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OFFICE OF PETITIONS

In re Application of
Eilon Riess et al.

Application No. 09/836,281

Filed: April 18, 2001

For: **RELIABLE SYMBOLS AS A MEANS OF
IMPROVING THE PERFORMANCE OF
INFORMATION TRANSMISSION
SYSTEMS**

ON PETITION

This is a decision on the petition under 37 CFR 1.183 filed September 18, 2001, requesting waiver of the requirement in 37 CFR 1.217(a) that a redacted copy of an application be filed within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code (title 35), and publication of only the redacted copy of the above-identified application under 37 CFR 1.217.

The petition to waive the requirement in 37 CFR 1.217(a) that a redacted copy of an application be filed within sixteen months after the earliest filing date for which a benefit is sought under title 35, and to publish only the redacted copy of the above-identified application under 37 CFR 1.217 is **DENIED**.

BACKGROUND

The above-identified application was filed under 35 U.S.C. § 111(a) and 37 CFR 1.53(b) on April 18, 2001. The application included an authorization to charge the filing fee to a deposit account but did not include an oath or declaration under 37 CFR 1.63.

On June 20, 2001, the United States Patent and Trademark Office (USPTO) issued a Notice to File Missing Parts of Nonprovisional Application requiring an oath or declaration under 37 CFR 1.63 and the surcharge under 37 CFR 1.16(e).

On July 16, 2001, petitioners submitted, *inter alia*, a declaration under 37 CFR 1.63 and the surcharge under 37 CFR 1.16(e). The declaration under 37 CFR 1.63 included claims to the benefit of international application PCT/GB 00/02634 (filed July 10, 2000), international application PCT/GB 00/02648 (filed July 10, 2000), United Kingdom application GB0016938.3 (filed July 10, 2000), and United Kingdom application GB9926167.9 (filed November 4, 1999).

On September 18, 2001, petitioners submitted: (1) a redacted copy of the above-identified application via the USPTO's electronic filing system; (2) a certified copy of each of international application PCT/GB 00/02634, international application PCT/GB 00/02648, United Kingdom application GB0016938.3, and United Kingdom application GB9926167.9; (3) a marked-up copy of the application showing the redactions in brackets; (4) a certification that the redacted copy of the application eliminates only the part of the description of the invention that is not contained in any of the four foreign-filed patent applications to which the above-identified application claims priority; and (5) a petition under 37 CFR 1.183 requesting waiver of the requirement in 37 CFR 1.217(a) that a redacted copy of an application be filed within sixteen months after the earliest filing date for which a benefit is sought under title 35.

STATUTE AND REGULATION

35 U.S.C. § 122¹ provides that

(a) **CONFIDENTIALITY**-- Except as provided in subsection (b), applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of an Act of Congress or in such special circumstances as may be determined by the Director.

(b) **Publication**--

(1) **IN GENERAL**-- (A) Subject to paragraph (2), each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title. At the request of the applicant, an application may be published earlier than the end of such 18-month period.

(B) No information concerning published patent applications shall be made available to the public except as the Director determines.

(C) Notwithstanding any other provision of law, a determination by the Director to release or not to release information concerning a published patent application shall be final and nonreviewable.

¹ See 35 U.S.C. § 122 (Supp. V 1999).

(2) EXCEPTIONS-- (A) An application shall not be published if that application is--

- (i) no longer pending;
- (ii) subject to a secrecy order under section 181 of this title;
- (iii) a provisional application filed under section 111(b) of this title; or
- (iv) an application for a design patent filed under chapter 16 of this title.

(B)(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) An applicant may rescind a request made under clause (i) at any time.

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(iv) If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

(v) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign filed applications corresponding to an application filed in the Patent and Trademark Office or the description of the invention in such foreign filed applications is less extensive than the application or description of the invention in the application filed in the Patent and Trademark Office, the applicant may submit a redacted copy of the application filed in the Patent and Trademark Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. The Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title. The provisions of section 154(d) shall not apply to a claim if the description of the invention published in the redacted application filed under this clause with respect to the claim does not enable a person skilled in the art to make and use the subject matter of the claim.

