



Key Topics Webinar Series

DOCX Filing — Submitter Beware

Before We Get Started...



Recording

A link to the recording and slides will be emailed to all registrants.



Questions

Type in the question box and we will answer in real time or during the Q&A.



Social

Follow us on LinkedIn or go to slwip.com to see upcoming and on demand webinars.

Today's Presenters...



Brad Forrest

Principal
Schwegman Lundberg & Woessner



Kasie Grover

U.S. Paralegal
Schwegman Lundberg & Woessner

Join Us for an Afterparty

Join from PC, Mac, Linux, iOS or Android:

<https://slwip.zoom.us/j/91938486104?pwd=NHRGWjRyd3pZb2hTMC9DYIVxSGxqQT09>

Password: 850070

Or join by phone:

+1 312 626 6799 (US Toll) or +1 646 876
9923 (US Toll)

Meeting ID: 919 3848 6104



Patent Center Application Filing Using DOCX Files

- January 1, 2022 – file DOCX files or pay \$400/200/100
- For all 35 USC 111(a) filings
- USPTO Systems Built Around Needing Tag Based Text
- **DOCX files CAN look different on different systems**



Brief History of Filing Applications

A Brief History of Filing Applications

- Paper, typed, velum, India Ink Drawings Hand carried to USPTO
- Inventor and attorney review what is to be filed
- Mail
- Express mail

A Brief History of Filing Applications

- EFS – PDF created and proofed by applicant
- Inventor and attorney review PDF
- Patent Center – DOCX, or extra \$400 (large entity)
- DOCX displayed by USPTO System – What did the inventor review?
- **DOCX can display differently on different systems!!**
 - Examples to follow

CFR § 1.63 Inventor's oath or declaration.

- (c) A person may not execute an oath or declaration for an application unless that person **has reviewed and understands** the contents of the application, including the claims
- an acknowledgment that any willful false statement made in such declaration or statement is punishable under 18 U.S.C. 1001 by fine or imprisonment
- Must remain applicable after alterations. MPEP 602.08(b)



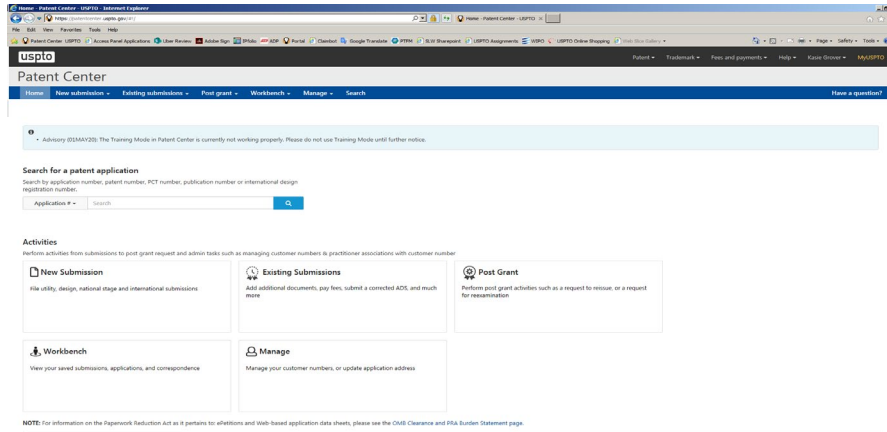
Process

DOCX Process

- PTO Training weekly
- Navigate to Patent Center
- Select new submission
- Load docx of spec, PDF drawings, ADS
- Review errors and warnings
- Click button that makes the USPTO displayed DOCX document is the document of record/Evidentiary Copy per June 2, 2021 Final Rule
- I hope you proofed it well before the system timed out

Patent Center Home Page

- <https://patentcenter.uspto.gov/#/>
- Includes link to final rule



Patent Center Home Page – Functions

- New PAIR Function

Search for a patent application




Search by application number, patent number, PCT number, publication number or international design registration number.

