

**IN THE UNITED STATES
COURT OF FEDERAL CLAIMS**

EVIDEO OWNERS	:	
MAURO DIDOMENICO,	:	
DOUGLAS BUERGER,	:	
CRAIG LINDEN,	:	
REALVIRT LLC and	:	
PAUL BAROUS	:	
individually and on behalf of a class of	:	
all those similarly situated,	:	
	:	
Plaintiffs,	:	Case No. 15-413-LKG
v.	:	
	:	Judge Lydia Kay Griggsby
UNITED STATES OF AMERICA,	:	
	:	
Defendant.	:	

**FIRST AMENDED
CLASS ACTION COMPLAINT**

PLAINTIFFS eVideo Owners, Mauro DiDomenico, Douglas Buerger, Craig Linden, RealVirt LLC and Paul Barous, individually and on behalf of all those similarly situated, bring this action pursuant to 28 U.S.C. §§ 1491(a)(1) and (2) against DEFENDANT The United States of America, and alleges as follows:

NATURE OF ACTION

1. Plaintiffs eVideo Owners, are the current Assignee of the ownership rights in U.S. patent application serial nos. 09/840,868 and 13/333,840 (hereinafter, the "eVideo applications") filed at the United States Patent and Trademark Office (hereinafter the "USPTO") for examination toward issue as a U.S. patent.

2. The sole inventor in both eVideo applications is Dr. Mauro DiDomenico, Jr., the Applicant and the original Assignor of ownership rights in both eVideo Applications. Dr. DiDomenico has had a highly distinguished career in the telecommunications industry, including over twenty years at Bell Laboratories, AT&T and Bellcore (now Ericsson). He is an inventor in several U.S. patents and has published over 80 technical papers.

3. The earlier filed of the two eVideo applications (U.S. patent application serial no. 09/840,868) was filed on April 25, 2001. eVideo has been diligently pursuing a fair and final disposition to the eVideo applications for over 13 years, approximately 10 years longer than the average.

4. Plaintiff Douglas Buerger is the owner of U.S. patent application serial no. 13/602,835.

5. Plaintiff Craig Linden is the owner of U.S. patent application serial nos. 09/856,228, 10/469,800 and 12/172,993.

6. Plaintiff Realvirt, Limited Liability Corporation (LLC) is the owner of U.S. patent application serial nos. 07/773,161 and 13/368,316.

7. Plaintiff Paul Barous is the owner of U.S. patent application serial no.10/397,778.

8. Currently, the average period of time a U.S. patent application is pending before the USPTO in the patent examination process before final disposition (*i.e.*, either an allowance by the USPTO toward issue as a patent, or abandonment of the application based on an applicant's decision that further prosecution is not advisable or desirable) is about 3 years and one month. Each of the Plaintiffs has been diligently pursuing a fair and final disposition to their respective patent applications far longer than the average.

9. In or about early December 2014, news reports began to emerge in the media from unofficial sources that the USPTO had a confidential program involving a secret examination process involving a purely internal review of some pending U.S. patent applications. The USPTO program or policy was known as the "Sensitive Application Warning System" (hereinafter the "S.A.W.S." program). The S.A.W.S. program does not appear to have been based on any U.S. statute. Furthermore, it does not appear to have been reflected in any USPTO published rules for its operation. Still further, there is no record, to Plaintiff's knowledge, that any patent applicant was ever officially notified by the USPTO when or if their patent application(s) had been placed in the S.A.W.S. program or was ever given information or advised on how to overcome the S.A.W.S. program designation.

10. The news reports described the S.A.W.S. program as involving, at the least, a written notice which was circulated internally at the USPTO regarding how an application might meet one or more of the S.A.W.S. program eligibility criteria. The news reports also described that, after an application had been designated or associated with the S.A.W.S. program, it required a plurality of approvals by multiple USPTO supervisors (by some accounts, several supervisors at different levels of USPTO management) before a S.A.W.S. designated patent application was permitted to reach a final disposition as an allowance.