(c) **PROTEST AND PRE-ISSUANCE OPPOSITION**-- The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

(d) **NATIONAL SECURITY**-- No application for patent shall be published under subsection (b)(1) if the publication or disclosure of such invention would be detrimental to the national security. The Director shall establish appropriate procedures to ensure that such applications are promptly identified and the secrecy of such inventions is maintained in accordance with chapter 17 of this title.

37 CFR 1.183² provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.215³ provides that

(a) The publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The date of publication shall be indicated on the patent application publication. The patent application publication will be based upon the application papers deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application, and any application papers or drawings submitted in reply to a preexamination notice requiring a title and abstract in compliance with § 1.72, application papers in compliance with § 1.52, drawings in compliance with § 1.84, or a sequence listing in compliance with §§ 1.821 through 1.825, except as otherwise provided in this section. The patent application publication will not include any amendments, including preliminary amendments, unless applicant supplies a copy of the application containing the amendment pursuant to paragraph (c) of this section.

(b) If applicant wants the patent application publication to include assignee information, the applicant must include the assignee information on the application transmittal sheet or the application data sheet (§ 1.76). Assignee information may not be included on the patent application publication unless this information is

See 37 CFR 1.183 (2001).

³ See 37 CFR 1.215 (2001).

provided on the application transmittal sheet or application data sheet included with the application on filing. Providing this information on the application transmittal sheet or the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or declaration) as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

(d) If the copy of the application submitted pursuant to paragraph (c) of this section does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in paragraph (a) of this section. If, however, the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.

37 CFR 1.217⁴ provides that:

(a) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the Office, the applicant may submit a redacted copy of the application filed in the Office for publication, eliminating any part or description of the invention that is not also contained in any of the corresponding applications filed in a foreign country. The Office will publish the application as provided in § 1.215(a) unless the applicant files a redacted copy of the application in compliance with this section within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code.

(b) The redacted copy of the application must be submitted in compliance with the Office electronic filing system requirements. The title of the invention in the redacted copy of the application must correspond to the title of the application at the time the redacted copy of the application is submitted to the Office. If the redacted copy of the application does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in § 1.215(a).

See 37 CFR 1.217 (2001).

(c) The applicant must also concurrently submit in paper (§ 1.52(a)) to be filed in the application:

- (1) A certified copy of each foreign-filed application that corresponds to the application for which a redacted copy is submitted;
- (2) A translation of each such foreign-filed application that is in a language other than English, and a statement that the translation is accurate;
- (3) A marked-up copy of the application showing the redactions in brackets; and
- (4) A certification that the redacted copy of the application eliminates only the part or description of the invention that is not contained in any application filed in a foreign country, directly or through a multilateral international agreement, that corresponds to the application filed in the Office.

(d) The Office will provide a copy of the complete file wrapper and contents of an application for which a redacted copy was submitted under this section to any person upon written request pursuant to § 1.14(c)(2), unless applicant complies with the requirements of paragraphs (d)(1), (d)(2), and (d)(3) of this section.

(1) Applicant must accompany the submission required by paragraph (c) of this section with the following:

- (i) A copy of any Office correspondence previously received by applicant including any desired redactions, and a second copy of all Office correspondence previously received by applicant showing the redacted material in brackets; and
- (ii) A copy of each submission previously filed by the applicant including any desired redactions, and a second copy of each submission previously filed by the applicant showing the redacted material in brackets.

(2) In addition to providing the submission required by paragraphs (c) and (d)(1) of this section, applicant must:

(i) Within one month of the date of mailing of any correspondence from the Office, file a copy of such Office correspondence including any desired redactions, and a second copy of such Office correspondence showing the redacted material in brackets; and

(ii) With each submission by the applicant, include a copy of such submission including any desired redactions, and a second copy of such submission showing the redacted material in brackets.

(3) Each submission under paragraph (d)(1) or (d)(2) of this paragraph must also be accompanied by the processing fee set forth in § 1.17(i) and a certification that the redactions are limited to the elimination of material that is relevant only to the part or description of the invention that was not contained in the redacted copy of the application submitted for publication.

(e) The provisions of § 1.8 do not apply to the time periods set forth in this section.

