





have the right to use the government as a witness through the Disclosure Document Program without relying upon a third party for corroboration.

*Response:* The fact that the United States uses a first-to-invent standard in determining the right to a patent does not make the Disclosure Document Program necessary. The United States used a first-to-invent standard in determining the right to a patent prior to 1969 without the need for a Disclosure Document Program. In addition, the core mission of the Office is the granting and issuing of patents and the registration of trademarks, and the disseminating to the public information with respect to patents and trademarks. See 35 U.S.C. 2(a). There is no reason why it is necessary or germane to its core missions for the Office to act as witness for inventors through the Disclosure Document Program. Furthermore, to the extent that the Disclosure Document Program acts as an evidence depository for the purpose of establishing a conception date, a provisional application can be used in the same fashion if necessary.

*Comment 6:* One comment argued that the Office assertions that “few, if any, inventors obtain any actual benefit from a disclosure document, and some inventors who use the Disclosure Document Program believe that they are actually filing an application for a patent” are not supported by verifiable evidence, such as opinion surveys. One comment argued that because of the long duration between submitting a disclosure document and obtaining a benefit from it, it is difficult to measure actual benefit. Another comment argued that it is unfair to judge the “conversion rate” of disclosure documents into provisional applications as an indicator of actual benefit.

*Response:* The Office issued over three million patents since 1976, and of these three million patents only 1,330 (0.04%) reference a disclosure document. Between fiscal years 2002 and 2005, the Office issued over 700,000 patents. While 86,087 disclosure documents were filed with the Office between fiscal years 2002 and 2005, of the over 700,000 patents issued between fiscal years 2002 and 2005, only 223 (0.03%) reference a disclosure document. That is, while the Office receives a large number of disclosure documents, there are relatively few instances in which a disclosure document is referenced in a subsequent patent. Thus, the Office maintains that few, if any, inventors obtain any actual benefit from a disclosure document (*i.e.*, through the filing of a subsequent patent application). The Office has received

sufficient feedback through its independent inventor outreach programs and from other Government agencies (*e.g.*, the Federal Trade Commission) to conclude that some inventors who use the Disclosure Document Program believe that they are actually filing an application for a patent. The Office has also been sued by an inventor who was under the impression that a disclosure document was a patent application. See *Akbar v. Dickinson*, Civil Action No. 99-1286 HHK (D.D.C. 1999) (Office motion to dismiss granted).

*Comment 7:* Several comments argued a disclosure document filing permits an independent inventor to tell potential investors the invention is “registered” with the Office, and encourages potential investors to sign non-disclosure agreements. One comment argued the Disclosure Document Program gives an “actual benefit” to inventors by easing fears that someone will steal their invention.

*Response:* The Document Disclosure Program was not and is not intended to be a vehicle for obtaining “registrations” from the Office. The Office does not “register” materials submitted in a disclosure document. There are commercial invention registries available that might be able to serve the registration functions desired by inventors. An inventor can ease fears that someone will steal his or her invention by taking other steps, such as the filing of a provisional application, or through the use of a commercial invention registry.

*Comment 8:* One comment cited a disclosure document as being instrumental in the receipt of his patent.

*Response:* A disclosure document may be relied upon as evidence of conception of invention in support of an affidavit or declaration under § 1.131. See MPEP 1706. A disclosure document, however, is only one of the types of evidence that may be relied upon as evidence of conception of invention in support of an affidavit or declaration under § 1.131. See MPEP 715.07 (an affidavit or declaration under § 1.131 may be supported by, for example, attached sketches, attached blueprints, attached photographs, attached reproductions of notebook entries, an accompanying model, attached supporting statements by witnesses, testimony given in an interference, or a disclosure document). The overwhelming majority of affidavits or declarations under § 1.131 do not rely upon a disclosure document as evidence of conception of invention and are acceptable without a disclosure document. Thus, a disclosure document

is not necessary for an applicant to establish a prior date of invention in an affidavit or declaration under § 1.131.

A disclosure document may also be relied upon during an interference proceeding to provide corroboration for a conception of the invention. The actual use of a disclosure document during an interference proceeding occurs about once every decade. In contrast, between 86 (fiscal year 2004) and 287 (fiscal year 1997) interferences have been declared each year during the last ten fiscal years. This incidental use of disclosure documents during interference proceedings likewise does not justify continuation of the Disclosure Document Program.

*Comment 9:* Many comments argued that independent inventors do not generally keep a fully documented, updated, and witnessed inventor’s notebook and thus rely on the Disclosure Document Program. One comment argued that elimination of the Disclosure Document Program would lead to increased use of self-addressed stamped envelopes (SASE) and a decrease of intellectual property creators registering a copyright with the Library of Congress. One comment argued individual inventors can achieve stronger protections through the use of an inventor’s notebook, because of possibility of witnesses, a disclosure more thorough than that in the Disclosure Document Program, and the lack of an expiration date.

*Response:* There is no reason why inventors could not use a properly maintained inventor’s laboratory notebook as an alternative to the Disclosure Document Program. An inventor’s laboratory notebook requires no filing fee and has no expiration date.

*Comment 10:* One comment included a proposal to privatize and manage the Disclosure Document Program should the Office decide to eliminate the Disclosure Document Program.

*Response:* The Disclosure Document Program is not an inherently governmental function of the Office, and there are no statutory provisions relating to the Disclosure Document Program. Therefore, it is not necessary for any non-governmental entity that wishes to manage a “disclosure document” type program to obtain approval from the Office.

*Comment 11:* One comment stated the Disclosure Document Program should remain in effect, with filings re-named “Non-Patent Information Record” to record idea conception. One comment argued for the retention of the Disclosure Document Program, along with the creation of a new “independent

