

Clarification of the Requirement for the Non-DOCX Surcharge

Summary

On January 17, 2024, the fee for filing a nonprovisional utility patent application under 35 U.S.C. 111 that is not in DOCX format took effect. See 37 CFR 1.16(u). The United States Patent and Trademark Office (USPTO) has become aware of some confusion about whether an applicant must pay the non-DOCX fee if they submit, on the same day, an application in DOCX and a preliminary amendment to the specification, claims, and/or abstract in PDF format. This notice is being published to clarify that an applicant who files a preliminary amendment to the specification, claims, and/or abstract on the filing date of the application must submit the preliminary amendment as a follow-on submission in DOCX format in order to avoid incurring the fee set forth in 37 CFR 1.16(u) (hereafter referred to as “the non-DOCX surcharge”). This notice also clarifies that an applicant who submits a PDF version of the application (e.g., specification, claims, and abstract) when filing an application in DOCX format must follow the process for submitting an Auxiliary PDF set forth by the USPTO in order to avoid incurring the non-DOCX surcharge.

Under certain conditions set forth in this notice, an applicant who relied on confusing or incorrect information from the USPTO and filed a preliminary amendment to the specification, claims, and/or abstract in PDF format on the filing date of an application where the application was otherwise filed in DOCX format, and who received a notice requiring the non-DOCX surcharge but has not yet paid that surcharge, may file a petition under 37 CFR 1.183 requesting waiver of the outstanding non-DOCX surcharge.

Background

The USPTO has been transitioning to the filing of patent application-related documents in DOCX format through Patent Center as part of its continuing efforts to modernize its patent application systems and strengthen its ability to examine applications quickly and effectively. As part of the transition, the USPTO implemented a fee for nonprovisional utility patent applications filed under 35 U.S.C. 111 that are not filed in DOCX format. See 37 CFR 1.16(u). This fee became effective on January 17, 2024.

Filing a preliminary amendment

37 CFR 1.16(u) applies to nonprovisional utility patent applications filed under 35 U.S.C. 111 and provides that the additional fee (non-DOCX surcharge) is required “where the specification, claims, and/or abstract does not conform to the USPTO requirements for submission in DOCX format.” In accordance with 37 CFR 1.115(a)(1), a preliminary amendment that is filed on the filing date of an application is part of the original disclosure of the application. Thus, a preliminary amendment to the specification, claims, and/or abstract filed on the same day as the application must be in DOCX format to avoid the non-DOCX surcharge.

Patent Center provides for the *initial submission* of new applications and *follow-on submissions* in existing applications. See <https://www.uspto.gov/patents/apply/patent-center>. To file a preliminary amendment to the specification, claims, and/or abstract in DOCX format on the same day as the application, the preliminary amendment must be filed as a *follow-on submission* in the application. Applicants are advised that a preliminary amendment to the specification, claims, and/or abstract cannot be filed in DOCX format as part of the *initial submission* of a new application.

Because a preliminary amendment to the specification, claims, and/or abstract filed on the same day as the application is part of the original disclosure of the application, the filing of such a preliminary amendment in PDF format will incur the non-DOCX surcharge. However, a preliminary amendment filed in PDF format after the filing date of the application will not incur the non-DOCX surcharge because the preliminary amendment is not part of the original disclosure of the application and thus is not required to be in DOCX format.

The USPTO is aware of some confusion from information that was made publicly available on the USPTO website or was presented in DOCX training sessions. To the extent the information suggested or indicated that preliminary amendments can be filed in PDF format and be included in the initial filing without incurring the non-DOCX surcharge, the information was confusing and/or incorrect.

Under the conditions set forth below, an applicant who relied on the information that was made publicly available on the USPTO website or was presented in DOCX training sessions may file a petition under 37 CFR 1.183 requesting waiver of the non-DOCX surcharge set forth in 37 CFR 1.16(u):

1. The application must have been filed prior to the date that is one week after the publication date of this notice in the Official Gazette (note that publication will occur approximately three weeks after this notice is signed and posted on the USPTO website);
2. A preliminary amendment to the specification, claims, and/or abstract in PDF format must have been filed on the filing date of an application otherwise filed in DOCX format (e.g., the specification, claims, and/or abstract that were not part of the preliminary amendment were filed in DOCX format); and
3. A notice requiring the non-DOCX surcharge under 37 CFR 1.16(u) due to the preliminary amendment being filed in PDF format must be outstanding because the non-DOCX surcharge has not yet been paid.

A grantable petition under 37 CFR 1.183 requesting waiver of the non-DOCX surcharge based on the information provided by the USPTO must include a statement that petitioner relied upon confusing or incorrect information in filing the preliminary amendment in PDF format and must distinctly identify the source (e.g., specific training session) of the information. The petition must also be accompanied by the petition fee set forth in 37 CFR 1.17(f). However, the petition fee will be refunded if the petition is granted. Note that the mere filing of a petition does not stay the time period for reply to an outstanding notice. See 37 CFR 1.181(f). In order for the petition to be a complete reply to the non-DOCX surcharge requirement, the petition must be grantable. If the petition is not grantable, the period for response will continue to run from the notice requiring the non-DOCX surcharge.

Applicants are reminded that they can avoid filing a preliminary amendment when filing a new application by incorporating any desired amendments into the text of the specification, including a new set of claims, even where the application is a continuation or divisional application. For further information, see the Manual of Patent Examining Procedure (MPEP) (9th Edition, Rev. 07.2022, February 2023), Section 201.06(c), subsection III, and Section 714.01(e).

Filing an Auxiliary PDF of the application

When filing a nonprovisional utility patent application in DOCX format, applicants have the option to submit an Auxiliary PDF of the application without incurring the non-DOCX surcharge. However, applicants must follow the process for submitting an Auxiliary PDF of the application set forth in the quick reference guide that is accessible from the DOCX information webpage at <https://www.uspto.gov/patents/docx>. See “Extension of the Option for Submission of a PDF With a Patent Application Filed in DOCX Format,” 88 FR 37036 (Jun. 6, 2023) (the 2023 Notice) and “Extension of Period To Allow Submission of a PDF With a Patent Application Filed in DOCX Format,” 87 FR 77812 (Dec. 20, 2022) (the 2022 Notice). The non-DOCX surcharge will be required if an applicant does not follow the process for submitting an Auxiliary PDF of the application set forth in the quick reference guide, but instead uploads a PDF version of the application in some other manner during the application filing process or after filing of the application. By following the process for submitting an Auxiliary PDF of the application set forth in the quick reference guide, the Auxiliary PDF will be automatically assigned the document description “Auxiliary PDF” and the document code “AUX.PDF.” This will allow the USPTO, applicants, and members of the public viewing the application file to distinguish the Auxiliary PDF of the application from the specification, claims, and abstract that will be or has been used during examination.

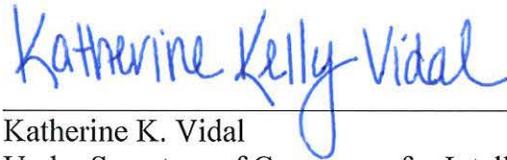
Contact information

For questions or assistance regarding filing in DOCX, please contact the Patent Electronic Business Center at ebc@uspto.gov or 866-217-9197, Monday through Friday, 6 a.m. to midnight, ET.

For questions or assistance regarding filing a petition under 37 CFR 1.183, please contact the Office of Petitions at 571-272-3282.

For questions regarding this notice, please contact the Office of Patent Legal Administration at 571-272-7701 or PatentPractice@uspto.gov.

Dated: 5/17/24



Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office