

Dear Sirs,

I am writing in relation to your request for comments on 'Economic Security-Based Secrecy Orders'.

I am active as a patent attorney representing Australian applicants, many of whom ultimately seek protection in the USPTO.

With the greatest respect, the general proposal under consideration here is inherently flawed. If the applicant seeks to have his invention not published at present, then the 35 U.S.C. 122(b)(2)(B)(i) procedure is available to them. No change is needed. They must, however, certify that (in effect) they are not intending to file outside the US.

The reason for this is simple. Every other country publishes all applications filed at 18 months from priority date. All PCT filings are so published. It would be pointless for the USPTO to not publish when the case is filed outside the US, as every other patent office would publish exactly the same material.

Hence, the applicant had a perfectly good secrecy-to-grant mechanism available to them for US only filed inventions.

One may postulate fairly that any invention of significant economic significance will require protection internationally. If it is significant, then the applicant will want protection in the countries where it is presumably feared that the invention may be reviewed, worked around, etc, etc. If the application is to be filed directly in those countries or via the PCT, then those countries and WIPO will publish the application. So there is no point preventing publication by the USPTO if international filings are required.

If the US government is going to prohibit publication and dissemination, using a similar mechanism to national security criteria, then no foreign filings will or can happen. Defence related material is generally held closely by all national governments, so this does not absolutely prevent protection in other countries. US firms do file secret patent applications in allied countries, including Australia and the UK. However, this relies on the military technology being secret, at least when filed in the allied countries.

However, if the developments are economically significant, then there is presumably a plan to exploit and sell products on the open market. This is publication, and unless a convention filing happens in the appropriate time one year period in each foreign country, there is no protection in those countries. Unless foreign filings are made within a year of US filing, no convention priority can be obtained in the foreign countries, and the invention may be considered to be abandoned to the public domain in those countries. Certainly, the US applicant will have a reduced ability, if any, to obtain patent protection

The net effect of the proposals is either nothing, for US only destined inventions, or where the applications are published internationally in any case; or to create a situation where American inventors are legally prevented from any protection at all being obtained internationally. I suggest that none of these outcomes are helpful to US industry, but may be welcomed by international imitators, as they create more issues and red tape, and only for American inventors.

I respectfully suggest that this proposal not be pursued.

Peter Franke
Principal

p: +61 2 8071 5300 f: +61 2 8008 1655 www.frankehyland.com.au

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