

December 30, 2020

At present, the preferred format for filing patent applications electronically is the PDF format. Filers generate their own pdf files, and can easily check these files for correctness prior to submission.

37 C.F.R. § 1.16(u), which is set to go into effect in January 2022, will impose a \$400 surcharge for electronically filing a patent application in any form other than Microsoft Word DOCX, which will at that time become the USPTO's preferred format for filing applications electronically. For reasons that will be explained briefly below – and that the PTO did not relate to at all in the rulemaking process, including in its comments thus far to OMB - this change will impose a tremendous burden on the community of patent filers, and should not be approved.

Ostensibly, the reason for the change in preference from pdf format to docx format is that the USPTO presently takes the pdf files that are submitted and converts them to a different format, which is not searchable by PTO personnel. This makes life more difficult for USPTO examiners and others working at the PTO than it would be if PTO personnel were provided with searchable documents. But the solution proffered by the PTO, viz. requiring submission in docx format (or ponying up \$400 for maintaining the privilege of filing in pdf format), is both unnecessary and burdensome. Notably, and ironically, according to the USPTO's proposal, patent applications filed in DOCX will *\*still\** be converted to PDF format. It's just that those documents will be converted by the PTO itself, into a pdf format that is searchable. In other words, the USPTO is proposing to penalize applicants for electronically filing applications in a form that is not only the currently preferred form, but also the form the USPTO will ultimately convert the applications into! It is hard to see the change in document filing preference with its penalty for noncompliance as anything more than a bare attempt to generate more fees.

I am licensed to practice before both the USPTO and the Israel Patent Office. In Israel, we submit *\*searchable\** pdf files, to allow patent examiners to look for key phrases in our patent applications, or to easily cut-and-paste parts of our applications when generating examination reports. There's no reason the USPTO can't do the same thing. The fact that the USPTO's present choice to take our pdf files and to convert them to an unsearchable format, creating more work for the USPTO, is neither our fault nor our problem, and a simpler solution than the one now being proposed by the PTO to the PTO's self-created "problem" is to simply ask us to submit searchable pdfs.

Another possibility is similar to that offered by the World Intellectual Property Organization (WIPO), which is a United Nations organization that oversees implementation of the Patent Cooperation Treaty (PCT), a treaty to which the USA is a signatory. US citizens may file applications under the PCT at either the USPTO or at the WIPO International Bureau (IB) in Geneva. Applicants who file at the IB submit documents in pdf format, but have the option of additionally submitting the same document in the format it was in prior to conversion to pdf, e.g. in the original MS Word format. That "pre-conversion" format is not available to the public, but can be relied upon by the applicant if there appears to be a mistake in the pdf file. In the case of the USPTO, a variation on this could easily be implemented: applicants could be allowed to submit their own pdfs, which would control, but to simultaneously submit a searchable pre-conversion version of such pdf files, i.e. files in docx format. This would provide the PTO examiner with the searchable text they desire, without compromising the integrity of the documents submitted by applicants (see next paragraph).

Further, the likelihood of the introduction of error during the process of converting docx to pdf is very high. Contrary to the PTO's assertion, there isn't a single docx format, there are multiple docx formats, so that each computer may do something different with a DOCX file, depending on how that docx file was created. There's no way that the USPTO can guarantee that the PDF they generate will look anything like the PDF applicants generate on their computers. The documents converted by the PTO from docx to pdf format will have to be carefully checked to ensure that no errors have been introduced during the conversion process. This would create immense unwarranted burden on the public even if it were possible to first convert the files using PTO software and to check those files off-line. But the way the USPTO's electronic filing system is configured, applicants will only be able to check those converted files online, during the filing process. If they are not quick enough, the system will boot them out. And such checks can only be performed manually, not automatically. This is just an intolerable burden, one that will require far more than \$400 of attorney time – and attorney exposure to liability – to carry out. Hence it's a certainty that persons practicing before the PTO will almost always pay the \$400 and submit their own pdf file, rather than risk allowing the PTO to convert a docx file to pdf format and thereby to introduce errors that the applicant does not have time or budget to ferret out.

In sum then, the proposed 37 C.F.R. § 1.16(u) proposes to solve a problem of the PTO's own making, in a manner that the PTO knows amounts to nothing more than a money grab.

I was one of 73 practitioners to sign on the letter that is found at [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). This letter sets forth many additional reasons why the proposed 37 C.F.R. § 1.16(u) should not be adopted, and includes examples of problems with conversion from docx to pdf format. While I mention this letter in the hope that the OMB will look at the letter, I also mention the letter because the PTO, in its proposed rulemaking, and in its comments to the OMB, did not relate to the points in this letter. In fact, the PTO even said in the Federal Register that no examples of problems with conversion were provided. Thus, throughout this process, the PTO has misled, and continues to mislead, the public and other Federal agencies.

For the foregoing reasons, the USPTO's DOCX proposal should be disapproved.

As long as I'm writing, I take this opportunity to relate to a few additional issues in how the USPTO operates. When making an initial patent filing, an applicant must file a document called an "application data sheet" (ADS). An ADS is just a way for the PTO to collect information about the application – the names, citizenships and contact information for the inventors; the identity and contact information of the applicant (if the applicant is not the inventor); information about the legal representative; address for service; and of course title of the application. The ADS also allows applicants to claim the benefit of earlier-filed US patent applications.

An applicant can make up his own ADS, for example using MS Word (which is then converted to pdf format prior to filing), or he can use a fillable pdf form that can be downloaded from the USPTO. The advantage of using the PTO's pdf ADS form is that the PTO's computer systems automatically scrape the data from the ADS and use it to populate the PTO's databases. This is a significant advantage over using one's own ADS, which the PTO's systems are not able to scrape for data and results in manual data entry at the PTO's end, which of course is subject to errors.

