

SUPPORTING STATEMENT
United States Patent and Trademark Office
DOCX Submission Requirements
OMB CONTROL NUMBER 0651-00xx
2023

A. Justification

- 1. Explain the circumstances that make the collection of information necessary. Identify any legal or administrative requirements that necessitate the information collection. Attach a copy of the appropriate section of each statute and regulation mandating or authorizing the collection of information.**

On August 3, 2020, the USPTO published a final rule in the Federal Register that included a new fee set forth in 37 CFR 1.16(u). See Setting and Adjusting Patent Fees in Fiscal Year 2020, 85 FR 46932 (Patent Fee Rule). Although that final rule indicated the new fee at §1.16(u) would go into effect on January 1, 2022, the effective date of the new fee was delayed to give applicants more time to adjust to filing patent applications in the DOCX format. The fee is scheduled to go into effect on January 17, 2024. See Setting and Adjusting Patent Fees during Fiscal Year 2020, 88 FR 36956 (June 6, 2023).

As specified in §1.16(u), the fee is due for any application filed under 35 U.S.C. 111 for an original patent—except design, plant, or provisional applications—where the specification, claims, and/or abstract do not conform to the USPTO requirements for submission in the DOCX format. Therefore, the fee is due for nonprovisional utility applications filed under 35 U.S.C. 111, including continuing applications, that are not filed in the DOCX format.

The USPTO conducted two pilot programs for filing applications in the DOCX format. The eMod Text Pilot Program was conducted between August 2016 and September 2017. The USPTO then expanded the ability to file patent applications in the DOCX format in EFS-Web to all users in September 2017. In 2018, the USPTO launched the Patent Center and conducted the Patent Center Text Pilot Program from June 2018 through April 2020. All applicants have been able to file applications in the DOCX format in the Patent Center since April 2020. Information about the Patent Center is available at www.uspto.gov/PatentCenter. The USPTO continues to hold many discussions and training sessions with stakeholders to ensure a fair and reasonable transition to the DOCX format. In addition, to further ensure a fair and reasonable transition to the DOCX format, the USPTO has, since April 2022, provided patent applicants with the option to submit a back-up applicant-generated PDF version of the application along with the DOCX file(s) when filing an application in Patent Center. See Extension of the Option for Submission of a PDF With a Patent Application Filed in DOCX Format, 88 FR 37036 (June 6, 2023).

The items in this new information collection relate solely to the impacts of the § 1.16(u) non-DOCX filing surcharge fee on the filing of nonprovisional utility applications under 35 U.S.C. 111, including continuing applications. In particular, this new information collection accounts for the § 1.16(u) non-DOCX filing surcharge fee itself, as well as an additional 30 minutes of time to accommodate (i) the extra review that some respondents may undertake as they start to become more familiar with the DOCX format and (ii) submission of the back-up applicant-generated PDF that some respondents will opt to submit.

The estimated volumes for the items in this new information collection are based from the estimates for the corresponding nonprovisional utility applications filed under 35 U.S.C. 111, including continuing applications, that are covered under an existing information collection (OMB control number 0651-0032; Initial Patent Applications). Respondents for the items in the new information collection will either take an extra 30 minutes to file their applications in DOCX format or they will pay the non-DOCX surcharge, they will not do both.

Table 1 provides the specific statutes and regulations authorizing the USPTO to collect the information discussed above:

Table 1: Information Requirements

Item No.	Requirement	Statute	Regulation
1	DOCX submission of Original New Utility Applications	35 U.S.C. §§ 41 and 111	37 CFR 1.16(u) and 1.51
2	DOCX submission of Utility Continuation/Divisional of an International Application	35 U.S.C. §§ 41 and 111	37 CFR 1.16(u) and 1.51
3	DOCX submission of Utility Continuation/Divisional Applications	35 U.S.C. §§ 41 and 111	37 CFR 1.16(u) and 1.51
4	DOCX submission of Utility Continuation-in-Part Applications	35 U.S.C. §§ 41 and 111	37 CFR 1.16(u) and 1.51

2. Indicate how, by whom, and for what purpose the information is to be used. Except for a new information collection, indicate the actual use the agency has made of the information received from the current information collection.

The majority of the patent application process is covered under an existing information collection (control number 0651-0032; Initial Patent Applications). The public uses this information collection only to file nonprovisional utility patent applications in the DOCX format or to pay the fee for not filing the applications in the DOCX format.

The information collected, maintained, and used in this information collection is based on OMB and USPTO guidelines. This includes the basic information quality standards established in the Paperwork Reduction Act (44 U.S.C. Chapter 35), OMB Circular A-130, and the USPTO and OMB’s information quality guidelines.

Table 2 outlines how this collection of information is used by the public and the USPTO:

Table 2: Needs and Uses

Item No.	Form and Function	Form No.	Needs and Uses
1	DOCX submission of Original New Utility Applications	No Form Associated	<ul style="list-style-type: none"> • Used by patent applicants to file an original new utility application with the USPTO in the DOCX format. • Used by patent applicants to pay the non-DOCX filing surcharge fee when not filing an original new utility application with the USPTO in the DOCX format. • Used by the USPTO to process an application for patent.
2	DOCX submission of Utility Continuation/Divisional of an International Application	No Form Associated	<ul style="list-style-type: none"> • Used by patent applicants to file a utility continuation or divisional of an international application with the USPTO in the DOCX format. • Used by patent applicants to pay the non-DOCX filing surcharge fee when not filing a utility continuation or divisional of an international application with the USPTO in the DOCX format. • Used by the USPTO to process an application for patent.
3	DOCX submission of Utility Continuation/Divisional Applications	No Form Associated	<ul style="list-style-type: none"> • Used by patent applicants to file a utility continuation or divisional application with the USPTO in the DOCX format. • Used by patent applicants to pay the non-DOCX filing surcharge fee when not filing a utility continuation or divisional application with the USPTO in the DOCX format. • Used by the USPTO to process an application for patent.
4	DOCX submission of Utility Continuation-in-Part Applications	No Form Associated	<ul style="list-style-type: none"> • Used by patent applicants to file a utility continuation-in-part application with the USPTO in the DOCX format. • Used by patent applicants to pay the non-DOCX filing surcharge fee when not filing a utility continuation-in-part application with the USPTO in the DOCX format. • Used by the USPTO to process an application for patent.

