

Jeffrey Wolfson, Braden Davies Author Article in IP and Technology Law Journal: ‘Mirror, Mirror? A New PDF Backup Option for DOCX Filings via Patent Center’

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PRACTICES Intellectual Property Litigation, AI and Technology, Patent Litigation, Patent Office Trials, Patents, Trademark and Advertising, Intellectual Property

Partner [Jeffrey Wolfson](#) and [Braden Davies](#) authored an article in *Intellectual Property and Technology Law Journal*. Read an excerpt below:

In an effort to ease the transition to the new DOCX filing format for non-provisional utility patent applications, the United States Patent and Trademark Office (“USPTO”) recently announced it will allow the option to file an applicant-generated PDF along with the DOCX filing of the application through December 31, 2022. This announcement came from Kathi Vidal, the new director of the USPTO, in a blog post released on the USPTO website and that thereafter was formally published in the Federal Register.

The Surcharge Fee

The option to file an applicant-generated PDF follows a previous announcement from the USPTO that the implementation of a surcharge fee for non-DOCX filings would be delayed until January 1, 2023. The previous effective date for the surcharge fee had been set for January 1, 2022, however, numerous objections and concerns have been raised.

On January 1, 2023, the surcharge fee will be due for any non-provisional utility application –other than a reissue application – that is filed in a non-DOCX format. Until then, and to encourage applicants to begin the transition to DOCX format filings, the USPTO is giving applicants the option to file a backup, applicant-generated PDF along with the DOCX filing. The applicant-generated PDF will serve as a safeguard against any discrepancies that may arise as a result of the conversion process of the DOCX file to a PDF file at the USPTO.

If such a discrepancy does arise, the applicant will be able to rely on the applicant-generated PDF to make any necessary corrections supported by the PDF upon the filing of a petition under 37 C.F.R. § 1.182 and an amendment in compliance with 37 C.F.R. § 1.121. Importantly, “[t]he applicant-generated PDF that accompanies a DOCX filing will not become part of the permanent record unless a petition is filed requesting the USPTO to correct the record in view of the applicant-generated PDF.”

Excerpted from *Intellectual Property and Technology Law Journal*. To read the full article, click [here](#).