Application # ▾ Search 

- New Submission Function

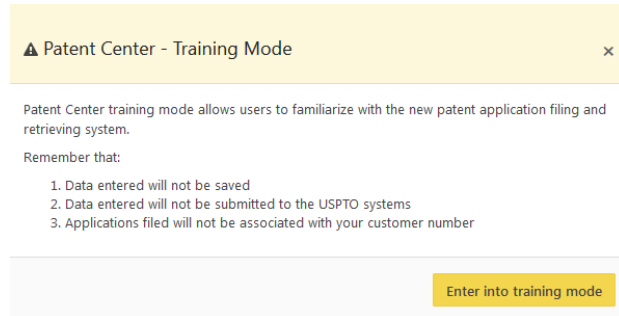
Activities

Perform activities from submissions to post grant request and admin tasks such as managing customer numbers & practitioner associations with customer number

 New Submission File utility, design, national stage and international submissions	 Petitions File ePetitions for automatic processing and immediate grant, if all requirements are met	 Post Grant Perform post grant activities such as a request to reissue, or a request for reexamination
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Patent Center Home Page – Training

- Training Mode – don't log in to access this



▲ Patent Center - Training Mode ×

Patent Center training mode allows users to familiarize with the new patent application filing and retrieving system.

Remember that:

1. Data entered will not be saved
2. Data entered will not be submitted to the USPTO systems
3. Applications filed will not be associated with your customer number

[Enter into training mode](#)

- Quick Start and Training Guides on Patent Center website

Submitting DOCX – Upload Page

The screenshot shows the USPTO Patent Center interface for a 'Utility Nonprovisional' application. The page is titled 'Upload documents' and includes a progress bar with four steps: 'Application data', 'Upload documents', 'Calculate fees', and 'Review & submit'. The 'Upload documents' step is currently active. Below the progress bar, there is a section titled 'Upload documents' with the instruction: 'Add files that you wish to accompany your patent application submission. To add more files, use the file upload interaction or drag & drop them into the area below.' A 'Select file(s)...' button is provided for file selection. A large graphic shows a document icon with the text: 'To get started, drag and drop files here OR upload using the Select file(s) button above'. At the bottom of the main content area, there are three buttons: 'Back', 'Cancel submission', and 'Save Continue'. The footer of the page contains the USPTO logo and navigation links for 'BROWSE BY TOPIC', 'ABOUT THIS SITE', 'USPTO BACKGROUND', and 'FEDERAL GOVERNMENT'.

uspto

Patent Center

Home New submission Existing submissions Past grant Workbench Manage Search Have a question?

Utility Nonprovisional

Nonprovisional Application under 35 USC 111(a)

Application data Upload documents Calculate fees Review & submit

Upload documents

Add files that you wish to accompany your patent application submission. To add more files, use the file upload interaction or drag & drop them into the area below.

Upload documents

To get started,
drag and drop files here
OR
upload using the **Select file(s)** button above

uspto UNITED STATES PATENT AND TRADEMARK OFFICE

BROWSE BY TOPIC

- Patents
- Trademarks
- Learning & Resources

ABOUT THIS SITE

- Accessibility
- Privacy Policy
- Terms of Use

USPTO BACKGROUND

- Federal Activity Inventory Reform Act (FAIR)
- Performance and Planning
- Freedom of Information Act

FEDERAL GOVERNMENT












- Regulations.gov
- StopFakes.gov
- USA.gov


Submitting DOCX – Uploading

- You will need to submit 3 different file types:
 - ADS (WEB/FILLABLE/PDF)
 - DOCX version of Application – Paragraph numbering required
 - PDF of Drawings

Total documents uploaded: 3 [Download all documents](#)

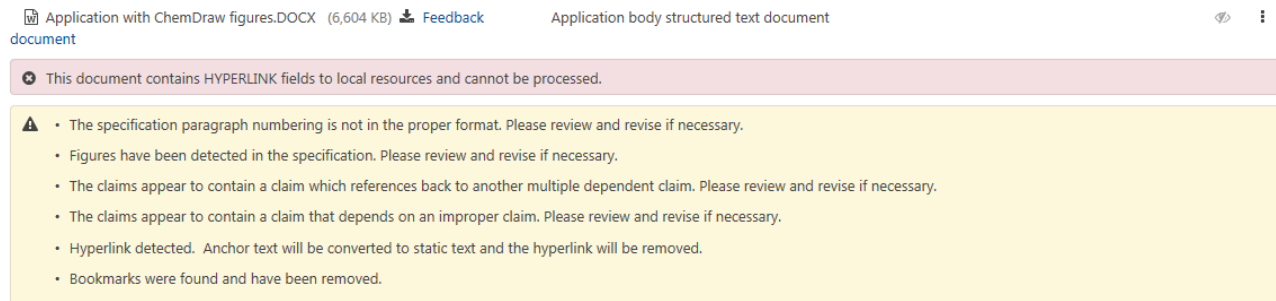
The PDF(s) have been generated from the docx file(s). Please review the PDF(s) for accuracy. By clicking the submit button, you agree to accept any changes made by the conversion and that it will become the final submission. ✕