3. Describe whether, and to what extent, the collection of information involves the use of automated, electronic, mechanical, or other technological information collection techniques or other forms of information technology, e.g., permitting electronic submission of responses, and the basis for the decision for adopting this means of information collection. Also describe any consideration of using information technology to reduce burden.

DOCX submission of the applications in this collection must be undertaken electronically through the USPTO patent electronic filing system (Patent Center), the USPTO's online filing and viewing system for patent applications and related documents. For those respondents who choose to not file the applications in this collection in the DOCX format and pay the non-DOCX filing surcharge fee, the applications and fee may be submitted electronically by Patent Center, mail, or hand delivery.

Patent Center allows customers to electronically file patent applications and associated documents through their standard Web browser without downloading special software, changing their documentation preparation tools, or altering their workflow processes.

The USPTO is adopting the DOCX format because it aligns with the USPTO's plans to expand automation of the patent application process, which will increase efficiencies and reduce costs for applicants and the USPTO.

4. Describe efforts to identify duplication. Show specifically why any similar information already available cannot be used or modified for use for the purposes described in Item 2 above.

This information is collected only when an applicant (or representative) submits one of the following patent application types in DOCX format: an original new utility application; a utility continuation or divisional of an international application; a utility continuation or divisional application; and a utility continuation-in-part application. The items in this information collection are related to, and part of, the actions taken to submit patent applications under OMB control number 0651-0032 (Initial Patent Applications). This information collection covers any extra review applicants take in submitting DOCX files to USPTO, which is a review step not included within the burden estimates of OMB control number 0651-0032. Additionally, the submission of auxiliary PDFs, at the voluntary discretion of the applicant, is covered by this information collection. The auxiliary PDF serves as a safeguard for the application in the unlikely event that any correction is needed later in the process. This information collection also covers the fee for those applicants who do not file a DOCX application. Therefore, this information collection does not create a duplication of effort or collection of data.

5. If the collection of information impacts small businesses or other small entities, describe any methods used to minimize burden.

USPTO estimates that approximately 25% of this information collection will be submitted by small businesses or other small entities (of which 3% are micro entities). Pursuant to section 10(b) of the Leahy-Smith America Invents Act (AIA), Pub. L. 112-29, as amended by the Unleashing American Innovators Act of 2022 (UAIA), Pub. L. 117-103, the USPTO provides a 60% reduction in the fees for certain patent filings by small entity applicants, such as persons, small businesses, and nonprofit organizations who meet the definition of a small entity provided at 37 CFR 1.27(a). Also pursuant to section 10(b) of the AIA, the USPTO provides a 80% reduction in the fees set or adjusted under section 10(a) of the Act for certain patent filings by applicants who meet the definition of a micro entity provided at 35 U.S.C. § 123 and 37 CFR 1.29.

This information collection involves payment of fees by customers who may qualify as small entities or micro entities. No significant burden is placed on small or micro entities to establish their status and pay the discounted fee. Small entities must only make an assertion of entitlement to small entity status in the manner set forth in 37 CFR 1.27(c)

(1) or (c)(3). Micro entities must only provide a certification of micro entity status complying with the requirements of either 37 CFR 1.29(a) or (d).

6. Describe the consequence to Federal program or policy activities if the information collection is not conducted or is conducted less frequently, as well as any technical or legal obstacles to reducing burden.

This information collection relates solely to the impacts of filing nonprovisional utility applications under 35 U.S.C. 111, including continuing applications, in the DOCX format and the non-DOCX filing surcharge fee. Patent applicants will either take an extra 30 minutes to file their applications in DOCX format or they will pay the non-DOCX surcharge, they will not do both. Furthermore, the USPTO provides the 30-minute estimate out of an abundance of caution for the initial period after the effective date of the non-DOCX filing surcharge fee. The USPTO expects to decrease the 30-minute estimate by the first renewal of this collection as the public more fully comprehends the nature of, and how to comply with, the DOCX format.

The DOCX format aligns with the USPTO's plans to expand automation of the patent application process, which will increase efficiencies and reduce costs for applicants and the USPTO. The non-DOCX filing surcharge fee is intended to encourage the filing of more applications in DOCX format. Not conducting this collection of information would slow the adoption of DOCX filing and thereby would impede applicants, the USPTO and the public from reaping its maximum benefit. More information on the benefits of submitting patent applications in DOCX format is available at www.uspto.gov/patents/docx.

7. Explain any special circumstances that would cause an information collection to be conducted in a manner:

- **requiring respondents to report information to the agency more often than quarterly;**
- **requiring respondents to prepare a written response to a collection of information in fewer than 30 days after receipt of it;**
- **requiring respondents to submit more than an original and two copies of any document**
- **requiring respondents to retain records, other than health, medical, government contract, grant-in-aid, or tax records, for more than three years;**
- **in connection with a statistical survey, that is not designed to produce valid and reliable results that can be generalized to the universe of study;**
- **requiring the use of a statistical data classification that has not been reviewed and approved by OMB;**
- **that includes a pledge of confidentiality that is not supported by authority established in statute or regulation, that is not supported by disclosure and data security policies that are consistent with the**

- pledge, or which unnecessarily impedes sharing of data with other agencies for compatible confidential use; or
- requiring respondents to submit proprietary trade secrets, or other confidential information unless the agency can demonstrate that it has instituted procedures to protect the information's confidentiality to the extent permitted by law.

There are no special circumstances associated with this collection of information.

