

123 PATENT PROFESSIONALS

PTAAARMIGAN

PATENT AND TRADEMARK ATTORNEYS, AGENTS AND APPLICANTS FOR
RESTORATION AND MAINTENANCE OF INTEGRITY IN GOVERNMENT

October 27, 2023

Via regulations.gov and email

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Re: ICR 2202309-0651-002 (control number 0651-new), *DOCX Submission Requirements*,
30-day notice at 88 Fed. Reg. 66414 (Sep. 27, 2023)

Dear Dr. Mancini and Mr. Fraser:

This ICR seeks clearance for the PTO's buggy new software. The PTO proposes to displace a reliable, voluntary consensus standard that it currently accepts, and replace it with a single-company standard. The PTO proposes to create about \$200-600 million of annual burden for proofreading and error correction, in order to yield a savings to the agency of only about \$780,000 per year. OIRA should not clear burden created by the PTO's software bugs, and should not clear an information collection that shifts costs or burdens onto the public that are "disproportionate" by a ratio of over 200-to-1.

The PTO's computer system for filing patent applications is about 20 years old. It is comparatively reliable and more-or-less adequate, but could use some updating. (A more-detailed tutorial on the technology is given in the first few pages of our 60-day letter.) In 2015, the PTO commissioned a "yearlong study" that concluded that the update should do what every other agency and court does—collect information in PDF form (the industry-wide voluntary consensus standard for "portable document form" that guarantees stability across all computers for all time).¹ Instead, the PTO's engineers ignored the PTO's own study, and decided to collect information in DOCX form (Microsoft's proprietary format used in Microsoft Word[®] and that no

¹ American Environmental and Engineering Consultants (AEEC, LLC), *Text2PTO Proof of Concept White Paper Version 1.0* (24 Mar. 2015), as produced by USPTO under FOIA request F-21-00169 on January 13, 2023. The PTO's "yearlong study" is attached as Exhibit 1 to the 152 Practitioners letter from the 60-day comment period, <https://www.reginfo.gov/public/do/DownloadDocument?objectID=135639300> at pages 42-66, and discussed in that letter at pages 19-20.

other vendor implements with high reliability, that leaves many parameters variable and “implementation defined.”). Public comment letters have pointed out that DOCX *cannot* work reliably for this purpose—DOCX is not designed to ensure portability or reliability as a file moves from one computer to another, or over time, as Microsoft changes Word in unpredictable ways.² During the NPRM comment period, the public reported filings that failed because the PTO’s buggy software changed the document³—the PTO responded by claiming “The Office has not received notifications of any issues resulting from the filing of applications in DOCX format”⁴ Over the last three years, many more bugs have turned up and been reported to the PTO⁵. The Supporting Statement attempts to conceal the truth from OIRA, claiming “The USPTO has not experienced the issue raised by commenters.”⁶ While perhaps literally true, the PTO’s “experience” is irrelevant as a metric for software bugs in user-facing software. The PTO’s software is buggy and unreliable because the PTO made an unreliable choice in its initial design. Software built on an unreliable foundation is inherently unreliable. The bugs can’t get fixed because the PTO insists that it hasn’t “received notifications” or “experienced” the bugs for itself.

² The standard document itself states about 100 times that various features will vary implementation-to-implementation. We give a short list of such statements from the standards documents at page 17 of this letter, and a longer list in our NPRM letter in 2019. The ISO standard itself is attached as Exhibit 14.

³ Letter of Carl Oppedahl in response to 2019 NPRM, https://www.uspto.gov/sites/default/files/documents/Comment_Carl_Oppedahl_081219.pdf at pages 2-3. Another example of ordinary use of word processors mangling a DOCX document to the point of unuseability was given to the PTO in an NPRM letter, *Seventy-Three Patent Practitioners*, NPRM letter of Sept. 27, 2019, https://www.uspto.gov/sites/default/files/documents/Comment_Seventy_Three_Patent_Practitioners_092719.pdf contrast pages 1-34 against pages 48-81, attached as Exhibit 11 to our 60-day letter, note 1, *supra* (PDF pages 215-219).

⁴ This claim was stated five times in the final rule. Patent and Trademark Office, *Setting and Adjusting Patent Fees During Fiscal Year 2020, Final Rule*, 85 Fed. Reg. 46932, 46956, col. 2; 46957, col. 2; 46958 col. 1 and 3; 46959, col. 1 (Aug 3, 2020). This was simply a falsehood. Examples were presented in the NPRM comments—for examples listed in note 3.

⁵ The 60-day comment letters listed a number of bugs: 152 Patent Practitioners (note 1 *supra*) at page 6 and Exhibits 2, 3, and 4 (PDF pages 6, 67-94), American Intellectual Property Law Association (AIPLA), <https://www.reginfo.gov/public/do/DownloadDocument?objectID=135639500> at pages 25, 27, 29-37, 51, 58, 60; 60-day letter of Kilpatrick Townsend & Stockton LLP, <https://www.reginfo.gov/public/do/DownloadDocument?objectID=135640600> at page 2 n. 4.

⁶ Supporting Statement, Response 7 (at page 10); see also Response 5 (at page 9), discussed in this letter in the text above footnote

In recent examples⁷, the PTO’s DOCX system gave a hard error message and refused to accept a patent application with this equation:

$$w_t = \sum_1^n x \frac{L_n}{F_n}$$

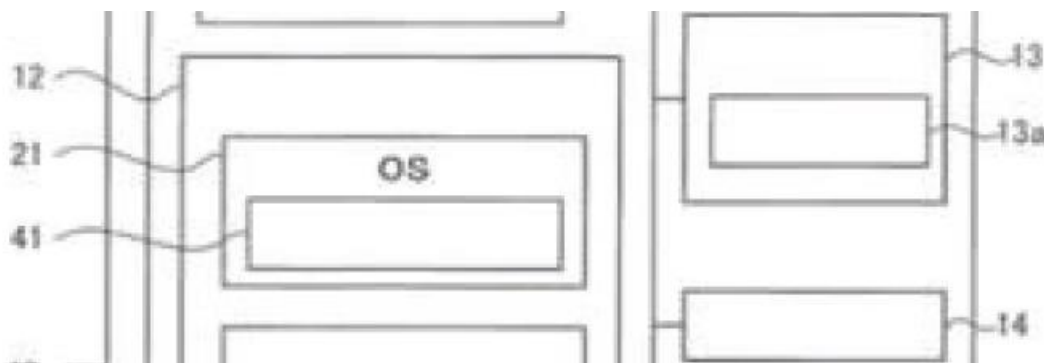
The PTO’s software mangled equations of another:

[0002] □□□□□(□□)

[0003] □□_PUSCH,□□□□(j)

[0004] □□□□□(j)

and blanked out the text in the drawings of a third:



The PTO’s DOCX software refuses to accept routine Word documents that use “standard” features of Word.⁸

Notably, in this ICR, the Supporting Statement admits that the proposed DOCX rule for which the PTO seeks clearance will create annual burden of ***over \$100 million simply for “adjusting the existing ways to comply with any previously applicable instructions and requirements,”*** 5 C.F.R. § 1320.3(b)(1)(5)) as the public “become[s] more familiar with the” PTO’s unreliable new software, and “submission of the back-up applicant-generated PDF that some respondents will opt to submit” as a duplicative PDF submission to compensate for the PTO’s bugs in processing the DOCX submission, during a trial period.⁹ The ***PTO does not seek***

⁷ 60-day letter of 152 Patent Practitioners (note 1 *supra*) at page 6 and Exhibits 2 and 3 (PDF pages 6, 67-82); see additional examples noted at note 5.

⁸ 60-day letter of 152 Patent Practitioners (note 1 *supra*) at Exhibit 4 (PDF pages 83-94)

⁹ The Supporting Statement characterizes the scope of the clearance quite differently than the 60-day notice (88 Fed. Reg. 37039). If the PTO seeks clearance of the scope stated in the Supporting Statement, the PTO must run a new 60-day notice. This is explained in more detail in § II starting at page 14 of this letter.

an amendment to 0651-0032 for additional “completing and reviewing” burden of the information collection itself. Likewise, the PTO offers *no “record supporting”* any disagreement with the public’s estimate that “completing and reviewing” burden is between \$200 million and \$600 million per year.¹⁰ Nor does the Supporting Statement dispute the public’s showings of substantial malpractice risk that the PTO’s unreliable approach will shift onto the public.¹¹

The facts are essentially undisputed—indeed, most are set out in the very documents the Supporting Statement purports to rely on (the standards definition), *but never quotes or cites*. The PTO has never disagreed with the public’s cites from the standards documents and third-party article (and with respect to the PTO’s own 2015 “study,” documents the PTO affirmatively hid). Instead, the Supporting Statement ignores the data, and relies on naked assertion contrary to those documents. The Supporting Statement avoids responding to many of the 60-day comments by, for example, misparaphrasing the comments instead of addressing them. All along, the PTO’s claim has been that it would recognize savings of \$3.15 per patent application—about \$780,000 per year, and the Supporting Statement offers no other estimate here. Even using the PTO’s underestimation of the burden (at \$102 million), the burden is disproportionate by a ratio of **130 to one**. As the public comment letters noted, the PTO’s *own documents* explain that DOCX is *nearly guaranteed* to introduce faulty changes to documents—by silence, the Supporting Statement concedes that point. Moreover, public comments estimated burden of that unpredictability and variability and consequent proofreading at **\$200 million to \$600 million**, with specific examples and extensive analytical support¹²—the PTO does not dispute that, either.

Resolving the difference between the PTO’s estimate of a one-time cost of \$100 million and the public’s estimates of \$200 to \$600 million *annually* is simple. The public comments estimate the day-to-day costs of “completing and reviewing” once the rule is fully implemented. 44 U.S.C. § 3502(2)(E). In contrast, in this ICR, the PTO’s 60-day notice identifies and seeks clearance *only for the short-term burden of “adjusting existing ways to comply.”* 44 U.S.C.

¹⁰ Four different commenters offered numerical estimates, all coming in at \$200 million to \$600 million per year. Affidavit of Bradley Forrest, attached as Exhibit 6 to 60-day letter of 152 Practitioners (note 1 *supra*), Exhibit 6 (PDF pages 99-107) (estimating at \$200 million annually); David Boundy’s estimate from November 2020, Exhibit 7 to 60-day letter of 152 Practitioners (note 1 *supra*), and Exhibit 7, pages 3-5 (PDF pages 111-113) (estimate of \$200 million annually); 60-day letter of 107 Practitioners, <https://www.reginfo.gov/public/do/DownloadDocument?objectID=135640900>, at 6-10 (estimating burden at \$600 million per year, on the *ceteris paribus* assumption that applicants will seek the same reliability as PDF); 60-day letter of Kilpatrick Townsend & Stockton LLP, note 5, *supra*, at pages 2-3 (estimating burden at about \$600 million).

¹¹ 60-day letter of AIPLA (note 5, *supra*), at pages 25, 39, 48, 52, 68; 60-day letter of 152 Practitioners (note 1 *supra*), at pages 99-107; 60-day letter of 107 Practitioners, note 10, *supra*, at pages 4-5.

¹² See letters cited in footnote 10

§ 3502(2)(C).¹³ The PTO *seeks no clearance for the “completing and reviewing” burden of the underlying information collection*.¹⁴ The two burden estimates are *additive*, not alternative—over \$300 to \$700 million in the first year, and \$200 to \$600 million/yr. thereafter. The PTO is playing games with the facts in order to cover up its own failings and obtain approval, as explained in more detail in § II starting at page 14 of this letter.

The PTO will suffer no prejudice if this ICR is denied: the PTO has had a perfectly workable system in place for nearly 20 years, and it will continue to work for many more. Implementation of DOCX has already been delayed 3½ years past the final rule. The PTO does not dispute our showing that there is an alternative that is *better* for the PTO and *better* for the public: the same text-based PDF that the courts use. Any prejudice that does arise is entirely the product of the PTO’s multi-year history of falsehood, evasion, and misinformation of its obligations to OIRA, which we document in §§ IV.A and IV.B starting at page 22 of this letter. Procedural rules and process matter. The nine-figure burden of the PTO’s pattern of shortcutting should fall on the PTO, not on the public.

We suggest reading our 60-day letter of 152 Patent Practitioners first, at least the first 12 pages. Our 60-day letter is written to set context and provide a technology tutorial. This letter is largely a rebuttal to new assertions and changes of position the PTO states for the first time in the Supporting Statement.

In summary:

- An information collection that “shifts costs to the public” in a ratio of over **200 to one** is not approvable.
- An information collection that displaces a voluntary consensus standard (today’s PDF) in favor of a single-vendor captive standard (the PTO’s proposed DOCX) is not approvable.
- An ICR that requests clearance only for “adjusting existing ways” (§ 3502(2)(C)) and ignores “completing and reviewing” burden (§ 3502(2)(E)) is not approvable.
- An ICR that calls for duplicative collection to give the public a costly way to correct agency error in the agency’s mis-processing one of the two collections is not approvable.
- An ICR that estimates burden based on a temporary waiver of part of the burden of the information collection is not approvable.

¹³ The inconsistency between the 60-day notice and Supporting Statement is discussed in note 9, *supra*.

