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December 29, 2020

Via Email Nicholas_A_Fraser@omb.eop.gov

Nicholas A. Fraser
Office of Information and Regulatory Affairs
Office of Management and Budget
New Executive Office Building, Room 10202
725 17th St. NW
Washington D.C. 20503

Re: Control Number 0651-0031, ICR 202011-0651-001, *Patent Processing*, 60-day notice at 85 Fed. Reg. 60975 (Sep. 29, 2020), 30-day notice at 85 Fed. Reg. 76541 (Nov. 30, 2020)

Control Number 0651-0032, ICR 202011-0651-005, *Initial Patent Applications*, 60-day notice at 85 Fed. Reg. 60967 (Sep. 29, 2020), 30-day notice at 85 Fed. Reg. 76538 (Nov. 30, 2020)

Dear Mr. Frasier:

These two ICRs are too procedurally defective to receive your consideration, let alone your approval. If you decide to act on either despite the PTO's incomplete filing, several of the component collections of information should be disapproved. Together, unacknowledged burden in three ICRs before you (0651-0031, -0032, and -0056) approach **\$300 million per year**. Each burdensome collection of information has been raised in public comment letters during the rulemaking or prior comment periods. In a letter¹ I filed on November 30 during the 60-day notice on -0031 and -0032, I consolidated a number of comments from previous comment periods, comments that the PTO had not acted on or responded to. The PTO's Supporting Statements take no issue with any of the facts or estimates in the public comment letters, and

¹ My November 30 letter into the PTO's 60-day notice for 0651-0031 and -0032 is at <https://www.regulations.gov/contentStreamer?documentId=PTO-P-2020-0053-0004&attachmentNumber=1>, and I have filed it again as a comment letter in this 30-day comment period. This November 30 letter summarizes past comment letters from <https://www.uspto.gov/about-us/performance-and-planning/public-comments-setting-and-adjusting-patent-fees-0> and <https://www.uspto.gov/learning-and-resources/federal-register-notices/federal-register-notices-2016> and <https://www.uspto.gov/learning-and-resources/federal-register-notices/federal-register-notices-2012>.

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offer no offsetting justification. It certainly appears that the PTO is trying to sneak about \$300 million in burden past you, by simply not disclosing it to you in Supporting Statements. If these ICRs are approved, the approval should expressly state that certain collections of information for which approval was not requested are not within approved coverage.

The following collections of information should not be approved:

- In 0651-0032, despite having promulgated a regulation in August 2020, the PTO makes no disclosure to you of about **\$200 million per year** in new burden. Any approval of 0651-0032 should expressly state that no approval is given for the following:
 - 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 **100X** the PTO's estimated cost savings. It's a new collection of information for which the PTO has no existing approval. During NPRM comment period in fall 2019, this was *extremely* controversial, with many dozens of comment letters opposing, including from all three of the large trade associations, and one sign-on letter that got 73 signatures. Several of these comment letters are excerpted in my November 30 letter¹.at pages 3-25, and a more detailed discussion at Exhibits A, B, C, and D.
 - The PTO's Supporting Statement and ICR filing offer no dispute of this \$200 million burden estimate, and the 100-to-1 mismatch. In fact, the PTO's Supporting Statement does not include this as a collection of information for which approval is sought. Any approval of this ICR should expressly state that the § 1.16(u) DOCX collection of information is not approved.
 - Any approval for 0651-0032 should include a notation that preserves the status quo, "Approval does not include 37 C.F.R. § 1.16(u) and collection of patent applications in DOCX form. Only collections in PDF form are approved."
- In 0651-0031, the following new collections of information are not disclosed in the Supporting Statement, and have never been run through a § 3506(c)(2)(A) comment period. They are not now approved, and any approval of 0651-0031 should note that they are excluded:
 - The PTO has a number of guidance documents relating to Application Data Sheets, that raise requirements not stated in the relevant regulation, 37 C.F.R. § 1.79. *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> The burden of these here is multiple millions of

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dollars per year, as explained in my November 30 letter,¹ in Exhibit F, pages 35-36. The PTO does not dispute any of my facts or estimates, and the Supporting Statement does not seek clearance for these guidance documents. Any approval should be expressly limited to only collections of information specified by *regulation*, and does not extend to burden or collections of information raised in guidance documents relating to Application Data Sheets.