11. The news reports suggested that a substantial number of U.S. patent applications had been significantly delayed from reaching a final disposition in the examination process due to being designated for review under the S.A.W.S. program. Since no U.S. patent applicant was ever officially notified whether their application had been designated as being in the S.A.W.S. program, and because the USPTO has statutory time limitations requiring it to take some action

in an application once the patent examination process has become active, it is not clear what action the USPTO may have taken in those applications that had been flagged by a S.A.W.S. designation and were not allowed because of the S.A.W.S. designation, but were otherwise in condition for allowance to issue as a U.S. patent despite the S.A.W.S. designation.

12. On or about March 2, 2015, the USPTO publicly announced that the S.A.W.S. program had been discontinued, recently and abruptly, but did not explain the circumstances for the unilateral action other than that the USPTO no longer deemed the program to be necessary. The public announcement acknowledged the S.A.W.S program had been active since 1994, but provided no details as to the extent of the program or about any specific patent applications which had been designated as having been in the S.A.W.S. program.

13. Several requests under the Freedom of Information Act (hereinafter "FOIA") for information regarding the S.A.W.S. program have been submitted to the Defendant by different parties at different times, both before and after the March 2, 2015 public announcement. Under the limited disclosures that have been obtained through the FOIA requests, it was revealed that the S.A.W.S. program included dozens of different types of SAWS-eligibility criteria, that the program had been widely implemented throughout the USPTO and that it applied to almost every aspect of the patent examination process for utility patent applications, including patent reexaminations, patent reissues and appealed applications which had been sent forward for review to the appellate board at the USPTO.

14. Plaintiffs have several reasons for believing the eVideo applications were designated or affected by the S.A.W.S. program. First, the subject matter of the eVideo applications matches several S.A.W.S. eligibility criteria recently made public through

Defendant's responses to F.O.I.A. requests. Other bases include the contentious and extended nature of the examination process associated with the two eVideo applications.

15. Given the above reasons, Plaintiffs have a good faith belief that the eVideo applications were designated under the S.A.W.S. program at the USPTO; that the eVideo applications have or had been delayed in reaching a final disposition in the examination process based on their being so designated; and that Plaintiffs have been harmed financially in terms of paying official fees under 37 C.F.R. § 1.17 and attorney fees for the prosecution of the eVideo applications as a result of the eVideo application having been designated or associated with the S.A.W.S. program.

JURISDICTION AND VENUE

16. Pursuant to 28 U.S.C. §§ 1491 (a) (1) and (2), this Court has jurisdiction and is the proper venue for Plaintiffs' claims for money damages and accompanying relief against the United States founded upon the Constitution, 35 U.S.C. § 132 (a), 37 C.F.R. § 1.104 (a) (2) and 37 C.F.R. § 1.17.

PARTIES

17. Plaintiffs eVideo Owners, are the members of an association of U.S. citizens who are the current owners of the ownership rights in the eVideo applications, forming an unincorporated entity doing business in the United States as "eVideo", with an address at 25070 Bay Cedar Drive, Bonita Springs, Florida 34134. Plaintiffs eVideo Owners are the successors to eVideo Inc., a dissolved Delaware corporation, and an earlier Assignee of the eVideo

applications. Subsequently, eVideo, Inc. transferred its ownership rights in the eVideo applications to Plaintiffs eVideo Owners.

18. Plaintiff Mauro DiDomenico, Jr. is a United States citizen residing at 25070 Bay Cedar Drive, Bonita Springs, Florida 34134, the Applicant and original Assignor of the eVideo applications, and one of the owners of Plaintiff eVideo.

19. Plaintiff Douglas Buerger is a US citizen residing at 3657 South Sunset Drive, Milwaukee, Wisconsin 53220, the applicant and the owner of U.S. patent application serial no. 13/602, 835.

20. Plaintiff Craig Linden is a US citizen residing at 1335 Midway Drive, Alpine, California 91901, the applicant and the owner of U.S. patent application serial nos. 09/856,228, 10/469,800 and 12/172,993.