8. **If applicable, provide a copy and identify the date and page number of publication in the Federal Register of the agency's notice, required by 5 CFR 1320.8(d), soliciting comments on the information collection prior to submission to OMB. Summarize public comments received in response to that notice and describe actions taken by the agency in response to these comments. Specifically address comments received on cost and hour burden. Describe efforts to consult with persons outside the agency to obtain their views on the availability of data, frequency of information collection, the clarity of instructions and recordkeeping, disclosure, or reporting format (if any), and on the data elements to be recorded, disclosed, or reported. Consultation with representatives of those from whom information is to be obtained or those who must compile records should occur at least once every 3 years - even if the collection of information activity is the same as in prior periods. There may be circumstances that may preclude consultation in a specific situation. These circumstances should be explained.**

On June 6, 2023, the USPTO published its 60-day notice soliciting public comments on this information collection (88 FR 37039). In response, the USPTO received a total of nine comments. A summary of comments, grouped by subject matter, and the USPTO's responses follow below.

In addition, a 30-day notice was published in the Federal Register on September 27, 2023 (88 FR 66414). The public comment period ends on October 27, 2023.

Comment on the Necessity and Utility of DOCX

Comment 1:

Several commenters appreciated the goal of moving towards a more structured text application driven process. However, commenters asserted that submitting applications in the DOCX format is not necessary for the performance of the functions of the agency. They asserted that the USPTO is currently able to scan PDFs and perform text recognition on the document, and that changing to a new format is not necessary.

Response:

The USPTO is continuing to modernize and streamline its patent application systems to support robust and reliable patent rights, speed the issuance of patents, and reduce the

costs and barriers of global patent protection. The submission of patent applications in DOCX format facilitates the USPTO's ongoing efforts. For example, filing in DOCX format:

- Improves patent application quality by providing content-based validations prior to submission;
- Provides automated document indexing;
- Improves downstream reuse of content by applicants and the USPTO;
- Improves searches for patent applications; and
- Eliminates the need for patent applicants to convert structured text to PDF format.

The DOCX filing format aligns with the USPTO's plans to expand automation of the patent application process, which will increase efficiencies and reduce costs for applicants and the USPTO.

Concerns with DOCX File Format

Comment 2:

Some commenters asserted the DOCX was not a static format. They were concerned about Microsoft Corporation owning the file format, thus making it subject to changes by that corporate entity. One commenter asserted that there does not exist a single "DOCX format." Also, another commenter asserted that the DOCX format is not part of the Office Open XML (OOXML) standard. The preference of these commenters is the PDF format, which they viewed as more stable. Some commenters expressed concern that only 80% of patent applicants use Microsoft Word as the software supporting their document creation.

Response:

DOCX is a word-processing file format that is part of OOXML, an XML-based open standard approved by the Ecma International® consortium and subsequently by the ISO/IEC joint technical committee. For more information about the OOXML standard, please see:

- ECMA-376 at <https://www.ecma-international.org/publications-and-standards/standards/ecma-376/>;
- ISO/IEC 29500 at <https://www.iso.org/committee/45374/x/catalogue/>; and
- *NIST Votes for U.S. Approval of the Modified OOXML Standard* at <https://www.nist.gov/news-events/news/2008/03/nist-votes-us-approval-modified-office-open-xml-standard>.

Like the PDF standard, DOCX presents documents, including text and formatting, in a manner that is independent of software, hardware, or operating system. A particular operating system will have its own process for interpreting and showing those text and format elements. However, the DOCX file is itself a stable carrier for the textual elements of the document. The open standard means that anyone has access to the information that guides the DOCX standard's use of information. This is similar to the

PDF format which also has corporate ownership and has an ISO standard. This means that both PDF and DOCX present documents, including text and formatting, in a manner independent of software, hardware or operating systems. The DOCX format, being open source, is available to users of most every document processing application or software options including Google docs and Apple products. DOCX is backward compatible and supported by many popular word processing applications, such as Microsoft Word 2007 or higher, Google Docs, Office Online, LibreOffice, and Pages for Mac. The USPTO performs regular regression testing using different DOCX documents, including different versions of Microsoft Word, Google Docs, Pages for Mac, to ensure that these options are available for patent applicants. Thus, an applicant does not have to use Microsoft Word in order to create a DOCX file, nor be concerned about using a specific version of DOCX.

Comment 3:

Some commenters expressed concern that errors would be introduced into applications submitted in the DOCX file format because USPTO systems are unable to recognize various technical symbols and characters, and thus may render them incorrectly. For example, commenters expressed concern that DOCX files containing mathematical equations, chemical formulas, tables, or special fonts may get corrupted.

Response:

The USPTO performs continuous testing of DOCX format files, including sample files that include mathematical equations, chemical formulas, tables, and special fonts. Recent results have shown very few issues with the conversion of these data types, and as of mid-September 2023, only five petitions have been received relating to a conversion of data type error out of 183,685 total applications submitted in DOCX since the USPTO began accepting new applications in the DOCX format.

The USPTO has addressed many past issues with mathematical equations, complicated structures in chemical and biochemical patent applications, and tables so that they are properly rendered. For example, for a brief period of time, some applicants may have encountered an issue in which equations presented in certain fonts in DOCX filings were not rendered accurately in the downstream documents generated by the USPTO. At no time was there an issue with the DOCX filing which served as the authoritative document. As of May 2023, the USPTO resolved this issue and all supported fonts can be used in equations included within a DOCX filing without creating a rendering issue in downstream documents generated by the USPTO. As another example, in September 2023, the USPTO resolved an issue with images, including images of equations and formulas embedded as Scalable Vector Graphics (SVG) format, that were not supported in multi-section DOCX documents. The USPTO continuously performs rigorous testing to ensure that document integrity is preserved across document format types. Any applicant who previously tried to file using DOCX and encountered any issues, reported or otherwise, should find those issues resolved if they use the DOCX filing option again.

The USPTO's DOCX support web page, located at <https://www.uspto.gov/patent/docx>,

contains a complete list of 32 supported fonts, 10 of which were added in 2020 or later. Moreover, the USPTO is in the process of adding a number of additional fonts. If there is a font that is not currently supported by the conversion and validation system, applicants should contact the Electronic Business Center and the proposed font may be added to the supported font list as allowable following a thorough analysis by the USPTO.

