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Comment On: PTO-P-2023-0031-0001
Agency Information Collection Activities; Proposals, Submissions, and Approvals: DOCX Submission
Requirements

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Comment by James Lake

Submitter Information

Name: James Lake
Address:
   601 W Riverside Ave, Suite 1500, WA, 99201
Email: jel@randalldanskin.com
Phone: 509-747-2052

General Comment

The USPTO proposal to mandate DOCX filing is fundamentally misguided in that it removes applicants' ability to control the accuracy of their specifications, claims, and abstracts. In any system of filing structured text, applicants must retain certainty in knowing that filed documents are accurate.

Applicants should not be penalized with increased fees for choosing to guarantee the accuracy of applications by filing a PDF as the official application generated under their own control. Instead, the USPTO should reduce fees for those who file an ISO 19005-1 compliant PDF/A document, which is fully text searchable and accessible. The USPTO should further reduce fees for those who, additional to their own PDF, file a DOCX version of the application with a certification of its accuracy. The supplemental DOCX file would provide the USPTO with their desired collection of information without jeopardizing the official application filed in PDF. No need exists for the USPTO to engage in the practice of DOCX to PDF conversion.

No reliable process exists wherein errors introduced by USPTO in its validation of DOCX files and in its rendering of DOCX files into PDF files may be corrected without being subject to the risk of the patent application being fatally rejected for adding impermissible new matter. Currently, the USPTO requires applicants to agree to accept the DOCX validation(s) as their final submission produced by the USPTO's unreliable and error-laden validation and conversion tool. In my personal experience, converting MS Word generated DOCX patent applications to PDF using the MS Word, Adobe Acrobat, or CutePDF conversion tools has never created an error. In contrast, attempted filings via USPTO systems from 2019 through April 2023 have always created an error in the resulting DOCX validation and PDF. Since then, I no longer attempt to use USPTO's unreliable and error-laden validation and conversion tool.

It is disingenuous for the Abstract of the Notice of Information Collection to state, "All applicants have been able to file applications in the DOCX format in the Patent Center since April 2020." Such filing has only been available for applicants willing to take the substantial risk that their filings will be inaccurate.

For these enumerated reasons, the Agency's estimate of the burden of the proposed collection of information is not accurate. The Agency does not account for the lost value of rejected or invalidated patents that might otherwise have been obtained, but for the USPTO's unreliable and error-laden validation and conversion tool.