¹⁴ This anomaly in the PTO’s request for clearance is explained in § II starting at page 14 of this letter.

- An ICR that concedes that the PTO is not booking all the burden it admits is not approvable.¹⁵
- An ICR that understates true burden by a factor of three—with no objective supporting record, and no more than two non-experts’ guesses pulled out of thin air¹⁶—is not approvable.

The PTO’s rationale is complete fiction, as described in § III starting at page 16. The PTO’s claims about the DOCX “standard” are directly rebutted *by the standards document itself*. These discrepancies have been pointed out on multiple occasions; the PTO makes no effort to reconcile its statements to its evidence, but instead in each round has escalated that conflict. OIRA may draw inferences as to agency intent.

OIRA should issue a disapproval under 5 C.F.R. § 1320.12(f). This is now the *fourth* time the PTO either should have filed an ICR and didn’t, or did file and the filing is defective. The Supporting Statement now admits facts that concede that burden is “disproportionate.” OIRA should invoke § 1320.12(f), and require the PTO to rescind the 2020 revision to 37 C.F.R. § 1.16(u). The signatories of this letter are ready, willing, and able to guide the PTO to an approach that works better for both the public and the PTO.

Finally, the PTO recently promulgated a half-*billion* dollar bootleg by guidance, as we discuss in § VII starting at page 34 of this letter. That should be rescinded as well.

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¹⁶ The PTO’s failure to provide an objective record in support, and non-response to the public’s estimates, is explained in our 60-day comment letter, note 1 *supra*, at pages 12-14.

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The signatories of this letter are 123 users of the Patent and Trademark Office’s computer systems, members of several email lists, and other interested persons, and members of PTAAARMIGAN, an organization of Patent and Trademark Attorneys, Agents and Applicants.

I. The following issues raised in the public comment letters are undisputed

Most of the relevant issues were raised in our 60-day comment letter (152 Practitioners), and we urge you to read at least the first twelve pages of that letter first. The following points were raised in the 60-day comment letters, and the PTO is either silent, or re-paraphrases the comment into a softball that allows the PTO to evade response. The following points are not genuinely in dispute, and OIRA may rely on the PTO’s silence to consider these facts conceded:

- Patent applications are near-unique among legal documents—as a practical matter, nothing significant can be changed, corrected, or amended after filing. 35 U.S.C. § 132. The PTO has never disagreed with our observation that patent application filing software must be as close to zero-defect as software can be, and must be designed from foundation up using reliable software design principles. Until the claims in the Supporting Statement, the PTO had never claimed that DOCX was a reliable design choice—and as we show below, the PTO’s new claims lack any support.
- The PTO does not dispute that DOCX filing introduces errors. The PTO does not contest the content of the two standards documents (attached as Exhibits 13 and 14): the standards documents repeatedly guarantee that the DOCX standard is *not* an interoperability standard, and that many parameters are “implementation defined” and variable between implementations and over time. That variability guarantees that the bugs *can never be fixed*—the errors are inherent to the design of DOCX. Fixing the PTO’s software for one word processor necessarily breaks it for others. All the PTO offers is “The USPTO has not experienced the issue raised by commenters” (Supporting Statement Responses 5 and 7). The PTO’s “experience” reflects either willful ignorance or plain falsehood:

- The Supporting Statement admits to five known instances.¹⁷ The public comment letters inform the PTO of several more.¹⁸ The signatories of this list are members of an email group on which were posted many more reports of bugs phoned in to the PTO's phone help desk. The PTO's claims raise serious questions of candor and truthfulness.
- The PTO does not dispute that specific instances in the comment letters¹⁹ were "experienced" by users. The Supporting Statement never mentions these instances, let alone explain why they are not important or may be disregarded. The Supporting Statement gives no rationale to explain why *the PTO's* "experience" is even relevant, let alone give the PTO license to disregard the experience *of the public* that actually uses the PTO's unreliable software.
- The PTO's statement is also heavily influenced by sample bias: if a user catches the problem before filing, the user finds a different way to file a patent application, rather than use the PTO's unreliable DOCX software.

The PTO's claim of lack of "experience" with such problems doesn't mean that the problems don't exist. All that OIRA can conclude from the PTO's representations is that the PTO has not undertaken to ensure that its representations meet Information Quality principles.

- The Supporting Statement claims "The [PTO's] application system stores the initial submitted documents." That is a falsehood. Though the PTO has changed the rule several times over the last three years, the constant has been that the PTO proposes to either *disregard* or *entirely discard* the documents uploaded by the applicant, and instead rely on a document that results from the PTO's error-prone document tampering.²⁰
- The public comment letters cite to and quote the DOCX standard, and Microsoft's own statements about its standard compliance, to show that DOCX *cannot possibly* meet the

¹⁷ Supporting Statement, Response 3 (at page 8), Response 15 (at page 15).

¹⁸ See multiple lists of bugs provided in the 60-day comments in note 5, *supra*; letter of Carl Oppedahl in response to 2019 NPRM, <https://www.reginfo.gov/public/do/DownloadDocument?objectID=135639500> at pages 2-3.

¹⁹ See note 18, *supra*.

²⁰ The PTO's "flavor of the month" approach is explained more fully in § IV.B starting at page 28 of this letter. Patent and Trademark Office, *Extension of the Option for Submission of a PDF With a Patent Application Filed in DOCX Format, Notice*, 88 Fed. Reg. 37036, 37037, col. 1 (Jun. 6, 2023); Patent and Trademark Office, *Submitting Patent Applications in Structured Text Format and Reliance on the Text Version as the Source or Evidentiary Copy*, 86 Fed. Reg. 29571, 29571 col. 3 to 29572 (Jun. 2, 2021) ("applicants are advised to check the USPTO-generated versions as soon as practicable for any discrepancies or errors. . . After the expiration of the one-year period, the USPTO disposes of the paper. . . DOCX submissions will be treated similarly.").

necessary reliability requirements.²¹ The Supporting Statement responds with a number of claims about what the DOCX standard document purportedly says. The public gave specific quotes and cites to the relevant ISO standard refuting the PTO; the Supporting Statement gives not a single quote or cite in support of its claims. The relevant ISO Standard is included as Exhibit 14. The public's statements about the standard track the standards document and reliable third-party articles; the Supporting Statement characterizations about the DOCX standard do not even pretend to do so. Most of the PTO's claims are *directly negated* by the standards document itself. The falsehoods in the PTO's characterizations of the standard are discussed in § III starting at page 16 of this letter.

- The PTO does not dispute that, if the DOCX filing regime is to maintain an error rate and error consequence on par with today's PDF filing regime, all other things being equal, then even a small error rate (which the PTO concedes) requires that applicants give a painstaking review of *all* patent applications.²²
- The Supporting Statement *agrees* that the PTO's DOCX filing system has a history of being unreliable.²³ Over the last several years, the PTO has released dozens of corrected versions of its filing software—and each new version of the filing software introduces nearly as many bugs as it fixes. Net reliability has only partially improved over the last four years, confirming our view that the PTO's underlying technology is inherently unstable and unreliable. The public pointed out the general pattern of bugginess in comment letters during the 2019-20 NPRM comment period, the 2020-21 triennial renewal ICR, and in many letters to the PTO between fall 2021 and spring 2023. The Supporting Statement offers no dispute to our showing of pervasive unreliability>
- The Supporting Statement does not dispute the public comments' claims that the burden of error detection and correction is cognizable as “completing and reviewing” under § 3502(2)(E), and that the annual burden is between \$200 million and \$600 million annually.²⁴

²¹ The inconsistencies between the Supporting Statement vs. the two relevant standards documents, and the implausibility of the PTO's claims for what DOCX can and cannot do, are discussed in § III starting at page 16.

²² 60-day letter of 107 Practitioners, note 10, *supra*, at page 8-9, see also 2-3, 4-5; 60-day letter of Kilpatrick Townsend & Stockton LLP, note 5, *supra*, at pages 3-4; 60-day letter of 152 Practitioners (note 1 *supra*), at pages 1-10, Exhibits 3 and 4 (PDF pages 77-94); Affidavit of Bradley Forrest, note 1 *supra*, at PDF pages 99-107.

²³ Supporting Statement Response 3 (page 8).

²⁴ Burden estimates from the public comment letters, ranging from \$200 million per year to \$600 million per year, are collected at footnote 10. The Supporting Statement does not respond to any of them, let alone explain any disagreement.

- The Supporting Statement does not dispute that PDF and PDF/A are “voluntary consensus” standards developed through multi-year, multilateral deliberation, in compliance with OIRA Circular A-119 and the National Technology Transfer and Advancement Act of 1995.
- Likewise, the Supporting Statement does not contest that DOCX is *not*.²⁵ The Supporting Statement does not contest that the DOCX “standard” was “adopted” via a “fast track” low-review procedure. A number of articles from the time note that Microsoft engaged in a number of underhanded techniques to muscle the DOCX standard through, for reasons having nothing to do with the merits—fraudulent votes, bribes, etc.²⁶ The Supporting Statement does not contest our showing that, in 2023, ***no vendor--not even Microsoft*** implements the DOCX “standard” as its default (and most-debugged) mode. The Supporting Statement also does not dispute that the PTO’s own “yearlong study”²⁷ concluded that PDF is “the right approach.”
- The PTO offers ***no*** “record supporting” any of its claims (§ 3506(c)(3)). To take but one example, in its Response 11, the Supporting Statement claims that the decision in favor of DOCX is “reached based on internal IT considerations and initiatives, external sources, and industry practice.” However, the PTO **has made none of that supporting information available—the only document made available is the yearlong study²⁷ that concludes “PDF is the right approach.”** FOIA requests F-21-000215 and F-22-00092 requested all such documents—yet the PTO has produced essentially nothing relevant, except promises to produce on a monthly “rolling” basis—a promise the PTO kept for two month and then abandoned. (note that these FOIA requests have been pending for ***over two years***). Written communications with OIRA were redacted down to

²⁵ 60-day letter of 152 Practitioners (note 1 *supra*), at 14-19.

²⁶ The Supporting Statement claims that the DOCX standard was adopted by a process as fair and robust as PDF’s. The Supporting Statement cites nothing in support. The PTO is in full possession of facts contrary to its representations to OIRA and chose to hide those facts. The standardization process was a shortcut affair, with a very limited committee. Jira Kosek, *Fron the Office Document Format Battlefield*, IEEE IT Professional 10:3:51-55 (May-Jun 2008). Articles explaining the irregularities include *Microsoft Allegedly Bullies and Bribes to Make Office an International Standard*, <https://www.wired.com/2007/08/microsoft-allegedly-bullies-and-bribes-to-make-office-an-international-standard> (Aug. 31, 2007); *Office Open XML ISO certification process grows even murkier for Microsoft*, <https://arstechnica.com/information-technology/2007/07/office-open-xml-iso-certification-process-grows-even-murkier-for-microsoft/> (Jul. 26, 2007); *Complaints about the national bodies process*, https://en.wikipedia.org/wiki/Standardization_of_Office_Open_XML#Complaints_about_the_national_bodies_process. The PTO cannot claim to be ignorant of this history—the PTO was given a copy of this article which explains Microsoft’s sordid behavior. 60-day letter of 152 Practitioners (note 1 *supra*), Exhibit 10 (PDF pages 165 to 199). OIRA may infer intent.

²⁷ 60-day letter of 152 Practitioners (note 1 *supra*), Exhibit 1 (PDF pages 42-66).

blank sheets, despite a reminder of the requirement to produce. 44 U.S.C. § 3507(e)(2).²⁸ See Exhibit 12. Given the lack of disclosure with the NPRM, Supporting Statement, or FOIA, OIRA may conclude that no supporting evidence exists, and that any evidence that *does* exist supports the view of the public comment letters—DOCX is the wrong approach.

- The Supporting Statement does not dispute that many patent applications are written in word processors other than Word—Google Docs, Word Perfect, Libre Office, and the like. Nor does the Supporting Statement disagree with the showing in the public comment letters that these non-Microsoft word processors do not generate DOCX output *reliably*. Equations are often set in specialized products for mathematics, such as LaTeX. The PTO’s own “survey” relied on in the Federal Register notice estimated this non-DOCX usage at about **20%**.²⁹ The Library of Congress has noted that conversion between different software products is imperfect: “a round-trip to an identical document should *never* be expected.”³⁰ Despite several challenges to do so,³¹ the PTO has been unable to provide an objective record in support of *any* claim that its DOCX collection rules will even work for these non-Microsoft users, nor that the DOCX rule will be “consistent and compatible, to the maximum extent practicable, with ... existing reporting and recordkeeping practices” for those 20%. 44 U.S.C. § 3506(c)(3)(E).
- The public comment letters pointed out an incongruity: the Supporting Statement claims that DOCX is a good vehicle for patent applications because DOCX is a “standard,” but neither the PTO nor Microsoft implements the standard. The PTO’s DOCX system implements only a very limited, poorly-documented, and ever changing subset of the standard.³² If the DOCX “standard” is relevant, then the PTO should implement it. The

²⁸ A number of other emails have Re line “EO 12866” review. The emails in Exhibit 12 are the ones that do not, and that appear to be related to the Paperwork Reduction Act and Information Collection rules. On the other hand, perhaps there are no emails at all relating to the PRA and IC regulations. That’s agency error of a different order of magnitude. In any event, in two years, the PTO has produced no relevant emails.

