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Comments Received :

The requirement of 37 C.F.R. § 1.16(u), a $400 surcharge for filing a patent application in PDF form rather than DOCX, creates unwarranted burden on the public, and should not be approved. The PTO claims that its cost savings are $3.15 per application. The consensus estimate among attorneys I know is that the costs of pre-filing error correction, post-filing error correction, loss of patent validity, and increase in malpractice costs will be much greater than $400 per patent application filed. Several of us have asked our malpractice carriers about the error risk that the PTO proposes to impose, and they have advised that they will likely not be able to cover claims that arise from filing patent applications in DOCX form.

The USPTO, however, is attempting to impose a significant penalty for any application that is not filed in DOCX format. While documents in DOCX format, e.g., as Microsoft Word files, are generally sufficient for a variety of business and commercial purposes, the DOCX format is not acceptable as the legally recognized version for patent applications which often require the use of scientific, mathematical, and other technical symbols and notations throughout. This is because the "conversion" of such symbols and notations is inconsistent and varies across different user computer platforms and software.

The proposed DOCX format for patent applications does not account for variations in how different software programs handle other features that must be embedded within the disclosure of a patent application such as chemical structural formulas and complex mathematical expressions. One cannot be assured that a chemical structure will be correctly shown in a Word based document unless the same software used to generate the chemical structure is used unless the person who generated the Word document having the chemical structure is the one who converts the Word document into a PDF.

The time it would require me to review a patent application—character by character—to try to ensure that what is presented is exactly as it should be after the countless hours of back-and-forth review with an inventor, far exceeds the DOCX penalty fee. As such, I will be advising my clients that paying the DOCX penalty fee will be less expensive and less risky to the protection of their IP than filing in DOCX format. Therefore, I will have to recommend to them that if the DOCX penalty fee is implemented, they continue with having their applications filed in PDF format.

In view of the above and that set forth in the letter of Seventy Three Patent Practitioners (enclosed), the penalty for not filing patent applications in DOCX seems to me to be a rule to line the pockets of the USPTO without any benefit to the public. In light of the procedures that would be required to fix an error resulting from the DOCX format, it certainly will cause an increase in paperwork, not a decrease!. Additionally, because certain types of inventions, particularly those in the chemical and pharmaceutical arts, require the use of special software to generate and properly view certain information, the penalty unfairly and disproportionally impacts applicants of some industries more than those in others.

For at least these reasons, the USPTO's proposed DOCX penalty fee should be disapproved.