But there's a problem with the PTO's fillable ADS form, or rather in the PTO's computer systems: in the section of the ADS for claiming the benefit of earlier applications, one can only add a new application in the benefit chain at the \*end\* of the list, not at the beginning. So if, for example, my patent application has just been allowed, and I wish to file a continuation application to obtain protection for some aspect of the invention not covered in my just-allowed application, and I want to recycle the ADS I used in the just-allowed application, I can only add a line explaining that my new application is a continuation of the present application at the \*end\* of the list, viz. at the bottom. This is not *per se* a problem. But the PTO's computer systems are incapable of scraping the data about the chain of benefit of applications unless those applications are listed on the fillable ADS form in reverse chronological order. This means that unless I add the new entry at the beginning of the list, viz. at the top, the PTO won't recognize my benefit claims. This is illustrated below:

How the PTO's systems require the listing	What the PTO's fillable ADS allows
This new application claims the benefit of application no. 1237 filed on January 1, 2020, which claims the benefit of	Application no. 1237 claims the benefit of application no. 1236, filed January 1, 2019, which claims the benefit of
Application no. 1237, which claims the benefit of application no. 1236, filed January 1, 2019, which claims the benefit of	Application no. 1236, which claims the benefit of application no. 1235, filed January 1, 2018, which claims the benefit of
Application no. 1236, which claims the benefit of application no. 1235, filed January 1, 2018, which claims the benefit of	Application no. 1235, which claims the benefit of application no. 1234, filed January 1, 2017
Application no. 1235, which claims the benefit of application no. 1234, filed January 1, 2017	This new application claims the benefit of application no. 1237 filed on January 1, 2020

There is no CFR-published rule that states this. Indeed, the relevant Rule simply says that one needs to list all the applications from which benefit is claimed; it says nothing about the order of listing. Nevertheless, if the applications are not listed in reverse chronological order, the PTO's software will not recognize the benefit claims, and the applicant will be forced to file a new ADS. That itself creates additional work, since the follow-on ADS must have old information crossed out and new information underlined, and the PTO's fillable ADS does not facilitate such crossing-out and underlining.

Because of this, when filing continuation applications, experienced practitioners who use the PTO's fillable ADS will manually cut-and-paste the benefit information so that the newest application appears at the top of the list. That's a burden. But there is no reason why the PTO's software can't scrape that data and figure out the correct order – it's really not a tall order for software.

I also note that when filing electronically, applicants are first asked to manually input the title of the application, the name of the first inventor, and, if the application is what is called a national stage of a PCT application, the PCT application number and filing date, before they begin uploading the actual documents to be submitted, including the ADS. It sometimes happens that in that initial pre-upload stage, the PCT application number is entered incorrectly. When this happens, the Rules state that the information in the ADS controls. But the PTO ignores this rule, and will allow the manually-entered PCT number to control, even when there's a discrepancy with what's in the ADS. This can have negative

consequences not only for the applicant, but for the owner of the PCT application whose number was erroneously entered, since one can only enter the national phase once, and now the USPTO will regard that PCT applicant as having already entered the national phase in the US. There's no reason for the USPTO to ignore its own rules and burden the public in this way, but it does so nevertheless.

Finally, at present, the USPTO maintains separate electronic filing and electronic access systems. The former is called EFS and the latter is called PAIR. (PAIR itself is accessible in two forms, a public form, and private form; the latter contains information only visible to individuals, such as patent attorneys, who are associated with a given patent application.) The USPTO is in the process of switching to a new system, called "Patent Center", that is supposed to combine the functionalities of both EFS and PAIR in a single system. Patent Center is presently in beta testing, and many, many problems with Patent Center have been identified by users, yet it appears the PTO is uninterested and unwilling to listen to the public. Dozens of comments have been made by members of a listserv Patent Center, and yet almost none have been acted upon. As with the proposed docx rulemaking, this appears to be part of a pattern of the PTO trying to force sub-standard computer systems on the public. By comparison, WIPO has an integrated filing-and-access system called ePCT that works extremely well. The PTO could have adopted WIPO's system, but instead seems dead-set on developing its own inferior Patent Center system, and then forcing this inferior system on the public.

Another example of the PTO's cockamamie "solutions" to IT problems was its decision in November 2019 to deny access via private PAIR to applications with which a practitioner is not official associated. Until that time, a practitioner who was logged into private PAIR could see all the information associated with his own patent applications, and from within private PAIR could also see the same data available via public PAIR for applications with which he was not associated. This was reasonable: if, for example, a practitioner filed a continuation of an earlier application for which he himself was not responsible, he could still see information about that earlier application while logged into private PAIR, so that he could go back and forth between his own application and the earlier one. But in November 2019, the PTO cut off such access. Now, in that same situation, the practitioner will need to separately access public PAIR to access information about the earlier application. This is a small burden but a burden nevertheless. The rationale given for the change was that since private PAIR has fewer users, it runs faster than public PAIR, so some parties that agglomerate information and then repackage it for purchase were (ab)using private PAIR access to do their information collection. So rather than cut off private PAIR access for those parties, who could easily be identified by the PTO, the solution was to make life more difficult for everyone by completely severing public and private PAIR.

The docx proposal is thus just one of many instances of the PTO trying to solve problems of its own creation by imposing burdens on the public, rather than solving those problems at their root. The USPTO's DOCX proposal should be disapproved, and the other issues I've mentioned herein should be addressed as well.

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