²⁹ Patent and Trademark Office, *Setting and Adjusting Patent Fees During Fiscal Year 2020*, 84 Fed. Reg. 37398, 37413 col. 2 (Jul. 31, 2019). The PTO violated the Administrative Procedure Act and Information Quality Act by keeping this “survey” secret during public comment. The public requested it by FOIA over two years ago; the PTO has not produced it—three years later, this “survey” remains a “black box.” The PTO has not made available any reason to believe that the PTO’s “survey” complied with OMB’s guidance for influential statistical information.

³⁰ Library of Congress, *DOCX Transitional (Office Open XML), ISO 29500:2008-2016, ECMA-376, Editions 1-5*, <https://www.loc.gov/preservation/digital/formats/fdd/fdd000397.shtml> Because of the used of Greek letters, equations, etc., patent applications are not “simple documents.”

³¹ 60-day letter of 152 Practitioners (note 1 *supra*), at 14-15.

³² 60-day letter of 152 Practitioners (note 1 *supra*), at 6-7, and Exhibit 4 (PDF pages 83-94).

PTO's invocation of the importance of a "standard," but then deviating to implement only the subset that is convenient for the agency, and leaving out parts of the standard that are important to the public, is at best disingenuous.

- The Supporting Statement claims "submitted files from all applicants are validated and converted to PDF by USPTO systems in a consistent manner." (Response 4, at page 9). That's a statement of the *problem*, not a solution, and a confession by the PTO that the PTO lacks understanding of the technology. The necessary consistency is between *applicants' computers and the PTO's*. That is the promise PDF makes. And that is the promise that the DOCX standard pointedly does *not*. The PTO's claim of consistency by the PTO's computers necessarily implies *inconsistency* with *applicants' computers*.
- The Supporting Statement is a series of diversions, evasions, and *non sequiturs*. For example, the Supporting Statement claims. "The USPTO has not received specific instances where the application system developed textual discrepancies between the DOCX file at submission [that is, after the PTO's software does its document tampering] and the PDF file at the 18-month mark prior to publication."³³ This claim is not literally false, but it's irrelevant. The relevant comparison is between the DOCX *as it appears on the applicant's computer* vs. the document as the PTO stores it in the file record and extracts text from the applicant's submission for publication of the patent. *Nowhere* does the PTO make any claim *as to the relevant comparison*. Under the public's proposal (text-based PDF), this all works correctly and simply. Under the PTO's proposal, it does not, and *cannot*.
- During the 2019 comment period, the public requested that they should be able to file a PDF file as a check document to correct errors in the PTO's unreliable rendering of a DOCX (Comment 48, 85 Fed. Reg. at 46956, col. 3). In June 2021, the PTO issued a guidance document (with no notice and comment). In that guidance, the PTO stated that filers would not even be permitted to file a safety PDF (or rather, if they did, they would be penalized \$400): "If the applicant submits documents in DOCX along with PDF versions they created (not the autogenerated PDFs created by the USPTO), then the DOCX version will still be considered the source or evidentiary copy, and the applicant will be required to pay the non-DOCX surcharge fee."³⁴ OIRA may infer that the PTO lacks public interest rationale for much of its decision-making. OIRA may infer that, at least in part, the PTO acts out of pure malice—the PTO offered no other explanation, and none is visible to us. The PTO's latest word is that a PDF safety document may be submitted "until further notice," but the PTO refuses to commit to making that

³³ Supporting Statement, Response 5 (at page 9).

³⁴ *Submitting Patent Applications in Structured Text Format* (note 20, *supra*), 86 Fed. Reg. at 29571, col. 3.

permanent.³⁵ Instead, the Supporting Statement misrepresents the PTO's last position, as described at page 31 of this letter.

- Our 60-day comment letter notes that two of the ten largest law firms in the U.S. in the relevant specialty have explained the problems to their clients.³⁶ The PTO itself estimates that 40% of filers find the risk of error so great that they will pay the \$400 penalty rather than take the risk of error introduced by the PTO's software bugs.³⁷
- The public comment letters pointed out that the PTO's DOCX implementation also violates the Federal Records Act, because the PTO proposes to discard the application as the applicant uploads it, and to replace it with a version created by the PTO's own unreliable and undocumented software. The PTO's proposal makes it *impossible* to prove what the applicant actually uploaded, either for error correction during examination, or during subsequent litigation. Likewise, the Federal Rules of Evidence require that the PTO rely on the "original document," not a version that the PTO creates.³⁸ The Supporting Statement does not dispute that the DOCX information collection violates both the Federal Rules of Evidence and Federal Records Act.
- The public comment letters pointed out a pattern of agency falsification, omission, and excuses that lack legal and/or factual underpinning.³⁹ The Supporting Statement offers no response or justification for the PTO's procedural shortcutting.
- The public comment letters raised the possibility that "More than a few people have speculated that this is simply a way for the Patent Office to raise fees *sub rosa*, without going through the rulemaking process."⁴⁰ The Supporting Statement does not disagree. Misappropriation is an inference available to OIRA.
- The public comment letters explained that doing what the Federal Courts do—a text-based PDF approach (for example, using PDF/A) has all the advantages the PTO seeks from DOCX, and would accomplish the PTO's goals *better*⁴¹—
 - PDF is stable across all machines for all time. DOCX is not. Microsoft has never implemented to the standard. Microsoft's web page [*MS-OI29500*]: *Office*

³⁵ *Extension of Option*, note 20, *supra*, 88 Fed. Reg. 37036, 37036 col. 1.

³⁶ 60-day letter of 152 Practitioners (note 1 *supra*), at 9.

³⁷ Supporting Statement, compare Table 5 (at page 21) to Table 3 (164,00 out of a total of 404,000 applications will be filed with the fee).

³⁸ Federal Rule of Evidence 1002, https://www.law.cornell.edu/rules/fre/rule_1002 ; 60-day letter of 152 Practitioners (note 1 *supra*), at page 14.

³⁹ 60-day letter of 152 Practitioners (note 1 *supra*), at 23-28.

⁴⁰ 60-day letter of 152 Practitioners (note 1 *supra*), at 3.

⁴¹ 60-day letter of 152 Practitioners (note 1 *supra*), at 14-15.

*Implementation Information for ISO/IEC 29500 Standards Support*⁴² states that Microsoft Word “is known to vary from or extend the specification.” The PTO is chasing an undocumented, moving target, and placing its customers at risk.

- The public will use text-based PDF (because the public does today). The PTO admits that 40% won’t use DOCX. The PTO’s publication goals cannot be achieved via DOCX.
- The PDF standard is under 800 pages. The DOCX standard is over 5000 pages. The complexity of PDF intake software would be much lower.

The Supporting Statement offers no disagreement. The Supporting Statements notes a complete irrelevancy, namely that “image based PDF” is not a good solution (Response 12, at page 13), but *no one proposed that*. The PTO’s response is a *non sequitur* a misdirection.

- Our 60-day comment letter pointed out that “The PTO will suffer no prejudice if the ICR is denied: the information collection is not “necessary for the proper function of the agency”⁴³ The Supporting Statement offers no disagreement. The Supporting Statement explains that DOCX is a “nice to have” for the PTO (Response 1, pages 6-7), but agrees (by silence) that DOCX is not “necessary.”

Our primary explanation is in our 60-day comment letter. The following sections address the few issues where the Supporting Statement raises new issues or makes some attempt to respond.

II. The PTO requests clearance only for “adjusting existing ways to comply,” 44 U.S.C. § 3502(2)(C), and neglects burden of “completing and reviewing” the collection, 44 U.S.C. § 3502(2)(E).

It is important to note what this ICR does not seek. This ICR does not request a modification to the clearance for new patent applications, in 0651-0032. Instead, the PTO proposes a new control number “0651-new.” The PTO explains that the agency is *not* requesting clearance for the “completing and reviewing” burden (§ 3502(2)(E)) of additional error review and error correction under the permanent regulation (indeed, at several points, the PTO disclaims any effort to seek such clearance—for example, the Supporting Statement expressly states that it is not requesting clearance for petitions to correct the PTO’s errors. (Response 17 at page 15)). Instead, the PTO seeks clearance *solely for temporary transition costs and a temporary waiver*:⁴⁴

⁴² https://learn.microsoft.com/en-us/openspecs/office_standards/ms-oi29500/1fd4a662-8623-49c0-82f0-18fa91b413b8

⁴³ 60-day letter of 152 Practitioners (note 1 *supra*), at 29-30.

⁴⁴ 60-day notice, 88 Fed. Reg. 37039,

The items in this proposed new information collection relate *solely* to the impacts of the § 1.16(u) non-DOCX filing surcharge... In particular, this proposed new information collection accounts for the § 1.16(u) non-DOCX filing surcharge fee itself, as well as an additional 30 minutes of time to accommodate the (i) extra review that some respondents may undertake as they start to become more familiar with the DOCX format and (ii) submission of the back-up applicant-generated PDF that some respondents will opt to submit.⁴⁵

The PTO is *not requesting clearance for the day-to-day burden* addressed in the comment letters: proofreading and error correction, for the regulation as it will stand in permanent form. The PTO has never even acknowledged *that* burden, let alone disagreed with the public's estimates of \$200 million to \$600 million per year.⁴⁶

Because the PTO is only requesting clearance for transition costs and an interim measure, and is *not* seeking clearance for the burden of collecting patent applications in DOCX form under the permanent regulation, Terms of Clearance should make clear that no clearance for the latter is granted. Without that clearance, the PTO is barred from collecting DOCX filings.

Still further, the PTO's \$103 million estimate for transition costs is *in addition to*, not a replacement for, the \$200-600 million estimates from the public.

Notably, this is the third time the PTO has evaded its obligations to clear the underlying "completing and reviewing" information collection of the permanent regulation. In the 2019-20 NPRM comment period, the PTO sought no clearance, instead claiming that "this proposed rule has been reviewed and previously approved by OMB"—a claim that is demonstrably false.⁴⁷ At the time of the final rule (July 2020),⁴⁸ the PTO again avoided a proper ICR.⁴⁹ In a 2020-21 triennial renewal review, the PTO acknowledged that it had no clearance, offered no dispute of

⁴⁵ The inconsistency between the 60-day notice and Supporting Statement is discussed in note 9, *supra*.

⁴⁶ Burden estimates from the public comment letters, ranging from \$200 million per year to \$600 million per year, are collected at footnote 10. The Supporting Statement does not respond to any of them, let alone explain any disagreement.

⁴⁷ The full history of the PTO's false claims and evasion is explained in our 60-day comment letter, note 1 *supra*, at pages 23-28.

⁴⁸ Final rule, note 4, *supra*, 85 Fed. Reg. at 46985, col. 2.

⁴⁹ The PTO's FOIA response includes several emails between the PTO and Mr. Fraser (other than the EO 12866 communications), but the entire content of those emails is redacted, in violation of § 3507(e)(2). See Exhibit 12. The final rule has several material falsehoods, as discussed in § IV.A starting at page 22—if those falsehoods were included in the draft sent to Mr. Fraser for *ex parte* review, the PTO's lawyers violated the rules of Professional Conduct.

the public's \$200 million estimates, and declined to seek clearance.⁵⁰ Now, the PTO dodges the issue by only seeking clearance for “adjusting ways,” while continuing to ignore “completing and reviewing” burden of \$200 million to \$600 million per year.⁵¹

The PTO is playing games, trying to divert attention to a smaller burden component of the overall burden, while ignoring the largest component. That game-playing should mature into a § 1320.12(h)(2) order requiring the PTO to rescind within 120 days.

III. The PTO's representations about the DOCX standard are pure fiction—none of the PTO's representations are supported by the standards document itself, and most are directly rebutted by the standards document and third-party articles

The Supporting Statement makes a number of claims about the DOCX standard. All of the material claims are false. The PTO was informed by the 60-day comments that its claims are false.⁵² The Supporting Statement cites *nothing* supporting any of its claims, thereby violating the requirement to provide a “record supporting” its claims. The PTO's claims are directly rebutted by the standards document itself. *Direct quotes* from the standards were provided to the PTO at each stage of comment; yet the Supporting Statement continues to state falsehoods with no response, and no attempt to reconcile its claims with the standard documents. The fair inference is that the PTO's falsehoods are fully informed and intentional.

For example, the Supporting Statement, in Response 2 (page 7) claims:

DOCX is a word-processing file format that is part of OOXML, an XML-based open standard approved by the Ecma International® consortium and subsequently by the ISO/IEC joint technical committee. For more information about the OOXML standard, please see:

- ECMA–376 at <https://www.ecma-international.org/publications-and-standards/standards/ecma-376/>;
- ISO/IEC 29500 at <https://www.iso.org/committee/45374/x/catalogue/>; and
- *NIST Votes for U.S. Approval of the Modified OOXML Standard* at <https://www.nist.gov/news-events/news/2008/03/nist-votes-us-approval-modified-office-open-xml-standard>.

Like the PDF standard, DOCX presents documents, including text and formatting, in a manner that is independent of software, hardware, or operating

⁵⁰ May 25, 2021 Supporting Statement for 0651-0032, ICR 202011-0651-006, at <https://www.reginfo.gov/public/do/DownloadDocument?objectID=106619502> at 14.

