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May 24, 2023

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office Kathi Vidal
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313
Via Email Kathi.Vidal@uspto.gov

Re: DOCX and Non-DOCX Storage Surcharge

Dear Director Vidal:

The National Association of Patent Practitioners (NAPP) is an organization dedicated to providing a collective voice for all practitioners within the patent law field of intellectual property law practice, affording patent practitioners the opportunity to achieve the highest levels of competence and professionalism with respect to practice at the United States Patent and Trademark Office (the USPTO or the Office).

We respectfully appreciate the opportunity to express our concern regarding the implementation of DOCX and the proposed non-DOCX storage surcharge set forth in 37 C.F.R. § 1.16(u). We are a forward-looking organization taking the needs of our fellow practitioners and the USPTO, with whom we work daily, very seriously. NAPP agrees with the USPTO that steps need to be taken to increase USPTO efficiencies and the effectiveness of the USPTO's online document capture and storage process, in order to reduce associated costs and increase the accuracy of the resulting work product. However, we believe that the current implementation plan for the DOCX storage process has issues that need to be addressed prior to launch.

Our recommendation is based on the observations of hundreds of NAPP members across the country who specialize in patent practice before the USPTO. As such, our members are key customers of the USPTO and critically dependent on the agency's document capture and storage systems to process tens of thousands of documents each year. Thus, our members are always heavily impacted by changes to these systems.

While NAPP acknowledges that storage of documents in DOCX may benefit the USPTO and applicants, there are also costs and risks to be addressed. The public depends on the USPTO to ensure that patent applications are filed correctly, stored reliably, and easily retrievable. That is, the public depends on the USPTO to ensure the reliability and useability of these documents of record.

We respectfully ask the USPTO to delay the effective date of the non-DOCX storage surcharge until all of the concerns expressed by NAPP in this letter are fully addressed. If these concerns cannot be resolved, then the penalty for filing PDF documents should be removed.

NAPP recommends that the following principles govern any electronic storage system. The USPTO's current proposal, as understood by NAPP, does not appear to address these principles.

Recommended Principles:

1. **Reliability and Accuracy.** Because of the legal bar against new matter, there is a requirement that the document capture and storage system prevent any alterations of the documents. NAPP believes that this requirement dictates: (1) the primary function of a document capture system; and (2) the document format of the capture system. The implemented capture system must capture a document and ensure that it cannot be modified. The document capture system must then be linked to a reliable storage system that uses reliable techniques designed to preserve the information that has been filed. The filed information must be preserved in a format that cannot be altered.

The current PDF storage system uses a format that provides a permanent record that cannot be altered. The associated text format is not the document of record for the application and therefore does not present an issue with regards to alteration or new matter being added. The as-filed original is stored in the Patent Center document application data (File Wrapper), cannot be modified, and meets all the requirements for a document of record capture system and storage system. Using the current method of capture and storage, the original filed document is secure and unalterable, thereby protecting both the applicant and the Office from inadvertent changes to the document of record. NAPP believes that an accurate and unalterable document of record must be part of any document capture system and storage system used to intake and store documents.

NAPP believes that documents stored in an editable format such as DOCX do not meet the requirements that the document capture system and document storage system be 100 percent reliable and unalterable as discussed above. While NAPP agrees that the DOCX format provides the Office with substantial cost savings, the reliable document capture system and storage system currently in use would be lost.

2. **Any System Must Accept All Documents that Meet the Implemented Standard.** The capture system and storage system must accept any document that an applicant files, as long as the document file meets the standard set by the Office. Microsoft Word has undergone at least nine (9) version upgrades since Word 2000 was released. If Microsoft Word's future version update process involves a similar rate of change, then either the Office would be forced to accommodate numerous DOCX upgrades, or practitioners would be forced to delay software upgrades, or both. This would force practitioners and or the Office to remain locked into using old versions of the DOCX format, creating incompatibility issues with other systems used by practitioners and the Office.

Problems with various advanced features of the DOCX protocol could also present issues for the Office. NAPP is aware of a problem with the existing DOCX capture system, namely, NAPP has confirmed an issue where a DOCX document containing embedded mathematical formulas created with the Equation Editor incorporated into Microsoft Word was uploaded into the USPTO's DOCX capture system, the DOCX capture system generated an error message and refused to accept the file. NAPP anticipates other errors will need to be documented and resolved prior to the launch of the DOCX system.

3. **USPTO 2015 Study Endorsed the PDF Format.** NAPP notes that the USPTO commissioned a study in 2015 entitled, [Text2PTO Proof of Concept White Paper | Version 1.0](#). That study concluded that the PDF format is the “right approach” to storage for the USPTO:

5.9 CONCLUSION

Although the presented solution has some limitations, it takes the right approach towards achieving the objectives. Limitations may be addressed in the long term by extending the Java application and using future releases of PDFxStream to customize / enhance the product to suit USPTO's needs.

Proposed Alternatives:

Examining the results of that Study with respect to current technological advancements and in light of the Principles discussed herein, NAPP suggests the following two (2) alternatives to meet the needs of applicants, practitioners, and the Office:

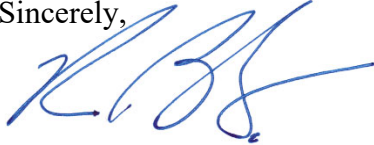
- a. A text-based PDF system (as opposed to bitmap image PDFs); and/or
- b. A text-based PDF system allowing the Office to capture a text-based PDF, create a DOCX document, and store the PDF in Patent Center as the document of record.

NAPP is confident that all current PDF writer software packages are capable of generating text-based PDFs that will achieve the USPTO's goals if the USPTO recommends specific settings.

For example, ISO standards ISO 19005-2:2011 (commonly known as “PDF/A”) and ISO 14289-1:2014 (commonly known as “PDF/UA”) impose required guarantees regarding document contents and properties that, as we understand it, are important to the USPTO. It seems that the USPTO's key need is the “natural order” guarantee of PDF/A and PDF/UA. We respectfully suggest that it would likely be quite easy for the USPTO to formulate instructions to customers for recommended specific settings for PDF generation, just as [the USPTO did in 2005 for EFS-Web](#).

NAPP looks forward to further conversations with the USPTO. In the meantime, NAPP respectfully requests the non-DOCX storage surcharge be eliminated from further consideration.

Sincerely,



Richard A. Baker, Jr.
National Association of Patent Practitioners, Secretary