21. Plaintiff Realvirt, Limited Liability Corporation (LLC) is a corporation existing under the laws of the State of Massachusetts with a business address at P.O.Box 779, Sherborn, Massachusetts 01770, the applicant and the owner of U.S. patent application serial nos. 07/773,161 and 13/368,316.

22. Plaintiff Paul Barous is a US citizen residing at 98 Central Street, Andover, Massachusetts 01810, the applicant and the owner of U.S. patent application serial no. 10/397,778.

23. Defendant, the United States of America, is the proper party to be sued under 28 U.S.C. § 1491(a)(1).

CLASS ACTION ALLEGATIONS

24. Plaintiffs bring this action on behalf of themselves and as a class action under the provisions of Rule 23(a) and (b) of the Rules of the United States Court of Federal Claims on behalf of all the members of the following class:

All Applicants and/or their Assignees of a United States utility patent application who, at any time, had one more of their patent application(s) designated under or associated with the SAWS program or similar "Watch List Application" program while the application(s) were pending before the USPTO and, having been so designated, the Applicants and/or Assignees paid the USPTO an official fee under 37 C.F.R. § 1.17 and/or paid a reasonable attorney fee in the prosecution of their application(s) after the application(s) were designated under or associated with the SAWS program or a similar "Application Watch List" program while not having been officially informed by the USPTO of the SAWS and/or Watch List Program designation and/or not being advised or given information by the USPTO how to overcome the SAWS and/or Watch List Program designation.

25. Plaintiffs do not know the exact number of Class members because such information is in the exclusive control of the Defendant. Upon information and belief, based on limited public information available through responses to F.O.I.A. requests, Plaintiffs believe that there are more than one hundred Class members as described above, the exact number and their identities being known by the Defendant.

26. The Class is so numerous and geographically dispersed that joinder of all the members is impracticable.

27. There are questions of law and fact common to the Class including:

- i. Whether the Defendant implemented and administered, during the Class Period, a S.A. W .S. program or policy that, in an official examination of a S.A.W.S.-designated patent application, any claim for a patent was rejected, or an objection or requirement was made without notifying the applicant and/or their assignee of the S.A. W.S. designation, and providing the reasons for the S.A.W.S. designation together with such information about the S.A.W.S. designation as might have been useful in judging the propriety of continuing the prosecution of the application;

- ii. Whether the S.A. W .S. program or policy unconstitutionally burdens and penalized Plaintiffs' and the Class's fundamental rights and protected liberty interests, in violation of the Fifth Amendment's guarantee of substantive due process;
- iii. Whether the conduct of the Defendant, as alleged in this Complaint, caused injury to Plaintiff and the other members of the Class; and
- iv. The appropriate class-wide measure of damages.

28. Upon information and belief, Plaintiffs are a member of the Class. The fact is known to, and in the sole control of, the Defendant.

29. Plaintiffs' claims are typical of the claims of the Class members, and Plaintiffs will fairly and adequately protect the interests of the Class. Plaintiffs' interests are coincident with, and not antagonistic to, those of the other members of the Class.

30. Plaintiff is represented by counsel that is competent and experienced in the prosecution of constitutional claims and class-action litigation.

31. Through its S.A.W.S. program or policy, and/or similar "Application Watch List" programs, as implemented by the USPTO, Defendant has acted or refused to act on grounds generally applicable to the Class.

32. The questions of law and fact common to the members of the Class predominate over any questions affecting only individual members, including legal and factual issues relating to liability and damages.

33. A class action is superior to other available methods for the fair and efficient adjudication of this controversy. The Class is readily definable and is one for which records should exist. Prosecution as a class action will eliminate the possibility of repetitious litigation. Treatment as a class action will permit a large number of similarly situated persons and parties to

adjudicate their common claims in a single forum simultaneously, efficiently, and without the duplication of effort and expense that numerous individual actions would engender. This class action presents no difficulties in management that would preclude maintenance as a class action.

FACTUAL BACKGROUND

Facts Related to Plaintiffs eVideo Owners and Mauro DiDomenico

34. The eVideo applications include claims involving systems and methods for providing video on demand. The systems and methods involve, *inter alia*, the Internet, computers operated by a user, a video decoding device of a user and a payment from a user for video content.

