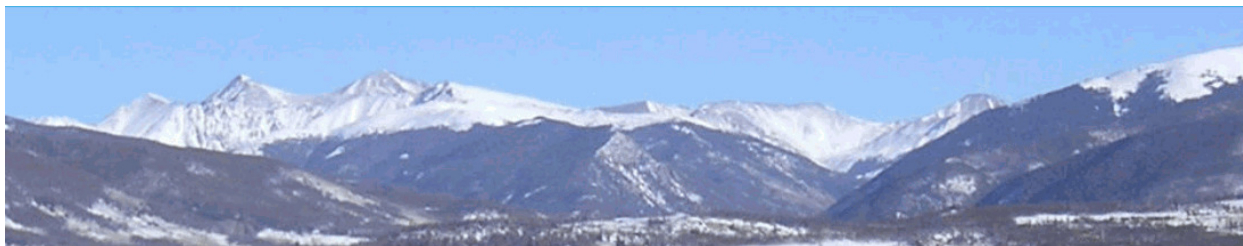
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USPTO fails to support DOCX from non-Microsoft word processors (<https://blog.oppedahl.com/?p=4638>)

9th August, 2019 (<https://blog.oppedahl.com/?p=4638>) (<https://blog.oppedahl.com/?author=1>)

One of the fundamental requirements in the design of an important system like USPTO's system for e-filing patent applications is that the system should not force the customer to purchase any particular proprietary software as a precondition of use of the system.

USPTO's initiative to try to force customers to file patent applications in DOCX format is an example of a failure to satisfy that requirement.

USPTO states, disingenuously:

DOCX is supported by many popular word processing applications, such as Microsoft Word, Google Docs, and LibreOffice.

There is not, in fact, any single DOCX standard. Most word processors follow a fairly well standardized version of the DOCX format, but Microsoft's word processor follows Microsoft's usual pattern of "embracing and extending" any industry standard with which it comes in contact.

The USPTO patent e-filing system calls for the user to upload a DOCX file for a specification, claims, or abstract. It carries out some processing of the DOCX file, and if the DOCX file passes USPTO's scrutiny, the e-filing system "renders" the file as a PDF. The e-filing system then tells the user that the user must inspect the PDF file. If the user clicks "submit", the user is deemed to have agreed that the PDF file is the official file.

Importantly, if at some later time it becomes clear that the USPTO system introduced errors into the PDF file, the user is not permitted to point to the original DOCX file (as rendered by the user's word processor) as the authoritative document. The USPTO's position is that the corrupted PDF file on which the user clicked "submit" is the authoritative document.

Imagine filing a patent application at 11PM on the last possible day, and the message appears on the screen that the user must now proofread a PDF generated by the USPTO to see if it contains errors introduced by the USPTO. This is not an idle or hypothetical problem; see this blog article (<https://blog.oppedahl.com/?p=4623>) which gives an actual example in which the USPTO system corrupted a math equation in a patent application, changing the number “0” to the number “10”.

But the point of this blog article is to point out that it is clear that USPTO never actually tested its DOCX e-filing system with any word processor other than Microsoft Word. And the software in USPTO’s e-filing system fails to handle correctly even a very simple DOCX file created using Libre Office. It is recalled (see above) that Libre Office is one of the word processors that USPTO points to as (supposedly) being supported by USPTO in its patent e-filing system.

Here is the source file for a real-life example that I attempted to e-file today. It is an abstract, edited in Libre Office. As may be seen the font is “arial narrow” which is one of the fonts that USPTO says is acceptable for DOCX patent application filing.

But when one uploads the DOCX file into EFS-Web or into Patentcenter, the USPTO system pukes on the file, stating (falsely) that the DOCX file contains a font called “lucida sans”. Here you can see the error message.

I will mention that in this case, the USPTO also introduced another corruption into the DOCX file, changing the font of the word “Abstract” to be “calibri”.

This extremely simple word processor file contains no exotic characters, no Greek letters, no math equations, no chemical formulas. It contains only text. Had it been created using Microsoft Word, there is no doubt USPTO’s e-filing system would have accepted and indeed welcomed the DOCX file. (I know this is true because I tried it in Microsoft Word and USPTO’s system welcomed the DOCX file.)

But what I did today, that exposed this problem in USPTO’s e-filing system, was to use a word processor other than Microsoft Word to generate my DOCX file. I used Libre Office. And USPTO’s system corrupted the file (changing a font) and puked on it (stating falsely that I had used a font called “lucida sans”).

From this it is quite clear that USPTO never tested its e-filing system to see if it would handle correctly the versions of DOCX format generated by word processors other than Microsoft Word.



(<https://blog.oppedahl.com/wp-content/uploads/2019/08/source-file.png>)

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(<https://blog.oppedahl.com/wp-content/uploads/2019/08/uspto-pukes.png>)

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This would not be so bad if DOCX filing were purely optional. But USPTO has proposed (<https://www.govinfo.gov/content/pkg/FR-2019-07-31/pdf/2019-15727.pdf>) to start penalizing customers who e-file patent applications in formats other than DOCX. A \$400 penalty would be imposed so as to “incentivize” customers to file in DOCX format.

USPTO needs to put its proposed \$400 penalty “on hold” until *after* it fixes its e-filing system so that it will work correctly with DOCX files generated by word processors other than Microsoft Word.

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One thought on “USPTO fails to support DOCX from non-Microsoft word processors”

RICK NEIFELD says:

August 9, 2019 at 6:58 pm (<https://blog.oppedahl.com/?p=4638#comment-160566>)

Carl, I would be happy to collaborate with you and David Boundy to challenge promulgation of the proposed “docx” requirement and non-DOCX surcharge. I am a member of the EDVA bar where such a complaint should be filed. Your blog post above is evidence relevant to such a challenge.

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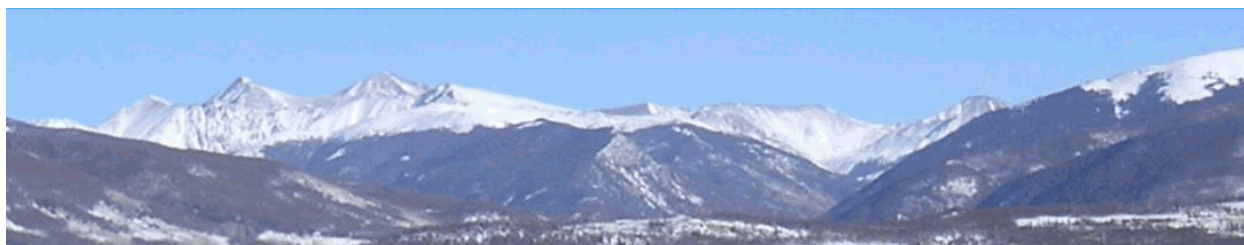
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The problem with USPTO's proposed non-DOCX penalty (<https://blog.oppedahl.com/?p=4623>)

5th August, 2019 (<https://blog.oppedahl.com/?p=4623>) (<https://blog.oppedahl.com/?author=1>)

Until now, it has been optional for a practitioner to file a US patent application in DOCX format rather than in PDF format. But USPTO now proposes (<https://www.federalregister.gov/documents/2019/07/31/2019-15727/setting-and-adjusting-patent-fees-during-fiscal-year-2020>) to charge a \$400 penalty for filing a patent application in non-DOCX format. This is a very bad idea, for reasons that I will discuss in detail. Only if USPTO were to make fundamental changes in its way of receiving DOCX files would it be acceptable for USPTO to impose a penalty for filing in a non-DOCX format.

USPTO needs to follow WIPO's example, permitting the practitioner to file a "pre-conversion format (<https://www.wipo.int/pct/en/texts/ai/s706.html>)" version of a patent application along with the DOCX file. In the event of some later problem with USPTO's rendering of the DOCX file, the practitioner would be permitted to point to the pre-conversion format, which would control in the event of any discrepancy.

The normal way to file US patent applications is in PDF format. With PDF format, the applicant has complete control over the appearance of characters and symbols.

Some years ago, the USPTO began beta-testing a system that would permit a practitioner to file a patent application in DOCX format instead of in PDF format. Yours truly was among the very first of the beta-testers of USPTO's system for DOCX filings. As implemented by the USPTO, the practitioner would upload a DOCX file, and USPTO would render the DOCX file in a human-readable PDF image format. As part of the e-filing process, the practitioner was expected to proofread the rendered image as provided by the USPTO's e-filing system. The notion was that the practitioner would be obliged to catch any instances of USPTO's system rendering the DOCX file differently from the way the practitioner's word processor had

rendered that same DOCX file. If, for example, some math equation or chemical formula had gotten corrupted in USPTO's system, the practitioner would expected to catch this **prior to** clicking "submit".

A first difficulty about this is that there is no single unambiguous thing called "DOCX" format. The history may be seen in this Wikipedia article (https://en.wikipedia.org/wiki/Office_Open_XML). DOCX exists in many variants, and in particular Microsoft has a history of of making poorly documented changes over time to the ways that Microsoft Word implements DOCX formatting of documents.

USPTO inaccurately characterizes DOCX as if one could be sure that any word processor will implement DOCX in the same way as any other word processor. For example, USPTO says:

There are several word processors that can create and save in DOCX format, including Google Docs, Microsoft Word 2007 or higher, Office Online, LibreOffice, and Pages for Mac.

That statement is disingenuous at best, and borders upon falsity given that there is no single unambiguous DOCX format. A more accurate statement would be:

There are several word processors that can create and save documents in variants of DOCX formats, including Google Docs, Microsoft Word 2007 or higher, Office Online, LibreOffice, and Pages for Mac.

USPTO also says:

DOCX is stable and governed by two international standards (ECMA-376 and ISO/IEC 29500).

This statement is simply false. There is no single DOCX standard to which Microsoft Word and the other word processors are all compliant.

To give a simple example, consider this math equation in a patent application that I recently filed as a PDF-based PCT application using Libre Office:


$$f(u) = \cos(u)^3 \exp(0.2u) \quad (\text{Equation 14})$$

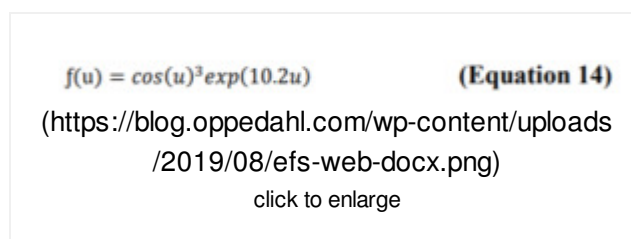
(<https://blog.oppedahl.com/wp-content/uploads/2019/08/libre-pdf.png>)
click to enlarge

As an experiment I uploaded the DOCX file of this PCT application to EFS-Web as if I were filing a domestic US patent application. The way the USPTO has designed EFS-Web, what happens next is that the practitioner sees this message in red letters:

The PDF(s) have been generated from the docx file(s). Please review the PDF(s) for accuracy. By clicking the continue button, you agree to accept any changes made by the conversion and that it will become the final submission.

It is easy to see that this filing procedure, as contemplated by USPTO, imposes an enormous professional liability risk on the practitioner. The practitioner is obligated to proofread the entire patent application, from top to bottom, for any corruption introduced by the USPTO's rendering system.

Here is how the USPTO rendered this math equation:



$f(u) = \cos(u)^3 \exp(10.2u)$ (Equation 14)

(<https://blog.oppedahl.com/wp-content/uploads/2019/08/efs-web-docx.png>)

[click to enlarge](#)

The alert reader will notice that the USPTO inserted a spurious digit “1” into the math equation. Had I overlooked this corruption of the document by the USPTO, I might then have clicked “continue”, at which point it would have been USPTO's position that I had agreed to accept USPTO's change of “0.2” to “10.2”. TYFNIL the accused infringer would be able to seize upon this.

There are a dozen other places in this patent application where USPTO corrupted math equations; Equation 14 is merely the most striking so that is the one that I quoted here.

As a beta-tester of USPTO's DOCX systems, I have used a pretty simple way of choosing which of my patent applications I am willing to subject to the risks of filing in DOCX. Basically if there is any math equation or chemical formula, or anything other than very simple alphanumerical characters, I don't take the risk. Every now and then, on a whim, I will experiment with something like this “Equation 14” document, but I don't risk any actual substantive rights of a client by actually clicking “submit” in such a case.

But USPTO's proposed rulemaking would put me in the untenable position of having to pay a \$400 penalty for every case that I file that has a math equation or chemical formula in it.