 ADS.pdf (199 KB / 6 pages)	Application Data Sheet	 
 This is not a USPTO supplied ADS fillable form. Data in the form cannot be automatically loaded to other USPTO systems.		
 Drawings.pdf (29 KB / 3 pages)	Drawings-only black and white line drawings	 
 Specification-APP.TEXT.docx (76 KB / 4 pages)  Feedback document	Application body structured text document	 

 The system detected multiple sections within the document. The individual sections may be downloaded after the submission by going to the respective application's IFW.
Detected: Specification, Claims, Abstract

Submitting DOCX – Warning Errors

- The system will indicate any warnings/errors and generate a feedback document for review



Application with ChemDraw figures.DOCX (6,604 KB) [Feedback](#) document

Application body structured text document

⊘ This document contains HYPERLINK fields to local resources and cannot be processed.

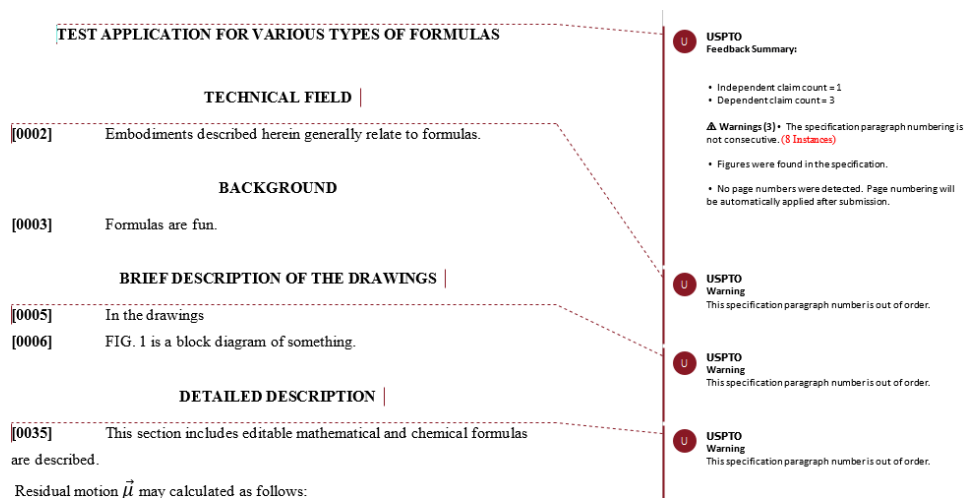
⚠

- The specification paragraph numbering is not in the proper format. Please review and revise if necessary.
- Figures have been detected in the specification. Please review and revise if necessary.
- The claims appear to contain a claim which references back to another multiple dependent claim. Please review and revise if necessary.
- The claims appear to contain a claim that depends on an improper claim. Please review and revise if necessary.
- Hyperlink detected. Anchor text will be converted to static text and the hyperlink will be removed.
- Bookmarks were found and have been removed.

- You can submit an application with a warning but cannot submit an application with an error

Submitting DOCX – Feedback Document

- The document will contain balloons where warnings/errors occur




Submitting DOCX – Document of Record

Total documents uploaded: 1

[Download all documents](#)


Please review the DOCX file(s) that is being submitted. By clicking the submit button, you agree to accept the DOCX validation(s) as your final submission.



 021WO1-APP.TEXT.docx (67 KB / 29 pages)

Application body structured text document

 [Feedback document](#)

 The system detected multiple sections within the document. The individual sections may be downloaded after the submission by going to the respective application's IFW.
Detected: Abstract, Claims, Specification

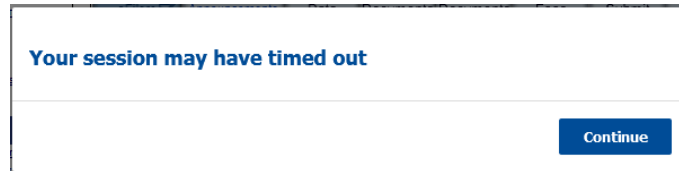
- Your final warning before clicking submit

Proofing

- A hash of the DOCX file is generated by the USPTO
 - See submission receipt
- You can find your own hash generator and check to make sure they match – after you have filed.
- However, rendering the DOCX file may still vary depending on platform
- If a formula is missing or mangled
 - Enablement?
 - Inequitable conduct?
 - Malpractice?