35. In the October 9, 2014, response to FOIA Request No. F-15-00004, it was revealed that the SAWS-eligibility criteria for Technology Center 2400 at the USPTO included applications involving: business methods or E-commerce systems. As a specific example of such business methods or E-commerce systems, the SAWS-eligibility criteria for Technology Center 2400 names "video or music distribution over network or phone" as a model example of this specific SAWS-eligibility criterion. Other SAWS-eligibility criteria for Technology Center 2400 at the USPTO listed in the response include "[d]igital, internet or wireless versions of prior art devices", "applications dealing with automating a known manual process", and "convergence inventions." Thus the eVideo applications meet several of the SAWS-eligibility criteria for Technology Center 2400 at the USPTO. Furthermore, in the portion of the response to the FOIA Request relating to Technology Center 2400, the Examiners were instructed to construe the SAWS-eligibility criteria broadly and states: "Examiners should use their judgement and are

encouraged to be *liberal* in their identification as to whether or not an application contains potential SAWS material."

36. The earlier-filed eVideo application (serial no. 09/840,868 filed on April 25, 2001) was delayed by a series of contentious rejections by the Examiner assigned to the case. This occurred despite the granting of a petition for expedited prosecution due to the age of the inventor. The contentious rejections include a premature final rejection issuing May 9, 2003 which was acknowledged as premature and later withdrawn, a non-final rejection issuing on June 30, 2003 which was acknowledged as improper and later withdrawn after an appeal brief had been filed, a final rejection issuing on May 10, 2004 which was acknowledged as improper and later withdrawn after another appeal brief had been filed, and a final rejection issuing on June 3, 2009 based allegedly on Res Judicata. The June 3, 2009 final rejection was the basis for an appeal in which the Examiner was reversed by the appellate board in a decision dated October 21, 2011, for making an improper rejection based on Res Judicata.

37. The second eVideo application (serial no. 13/333,840 filed on December 21, 2011), had been filed, at least in part, as an alternate approach to overcoming the Examiner's improper Res Judicata rejection in the earlier-filed eVideo application. Despite the appellate board decision of October 21, 2011 in the earlier-filed eVideo application, in which the Examiner was reversed for making an improper Res Judicata rejection, in a first action Final rejection issuing January 2, 2013, the Examiner rejected the claims in the second eVideo application, allegedly based on the same Res Judicata issue. After further interactions, the Examiner issued a final rejection on November 6, 2014 which is now under appeal at the USPTO.

38. Throughout the prosecution of the first and second eVideo applications, extending back to April 25, 2001, Plaintiffs have paid all fees due under 37 C.F.R. § 1.17, according to the USPTO official fee schedule.

39. Any date in which one or both of the eVideo applications were first designated under or associated with the S.A.W.S. program is known by the Defendant.

40. None of the official communications issuing from the USPTO, throughout the prosecution of the first and second eVideo applications, have provided any notice when or if either the first or second eVideo applications were designated under or associated with the S.A.W.S. program.

41. Any of the official communications in the eVideo applications issuing from the USPTO, after the date in which either eVideo application was first designated under the S.A.W.S. program, therefore, fail to comply with 35 U.S.C. § 132 (a) and 37 C.F.R. § 1.104 (a) (2) because they failed to provide any notice to Plaintiffs of the S.A.W.S. designation or information as to how to overcome the designation.

42. Official fees under 37 C.F.R. § 1.17 and the reasonable attorney fees for the prosecution of the eVideo applications paid by Plaintiffs after the date in which the eVideo applications were first designated under S.A.W.S. are damages to Plaintiffs because they were denied notice of the S.A.W.S. designation as the USPTO is mandated to give notice, under 35 U.S.C. § 132 (a) and 37 C.F.R. § 1.104 (a) (2), prior to paying such fees.

Facts Related to Plaintiff Douglas Buerger

43. Plaintiff Douglas Buerger is the sole inventor and owner of U.S. patent

application serial no. 13/602,835 (hereinafter “the Buerger Application”). The Buerger Application relates to methods and devices utilized in certain energy conversion processes.

