

Sir:

I am a registered patent attorney, founder of Neifeld IP Law, PC, a law firm, and member of various bar associations. I respond herein below to your request for comments published at 77 FR 23662 (4/20/2012), titled " Notice of Request for Comments on the Feasibility of Placing Economically Significant Patents Under a Secrecy Order and the Need To Review Criteria Used in Determining Secrecy Orders Related to National Security"

Your notice contains series of questions to which I respond below.

1. Should the USPTO institute a plan to identify patent applications relating to critical technologies or technologies important to the United States economy to be placed under secrecy orders?

ANSWER: NO. Placing a patent application for an invention originating in the United States under a secrecy order would prevent its export until the secrecy order was lifted. Consequently, the applicant would not be entitled to file a copy of the application in any foreign country, and would not be entitled to comply with the Paris Convention to obtain the legal benefit of the filing date of the originally filed in-the-United-States patent application an any application filed in a foreign country. In most cases, the invention would become legally obvious before the secrecy order was lifted, and therefore in most cases the invention would no longer be patentable in most foreign countries. Accordingly, the imposition of the secrecy order would effectively preclude the application from obtaining rights to the invention anywhere outside the United States. Since that would allow anyone outside the United States to practice the invention disclosed in the patent application, it would weaken the economic benefit of the invention to the applicant. Accordingly, it would weaken the economic benefit of the invention to the United States. Moreover, the patent applicant is almost certainly in a better position to determine whether filing a patent application in foreign countries for their United States origin invention will be more economically effective than any United States government entity. This is because the patent applicant in the vast majority of applications will be more familiar with the scope, relative benefit, novelty, and potential economic benefit, and competitive landscape of the invention defined by the claims in the patent application, than any United States government entity could be.

2-13. These questions are moot in view of my response to question 1.

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