- In June 2020, the PTO revised an economically-significant guidance document, the Manual of Patent Examination Procedure (MPEP) § 706.07(b), without notice and comment, to create substantial burden, as explained in Exhibit E to my November 30 letter.¹ This new burden is not mentioned in the PTO's Supporting Statement. The PTO disputes none of the showings made in Exhibit E. Because the PTO does not request clearance, and does not dispute that this amendment to guidance creates several million dollars per year of unapproved burden, any approval should be expressly limited to the pre-June-2020 version of MPEP § 706.07(b).
- MPEP § 1207.04 purports to grant examiners authority to create substantial additional paperwork, without the procedural protections that favor patent applicants in 37 C.F.R. § 41.39(b). 37 C.F.R. § 41.39(b) has a prior ICR approval; MPEP § 1207.04 does not. This unwarranted burden is fully explained in my November 30 letter¹ at Exhibit F, at pages 38-42. In this ICR, the PTO requests approval for collections of information that flow from 37 C.F.R. § 41.39(b), but not for the additional burden imposed by MPEP § 1207.04, and does not dispute the showings I made in my 60-day letter. If 0651-0031 is approved, approval should carve out any information collections pursuant to MPEP § 1207.04.
- MPEP § 2144.03(C) places a burden on an applicant to make specific showings, on issues where the burden of proof is on the examiner. Showings requested by MPEP § 2144.03(C) require an applicant to prove a negative, which of course is extraordinarily burdensome. This guidance provision is inconsistent with the operative regulation, 37 C.F.R. § 1.104(d)(2), which accurately states the burden of proof, and permits an applicant to deal with the relevant issue by simply "calling for" evidence. MPEP § 2144.03(C) is inconsistent with law, and has never been properly cleared. This unwarranted burden is fully explained in my November 30 letter at Exhibit F, at pages 26-38. The PTO's ICR submission offers no rebuttal, and the Supporting Statement doesn't mention MPEP § 2144.03(C) as part of the request. Since the issue is not disputed, any approval should carve out all information collections pursuant to MPEP § 2144.03(C).

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- Any approval for 0651-0031 and -0032 should include reservations that preserve the status quo for the following:
 - ⇒ Information collections pursuant to MPEP § 706.07(b) are only approved for the January 2018 edition of MPEP § 706.07(b); the June 2020 edition is not approved.
- Any approval for 0651-0031 should include reservations that reflect the PTO's choice not to defend the status quo for the following:
 - ⇒ Approval does not include collections of information for Application Data Sheets under 37 C.F.R. § 1.79 above those stated in the text of the regulation. Additional collections of information stated in guidance, for example requirements for ordering of priority claims, are not approved.
 - ⇒ Approval does not include collections of information pursuant to MPEP § 1207.04. Only collections pursuant to 37 C.F.R. § 41.39(b) are approved.
 - ⇒ Approval does not include collections of information pursuant to MPEP § 2144.03(C). For traversals of Official notice, only information collections pursuant to 37 C.F.R. § 1.104(d)(2) are approved.

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, *Agency Bad Guidance Practices at the Patent and Trademark Office: a Billion Dollar Problem*, 2018 Patently-O Patent Law Journal 20 (December 6, 2018), attached as Exhibit E to my November 30 letter. The collections of information to be removed are listed above, but they're only the tip of a \$2 billion iceberg. OMB should insist that the PTO take Executive Orders 13891, 13771, 12866, the Paperwork Reduction Act, rulemaking, reduction of paperwork burden, and the like, seriously.

One example of unaccounted and large burden—the 37 C.F.R. § 1.16(u) and the DOCX rule

Though there are a number of defects in these three submissions, for this letter, I will focus on one, which knowledgeable members of the public estimate at **\$200 million per year**. The reason I am focusing on this one is that it raises a strong inference that the PTO is serially and intentionally attempting to gain approval by misleading you.

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In an NPRM of July 2019,² the PTO proposed to require that patent applications be filed in Microsoft Word DOCX format instead of Adobe PDF form. PDF applications are to be subject to a \$400-per-filing penalty. The NPRM estimated savings for the agency of \$3.15 per filing, and estimated burden on the public \$ 0. The NPRM did not ask the four questions required by 44 U.S.C. § 3506(c)(2)(A) and 5 C.F.R. § 1320.8(d)(1).

Many of the public comment letters³ explained that the burden would be large, because a patent application must be very precise, where, in contrast, DOCX files do not render consistently from one computer to the next. That's why all filing systems at all federal courts and all other federal agencies, and all other international patent offices, use PDF as their filing format—"P" stands for "portable," because PDF is designed to ensure that all computers treat PDF documents the same. In contrast, DOCX is designed to adapt to the computer it runs on—inconsistency from computer to computer is a designed-in feature. The public comment letters noted the immense costs of error-checking before filing, and error-correction after filing when the PTO's computers interpret a DOCX file differently than the applicant's computer, so that the error can be corrected by immediate re-filing.

The NPRM claimed that the PTO had already filed for and obtained ICR approval for changing from PDF to DOCX. The public comment letters pointed out that no clearance request or approval was visible at OMB's web site. A year later, no such filing or approval is visible—this appears to be a brazen falsehood by the PTO.