44. From the prosecution history of the Buerger Application, in an Office Action dated January 24, 2013, at pages 4-5, it was alleged, incorrectly, that the Buerger ‘835 Application involved “...a **perpetual motion machine of the first kind...**” (**emphasis** in the original) and it was further alleged, incorrectly, “[i]t thus violates the first law of conservation of energy.”

45. In the October 9, 2014, response to FOIA Request No. F-15-00004, Plaintiff Exhibit 1, it was revealed that the SAWS-eligibility criteria for Technology Center 2800 included applications involving: alleged perpetual motion machines, other matters that allegedly violate the general laws of physics, applications which allegedly might generate unfavorable publicity for the U.S. PTO, and applications allegedly having claims that were broad, domineering and/or pioneering scope. Furthermore, the Technology Center 2800 Memorandum, from the response to FOIA Request No. F-15-00004, PX 1, instructs the Examiners that the list of SAWS designation criteria is non-exhaustive. For example, the Memorandum states [t]he initial identification by the Examiner is intended to cast a broad net for applications of interest...” and “[f]or applications (allegedly) claiming highly controversial subject matter. The SAWS report should be prepared prior to first office action.”

46. For at least the reasons given above, Plaintiffs have a good faith belief that the Buerger Application was designated under the SAWS program at the U.S. PTO; that the Buerger Application was delayed in reaching a final disposition in the examination process based on being so designated; and that Plaintiff Douglas Buerger has been harmed financially as a result

of the Buerger Application having been designated or associated with the SAWS program.

47. Upon information and belief, Plaintiff Douglas Buerger is a member of the Class. The fact is known to, and in the sole control of, the Defendant.

Facts Related to Plaintiff Craig Linden

48. Plaintiff Craig Linden is the sole inventor and owner of U.S. patent application serial nos. 09/856,228, 10/469,800 and 12/172,993 (hereinafter “the Linden Applications”). The Linden Applications relate to automated methods, including business methods, involving the internet and mobile devices.

49. In the October 9, 2014, response to FOIA Request No. F-15-00004, PX 1, it was revealed that the SAWS-eligibility criteria for Technology Center 2400 included: applications involving business methods or e-commerce systems that would allegedly have a significant impact on an industry, applications involving personal data assistants, applications involving digital, internet or wireless versions of prior art devices, applications involving automation of a known manual process, and applications allegedly having claims that were broad in scope. Furthermore, the Technology Center 2400 Memorandum, from the response to FOIA Request No. F-15-00004, PX 1, instructs the Examiners that the list of SAWS designation criteria is non-exhaustive. For example, the Technology Center 2400 Memorandum states [t]he initial identification by the Examiner is intended to cast a broad net for applications of interest...” and “[f]or applications (allegedly) claiming highly controversial subject matter. The SAWS report should be prepared prior to first office action.”

50. For at least the reasons given above, Plaintiffs have a good faith belief that one or

more of the Linden Applications were designated under the SAWS program at the U.S. PTO; that one or more of the Linden Applications were delayed in reaching a final disposition in the examination process based on being so designated; and that Plaintiff Craig Linden has been harmed financially as a result of one or more of the Linden Applications having been designated or associated with the SAWS program.

51. Upon information and belief, Plaintiff Craig Linden is a member of the Class. The fact is known to, and in the sole control of, the Defendant.

Facts Related to Plaintiff Realvirt, LLC

52. Plaintiff Realvirt, LLC is the owner by assignment of U.S. patent application serial nos. 07/773,161 and 13/368,316 (hereinafter “the Realvirt Applications”). The Realvirt Applications both have an effective filing date of October 8, 1991, based on the filing of U.S. patent application serial no. 07/773,161. In addition, the present ownership and the control of patent prosecution in the Realvirt Applications were established through a third-party takeover by Realvirt, LLC, which had been challenged and later accepted by the U.S. PTO. The Realvirt Applications relate to early developments in computer networking. The networking methods and systems claimed include software features that were rejected by the U.S. PTO Examiner, and reversed by the U.S. Patent Trial and Appeal Board, as allegedly directed to an abstract judicial exception to patent eligible subject matter under 35 U.S.C. § 101.