⁵¹ Burden estimates from the public comment letters, ranging from \$200 million per year to \$600 million per year, are collected at footnote 10.

⁵² 60-day letter of 152 Practitioners (note 1 *supra*), at pages 16-18

system. A particular operating system will have its own process for interpreting and showing those text and format elements. However, the DOCX file is itself a stable carrier for the textual elements of the document.

In Response 4 (page 9), the Supporting Statement claims

An advantage of submitting in DOCX format directly is that submitted files from all applicants are validated and converted to PDF by USPTO systems in a consistent manner.

In response 7 (page 10), the Supporting Statement claims:

The DOCX file acts as an effective vehicle for sending the structured text to the USPTO. Like the PDF standard, DOCX presents documents, including text and formatting, in a manner that is independent of software, hardware, or operating systems.

To start with, the PTO's URL for the ISO standard is wrong. That URL is for group ISO/IEC JTC 1/SC 34, not for a standard. The correct URL for the standard is at <https://www.iso.org/standard/71691.html> (2016 version) and <https://www.iso.org/standard/77818.html> (2021 version). The error in the URL suggests the PTO never even acquired a copy of the standard document, let alone read it. The extensive quotation and footnoting in our comment letters demonstrates that we carefully read the relevant portions of these standards documents. Attached as Exhibit 13 and Exhibit 14 are copies of ECMA-376 and ISO 29500-1 that we obtained in 2019 for the NPRM comment letters.

In the DOCX standards document, the terms "implementation defined" or "implementation specific" or "built-down form" or "built-up form" or "linear form" or "professional form" (each of which itself incorporates the notion of "implementation defined", see § 15.1) are used *hundreds* of times. This precise issue was raised in the 2019 comment period,⁵³ with direct quotes from the two relevant standards documents, ECMA-376 and ISO/IEC 29500. Both standards expressly disclaim the kind of interoperability that the PTO assumes. The third bullet below is especially striking, in the degree to which the DOCX standard permits a conforming implementation to entirely mangle the text of a document:

- Both standards have an explicit section "Interoperability Guidelines" stating that a user may *not* rely on uniformity and interoperability.⁵⁴ "[A] software application should be accompanied by documentation that describes what subset of ECMA-376 / ISO/IEC 29500 it supports."⁵⁵ ECMA-376 and ISO/IEC 29500 expressly state that ***there is no common set of features that are required to be implemented***; all the standard

⁵³ Seventy-Three Patent Practitioners, NPRM letter of Sept. 27, 2019 (note 3, *supra*), at pages 15-19, attached as Exhibit 11 to our 60-day letter, note 1, *supra* (PDF pages 215-219).

⁵⁴ ECMA-376 § 2.4 (Exhibit 13 at PDF page 15); ISO/IEC 29500-2 § 2.4 (Exhibit 14 at PDF page 15).

⁵⁵ § 2.4, note 54, *supra*.

guarantees is that *if* certain features are implemented, they will behave in a certain manner. A standard useful for an electronic filing system cannot rely on features that are optional in some implementations and unimplemented in others.

- “The application need not implement operations on all XML elements defined in ECMA-376.”⁵⁶ Some implementations of DOCX are permitted to have features that will cause errors in others.
- “A batch tool that reads a word-processing document and reverses the order of text characters in every paragraph with ‘Title’ style before saving it can be conforming even though ECMA-376 does not recommend this behavior. [A conforming word processor may] transform the title ‘Office Open XML’ into ‘LMX nepO eciffO’. Its documentation should declare its effect on such paragraphs.”⁵⁷ The ECMA-376 and ISO 29500-1 standards *expressly allow* for entirely different renderings, so long as it’s documented.
- “These application descriptions should not be taken as limiting the ability of an application provider to create innovative applications. They are intended as a mechanism for labelling applications rather than for restricting their capabilities.”⁵⁸ A standard useful for an electronic filing system can’t rely on features that are optional in some implementations and unimplemented in others, or that invites “innovative applications.” The essential property is uniformity, and that is what ECMA-376 and ISO 29500-1 do **not** promise.
- “[*Note*: A possible application description would be a ‘standard’ application description for a word processing application. This could be created by taking the intersection of the features available in common word processing applications such as Word 2000, OpenOffice 2, WordPerfect, and iWork Pages. ... *end note*]”⁵⁹ ECMA-376 and ISO 29500-1 expressly state that there is no common set of features that are required to be implemented; all ECMA-376 and ISO 29500-1 guarantee is that *if* an implementer wants to implement a given feature, there is a format in which to implement it. There are very few **behavioral** guarantees, and almost none of **uniformity**.
- ECMA-376 and ISO 29500-1 leave a number of features “implementation defined,” including whether and how to save any element that is under the control of a plug-in, how dates are rendered, how embedded pictures are rendered, whether numerical values are rendered with a “.” or a “,” as a decimal point, how fonts are chosen in

⁵⁶ § 2.4, note 54, *supra*.

⁵⁷ § 2.4, note 54, *supra*.

⁵⁸ ECMA-376 § 2.3 (Exhibit 13 at PDF page 13); ISO/IEC 29500-2 § 2.3 (Exhibit 14 at PDF page 13).

⁵⁹ ECMA-376 § 2.3.3 (Exhibit 13 at PDF page 14); ISO/IEC 29500-2 § 2.3.3 (Exhibit 14 at PDF page 14).

rendering, line number spacing, and other characteristics.⁶⁰ Documents copied from one DOCX program to another have no guarantee of being rendered consistently.

- A Microsoft blog⁶¹ writes “One of the great things about ISO/IEC 29500 is its extensibility mechanisms - implementers can extend the file format while remaining 100% compliant with the standard.” That statement is the admission—there is no uniform interoperability standard. ECMA-376 and ISO/IEC 29500 are only a baseline, minimum functionality standard, not an interoperability standard that guarantees bilateral consistency between any two implementations. That may be a good feature for software developers, but it’s catastrophic for archival storage of legal documents that the PTO contemplates. IN contrast, bilateral interoperability is the whole point of the PDF standard.

The Supporting Statement claims “DOCX presents documents, including text and formatting, in a manner that is independent of software, hardware, or operating system” (response 2 at page 7; see also response 7 at page 10). The PTO cites *nothing*. The PTO’s lack of citation is curious, in view of the showing in our 60-day letter of facts that are inconsistent with this claim. The following is a near-direct quote from our 60-day letter—the Supporting Statement responds to *none* of these facts:⁶²

- The DOCX standards do not offer the relevant guarantees: reliability, portability, or interoperability. In fact, they guarantee the opposite. The standards for DOCX leave many characteristics “implementation defined” and do not require that DOCX documents provide content fidelity. One of the comment letters gave an extensive list of “implementation defined” and other unreliable features of the two standards cited by the PTO.⁶³
- Though both ECMA-376 and ISO/IEC 29500-1 standard documents for DOCX are over 5000 pages long, neither ever uses the text string “reliab” “interchan” or “interoper” the relevant properties. The string “reliab” appears nowhere. The word “portable” is used three times, none of which are relevant. The word “uniform” is used 16 times, but only in phrases such as “uniform resource locator,” never to imply uniformity across implementations. The string “interchang” is used a few dozen times, none of which are relevant—titles of *other* documents and the like. The word “interoperable” is used only to note that the standard itself *doesn’t* promise interoperability. All that ECMA-376 and ISO/IEC 29500-1 offer is recommendations for further parameters that must be defined if interoperability is desired.

⁶⁰ ECMA-376 (Exhibit 13); ISO/IEC 29500-2 (Exhibit 14): search for the text “implementation defined” or “implementation specific” or “built-down form” or “built-up form” or “linear form” or “professional form”—we got over 100 hits.

⁶¹ <https://blogs.msdn.microsoft.com/chrisrae/2010/10/06/where-is-the-documentation-for-offices-docxxlsxpptx-formats-part-2-office-2010/>

⁶² 60-day letter of 152 Practitioners (note 1 *supra*), at pages 16-18

⁶³ NPRM letter of Seventy-Three Patent Practitioners (note 3, *supra*), at pages 15-16, attached as Exhibit 11 to our 60-day letter, note 1, *supra*, at PDF pages 215-216.

- Most important, *Microsoft does not implement the DOCX standards*, except to users that investigate and locate a hidden checkbox. Microsoft's web page [MS-OI29500]: *Office Implementation Information for ISO/IEC 29500 Standards Support*⁶⁴ states that Microsoft Word "is known to vary from or extend the specification."
- Microsoft Corp. discontinued new versions of Microsoft Office for desktops, and has announced that it will end support for all versions of Microsoft Office by 2025.⁶⁵ Instead, Microsoft will offer Office 365, a "subscription-based software as a service" (Internet based service that interacts with a user's PC by communicating with the PC over the Internet). Users have no control—indeed no visibility—into Microsoft's updates to Office 365. For third-party vendors (Libre Office, Google Docs, Word Perfect, Apple Pages, and **the Patent Office's** home-grown and undocumented software that attempts to read DOCX files), it will be impossible to know that changes occurred, let alone make timely changes to their programs to track Microsoft's changes with the precision and fidelity necessary to meet the high reliability necessary for patent applications. **It will be entirely impossible for the Patent Office to maintain the ability for applicants to file applications correctly over any amount of time.**
- The Library of Congress, on its page directed to various different software programs that purport to support the two DOCX standards, warns that "Although simple documents can be effectively converted, a round-trip to an identical document should never be expected."⁶⁶ The PTO's claim that DOCX is "supported by" multiple vendors is either intentionally false or willfully blind to practical reality.
- Articles describing the unreliability of content fidelity between different programs' treatment of DOCX files, and even between different versions of Word, were cited during notice and comment, and are generally known to those in the computer arts. These articles include Free Software Foundation, *Interoperability woes with MS-OOXML: ...Lack of conformance clause*, <https://fsfe.org/activities/msooxml/msooxml-interoperability.pdf>; Abhishek Bhatnagar, *Is DOCX really an open standard?*, <https://brattahlid.wordpress.com/2012/05/08/is-docx-really-an-open-standard> (May 8, 2012); *If DOCX format is open source, why so many word processors have problem [sic] decoding this file format?*, comments of Joe Woo, a former program manager for Microsoft Word, <https://qr.ae/pv26G5> ("Even with the same data, you cannot match the rendering fidelity of Word."—noting clash between Microsoft Word vs. Google Docs); Joel Madero, *Pointing the Finger – Interoperability and Microsoft's Share of the Blame*, <https://joelmadero.wordpress.com/2014/10/23> (Oct. 23, 2014) (noting incompatibility between Word for Windows and Word for Mac); Markus Feilner, *Complex singularity vs. openness*, letter to European Commission, at <https://joinup.ec.europa.eu/sites/default/files/document/2014->

⁶⁴ https://learn.microsoft.com/en-us/openspecs/office_standards/ms-oi29500/1fd4a662-8623-49c0-82f0-18fa91b413b8

⁶⁵ <https://learn.microsoft.com/en-us/lifecycle/end-of-support/end-of-support-2025>

⁶⁶ Library of Congress, *DOCX Transitional (Office Open XML), ISO 29500:2008-2016, ECMA-376, Editions 1-5*, <https://www.loc.gov/preservation/digital/formats/fdd/fdd000397.shtml>

[06/complex_singularity_vs_openess.pdf](#) (collecting studies and reports of others: the ISO 29500 DOCX standard fails to specify sufficient parameters to allow portability, even Microsoft has never released a strictly conforming implementation, Microsoft's own versions of Word are incompatible with each other, and other vendors cannot track Microsoft's changes. "[The ISO DOCX standard] causes problems when used in public services. For an ISO standard it shows surprising weaknesses: No single product complies with the only acceptable variant of the standard ..., nor is there any alternative to Microsoft's products."). The PTO has never contested the showings of any of these articles. Instead, the PTO ignores any information contrary to its predetermined outcome.

The Supporting Statement offers nothing more than unsupported claims that "DOCX presents documents... in a manner that is independent of software, hardware, or operating systems." The PTO offers no support whatsoever for such a blanket statement. The Supporting Statement has *not a single cite or quotation* drawn from the standards documents the PTO purports to rely on. The Supporting Statement's factual statements are false, and were known to be false when the PTO submitted its Supporting Statement.

In Response 4 (at page 9), the Supporting Statement claims "The validation features are new to the submission process and made available due to the structured data in DOCX files; this is not a feature that is available for PDF submissions." True, the PTO's software does not perform validations against PDF submissions today. But, as we pointed out in our 60-day comment letter, the information is available in a PDF document (perfect characters, paragraphing, headings, etc.). There is no reason whatsoever that the PTO's software couldn't be taught to do the same validation on PDF files. From the research we've been able to conduct, text-based PDF would work *better* for the PTO than DOCX ((a) because PDF is an interoperability standard, while DOCX is not—the PTO cannot be blindsided by changes introduced by Microsoft, and (b) applicants will use PDF, but won't use DOCX), and it is *better* for applicants. The Supporting Statement offers little explanation, and no evidence whatsoever, to the contrary.