The PTO's final rule notice did not answer the comments. Instead, the PTO paraphrased the comments into softball parodies of the comments, and answered only the parodies. The PTO maintained its claim that the PTO had obtained clearance for the collection of information, though without identifying any ICR filing that would have covered it.

The comment letters to the PTO during the 60-day comment period reiterated the same comments. My letter listed the various components of burden for the DOCX change, and estimated the total at about \$200 million per year.

Bradley Forrest, the Chairman and General Counsel of one of the larger patent law firms in the country, filed an affidavit which likewise estimates burden at about \$200 million per year

² Patent and Trademark Office, *Setting and Adjusting Patent Fees During Fiscal Year 2020*, Notice of Proposed Rulemaking, 84 Fed. Reg. 37398 (Jul. 31, 2019).

³ The letters are at <https://www.uspto.gov/about-us/performance-and-planning/public-comments-setting-and-adjusting-patent-fees-0>. Relevant excerpts from the public comment letters are in my November 30 letter (see footnote 1), Exhibit C, and several blog articles are in Exhibit D.

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(originally Exhibit A to my November 30 letter, now attached as Attachment A to this letter). Mr. Forrest asked his firm's malpractice carrier about various risks involved; his affidavit states:

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.

If others reach the same conclusion as Mr. Forrest, then for almost all of 500,000 patent applications filed per year, the public will pay an extra \$400 each in order to avoid the paperwork burden of § 1.16(u). This affidavit was provided to the PTO during the 60-day notice; the PTO's ICR filing does not disagree.

Procedural defects

These three ICRs should be disapproved and returned to be resubmitted, because of procedural defects. The facts will support an inference that something is badly rotten at the PTO's Office of General Counsel, and that something more than routine disapprove-for-resubmit is required.

1. The PTO actively disregarded public comments. The PTO's submission to you represents to you that only one comment letters were received during the 60-day notice. This is a falsehood. There were two. The comments page⁴ for 0651-0032 shows two comment letters received:

Docket ID: PTO-P-2020-0050 **Agency:** Patent and Trademark Office (PTO)
Parent Agency: Department of Commerce (DOC)


Summary:
The United States Patent and Trademark Office (USPTO), in accordance with the Paperwork Reduction Act of 1995, invites comments on the extension and revision of an existing information collection: 0651-0032 (*Initial Patent Applications*). The purpose of this notice is to allow 60 days for public comment preceding submission of the information collection to OMB.

⁴ <https://www.regulations.gov/docket?D=PTO-P-2020-0050>

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Control Number 0651-0032, ICR 202011-0651-005, *Initial Patent Applications*, 60-day notice at 85 Fed. Reg. 60967 (Sep. 29, 2020), 30-day notice at 85 Fed. Reg. 76538 (Nov. 30, 2020)


Comments
View All (2)



I am a practicing patent attorney. A particular issue that frequently arises with USPTO approved forms is that they fail to embed fonts such that the form..."

[View Comment](#) **Submitter Name:** Steven Hoffberg **Posted:** 12/01/2020
ID: PTO-P-2020-0050-0003



See attachment" 

[View Comment](#) **Submitter Name:** David Boundy **Posted:** 12/01/2020
ID: PTO-P-2020-0050-0004

But the PTO's upload at [reginfo.gov](https://www.reginfo.gov)⁵ included only one:

ICR Documents							
Supporting Statement A							
Document		Date Uploaded					
0651-0032 Supporting Statement final.docx		11/30/2020					
Supporting Statement B							
Document		Date Uploaded					
Supplementary Documents							
Title	Document	Document Type	Date Uploaded				
USPTO Information Quality Guidelines	USPTO Information Quality Guidelines.pdf	Supplementary Document	03/11/2020				
Leahy-Smith America Invents Act (AIA), Public Law 112-29 § 32 (2011)	Leahy-Smith America Invents Act (AIA), Public Law 112-29 § 32 (2011).pdf	Supplementary Document	04/30/2020				
Public Comments							
Author Name	Comment Document	Author Affiliation	Sponsoring Org.	Type	Category	Date of Comment	Date Comment Received
Hoffberg, Steven	comment 0032.docx	Hoffberg & Associates		Other -- regulations.gov	Simple	10/22/2020	11/22/2020
Blank fields in records indicate information that was not collected or not collected electronically prior to July 2006.							

The omitted letter is the one that most specifically discusses \$200 million of burden that the PTO never ran through proper notice and comment. And this \$200 million is not mentioned in the November 30 Supporting Statement. 28 days later, the PTO has not corrected its filing at OMB. OMB would be well-justified in concluding that the PTO's omission of material information is intentional.

