



American Intellectual Property Law Association

AIPLA Advocacy and the USPTO Delaying Fee for Patent Applications Not Filed in DOCX Format

January 9, 2023

AIPLA is pleased to report that based, in part, on its continued leadership in intellectual property advocacy, the United States Patent and Trademark Office (USPTO) has again delayed implementation of fees on patent applicants who do not file applications in a specific electronic filing format.

AIPLA also continues to work with the USPTO in a collaborative manner to help develop filing standards that are robust and do not negatively impact applicants' legal rights.

On July 31, 2019, the USPTO published its Notice of Proposed Rulemaking, "Setting and Adjusting Patent Fees During Fiscal Year 2020" ("Notice," 84 Fed. Reg. 37398). In that Notice, the USPTO proposed to institute fees for filing patent applications in formats other than what they designated as a "structured text format" and referred to as DOCX.

In 2019, members of the AIPLA community recognized the significance of this fee, the implications of a transition to an electronic filing format with no established standard, and the potential disproportionate impact of the charge on independent and small entities.

Following the Notice, the AIPLA began discussions with the USPTO about their DOCX filing process and the use of financial measures to "encourage" patent applicants to file their patent applications in a singular electronic format.

AIPLA/USPTO discussions have highlighted DOCX software limitations and the burden of the "non-DOCX" filing fees would incur. Additionally, AIPLA has been advocating for DOCX process changes that would preserve patent applicants right to file patent applications in formats that would preserve their legal rights and to do so without incurring unwarranted financial penalties.

Recently, at their 2022 Annual Meeting and more recently, AIPLA leadership and members met with USPTO Director Kathi Vidal and members of her executive team to continue highlighting the legal questions, technical limitations, and financial impacts attributable to implementation of their DOCX program.

In addition, the AIPLA's engagement with the USPTO has resulted in many technical improvements in the DOCX system. It is our goal that these changes will eventually result in a fair and robust filing system that benefits patent applicants and increases USPTO patent examination quality.