Submitting DOCX – Timeout

- Your session will timeout after a designated time of inactivity
 - Less time for review of the displayed DOCX file
 - Saved submissions require re-review



Warning!!!

- Our testing has shown that most formulas and chemical drawings using Chemdraw® Software come out ok.
- Others have described problems.
 - See Carl Opedahl's blog: <https://blog.oppedahl.com/?s=docx>
- Hidden URL prevented filing using DOCX – test mode did not identify the URL.
 - Finally identified in submitting mode

Warning, Cont.

- DOCX is designed to adapt for each computer it's rendered on.
 - Pagination may change
 - Non Microsoft shops are likely to encounter bigger changes
- List of fonts supported by DOCX.
 - Subject to change without notice
- Plugins and additional settings are not allowed

Potential for Error in Filing

- USPTO DOCX file may display differently on USPTO system.
 - It even happened within our firm on different computers
- Software changes over time
- LaTeX used for math heavy research papers
- New ways to express new ideas
 - Next example apparently fixed by programmers
 - But, what about the next new way to express a new idea?



Examples

Example

- SUBMITTED DOCX:

- [0128]

```
[h,w]=size(lin);
lout=zeros(size(lin));
for i=1:h,
    for j=1:w,
        x=j;
        y=i;
        S=dZ/(f*H);
        x1=x(:)-x0;
        y1=y(:)-y0;
        y2=y1./(1+y1*S);
        x2=x1./(1+y1*S);
        x2=x2+x0;
        y2=y2+y0;
        lout(i,j)=bilinearInterpolate(lin,x2,y2);
    end;
end;
```

- USPTO DOCX:

- [0128]

```
for j=1:w,
    [h,w]=size(lin);
    S=dZ/(f*H);
    x2=x2+x0;
    lout(i,j)=bilinearInterpolate(lin,x2,y2);
end;
x=j;
lout=zeros(size(lin));
x1=x(:)-x0;
y2=y2+y0;
end;
for i=1:h,
    y=i;
    y1=y(:)-y0;
    x2=x1./(1+y1*S);
end;
```

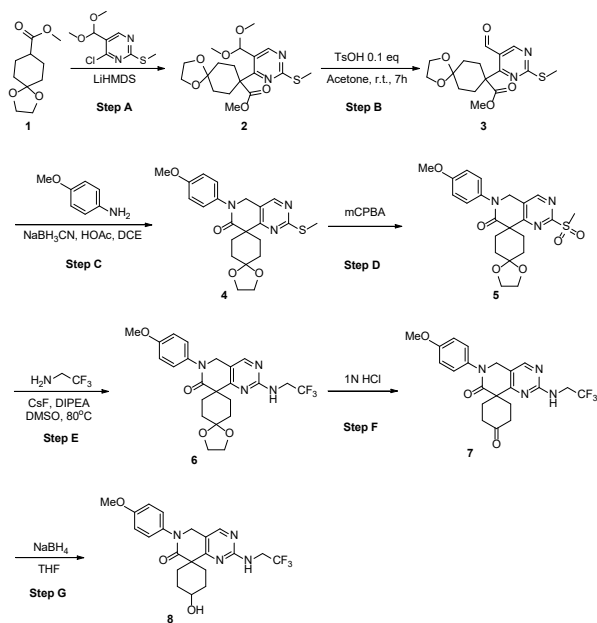
Example

PTO PDF:

```
[0009]      [h,w]=size(Iin);          Iout=zeros(size(Iin));      for i=1:h,
              for j=1:w,              x=j;
              y=i;                    S=dZ/(f*H);          x1=x(:)-
x0;              y1=y(:)-y0;
              y2=y1./(1+y1*S);        x2=x1./(1+y1*S);
              x2=x2+x0;              y2=y2+y0;
              Iout(i,j)=bilinearInterpolate(Iin,x2,y2);      end;
end;
```