An extensive example of the mangling that arises when copying a DOCX document from one "conforming implementation" to another is given in this 2019 letter⁶⁷-- we copied a letter from Microsoft Word for Windows to Word for Mac to Libre Office to Word Perfect, with no editing. Merely copying the document from one to the other mangled the document to the point that it would be unusable as a patent application. The Supporting Statement offers no guarantees that the PTO's software can be any more reliable, if the patent application was written on a non-Microsoft word processor.

As this very letter was being drafted in early October, an attorney reported a new bug. The new bug introduced into the PTO's new filing software is catastrophic: Japanese characters are entirely blanked out. Under international treaty, some patent applications are filed in foreign

⁶⁷ NPRM letter of Seventy-Three Patent Practitioners (note 3, *supra*), at page 15-19, attached as Exhibit 11 to our 60-day letter, note 1, *supra*, at pages 215-219.

languages, with a translation filed as a follow-up. A blanked-out patent application, of course, is totally worthless.

The principal fact claims in the Supporting Statement are directly contrary to the governing standards documents. Our letters fully informed the PTO of the facts relating to ECMA-376 and ISO 29500-1, with either direct quotations or citations to the standards documents—the PTO could have easily checked the public’s claims if they PTO had the slightest interest in factual accuracy. But the PTO doesn’t and didn’t. Instead, the Supporting Statement ignored Information Quality principles. An error once is honest error. Two is careless, but generally excusable. Between the NPRM, final rule, the PTO’s Supporting Statement in ICR 202011-0651-005 in November 2020, the public’s conversations with the PTO in spring 2023,⁶⁸ and the 60-day letters, this is now the fifth round of false statements. OIRA may infer that false claims at this stage are intentional. On the facts as they may be read in the standards documents, the public’s estimate of \$200 million to \$600 million per year for “completing and reviewing,” proofreading, and error correction, is the more accurate. \$200-600 million vs. \$780,000 is “disproportionate.” The ICR should be disapproved.

IV. A pattern of mutiny by the Patent Office in defiance of OIRA authority

A. The procedural history of this rule reflects a pattern of agency falsification, omission, and excuses that lack legal or factual underpinning

The PTO skipped many steps required by the PRA and OMB regulations. The PTO never sought clearance and made several false representations to OIRA. This catalog of agency cheating was laid out in our 60-day letter, and the PTO offers no disagreement with any of the facts, or the implication that the cheating was intentional. For example:

- The PTO made none of the required filings at the required times.⁶⁹
- In the July 2019 NPRM (84 Fed. Reg. at 37431, col. 1), the PTO claimed to have made the requisite filings under the Paperwork Reduction Act and to have obtained approval from the Office of Management and Budget (“OMB”), stating:

⁶⁸ 60-day letter of 152 Practitioners (note 1 *supra*), Exhibits 9 and 10 (pages 145-199).

⁶⁹ The “Control Number History” page for 0651-0032 at <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0032> shows no relevant filings around the time of the NPRM (July 31, 2019) or the Final Rule (August 3, 2020).

P. Paperwork Reduction Act: The Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This proposed rule involves information collection requirements which are subject to review by the OMB under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501–3549). The collection of information involved in this proposed rule has been reviewed and previously approved by OMB under control numbers 0651–0012, 0651–0016, 0651–0020, 0651–0021, 0651–0031, 0651–0032, 0651–0033, 0651–0059, 0651–0063, 0651–0064, 0651–0069, and 0651–0075.

The public comment letters pointed out that there were no relevant filings at the relevant times,⁷⁰ including screen shots from the relevant pages of reginfo.gov, so no such review or approval could possibly exist. Nonetheless, the Final Rule notice repeated the false claim of a “reviewed” and “previously approved” control number:⁷¹

U.S.C. 3501–3549). The collection of information involved in this Final Rule have been reviewed and previously approved by the OMB under control numbers 0651–0012, 0651–0016, 0651–0020, 0651–0021, 0651–0031, 0651–0032, 0651–0033, 0651–0059, 0651–0063, 0651–0064, 0651–0069, and 0651–0075. In addition, updates to the aforementioned information collections as a result of this Final Rule have been submitted to the OMB as non-substantive change requests.

⁷⁰ NPRM letter of Seventy-Three Patent Practitioners (note 3, *supra*), at page 26, attached as Exhibit 11 to our 60-day letter, note 1, *supra*, at PDF page 226.

⁷¹ Final rule, note 4, *supra*, 85 Fed. Reg. at 46985, col. 2.

OIRA's web site shows that no such filings were ever made. The PTO's statement in the Final Rule, 85 Fed. Reg. at 46985, that it had OMB approval for § 1.16(u) Non-DOCX Penalty Fee was false. In view of the notification in the public comment letter, OIRA may infer that the falsehood and evasion of OIRA review were intentional. The Supporting Statement offers no basis to infer otherwise.

- Documents we received pursuant to a FOIA request⁷² include an email conversation from late July 2020, in which the PTO sent Mr. Fraser a draft of the Final Rule requesting approval. The draft Federal Register notice attached to this email represented to Mr. Fraser, "To date, the Office has not received notifications of any issues resulting from the filing of applications in DOCX format." That was a falsehood. In the Supporting Statement, the PTO states "The USPTO has not experienced the issue raised by commenters" (Supporting Statement Response 7 at page 10). At best, this statement is misleading, as discussed at page 7.
- Many patent applications are written in word processors other than Word—Google Docs, Word Perfect, Libre Office, and the like. Equations are often set in specialized products for mathematics, such as LaTeX. The PTO's own "survey" relied on in the Federal Register notice estimated this non-DOCX usage at about **20%**.⁷³ The entities making up this 20% won't have a choice. They will either have to change the way they prepare applications, which may be onerous, or pay the fee. But in its May 2021 Supporting Statement to OIRA, "The USPTO presently estimates that ... approximately **10%** of initial submissions made by the public will incur the additional non-DOCX filing surcharge."⁷⁴ The PTO offered no support for its estimate of "10%," when its own survey showed 20%. In this Supporting Statement, the PTO offers no disagreement with the public's showing that users of Google Docs, Word Perfect, Libre Office, and Apple Pages can't use DOCX *reliably*, and will be penalized \$400 for following their existing practices in order to ensure adequate reliability.

⁷² Emails to and from PTO personnel and Nicholas Fraser (of OMB) were produced in part in the PTO's production for FOIA Request F-21-00169. Despite the requirements of § 3507(e)(2) to make all written communications available, the PTO heavily redacted the relevant communications from its FOIA production.

⁷³ NPRM, 84 Fed. Reg. at 37413 col. 2. The PTO violated the Information Quality Act, as we discuss in footnote 29.

⁷⁴ May 25, 2021 Supporting Statement for 0651-0032, ICR 202011-0651-006, at <https://www.reginfo.gov/public/do/DownloadDocument?objectID=106619502>, at 14. The PTO offered no supporting record, let alone evidence, in support of its claim for "10%."

- The other word processors referenced in the preceding paragraph do *not* produce DOCX files that can be reliably imported by the PTO.⁷⁵ The public noted the requirement, § 3506(c)(3)(E), that patent application filing be “implemented in ways consistent and compatible, to the maximum extent practicable, with the existing reporting and recordkeeping practices,” and asked the PTO to explain (a) the validity of this “study,” and (b) to explain how these 20% are to file their applications. The PTO’s Final Rule offered only a *non sequitur*, explaining benefit to the PTO itself, and failing to address burden on those who are to respond.⁷⁶ The Supporting Statement offers no contest. Thus, by silence, the PTO admits that the DOCX rule violates the PTO’s obligation to work with “existing reporting and recordkeeping practices.”
- In the Final Rule, the PTO’s stated rationale for insisting on DOCX filing instead of text-based PDF is stated four times in nearly identical language, relying on a “yearlong study:”⁷⁷

⁷⁵ Several of the examples we cite in notes 3 and 5 arise because of a patent application written in a non-Microsoft word processor (for example, Libre Office or LaTeX) and altered by the PTO’s DOCX intake software.

⁷⁶ Final rule, note 4, *supra*, Response 63, 85 Fed. Reg. at 46959, col. 1:

receiving DOCX filings properly.
Response: A survey was conducted by the USPTO to obtain this data. An advantage of submitting in DOCX format directly is that submitted files from all applicants are validated and converted to PDF by USPTO systems in a consistent manner. The USPTO continuously performs rigorous testing to ensure that document integrity is preserved.

⁷⁷ Final rule, note 4, *supra*, 85 Fed. Reg. at 46959 col. 1-2.

EXHIBIT 10.1

Response: The USPTO conducted a yearlong study of the feasibility of processing text in PDF documents. The results showed that searchable text data is available in some PDFs, but the order and accuracy of the content could not be preserved. With DOCX, the Office is

able to use the text directly and pass it on to USPTO downstream systems, which results in increased data accuracy and a more streamlined patent process.

This “yearlong study” was neither referred to in, nor made available for public vetting with, the NPRM. It was not made available at the time of the Final Rule. We *only* received it as a result of a FOIA request.⁷⁸ Once we obtained it, it became apparent that the PTO’s representation in the Final Rule fails “Information Quality” principles. In fact, as noted above multiple times, the conclusion of the “yearlong study that PDF is the “right approach” is 180 degrees *opposite* the PTO’s representation to the public and to OIRA.⁷⁹ The yearlong study says not a single word about DOCX—the PTO’s conclusion in the Final Rule that DOCX is suitable is *entirely unsupported*. The PTO materially misrepresented the evidence it *did* have to the public and to OIRA.

- In the Supporting Statement of May 25, 2021, the PTO did not dispute the \$200 million estimate offered by the public comments—instead, the PTO dodged the issue, asserting that any explanation “would be premature and not meaningful to the cause of estimating public burden.”⁸⁰ In this Supporting Statement, the PTO never mentions the public’s three estimates of \$200 million to \$600 million,⁸¹ let alone to disagree or explain any fault in the analytical methods. Because of the PTO’s acquiescence, OIRA may accept \$200 to \$600 million annually in perpetuity as the accurate estimate for “completing and reviewing” and the PTO’s \$100 million estimate for first year “adjusting the existing ways to comply with any previously applicable instructions and requirements.” Imposing

⁷⁸ 60-day letter of 152 Practitioners (note 1 *supra*), Exhibit 1 (PDF pages 42-66).

⁷⁹ See. e.g. discussion at § I.E starting at page 19 of our 60-day letter, and Exhibit 1 to our 60-day letter.)

⁸⁰ May 25, 2021 Supporting statement, note 27 *supra*, at 14.

⁸¹ Burden estimates from the public comment letters, ranging from \$200 million per year to \$600 million per year, are collected at footnote 10.

a \$300-700 million information collection burden on the public, so that the agency can save \$780,000 annually, is manifestly “disproportionate,” not approvable.

- The PTO has evaded statutory requirements for rulemaking and information collection clearance by imposing substantial regulatory content and burden via guidance.⁸² The PTO issued a guidance document for patent application filing. This document goes *far beyond* the regulation, requiring specific fonts, paragraph numbering, section headings, and the like. The PTO updates this guidance document from time to time *without* public notice, and then *applies it retroactively*. This violates the APA,⁸³ the *Good Guidance Bulletin*, and Commerce’s regulations governing component agencies’ use of guidance (15 C.F.R. § 29.2). The Supporting Statement explains why the PTO thought the guidance was beneficial (Response 14, at page 15), but does not dispute that the PTO’s guidance practices are unlawful, and that this guidance was issued without the requisite procedure.
- Rule 0651-AD31 involved **\$4 billion in fees**, and raises user fees by several hundred million dollars. It purported to create this DOCX information collection of \$200 to \$600 million per year, and another new information collection at about \$120 million per year.⁸⁴ Yet, the PTO claims that the rule is “not significant” for purposes of Executive Order 12866. 85 Fed. Reg. at 58283:

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

⁸² U.S. Patent and Trademark Office, *DOCX Conversion Services Errors and Warnings*, https://www.uspto.gov/sites/default/files/documents/DOCX_Feedback_Errors_and_Warnings.pdf (last updated Nov. 11, 2022). Note that the PTO understands that information it wishes to disseminate reliably must be in PDF, not DOCX. The PTO does not explain the double standard.

⁸³ *Appalachian Power Co. v. EPA*, 208 F.3d 1015, 1020 (D.C. Cir. 2000) (“The phenomenon we see in this case is familiar:” agency may not issue broad or vague regulations, and then flesh out the specific binding provisions by guidance); *Hocor v. Dep’t. of Agriculture*, 82 F.3d 165, 169-70 (7th Cir. 1996) (when regulation for zoo fences requires “such strength as appropriate ... [and] to contain the animals,” guidance requiring fences to be eight feet is not “interpretive.”); *U.S. v. Picciotto*, 875 F.2d 345, 347 (D.C. Cir. 1989) (regulation purported to permit the agency to impose “additional reasonable conditions and ... limitations” by guidance and wording on a permit; Court reminded agencies that they cannot grant themselves *ad hoc* substitutes for statutory rulemaking procedure).

⁸⁴ We commented on that uncleared \$120 million information collection in 2021 at <https://www.reginfo.gov/public/do/DownloadDocument?objectID=110309202> The PTO subsequently rescinded this rule.