The use of fonts not on the USPTO's supported font list, such as specialized fonts, custom fonts, particularly uncommon fonts, or internal fonts that have similar labels but use different glyphs from standard font typeface, creates discrepancies during the document validation and conversion processes. The validation and conversion system that the USPTO uses to render the structured text from the DOCX file has been tested on a wide variety of fonts, but will not accept a font outside those it has been programmed to read, i.e., those on the supported list.

Comment 4:

Several commenters asserted that the USPTO conversion tool and validation system are “unreliable and error-laden.”

Response:

As a part of the DOCX intake process, preliminary validation is performed on DOCX documents at the time of upload. The system immediately detects and supplies the applicant with useful error and warning messages, allowing for adjustments to patent applications earlier in the process. This saves time, reduces potential costs to applicants and the USPTO, and prevents delays in processing by minimizing notices of missing parts or incomplete applications from the Office of Patent Application Processing (OPAP). An advantage of submitting in DOCX format directly is that submitted files from all applicants are validated and converted to PDF by USPTO systems in a consistent manner. The USPTO continuously performs rigorous testing to ensure that document integrity is preserved.

The validation features are new to the submission process and made available due to the structured data in DOCX files; this is not a feature that is available for PDF submissions. The validation step helps applicants identify issues with their application prior to submission. Currently less than 2% of all help desk tickets involve a DOCX submission, indicating that applicants may be benefiting from these system improvements.

Comment 5:

One commenter expressed concern that the USPTO's “DOCX rendering engine” changes over time and requires them to review document both upon submission and at the 18-month mark.

Response:

The USPTO has not received specific instances where the application system developed textual discrepancies between the DOCX file at submission and the PDF file

at the 18-month mark prior to publication. The application system stores the initial submitted documents, and it is the same file which is returned to users seeking to view their documents later in the process. The DOCX system does not double back and perform second conversion and validation of items, therefore it is not possible for errors to be introduced into the USPTO generated PDF. The USPTO is not aware of any particular reason why review of documents at the 18-month mark would be any different with DOCX or PDF formats. If there is an instance in which an error occurs, the Electronic Business Center should be contacted for investigation and resolution.

Comment 6:

At least one commenter mentioned that the USPTO has not provided the source code for the conversion and validation system. They suggested that doing so would provide meaningful help for applicants to understand the process and reduce much of their confusion about how the system renders documents.

Response:

While the entire code of the conversion and optical character recognition (OCR) tools has not been made public, extensive resources have been produced to guide users through the application process and to understand how their text is used and rendered by the system. This includes information about the section headers that are needed for the system to detect the information for a field and the fonts that are supported by the conversion tool. This information is available through the USPTO website at: <https://www.uspto.gov/patents/docx>. Applicants can always examine the XML schema information to understand the elements, attributes, and data types located at https://www.uspto.gov/sites/default/files/documents/XML4IP_V7_1.zip.

Comment 7:

Some commenters noted that a DOCX file created on one computer may not appear the same when viewed with a different program on a different computer because the file may have been generated in a foreign country or due to different software configurations. These discrepancies make it seem to commenters that the DOCX submission process is not trustworthy, thus leading commenters to conclude that only PDFs are able to hold the format and be the authoritative document.

Response:

The USPTO has not experienced the issue raised by commenters. The DOCX file acts as an effective vehicle for sending the structured text to the USPTO. Like the PDF standard, DOCX presents documents, including text and formatting, in a manner that is independent of software, hardware, or operating systems. If you experience any issues with viewing the DOCX on a different computer, please report it to the Electronic Business Center.

Comment 8:

Some commenters questioned why the USPTO requires the removal of various standard Word document features in DOCX files that are submitted to the USPTO. They suggest that it forces non-standard usage of DOCX files and that the USPTO is making

its own standard.

Response:

The USPTO's parameters for filing in the DOCX format do not amount to the creation of a new DOCX standard. For security, the USPTO's system rejects DOCX with macros and implements virus detection software to prevent malware. Additionally, the USPTO's system removes certain other unnecessary document properties that may affect USPTO processes, such as metadata, if not already removed by applicants prior to submission. Please see the DOCX Feedback Errors and Warnings document available at

https://www.uspto.gov/sites/default/files/documents/Docx_Errors_and_Warning_Brand_Update_May_31_2023.docx for a complete list of errors and warnings. The USPTO is continuously reexamining its processes to reduce the errors that would prohibit filing.

Alternatives to Submitting in DOCX Format

Comment 9:

Some commenters offered a solution that the USPTO address its needs by adopting the Federal courts practice of accepting rich text formatted PDFs. The commenters suggested that this would allow the USPTO to accept PDFs as provided by the applicant.

Response:

The USPTO acknowledges that Federal courts accept rich text formatted PDF file submissions. However, in order to better support the patent examination process, the USPTO prefers the use of structured text to speed examination times and provide more accurate text searchable solutions for applicants and the general public. In comparison to DOCX, rich text formatted PDF does not provide a reliable source of structured text. Although rich text formatted PDF files may convey some textual information, they are not substitutes for the quantity and quality of information provided by a DOCX submission. The DOCX file submission has benefits for both internal processes and the submission process that are not available with even a rich text formatted PDF filing.

Comment 10:

Some commenters suggested that the USPTO accept the auxiliary PDF submitted by applicants as the authoritative document when submitting applications in the agency-preferred DOCX format. These commenters stated that they are currently permitted to submit PDFs, but the system requires applicants to agree that the DOCX document will be the authoritative document. Some of the commenters who suggested that the USPTO treat the PDF as the authoritative document also suggested that the USPTO could collect a DOCX formatted version as an "auxiliary" document to facilitate internal USPTO processes. Those applicants who submit this "auxiliary DOCX" file could be given a discount in filing fees as an incentive.