If USPTO wants to pursue this, USPTO should follow the example of the World Intellectual Property Organization (WIPO). Like the USPTO, WIPO of course encourages practitioners to e-file using characters rather than images. Clearly all forward-thinking patent offices need to consider ways to try to collect characters, because that is more efficient in later workflow than collecting page images.

But what does WIPO do so that practitioners are protected from the kind of risks that we see above with Equation 14? WIPO permits the applicant, at the time of filing an international patent application, to provide not only the character-based version of the patent application (XML, in the case of PCT), but also the “pre-conversion format” of the document. You can

see this in Section 706 (<https://www.wipo.int/pct/en/texts/ai/s706.html>) of the PCT Administrative Instructions. The idea is that if later it turns out that some flaw arose in the generation of the XML file, or some flaw in the way the XML got rendered into human-readable form, the applicant would be able to point to what the application looked like in its “pre-conversion format”.

It's clear from this the simple thing that USPTO would need to do, as a precondition to imposing a \$400 penalty for non-DOCX filings, is to make a provision for the practitioner to be able to provide a PDF version of the patent application being filed, along with the DOCX file. This PDF version would serve as the controlling version in the event that (for example) the USPTO ended up inserting a spurious “1” into a math equation.

We can then circle around to the USPTO's disingenuous statements about DOCX. If it were really true that there is some single unambiguous DOCX standard, then this spurious “1” would never have gotten inserted into the rendered patent specification in EFS-Web. The very fact that this happened proves that USPTO is wrong when it suggests that there is some single thing called DOCX that means the same thing in EFS-Web and in all word processors.

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12 thoughts on “The problem with USPTO’s proposed non-DOCX penalty”



Robert Leikes says:

August 5, 2019 at 3:31 am (<https://blog.oppedahl.com/?p=4623#comment-160433>)

Thank you for bringing this problem to my attention. This is a very serious issue and one which will lead to serious problems for practitioners who accept the representations of the USPTO at face value.

It is also a serious issue for practitioners who have been assuming that pdf documents created from docx files can be trusted when making submissions to the USPTO. Does anyone know if any docx-pdf conversion software have been certified for reliability?

In the case of mathematical and chemical formulae, would it not be safer to insert those as graphic image files into the docx document, so that any problems arising from conversion would be all or nothing (the image is either there or not) to simplify proofreading the pdf document?

Reply



Brad says:

August 5, 2019 at 7:30 am (<https://blog.oppedahl.com/?p=4623#comment-160442>)

This is indeed scary. I had flashback nightmares of trying to fix formulas in those old .xml files we had to upload. Took hours to proof just one application.....

Reply



Henry Blanco White says:

August 5, 2019 at 7:53 am (<https://blog.oppedahl.com/?p=4623#comment-160444>)

In reply to Robert Leikes, would you trust the USPTO's software to handle an embedded graphic correctly?

An alternative might be to include one or more sheets of equations or formulae as drawings, cross referenced to the text by equation number. I remember the days back in London when we were required to provide formula drawings for any in-line formulae and equations, so that the printers had a clean master to work from.

Reply



Dan Feigelson says:

August 6, 2019 at 2:25 am (<https://blog.oppedahl.com/?p=4623#comment-160461>)

Thanks for this Carl.

Yet again, the USPTO refuses to learn from anyone else, tries to go it alone, and screws it up, badly.

It's bad enough that, currently, when I submit a searchable pdf file, the USPTO takes that file, makes it unsearchable, and at the same time makes a much larger file in terms of number of bytes. And that, often, it takes decent-looking pdf drawings and renders them unintelligible.

But to expect us to trust them to do the conversions properly, and to put the onus on us to proofread a document that they've converted on their end, and have the chutzpa to charge us if we choose not to go along with that?!

They'll be getting my comments.

Reply



D.S. says:

August 6, 2019 at 11:04 am (<https://blog.oppedahl.com/?p=4623#comment-160474>)

Hmm, it is possible to copy pdfs as images into a Word document. I wonder if you could avoid the fee and the risk by submitting a docx file that contained only pdf images. I usually like to follow both the spirit and the letter of the law, but not if rules are unfair.

Reply



Chad Gilles says:

August 7, 2019 at 10:27 am (<https://blog.oppedahl.com/?p=4623#comment-160501>)

I never succeeded in filing a docx, so I don't know if the original docx is kept and downloadable by the filer? If it is, and you download it and inspect the xml (unzip it), is the equation the same as filed? If so, then the docx file in PAIR should serve as the Fail-Safe for the incorrectly rendered pdf...?

Reply



oppedahl says:

August 7, 2019 at 10:40 am (<https://blog.oppedahl.com/?p=4623#comment-160502>)

Yes I am sure USPTO secretes a copy of the DOCX file somewhere. They never throw away anything like this. But no, USPTO's policy is that once the practitioner has signed the adhesion contract (quoted in the blog article) in red letters, then the PDF rendering is the official document.

Reply**Moshe says:**August 8, 2019 at 6:14 am (<https://blog.oppedahl.com/?p=4623#comment-160527>)

Are figures required to be in DocX format to avoid the \$400 extortion fee? Can I file text as 'figures' and then delete in a preliminary amendment – this might give me a backstop.

Thoughts?

Reply

Pingback: USPTO fails to support DOCX from non-Microsoft word processors - Ant-like Persistence (<https://blog.oppedahl.com/?p=4638>)

**Mike D says:**August 28, 2019 at 11:11 am (<https://blog.oppedahl.com/?p=4623#comment-161140>)

How often are you seeing errors like this, Carl? It would be one thing if the equations just didn't show up at all, or were translated into jibberish, but to have them almost imperceptibly change — that's something that even the closest of proofreading is not going to catch.

I think Moshe has more or less the right idea. For equation-heavy applications, I would probably just move the equations into the drawings.

Reply

Pingback: If there was any doubt that USPTO does not really support non-Microsoft DOCX files - Ant-like Persistence (<https://blog.oppedahl.com/?p=4704>)

**James Lake says:**August 29, 2019 at 12:09 pm (<https://blog.oppedahl.com/?p=4623#comment-161192>)

The USPTO proposal to mandate DOCX filing is fundamentally misguided in that it removes applicants' ability to control the accuracy of their specifications, claims, and abstracts. In any system of filing structured text, applicants must retain certainty in knowing that filed documents are accurate.

Applicants should not be penalized with increased fees for choosing to guarantee the accuracy of applications by filing a PDF as the official application generated under their own control. Instead, the Office should reduce fees for those who file an ISO 19005-1 compliant PDF/A document, which is fully text searchable and

accessible. The Office should further reduce fees for those who, additional to their own PDF, file a DOCX version of the application with a certification of its accuracy. The supplemental DOCX file would provide the Office with their structured text without jeopardizing the official application filed in PDF. No need exists for the Office to engage in the practice of DOCX to PDF conversion.

Reply

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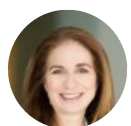
Exhibit E

**Julie Burke, Michael Spector, and William
Smith, Newly Created First Action Final
Rejection Policy Adds Needless
Complications to Patent Prosecution, IP
Watchdog,**

<https://www.ipwatchdog.com/2020/09/22/newly-created-first-action-final-rejection-policy-adds-needless-complications-patent-prosecution/id=125456/> (Sep 22, 2020)



Newly Created First Action Final Rejection Policy Adds Needless Complications to Patent Prosecution



By **Julie Burke, Ph.D.** & **Michael Spector** & **William Smith**
September 22, 2020

 [Print Article](#)

“By permitting first action final rejections when amended claims are not ‘patentably indistinct’, the new policy requires a comparison between the pending claims and the proposed amended claims. In other words, the patentability of the proposed amended claims is judged in the context of simultaneously judging if the pending claims are prior art to the proposed amended claims. The USPTO has no authority under the statute to create such phantom prior art.”

The USPTO recently revised the Manual of Patent Examination Procedure (MPEP) Section 706.07(b) to retroactively impose a first action final rejection (FAFR) policy that



significantly reduces a patent applicant's options (MPEP, E9R10.2019. Fed. Reg. Vol. 85, No. 133 page 41,571). Here, in Part I of



this two-part series, we identify and analyze the final agency petition decision behind the policy change. In Part II, we provide summary and analysis of petition decisions relating to premature final office actions. Codifying the new FAFR standard in the June MPEP revision opens the door for all patent examiners to impose FAFRs on substantively amended claims, if they so wish.

Alternative Definition of *Same Invention*

As noted in a [recent LAW360 article](#), the USPTO has quietly expanded FAFR practice to permit examiners to make FAFRs in continuing applications even when there is much more than a *de minimis* amendment to the claims. This policy change is not readily apparent to practitioners, since the USPTO [discontinued the practice of providing MPEP revision marking](#) in 2014. Moreover, the Section 706.07(b) policy change appears **retroactively applicable** to requests for continued examination (RCEs) and continuation applications (CONs), even those filed with substantive claim amendments prior to the June 2020 revision. Further, FAFRs are in general at odds with 35 U.S.C. Section 132's requirement that should "applicant persist[s] in his claim for a patent, with or without amendment, **the application shall be re-examined.**" (Emphasis added.)

Since 1969, the term **same invention** has been defined for FAFR purposes as in the context of statutory double patenting, *i.e.*, as identical subject matter being claimed twice or "**same invention**" (See MPEP Section 804, discussing *In re Vogel*, 422 F.2d 438 [CCPA 1970] and Examiner Note 1 in Form Paragraph 8.31). For the purposes of this paper, the traditional pre-June 2020 definition for "**same invention**" is referred to as "**identical scope**". Under the **identical scope** legal standard, most RCEs and CONs filed with claims amended to be broader or narrower than those previously examined would be entitled to non-final office actions (or allowances) because the scope of the claimed subject matter would not be identical.

The June 2020 revision expands Section 706.07(b) by retaining the **identical scope** legal standard and by also providing a second legal standard which permits a FAFR when claims are **patentably indistinct** from previously examined claims. Revised Section 706.07(b)

further defines **patentably indistinct** as independent and distinct as used in 37 C.F.R. Section 1.145 in the context of restriction practice. Adding additional layers of uncertainty, MPEP 802.01 further re-defines independent **and** distinct language of 37 C.F.R. Sections 1.145, 1.141, 1.142, 1.145 and 35 U.S.C. Section 121 to mean independent **or** distinct. The expanded **patentably indistinct** legal standard allows even substantially amended claims to receive a FAFR.

The June 2020 Section 706.07(b) revision lacks rationale or guidance to identify circumstances in which examiners would be authorized to apply the **identical scope** legal standard or the **patentably indistinct** legal standard. Without rationale or guidance, the choice of FAFR legal standard is seemingly arbitrary and left to the Examiner's discretion.

Why the Change in Policy?

Section 706.07(b) continues to state “[i]t would not be proper to make final a first Office action in a continuing or substitute application or an RCE where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.”

Thus, in order to avoid a FAFR in a CON/RCE, the applicant must file an after final submission knowing that in most cases it will not be entered by the examiner. As previously explained, final office actions are not required by statute or rule. See 37 C.F.R. Section 1.113 (Examiner “may” make rejection final) and *In Order To Form A More Perfect Patent Examination System—It Is Time To Update Compact Prosecution to Compact Prosecution 2.0*, posted September 24, 2013 on the IPO Law Journal-Patent Section web page. Rather, this practice originated with the advent of “compact prosecution” in the late 1960s together with the then-needed after final practice. By requiring applicants to file a needless after final submission, the USPTO only engenders more fees for unnecessary extensions of time and a 2-4 month delay in prosecution.

Of course, by allowing the examiners to make FAFRs under the new policy, the examiners receive their extra “counts” from the refiling more expeditiously.

Is the New “Patentably Indistinct” Legal Standard Correct?

By permitting FAFR when amended claims are not “patentably indistinct” the new policy requires a comparison between the pending claims and the proposed amended claims. In

other words, the patentability of the proposed amended claims is judged in the context of simultaneously judging if the pending claims are prior art to the proposed amended claims. The USPTO has no authority under the statute to create such phantom prior art. Instead of using the pending claims as prior art as a comparator under this new policy, the proposed amended claims should be compared against the prior art that is used by the examiner in the pending rejections.

The June 2020 MPEP Revision is Based Upon an Obscure Final Agency Petition Decision

Normally, USPTO personnel are alerted of upcoming policy changes, including advance notice of changes to the MPEP, by way of memoranda to the examining corps, and the USPTO announces upcoming policy changes via the Federal Register Notice. Unusually, this recent revision to Section 706.07(b) was made without advance notice, causing patent practitioners to be caught unaware of the retroactive change in practice. When one of the authors contacted an MPEP editor to request a copy of the Federal Register Notice announcing the specific change to Section 706.07(b), they were instead provided the October 13, 2017 final agency petition decision ([FA Decision](#)) in patent application 13/353,841 (application '841).

