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0651-0089 comment on 91 Fed. Reg. 22526 (Apr 27, 2026) request for comment on *DOCX Submission Requirements*

The PTO's estimated burden on users – a mere 30 minutes to file using “docx” – is comically low. There are several reasons for this.

First, contrary to the PTO's claim, “docx” is not actually a standard, but a proprietary Microsoft format, one that Microsoft changes without notice between versions of MS Word, even versions for different platforms (e.g. for Windows XP, Windows 10, Windows 11, or Word for various Apple operating systems). I sometimes receive documents in “docx format” from colleagues in the Far East which, when opened on my computer in my operating system, display rectangles instead of Latin or Greek characters. If “docx” was in fact a uniform format, that wouldn't happen. And of course, it doesn't happen when I open documents in PDF format that I receive from colleagues in the Far East, because, unlike “docx”, PDF really is a standard, and it was built for portability (hence “pdf” = “portable document format”) to display the same thing regardless of the hardware or operating system.

The fact that docx documents display differently depending on the hardware and software means that that when I file a docx document, I'm taking a risk that the way that document appears on the PTO's screen will differ from how it appears on my screen. That fact alone is enough reason to avoid filing in docx format.

The PTO could in principle address the issue of docx displaying differently in different platforms by enabling users to preview what their document will look like once the document is uploaded into the PTO's systems. If the PTO did that, then we could compare the docx document as it will appear to the PTO to the document as it is supposed to appear, viz. as it appears on the computer one which the patent application document was written. Of course, conducting such comparison might take an hour or two, depending on the length of the application. Nothing in the PTO's “estimated burden” accounts for this, likely because the PTO knows full well that the cost in attorney time to make such a comparison exceeds the \$430 fee for filing in docx. But the PTO should have included such time and cost in its accounting.

In fact, it's worse than that, because the PTO *doesn't* facilitate such a preview of the document as the document will appear in the USPTO's systems. Sure, when I'm in PatentCenter, after I've uploaded a document, I can click on a button that says “preview”, but that's a preview of the document as it looks pre-submission. After I click “submit”, if the document is a docx file, the PTO's own software – which it does not share with the public – does further manipulations on the document. It is that manipulated version that the PTO considers to be the official version of the document. And users have no way of knowing what the manipulated document will look like, since the PTO doesn't not allow us to preview it.

So if someone submits a docx document to the PTO, there's a chance the document that the PTO regards as the official document is not only different from what the user submitted, but a version that the user never saw beforehand.

In order to address this problem, users are forced into several “choices”, most of which cost more in time and expense than paying the “surcharge” for non-docx filing. Once choice – and presumably the

one the PTO wants user to follow, in order for the PTO to get more money – is to file a new patent application in PDF format, and to pay a fee for not allowing the PTO to mangle the user’s submission.

Another option is based on the fact that Patent Cooperation Treaty (PCT) national phase applications are obtained by the PTO from WIPO (the UN body that which administers the PCT) as PDF documents, and thus there is no non-docx surcharge for PCT applications that enter the national phase in the USA. As a result, users whose applications have entered the PCT national phase in the USA, and who wish to file a continuation application, could check the “filing by reference” box in the Application Data Sheet at the time of filing the continuation application, and then a day later file a preliminary amendment as necessary. However, this option is not available to all.

Another option is to file the application as a docx document, but with an “auxiliary PDF” document, a practice in which PTO, in its, um, benevolence and munificence, presently deigns to allow to users to engage. After filing, the applicant can then check the accuracy of the PTO-generated application document against the actual document, and then if discrepancies are found, petition the PTO to correct the mistakes. The PTO’s calculation of “estimated burden” does not account for the time and expense involved in this pathway, which will be at a minimum several hours, and possible tens of hours if many corrections are required because PTO-introduced errors and the PTO is being particularly recalcitrant in acknowledging those errors.

Yet another option is to file the application as a docx document, but to include a second copy of the entire text as *figures* (drawings), which may be in PDF format and do not incur the non-docx surcharge. Then a day or two after filing, the applicant may submit a complete replacement specification and claims in PDF format (since follow-on filing in PDF do not incur the non-docx surcharge), and a set of replacement drawings that include only the actual drawings and not the application text. Since the entire correct text was part of the application as originally filed, there is no issue of entering new matter into the application. The PTO, of course, does not account for this in its “estimated burden”. The good news is that if this process is done efficiently, it can cost about as much in attorney time as the non-docx surcharge, at least for a large entity, and thus cost the applicant no more than the surcharge, but with the money going to the attorney rather than the PTO.

In short, the PTO is deceptive in its “estimated burden” calculations, apparently because it assumes that since it will generally be less costly to pay the fine, er, “surcharge”, for filing in PDF, that’s the route that applicants will take, and therefore the PTO can ignore the additional time and expense that is necessary if one chooses not to file in PDF.

The foregoing discussion assumes, of course, that the PTO’s PatentCenter doesn’t gag on a docx filing. The problem is, it does, because, as noted at the outset, docx is a not a standard format but a Microsoft proprietary format. So if the user doesn’t use whatever version of MS Word the PTO’s software is set up to recognize, the user is out of luck. The user tries to file a docx document, and the system says, “It’s not a docx document”. And then the user spends time – lots of time – trying to save the document in a format that the PTO considers to be docx, which is a lot of trial-and-error, because the PTO doesn’t publish which versions of MS Word are acceptable. (In fact, during rulemaking, the PTO insisted that all versions of “docx” would be acceptable, see “Setting and Adjusting Patent Fees During Fiscal Year 2020, Response to Comments 46, 51, 54, 61, 85 FR 46932, 46956-58 (Aug. 3, 2020)”). The PTO’s “estimated burden” calculations don’t account for this time either.

The bottom line is that the PTO's docx rule imposes much more burden, in time and money, than its estimates say.

In all of the cases discussed above, what would be best is not for the PTO to force applicants to waste time and money, or to effectively pay for the "privilege" of filing in PDF by paying a "surcharge". What would be best is for the PTO to stop lying about docx being a standard format, to drop its insistence on filing in docx, and to allow applicants to file in PDF/A, just as other patent offices do. I regularly file patent applications at the International Bureau of WIPO via its ePCT system, and at the Israel Patent Office using its electronic filing system, and both accept PDF. Israel, in fact, insists on applicants submitting searchable PDF documents.

I also note that if the concern is about making it easy for examiners to search the text of patent applications, on my computer I have an inexpensive program (PDF-Xchange Editor) that allows me to do optical character recognition (OCR) of PDF documents that were not created as searchable documents. There's no reason the PTO can't equip its examiners with such a tool, at an overall cost that's far less than the one that the PTO duplicitously externalizes on patent applicants.

The USPTO's insistence on this docx farce drives up costs for applicants, while yielding nothing for the PTO that could not be achieved by allowing applicants to file in PDF, at an overall lower cost to everyone.

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