

REPORT

**USPTO TO REQUIRE DOCX FORMATTED APPLICATIONS IN
NON-PROVISIONAL APPLICATIONS STARTING JANUARY 1, 2023****November 24, 2021**

The U.S. Patent and Trademark Office (USPTO) previously announced a requirement to file many new patent applications in DOCX format, beginning January 1, 2022. That requirement has now been postponed one year, to January 1, 2023, so that the USPTO can further review its procedures and conduct more internal testing. This Special Report addresses the upcoming requirement so that clients can consider the requirement and necessary procedural changes.

We will continue to update this Special Report and provide updated guidance as any USPTO changes occur.

On January 1, 2023, the USPTO will begin requiring that many new patent applications be filed in DOCX format rather than PDF format in order to avoid an additional filing fee surcharge. PDF format application filings will still be accepted by the USPTO after January 1, 2023; however, applications not filed in DOCX format will be assessed an additional surcharge of \$400 (\$200 for small entities; \$100 for micro entities).

This DOCX requirement applies to new non-provisional utility application filings under 35 U.S.C. §111(a) (including new non-provisional, divisional, continuation,

continuation-in-part, and bypass application filings) filed on or after January 1, 2023.

This DOCX requirement does not apply to new provisional, design, reissue, reexamination, or Supplemental Examination application filings. For these latter application filings, PDF format will still be required. This DOCX requirement also does not apply to new plant patent application filings or to applications subject to a Secrecy Order, which must still be filed in paper form.

This DOCX requirement does not apply to PCT-U.S. national phase applications. PCT-U.S. national phase applications can still be filed in PDF format, or can optionally be filed in DOCX format if desired, but only if the English-language text is filed at the time of the initial national phase entry. DOCX format files cannot be filed as follow-on filings after the initial national phase entry date, i.e., for late submission of the English-language translation of the PCT application.

In view of these new requirements, we request that our clients start providing us with DOCX formatted new application filing documents in advance of January 1, 2023.

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For clients not familiar with DOCX, we provide the following additional guidance, followed by some general recommendations.

I. DOCX Explained

DOCX format is a word processing document format, also known as Office Open XML. DOCX format is standardized as ECMA-376 and ISO/IEC 29500. DOCX is supported by many popular word processing applications, such as Microsoft Word, Google Docs, and LibreOffice.

As noted by the USPTO, the benefits of using the DOCX format include:

- Increased efficiencies, by eliminating the need to convert structured text into a PDF for filing.
- Higher data quality, by reducing conversion errors that can occur when converting a standard word processing file to a PDF file.
- Smarter interface, because the USPTO filing system can detect common errors during the filing process, such as formatting errors, and provides instant feedback to prevent unnecessary delays in processing the application, all before the application is formally submitted to the USPTO.
- Application Management: DOCX data allows future reuse of content and delivering new powerful features such as improved searching for patent applications and submissions.
- Privacy: the USPTO filing system provides automatic metadata detection (e.g., author and comments) and removal features to support the submission of only substantive information in the DOCX file.
- Improved application quality: the USPTO filing system provides content-based validations pre-submission, identifying issues up front and

allowing for them to be addressed before examination begins or even before the filing is completed.

- Ease of use: provides automated document indexing. That is, the need to separately identify the pages of the specification, claims, and abstract during the filing process will no longer be necessary.
- Compatibility: eliminates the non-embedded font error, the most common obstacle in uploading a PDF, by uploading the application file with supported fonts.

Because the DOCX file is formatted and searchable, the USPTO filing system will perform a number of quality checks during the filing process. The USPTO filing system will then provide any relevant warnings and errors via a feedback document. Any errors must be addressed in order to proceed with the application filing. While warnings will not prevent an application from being filed, the application can be revised to address the warnings and thus to avoid potential issues during future examination.

For initial non-provisional patent application filings, the specification, claims, and abstract can be included in a single DOCX file or in separate DOCX files. For initial PCT-U.S. national phase application filings that include an English-language specification or translation optionally filed in DOCX format, the specification, claims, and abstract must be filed as separate DOCX files. Any drawings for all application types should still be provided in a separate PDF file for filing.