DECISION

Petitioners request waiver of the requirement in 37 CFR 1.217(a) that a redacted copy of an application be filed within sixteen months after the earliest filing date for which a benefit is sought under title 35, and that the USPTO publish only the redacted copy of the above-identified application under 37 CFR 1.217. Petitioners argue, *inter alia*, that: (1) the sixteen-month filing period requirement in 37 CFR 1.217(a) is not a requirement of statute, in that the USPTO must publish only a redacted version if a redacted copy of the application is filed by that date, but may publish a redacted version in other circumstances provided that the other conditions of 35 U.S.C. § 122(b)(2)(B)(v) are met; (2) filing a redacted copy of the application within the sixteen-month period set forth in 37 CFR 1.217(a) was an impossibility in the above-identified application, as the above-identified application was not filed until more than sixteen months after the earliest claimed priority date; and (3) the assignee of the above-identified application is particularly sensitive to the disclosure of proprietary technology and desires to maintain it in confidentiality for as long as possible.

The American Inventors Protection Act of 1999 (AIPA) was enacted into law on November 29, 1999. See Pub. L. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999). The AIPA contained a number of changes to title 35, including provisions for the publication of pending applications for patent, with certain exceptions, promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35 (“eighteen-month publication”). The eighteen-month publication provisions of the AIPA became effective on November 29, 2000, and apply to all applications filed on or after November 29, 2000. See Pub. L. 106-113, 113 Stat. at 1501A-566 through 1501A-567. The USPTO implemented the eighteen-month publication provisions of the AIPA in a final rule published in September of 2000. See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office 63 (Oct. 10, 2000) (final rule). The USPTO indicated in that final rule that the sixteen-month period in 37 CFR 1.217(a) is provided by statute (specifically, 35 U.S.C. § 122(b)(2)(B)(v)), and as such, requests for waiver of this sixteen-month period will be denied. See id. at 57036, 1239 Off. Gaz. Pat. Office at 74.

While the language of 35 U.S.C. § 122(b)(2)(B)(v) (“[t]he Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title”) taken in isolation may suggest that the USPTO has discretion to publish either a redacted or a complete copy of the application if a redacted copy of the application is filed later than sixteen months after the earliest filing date for which a benefit is claimed under title 35, such a reading of 35 U.S.C. § 122(b)(2)(B)(v) is inconsistent with the statutory scheme and legislative history of 35 U.S.C. § 122(b).

35 U.S.C. § 122(b)(1)(A) provides that, subject to 35 U.S.C. § 122(b)(2), “each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under [title 35].” See 35 U.S.C. § 122(b)(1)(A). That is, the USPTO is to publish each application after eighteen months from the earliest filing date for which a benefit is sought under title 35 in accordance with the USPTO’s procedures for the publication of applications unless the application falls within an exception provided in 35 U.S.C. § 122(b)(2).⁵

The above-identified application does not fall within any exception provided in 35 U.S.C. § 122(b)(2). The above-identified application is a pending nonprovisional utility application that is not subject to a secrecy order under 35 U.S.C. § 181 (or whose disclosure otherwise raises national security concerns). See 35 U.S.C. § 122(b)(2)(A). The application was not filed with a nonpublication request containing a certification that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires eighteen month publication of applications. See 35 U.S.C. § 122(b)(2)(B)(i)-(iv). Finally, while petitioners may have filed applications in a foreign country and under a multilateral international agreement with a cumulative description of the invention that is less extensive than the description of the invention in the above-identified application, petitioners did **not** submit a redacted copy of the application within sixteen months after the earliest effective filing date for which a benefit is sought under title 35. See 35 U.S.C. § 122(b)(2)(B)(v). Therefore, the above-identified application does not fall within an exception provided in 35 U.S.C. § 122(b)(2), and the USPTO is required to publish the application as provided in 35 U.S.C. § 122(b)(1).

⁵ The legislative history of the eighteen-month publication provisions of the AIPA demonstrates that the exceptions to publication provided in 35 U.S.C. § 122(b)(2) are not mere statements of minimum conduct, but mark the line of demarcation between: (1) the applications that the USPTO must maintain in confidentiality under 35 U.S.C. § 122(a) to the extent that publication is precluded or limited under 35 U.S.C. § 122(b)(2); and (2) the applications that the USPTO must publish as provided in 35 U.S.C. § 122(b)(1) if the exceptions to publication provided in 35 U.S.C. § 122(b)(2) are not applicable. See 145 Cong. Rec. S14,708, S14,718 (daily ed. Nov. 17, 1999) (section-by-section analysis of S. 1948 printed in the Congressional Record at the request of Senator Lott) (35 U.S.C. § 122(b)(2) enumerates exceptions to the general rule requiring publication). In addition, the legislative history of the eighteen-month publication provisions of the AIPA indicates that Congress did not envision the USPTO publishing only a redacted copy of an application based upon a redacted copy of the application filed outside of the sixteen-month period provided in 35 U.S.C. § 122(b)(2)(B)(v). See 145 Cong. Rec. at S14,719 (to ensure that any redacted copy of the application is published in place of the original U.S. application, the redacted copy must be received within sixteen months from the earliest effective filing date).