Response:

As stated in the April 2022 notice, the USPTO considers the validated DOCX file(s)

submitted by the applicant to be the authoritative document and that applicants may rely on the validated DOCX file(s) as the source or evidentiary copy of the application to make corrections to the record when any discrepancies are identified between the source or evidentiary copy and the documents the USPTO has converted. Although the USPTO is not making the applicant-generated PDF the source or evidentiary copy, as requested by commenters, the USPTO has made two changes in response to stakeholder requests. First, the USPTO will keep copies of the applicant-generated PDF as part of the permanent record, regardless of whether a petition is filed. See Extension of the Option for Submission of a PDF With a Patent Application Filed in DOCX Format, 88 FR 37036 (June 6, 2023). For example, for granted patents, the USPTO will keep copies of the applicant-generated PDF for at least 25 years after the patent grant before transferring it to the National Archives and Records Administration. Second, the USPTO has extended indefinitely the option to submit an applicant-generated PDF of the application along with the validated DOCX file(s) when filing an application in Patent Center. See Extension of the Option for Submission of a PDF With a Patent Application Filed in DOCX Format, 88 FR 37036 (June, 6, 2023). These two changes better ensure patent applicants choosing to submit an applicant-generated PDF with the validated DOCX file(s) when filing an application in Patent Center will have an ongoing safeguard should any unexpected conversion discrepancies occur during the filing process.

As for the commenters' suggestion that the USPTO use a voluntarily submitted auxiliary DOCX file to facilitate internal USPTO processes, while keeping a concurrently submitted PDF as the authoritative document, any document used to facilitate internal USPTO processes must be the authoritative document. For reasons stated, the USPTO has determined that documents submitted in the DOCX format better facilitate internal USPTO processes. PDF submissions, even rich text formatted PDF submissions, do not provide the same benefits to internal processes as filing in the DOCX format. Therefore, the USPTO is implementing a DOCX filing format to align with its plans to modernize and streamline its patent application systems. In such a system, the DOCX formatted submission must be the authoritative document.

PDF Study

Comment 11:

Some commenters discussed a previous USPTO study which investigated the use of PDFs and their application to USPTO processes. These commenters claim that the USPTO has been misrepresenting the findings of the study as supportive of the DOCX standard; the commenters assert that the study shows the benefits of the PDF standard. The commenters believe that the USPTO should have disclosed this study in our previous rulemaking. As a result, the commenters say that our nondisclosure of the study did not follow the Administrative Procedure Act (APA).

Response:

The USPTO made the decision to encourage submissions of applicant files via DOCX format in order to leverage the structured text and not rely upon the OCR process of the PDF conversion. This decision was reached based on internal IT considerations and

initiatives, external sources, and industry practices, not solely based on any one study. The USPTO referenced the study in its Patent Fee Rule as part of responses to comments received (88 FR at 46957).

The USPTO did not misrepresent the yearlong study of the feasibility of processing text in PDF documents. The results showed that searchable text data is available in some PDFs, but the order and accuracy of the content could not be preserved. With DOCX, the USPTO is able to use the text directly and pass it to our downstream systems, which results in increased data accuracy and a more streamlined patent process.

Non-DOCX Filing Surcharge Fee

Comment 12:

Most commenters expressed their desire for the USPTO to reduce or withdraw the \$400 fee for applicants filing a document in a non-DOCX format. Some of the commenters expressed confusion or concern that the fee is much higher than the costs associated with the OCR process. These commenters asserted that, based on previous documentation from the USPTO, the cost to OCR documents was estimated to be \$3.15 and the non-DOCX fee is exponentially greater than that cost. The commenters concluded that this showed that the fee associated with filing a document in a non-DOCX format is not justified and should be much lower than the \$400 fee amount.

Response:

The USPTO acknowledges that the cost to OCR documents was previously explained to be \$3.15. However, this amount does not include other costs incurred in processing these documents. The use of image-based PDFs incurs many costs over the lifetime of an application. There are large costs associated with the USPTO's systems and personnel—from preexamination, examination, and publication—due to the need to apply OCR to convert image-based PDFs into structured text that can be leveraged by downstream systems, and in many cases for staff to manually review the changes. The surcharge is applied not only to account for these costs, but also to address rising expenses.

Additionally, USPTO fee setting is not limited to the exact cost of a particular item. As explained in the Patent Fee Rule, individual fees are not necessarily set equal to the estimated cost of performing the activities related to the fee. Instead, some of the individual fees are set at, above, or below their unit costs to balance several key fee setting policy factors: promoting innovation strategies, aligning fees with the full cost of products and services, facilitating effective administration of the patent system, and offering patent processing options to applicants.

The USPTO implements the non-DOCX filing surcharge fee because filing in the DOCX format (1) provides advantages to examiners during examination; (2) focuses patent resources on providing meaningful benefits to patent applicants (immediate feedback during submission, etc.) rather than diffusing those resources across many IT initiatives; and (3) yields structured text that enhances the ability and speed at which items are

searchable and disseminated.

Estimated Time Burden for Filing in DOCX

Comment 13:

Several commenters expressed concerns that the time estimate given in this proposed information collection does not account for the time that they will spend reviewing the documents in light of all the issues raised with submitting in DOCX format. They assert that the USPTO's proposed estimate of an additional 0.5 hour (30 minutes) for those users who are filing applications in DOCX format is too low. Commenters estimated that they needed between 3 to 6 additional hours to review a single application filed in DOCX, including time spent consulting with their client and reviewing the documents both upon submission and at the 18-month mark.

Response:

This information collection covers any extra review for DOCX filers due to either validation issues or conversion concerns. Regarding the estimated time for applicants to review their documents, the USPTO considered the most recent feedback received and maintains that the estimated time burden of 30 minutes is an adequate amount of time and does not warrant a further increase. The 30-minute estimate is an average of the time needed across all patent applications submitted in the DOCX format. For this estimate, the USPTO took into account suggestions from commenters on the additional time needed for review of DOCX filings during the renewal of 0651-0032 in 2020-2021.

Most filers will not need any additional time under this information collection to review documents. The USPTO acknowledges that some filers submitting complex and technical applications could take longer than the estimated 30 minutes to review the documents. However, the USPTO believes that the 30 minutes of additional time is a reasonable average for the entire applicant pool.

