



American Intellectual Property Law Association

October 27, 2023

Mr. Justin Isaac
Office of the Chief Administrative Officer
United States Patent and Trademark Office (USPTO)
P.O. Box 1450
Alexandria, VA 22313-1450

Via Federal eRulemaking Portal: <https://www.regulations.gov>

Re: Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; DOCX Submission Requirements

The American Intellectual Property Law Association (“AIPLA”) is pleased to have the opportunity to respond to a series of Federal Register Notices of Information Collection (NOIC) issued by the United States Patent and Trademark Office (“Office”). The Office originally issued a NOIC inviting comments on a proposed information collection concerning DOCX Submission Requirements. This Notice set a 60-day period for response ending August 7, 2023 (88 Fed. Reg. 37039 (June 6, 2023)) (“Original Notice”). The AIPLA submitted comments (dated August 7, 2023) in response to this Original Notice. On September 27, 2023, the Office extended the period of response for an additional 30 days (88 Fed. Reg. 66414 (September 27, 2023)) (“Notice”).¹

Founded in 1897, the American Intellectual Property Law Association is a national bar association of approximately 7,000 members including professionals engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

In our comments to the Original Notice, we noted that DOCX is a computer format that is specific to the Microsoft Corporation, and that DOCX is not a globally standardized format.^{2,3} We also continued to express our concerns that the actual financial burden on the public is substantially greater than what would be saved by the Office with DOCX implementation, and in addition, that the DOCX filing system lacked sufficient efficacy to address the rigid

¹ We note that the Office has also issued a Supporting Statement that will be submitted to the Office of Management and Budget (OMB) along with the information collected with this Notice for review and clearance in accordance with the Paperwork Reduction Act of 1995. The Supporting Statement responds to some of AIPLA’s comments on the Original Notice.

² See AIPLA’s August 7, 2023, Comments on the United States Patent and Trademark Office’s Federal Register Notice of Information Collection and Request for Comments Published in 88 Fed. Reg. 37039 (June 6, 2023), p. 6.

³ *Id.*

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disclosure requirements of patent applications. We maintain these positions as stated in our comments to the Original Notice. The Office, however, has made it clear that they are continuing with DOCX filing standards. The Office also continues to require an associated fee/penalty for not filing patent applications in the DOCX format.

Given the Office's position regarding DOCX and the concerns raised by AIPLA and others, the Office has considered a proposal to allow patent applicants to submit an applicant-generated and authored PDF document along with the DOCX filing. The Office, however, has not yet agreed to allow such a PDF to be considered the official and authoritative version of the patent application as intended by applicant.

Some anecdotal Office communications have indicated that they will permit corrections to a DOCX filing based on an applicant-generated and authored PDF using their petitions process. We are concerned, however, that such internal processes may not be legally sufficient for correction of computer-generated DOCX filings and that such corrections will not be legally acceptable both during and after patent prosecution. Further, we are concerned that other countries will not accept modifications to DOCX filings.

We are unaware of any law or rule that disallows the scenario where an applicant-generated PDF is authoritative, but the Office uses the DOCX file for internal process. The Office's reluctance to make the applicant-generated PDF a legally sufficient and authoritative document precludes a solution to the problem of errors in a DOCX file, and may also preclude patent protection in other countries, as we discussed in our comments on the Original Notice.⁴ We note that other organizations allow for filing of both pre-conversion DOCX and PDF copies of an applicant-generated application, both of which may be recognized as an official view of the application as-filed, which permits correction of any conversion errors later discovered.⁵

We also remain concerned that the Office's position will have a disproportionate effect on small and medium entities (SME) as well as independent and *pro se* patent applicants. In particular, we are concerned that the dominant use of DOCX, as explained in the Notice, will preclude these often under-resourced entities from full and effective participation in the patent system.

AIPLA appreciates the opportunity to provide feedback to the Office on the Notice and we look forward to continuing collaborative dialogue with the Office.

Sincerely,

A handwritten signature in blue ink that reads "Ann M. Mueting". The signature is written in a cursive, flowing style.

Ann M. Mueting
President
American Intellectual Property Law Association

⁴ *Id.* at pp. 6-7.

⁵ WIPO ePCT filing; Application Body Converter; PCT/WG/14/8.