

October 27, 2023

Via regulations.gov

Dominic Mancini and Nicholas A. Fraser
Office of Information and Regulatory Affairs
Office of Management and Budget
725 17th St. NW
Washington, D.C.

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:

I previously submitted comments (ID PTO-P-2023-0031-0007) on the Notice of Information Collection in which I argued in favor of submitting patent applications to the USPTO with an optional, auxiliary DOCX formatted document in addition to PDF/A formatted document. After reading other's comment letters, I now agree with other commenters that a duplicative filing rule permitting both DOCX and PDF/A is both contrary to law and technologically unworkable. Specifically in this regard, I refer in support to "Comment by 152 Patent Practitioners, PTAAARMIGAN" (ID PTO-P-2023-0031-0008) and to "Comment by One Hundred Seven Patent Practitioners" (ID PTO-P-2023-0031-0010). As a result, I withdraw the portion of my previous comment that supported filing an optional, auxiliary DOCX formatted document in addition to PDF/A formatted document. Nevertheless, I reiterate and supplement below the remainder of my previous comment.

The USPTO proposal to mandate DOCX filing is fundamentally misguided in that it removes applicants' ability to control the accuracy of their specifications, claims, and abstracts. This need grossly outweighs any USPTO desire for increasing processing efficiency, such as reiterated throughout its Supporting Statement.

In any system of filing structured text, applicants must retain certainty in knowing that filed documents are accurate. Applicants should not be penalized with increased fees for choosing to guarantee the accuracy of applications by filing a PDF/A as the official application generated under their own control. Instead, the USPTO should reduce fees for those who file an ISO 19005-1 compliant PDF/A document, which is fully text searchable and accessible. No need exists for the USPTO to engage in the practice of DOCX to PDF conversion and modifying originally-submitted documents.

In its Supporting Statement, the USPTO's response to Comment 13 discusses the review burden placed on applicants because the USPTO modifies ("validates") applicants' DOCX applications uploaded in Patent Center when the USPTO produces the so-called "authoritative" DOCX. That is, applicants upload an original DOCX document that includes the content desired.

The USPTO then modifies (“validates”) the original document by some unknown software that has not been publicly disclosed and produces the authoritative document. Then, applicants compare the authoritative DOCX to the original DOCX to ascertain whether the USPTO modification introduced any content errors. In past experience, errors introduced by the USPTO modification do not occur in PDF/A documents generated directly from applicants’ word processors. When the USPTO modification introduces an error, applicants have no recourse other than to file the application as a PDF document and pay the \$400 penalty. Accordingly, such applicants pay a penalty for an error that was caused by the USPTO.

In its Supporting Statement, the USPTO’s response to Comment 4 asserts, “The USPTO continuously performs rigorous testing to ensure that document integrity is preserved.” Even so, from the time that the USPTO released its final version of the unknown software to the present, various patent professionals and organizations have reported numerous errors. The “rigorous testing” did not uncover those errors in the final version. This was not beta-testing software, this was final version software that was supposedly reliable and ensured “document integrity,” the same claim the USPTO makes for its current version of the unknown software.

Although the USPTO has apparently produced numerous versions of its unknown software, the USPTO has never, to my knowledge, released any information to applicants concerning how applicants may expect software performance to change over time. And yet, software performance has changed over time. USPTO has never described what errors were corrected nor has USPTO described when updates were being released. Instead, the USPTO expects applicants blindly to compare the authoritative DOCX to the original DOCX to ascertain whether the USPTO “validation” introduced any content errors. Applicants are not informed when a new update is released that might introduce new errors or re-introduce old errors.

From the inception of Patent Center in 2020, I encountered a repeated error in which the USPTO DOCX validation and/or PDF conversion with its unknown software changed original patent claims in DOCX patent applications and started new paragraphs in the middle of the original paragraphs, mangling them into nonsense. USPTO rigorous testing from 2020 to 2023 did not resolve this error and I elected not to file applications in DOCX.

As USPTO pressure increased to advance DOCX filing, I reported the error to the Electronic Business Center in an email dated 1/26/2023 (Exhibit 1), attaching several sample documents and explaining how to generate the error. I received no reply. The error persisted and I repeated my report in an email dated 4/6/2023 (Exhibit 2), this time without sample documents. I initially received a reply that my request was escalated to Ticket Number 1-827987218 and to wait 10-14 days for a response. Id. I received no response. In an email dated 8/7/2023, I requested a status of the escalated ticket and received a request to send sample documents for troubleshooting. Id. Although I still had the original sample documents, I re-checked the uploads in Patent Center and noticed the error did not occur. See, id. It is not possible for me to know whether that means the system was updated to resolve the problem or

whether this problem will arise again. The USPTO has not acknowledged, in any manner of which I am aware, the existence of this error or its repair.