II. Supported Fonts in DOCX Files

To avoid receiving an error during the filing process, the DOCX file should only use

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fonts supported by the USPTO filing system. The recommended supported fonts are listed here:

Arial	Liberation Sans
Arial Black	Lucida Sans
Arial Narrow	Monaco
Arial Rounded Mt	Symbol
Arial Unicode Ms	Tahoma
Calibri	Times
Cambria	Times New Roman
Cambria Math	Trebuchet MS
Castellar	Verdana
Courier New	Wide Latin
Georgia	

III. Headings

The USPTO filing system recognizes the different sections of the specification and claims based on specifically worded headings used in the application text. It is thus important to use standard section headings when drafting the application. Further, it is important that those section headings be spelled correctly, otherwise they will not be properly recognized by the USPTO filing system.

For most applications, the relevant section headings would include:

INVENTION TITLE

BACKGROUND OF THE INVENTION

SUMMARY OF THE INVENTION

BRIEF DESCRIPTION OF THE
DRAWINGS

DETAILED DESCRIPTION

CLAIMS

ABSTRACT

Other section headings and alternative wordings for the above section headings are shown in the attached "DOCX Keywords for Section Headers" document provided by the USPTO.

IV. How Oliff PLC Will Handle DOCX Filings

Because the USPTO filing system provides immediate, pre-filing feedback in the form of warnings and errors related to the DOCX file, we will attempt to resolve any issues before completing the application filing. For simple issues that do not have any substantive impact on the application, we will attempt to resolve the issues on our end. For other issues that cannot be readily addressed on our end, and if time permits before any convention or client-indicated filing due date, we will contact clients for guidance and any necessary corrections. In a worst-case situation, where we cannot address any indicated warnings or errors, we will proceed with the application filing to secure the filing date. In those situations, we may proceed to file the application in DOCX format understanding that corrections may be required at a later date, or we may proceed to file the application in PDF format and pay the non-DOCX filing surcharge. We will not incur the non-DOCX filing surcharge without permission from the client unless we must file in PDF format to secure a necessary filing date.

For PCT-U.S. national phase applications, absent specific instructions from the client, we will attempt to file the application in DOCX format, if possible. However, if the client does not provide suitable DOCX format files, if we cannot readily resolve any USPTO-indicated warnings or errors in the DOCX format files, or if the initial U.S. national phase entry filing application text is not in English, then we will proceed to instead file in PDF format. Neither of

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these approaches will incur any additional fees at this time.

V. Checking of USPTO-Generated Files

After the DOCX formatted files are received by the USPTO, the USPTO will automatically generate a PDF file of the application as filed, and that PDF file will appear in the Image File Wrapper. The USPTO has indicated that the official (evidentiary) copy of the application as filed would be the DOCX documents. Applicant can thus rely on that DOCX version as the source or evidentiary copy of the application to make any corrections in subsequent prosecution.

However, the USPTO recommends checking the final USPTO-generated PDF document for any discrepancies or conversion errors. Any such discrepancies or conversion errors can be corrected either by bringing them to the attention of the USPTO Electronic Business Center, or by a Petition under 37 C.F.R. §1.181. Any request for correction should be filed within one year of the document filing date, and the USPTO has indicated that correction requests filed later than that date might not be considered.

As a general matter, because the DOCX format document is the official version of the application, we do not plan to check every USPTO-generated PDF copy of application documents that we file in DOCX format to ensure that they are the same. Further, for most applications, especially applications that include only normal text and no Greek characters or formulas or equations, checking the USPTO-generated PDF copy should not be necessary.

Checking the USPTO-generated PDF copy for accuracy would add significant work and cost to the application filing process. To avoid added costs to our clients, Oliff PLC does not

intend to check the USPTO-generated PDF copy for accuracy in all instances. Rather, Oliff PLC intends to very briefly spot-check the USPTO-generated PDF copy only in instances where we believe such check is warranted. Such spot-checking will be conducted at no cost to our clients. For clients that would like for us to conduct a more thorough review of the USPTO-generated PDF copies, please let us know so that we may provide appropriate cost estimates.

VI. Recommendations

Before DOCX format filing becomes a requirement on January 1, 2023, Oliff PLC will continue to file new patent applications in whichever format they are provided to us by our clients, unless a client specifies a preference for PDF or DOCX format.

