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December 30, 2020

Re: OMB CONTROL NUMBER: 0651-0032

ICR REFERENCE NUMBER: 202011-0651-006

TITLE: Initial Patent Applications

Dear OMB:

This is sequel to my earlier comments submitted to you on 12/23/2020. I write to repeat and endorse certain comments that my colleague Suzannah Sundby submitted today. Suzannah wrote, and I endorse as my own comments:

37 C.F.R. § 1.16(u), to go into effect in January 2022, imposes a \$400 surcharge for filing a patent application in PDF form, which currently and ever since the start of EFS-Web filings, applications are successfully filed in PDF form.

...the DOCX format is not acceptable as the legally recognized version for patent applications which often require the use of scientific, mathematical, and other technical symbols and notations throughout. This is because the “conversion” of such symbols and notations is inconsistent and varies across different user computer platforms and software.

Not only are the scientific, mathematical, and technical symbols inconsistent across different user computer platforms and software, but the simplest characters are often misrepresented when opened and viewed using a different computer platform or software than that used to generate the original document. For example, often symbols like the mu (i.e., “micro” symbol) and the delta symbol in Word documents I receive from clients show up as a big fat square on my Microsoft computer using Microsoft Word. As another example, I received a “revised” draft patent application from an inventor where she replaced a “space” with a “space” in several places throughout the document. Wanting to be sure that all “space” issues were addressed, I did a “find and replace” to replace each “space” with a “space” and after incorporating all her changes, I sent the revised patent application back to her for a final review. Unfortunately, the document was completely unreadable to her on her computer using Microsoft Word because none of the spaces showed. Instead, the words and sentences of the

40+ page patent application showed up as one single word. Hence, I had to send the inventor a PDF version of the Word document so she could review and send comments and changes like back in the pre-word processor days as handwritten notes on the PDF document.

As an example of the type of problem that will likely result from patent applications filed in DOCX and then converted (or viewed) by the USPTO is evident in the type of error I often see when converting the text of a PDF document and into a Word document. The mu symbol changes to a “p”. The difference between a “p” and the mu symbol means the difference between pico- and micro- which can be dramatic or even deadly in the pharmaceutical and biotech arts. And catching the error in conversion is extremely timely and challenging because both pico- and micro- are regularly used in units of measurement, e.g., picogram and microgram, in science and are therefore regularly used throughout patent applications.

The proposed DOCX format for patent applications does not account for variations in how different software programs handle other features that must be embedded within the disclosure of a patent application such as chemical structural formulas and complex mathematical expressions. One cannot be assured that a chemical structure will be correctly shown in a Word based document unless the same software used to generate the chemical structure is used unless the person who generated the Word document having the chemical structure is the one who converts the Word document into a PDF.

In patent law, everything is based on the patent application as originally filed. Every word, letter, period, comma, dash, and space can have a significant impact on the scope and meaning of the patent claims. Thus, seemingly insignificant typos are often problematic and can be deadly to the patent claims. One cannot amend a patent application after it is filed without risk to how the patent claims are interpreted and construed.

My original determination in my originally submitted comments to OMB only accounted for my time spent on a *final review*, prior to submission of a new patent application. I did not account for the back and forth with drafts sent to and from inventors. Checking these back and forths of documents identified having a “.DOCX” extension, for unwanted character conversions, would consume additional time. These factors would have increased my estimated time and therefore cost for complying with the PTO’s DOCX filing requirement.

Very truly yours,  
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