The FA Decision expanded the USPTO's authorization to make FAFRs of amended claims, citing *In re Bogese*, 22 USPQ2d 1821, 1824-26 (Comm'r Pat 1992), and the *Molins PLC v. Quigg*, (D.D.C. 1987) and (Fed. Cir. 1988) decisions, case law arising from pre-GATT applications eligible for a potential patent term beginning on the day of issue and extended with each continuing application. See FA Decision at 5-6. In *In re Bogese*, an applicant filed a series of file-wrapper-continuation applications, each without response or amendment to the prior non-final Office action

Unlike the facts in *In re Bogese*, the FA Decision pertains to two RCEs filed in application '841 which included full responses to the prior office actions and substantive amendments to the claims. Exemplary amendments accompanying the September 30, 2016 RCE include (i) Claim 1 amended to add "wherein the nozzle plate has a flat portion which is parallel to the surface of the base material and the opening is arranged in the flat portion" and (ii) Claim 19 amended to add "and the pressure outside of the region is measured at the peripheral portion of the opening".

For the second time in application '841's prosecution, When the examiner made the

second FAFR on amended claims filed with an RCE in application ‘841, applicant petitioned for withdrawal of the FAFR. In a decision dated August 17, 2017, the Technology Center (“TC”) 3700 Group Director used the following rationale to deny the initial petition and uphold the FAFR:

In a RCE application, all claims should be directed to the same invention as previously examined and claimed. Claims 1 and 19 as amended in the RCE are directed to the same invention but albeit with different scope. If claims 1 and 19 were directed to a different invention, then the RCE could have been improperly filed. (See MPEP 706.07(h)).

The August 17, 2017 decision exposes the catch-22 situation applicants now face when filing RCEs. “The applicant cannot, as a matter of right, file a request for continued examination (RCE) on claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). See MPEP § 706.07(h), subsection VI.(B)” See MPEP Section 819. Yet with the August 17, 2017 TC Group Director’s decision, now codified in the June 2020 revision to Section 706.07(b), applicants now are at risk for a FAFR when the RCE is filed with **patentably indistinct** claims.

When applicant requested reconsideration of the TC Group Director’s decision, the USPTO issued a final agency decision stating “making the Office action of July 7, 2016, a final Office action was consistent with MPEP 706.07(b).” FA Decision at 9. However, the USPTO’s June 2020 expansion of Section 706.07(b) to add a second, alternative legal standard casts doubt on the notion that the final Office actions in application ‘841 were in fact consistent with the pre-June 2020 Section 706.07(b). Specifically, the FA Decision upheld the examiner’s consecutive FAFRs on claims substantively amended by the October 8, 2015 RCE and the September 30, 2016 RCE.

The FA decision is not consistent with co-author Burke’s understanding of FAFR practice. In co-author Burke’s experience, TC1600 decisions granting or dismissing requests for withdrawal of a premature final Office action were consistently based on the **identical scope** legal standard of MPEP Section 804. Dr. Burke is unfamiliar with the practice of assessing propriety of a FAFR using the newly established **patentably indistinct** legal standard.

Applicants routinely rely upon the legal advisors of the Office of Patent Legal

Administration (OPLA) who are authorized “[I]n its representative capacity of the USPTO, [to respond] to inquiries about patent law and Office policies and procedures via letters, phone calls, lectures, presentations, and other contacts with members of the public and the patent bar.” See Office of Patent Legal Administration page at the USPTO website. Indeed, the OPLA took the position that the **same invention** condition. i.e., claims are drawn to the same scope of invention, is not met if there is more than a *de minimis* amendment to the claims:

Applicant's representative also spoke with Joe Weiss from the Office of Patent Legal Administration. Mr. Weiss emphatically stated that the focus of condition (A) is to "the same invention **claimed**" and that the condition is not met if there is more than a *de minimis* amendment to the claims. He also stated that the finality in this case was not proper.

(Emphasis in original). Page 3 of the July 28, 2017 petition in application ‘841.

Nonetheless, the FA Decision dismissed arguments concerning “information allegedly provided by an employee or employees of OPLA” as “of no consequence”. See FA Decision Footnote 5 and page 8. Instead, the FA Decision provided the following rationale for expanding FAFR practice:

[W]hile many first action final rejection situations involve instances in which an applicant has failed to make any amendment to the claims (e. g., Bogese), a review of past first final actions decisions reveals first action final rejections being approved notwithstanding a change to the scope of the claims (e. g., the application at issue in Molins PLC v. Quigg, 837 F.2d 1064 (Fed. Cir. 1988), involved a change of scope of the claims that is comparable to the changes in the above-identified application). This suggests that the phrase “same invention” in MPEP 706.07(b) has not previously been considered by the United States Patent and Trademark Office (USPTO) as being limited to the “same invention” for purposes of statutory double patenting under 35 U.S.C 101.”

See FA Decision at pages 7-8.

As Section 802.01 cautions “[a]ll decisions should be read carefully to determine the meaning intended.” Confusingly, the FA Decision is both “**granted** to the extent that the

action of the Technology Center Director has been reviewed” and “**denied** with respect to overturning the Technology Center’s Decision.” (Emphasis added). See FA Decision at 9. The FA Decision muddies the waters by suggesting that a second, separate definition exists for the phrase **same invention** yet refraining to provide that second definition or identify circumstances when the alternative definition would be applicable. The FA Decision does not employ the phrases “independent and distinct,” “restriction,” or “37 C.F.R. Section 1.145” now codified in Section 706.07(b). The phrase “patentably indistinct” is used only in the context of acknowledging petitioner’s argument and the phrase “patentably distinct” only occurs in the context of a double negative: “it is not superfluous for “same invention” in MPEP 706.07(b) to mean only that the claims must not be drawn to a patentably distinct invention.” See FA Decision at page 8. Section 802.01 goes on to caution “[t]he terms ‘independent’ and ‘distinct’ are used in decisions with varying meanings.” Layering upon the confusion, Section 802.01 mis-interprets the plain language independent **and** distinct of 35 U.S.C. Section 121 and 37 C.F.R. Section 1.145 to mean independent **or** distinct. In any event, it is difficult to determine whether the FA Decision led to the Section 706.07(b) policy change or whether the Section 706.07(b) policy change was made to retroactively provide support for the FA Decision.

In Part II, we will identify and analyze decisions issued before and after the FA Decision which address the propriety of FAFR on amended claims filed with a CON or RCE. We discover that the FA Decision, which was inconsistent with the standard of pre-2020 Section 706.07(b), inconsistent with co-author Burke’s understanding, and inconsistent with the OPLA’s assessment, is also inconsistent with the manner in which the majority of the TC Group Directors decide FAFR petitions.

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Curious September 22, 2020 10:32 am

Sounds like classic USPTO BS.

John L. Rogitz September 22, 2020 10:26 am

This just ensures more and earlier appeals. Which is the way many practitioners are going anyway.

I saw one of those recently in which a RCE was filed with amendments to the claims, and the examiner came back with a Final Office Action. We considered filing a petition as our understanding was that “the term same invention has been defined for FAFR purposes as in the context of statutory double patenting, i.e., as identical subject matter being claimed twice or ‘same invention’.”

After decades dealing with the USPTO, the logic behind this is readily apparent. The USPTO really doesn’t like to do its job — which is to examine patent applications. Moreover, the USPTO apparently really likes to extort RCEs from applicants — putting more money into the USPTO’s coffers and giving examiners cheap production credit.

To paraphrase an old Star Wars quote ...

“General [David Boundy]. Years ago you served [patent attorneys everywhere] in the [wars against the Jon Dudas]. Now he begs you to help him in his struggle against the Empire. This is our most desperate hour. Help me, [David Boundy]. You’re my only hope.

I write that in half jest — if there is someone who knows how to take this down, it will be David Boundy.

Pro Say September 22, 2020 10:32 am

Thank you all for this important information.

So the Patent Office’s right hand . . . doesn’t know what its left hand is doing.

Something we’re all SO surprised to discover, right?

AAA JJ September 22, 2020 3:36 pm

It’s silly but you have to file a response after final and get that “new issues that would require

further search and/or consideration” box checked on the advisory action if you want to be assured of avoiding a FAFR. Sometimes I will conduct an examiner interview after final and ask the examiner to acknowledge that any proposed amendments will constitute a new issue and then, upon agreement, proceed straight to an RCE with that agreement clearly stated in the remarks section of the response accompanying the RCE.

Of course the PTO could simply get rid of FAFR practice as the Bogese fact pattern is practically non-existent.

ipguy September 22, 2020 4:15 pm

This article brings to light an issue that I’m sure few practitioners are even consciously aware of. The USPTO is creating a situation ripe for abuse. Even experienced Primary Examiners seem to have a loose grasp of when a second Action may properly be deemed “Final,” much less when a First Action may properly be deemed “Final.”

Ultimately, I view this as a revenue-generating move by the USPTO with increased fees coming from petitions, appeals and RCEs.

A few years ago, a new associate was studying for the Patent Bar, and asked for my advice as to what to do if they couldn’t decide on the proper answer to a multiple choice question. I told them that, when in doubt, the correct answer is usually the answer that requires the applicant to pay a fee to the USPTO. It’s all about the fees.

Anon September 22, 2020 8:33 pm

ipguy,

Sadly you alight upon an inconvenient fact: challenging improper finality is a blackhole sojourn into the abyss of petition practice.

PTO-indentured September 23, 2020 11:46 am

Oligarch Secret Sauce: **Amibiguity**

David Lewis September 23, 2020 3:47 pm

Thank you for this article.

).

JPOS reader September 28, 2020 12:06 pm

Fact Correction: “Compact prosecution” was first published at least September 1962 (see 44 JPOS 635). It has roots back to Kinnan’s publication in Mortimer’s Patent Office Papers. The Journal has lots of historically insightful articles, including final rejection practice (e.g., 11 JPOS 390).

Exhibit F

David Boundy, *Agency Bad Guidance Practices at the Patent and Trademark Office: a Billion Dollar Problem*, 2018 Patently-O Patent Law Journal 20 (December 6, 2018), Available at <https://ssrn.com/abstract=3258040>

2018 PATENTLY-O PATENT LAW JOURNAL

Agency Bad Guidance Practices at the Patent and Trademark Office: a Billion Dollar Problem¹

by David E. Boundy²
December 4, 2018 (revised December 6, 2018)

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In 2007, the Office of Management and Budget in the Executive Office of the President issued the *Bulletin on Agency Good Guidance Practices* addressed to all

¹ Cite as David E. Boundy, Agency Bad Guidance Practices at the Patent and Trademark Office: a Billion Dollar Problem, 2018 Patently-O Patent Law Journal 20.

² David Boundy is a partner at Cambridge Technology Law. He may be reached at DBoundy@CambridgeTechLaw.com.

executive branch agencies.³ The *Bulletin* does two things. First, it reminds agencies of a number of basic statutory principles of administrative law. Second, the *Bulletin* constitutes OMB's implementing guidance for several statutes and executive orders, and itself carries the authority of an Executive Order, to assist agencies in improving the "quality, utility, objectivity, and integrity of information" disseminated by agencies (including their guidance documents), and to help agencies improve their rulemaking processes. The *Bulletin* is no dusty old historical relic—within 10 days of his inauguration, President Trump put the *Bulletin* front and center in his deregulatory agenda, and reminded agencies of their obligations to adhere to it.⁴

PTO has been, well, a bit behind the times on implementing this *Bulletin*. In fact, PTO is now coming up on twelve years delinquent in implementing the *statutory* requirements noted in the *Bulletin*, let alone the directives issued on the authority of the President. Not only is PTO now over a decade late, it's several billion dollars short. In early November, I asked the following question of one of the patent attorney email lists:

As a percentage of your post-filing prosecution (after initial filing, before allowance), what percentage of your time do you spend dealing with PTO error due to misuse of guidance?⁵

The median (half above, half below) response was "a little under 50%," and mode (most common response) was 50%. This translates into over **\$1.5 billion per year** in direct costs—attorney fees, excess fees paid to PTO, and the like. The cost to the public for the waste arising from PTO's delay in implementing the *Good Guidance Bulletin* is about equal to (and perhaps greater than) PTO's budget for its entire patent operation.⁶

³ Office of Management and Budget, Executive Office of the President, *Final Bulletin for Agency Good Guidance Practices*, <https://georgewbush-whitehouse.archives.gov/omb/memoranda/fy2007/m07-07.pdf> (Jan. 18, 2007), reprinted in 72 Fed. Reg. 3432-40 <https://www.federalregister.gov/documents/2007/01/25/E7-1066/final-bulletin-for-agency-good-guidance-practices> (Jan. 25, 2007).

