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Setting and Adjusting Patent Fees During Fiscal Year 2020

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Comment James Lake

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General Comment

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

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

No reliable process exists wherein errors introduced by EFS in its rendering of DOCX files into PDF files may be corrected without being subject to the risk of rejection for new matter. Currently, EFS requires applicants to certify the accuracy of PDF files produced by the USPTOs unreliable and error-laden conversion tool. It is impossible for applicants to use DOCX filing in EFS because applicants cannot certify the accuracy of PDF files with known errors and applicants have no means for discerning what causes the errors in the EFS-generated PDFs. The EFS feedback document does not identify these errors. In my personal experience, converting MS Word generated DOCX applications to PDF using the MS Word or Adobe Acrobat conversion tools has never created an error, while attempted filing in EFS has always created an error in the resulting PDF. Specific conversion errors are documented in IP discussion platforms, such as <https://blog.oppedahl.com/?p=4623> .

It is disingenuous for the notice of proposed rulemaking to state, EFS-Web registered eFilers have been

able to file specification, abstract, and claims in DOCX for utility non-provisional filings since August 2017. Such filing has only been available for applicants willing to take the substantial risk that their filings will be inaccurate. It is likewise disingenuous for the notice to state, The Office tested the capabilities of structured text within EFS-Web [which] was successful and many improvements were made based on feedback. The DOCX filing system in EFS remains unreliable and, practically speaking, non-functional.

For these enumerated reasons, the proposed new fee for non-DOCX filing should be withdrawn. Efficiency considerations dictate that the Office permit applicants to file applications in DOCX as one document instead of parsing into specification, claim, and abstract files. Applications are not drafted, nor published, nor issued as separate files. No technological reason appears to exist why DOCX applications must be parsed, increasing the likelihood of errors. Distinct advantages exist to keeping the sections together during drafting for more easily maintaining consistent formatting, terminology use, and page numbering. Keeping sections together also during filing eliminates the risk of human error in mistakenly filing the specification of one application with the claims of another application. Why would the Office require a practice that propagates errors?