- The PTO evaded review under Executive Order 12866 by claiming that this information collection was “expected to involve a transfer payment.”⁸⁵ There is no transfer payment. The \$ 4 billion in fees are used entirely for government consumption. The Supporting Statement does not dispute that the PTO’s characterization as a “transfer payment” was a falsehood.
- The PTO has imposed entirely unnecessary burden through untimely, inconsistent, and selective information dissemination. Since the information collection was published as a final rule, the PTO has issued three notices of delay. One was published **three days** before the information collection was due to go into effect.⁸⁶ On March 27, the PTO issued another notice of delay—but the PTO had “leaked” the delay to a few selected parties as early as March 9. This March 27 notice was only **one week** before the scheduled effective date. This stop-start-stop-start has forced the public to absorb transition costs multiple times, none of which are captured in the PTO’s estimates in the June 2023 60-day notice. The Supporting Statement does not respond, let alone disagree.
- The comments on the PTO’s May 2021 blog notice indicate a number of other issues with DOCX filing.⁸⁷ Some are software bugs and are potentially fixable; some raise questions that are inherent to DOCX and can never be fixed. The exhibits to our 60-day letter⁸⁸ includes many bug reports of many users, and reports the PTO’s non-response (and apparent indifference) to those comments. The fixable bugs aren’t getting fixed. The unfixable ones aren’t even acknowledged.

B. The DOCX rule cannot be cleared because the PTO keeps changing it without public consultation, § 1320.8 or EO 12866 procedure; OIRA ought not give the PTO a wildcard option

Since promulgating the regulation in August 2020, the PTO has issued several guidance documents changing the rule willy-nilly, *e.g.*, what can and can’t an applicant do to avoid the \$400 fee; of the duplicative submissions the PTO requests, which will be relied on by the PTO as authoritative and needs close review vs. which documents are pure annotation, etc. *None of*

⁸⁵ NPRM, 84 Fed. Reg. at 37400, col. 3; 37430, col. 2; Final rule, note 4, *supra*, at 46935, col. 1; 46972, col. 1-2; 46984 col. 3.

⁸⁶ *Setting and Adjusting Patent Fees During Fiscal Year 2020*, 86 Fed. Reg. 66192 (Nov. 22, 2021) (five weeks before effective date, delay implementation from Jan. 1, 2022 to Jan. 1, 2023); *Setting and Adjusting Patent Fees During Fiscal Year 2020, Final Rule*, 87 Fed. Reg. 80073 (Dec. 29, 2022) (**three days** before rule is to go into effect, delaying from Jan. 1, 2023 to April 3, 2023); *Setting and Adjusting Patent Fees During Fiscal Year 2020, Final Rule*, 87 Fed. Reg. 18052 (Mar. 27, 2023) (**seven days** before rule is to go into effect, delaying from April 3, 2023 to Jun. 30 2023).

⁸⁷ See Director’s Forum: A Blog from USPTO’s Leadership, *Modernizing patent filing with DOCX* (May 25, 2021), <https://www.uspto.gov/blog/director/entry/modernizing-patent-filing-with-docx>

⁸⁸ 60-day letter of 152 Practitioners (note 1 *supra*), Exhibits 5 and 6 (PDF pages 95-98).

these revisions have been subjected to notice and comment; none have had a § 1320.8 review. When the PTO takes action to reduce burden, the PTO characterizes it as “until further notice”—the PTO refuses to commit to low-burden alternatives permanently.⁸⁹ This willy-nilly, after-the-fact, amendment by guidance makes it impossible for OIRA to grant a clearance. Further, the practical implication of all these amendments made on-the-fly is that the PTO recognizes that its rule does not “minimize burden” at all, violating multiple provisions of the Paperwork Reduction Act.

As initially proposed in 2019, the proposed rule did not specify which copy would be the authoritative or evidentiary copy, and did not preclude the public from filing a “safety” PDF to ensure that an accurate statement of the intended content would be in the file.

In the final rule of August 2020, the PTO stated that *nothing* actually uploaded by the applicant would be considered “authoritative;” the authoritative copy would be a PDF created on the fly by the PTO’s unreliable internal software, with no opportunity to control, and little opportunity to review, the result for correctness.⁹⁰ The Final Rule, Response 48, 85 Fed. Reg. at 46956 had recognized that an opportunity to review the PTO-tampered PDF, prior to submission, was *essential* to any plausible implementation of the § 1.16(u) non-DOCX surcharge.

In June 2021, the PTO changed the rule **again**. This time the “authoritative document” or “source or evidentiary copy” would be a DOCX generated as a product of the PTO’s document tampering (86 Fed. Reg. at 29571, col. 1): Of course this is nonsense: a DOCX *has no authoritative meaning*. This is a retrograde change. At least when a PDF document was “authoritative,” it was possible for an applicant to reliably review it, with assurance that the applicant and PTO were viewing the same content. But a DOCX is not guaranteed to appear the same on the PTO’s computers and the applicant’s. Designating a DOCX as “authoritative” makes that bilateral common view impossible, and increases risk of failure. The June 2021 Amendment does not explain how reviewing the PTO’s “authoritative DOCX” on the applicant’s computer can provide the same reliability as review of a PDF, which is guaranteed to be platform independent.

Likewise, the June 2021 amendment announces that the PTO would discard everything filed by the Applicant, and keep only a version created on the fly by the PTO’s unreliable, undocumented internal software. 86 Fed. Reg. at 29571, 3rd col. The PTO’s policy set forth in June 2021, to dispose of all original documents violates the Federal Records Act. The PTO’s June 2021 policy will also put the PTO in violation of Federal Rule of Evidence 1002 the first time the PTO is asked to produce a certified copy of a file history for any court proceeding. The only apparent purpose of the June 2021 amendment, to discard all documents uploaded by the applicant, is to hide PTO errors introduced by its document tampering. This will add difficulty for any applicant who needs to show that an error was not present in what was uploaded, as opposed to created by the PTO’s internal software. From this fact, OIRA may infer bad faith.

⁸⁹ *Extension of Option*, note 20, *supra*, 88 Fed. Reg. 37036, 37036 col. 1.

⁹⁰ Final rule, note 4, *supra*, Response 70, 85 Fed. Reg. at 46960, col. 1.

The June 2021 amendment also explains a new policy: requests for correction must be made within one year (86 Fed. Reg. 29572 at col. 1). (a) The PTO states “applicants are advised to check the USPTO-generated versions as soon as practicable for any discrepancies or errors.” The PTO sought no additional Paperwork clearance for this “check.” (b) “Applicants should not expect to have a request to correct the electronic record granted if the request is based on the source or evidentiary copy and it is filed more than one year after submission of the document.” 86 Fed. Reg. 29572 col. 1. This is a Catch-22: the first time an applicant has access to an electronic copy of the text that the PTO extracts from a patent application is when the application is published, typically at 18 months. 35 U.S.C. § 122. The PTO provides no earlier access to the rendering of any DOCX file *as the PTO’s computers render it*. A “review” of a DOCX file *on the applicant’s computer* cannot yield reliable information to know what the PTO will consider to be its internally held DOCX. Correction cannot be sought in one year if the applicant has no idea what the PTO’s current text of record is until 18 months. And finally, it turns the Paperwork Reduction Act on its head for the agency to concede that its document processing is so faulty that it must “advise [applicants] to check the USPTO-generated versions as soon as practicable for any discrepancies or errors.” It’s the agency’s job to do the work correctly in the first place, not to ask the public to clean up the messes.

In the June 2021 amendment, the PTO states that efforts to guard against PTO error by filing a (reliable) PDF along with the (unreliable) DOCX will be penalized (86 Fed. Reg. 29571 col. 3).

In April 2022, the PTO announced that, for a period of time ending December 31, 2022, the PTO would allow patent applicants to submit a back-up, applicant-generated PDF version of the application along with the DOCX file, to serve as a basis for error correction.⁹¹ Even in this notice, the PTO explained that the cost of correcting errors introduced by the PTO’s unreliable, undocumented internal software would fall on the applicant, *not* the PTO.

In April 2023, the PTO stated that it would only save that PDF for one year—but typically the first time the PTO gives notice of how it renders a DOCX is at eighteen months. The PTO has identified no exemption from the general obligation under the Federal Records Act to preserve documents. Nor has the PTO identified any manner in which the PTO could comply with the “original document” requirement of Federal Rule of Evidence 1002.

In a salvage effort, on the same day as the PTO’s 60-day notice, the PTO published a notice extending the right to file a PDF auxiliary document.⁹² This extension is expressly temporary: only “until further notice.”

As the public has gained experience with DOCX filing, it has become clear that even a DOCX-with-a-PDF-check-document is *not* a workable approach. During conversations with the PTO in January to March 2023, signatories of this letter explained why not. These letters are

⁹¹ *Filing Patent Applications in DOCX Format*, 87 Fed. Reg. 25226 (April 28, 2022).

⁹² *Extension of the Option* (Jun. 6, 2023), note 20, *supra*, 88 Fed. Reg. 37036.

attached as an exhibit to our 60-day comment letter.⁹³ The PTO has never explained any disagreement with that letter, and does not offer any explanation in its Supporting Statement now.

Likewise, in the 60-day comment letters,⁹⁴ the public asked the PTO to explain how this is not an “unnecessarily duplicative” collection, forbidden by 44 U.S.C. § 3506(c)(3)(B); 5 C.F.R. § 1320.5(d)(1)(ii), and how the PTO’s proposal to shift the cost of correcting the errors introduced by the PTO’s unreliable software is not an improper “shift of costs onto the public” forbidden by § 1320.5(d)(1)(iii). The PTO addresses neither challenge. OIRA may take the PTO’s silent concessions as further basis to deny the clearance.

In the Supporting Statement (Response 10, at page 12), the PTO states “ the USPTO has extended indefinitely the option to submit an applicant-generated PDF of the application along with the validated DOCX file(s) when filing an application in Patent Center. That is a misrepresentation. The relevant Federal Register notice only extends the option “until further notice.”⁹⁵ The word “indefinitely” does not appear, let alone the word “permanently.” Given the PTO’s history, this appears to be no more than a “bait and switch” to be later changed via further “guidance” without notice and comment or § 1320.8 procedure.

It’s possible that these rule changes—especially the June 2021 amendment—have a legitimate purpose. That legitimate purpose is, however, not apparent to the signatories of this letter, and that purpose has never been articulated by the PTO. Some of the amendments, particularly the statement in June 2021 that the PTO would charge the \$400 fee for submitting a “safety PDF” (see page 12) have no explanation other than PTO malevolence.

Several of these changes are amendments to rules that required notice-and-comment under the PTO’s fee setting statute and under the Paperwork Reduction Act. Yet the PTO never did so for *any* of them.

The upshot is that the regulatory text has *no stable meaning*. It is not “written using plain, coherent, and *unambiguous* terminology,” 44 U.S.C. § 3506(c)(3)(D). The PTO exploits the ambiguity to create a moving target. OIRA cannot meaningfully assess burden estimates, and cannot give a meaningful clearance, until the PTO issues a permanent *regulation* with proper procedure under § 1320.8 and .9.

⁹³ Letter of Feb. 10, 2023, Attachment 10 to 60-day letter of 152 Practitioners (note 1 *supra*), at PDF pages 148-155.

⁹⁴ 60-day letter of 152 Practitioners (note 1 *supra*), at pages 22-23.

⁹⁵ *Extension of the Option* (Jun. 6, 2023), note 20, *supra*, 88 Fed. Reg. 37036, 37036 col.3.

V. The “auxiliary PDF” approach has not been submitted for clearance, and doesn’t solve the problem

During both the NPRM comment period and during the 60-day comment period, several of our colleagues proposed a duplicative filing approach: the applicant would file *both* a DOCX and an “auxiliary” PDF as a check document and error-correction reference. A co-author of this letter was an advocate of that approach. With experience, we suggest that that proposal is unworkable.

- The proposal has not been cleared in the past, and is not submitted for clearance with this ICR. The PTO proposed it in a Federal Register notice that was issued with no request for notice-and-comment,⁹⁶ and with no observance of § 1320.8 procedure. At the very least, this change to the rule and information collection should observe full-dress procedure, with a do-over from the beginning. The PTO cannot complain—they made the choice to sidestep OIRA procedure and defy OIRA authority, as we describe in § IV.A starting at page 22
- In earlier incarnations of the DOCX rule, the PTO insisted that it would *not* accept an auxiliary DOCX.⁹⁷ Unless this is promulgated as a formal CFR regulation, the PTO will have the inclination to play “bait and switch” in the future and withdraw this option. Indeed, the PTO’s last Federal Register notice characterized the current state as an “extension until further notice,” not a permanent change to the information collection.⁹⁸ It should not be cleared now.
- Legally, this is a classic case of “unnecessarily duplicative” submission, forbidden by 44 U.S.C. § 3506(c)(3)(B).
- Technologically, it concedes the issue. The whole point of this duplicative submission scheme is a concession that DOCX is unreliable as a filing medium, and requires an error correction mechanism.⁹⁹ No one disputes that text-based PDF (the PDFs that applicants file today, before the PTO flattens them to bitmaps) are 100% reliable, and that with a little software engineering, the PTO can extract text from them with *better* reliability than with DOCX. The Supporting Statement offers no response to this issue, let alone explain how a DOCX that is unreliable alone suddenly becomes reliable because of a duplicative submission.