⁴ Dominic J. Mancini, Acting Administrator, Office of Info. & Regulatory Affairs, to Regulatory Policy Officers at Executive Departments and Agencies, *Interim Guidance Implementing Section 2 of the Executive Order of January 30, 2017*, Titled "Reducing Regulation and Controlling Regulatory Costs (Feb. 2, 2017), <https://www.whitehouse.gov/the-press-office/2017/02/03/interim-guidance-implementing-section-2-executive-order-january-30-2017> ("Agencies should continue to adhere to OMB's 2007 Memorandum on Good Guidance Practices.").

⁵ Email questions and responses on file with the author.

⁶ PTO's most recent estimate of direct costs of prosecution, after filing and before allowance, not including appeals, in 2012, was \$3.9 billion per year. 77 Fed. Reg. 16813-17. (Public comments noted that PTO's estimate was too low, skewed by incorrect choices of statistical methods, under-inclusions, and obsolete data.) 50% of \$3.9 billion is \$1.95 billion (in 2012). In contrast, for FY2012, the budget for PTO's entire patent business unit was about \$1.5 billion. PTO Performance and Accountability Report FY2012 <https://www.uspto.gov/sites/default/files/about/stratplan/ar/USPTOFY2012PAR.pdf> at 74. FY2018 numbers are up over FY2012 by about 28%.

Several survey respondents gave narrative elaborations of their numerical answers. Many noted that inventors often can't afford to fight PTO errors, and instead sacrifice patent coverage to which they are entitled by law. One respondent wrote:

[T]hings like this don't just waste our time as practitioners; they are seriously harmful to the US economy. Big businesses get slowed down and waste resources ..., and small businesses often just do not have the expertise or money to deal with it at all, and so they abandon research that could have resulted in valuable products. I know this is true—I've seen it. I'm sure you've all seen it.

When the value of attorney fees, lost patent protection, companies not formed, companies that fold because of delays and unpredictability of their patent applications, business opportunities not pursued, and similar economic effects are factored in, the economic damage caused by PTO's bad guidance practices is well into the *billions* each year.

Maybe it's time for PTO to follow the law. This article is a primer on one of the key issues in the law of guidance: when may PTO act by less-formal-than-regulation guidance, vs. when *must* the agency use regulation promulgated under full statutory procedure? What are the legal consequences when PTO uses less procedure than required by law? Among PTO's non-regulatory guidance, are there especially-costly rules that were invalidly promulgated, that should be removed from guidance? Which could be re-promulgated by proper regulation? Which are simply illegal and should be dropped entirely?

I. “Guidance?” “Rule?” “Regulation?” What do those words mean?

“Guidance” is an informal term that doesn't appear in any statute. The term started showing up in D.C. Circuit decisions in the late 1980s⁷ to refer to any “rule” that isn't a “regulation.”

What's a “rule?” The Administrative Procedure Act, 5 U.S.C. § 551(4), defines “rule” as “the whole or a part of an agency statement of general or particular applicability and future effect designed to implement, interpret, or prescribe law or policy or describing the organization, procedure, or practice requirements of an agency...” One of the key administrative law cases from the D.C. Circuit notes that the definition of “rule” in § 551(4) “include[s] nearly every statement an agency may make,” and that exemptions from statutory rule making procedures are “limited.”⁸

What's a “regulation?” To my knowledge, the term isn't defined. However, in recent years, idiomatic use has coalesced around the Code of Federal Regulations—a “regulation” is a “rule” that has been run through the procedures required by

⁷ *E.g.*, *Natural Resources Defense Council, Inc. v. Thomas*, 838 F.2d 1224 (D.C. Cir. 1988).

⁸ *Batterton v. Marshall*, 648 F.2d 694, 700–01 (D.C. Cir. 1980).

various statutes (the APA's rulemaking provisions of 5 U.S.C. § 553, the APA's publication requirements of § 552, the notice-and-comment and other vetting requirements of the Paperwork Reduction Act and its implementing regulations, 44 U.S.C. §§ 3506 and 3507, and 5 C.F.R. Part 1320, the Regulatory Flexibility Act, etc.) and Executive Orders (E.O. 12,866, 13,771, etc.), and after all necessary procedure, has earned a place in the Code of Federal Regulations.

In the Patent Act, Congress is remarkably consistent and precise in its use of terms: Congress uses "regulation" when delegating rulemaking authority that (under one or another of the administrative law statutes) requires notice-and-comment rulemaking procedure, and Congress uses another less-specific term such as "rule" or "procedure" where no administrative law statute requires a "regulation" (in the sense of the previous paragraph). The Patent Act consistently uses "regulation" to delegate rulemaking authority where PTO is to bind the public with respect to issues that are foreseeable and determine substantial rights.⁹ In contrast, authority to act by non-regulation "rule" or to set "procedures" is delegated only for rules that fall within a recognized exception to the "regulation" requirements of the administrative law:

- (a) supervision of acts of agency employees,¹⁰
- (b) issues where equitable discretion is needed to adjudicate forgiveness for one-off errors (for example, to waive a rule to cure lost mail or missed

⁹ The following statutes grant the Director the authority to promulgate regulations. 35 U.S.C. § 2(b)(2)(D) (Director may promulgate general procedural regulations), § 2(b)(2)(D) (Director may promulgate regulations to govern recognition of attorneys and agents); §§ 41 (Director may, by regulation, set fees and conditions for refund), § 115(d) and (h) (Director may specify regulations for substitute statements), § 119(a) and (e) (Director may promulgate regulations for priority claims to foreign applications and provisional applications), § 123(a) (Director may issue regulations to define "micro entity"); § 132(b) (Director shall prescribe regulations for RCEs); § 135 (Director shall prescribe regulations for derivation proceedings); § 154(b)(2) and (3) (Director shall prescribe regulations for term adjustment); §§ 206, 208 (Secretary of Commerce shall issue regulations for Bayh-Dole); § 257(d) (Director shall issue regulations to govern supplemental examination), 311(a) (Director shall, by regulation, establish fees for IPR), § 312(a)(4) (Director may govern IPR petitions by regulation); § 316(a) and (d)(2) (Director shall prescribe regulations for conduct of IPR), § 321(a), § 322(a)(4), § 326 (same for PGR).

¹⁰ Housekeeping rules, by which an agency binds its employees, are governed by the "Housekeeping Act," 5 U.S.C. § 301, and carved out from the rulemaking provisions of § 553 (§ 553(a)(2) (exempting "matter[s] relating to agency management or personnel")). 5 U.S.C. § 3(b)(2)(A) charges that the Commissioners of Patents and Trademarks "shall be responsible for the management and direction of all aspects of the activities of the Office that affect the administration of patent and trademark operations, respectively."

deadlines)¹¹ but foresight of all possible future situations is nigh impossible, and

(c) ministerial acts, and acts of PTO that are tangential to adjudicating substantial rights.¹²

35 U.S.C. § 257(d)(2) is particularly instructive on Congress' exacting care: the Director shall issue *regulations* for the public to follow in requests for supplemental examination, and *procedures* for PTO employees to follow in reviewing those requests.

Administrative law rulemaking statutes and executive orders obligate agencies to consult with the public, introspect, analyze, and provide an explanation of rationale for any rule. Most importantly, rulemaking procedure requires an agency to look at its proposals from the point of view of regulated entities, not just from the agency's parochial or financial self-interest. Statutory rulemaking procedure is designed to ensure that an agency does not raise costs on the public by \$2 to reduce agency costs by \$1, does not create costs on the public that can be reduced through better internal agency controls, does not impose undue burden on small entities, etc. Statutory rulemaking procedure ensures predictability and, ultimately, "reasoned decisionmaking." When an agency bypasses any of these obligations, there's a high risk that the agency will fail to act in the public interest. And of course the incentives and risks are even higher when an agency is funded by user fees.

Rulemaking procedure, the Code of Federal Regulations, and the Federal Register as the publication venue for official interpretations of the Code, are important to agency predictability, so that the public has a single, consolidated, internally-consistent place to look, and thereby know how to interact with the agency. The alternative to orderly and predictable "regulations" and rulemaking procedure is a cacophony of other "stuff" that looks, to a member of the public trying to interact

¹¹ 5 U.S.C. § 553(d)(1) (a rule that "grants or recognizes an exemption or relieves a restriction" may be promulgated by mere publication in the Federal Register under § 552(a)); *American Farm Lines v. Black Ball Freight Service*, 397 U.S. 532, 539 (1970) ("It is always within the discretion of ... an administrative agency to relax or modify its procedural rules adopted for the orderly transaction of business before it when in a given case the ends of justice require it."). Delegations of rulemaking authority to relieve restrictions include 35 U.S.C. § 21(a) (Director may specify rules for lost mail); § 25 (Director may by rule provide for declaration in lieu of oath); § 27 (Director may establish procedures to revive an unintentionally abandoned application); §§ 119, 120, and § 365(b) (Director may establish procedures for unintentionally delayed priority claim); § 122(b)(1)(A) (Director to determine procedures for publication of applications); § 384 (Director may establish procedures for review of filing date for Hague design application).

¹² In addition to the examples in notes 10 and 11, the following statutes grant to the Director rulemaking authority *without* regulation. 35 U.S.C. § 23 (Director may establish rules for affidavits and depositions); § 122(b)(1)(A) (Director to determine procedures for publication of applications); § 122(c) (Director shall establish procedures governing protest or pre-issuance opposition); § 122(d) (Director shall establish procedures governing secrecy orders); § 181 (Director may prescribe rules to appeal secrecy orders).

with the agency, like a blizzard of anti-aircraft chaff. In addition to the statutory channels, PTO broadcasts rulemaking information through a *sui generis* Official Gazette (which is sometimes years out of date), agency staff manuals (that contain both information for agency staff, and in addition, have rules purporting to bind the public), internal memoranda (some visible to the public, some not), Q&A and FAQ web pages, PowerPoint slides, webinars (many of which are presented once, with no stored copy on the agency's web site), precedential decisions spread over several lists on PTO's web site, "informative" decisions (that the agency treats as precedential), Standard Operating Procedures (nominally directed to agency staff, but some of which have public-facing rule content), checkboxes on forms (that often create carve-outs from regulations that were adopted to protect the public), etc.. Because PTO does not even try to speak with a consistent voice, those nonstatutory pronouncements sometimes directly clash with statutory regulation and with each other.¹³ The Administrative Procedure Act, Paperwork Reduction Act, Information Quality Act, and *Good Guidance Bulletin* are supposed to prevent this kind of bedlam.

II. When may an agency act by non-regulation guidance?

The default of 5 U.S.C. § 553 is that an agency must conduct all rulemaking activities via notice-and-comment rulemaking, subject to specific exemptions. The courts have repeatedly declared that the exceptions are to be narrowly construed and reluctantly recognized, so as not to defeat the salutary purposes behind the notice-and-comment provisions of § 553.¹⁴ An agency must act by "regulation" for any "rule":

- that does not fit one of the exemptions of 5 U.S.C. § 553(a), (b)(A), (b)(B), or (d),¹⁵ *or*
- that is covered by a notice-and-comment requirement of another administrative law statute (for example, the Paperwork Reduction Act requires notice-and-comment for almost all of PTO's procedural rules, *e.g.*, 44 U.S.C. § 3506(c)(2)(A); 5 C.F.R. § 1320.3(c)(4)(i)), *or*
- if the agency's own organic statute requires.¹⁶

¹³ PTO's uncoordinated rule statements, and some examples of direct clashes, are explained in Boundy, Part 3: *Precedential and Informative Decisions*, note 41 *infra*, at § II(B)(2), pages 8-9.

¹⁴ See *United States v. Picciotto*, 875 F.2d 345, 347 (D.C. Cir. 1989); *American Hosp. Ass'n v. Bowen*, 834 F.2d 1037, 1044-45 (D.C. Cir. 1987) and cases cited therein.

¹⁵ A nice picture showing how those exemptions interrelate is shown in Boundy, Part 1, note 39 *infra*. Wouldn't you know. About two weeks after the Part 1 article went to press, I realized an even better way to visualize the taxonomy of all rules, and I started writing the next article. If you ask nicely, I would likely send you this work-in-progress article.