The procedures for publication of applications under 35 U.S.C. § 122(b) are set forth in 37 CFR 1.211 through 1.221. These procedures do not provide for the publication of only a redacted copy of an application in the situation in which the redacted copy of the application was not filed within sixteen months of the earliest claimed priority date. Therefore, granting petitioners' request to publish only a redacted copy of the above-identified application would constitute publication of the application under a procedure developed on an ad hoc basis. Such a publication of the above-identified application would not meet the statutory requirement that the above-identified application be published "in accordance with procedures determined by the Director" (*i.e.*, the procedures set forth in 37 CFR 1.211 through 1.221). See 35 U.S.C. § 122(b)(1)(A).

Accordingly, the USPTO maintains that waiving the requirement in 37 CFR 1.217(a) that a redacted copy of an application be filed within sixteen months after the earliest filing date for which a benefit is sought under title 35 would be inconsistent with the provisions of 35 U.S.C. § 122(b).

Assuming, *arguendo*, that the USPTO has the authority to waive the requirement in 37 CFR 1.217(a) that a redacted copy of an application be filed within sixteen months after the earliest filing date for which a benefit is sought under title 35, there is no showing as to why the circumstances at issue constitute an extraordinary situation in which justice requires the USPTO to waive this requirement of 37 CFR 1.217(a).

The AIPA required the USPTO to implement procedures and a process for the eighteen-month publication of each pending application (with certain exceptions) within one year of the date of enactment of the AIPA. Implementing the eighteen-month publication process was and continues to be the most resource consuming change required by the AIPA. The USPTO is now publishing approximately 2,000 applications each week, and the USPTO expects to be publishing between 4,000 and 5,000 applications each week once eighteen-month publication reaches a steady-state operation by the summer of 2002. Obviously, the USPTO's approach to eighteen-month publication must, by the nature of the task, be to publish each application (other than those exempt from publication) according to the established procedures. The USPTO cannot reasonably be expected to handle these publication volumes and still allow for the nature of how any particular application is to be published to be determined on an ad hoc basis.

The exceptions to eighteen-month publications specified in 35 U.S.C. § 122(b)(2)(B)(i)-(iv) (applications filed with a nonpublication request) and 122(b)(2)(B)(v) (applications for which a redacted copy is submitted for publication) add to challenges involved in the eighteen-month publication process. In particular, the provisions for the publication and subsequent handling of an application for which a redacted copy is submitted for publication place an inordinate burden on the USPTO. See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. at 57048, 1239 Off. Gaz. Pat. Office at 84-85. Therefore, the USPTO considers it inappropriate to publish a redacted copy of any application and subsequently treat the application

as provided in 37 CFR 1.217(d) unless the redacted copy is submitted in compliance with 37 CFR 1.217(a) and (b) within sixteen months after the earliest effective filing date.

Petitioners' argument that filing a redacted copy of the application within the sixteen-month period set forth in 37 CFR 1.217(a) was an impossibility, in the above-identified application as the above-identified application was not filed until more than sixteen months after the earliest claimed priority date, is not well taken.⁶ There is nothing in the patent statute or regulations that prevented petitioners from: (1) filing a first application containing only the subject matter cumulatively disclosed in the four priority applications and claims whose limitations are cumulatively disclosed in the four priority applications (claims corresponding to claims 19, 24, and 25) and claiming the benefit of the four priority applications in the first application; and (2) filing a second application also containing subject matter not cumulatively disclosed in the four priority applications and claims whose limitations are **not** cumulatively disclosed in the four priority applications (claims corresponding to claims 1 through 18, 20 through 23, and 26 through 57) and **not** claiming the benefit of any of the four priority applications in the second application,⁷ which would have allowed petitioners to file a redacted copy of the application for publication in compliance with 35 U.S.C. § 122(b)(2)(B)(v) and 37 CFR 1.217 within sixteen months of the filing date (or possibly even a nonpublication request under 35 U.S.C. 122(b)(2)(B)(i) and 37 CFR 1.213(a) on filing) in the second application. It was petitioners' decision to simply file a single application containing claims that may find support in the four priority applications as well as claims that find no support in the four priority applications, rather than any action or inaction by the USPTO, that has resulted in the situation in which petitioners are now unable to rely upon

