

Author Full Name : Peter Nichols**Received Date :** 12/30/2020 11:15 AM**Comments Received :**

37 C.F.R. § 1.16(u), to go into effect in January 2022, imposes a \$400 surcharge for filing a patent application in PDF format, which is an effort to actively force US Patent Office (USPTO) users to file their patent applications as a Microsoft Word DOCX document. Our firm files nearly 1,000 patent applications per year and of those, nearly all are filed in the PDF format. This rule will create an immense unwarranted burden on our firm's practitioners and the public, and should not be approved.

One problem with the Microsoft Word DOCX document is that there is no uniform, reproducible way to render a DOCX into a final document. Every computer does something different with a DOCX. The USPTO proposes that applicants file a DOCX patent application and the USPTO will convert that DOCX file to a PDF file on their computers. But, the USPTO does not and cannot guarantee that the PDF they generate on their computer will look anything like the PDF we generate on our computers. In fact, our experience shows that when the USPTO converts our DOCX file to a PDF file, there are errors. Some of these errors appear in mathematical formulas, chemical formulas, and chemical structures. Our experience shows that the likelihood of error when the USPTO converts our DOCX file to a PDF file is unacceptably high.

Because of these errors, each patent application must be painstakingly reviewed after it has been uploaded to the USPTO servers and then corrective action must be taken. That corrective action requires either generating our own PDF (which will result in a \$400 surcharge) or attempting to recreate another DOCX file, uploading that file, and then reviewing the newly uploaded file (again). You can appreciate that the time (and thus the cost) of performing these corrective actions will substantially increase the cost of patent applications.

Moreover, I believe that because of the burden imposed on practitioners to review the uploaded patent applications, will lead many practitioners to simply pay the \$400 surcharge for filing their patent applications in PDF format. This additional cost will likely be passed on to the "public".

For both reasons of unjustifiably large burden and additional costs to the public, the USPTO's DOCX proposal should not be approved.