Examples

SUBMITTED DOCX:



Potential for Error in Filing

- Concrete Examples:
 - Libre Office emailing DOCX to Office 365
 - Different page breaks
 - Different indents
 - Different spaces
 - Fonts rendered differently
 - Math formulas look different

$$f(u) = \cos(u)^3 \exp(0.2u)$$

- Converts to:

$$f(u) = \cos(u)^3 \exp(10.2u)$$

Hard to find errors when filing – no error or warning

$$M(x)[Z] \leq \exp(\epsilon \cdot d(x, x')) \cdot M(x')[Z].$$

$$M(\square)[Z] \leq \exp(\square \cdot \square(\square, \square')) \cdot M(\square')[Z].$$

Examples

Error! No text of specified style in document.

Various components goofed up

Error! No text of specified style in document.

ABSTRACT

An endoscope. One

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Hard to find errors

- Hidden hyperlink
 - Does not appear when reading application
 - Apparently F9 will reveal in MS Word.
 - Fixed
- Unrecognizable font error associated with Chemical equation
 - Prevents filing and hard to find.
 - Fixed
- “CONCLUSION” – on a separate line prevented filing

Hard to find errors

- PDF resulted in blank pages in PTO version
- USPTO programmer says it has been fixed after we provided an example
 - Temporary system resource constraint
 - But - hyperlink **error** returned.
 - P [272] – Javascript hyperlink
 - Now it works
- Providing client confidential information in testing is problematic – we had to work to create non-confidential examples when encountering errors.

Compatible with Current Filing Process?

- Inventor approves PDF of Application
 - That's not what we have to file to avoid non-docx filling fee
 - Can't control inventor system to review docx file
- Limited time to proof converted PDF
- Existing applicant processes may need changing, but how?
 - Paralegal files after practitioner approves final draft
 - Who does the proofing
 - This process is not compatible with Patent Center DOCX filing

Process Legal Issues

- What does inventor approve?
- How does that correspond to the USPTO displayed DOCX file?
- What if error not found before hitting submit?
- Malpractice?
- Inequitable conduct?
 - W. Covey (OED) says if good process followed, you should be ok
 - Malpractice plaintiff might not be so nice.

Before Patent Center Becomes Trusted

- Consider filing a same day provisional application in PDF without a fee
- Proof the PDF closely within two months of filing
- If errors, pay the provisional fee and claim priority
- Submit a preliminary amendment
- Use images of formulas in DOCX document
 - Enlarge the images as resolution reduced to 300x300 DPI for storage in USPTO system

Provisional PDF might not help you

- Internationally – 91BIS – obvious error
 - Different result in different countries
 - Playing with fire
- US - priority claim has to be present at filing. (MPEP 257 addressing 1.57)
 - filed on or after September 21, 2004
- Can burn up \$400 worth of protective measures fairly quickly

Advocacy Efforts

- Several meetings with USPTO over 1.5 years
- Worked to provide examples to programmers
- Asked PTO to allow applicant provided PDF to be used to correct the document of record/Evidentiary Copy
 - PDF should be a priority document
- Reduce/eliminate fee for non DOCX filing
 - Admitted cost to Office is only \$3.15 per application.
- No fee for emergency filing in non-English

DOCX fonts

- **DOCX Supported Font List**
- ***may be subject to change without notice**

Arial	Batangche	Fang Song	Symbol
Arial Black	Calibri	Georgia	Tahoma
Arial Narrow Cambria	Helvetica Neue	Times	
Arial Rounded Mt	Cambria Math	Liberation	Times New Roman
Arial Unicode Ms	Castellar	MS Mincho	Trebuchet MS
Ariel	Courier	MS pmincho	Verdana
Ariel Black	Courier New	Pmingliu	Wide Latin
Batang	Extb	Simsun	

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Join from PC, Mac, Linux, iOS or Android:

<https://slwip.zoom.us/j/91938486104?pwd=NHRGWjRyd3pZb2hTMC9DYIVxSGxqQT09>

Password: 850070

Or join by phone:

+1 312 626 6799 (US Toll) or +1 646 876
9923 (US Toll)

Meeting ID: 919 3848 6104





Thank you for your interest.

Questions?





These materials are for general informational purposes only. They are not intended to be legal advice, and should not be taken as legal advice. They do not establish an attorney-client relationship.