⁶ Petitioners' arguments concerning what would have been published and when had petitioners chosen to simply enter the national stage in the international applications at the thirty-month time period set forth in 37 CFR 1.495(b) are immaterial. The above-identified application was filed on April 18, 2001, it claims the benefit of *inter alia*, an application filed on November 4, 1999, and it does not fall within any of the exceptions to eighteen-month publication set forth in 35 U.S.C. § 122(b)(2). Therefore, 35 U.S.C. § 122(b)(1) provides that the USPTO is to publish the above-identified application promptly after eighteen months from November 4, 1999 (as soon as practical as that period has already expired) in accordance with the USPTO's established eighteen-month publication procedures.

⁷ Since the marked-up copy of the application showing the redactions in brackets shows claims 1 through 18, 20 through 23, and 26 through 57 enclosed in brackets in their entirety, the four priority applications must not provide support for any limitation contained in these claims (much less every limitation contained in these claims). See Studiengesellschaft Kohle m.b.H. v. Shell Oil Co., 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997) (a claim is entitled to the benefit of an earlier-filed application only if the earlier-filed application contain a disclosure which provides support under 35 U.S.C. § 112, ¶ 1, for the claim).

the provisions of 35 U.S.C. § 122(b)(2)(B)(v) and 37 CFR 1.217 to avoid publication of the subject matter not also contained in any of the four priority applications.⁸

Finally, that the assignee of the above-identified application is particularly sensitive to the disclosure of proprietary technology and desires to maintain it in confidentiality for as long as possible is not an extraordinary situation in which justice requires a waiver of any requirement of the rules of practice. Many independent inventors and small entities are sensitive to the disclosure of proprietary technology and desire to maintain it in confidentiality until a patent is granted (*i.e.*, the situation at issue is the usual situation, not an extraordinary situation). See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. at 57045, 1239 Off. Gaz. Pat. Office at 82 (comment 45 and response). The exception provisions set forth in 35 U.S.C. § 122(b)(2)(B) represent the balance struck by Congress between the desires of independent inventors, small entities and others seeking patent protection to maintain their inventions in confidence until a patent is granted and the benefits to the public resulting from an earlier disclosure of the technology. See id. It is not the USPTO's place to upset this carefully drawn balance by expanding upon the provisions of 35 U.S.C. § 122(b)(2)(B)(v) on an ad hoc basis because an applicant considers him or herself to be particularly sensitive to the disclosure of proprietary technology.

CONCLUSION

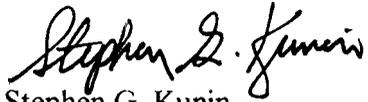
For the above-stated reasons, the petition under 37 CFR 1.183 to waive the requirement in 37 CFR 1.217(a) that a redacted copy of an application be filed within sixteen months after the earliest filing date for which a benefit is sought under title 35, and publish only a redacted copy of the above-identified application under 37 CFR 1.217 is **denied**. Therefore, the USPTO will publish the above-identified application in accordance with 37 CFR 1.215. See 37 CFR 1.217(a).

This decision may be viewed as final agency action. See MPEP 1002.02(b).

Telephone inquiries regarding this decision should be directed to Robert W. Bahr at (703) 305-8850.

⁸ In addition, a redacted copy of the above-identified application was not filed until September 18, 2001, five months after the filing date of the above-identified application. There is no justification for the further delay until September 18, 2001 in filing a redacted copy of the above-identified application.

The application file is being forwarded to the Office of Initial Patent Examination for further processing.

A handwritten signature in black ink, reading "Stephen G. Kunin". The signature is written in a cursive style with a large, stylized initial "S".

Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy

rwb