Some commenters suggested that time spent consulting with clients and training activities be included in the estimated time burden, however those actions are outside the definition of burden under the Paperwork Reduction Act (PRA). The USPTO's estimate for this information collection includes the time spent to review and submit patent applications in DOCX format to the USPTO. While legal deliberation about the choices leading up to submission is critical in developing a patent application, such actions are outside the scope of this information collection.

In addition, DOCX will provide for efficiencies and time savings both at the time of filing and during prosecution. For example, at the time of filing, applicants who choose to file in PDF through Patent Center may convert their DOCX document into a single PDF document, but must identify for the system which part of the PDF document corresponds to the specification, claims, and abstract (and drawings, if provided) portions. Filing in DOCX permits applicants to avoid these steps because Patent Center automatically indexes the specification, claims, and abstract (and drawings, if provided) portions of the DOCX document. During prosecution, efficiencies include improved

downstream reuse of content by applicants and the USPTO, and improved searches for patent applications.

Comment 14:

One commenter expressed concern that the USPTO guidance on the use of preferred fonts for patent applications “imposes additional burden” that is not approved by OMB under the PRA, and contains requirements that are not codified in regulations.

Response:

The USPTO disagrees that the identified guidance documents impose any additional burdens that need to be accounted for in this information collection. The guidance documents identified by the commenter provide information and instructions to assist users as they interact with USPTO systems. Among the guidance is the list of supported fonts (currently 32), which is based on the most commonly used fonts by applicants and are confirmed by the USPTO as not causing a rendering issue. The USPTO actively works to expand the list of supported fonts. If an applicant wishes to use a font that is not currently supported by the system, applicants may contact the Electronic Business Center and the proposed font may be added to the supported font list, as allowable following a thorough analysis of that font by the USPTO.

Comment 15:

One commenter asserted that the USPTO’s solution to allow applicants to submit the auxiliary PDF, in addition to the DOCX formatted file, is unnecessarily duplicative.

Response:

The submission of an auxiliary PDF is a voluntary action on the part of the applicant. The USPTO does not require submission of the auxiliary PDF. For those applicants who choose to submit an auxiliary PDF, the purpose of that document is to serve as a safeguard for the application in the unlikely event that any correction is needed later in the process. Recent results have shown very few issues with conversion of data type errors. As of mid-September 2023, only five petitions have been received relating to a conversion of data type error out of 183,685 total applications submitted in DOCX since the USPTO began accepting new applications in the DOCX format.

Comment 16:

Some commenters felt that the time needed to submit to the USPTO any error reports identifying application issues, font errors, and rendering and display concerns, and the time needed to resolve those issues, should be accounted for in this information collection, pursuant to the PRA.

Response:

The USPTO appreciates all error reports that are submitted. These items allow the USPTO to learn from our customers and focus resources on solving problems. Applicants are encouraged to reach out to the Electronic Business Center or any of the USPTO help desks as needed to support their submissions. However, the submission of error reports to the Electronic Business Center or the USPTO help desks is not

generally included in the time burden estimates as those submissions are outside of the scope of the PRA.

Comment 17:

One commenter expressed concern that the USPTO has offered no burden estimate for petitions that seek correction of errors introduced into a patent application based upon the supplemental PDF file.

Response:

The USPTO will continue to waive the petition fee under 37 CFR 1.17(f) for a petition under 37 CFR 1.182 that relies on an applicant-generated PDF that was filed in the Patent Center as the source to make a correction to the record. These 37 CFR 1.182 petitions are covered under an existing OMB approved information collection 0651-0059 (Patent Petitions Related to Application and Reexamination Processing Fees). The USPTO currently provides an estimated time for response of four hours for these petitions. As of mid-September 2023, only five petitions have been received relating to a conversion of data type error out of 183,685 total applications submitted in DOCX since the USPTO began accepting new applications in the DOCX format. When the 0651-0059 information collection is renewed in 2024, the USPTO will consider increasing the number of petitions estimated under the 37 CFR 1.17(f) grouping as needed and will seek public comment regarding burden estimates.

Questions About Information Collection Scope and Timing

Comment 18:

Commenters questioned why the USPTO submitted an information collection request after publishing the Patent Fee Rule. Some commenters further suggested that the USPTO was hiding burdens and requirements from the public and the OMB through the proposal of this item separate from other information collections.

Response:

The USPTO submitted an information collection request after publishing the Patent Fee Rule, because the USPTO delayed the effective date of the non-DOCX filing surcharge fee in order to respond to concerns and allow stakeholders more time to become familiar with DOCX submissions.

This new information collection addresses DOCX filings separately from 0651-0032 for efficiency due to the large size of 0651-0032 and to allow the public and the OMB to consider this collection on its own terms. It is likely that in the future this collection will be merged into 0651-0032.

The USPTO has long-standing relationships with groups from whom patent application information is collected, such as patent bar associations, independent inventor groups, and users of our public search facilities. Their views are expressed in regularly scheduled meetings and considered in developing proposals for information collection requirements.

9. Explain any decision to provide any payment or gift to respondents, other than remuneration of contractors or grantees.

This information collection does not involve a payment or gift to any respondent.

10. Describe any assurance of confidentiality provided to respondents and the basis for the assurance in statute, regulation, or agency policy. If the information collection requires a systems of records notice (SORN) or privacy impact assessment (PIA), those should be cited and described here.

The confidentiality of patent applications is governed by statute (35 U.S.C 122) and regulation (37 CFR 1.11 and 1.14). The USPTO has a legal obligation to maintain the confidentiality of the contents of unpublished patent applications and related documents. Upon publication of an application or issuance of a patent, the patent application file is made available to the public, subject to the provisions for providing only a redacted copy of the file contents (37 CFR 1.11(a) and 1.217).

Applications filed through Patent Center are maintained in confidence as required by 35 U.S.C. 122(a) until the application is published or issued as a patent. The confidentiality, security, integrity, authenticity, and non-repudiation of patent applications submitted electronically through Patent Center are maintained using TLS or SSL protocols. The USPTO posts the file contents of issued patents and application publications on its website. The information covered under this information collection will not be released to the public, unless it is part of an issued patent or application publication, or unless one or more specific conditions for power to inspect or access are met pursuant to 37 CFR 1.14(c)-(j). Patent applicants and/or their designated representatives can view the current status of their patent application through Patent Center.