¹⁶ *Tafas v. Dudas*, 541 F.Supp.2d 805, 812, 86 USPQ2d 1623, 1628 (E.D. Va. 2008) held that 35 U.S.C. § 2(b)(2) "makes it clear that the PTO must engage in notice and comment rule making when promulgating rules it is otherwise empowered to make," criticized *Tafas v. Doll*, 559 F.3d 1345, 1352 n.3, 90 USPQ2d 1129, 1134 n.3 (Fed. Cir. 2009), panel opinion

When may an agency act by less-than-regulation guidance? Simple question, simple answer: when a rule *doesn't* fall into a category that requires “regulation” rulemaking. But these exemptions have a “price” for the agency¹⁷—a rule promulgated by less-than-regulation procedure has less-than-regulation binding effect against the public:

- To instruct the agency’s own employees. These are carved out from the APA by § 553(a)(2) (exempting “matter[s] relating to agency management or personnel”). Instead, employee-facing rules are governed by the “Housekeeping Act,” 5 U.S.C. § 301, and PTO’s obligation to supervise its own employees, 35 U.S.C. § 3(b)(2)(B).
 - Once an agency issues guidance that uses mandatory language to state obligations of agency employees with respect to “important procedural benefits” to the public, or publishes an “interpretative” rule interpreting the agency’s statute or regulation, agency employees (including ALJs) are bound, the public is entitled to rely on employees’ observing the guidance, and the agency is obligated to enforce the procedural commitments it makes to the public.¹⁸ This is the well-known “*Accardi* principle.”¹⁹
- To *interpret* an “active” ambiguity, such as an ambiguous term, a general term, or a conflict. These are carved out from notice-and-comment (but not the rest of the APA) by § 553(b)(A). A passive silence in the underlying statute or regulation, or a new rule that is merely “consistent with” or “not negated” by the underlying statute or regulation, or that fleshes out empty or vague language like “fair and equitable” or “in the public interest” are almost never eligible for the “interpretative” exemption.²⁰

vacated, 328 Fed. Appx. 658, 91 USPQ2d 1153 (unpublished), on PTO’s motion to dismiss as moot, district court reinstated sub nom. *Tafas v. Kappos*, 586 F.3d 1369, 1371, 92 USPQ2d 1693, 1694 (Fed. Cir. 2009). Apparently the Federal Circuit has not revisited the issue of notice-and-comment procedure for PTO’s procedural rules since then. The continuing vitality of *Tafas* is discussed in Boundy Part 1, note 39 *infra*, at 51-52.

¹⁷ *Perez v. Mortgage Bankers Ass’n*, 135 S.Ct. 1199, 1204 (2015).

¹⁸ *In re Kaghan*, 387 F.2d 398, 401, 156 USPQ 130, 132 (CCPA 1967) (“we feel that an applicant should be entitled to rely not only on the statutes and Rules of Practice but also on the provisions of the MPEP in the prosecution of his patent application.”); *Vitarelli v. Seaton*, 359 U.S. 535, 545 (1959) (holding that an agency action was “illegal and of no effect” because the agency’s dismissal “fell substantially short of the requirements of the applicable department regulations”); *Service v. Dulles*, 354 U.S. 363, 386–88 (1957) (finding that an unpublished manual was binding, and violation of that manual was a ground for setting aside agency action); *Accardi v. Shaughnessy*, 347 U.S. 260 (1954); *Gulf States Mfrs., Inc. v. NLRB*, 579 F.2d 1298, 1308-09 (5th Cir. 1978) (an agency manual (whether procedural or substantive) is binding on agency staff, up to and including ALJs, even if not published in the Federal Register).

¹⁹ Thomas W. Merrill, *The Accardi Principle*, 74 Geo. Wash. L. Rev. 569 (Jun. 2006).

²⁰ Anthony, note 42 *infra*, 41 DUKE L.J. at 1312-13; *NLRB v. Wyman-Gordon Co.*, 394 U.S. 759, 761 (1969); *Mission Group Kan., Inc. v. Riley*, 146 F.3d 775, 781 (10th Cir. 1998) (quoting

- For example, the Supreme Court blessed the NLRB when it used guidance to interpret the statutory term “managerial employee,” but shot down an NLRB procedural rule that, while entirely consistent with the statute, and within the NLRB’s power to order as a one-off *adjudication* order, was invalid as a *rule*, because promulgated without APA procedure.²¹
- Interpretations that rely on the “interpretative” exemption to bypass “regulation” procedure “do not have the force and effect of law and are not accorded that weight in the adjudicatory process”²²—they are binding on the public with only *Skidmore* deference,²³ until an interpretation is confirmed by an Article III court. In the meantime, the agency may not rely on an interpretative rule to “foreclose consideration by the agency of positions advanced by private parties.”²⁴ (An interpretation within the non-regulatory *Skidmore* framework is like Schrödinger’s cat—it’s impossible to know whether the agency’s interpretation is live or dead, until an Article III court peeks into the box.)

Richard A. Posner, *The Rise and Fall of Administrative Law*, 72 CHI.-KENT L. REV. 953, 962 (1997)).

²¹ Contrast *Wyman-Gordon Co.*, note 20 *supra*, 394 U.S. at 761 (striking down a rule by which NLRB required employers to give employee lists to unions, because not promulgated by APA rulemaking procedure) against *NLRB v. Bell Aerospace Co.*, 415 U.S. 267, 294 (1974) (approving a rule promulgated with exactly the same level of procedure as in *Wyman-Gordon*, because it had interpretative grounding in an ambiguous statutory term, “managerial employees”). A longer explanation of the contrast between *Wyman-Gordon* against *Bell Aerospace* is in Boundy, *Part 3: Precedential and Informative Decisions*, note 41 *infra*, at § II(D), pages 12-14.

²² *Perez*, note 17 *supra*, 135 S.Ct. at 1204.

²³ *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944) (“We consider that the rulings, interpretations and opinions of the [agency], while not controlling upon the courts by reason of their authority, do constitute a body of experience and informed judgment to which courts and litigants may properly resort for guidance. The weight of such a judgment in a particular case will depend upon the thoroughness evident in its consideration, the validity of its reasoning, its consistency with earlier and later pronouncements, and all those factors which give it power to persuade, if lacking power to control.”).

Skidmore deference, where an agency’s interpretation is a “thumb on the scale” but not binding, stands in contrast to *Chevron* and *Auer* deference in which an agency’s rule binds courts, the public, and the agency. But *Chevron* and *Auer* deference only apply where a rule is past the “procedurally defective” threshold, *Encino Motorcars, LLC v. Navarro*, 579 U.S. ___, ___, 136 S.Ct. 2117, 2125 (2016); *Gonzales v. Oregon*, 546 U.S. 243, 255–56 (2006). This article is about guidance rules that don’t get across that first threshold.

²⁴ *Good Guidance Practices*, note 3 *supra*, § III(2)(b), [.../m07-07.pdf](#) at 21, 72 Fed. Reg. 3440 col. 2.

- To offer an agency’s advisory thoughts, that the agency does not intend to enforce (typically using the word “should”) as a “general statement of policy” under § 553(b)(A).
 - “General statements of policy” require no procedure (other than publication), but have no binding effect whatsoever—that’s the *quid pro quo*.²⁵
- Amendments to “recognize[] an exemption or relieve[] a restriction” can be promulgated on simple notice (§ 553(d)(1)); rules to raise burdens on the public must go through statutory rulemaking procedure (*e.g.*, 5 U.S.C. §§ 553(b) and (c), 603, 604; 44 U.S.C. § 3507(a)). An agency always has discretion to relax or waive a procedural regulation *in favor* of a member of the public,²⁶ but none in favor of itself.
- There are a few cases where an agency can issue guidance when it can’t act by regulation. For example, PTO has no substantive rulemaking authority, and so cannot bind the *public* on substantive patent law by regulation (nor by any other mechanism, such as precedential opinion)²⁷—but has not only the power but the *duty* to instruct *examiners* on substantive law. 35 U.S.C. § 3(b)(2)(B). Similarly, PTO could offer non-binding “interpretative” or “policy statement” guidance on issues where it has no rulemaking authority at all—for example, PTO *could* offer non-binding suggestions on state assignment law in the context of PTO’s patent or trademark activities.

Note that these exceptions are all targeted at areas where the effect of a rule is too small to warrant full rulemaking procedure (*e.g.*, interpretation of ambiguity, or non-binding advisory policy statements), or the agency’s incentives to act in self-interest instead of the public interest are small enough that Congress can trust the agency to be self-policing

When may an agency **not** use guidance? In other words, when **must** an agency act by “regulation?”

- An agency may **not** use non-regulation guidance to bind the public under a rule that goes beyond *interpreting* an “active” ambiguity.²⁸ To bind the public, an agency must use statutory rulemaking procedure. If a law itself has force of law, then an agency may “interpret” ambiguities in that law, § 553(b)(A), but may not, “under the guise of interpreting a regulation, ... create *de facto* a new regulation.”²⁹

²⁵ *Community Nutrition Institute v. Young*, 818 F.2d 943, 946 (D.C. Cir. 1987); *Brock v. Cathedral Bluffs Shale Oil Co.*, 796 F.2d 533, 536–37 (D.C. Cir. 1986) (Scalia, J.).

²⁶ See note 11 *supra*.

²⁷ See Boundy, Part 3: *Precedential and Informative Decisions*, note 41 *infra*.

²⁸ See note 20 *supra*.

²⁹ *Christensen v. Harris County*, 529 U.S. 576, 588 (2000).

- If an agency regulation speaks to an issue, the agency can interpret ambiguity in that regulation using guidance, but may **not** add additional provisions or carve-outs that add burden to the public or attenuate the agency's responsibilities.³⁰

The astute reader will note the asymmetry: an agency may bind *itself* and *its employees* easily. An agency may waive a rule that operates against the public. But the opposite doesn't apply: agencies can't renege on deals they make with the public during notice-and-comment, or grant themselves waivers from promises they make to the public in their guidance, or *add* burdens or obligations to the public. Asymmetry is not common in the law, but it's a defining feature of the law of guidance. The asymmetry is stated on the face of the APA, 5 U.S.C. § 552(a), and the way § 553(a)(2) exempts "matter[s] relating to agency management or personnel" from the high procedure of § 553(b), and remits them to the low-procedure mechanisms of § 301. The D.C. Circuit explained the asymmetry in *Lopez v. Federal Aviation Administration*, 318 F.3d 242, 246–47 (D.C. Cir. 2003).³¹

³⁰ *Perez*, 135 S.Ct. at 1206 (to amend a rule, an agency must use the same procedure that was used in first instance); *Wyman-Gordon Co.*, note 20 *supra*, 394 U.S. at 763-66 (an agency may not bypass statutory rulemaking procedure).

³¹ While § 552(a) provides that an agency may not enforce a rule against any party other than the agency itself without publication in the Federal Register, many courts have noted that such publication is not required for enforcement against the agency itself. *Service v. Dulles*, 354 U.S. 363, 386–88 (1957) (unpublished manual was binding, and violation of that manual was ground for setting aside agency action); *Yale-New Haven Hospital v. Leavitt*, 470 F.3d 71, 80 (2nd Cir. 2006) (addressing an agency staff manual: "An interpretative rule binds an agency's employees, including its ALJs," even though the agency has authority to change it without full § 553 procedures); *Farrell v. Dep't of Interior*, 314 F.3d 584, 590–91 (Fed. Cir. 2002) ("If an agency policy statement is intended to impose obligations or to limit the rights of members of the public, it is subject to the Administrative Procedure Act, and, with certain exceptions, must be published in the Federal Register as a regulation. 5 U.S.C. § 553(b)–(c) (2000). If it is not, it is invalid. ... Here, however, we have a different situation. The issue is not whether the agency statement is binding on the public, but whether it is binding on the agency itself. ... The general consensus is that an agency statement, not issued as a formal regulation, binds the agency only if the agency intended the statement to be binding. The primary consideration in determining the agency's intent is whether the text of the agency statement indicates that it was designed to be binding on the agency."); *Warder v. Shalala*, 149 F.3d 73, 82 (1st Cir. 1998) ("Of course, a rule with the force and effect of law—binding not only the agency and regulated parties, but also the courts—is by definition a substantive rule. However, a rule may lack this force and still bind agency personnel."); *Zhang v. Slattery*, 55 F.3d 732, 748 (2d Cir. 1995) ("We have ruled, however, that a regulation need not necessarily be published [in the Federal Register] in order to be enforced *against* the government."); *New England Tank Industries of New Hampshire v. United States*, 861 F.2d 685, 688, 694 (Fed. Cir. 1988).