No reliable process exists wherein errors introduced by USPTO validation/conversion, but not detected during the filing process, may be corrected without being subject to the risk of the patent application being fatally rejected for adding impermissible new matter. Currently, the USPTO requires applicants to agree to accept the DOCX validation(s) as their final submission produced by the USPTO's unreliable validation and conversion tool. The USPTO's response to Comment 10 in the Supporting Statement alleges it "will keep copies of the applicant-generated PDF as part of the permanent record" and "the USPTO has extended indefinitely the option to submit an applicant-generated PDF of the application along with the validated DOCX." These allowances are directly contrary to USPTO intentions announced previously.

Initially, USPTO would not allow any backup PDF submission without paying the PDF penalty. USPTO relented somewhat and agreed to accept PDF submissions for a limited transitional time and to retain PDFs temporarily. The relevant Federal Register notice cited by the USPTO under Comment 10 now only extends the option "until further notice." The word "indefinitely" does not appear, let alone the word "permanently." It appears no legal obligation exists for the USPTO "indefinitely" to permit backup PDF/A submissions and to retain them "permanently." Instead, the USPTO may simply issue "guidance" without notice and comment or § 1320.8 procedure and bring an end to those options.

It is disingenuous for the Supporting Statement to indicate in section A.1. "All applicants have been able to file applications in the DOCX format in the Patent Center since April 2020." Such filing has only been available for applicants willing to take the substantial risk that their filings will be inaccurate.

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

Respectfully yours,

James E. Lake

Exhibit 1

James E. Lake

From: James E. Lake
Sent: Thursday, January 26, 2023 10:19 AM
To: 'EBC@uspto.gov'
Subject: Patent Center converted document errors
Attachments: Patent_app_sample A-feedback.docx; Patent_app_sample B-APP.TEXT.pdf; Patent_app_sample B-APP.TEXT.docx; Patent_app_sample B-feedback.docx; Patent_app_sample A-APP.TEXT.pdf; Patent_app_sample A-APP.TEXT.docx; Patent_app_sample A.docx; Patent_app_sample B.docx; Comparison.docx

Most of the time, when I try uploading a non-provisional utility application in docx format to Patent Center, it changes the claim numbering so the uploaded application no longer matches the original. Occasionally, a docx application will work for an unexplained reason. I attempted to find the reason for the different result by copying the identical text and formatting into one docx file that worked and another docx file that did not work.

Attached please find sample docx applications A and B authored using the same computer and the same version of MS Word and based on my same template that I use for drafting patent applications. There is no discernable difference whatsoever within my capability between sample A and sample B. Using the MS Word Compare tool (output attached), they appear identical. When I upload these samples to Patent Center, app A works fine and produces the attached feedback document, processed docx, and PDF. App B does not work and the PTO manipulation mangles the claims, producing the attached feedback document, processed docx, and PDF.

Based on my attempts, I find the PTO docx system to be erratic and unreliable. I have no idea why the two samples yield two different results, one of which is unusable and there is no fix I can see to make it usable. If you could identify how I can change App B so that it works, then that would be very helpful.

James



James E. Lake

Principal, Randall | Danskin

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Exhibit 2

James E. Lake

From: James E. Lake
Sent: Thursday, August 10, 2023 9:41 AM
To: 'ebc@uspto.gov'
Subject: RE: Patent Center converted document errors
Attachments: Patent_app_sample A-feedback.docx; Patent_app_sample B-APP.TEXT.pdf; Patent_app_sample B-APP.TEXT.docx; Patent_app_sample B-feedback.docx; Patent_app_sample A-APP.TEXT.pdf; Patent_app_sample A-APP.TEXT.docx; Patent_app_sample A.docx; Patent_app_sample B.docx; Comparison.docx

Attached please find the documents that I submitted to EBC@uspto.gov on January 26, 2023, but did not receive any reply. Sample docx applications A and B were authored using the same computer and the same version of MS Word and based on my same template that I use for drafting patent applications. There is no discernable difference whatsoever within my capability between sample A and sample B. Using the MS Word Compare tool (output attached), they appear identical. In January, when I uploaded these samples to Patent Center, app A worked fine and produced the attached feedback document, processed docx, and PDF. App B did not work and the PTO manipulation mangled the claims, producing the attached feedback document, processed docx, and PDF. I tried again on April 6, 2023, when I sent the request below to EBC@uspto.gov, and received the same outputs.

