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File Format Fracas: USPTO Pushes Switch from PDF to DOCX

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Practice Area: Patents & Intellectual Property

The USPTO has repeatedly communicated its commitment to having patent applicants submit documents in DOCX format. Starting in 2020 with a final rule that encouraged applicants to transition from PDF to DOCX, in May of 2021 the Office announced a non-DOCX surcharge of $400 to take effect in January of 2022. Public criticism of the DOCX filing system forced the Office to delay implementation of the surcharge by one year, to January of 2023. Feedback from patent practitioners continues to be strongly skeptical of the system. Nevertheless, the Office has not communicated that it will further delay the change. Consequently, practitioners and clients that have not already adopted DOCX filing now have less than two months to decide whether to make the change.

Why Does the USPTO Want to Switch to DOCX?

The USPTO is pushing the use of the DOCX format to improve data intake, resulting in fewer errors in published applications and issued patents. Additionally, the Office asserts that the switch will help ferret out common errors, such as formatting errors, provide instant feedback to prevent unnecessary delays in processing applications, and avoid compatibility issues, such as non-embedded fonts associated with PDF files.

What is the Pushback from Applicants?

While a switch in file format may seem trivial, practitioners have raised several issues with the manner in which the USPTO will use documents filed in DOCX format. Under the currently proposed system, the USPTO will convert an applicant-submitted DOCX document (the "as-filed DOCX") into a USPTO-generated DOCX and a USPTO-generated PDF. Significantly, the as-filed DOCX is not inserted into the file wrapper. Instead, the USPTO-generated documents become the official application papers.

Practitioners have raised several concerns about the DOCX filing process proposed by the USPTO. Most of these issues relate to possible altering of the content of the patent application. For example, content of the application may be changed by the USPTO's conversion of the as-filed DOCX to the USPTO-generated DOCX. With the as-filed DOCX not being placed in the file wrapper, evidence of the original submission would be lost from the record. A similar concern exists with the USPTO's conversion of the as-filed DOCX to the USPTO-generated PDF. Additionally, because DOCX files are editable, greater opportunity exists for application materials to be inadvertently modified before being fixed in the file wrapper.

Best Practices for DOCX Submissions

In view of the foregoing, practitioners should update internal procedures to add additional steps to check for conversion errors after filing in DOCX format. Additionally, the USPTO has asked DOCX filers to conduct several checks to help trouble-shoot their system, including:

1. Comparing the as-filed DOCX to the USPTO-generated DOCX;
2. Comparing the as-filed DOCX to the USPTO-generated PDF;
3. Comparing a user-generated PDF to the USPTO-generated DOCX; and
4. Comparing a user-generated PDF to the USPTO-generated PDF.

Additionally, from now until December 31, 2022, the USPTO is allowing applicants to also submit an "auxiliary PDF" to facilitate correction of any conversion errors. The auxiliary PDF is simply a user-generated PDF of the application, much like what most of us file today. While the auxiliary PDF does not form part of the application itself, it serves as evidence of the intended content of the patent application should an applicant seek to correct conversion errors.

Conclusion

With the non-DOCX surcharge looming, practitioners and clients need to be discussing today whether to switch to filing applications in DOCX format. Those discussions should address the potential conversion errors associated with the DOCX filing process, define cost expectations for conversion error review, and discuss the cost-benefit associated with simply filing in PDF format and paying the new surcharge.

By keeping abreast of the latest USPTO processes, the IP professionals at von Briesen provide cost-effective solutions for their clients. We welcome the opportunity to apply our experience to help you navigate the IP landscape.

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