⁵ https://www.reginfo.gov/public/do/PRAViewDocument?ref_nbr=202011-0651-006

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Control Number 0651-0032, ICR 202011-0651-005, *Initial Patent Applications*, 60-day notice at 85 Fed. Reg. 60967 (Sep. 29, 2020), 30-day notice at 85 Fed. Reg. 76538 (Nov. 30, 2020)

2. False representation of previous clearance. In the NPRM, the PTO represented that it had already obtained clearance for the DOCX collection of information (84 Fed. Reg. 37398):

U.S.C. 3501–3549). The collection of information involved in this proposed rule has been reviewed and previously approved by 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.

Public comment letters pointed out that this could not be true.⁶ The only two Control Numbers where this DOCX collection of information would have been “reviewed and approved” are 0651-0031 and -0032, and neither had a relevant filing in the relevant time period:⁷

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

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), at page 12.

⁷ 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).

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Control Number 0651-0032, ICR 202011-0651-005, *Initial Patent Applications*, 60-day notice at 85 Fed. Reg. 60967 (Sep. 29, 2020), 30-day notice at 85 Fed. Reg. 76538 (Nov. 30, 2020)

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

Nonetheless, the Final Rule Notice continued to assert that the DOCX collection of information had been approved (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.

Everybody makes errors by accident. But when the error is pointed out, honest people correct it. The Patent Office doubles down on the falsehood. OMB would be well-justified in concluding that this false representation is intentional.

3. Falsified certification of “appropriate information technology.” The PTO certified as follows:

(j) It makes appropriate use of information technology.

This is false. Several dozen comment letters pointed out that the PTO’s understanding of basic technological concepts is just dead wrong, and why DOCX is *inappropriate* use of information technology. See Exhibit C to my November 30 letter.¹ The PTO did not respond to these comments. Instead, the PTO misparaphrased the relevant comments in order to avoid answering them fairly.

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4. Falsified certification of “necessary.” The PTO’s certification⁸ for this ICR states:

☒ (a) It is necessary for the proper performance of agency functions.

This certification is false as to DOCX filing under § 1.16(u). The PTO has accepted PDF documents for 15 years. All other world patent offices that accept electronic filing accept PDF (because the document is known to be consistent on all computers), none accept DOCX. The public comment letters during NPRM comment phased informed the PTO of these facts. The PTO is well aware that DOCX filing is not “necessary to agency function.” The basis for the PTO’s false certification here is unknown, unless the non-inclusion of § 1.16(u) in the PTO’s Supporting Statement was intentional

5. Falsified certification of “consistent with current reporting and recordkeeping.”
The PTO’s certification continues:

☒ (e) Its implementation will be consistent and compatible with current reporting and recordkeeping practices;

This certification is false, at least as to DOCX filing under § 1.16(u). The public comment letters pointed out that patent attorneys treat DOCX as working documents, and PDFs as archival. All other world patent offices accept PDFs, none (that I was able to find) accept DOCX, so the U.S. Patent Office is asking for “reporting and recordkeeping” that’s out of step with all other offices. A DOCX has no guarantee that it will appear consistently to readers over the many-year life of a patent application. The public comment letters pointed out that recordkeeping would be essentially impossible if DOCX became the PTO’s required filing format.

6. Falsified representation of incremental burden. The Supporting Statement represents to you that there’s no increase in burden per response over the last three years. If DOCX filing under § 1.16(u) is not covered by the Supporting Statement, then the sentence is plausibly true. If the PTO intends to gain coverage for DOCX filing under § 1.16(u), then the PTO’s Supporting Statement is false. The public comments explained that the increased burden per response burden is about \$400 each, or \$200 million annually.

Conclusion

The PTO has fallen into a pattern of evasive responses to comments, ignoring laws that require cost-benefit balancing, non-recognition of new burden in its information collection requests, and falsified certifications in its ICR and executive order submissions. The PTO is fully funded by user fees, and its senior executives are eligible for substantial bonuses. 35

⁸ https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=202011-0651-006

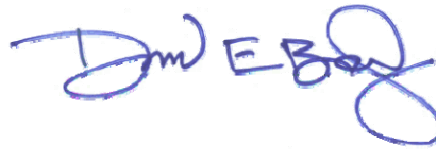
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U.S.C. §§ 3(b), 42. OMB would be well-justified in concluding that, because of these economic incentives, PTO senior career staff have adopted a policy of telling truthfulness, the law, and OMB's oversight to go to hell if any of them get in the way of those fees. OMB would be well-justified in concluding that the PTO regards OMB as a mere nuisance, to be fooled, deceived, or disregarded. The PTO should be informed that it's subject to the same laws as any other agency. ICRs submitted with falsified certifications should be declined.

ICRs for control numbers 0651-0031 and -0032 should not be approved. If either is approved, approval should include the carve-outs noted at the beginning of this letter.

Very truly yours,



Attachment A Affidavit of Bradley Forrest

Attachment 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*