The Privacy Act of 1974 (Pub. L. 93-579) requires that an applicant be given certain information in connection with the items covered under this information collection. The applicable Privacy Act System of Records Notice for this information collection is COMMERCE/PAT-TM-7 Patent Application Files (SORN 7), available at 78 FR 19243 (March 29, 2013).¹ The purpose of SORN 7 is to disclose how the USPTO intends to use, maintain, and protect the information that it has collected to carry out the duties of the USPTO to examine patent applications and issue patents. SORN 7 manages all applicant records including name, citizenship, residence, post office address, and other information pertaining to the applicant's activities in connection with the invention for which a patent is sought or has been granted.

The information in SORN 7 is protected from disclosure to third parties in accordance with the Privacy Act until the application is published under 35 U.S.C. 122(b) or issued as a patent under 35 U.S.C. 153. Prior to application publication or patent issuance, the information in SORN 7 is protected from disclosure to third parties in accordance with

¹ <https://www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf>.

the Privacy Act, except that disclosure is permitted for the following routine uses including, but not limited to: law enforcement in the event that the system of records indicates a violation or potential violation of law; a Federal, state, local, or international agency, in response to its request; an agency, organization, or individual for the purpose of performing audit or oversight operations as authorized by law; non-federal personnel under contract to the agency; the Department of Justice for Freedom of Information Act (FOIA) assistance; a Member of Congress working on behalf of an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record; the Office of Personnel Management (OPM) for personnel research purposes; and the Office of Management and Budget (OMB) for legislative coordination and clearance.

Categories of individuals covered by SORN 7 include applicants for patent, including inventors, legal representatives for deceased or incapacitated inventors, and other persons authorized by law to make applications for patent.

The applicable PIA for this information collection is the Privacy Impact Assessment for the Patent End to End (PE2E) System (March 14, 2022), which is available at https://osec.doc.gov/opog/privacy/pto%20pias/PE2E-PIA_SAOP_Approval_Delegation.pdf. PE2E is a Master system portfolio consisting of next generation Patents Automated Information Systems (AIS). The goal of PE2E is to make the interaction of USPTO's users as simple and efficient as possible in order to accomplish user goals. PE2E will be a single web-based examination tool providing users with a unified and robust set of tools. PE2E will overhaul the current patents examination baseline through the development of a new system that replaces the existing tools used in the examination process. The project stakeholders desire a simple, unified interface that does not require launching of separate applications in separate windows, and that supports new and improved IT advances. There are 14 sub-systems under PE2E, including Patent Center.

- 11. Provide additional justification for any questions of a sensitive nature, such as sexual behavior and attitudes, religious beliefs, and other matters that are commonly considered private. This justification should include the reasons why the agency considers the questions necessary, the specific uses to be made of the information, the explanation to be given to persons from whom the information is requested, and any steps to be taken to obtain their consent.**

None of the required information in this information collection is considered to be sensitive.

- 12. Provide estimates of the hour burden of the collection of information. The statement should:**
 - **Indicate the number of respondents, frequency of response, annual hour burden, and an explanation of how the burden was estimated. Unless directed to do so, agencies should not conduct special surveys**

- to obtain information on which to base hour burden estimates. Consultation with a sample (fewer than 10) of potential respondents is desirable. If the hour burden on respondents is expected to vary widely because of differences in activity, size, or complexity, show the range of estimated hour burden, and explain the reasons for the variance. Generally, estimates should not include burden hours for customary and usual business practices.
- If this request for approval covers more than one form, provide separate hour burden estimates for each form and aggregate the hour burdens.
 - Provide estimates of annualized cost to respondents for the hour burdens for collections of information, identifying and using appropriate wage rate categories. The cost of contracting out or paying outside parties for information collection activities should not be included here. Instead, this cost should be included under 'Annual Cost to Federal Government'.

Tables 3 and 4 calculate the burden hours and costs of this information collection to the public, based on the following factors:

- **Respondent Calculation Factors**

The respondents to this information collection include the private sector (97%) and individuals and households (3%). The USPTO estimates that it will receive approximately 247,751 responses per year under this information collection, with approximately 25% of these responses submitted by small entities (22%) and micro entities (3%). All of the items in this information collection will be submitted electronically.

These estimates are based on the Agency's long-standing institutional knowledge of and experience with the type of information collected by these items.

- **Burden Hour Calculation Factors**

The USPTO estimates that it will take the public 30 minutes to submit the information to the USPTO in the DOCX format. Using these burden factors, USPTO estimates that the total respondent hourly burden for this information collection is 123,877 hours per year.

- **Cost Burden Calculation Factors**

The USPTO uses a professional rate of \$435 per hour for respondent cost burden calculations, which is the mean rate for attorneys in private firms as shown in the 2021 *Report of the Economic Survey* published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA). The USPTO expects that the information in this information collection will be prepared by attorneys. Using this hourly rate, the USPTO estimates that the total respondent cost burden for this information collection is \$53,886,495 per year.

Table 3: Burden Hour/Burden Cost to Private Sector Respondents

Item No.	Item	Estimated Annual Respondents (a)	Responses per Respondent (b)	Estimated Annual Responses (a) x (b) = (c)	Estimated Time for Response (hours) (d)	Estimated Burden (hour/year) (c) x (d) = (e)	Rate ² (\$/hour) (f)	Estimated Annual Respondent Cost Burden (e) x (f) = (g)
1	DOCX submission of Original New Utility Applications	170,510	1	170,510	0.50	85,255	\$435	\$37,085,925
2	DOCX submission of Utility Continuation/Divisional of an International Application	6,049	1	6,049	0.50	3,025	\$435	\$1,315,875
3	DOCX submission of Utility Continuation/Divisional Applications	57,044	1	57,044	0.50	28,522	\$435	\$12,407,070
4	DOCX submission of Utility Continuation-in-Part Applications	6,516	1	6,516	0.50	3,258	\$435	\$1,417,230
	Totals	240,119	---	240,119	---	120,060	---	\$52,226,100