III. Consequences of short-cutting rulemaking procedure

A. *Rules rendered unenforceable*

Almost all of the laws that govern rulemaking provide that an agency may not enforce a rule promulgated with less than statutory procedure, and that agency adjudications under invalid rules may likewise be set aside:

- The cases are legion where an agency shortcuts rulemaking procedure by acting through guidance, tries to attach binding effect to its guidance, and gets caught, and a court orders the agency to stand down on the rule.³²
- 5 U.S.C. § 552(a) requires publication in the Federal Register, and guarantees to the public that it can watch one, and only one, channel to be fully informed of breaking news relating to agency rulemaking. Very few agencies are so inept that they can't manage this simplest requirement in the entire administrative law, simple publication under § 552, but when they do, courts invalidate those rules.³³ Remarkably, even though this statute has been in effect for seventy years, and the MPEP has been around for sixty, the Office of Patent Examination Policy only got around to complying with § 552 *ten months* ago.³⁴ Even more striking, PTO's *trademark* side has been running these notices for decades.³⁵

³² *Wyman-Gordon Co.*, note 20 *supra*, 394 U.S. at 761, 763-66; *McLouth Steel Products Corp. v. Thomas*, 838 F.2d 1317, 1320 (D.C. Cir. 1988); *Community Nutrition*, note 25 *supra*, 818 F.2d at 947-49. It's striking how few cases there are on this point after the mid-1990s—most agencies figured out how to comply with the law, most of the time. After the *Good Guidance Bulletin* was issued in 2007 and implemented by other agencies, these cases evaporated to near zero. PTO is a remarkable outlier.

³³ Even if a rule might be eligible for both the “interpretative” and “procedural” exemptions from notice-and-comment, if not published in the Federal Register, the rule may not be enforced. *W.C. v. Heckler*, 629 F.Supp.2d 791, 801 n.19 (W.D. Wash. 1985).

³⁴ Patent and Trademark Office, Manual of Patent Examining Procedure, Ninth Edition, Revision of January 2018, Notice of Publication, 83 Fed. Reg. 4473 (Jan. 31, 2018).

³⁵ The difference between the two sides of PTO in levels of compliance with the administrative law, and ability to learn from failures, is jarring. *Contrast Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (setting aside a rule promulgated by the PTAB, because of “an end-run around [the APA] by conducting rulemaking” without statutory rulemaking procedure—PTAB's misstatement that the rule was “procedural” was the error that started the court's unraveling of PTO's position); David Boundy and Andrew B. Freistein, *The PTAB Is Not an Article III Court, Part 2: Aqua Products v. Matal as a Case Study in Administrative Law*, ABA LANDSLIDE 10:5, pp. 44-51, 64 (May-Jun. 2018) (available [here](#), explaining the violations of law in PTAB's attempted rulemaking); Patent and Trademark Office, *Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, Final Rule, 83 Fed. Reg. 51340, 51357 col. 2 (Oct. 11, 2018) (the PTAB's claim construction rule is “procedural” because it “will not change the substantive criteria of patentability”—if this very same misstatement got the PTAB in hot water in *Aqua*, what's it doing again here?).

- The Paperwork Reduction Act is explicit in barring agencies from shortcutting, 44 U.S.C. § 3507(a) and § 3512—if an agency rule falls within the Act (most PTO procedural rules do, see the definitions in the implementing regulations, 5 C.F.R. § 1320.3), and PTO shortcuts necessary procedure (*e.g.*, MPEP rules by guidance), then the agency may not penalize a member of the public for failure to comply with that rule.
- The Regulatory Flexibility Act is interesting. The Act nominally restricts judicial review. However, a number of courts have invalidated agency rules when agency paperwork gave the facial *appearance* of compliance, and gave the facial *appearance* of triggering the preclusion of review statute. When a court looks below the surface and finds that agency compliance was illusory, that the agency's analysis was implausibly thin, or that the agency had improperly avoided inquiry into the practical consequences on small entities, courts set aside rules.³⁶

B. Statute of limitations

In addition, if an agency's shortcutting is so extensive that a rule never went into enforceable effect, or the public never had appropriate notice of an effective date, the statute of limitations never *begins*, and the agency may be divested of any opportunity to assert any statute of limitations defense to challenges to the rule.³⁷

The Paperwork Reduction Act provides a defense against enforcement of an invalidly-promulgated rule that may be asserted "at any time during the agency administrative process or judicial action," and "notwithstanding any other provision of law." 44 U.S.C. § 3512. Courts of Appeals have held that the defense is never waived, and may be first asserted in a Court of Appeals.³⁸ I know of no case directly on point vis-à-vis a statute of limitations, but it seems that the language of the statute is intended to leave agencies in no doubt that they put themselves at indefinite risk by noncompliance.

There are several structural differences between the patent and trademark sides of the agency that might steer the patent operation to shortcut laws that the trademark operation follows. Perhaps a subject for a future article.

³⁶ *American Federation of Labor v. Chertoff*, 552 F.Supp.2d 999 (N.D. Cal 2007); *North Carolina Fisheries Ass'n, Inc. v. Daley*, 27 F.Supp.2d 650 (E.D. Va. 1998).

³⁷ *National Resources Defense Council v. Nat'l Highway Traffic Safety Admin*, 894 F.3d 95, 106 (2d Cir. 2018) (a rule does not go effective until published in the Federal Register, and that's the event that commences the limitations period); *W.C. v. Heckler*, note 33 *supra*, 629 F.Supp.2d at 806; *State of New York v. Heckler*, 105 F.R.D. 118, 124 (S.D.N.Y. 1985) ("the absence of formal publication of [an agency rule]... had the same effect ... for purposes of the limitations period...").

³⁸ *United States v. Lee*, 967 F.2d 594 (table), 1992 WL 144716 at *2 (9th Cir. 1992).

IV. Good additional sources on guidance

Four good introductions to the law of guidance may be found in:

- The *Bulletin for Agency Good Guidance Practices*. The *Bulletin* itself creates no legal rights, but it usefully restates conventional APA law.
- David Boundy, *The PTAB is Not an Article III Court, Part 1: A Primer on Federal Agency Rule Making*.³⁹ At the March 2018 Federal Circuit Judicial Conference, Judge Plager recommended this article to the entire patent bar. The article presents a helpful taxonomy of the entire landscape of “rules” that clarifies a great deal.⁴⁰
- David Boundy, *The PTAB is Not an Article III Court, Part 3: Precedential and Informative Decisions*,⁴¹ including a more-elaborated explanation of “do’s” and “don’ts” for non-regulation guidance, is forthcoming in *AIPLA Quarterly Journal*.
- Robert Anthony (who was Chairman of the Administrative Conference of the United States from 1974-79), *Interpretive Rules, Policy Statements, Guidances, Manuals, And The Like—Should Federal Agencies Use Them To Bind The Public?*⁴² (Interestingly, I think the law is a little “looser” in favor of agencies than Prof. Anthony does—I think that the range of “interpretative rules” that have *Skidmore* conditional binding effect is a little larger, and that the range of “policy statements” with no effect at all is a little smaller. But my view is conditioned on an agency honoring its obligation to entertain alternative interpretations.⁴³)

V. Examples of rules improperly promulgated by guidance

A. *Example 1: The secret 2007 restriction memo*

35 U.S.C. § 121 allows PTO to divide an application when it claims “independent and distinct” inventions. For decades, the MPEP required a showing of “serious burden” as part of a restriction requirement. The pre-2007 MPEP required an examiner to support a restriction by showing that the two inventions are to be searched in

³⁹ David Boundy, *The PTAB is Not an Article III Court, Part 1: A Primer on Federal Agency Rule Making*, ABA LANDSLIDE 10:2, pp. 9-13, 51-57 (Nov-Dec. 2017), at [here](#) or [here](#).

⁴⁰ See note 15, *supra*.

⁴¹ David Boundy, *The PTAB is Not an Article III Court, Part 3: Precedential and Informative Decisions*, forthcoming in *AIPLA Quarterly Journal*, [here](#). On the guidance issues of this article, pages 3-19 are particularly relevant.

⁴² Robert Anthony, *Interpretive Rules, Policy Statements, Guidances, Manuals, And The Like—Should Federal Agencies Use Them To Bind The Public?*, 41 Duke L.J. 1311 (June 1992)

⁴³ See note 24 *supra*.

different search classes, or give some other objective explanation for “serious burden.”⁴⁴

In April 2007, PTO issued a memorandum to examiners that removed the requirement for specific written showings; rather, an examiner could use one-size-fits-all boilerplate, with no showings, no identification of facts specific to the case. The 2007 form language is a list of five reasons, two of which have *nothing* to do with “independent and distinct,” with no blanks that need to be filled in. The 2007 memo invites applicants to guess at the examiner’s reasoning—the examiner doesn’t even have to identify which of five reasons applies:

New form paragraph 8.21 replaces previous form paragraphs 8.21.01 - 8.21.03 and 8.22:

¶ 8.21 To Establish Burden AND Requirement for Election and Means for Traversal for all Restrictions, other than an Election of Species

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

PTO ***kept this memo hidden from the public***; invisible for over 2½ years.⁴⁵ All that applicants could see was that applications were being divided for no explained reason. Eventually, even though PTO made no effort to publish it, the URL for the 2007 memo leaked out. Even then, *there were no links to it* anywhere on PTO’s web site (at least none that Google or the Internet Wayback Machine could find). One had to know the URL.

Once the leaked URL reached me, I petitioned to have this memo withdrawn. A more-detailed explanation of 20-some violations of law embodied in the 2007 memo may be found in 10/446,572, Petitions of April 2012 and May 2011 (summarized in pages 21-25). Even more remarkable are PTO’s reasons for refusing to correct the violations of statute or to withdraw the 2007 memo, which will make nice topics for future articles.

In the meantime, PTO had issued two revisions to the MPEP, both reiterating the decades-old language requiring specific showings. At the time, the MPEP Foreword

⁴⁴ E.g. MPEP § 803(II) and Form paragraphs 8.21.01 to .03 (2006), https://www.uspto.gov/web/offices/pac/mpep/old/E8R6_800.pdf

⁴⁵ http://wayback.archive.org/web/*/http://www.uspto.gov/web/offices/pac/dapp/opla/documents/20070425_restriction.pdf

stated “Orders and Notices, or portions thereof ... which have been omitted or not incorporated in the text may be considered obsolete.” In 2009, I phoned the MPEP Office to ask that the 2007 memo, which had not been incorporated into two revised editions of the MPEP, be obsoleted, as the MPEP promised. The attorney in the MPEP office conceded all relevant facts, but insisted that the 2007 memo survived the “considered obsolete” promise of the MPEP, because the *specific part* of the MPEP involved had not been revised. I pointed out that that’s not what the MPEP Foreword says—if guidance is to survive into a new edition, then it’s PTO’s job to “incorporate” it, that’s the whole point of new editions, and that’s what the words in the Foreword say—but the attorney insisted that examiners using the 2007 language would not be reversed.⁴⁶

PTO eventually resolved the conflict between the MPEP Foreword and its non-obsolete secret memoranda by removing the “considered obsolete” sentence from the MPEP Foreword, in 2013. Applicants are now left to guess what guidance is in effect, and what is obsolete. Even though the *Good Guidance Bulletin*, and PTO’s own self-regulations under the Information Quality Act, require the agency to accurately inform the public of what guidance is in effect, what isn’t, and when each was issued or withdrawn, PTO proceeds outside the bounds of the law.

A decade later, although today’s MPEP nominally requires examiners to make specific showings (though less-specific than before 2007), the no-fact-showing practice fostered by the 2007 memo remains the practical day-to-day norm. In the restriction papers that I receive, the overwhelming majority short-cut required fact showings. Many make bald assertions that a material difference between inventions exists, and serious burden, with no identification of what that difference or burden might be. One recent example reads:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the golf training apparatus as claimed can be used in a materially difference process.

⁴⁶ I have the name of the specific attorney in my notes, and it’s available on request, but it’s not that relevant. This specific attorney isn’t the problem. I’ve had multiple conversations with multiple attorneys (and nonattorney petition decision-makers) in the Office of Patent Examination Policy over the years, and these conversations consistently run on similar lines. The problem isn’t any specific attorney. The problem is pervasive in the Office of Patent Examining Procedure: words don’t mean what they say, procedural law isn’t enforced, Supreme Court case law under the APA doesn’t matter, and PTO promises to the public won’t be kept. It would be unfair to pin that pervasive culture on one specific attorney.