53. In the October 9, 2014, response to FOIA Request No. F-15-00004, PX 1, it was revealed that the SAWS-eligibility criteria for Technology Center 1700 included: applications involving claims to computer programs or algorithms which have been rejected under 35 U.S.C.

§ 101, applications that were the subject of a third-party takeover of the patent prosecution, and applications with pendency greater than five years. It was also revealed that that the SAWS-eligibility criteria for Technology Center 2800 included: applications allegedly having claims that were broad, domineering and/or pioneering scope. Furthermore, the Technology Center 2800 Memorandum, from the response to FOIA Request No. F-15-00004, PX 1, instructs the Examiners that the list of SAWS designation criteria is non-exhaustive. For example, the Memorandum states [t]he initial identification by the Examiner is intended to cast a broad net for applications of interest...” and “[f]or applications (allegedly) claiming highly controversial subject matter. The SAWS report should be prepared prior to first office action.”

54. For at least the reasons given above, Plaintiffs have a good faith belief that one or more of the Realvirt Applications were designated under the SAWS program at the U.S. PTO; that one or more of the Realvirt Applications were delayed in reaching a final disposition in the examination process based on being so designated; and that Plaintiff Realvirt LLC has been harmed financially as a result of one or more of the Realvirt Applications having been designated or associated with the SAWS program.

55. Upon information and belief, Plaintiff Realvirt LLC is a member of the Class. The fact is known to, and in the sole control of, the Defendant.

Facts Related to Plaintiff Paul Barous

56. Plaintiff Paul Barous is the owner of U.S. patent application serial no. 10/397,778 (hereinafter “the Barous Application”). The Barous Application relates to automated e-commerce systems and methods, including business methods, involving the internet. The

Barous Application has a filing date of March 25, 2003.

57. In the October 9, 2014, response to FOIA Request No. F-15-00004, PX 1, it was revealed that the SAWS-eligibility criteria for Technology Center 1700 included: applications with pendency greater than five years. It was also revealed that that the SAWS-eligibility criteria for Technology Center 2800 included: applications allegedly having claims that were broad, domineering and/or pioneering scope. Furthermore, it was revealed that the SAWSeligibility criteria for Technology Center 2400 included: applications involving business methods or e-commerce systems that would allegedly have a significant impact on an industry, applications involving digital, internet or wireless versions of prior art devices, applications involving automation of a known manual process, and applications allegedly having claims that were broad in scope. Furthermore, the Technology Center 2400 Memorandum, from the response to FOIA Request No. F-15-00004, PX 1, instructs the Examiners that the list of SAWS designation criteria is non-exhaustive. For example, the Technology Center 2400 Memorandum states [t]he initial identification by the Examiner is intended to cast a broad net for applications of interest..." and "[f]or applications (allegedly) claiming highly controversial subject matter. The SAWS report should be prepared prior to first office action."

58. For at least the reasons given above, Plaintiffs have a good faith belief that the Barous Application was designated under the SAWS program at the U.S. PTO; that the Barous Application was delayed in reaching a final disposition in the examination process based on being so designated; and that Plaintiff Paul Barous has been harmed financially as a result of the Barous Application having been designated or associated with the SAWS program.

59. Upon information and belief, Plaintiff Paul Barous is a member of the Class. The

fact is known to, and in the sole control of, the Defendant.

FACTS COMMON TO THE CLASS

60. In order to provide for an equitable return on services provided in the examination of U.S. patent applications, Congress has approved an annually-updated schedule of fees under 37 C.F.R. § 1.17 chargeable to U.S. patent applicants for various services during the patent examination process at the USPTO.

61. 35 U.S.C. § 132 (a) mandates that whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify an applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging the propriety of continuing the prosecution of the application. Furthermore, 37 C.F.R. § 1.104 (a) (2) mandates that an applicant will be notified of the examiner's action and that the reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given to the applicant as may be useful in aiding the applicant to judge the propriety of continuing the prosecution.

