RE: Public Comment
Agency: United States Patent and Trademark Office, Department of Commerce.
Title: Initial Patent Applications.
OMB Control Number: 0651-0032.

The Patent and Trademark Office has failed to account for the monetary cost and time burdens imposed by its proposed changes to electronic filing requirements for initial patent filings with respect to two items: 1) the "PatentCenter" replacement to EFS, and 2) docx filing.

1) PatentCenter:

The Patent Office imposes a penalty for not filing a patent application electronically. The Patent Office is changing its electronic filing system from EFS to PatentCenter. The PatentCenter platform has not performed well in beta testing and the Patent Office has not been responsive to user concerns. (see a descriptive example at: https://blog.oppedahl.com/?p=6548 or a user-compiled list of problems at: https://patentcenter-tickets.oppedahl.com/). If the Patent Office continues to implement the filing changes without addressing the many technical problems, then the proposed switch to PatentCenter filing is likely to impose very significant burdens on members of the public and the attorneys representing patent applicants. Improvements to electronic infrastructure are needed, as shown by the outage in 2018 that lasted more than a week, but the Patent Office must follow appropriate procedures and be accountable for providing a system with equivalent functionality to the existing one, before requiring the public to use the new system.

2) DOCX Filing penalty:

The Patent Office proposes under 37 C.F.R. § 1.16(u) to impose a $400 penalty for filing a patent application in PDF form rather than DOCX format; this creates an unwarranted burden on the public, and should not be approved.

The attorney or applicant may not have an editable copy of a previously-filed application that they now want to use as the basis for a new divisional or continuation application. Patent ownership and representation may change during prosecution. Requiring applicants to generate a DOCX version may be extremely burdensome. Modifying a document by optical character recognition processing could compromise the underlying document.

The proposed docx filing surcharge is unreasonably high. Applying a $400 surcharge for non-DOCX filing is punitive. It is not intended to recoup costs, it is meant to penalize users whose software or procedures do not align with the Office's current preferences. This surcharge imposes a 20% increase in the cost of filing a patent application. Together with the recent (2020) increases in the basic filing fee, the search fee, and the examination fee, the USPTO is effectively proposing an increase of nearly 30% for applicants who file new applications in the same manner as they did a year ago. Even large corporations with robust IP funding will find a 30% increase hard to reconcile with their budgets. Small businesses

already have difficulty with the upfront patent costs, and a 30% increase may be prohibitive for some.

Requiring DOCX format would essentially be requiring the use of proprietary software made by one company. The USPTO is essentially requiring all practitioners to use Microsoft and Adobe products. While other software has some compatibility with the proprietary formats, the USPTO has used features that require advanced pdf functionality and, presumably, will do the same for docx format. In doing this, the USPTO is fostering a monopoly.

The undiscounted shelf price for a current professional version of Adobe Acrobat is more than $400 per device, likewise, the shelf price for a current professional version of Microsoft Office is more than $400 per device. Thus, when considering that practitioners and their support staff would all need the software, the price can be considerable. This will mean that law firms will not purchase alternative products, further strengthening the dominant position of these specific software companies. It is anti-competitive and it is also a burden for applicants. This is an unreasonable imposition and against public policy.

Another significant concern is that changing formats can introduce errors. For example, formulas and scientific symbols can be inadvertently changed into nonsense characters which could cause errors, confusion, and undue expense. This change would be likely to cause increases in malpractice insurance for attorneys. Additional errors would impose time burdens to make corrections and make the patenting process more expensive.

An additional concern is that docx files usually contain metadata. It is not unlikely that mistakes would be made, by either the USPTO or practitioners, revealing metadata that could include things like revision history, hidden text, and privileged communication between client and practitioner. This raises privacy concerns, privilege issues, and a whole new area for litigators to exploit.

Requiring DOCX format imposes an unreasonable cost burden, increases time burden, and is against public policy. The change should not be approved.

Sincerely,

D.S.

12/30/20