⁹⁶ *Filing Patent Applications in DOCX Format*, note 91 *supra*, 87 Fed. Reg. 25226.

⁹⁷ *Submitting Patent Applications in Structured Text Format* (note 20, *supra*), 86 Fed. Reg. at 29571, col. 3.

⁹⁸ *Extension of Option*, note 20, *supra*, 88 Fed. Reg. 37036, 37036 col. 1.

⁹⁹ See letter of February 14, 2023, attached as Exhibit 10 to 60-day letter of 152 Practitioners (note 1 *supra*), PDF pages 149-155.

- Under the “auxiliary PDF” proposal, the PTO extracts text from the unreliable DOCX, and then puts the burden back on the applicant to detect the errors, and seek correction. This ICR expressly does *not* seek clearance for the incremental filings of those error correction papers. This was raised in the 60-day comment letters;¹⁰⁰ the Supporting Statement offers no disagreement.
- The PTO’s own “survey” (relied on in its NPRM and final rule Federal Register notices) estimated that usage of non-DOCX word processors (pre-2007 versions of Word, Libre Office, Google Docs, Apple Pages, LaTeX, etc.) at about **20%**¹⁰¹ As we explained in our 60-day letter, while those non-Microsoft word processors can generate a file that nominally has a “DOCX” file name, it is not reliable.¹⁰² The issue has been fairly raised with the PTO; the Supporting Statement offers not a word of response.

VI. Appropriate information technology under § 3504—five design imperatives

OIRA has authority to oversee the PTO’s deployment of information technology, including to “oversee the use of information resources to improve the efficiency and effectiveness of governmental operations to serve agency missions, including burden reduction and service delivery to the public. ... [OIRA] shall ... provide direction and oversee ... the ... use of information technology.” 44 U.S.C. § 3504(a)(1)(B)(vi), (c)(2), (h)(1)(A) .

Many of the signatories of this letter are former software engineers. Good software engineering starts with identifying customers’ design imperatives. Over the course of multiple comment periods, the public noted five fundamental design imperatives for a patent application filing system. In discussions with the agency in January to March 2023, these were consolidated in one document.¹⁰³ The PTO has never disputed that these must be the governing design imperatives for “appropriate information technology” for patent application filing:

Imperative 0: Correctness first. Correctness may (nearly) never be compromised for “efficiency” or cost. This is especially true here—the law of new matter (35 U.S.C. § 132) makes post-filing correction of errors nearly impossible.

Imperative 1: The file that the applicant uploads must be the authoritative document. No changes, no “validation” if that means change or replacement. The applicant’s uploaded bits are authoritative, and must be retained indefinitely, as the legally-

¹⁰⁰ 60-day letter of Kilpatrick Townsend & Stockton LLP, note 5, *supra*, at pages 3-4; 60-day letter of 152 Practitioners (note 1 *supra*), at pages 149-155.

¹⁰¹ NPRM, 84 Fed. Reg. at 37413 col. 2. The PTO violated the Information Quality Act, as we discuss in footnote 29.

¹⁰² 60-day letter of 152 Practitioners (note 1 *supra*), at pages 24-25; 60-day letter of 107 Practitioners, note 10, *supra*, at 5-7.

¹⁰³ 60-day letter of 152 Practitioners (note 1 *supra*), Exhibit 9, at 146-147.

authoritative form. These are legal documents, evidence for litigation. The best evidence rule (Federal Rule of Evidence 1002) applies. Inevitably, the best-engineered system will still run into errors. Sound engineering design dictates that the system must be designed to minimize the path between file upload and authoritative archival storage, in order to minimize the chance for screw-up. At most, the system may add a time stamp and page numbering (analogous to the federal courts' ECF system).

Imperative 2: What You See Is What I Get. The file specification (perhaps ISO standard) for the authoritative file must guarantee that anyone, anywhere, any time, that opens or prints the authoritative document will see the same rendering in content and visual layout.

Imperative 3. Standards matter—but only if the guarantees of the standard match up to the correctness needs of the application. Imperative 2 implies that a usefully---applicable standard is one that is designed to ensure portability and uniform reproducibility. A standard that is designed to adapt the document to each computer it's opened on, that has a great many "implementation defined" parameters, or that is designed to encourage extensions and plug-ins, is not a useful standard for patent application filing.

Imperative 4. Any implementation must meet the requirements of the Paperwork Reduction Act. Rulemaking must observe the procedures of the Administrative Procedure Act, Paperwork Reduction Act, Regulatory Flexibility Act, and Executive Order 12866.

The right technological solution is to do what *every* other Federal court and agency does: accept text-based PDF filings, and maintain them exactly as they are filed, without downgrading them to image-based bitmap PDF as the PTO does today. The right resolution for both the PTO and the public is to simplify the PTO's software systems, and remove one unnecessary component from the PTO's current filing software, the component that flattens text-based PDFs to bitmaps. If the PTO simply removed this component, and kept the exact files that users submit without degrading them, *and* required text-based PDFs from those relatively few filers who currently file bitmap PDFs, the PTO would have *exactly* what it needs, at near-zero burden for the public (relative to today's practice).

Any go-forward plan should start from those imperatives.

VII. A half-billion dollar bootleg

As fully explained in our 60-day letter,¹⁰⁴ seven months ago, the PTO promulgated a bootleg that imposes \$200 to \$500 million of annual burden, and substantially weakens the notice that competitors have when they analyze portfolios for their own infringement analyses.

¹⁰⁴ 60-day letter of 152 Practitioners (note 1 *supra*), at pages 29-32.

That information collection was imposed by guidance, with no procedure and no clearance whatsoever, and is substantially similar to information collections that OIRA disapproved in 2008 and in 2009.

The Supporting Statement claims that “This new information collection addresses DOCX filings separately from 0651-0032 for efficiency due to the large size of 0651-0032 and to allow the public and the OIRA to consider this collection on its own terms.” The PTO’s explanation is improbable. The PTO regularly files ICR’s with similar scope of amendment to 0651-0031 and -0032. Whatever the agency’s subjective intent behind the odd “new” control number, the effect is to conceal this nine-figure bootleg from OIRA, and to evade OIRA oversight of an information collection that OIRA quashed in 2008 and 2009. Our 60-day letter explained why that uncleared bootleg should be ordered rescinded. The Supporting Statement offers no disagreement.

VIII. Conclusions

OIRA should issue an order pursuant to 5 C.F.R. § 1320.12(f) specifying that:

- Clearance *for the underlying information collection itself* (as opposed to “adjusting existing ways to comply”) is not requested by the PTO’s ICR (see § II starting at page 14 of this letter). Terms of Clearance should expressly state that no clearance extends to burden of “completing and reviewing” the underlying information collection. If the underlying collection is uncleared, the “adjusting” that the ICR requests should be denied as well.
- Under § 1320.12(f)(2), OIRA should order the PTO to rescind the relevant regulation, 37 C.F.R. § 16(u) and all associated guidance, within 60 (and no more than 120) days. OIRA should require that the PTO observe Information Quality principles in explaining the reason for the rescission, not the euphemistic mis-explanations given in past notices of rescission.
- Because the PTO has no clearance for collecting information in DOCX form, OIRA should order the PTO to decommission the relevant software within 60 (and no more than 120) days.
- During those 60 (and no more than 120) days, the PTO may not impose uncleared burden. The PTO seeks no clearance for burden created by guidance. Terms of Clearance should exclude burden by *guidance* (whether written document or by software enforcement), and should require the PTO to absorb costs of correcting errors introduced by the PTO’s software (the PTO has never requested clearance for the burden of error correction, so the PTO should arrange to internalize those costs to the maximum degree possible).

- Because the PTO does not seek clearance for burden of correcting errors introduced by the PTO’s software bugs,¹⁰⁵ the PTO should forthwith publish guidance explaining how the PTO will absorb those error correction costs, rather than shifting those costs to the public (as under the PTO’s current guidance).

The PTO will suffer no prejudice, and DOCX is not “necessary for the proper function of the agency,” as we explained in our 60-day comment letter¹⁰⁶—and the Supporting Statement offers not a word of disagreement. The only costs to the PTO are sunk costs, and saving face—we suggest that switching to text-based PDF will *save* the PTO money in even a medium term. First, of course, sunk costs are a fallacy; no rational software manager considers them. The relevant costs are future costs. There, it is highly likely that the PTO’s future costs for DOCX are greater than future costs for PDF. DOCX as a format is far more complex than PDF, far less reliable, and changes at Microsoft’s whim—DOCX is a greased pig that the PTO can never catch.

- PDF is designed for static documents. DOCX is designed for editing. The complexity is entirely different.
- The PDF standard ISO/IEC is 750 pages, plus 24 more for PDF/UA. In contrast, the 2012 version of the DOCX standard is 6764 pages—*nearly nine times larger*. In other words, even if the PTO believes that its DOCX implementation implements 88% of the standard,¹⁰⁷ it’s almost certainly better to abandon the sunk costs, and start over with PDF.
- The underlying implementation of DOCX and PDF are essentially similar—the file starts with a table of contents, and then has a series of blocks of content. Almost certainly, the PTO can retarget its existing software to PDF less expensively than continuing to chase the impossible.

If the PTO argues sunk costs, the reason for those high costs is simple: the PTO made a ill-informed engineering choice for a complex solution, and then failed to self-correct after public comment, and evaded OIRA review under both Executive Order 12866 and the Paperwork Reduction Act. PDF is the simpler solution. Almost certainly, pulling the plug on this DOCX fiasco, and reorienting around PDF will save the PTO money and aggravation in a short number of years. OMB should help PTO get out of digging a hole that can never reach bottom, and remind that PTO that defying OIRA authority is a game with no winners.

OIRA should further exercise its authority under 44 U.S.C. § 3504(a)(1)(B)(vi) and § 3504(c)(2) to oversee the PTO’s adoption of appropriate information technology, based on the

¹⁰⁵ The disconnect between the information collection, the 60-day notice, and the Supporting Statement is explained in § II starting at page 14 of this letter.

¹⁰⁶ 60-day letter of 152 Practitioners (note 1 *supra*), at pages 28-29

¹⁰⁷ It’s far below that, as we showed in

imperatives we outline of § VI starting at page 33 of this letter. The PTO’s “yearlong study” of 2015¹⁰⁸ and the public comment letters conclude that the appropriate vehicle for filing patent applications is text-based PDF (as opposed to bitmap PDFs or DOCX). Some comment letters have suggested that the best approach is likely to be the subvariant “PDF/A,” which the PTO has never disputed. However, that can be left to the PTO’s determination during a properly-conducted notice-and-comment rulemaking, after proper “consultation with members of the public” as required by § 3506(c)(2)(A).

As we wrote in our letters of December 2020¹⁰⁹ and our 60-day letter¹¹⁰, the DOCX information collection has reached this stage because of a series of poor engineering decisions, covered up by procedural shortcutting, evasion of procedure, false representations, and falsified certifications by the PTO to OIRA, . A fair inference is that these false statements were given intentionally to evade OIRA review of the PTO’s predetermined outcome. If a private sector entity gave similar falsified certifications to a government agency, persons that signed off on the falsification would be subject to criminal prosecution, and any lawyers would be subject to discipline, up to and including disbarment. OIRA should conduct a full investigation to identify the people in the PTO responsible for the pattern of false representations and certifications so that they can be subject to similar consequences.

Point of contact. A single point of contact can refer specific issues to specific authors of various sections of this letter. Please route any questions or further inquiries to David Boundy, DavidBoundyEsq@gmail.com, (646) 472-9737.

Respectfully submitted,

123 Intellectual Property Practitioners

Exhibits:

Exhibit 12. Pages from FOIA request F-21-000215, showing redactions in probable violation of 44 U.S.C. § 3507(e)(2)

Exhibit 13. ECMA-376, *Office Open XML file formats* (4th Ed. 2012)

Exhibit 14. ISO Standard ISO/IEC 29500-1, *Information technology — Document description and processing languages — Office Open XML File Formats* (Third ed. 2012-09-01)

¹⁰⁸ 60-day letter of 152 Practitioners (note 1 *supra*), Exhibit 1 (PDF pages 42-66).

¹⁰⁹ <https://www.reginfo.gov/public/do/DownloadDocument?objectID=107472702> and <https://www.reginfo.gov/public/do/DownloadDocument?objectID=107472802>

¹¹⁰ 152 Practitioners 60-day letter, note 1 *supra*, Exhibit 9, at 23-28.

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Exhibit 12

**Pages from FOIA request F-21-000215, showing
redactions in probable violation of 44 U.S.C.
§ 3507(e)(2)**

From: Fraser, Nicholas A. EOP/OMB
Sent: 27 Jul 2020 14:12:31 +0000
To: Oettinger, Nicolas
Cc: Choe, Tricia; Lee, Kyu S.; Matich IV, Nicholas T.; Stewart, Coke
Subject: RE: USPTO Patent Fee Rule revisions

(b)(5) Delib Proc Priv

-Nick

From: Oettinger, Nicolas <Nicolas.Oettinger@USPTO.GOV>
Sent: Friday, July 24, 2020 3:33 PM
To: Fraser, Nicholas A. EOP/OMB <Nicholas_A._Fraser@omb.eop.gov>
Cc: Choe, Tricia <Tricia.Choe@USPTO.GOV>; Lee, Kyu S. <kyu.lee@USPTO.GOV>; Matich IV, Nicholas T. <Nicholas.Matich@USPTO.GOV>; Stewart, Coke <Coke.Stewart@uspto.gov>
Subject: RE: USPTO Patent Fee Rule revisions

Okay, thanks.