3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and/or examination burden if restriction were not required because at least the following reason(s) apply:

- *the inventions have acquired a separate status in the art in view of their different classification*
- *the inventions have acquired a separate status in the art due to their recognized divergent subject matter*
- *the inventions require a different field of search (e.g., searching different classes /subclasses or electronic resources, or employing different search strategies or search queries).*

Not a single word of analysis of the two claims that are purportedly divided. I wish I could tell you that this one is an outlier. It isn't.

Due to PTO's unilateral rewriting of examiner restriction guidance, in evasion of all the laws that govern agency rulemaking, thousands of applications per year are divided unnecessarily. Since 2007, I've had applications divided into 20-way restrictions, when the application would have been undividable under "classical" pre-2007 restriction standards. Assuming other attorneys experience the same kinds of excess restrictions as I do, and all divisionals were filed, the cost to the inventing public is in the hundreds of millions of dollars per year. But of course, at that cost, all divisionals are *not* filed, so the loss to the economy of valuable patent rights is probably of the same magnitude. Competitors, who used to be able to look at one patent to understand their infringement posture, now have to look at multiple divisionals. PTO unilaterally increases its fee income, and reduces the quantum of work it does on each application. But PTO has never explained any benefit to applicants, to the public, or to the patent system that they receive in return for PTO's improved finances.

B. Example 2: Unpublished rules for ADS submission of bibliographic data

The 2012 Final Rule for AIA regulations gave applicants a range of options for providing bibliographic data (inventor name, priority claims, applicant name, and the like). A full Application Data Sheet could be filed either with the "day one" application filing package, or as the first ADS filed thereafter.⁴⁷ More-complex rules for any *amended* ADS only came into play for the *second* ADS. This interpretation of the regulations—the only interpretation that's consistent with the regulations'

⁴⁷ Patent and Trademark Office, *Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, Final rule, 77 Fed. Reg. 48775 (Aug. 14, 2012).

text—was explained by PTO in the 2012 Federal Register notice,⁴⁸ and in the August 2012 MPEP.

Nonetheless, PTO began bouncing papers that complied with its regulations and published interpretation. PTO's confusing behavior was the single most-discussed question on some of the attorney discussion email lists for several years.⁴⁹

Finally, in October 2015, PTO revealed a unilateral and heretofore-unwritten change in the rules. A rewrite of MPEP § 601.05(a) mandated that only *one* of the range of options negotiated during notice-and-comment would be acceptable. A straightforward ADS would be accepted *only* if it was filed with the initial filing package. Under this 2015 rewrite of the MPEP, that very same ADS, if filed *after* initial filing, had to comply with the rules for *amended* ADS', even if it was the *first*-filed ADS and was making no *amendments*.

PTO never told anyone that it had unilaterally changed the rules (at least not through the channels set by statute, 5 U.S.C. § 552(a)), and never asked anyone for input (for example, using the notice and comment required by the Paperwork Reduction Act and *Good Guidance Bulletin*)—the rules just changed unilaterally and, for some years, in secret.

I'm sure that the new rule saves costs for PTO. But it's not the rule that PTO negotiated during notice-and-comment. The public had no § 552 notice of PTO's change of mind. This violation of guidance law, and unilateral abrogation of a fair-and-square deal negotiated with the public, for the PTO's unilateral benefit, created costs for the public in the millions of dollars for several years, and continues to surprise attorneys that rely on PTO's properly-published regulations.

C. *Example 3: MPEP § 2144.03(C) misstatement of the law of intra-agency Official Notice*

MPEP § 2144.0(C) misstates the law of Official notice. The law is simple: PTO always has the burden of proof to show each element of unpatentability, and to support each element with substantial evidence. 37 C.F.R. § 1.104(d)(2) is clear that all an applicant has to do to traverse an issue of fact supported by no more than examiner explanation is to "call for" substantial evidence.

In contrast, MPEP § 2144.03(C) purports to require that an applicant must make an affirmative showing to rebut an assertion of Official notice. At least, that's how many examiners and the PTAB read MPEP § 2144.03(C).⁵⁰ MPEP § 2144.03(C) is not correct.

⁴⁸ *Inventor's Oath* Final rule, note 47 *supra*, 77 Fed. Reg. 48775, 48785 col. 3, 48807, col. 3, 48786 col. 2 (Aug. 14, 2012).

⁴⁹ See, e.g., Carl Oppedahl's blog, <https://blog.oppedahl.com/?p=1586>.

⁵⁰ E.g., *Ex parte El-Awady*, 14/508, 166, Appeal2018-000672, <https://e-foia.uspto.gov/Foia/RetrievePdf?system=BPAI&fNm=fd2018000672-09-24-2018-1> at 7

PTO always bears the burden of proof to establish all facts to a preponderance of evidence, supported by substantial evidence.⁵¹ MPEP § 2144.03(C) violates this simple principle of law, and rulemaking law, in at least three respects:

- First, when PTO shifts of a burden of proof, that's a "substantive" rule.⁵² But PTO has no relevant substantive rule making authority.⁵³ It is beyond PTO's authority to require an applicant to show "why the noticed fact is not considered to be common knowledge or well-known in the art." If the evidence is in equipoise at 0-to-0, the appellant wins.
- Second, MPEP § 2144.03(C) is unlawful because it conflicts with 37 C.F.R. § 1.104(d)(2), which permits an applicant to traverse official notice by simply "calling for" substantial evidence. Agencies do not have authority to attenuate a regulation that runs in favor of the public by stating opposite provisions in guidance documents.
- Third, PTO neglected rule making requirements when it promulgated MPEP § 2144.03(C). If PTO wants to impose a mandatory requirement on applicants relating to burdens of proof or substantive patentability, it must do so through the rulemaking procedures of 5 U.S.C. §§ 552 and 553, which—at a minimum—require publication in the Federal Register under § 552(a), notice and comment under the Paperwork Reduction Act, and, I believe, notice and comment under § 553. PTO has never run MPEP § 2144.03 through the procedural requirements of the APA or Paperwork Reduction Act—therefore the imposed burden is unapproved and subject to the law's public protection provisions.

The error in MPEP § 2144.03(C) is demonstrated by PTO's reliance (in different editions of the MPEP) on *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943) and *In re Boon*, 439 F.2d 724, 727, 169 USPQ 231, 234 (CCPA 1971) to

(PTAB Sep. 26, 2018) (quoting the incorrect language of MPEP § 2144.03(C) in *italic*, to shift the burdens of production and persuasion to the appellant).

⁵¹ *In re Oetiker*, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. ... If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent ... We think that the PTO is correct in treating the concept of the prima facie case as of broad applicability, for it places the initial burden on the examiner, the appropriate procedure whatever the technological class of invention" *emphasis added*).

⁵² *Director, Office of Workers Compensation Programs, Dept. of Labor v. Greenwich Colliers*, 512 U.S. 267, 271 (1994) ("assignment of the burden of proof is a rule of substantive law")

⁵³ *Koninklijke Philips Electronics N.V. v. Cardiac Science Operating Co.*, 590 F.3d 1326, 1337, 93 USPQ2d 1227, 1235 (Fed. Cir. 2010) ("We remind ... the Board that they must follow judicial precedent instead of [PTO-formulated substantive rules] because the PTO lacks the substantive rulemaking authority to administratively set aside judicial precedent."); *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549-50, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) (statute "does NOT grant the Commissioner the authority to issue substantive rules.").

support the shift of burden of proof in MPEP § 2144.0(C). *Chevenard* and *Boon* are court/agency review cases. They're simply irrelevant to intra-PTO proceedings. Further, they're both abrogated. Before 1997, the CCPA's standard of *review* favored PTO, and required an appellant to show "clear error." That was abrogated by *Dickinson v. Zurko* in 1998. In contrast, during intra-PTO proceedings, the presumption of the standard of *proof* is and always has been in favor of the *applicant*, and the burden is on PTO to support any adverse finding by substantial evidence.

By evading the law that governs rulemaking and guidance, PTO lost opportunities for second-set-of-eyes review that helps avoid error. PTO now instructs examiners to act in error. The requirements for public vetting in the *Good Guidance Bulletin* to seek notice and comment, and in § 2(b)(2)(B) to act by "regulation," would have prevented that agency error. Had PTO taken its obligations under the Paperwork Reduction Act seriously, the error would have been caught and fixed in response to notice and comment letters no later than 2012.⁵⁴ But PTO didn't act on those letters.

The costs of dealing with this particular rulemaking error and examination error are substantial, probably over \$100 million per year in attorney fees and lost patent asset value.

D. Example 4: MPEP § 1207.04 and an examiner's power to abort an appeal

*Hyatt v. PTO*⁵⁵ concerns MPEP § 1207.04, a rule that PTO promulgated (unlawfully) through guidance, and that conflicts with a regulation (in the forbidden direction).⁵⁶

From 1997 to 2004, the rules for *ex parte* appeals stated that "An examiner's answer must not include a new ground of rejection" 37 C.F.R. § 1.193(a)(2) (2003). That didn't work. When examiners raised new grounds anyway, the Board was put in an untenable squeeze between its obligations under the substantive law and obligations under procedural law.⁵⁷

⁵⁴ IEEE-USA explained the error in a comment letter under Paperwork Reduction Act, https://www.uspto.gov/sites/default/files/news/fedreg/comments/0651-0031_IEEE_Comment.pdf section 6.6 at pages 43-46 (May 29, 2012). PTO did nothing, not even a response to comments to explain its inaction (as required by statute).

⁵⁵ *Hyatt v. U.S. Patent and Trademark Office*, Appeal No. 17-1722, <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/17-1722.Opinion.9-24-2018.pdf> (Sep. 24, 2018).

⁵⁶ I wrote an amicus brief on behalf of several inventor's organizations. *Hyatt v. U.S. Patent and Trademark Office*, Fed. Cir. appeal 17-1722, brief of amici U.S. Inventor et al (Nov. 21, 2018).

⁵⁷ E.g., *Ex parte Peppel*, <https://e-foia.uspto.gov/Foia/RetrievePdf?system=BPAI&fNm=fd982848> at 9, 1998 WL 1766687 at *4 (Mar. 13, 2000) (after a "late hit" rejection, "there is nothing that can be done.")

In 2004, PTO corrected by adopting 37 C.F.R. § 41.39(b): an examiner may raise a new ground in an examiner's answer, and the *appellant* has the choice to either reopen prosecution before the examiner or maintain the appeal for decision by the Board. Rule 39(b) fairly recognizes that examiners aren't perfect, and should be allowed to raise new grounds—but simultaneously recognizes that the whole reason for appeal is that the applicant believes the examiner isn't "getting it" and higher-level review is needed. When an examiner raises a new ground, a choice has to be made, between going back to the examiner or forward to the Board. PTO explained, twice, that the proper "chooser" is the appellant. 69 Fed.Reg. 49980, Answer 69; 76 Fed.Reg. 72286, Response 31. This, of course, makes perfect sense—remember, that new grounds are raised during appeal *only* if the examiner erred in putting forth less than the best rejections during "regulation time" prosecution, and fell below the "compact prosecution" obligations of 37 C.F.R. § 1.104(c).

But PTO, through MPEP § 1207.04, allows the examiner, "with approval from the supervisory patent examiner, [to] reopen prosecution to enter a new ground of rejection." PTO has never offered any explanation of public benefit for giving a conflicting choice to examiners. The choice allows examiners to short-circuit the appellants' access to the PTAB, effectively allowing the examiner to put the costs onto the appellant for the examiner's oversight during ordinary prosecution. Nonetheless, that's exactly what MPEP § 1207.04 provides. MPEP § 1207.04 removes a burden from the examiner and imposes the burden on the applicant. Imposing such a burden on the public is a clear-cut trigger for several rule-making procedural statutes (*e.g.*, the Paperwork Reduction Act, 44 U.S.C. § 3507(a)), none of which PTO followed.

Normally a late hit gets a 15-yard penalty. Remarkably, MPEP § 1207.04 rewards the examiner with a first down instead.

I am aware of two cases where an examiner reopened *five times*, before allowing the appeal to proceed to the Board—which then reversed.⁵⁸

Had PTO put MPEP § 1207.04 through notice-and-comment (as required by three things: the Paperwork Reduction Act, the fact that PTO is trying to amend § 41.39(b) which itself was promulgated by notice and comment, and by, I believe, § 2(b)(2)(B)⁵⁹), the public comments would have pointed out:

- The conflict with statute, which requires that the PTAB "shall review," and the conflict with *United States ex rel. Steinmetz v. Allen*, 192 U.S. 543, 565 (1904), in which the Supreme Court held that "It was the duty of the

⁵⁸ Several attorneys that gave me facts for this article asked me to keep their names and serial numbers confidential—for the sin of asking PTO to follow the law, the fear of retaliation by PTO is pervasive and palpable. I will confirm that that fear is well-founded; I've experienced it.