In order to facilitate smooth filing of new patent applications, we recommend the following actions when clients decide to transition from filing applications in PDF format to DOCX format in advance of the January 1, 2023, date:

- Start providing us with new non-provisional patent applications in DOCX format. We can start filing these documents, and can also provide feedback as to suggested formatting changes, before DOCX filing becomes a requirement on January 1, 2023.
- We understand that some non-text items, such as mathematical equations and chemical formulas, may be best if they are included in the DOCX file as images. The USPTO has stated that DOCX services fully support equation editing software, such as MathML, and chemical structure editing software, such as ChemDraw, and that the resultant chemical structures and mathematical formulae are stored and rendered correctly when they use an approved font. However, it may still

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be beneficial to include these items as images to avoid any potential issues.

- Data tables can be included in the DOCX file, and are best presented in the form of text rather than as images.

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in our Alexandria, Virginia office.*

Oloff PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oloff PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

For further information, please contact us by telephone at (703) 836-6400, facsimile at (703) 836-2787, email at email@oliff.com or mail at 11 Canal Center Plaza, Suite 200, Alexandria, Virginia 22314. Information about our firm can also be found on our website, www.oliff.com.

スペシャルレポートの日本語版は、英語版の発行後、三週間以内にウェブサイトでご覧いただけます。

DOCX keywords for section headers
*Please note that at least one of these key words needs to be present for the section to be automatically detected.
Spec Section
INVENTION TITLE
INVENTION SPECIFICATION
INVENTION DESCRIPTION
TITLE OF (THE) INVENTION
DESCRIPTION OF (THE) INVENTION
SPECIFICATION
Claims Section
Claim
Claims
Patent Claims
What is claimed
What is claimed is
Claimed are
I claim
We (hereby) claim
We Claim
In the claims
The claims (here) defining the invention are
Claim or Claims
What is put forth is
Abstract Section
ABSTRACT
ABSTRACT OF (THE) INVENTION
INVENTION ABSTRACT
DISCLOSURE ABSTRACT
ABSTRACT OF (THE) DISCLOSURE
CONCLUSION
Spec Subsection
REFERENCE TO RELATED APPLICATIONS
RELATED APPLICATIONS
CROSS[-]REFERENCES
REFERENCE TO RELATED PATENTS

STATEMENT OF GOVERNMENT INTEREST
RIGHTS TO INVENTION UNDER FEDERAL RESEARCH
FEDERALLY SPONSORED RESEARCH AND DEVELOPMENT
GOVERNMENT INTEREST
GOVERNMENT RIGHTS IN THE INVENTION
FEDERAL FUNDS STATEMENT
STATEMENT AS TO RIGHTS TO INVENTIONS MADE UNDER FEDERALLY SPONSORED RESEARCH AND DEVELOPMENT
ORIGIN OF THE INVENTION
FEDERALLY SPONSORED RIGHTS
STATEMENT OF FEDERALLY SPONSORED RESEARCH
ACKNOWLEDGMENT OF GOVERNMENT SUPPORT
BACKGROUND OF THE INVENTION
DESCRIPTION
BACKGROUND OF (THE) INVENTION
BRIEF STATEMENT OF THE INVENTION
SUMMARY OF THE INVENTION
OBJECT OF THE INVENTION
OBJECT AND SUMMARY OF THE INVENTION
FIELD AND BACKGROUND OF THE INVENTION
FIELD OF (THE) INVENTION
TECHNICAL FIELD
TECHNICAL FIELD OF THE INVENTION
PRIOR ART
DESCRIPTION OF THE PRIOR ART
BRIEF STATEMENT OF THE PRIOR ART
BACKGROUND ART
DESCRIPTION OF RELATED ART
DESCRIPTION OF THE RELATED ART
BRIEF DESCRIPTION OF DRAWINGS
BRIEF DESCRIPTION OF THE DRAWINGS
BRIEF DESCRIPTION OF FIGURES
BRIEF DESCRIPTION OF THE FIGURES
JOINT RESEARCH AGREEMENT
BEST MODE FOR CARRYING OUT THE INVENTION
DETAILED DESCRIPTION
DESCRIPTION OF THE INVENTION
DETAILED DESCRIPTION OF THE INVENTION
DETAILED DESCRIPTION OF THE DRAWINGS
CROSS[-]REFERENCE TO RELATED APPLICATIONS

Drawings/Figures
DRAWING
DRAWINGS
FIGURE
FIGURES