Today, I retried uploading App A and App B and both appear to produce a correct feedback document, processed docx, and PDF. I do not know whether that means the system was updated to resolve the problem or whether this problem will arise again. Thank you very much for your help in looking into this.

James E. Lake
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-----Original Message-----

From: ebc@uspto.gov <ebc@uspto.gov>
Sent: Monday, August 7, 2023 5:37 PM
To: James E. Lake <jel@randalldanskin.com>
Subject: Patent Center converted document errors

[External Email]

Hello,

Thank you for contacting the Patent Electronic Business Center.

Please provide the sample documents for troubleshooting.

Reward, Agent 50
Patent Electronic Business Center (EBC)
22nd Century End User Support Team
Telephone: 1-866-217-9197
Email: EBC@USPTO.GOV
Web address: <http://www.uspto.gov/patents/ebc/about.jsp>

[THREAD ID:1-DOXYRQ]

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From: jel@randalldanskin.com
Sent: 8/7/2023 01:30:42 PM
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What is the status of this request? Ticket Number: 1-827987218

James E. Lake
Shareholder, Randall | Danskin
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<https://gcc02.safelinks.protection.outlook.com/?url=http%3A%2F%2Fwww.linkedin.com%2Fin%2Fjames-lake-1318b84&data=05%7C01%7Cebc%40uspto.gov%7C6c19664faf1c445c191908db976c1c24%7Cff4abfe983b540268b8ffa69a1cad0b8%7C1%7C0%7C638270262803214515%7CUnknown%7CTWFpbGZsb3d8eyJWljiMC4wLjAwMDAiLCJQIjoiV2luMzliLCJBTiI6I1haWwiLCJXVCi6Mn0%3D%7C3000%7C%7C%7C&sdata=jwCi%2F078rtmM6kQt%2FusDs6ZLoWDZUu3ocevzRD12rOY%3D&reserved=0>

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To: James E. Lake <jel@randalldanskin.com>
Subject: RE: Patent Center converted document errors

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Hello,

Thank you for contacting the Patent Electronic Business Center.

Thank you for this information I have sent an escalation for this request. This request can take up 10 to 14 business days for a response. If you would like to check the status of this request, please contact the Patent Electronic Business Center and refer to the below ticket number.

Ticket Number: 1-827987218

Reward, Agent 50
Patent Electronic Business Center (EBC)
22nd Century End User Support Team
Telephone: 1-866-217-9197
Email: EBC@USPTO.GOV
Web address: <http://www.uspto.gov/patents/ebc/about.jsp>

[THREAD ID:1-DOXYRQ]

-----Original Message-----

From: jel@randalldanskin.com
Sent: 4/6/2023 12:03:26 PM
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Most of the time, when I try uploading a non-provisional utility application authored in MS Word in DOCX format to Patent Center, it changes the claim numbering so the uploaded application no longer matches the original. Occasionally, a DOCX application will work for an unexplained reason. I attempted to find the reason for the different result by copying the identical text and formatting into one DOCX file that worked and another DOCX file that did not work.

I would be glad to send you the actual documents for evaluation, but here is an explanation of my approach. Sample DOCX applications A and B were authored using the same computer and the same version of MS Word and based on my same template that I use for drafting patent applications. There was no discernable difference whatsoever within my capability between sample A and sample B. The MS Word Compare tool output showed they appear identical. When I uploaded the samples to Patent Center, app A worked fine and produced an acceptable feedback document, processed DOCX, and PDF. App B did not work and the document manipulation changed the claims, producing a faulty feedback document, processed DOCX, and PDF.

I have no idea why the two samples yield two different results, one of which is unusable and there is no fix I can see to make it usable. If you could identify how I can change App B so that it works, then that would be very helpful. Please let me know where I can send the sample documents for evaluation.

James

James E. Lake

Principal, Randall | Danskin

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<https://gcc02.safelinks.protection.outlook.com/?url=http%3A%2F%2Fwww.linkedin.com%2Fin%2Fjames-lake-1318b84&data=05%7C01%7Cebc%40uspto.gov%7C6c19664faf1c445c191908db976c1c24%7Cff4abfe983b540268b8ffa69a1cad0b8%7C1%7C0%7C638270262803214515%7CUnknown%7CTWFpbGZsb3d8eyJWljiMC4wLjAwMDAiLCJQIjoiV2luMzliLCJBTiI6IjEhaWwiLCJXVCi6Mn0%3D%7C3000%7C%7C%7C&sdata=jwCi%2F078rtmM6kQt%2FusDs6ZLoWDZUu3ocevzRD12rOY%3D&reserved=0>

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