Table 4: Burden Hour/Burden Cost to Individual and Household Respondents

Item No.	Item	Estimated Annual Respondents (a)	Responses per Respondent (b)	Estimated Annual Responses (a) x (b) = (c)	Estimated Time for Response (hours) (d)	Estimated Burden (hour/year) (c) x (d) = (e)	Rate ³ (\$/hour) (f)	Estimated Annual Respondent Cost Burden (e) x (f) = (g)
1	DOCX submission of Original New Utility Applications	5,420	1	5,420	0.50	2,710	\$435	\$1,178,850
2	DOCX submission of Utility Continuation/Divisional of an International Application	192	1	192	0.50	96	\$435	\$41,760
3	DOCX submission of Utility Continuation/Divisional Applications	1,813	1	1,813	0.50	907	\$435	\$394,545
4	DOCX submission of Utility Continuation-in-Part Applications	207	1	207	0.50	104	\$435	\$45,240
	Totals	7,632	---	7,632	---	3,817	---	\$1,660,395

² 2021 Report of the Economic Survey published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); the USPTO uses the mean IP billing rate for attorneys in private firms which is \$435 per hour. (<https://www.aipla.org/home/news-publications/economic-survey>; pg F-27).

³ Ibid.

13. Provide an estimate for the total annual cost burden to respondents or recordkeepers resulting from the collection of information. (Do not include the cost of any hour burden already reflected on the burden worksheet).
- The cost estimate should be split into two components: (a) a total capital and start-up cost component (annualized over its expected useful life) and (b) a total operation and maintenance and purchase of services component. The estimates should take into account costs associated with generating, maintaining, and disclosing or providing the information. Include descriptions of methods used to estimate major cost factors including system and technology acquisition, expected useful life of capital equipment, the discount rate(s), and the time period over which costs will be incurred. Capital and start-up costs include, among other items, preparations for collecting information such as purchasing computers and software; monitoring, sampling, drilling and testing equipment; and record storage facilities.
 - If cost estimates are expected to vary widely, agencies should present ranges of cost burdens and explain the reasons for the variance. The cost of purchasing or contracting out information collections services should be a part of this cost burden estimate. In developing cost burden estimates, agencies may consult with a sample of respondents (fewer than 10), utilize the 60-day pre-OMB submission public comment process and use existing economic or regulatory impact analysis associated with the rulemaking containing the information collection, as appropriate.
 - Generally, estimates should not include purchases of equipment or services, or portions therefor, made: (1) prior to October 1, 1995, (2) to achieve regulatory compliance with requirements not associated with the information collection, (3) for reasons other than to provide information or keep records for the government, or (4) as part of customary and usual business or private practices.

There are no additional maintenance costs, capital start-up costs, recordkeeping costs, or postage associated with this information collection that are not already accounted for in OMB control number 0651-0032 (Initial Patent Applications). However, the USPTO estimates that the total annual (non-hour) cost burden for this information collection, in the form of filing fees is \$49,588,160.

Filing Fees

The items with filing fees are listed in the table below.

Table 5: Filing Fee Costs to Respondents

Item No.	Item	Estimated Annual Responses (a)	Amount (b)	Totals (a) x (b) = (c)
1-4	Non-DOCX Filing Surcharge Fee (undiscounted entity)	102,095	\$400	\$40,838,000

1-4	Non-DOCX Filing Surcharge Fee (small entity)	47,406	\$160	\$7,584,960
1-4	Non-DOCX Filing Surcharge Fee (micro entity)	14,565	\$80	\$1,165,200
	Totals	164,066	- - -	\$49,588,160

Postage

There are no additional postage costs associated with items in this information collection that are not already accounted for in OMB control number 0651-0032.

- 14. Provide estimates of annualized costs to the Federal government. Also, provide a description of the method used to estimate cost, which should include quantification of hours, operational expenses (such as equipment, overhead, printing, and support staff), and any other expense that would not have been incurred without this collection of information. Agencies may also aggregate cost estimates from Items 12, 13, and 14 in a single table.**

There are no additional government processing costs associated with the items in this information collection, because the actual submission of patent applications, and any government cost burden, is covered by OMB control number 0651-0032 (Initial Patent Applications).

- 15. Explain the reasons for any program changes or adjustments reported on the burden worksheet.**

	Requested	Program Change Due to New Statute	Program Change Due to Agency Discretion	Change Due to Adjustment in Agency Estimate	Change Due to Potential Violation of the PRA	Previously Approved
Annual Number of Responses	411,817	0	411,817	0	0	0
Annual Time Burden (Hr)	123,877	0	123,877	0	0	0
Annual Cost Burden (\$)	49,588,160	0	49,588,160	0	0	0

Changes due to Agency Discretion

This is a new information collection to support the submission to the USPTO of applications in the DOCX format. The USPTO is adopting the DOCX format because it aligns with the USPTO's plans to expand automation of the patent application process, which will increase efficiencies and reduce costs for applicants and the USPTO.

- 16. For collections of information whose results will be published, outline plans for tabulation and publication. Address any complex analytical techniques that will be used. Provide the time schedule for the entire**

project, including beginning and ending dates of the collection of information, completion of report, publication dates, and other actions.

The USPTO publishes applications under 35 U.S.C. 122(b) and issues patents under 35 U.S.C. 153. Also, information regarding patent applications filed and patents granted is published weekly in the Official Gazette of the United States Patent and Trademark Office on the USPTO website.⁴

17. If seeking approval to not display the expiration date for OMB approval of the information collection, explain the reasons that display would be inappropriate.

The items in this information collection will display the expiration date for OMB approval.

18. Explain each exception to the topics of the certification statement identified in “Certification for Paperwork Reduction Act Submissions.”

This collection of information does not include any exceptions to the certification statement.

B. COLLECTION OF INFORMATION EMPLOYING STATISTICAL METHODS

This collection of information does not employ statistical methods.

⁴ <https://www.uspto.gov/learning-and-resources/official-gazette>.