⁵⁹ See Boundy *Part 1*, note 39 *infra*, at 51-52. PTO stipulated to notice-and-comment in its moving papers in *Tafas v. Kappos* in 2009.

Commissioner to compel the appeal. [Inventors have certain rights at PTO.] The first of those rights is a hearing [on an applicant's appeal]. If that be denied other rights cannot accrue." One of the key benefits of notice and comment is that it helps the agency avoid promulgating illegal rules!

- The practical costs of MPEP § 1207.04. Appeal starts when costs are already high. One side or the other (or perhaps both) has stopped engaging with anything the other has to say. Putting the application back into prosecution before the same examiner is utterly absurd on its face, *even if* PTO had such legal authority.
- The inconsistency between MPEP § 1207.04 and PTO's obligations to "proceed to conclude a matter presented to it," 5 U.S.C. § 555(b), and the obligation to avoid bouncing a matter between various levels of intra-agency review.⁶⁰

And PTO wouldn't be caught in an impossible *Chenery* or *State Farm* "arbitrary and capricious" squeeze, trying to defend a rule for which the agency had offered no timely explanation.⁶¹ *Chenery* is the classic case holding that agencies may only defend themselves in court based on the explanations they gave when they took the action in the first place, and courts are not supposed to entertain *post hoc* rationalizations that weren't given at the proper time. *State Farm* is the classic case defining "arbitrary and capricious," and singling out failure to explain as a near *per se* ground for setting aside a rule. Together, *Chenery* and *State Farm* establish that the most fundamental right in administrative law is the right to a written explanation for agency action, at the time the agency acts⁶²—without that, all the

⁶⁰ *Deering-Milliken Inc. v. Johnston*, 295 F.2d 856, 865 (4th Cir. 1961); *McDonnell Douglas Corp. v. National Aeronautics and Space Admin.*, 895 F.Supp. 316, 319 (D.D.C. 1995) (condemning "second bites" and an agency's "never ending loops").

⁶¹ *Motor Vehicle Mfrs. Ass'n v. State Farm Mutual Auto. Ins. Co.*, 463 U.S. 29, 43, 48, 50 (1983) ("the agency must examine the relevant data and articulate a satisfactory explanation for its action including a 'rational connection between the facts found and the choice made,'" and agency action is "arbitrary and capricious" on essentially a *per se* basis if the agency failed that obligation to explain); *Burlington Truck Lines v. United States*, 371 U.S. 156, 168–69 (1962) (an agency decision can only be affirmed "on the same basis articulated in the order by the agency itself"); *SEC v. Chenery Corp.*, 318 U.S. 80, 93–95 (1943) ("an administrative order cannot be upheld unless the grounds upon which the agency acted in exercising its powers were those upon which its action can be sustained").

⁶² *Amerijet Int'l Inc. v. Pistole*, 753 F.3d 1343, 1350 (D.C. Cir. 2014) ("We have explained that a 'fundamental requirement of administrative law is that an agency set forth its reasons for decision; an agency's failure to do so constitutes arbitrary and capricious agency action.'"); *McHenry v. Bond*, 668 F.2d 1185, 1192 (11th Cir. 1982) ("The fundamental principle of reasoned explanation embodied in ... (agency) decisions serves at least three interrelated purposes: enabling the court to give proper review to the administrative determination; helping to keep the administrative agency within proper authority and discretion, as well as helping to avoid and prevent arbitrary, discriminatory, and irrational action by the agency; and informing the aggrieved person of the grounds of the administrative action so that he can plan his course of action (including the seeking of judicial review)."), *quoting Matlovich v.*

other rights are nugatory.⁶³ Lack of a cogent explanation *at the time the agency promulgates a rule* is probably the single most common reason for a court to set aside agency action.

PTO gave no such explanation—in fact, the PTO’s most recent statement in the Federal Register is a *refusal* to reconsider, and refusal to explain.⁶⁴ That’s illegal. Once an agency identifies the problem to be solved (in 2011, retailoring the appeal rules), it must address all suggested solutions to that problem. Artificially narrowing options under consideration is arbitrary and capricious *per se*.⁶⁵

Chenery captures an important bit of wisdom: “When you’re in a hole, stop digging.” PTO’s brief to the panel⁶⁶ argued a number of rationales for MPEP § 1207.04, which dug PTO even deeper into the hole of error:

- PTO argued that MPEP § 1207.04 stems from an examiner’s “inherent authority” to reconsider an earlier decision. But this inherent authority is a power of an *agency*, not of its individual employees. Individual agency employees have only the authority delegated by the agency’s validly-promulgated rules. The only validly-promulgated rule in the area is § 41.39(b)—the examiner may raise a new ground *in an examiner’s answer*, but not in an Office Action reopening prosecution.
- PTO argued that MPEP § 1207.04 is “consistent with the Patent Act.” Even if that were true (which it isn’t), it’s irrelevant—an agency can only issue rules “consistent with” its organic statute if the rule *also* “conform[s] with any procedural requirements imposed by Congress. . . . [to] ‘assure fairness and mature consideration of rules of general application.’” *Chrysler Corp. v. Brown*, 441 U.S. 281, 303 (1979). PTO didn’t.
- PTO argued that MPEP § 1207.04 is eligible for the “interpretive” or “procedural” exemptions from notice and comment. But even interpretive

Sec’y of the Air Force, 591 F.2d 852, 857 (D.C. Cir. 1978); *People of the State of Illinois v. U.S.*, 666 F.2d 1066, 1073 (7th Cir. 1981) (“The primary requirement of the ‘arbitrary and capricious’ standard of review is the ‘simple but fundamental rule of law’ that an ‘agency must set forth clearly the grounds on which it acted.’”), quoting *Atchison, Topeka & Santa Fe Ry. Co. v. Wichita Bd. of Trade*, 412 U.S. 800, 807 (1972).

⁶³ *Roelofs v. Secretary of Air Force*, 628 F.2d 594, 599–600 (D.C. Cir. 1980) (the APA embodies a “‘simple but fundamental’ requirement that an agency or official set forth its reasons, a requirement that is essential to ‘the integrity of the Administrative process,’ for it tends to require ‘the agency to focus on the values served by its decision, . . . hence releasing the clutch of unconscious preference and irrelevant prejudice.’”).

⁶⁴ Patent and Trademark Office, *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals*, Final Rule, 76 Fed.Reg. 72269, 72287, Response 58 (Nov. 22, 2011) (MPEP § 1207.04 is “outside the scope” of issues under consideration).

⁶⁵ *Pillai v. Civilian Aeronautics Board*, 485 F.2d 1018, 1027 (D.C. Cir.1973).

⁶⁶ *Hyatt v. PTO*, Appeal No. 2017-1722, Brief of Appellees PTO (paper no 15) (Jun. 12, 2017).

and procedural rules have preconditions and require some procedure. MPEP § 1207.04 didn't.

- PTO argues that MPEP § 1207.04 is a “general statement of policy”—and in the next breath argues that it should be enforceable. But “general statements of policy” have no binding effect whatsoever.⁶⁷ By this argument, PTO concedes the case.
- PTO argues advantages of MPEP § 1207.04 that accrue to itself, but never explains public benefit. This argument concedes that MPEP § 1207.04 violates the Paperwork Reduction Act. “The agency shall also seek to minimize the cost to itself of collecting, processing, and using the information, but shall not do so by means of shifting disproportionate costs or burdens onto the public.”⁶⁸
- PTO’s arguments ignore the fact that § 41.39(b) is not under challenge—if MPEP § 1207.04 is set aside, examiners will still have full power to raise new grounds *in an examiner’s answer*. The only issue is whether the appellant maintains the choice to proceed to the Board over that new ground.

E. Example 5: the PTAB’s Trial Practice Guide

The 2018 revision of the PTAB’s *Trial Practice Guide*⁶⁹ is an example of *appropriate* use of non-regulatory guidance. It contains two kinds of statements:

- direct quotations of regulatory text, and court interpretations of the Federal Rules of Evidence. An agency is permitted to (and indeed, encouraged to) consolidate this kind of information in a form most useful to the public, so long as the agency does not try to inject additional legal obligations (or grant itself carveouts) that are not reflected in underlying statutory or regulatory text.
- various non-binding, purely advisory lists of non-exclusive discretionary factors, non-binding expressions of “Board’s experience,” practical guidance, and the like. These are perfectly good “general statements of policy” exempted from rulemaking procedure by § 553(b)(A), but (as part of the *quid pro quo*) entirely unenforceable.

The original 2012 *Trial Practice Guide* was published in the Federal Register.⁷⁰ That was a good move.

⁶⁷ See note 25 *supra*.

⁶⁸ 5 C.F.R. § 1320.5(d)(1).

⁶⁹ Patent Trial and Appeal Board, *Trial Practice Guide*, https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf (August 2018), announced at Patent and Trademark Office, *Office Patent Trial Practice Guide*, August 2018 Update, Notice, 83 Fed. Reg. 39989 (Aug. 13, 2018).

⁷⁰ Patent and Trademark Office, *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48755 (Aug. 14, 2018).

In contrast, the 2018 *TPG*, presents a quibble: the August 2018 Federal Register notice is only a *notice* of publication, not an *incorporation by reference* as required by 5 U.S.C. § 552(a). But the 2018 *TPG* sets no binding standards, and so long as the PTAB doesn't rely on the *TPG* as if it *were* binding, no harm done.

VI. Conclusion and recommendations

The law is as it is to provide predictability and fairness for everyone—the agency *and* the public. By promulgating rules by guidance when statute requires rulemaking by regulation, PTO evades the introspection, analysis, and cost-benefit balancing at the core of Congress' laws and the President's direction. PTO neglects to consider the rule from the public's point of view, as several statutes and executive orders require, and ends up regulating in self-interest. The public has no notice-and-comment opportunity. PTO does not prepare, and the Office of Management and Budget does not review, required cost-benefit analyses. The public gets sandbagged with rules that pop out of nowhere with no meaningful notice, and sometimes no notice at all. Examiners benefit because they are permitted to do less work per compensation count. The agency benefits because it can exact more user fees for less time spent, and still more user fees for RCEs to correct its own errors. Do applicants or the public benefit? When PTO enacts rules by guidance, it provides no explanation of benefit to offset the costs of its rules, as would be required by the APA, Paperwork Reduction Act, and executive orders. In the case of the rules examined in this article, such public benefit probably doesn't exist. But the costs are very real, and very large.

The problem, of course, is a classic of regulatory economics: concentrated benefit (for PTO) and distributed harm (500,000 applicants). I've raised these issues with several senior PTO officials over the years—uniformly, the response has been “So sue me.” Who can afford six figures to sue over these kinds of issues for an individual patent application?⁷¹ God bless Gil Hyatt.

PTO's brief in the *Hyatt* case does not reassure the public that PTO has capacity to comply with the law that governs it. Rather than taking action against the very applicants that PTO is tasked with supporting, PTO should establish a compliance department, analogous to the compliance function in any private sector company. A compliance function requires two things: deep expertise in the relevant law, and sufficient power to ensure that the client operates within that law.

When an agency sidesteps these statutory obligations, the costs on the public can be **immense**. For an agency whose fundamental purpose is the economic health of the nation, that sidestepping and the concomitant costs are unconscionable. It's time for PTO's bad guidance practices to stop.

⁷¹ Prof. Anthony notes that the cost of court relief is a problem that pervades nonregulatory rulemaking across many agencies. Anthony, *Interpretive Rules*, note 42, 41 Duke L.J. at 1314 n.6, 1316-17.

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David Boundy is a partner at [Cambridge Technology Law](#). Mr. Boundy practices at the intersection of patent and administrative law, and consults with other firms on court and administrative agency proceedings, including PTAB trials and appeals. In 2007–09, Mr. Boundy led teams that successfully urged the Office of Management and Budget to [withhold approval](#) of the USPTO’s continuations, 5/25 claims, information disclosure statements, and [appeal](#) regulations under the Paperwork Reduction Act. In 2018, the Court of Appeals for the Federal Circuit asked Mr. Boundy to lead a panel of eminent administrative law academics and the President’s chief regulatory oversight officer in a program at the court’s Judicial Conference on administrative law issues. Judge Plager recommended Mr. Boundy’s papers published in ABA LANDSLIDE, [The PTAB is Not an Article III Court, Part 1](#), to the patent bar. He may be reached at DBoundy@CambridgeTechLaw.com.