(b)(5) Delib Proc Priv

Thank you again for turning this one around so quickly.

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From: Fraser, Nicholas A. EOP/OMB <Nicholas_A._Fraser@omb.eop.gov>
Sent: Friday, July 24, 2020 3:31 PM
To: Oettinger, Nicolas <Nicolas.Oettinger@USPTO.GOV>
Cc: Choe, Tricia <Tricia.Choe@USPTO.GOV>; Lee, Kyu S. <kyu.lee@USPTO.GOV>; Matich IV, Nicholas T. <Nicholas.Matich@USPTO.GOV>; Stewart, Coke <Coke.Stewart@uspto.gov>
Subject: RE: USPTO Patent Fee Rule revisions

(b)(5) Delib Proc Priv

-Nick

From: Oettinger, Nicolas <Nicolas.Oettinger@USPTO.GOV>
Sent: Wednesday, July 22, 2020 9:47 AM
To: Fraser, Nicholas A. EOP/OMB <Nicholas.A.Fraser@omb.eop.gov>
Cc: Choe, Tricia <Tricia.Choe@USPTO.GOV>; Lee, Kyu S. <kyu.lee@USPTO.GOV>; Matich IV, Nicholas T. <Nicholas.Matich@USPTO.GOV>; Stewart, Coke <Coke.Stewart@uspto.gov>
Subject: RE: USPTO Patent Fee Rule revisions

Nick – thank you.

(b)(5) Delib Proc Priv

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Subject: RE: USPTO Patent Fee Rule revisions

Hi Nick,

(b)(5) Delib Proc Priv


(b)(5) Delib Proc Priv

Thanks. –Nick

From: Oettinger, Nicolas <Nicolas.Oettinger@USPTO.GOV>
Sent: Tuesday, July 21, 2020 8:31 PM
To: Fraser, Nicholas A. EOP/OMB <Nicholas.A.Fraser@omb.eop.gov>
Cc: Choe, Tricia <Tricia.Choe@USPTO.GOV>; Lee, Kyu S. <kyu.lee@USPTO.GOV>; Matich IV, Nicholas T. <Nicholas.Matich@USPTO.GOV>; Stewart, Coke <Coke.Stewart@uspto.gov>
Subject: [WARNING: A/V UNSCANNABLE]RE: USPTO Patent Fee Rule revisions

Nick,

(b)(5) Delib Proc Priv



Please let us know if you have any questions or would like to discuss.

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Sent: Tuesday, July 21, 2020 3:08 PM
To: Oettinger, Nicolas <Nicolas.Oettinger@USPTO.GOV>
Cc: Choe, Tricia <Tricia.Cho@USPTO.GOV>; Lee, Kyu S. <kyu.lee@USPTO.GOV>
Subject: RE: USPTO Patent Fee Rule revisions

Ok thanks.

From: Oettinger, Nicolas <Nicolas.Oettinger@USPTO.GOV>

Sent: Tuesday, July 21, 2020 9:54 AM

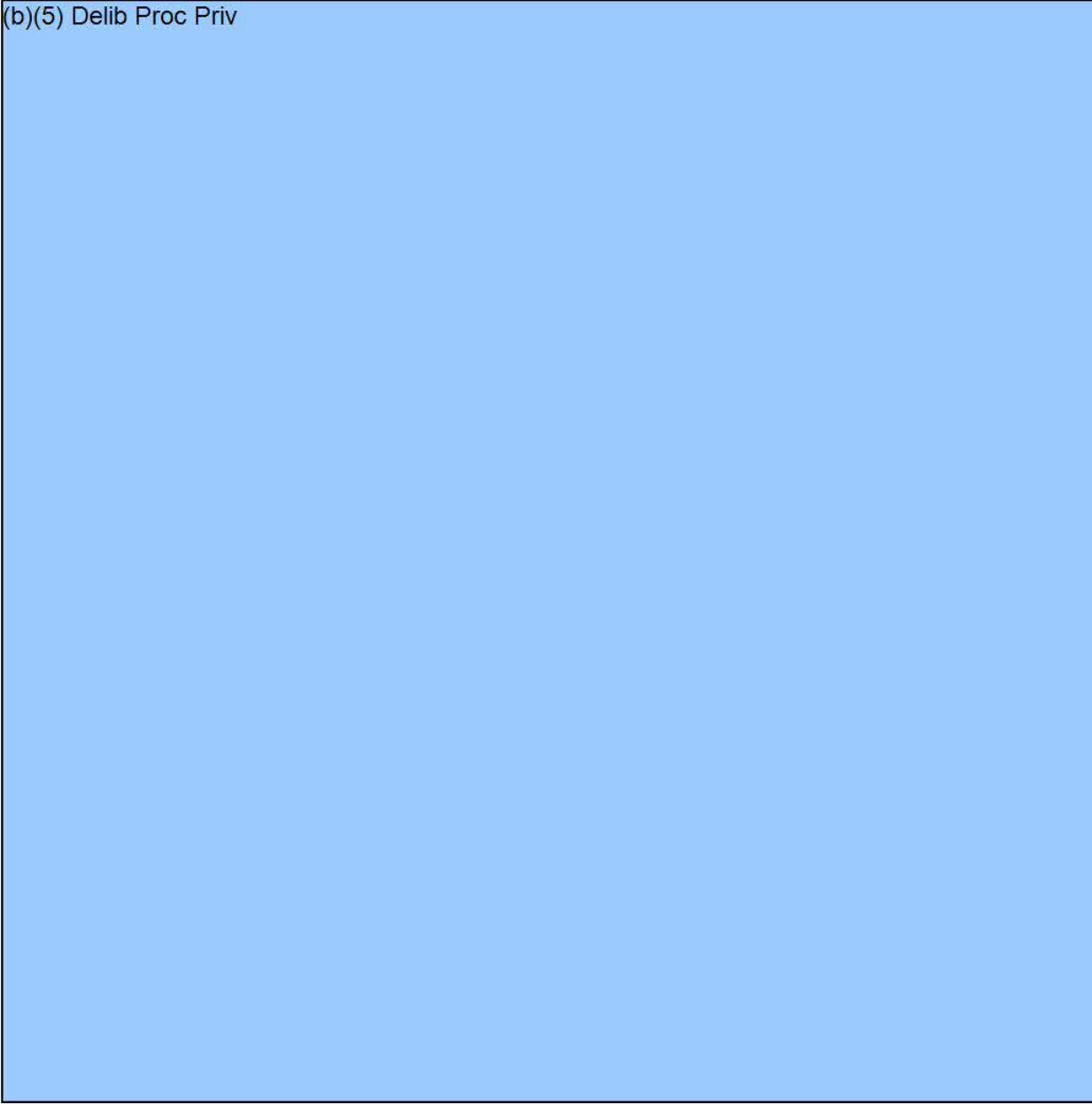
To: Fraser, Nicholas A. EOP/OMB <Nicholas.A.Fraser@omb.eop.gov>

Cc: Choe, Tricia <Tricia.Cho@USPTO.GOV>; Lee, Kyu S. <kyu.lee@USPTO.GOV>

Subject: USPTO Patent Fee Rule revisions

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From: Choe, Tricia
Sent: 8 Apr 2020 20:16:38 +0000
To: Fraser, Nicholas A. EOP/OMB
Cc: Oettinger, Nicolas; Lee, Kyu S.
Subject: RE: Setting and Adjusting Patent Fees During Fiscal Year 2020 RIN 0651-AD31
Attachments: Patents Final Rule_clean_407.docx

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From: Fraser, Nicholas A. EOP/OMB <Nicholas_A._Fraser@omb.eop.gov>
Sent: Tuesday, April 7, 2020 12:00 PM
To: Choe, Tricia <Tricia.Choe@USPTO.GOV>
Cc: Oettinger, Nicolas <Nicolas.Oettinger@USPTO.GOV>; Lee, Kyu S. <kyu.lee@USPTO.GOV>
Subject: RE: Setting and Adjusting Patent Fees During Fiscal Year 2020 RIN 0651-AD31

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From: Choe, Tricia <Tricia.Choe@USPTO.GOV>
Sent: Wednesday, April 1, 2020 2:39 PM
To: Fraser, Nicholas A. EOP/OMB <Nicholas_A._Fraser@omb.eop.gov>
Cc: Oettinger, Nicolas <Nicolas.Oettinger@USPTO.GOV>; Lee, Kyu S. <kyu.lee@USPTO.GOV>
Subject: RE: Setting and Adjusting Patent Fees During Fiscal Year 2020 RIN 0651-AD31

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From: Fraser, Nicholas A. EOP/OMB <Nicholas.A.Fraser@omb.eop.gov>
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Subject: RE: Setting and Adjusting Patent Fees During Fiscal Year 2020 RIN 0651-AD31

Hello all, (b)(5) Delib Proc Priv attached.

(b)(5) Delib Proc Priv

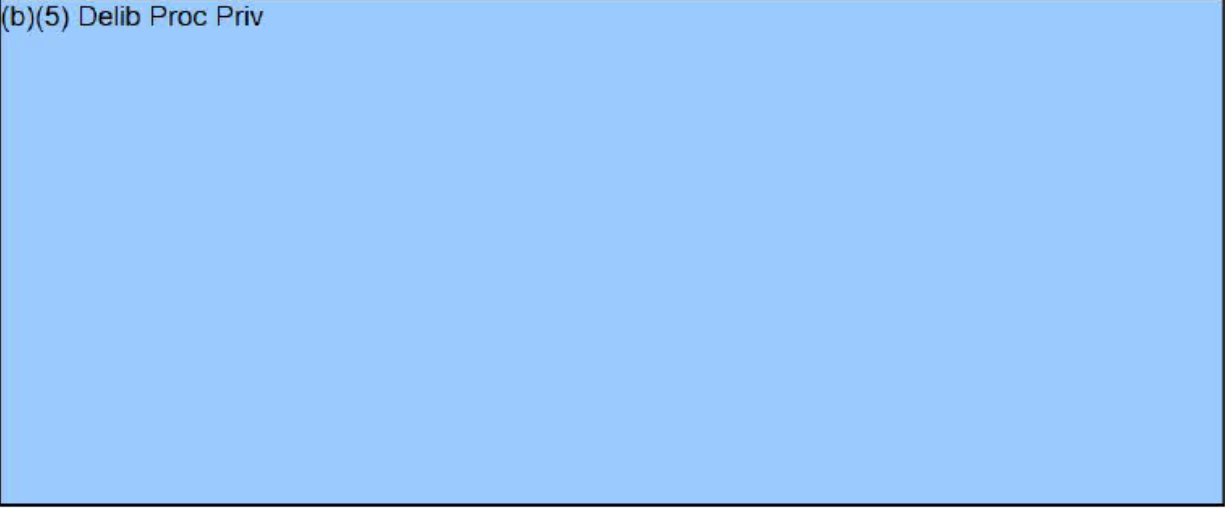
-Nick

From: Choe, Tricia <Tricia.Choe@USPTO.GOV>
Sent: Friday, March 13, 2020 2:07 PM
To: Fraser, Nicholas A. EOP/OMB <Nicholas.A.Fraser@omb.eop.gov>
Cc: Oettinger, Nicolas <Nicolas.Oettinger@USPTO.GOV>; Lee, Kyu S. <kyu.lee@USPTO.GOV>
Subject: [WARNING: A/V UNSCANNABLE]Setting and Adjusting Patent Fees During Fiscal Year 2020 RIN 0651-AD31

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If you have any questions or need any other information on the rule please let us know.

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From: Choe, Tricia
Sent: 16 Mar 2020 15:20:20 +0000
To: Fraser, Nicholas A. EOP/OMB
Cc: Oettinger, Nicolas; Lee, Kyu S.
Subject: RE: Setting and Adjusting Patent Fees During Fiscal Year 2020 RIN 0651-AD31

Thanks Nick. The rule is submitted in ROCIS.

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Sent: Monday, March 16, 2020 10:59 AM
To: Choe, Tricia <Tricia.Choe@USPTO.GOV>
Cc: Oettinger, Nicolas <Nicolas.Oettinger@USPTO.GOV>; Lee, Kyu S. <kyu.lee@USPTO.GOV>
Subject: RE: Setting and Adjusting Patent Fees During Fiscal Year 2020 RIN 0651-AD31

Thanks please submit it into ROCIS when you are able.

-Nick

From: Choe, Tricia <Tricia.Choe@USPTO.GOV>
Sent: Friday, March 13, 2020 2:07 PM
To: Fraser, Nicholas A. EOP/OMB <Nicholas_A._Fraser@omb.eop.gov>
Cc: Oettinger, Nicolas <Nicolas.Oettinger@USPTO.GOV>; Lee, Kyu S. <kyu.lee@USPTO.GOV>
Subject: [WARNING: A/V UNSCANNABLE]Setting and Adjusting Patent Fees During Fiscal Year 2020 RIN 0651-AD31

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