62. In the government's October 9, 2014 response to F.O.I.A. Request No. F-15-0004, it was revealed that there was a general list of S.A.W.S. eligibility criteria which applied across all the different Technology Center's at the USPTO, of which there are nine at present. Furthermore, there are different lists of criteria which are specific to the Technology Centers. The criteria listed in the different lists are often vague, over-inclusive and often lacking any statutory basis. Some examples from the general list include: (1) applications dealing with inventions, which, if issued, would potentially generate unwanted media coverage, (2)

applications with claims of broad or domineering scope, and (3) Applications with claims of pioneering scope. Some examples from the lists specific to respective USPTO Technology Centers (TCs) include: TC 1600: "Personalized medicine" as well as "synthetic or wholly engineered bacterial or viral genomes"; TC 1700: "Nanotechnology without specific disclosure as to method of manufacture"; TC 2400: "Convergence inventions"; TC 2600: "Smartphones" and "Internet-enabled systems"; and TC 3600 "Processes and apparatuses involving education".

63. Under the S.A.W.S. program, the applicants having an application designated under S.A.W.S. were not notified of that designation. Nor were those applicants provided information or advised how to overcome the S.A.W.S. designation. Thus those applicants were not notified, in accordance with 35 U.S.C. § 132 (a), stating the reasons for a rejection, or objection or requirement associated with the S.A.W.S. designation, together with such information as may be useful in judging of the propriety of continuing the prosecution of the application based on the S.A.W.S.-designation. Further, the official communications to those applicants failed to include, as mandated by 37 C.F.R. § 1.104 (a) (2), such information as might have been useful in aiding the applicant to judge the propriety of continuing the prosecution of the application.

64. Official fees under 37 C.F.R. § 1.17 and any reasonable attorney fees for the prosecution of an application paid, by any Plaintiff for examination, or continuance of examination, of a U.S. patent application, after a date in which the application was first designated under S.A.W.S. are damages as the Plaintiff was denied notice under 35 U.S.C. § 132 (a) and 37 C.F.R. § 1.104 (a) (2) prior to paying such fees.

65. In the Affidavit of former U.S. PTO Director John Doll, Plaintiff Exhibit 2, it

was revealed that the SAWS Program is one of many “Watch List Application” and/or “Second-Pair-of-Eyes” programs which have been implemented at the U.S. PTO, PX 2, Fact Nos. 28-30.

66. The U.S. PTO Examiners were instructed not to inform the patent applicant(s) if their patent applications are subject to the SAWS Program, PX 2, Fact No. 32.

67. The SAWS program was administered through committees that often directed the U.S. PTO Examiners to issue new grounds of rejection rather than allow an application designated in the SAWS program, PX 2, Fact No. 40.

COUNT I
SUBSTANTIVE DUE PROCESS

68. Plaintiffs incorporate by reference all preceding allegations as if fully set forth herein.

69. 35 U.S.C. § 132 (a) is a notice-mandating statute and 37 C.F.R. § 1.104 (a) (2) is a notice-mandating regulation entitling Plaintiffs and the Class to reasonable information as might be useful in responding to a rejection, or objection or requirement based on a S.A.W.S. designation or in aiding the applicant to judge the propriety of continuing the prosecution of such a patent application.

70. The S.A.W.S. program has burdened and penalized patent applicants' fundamental rights and protected interests in receiving an equitable return on the fees they have paid under 37 C.F.R. § 1.17 by denying these applicants reasonable information as might be useful to them in the prosecution of their patent applications and to judge the propriety of continuing the prosecution of such patent applications designated under S.A.W.S.

71. The S.A.W.S. program did not further the government's interest in issuing valid U.S. patents, or any other legitimate state interest, as these interests were already served through the proper application of the relevant statutes under Title 35 of the U.S. Code relating to patent examinations at the USPTO.

72. The S.A.W.S. program, considering the expansive S.A.W.S. designation criteria, was not narrowly tailored to serve a compelling governmental interest and was not necessary to significantly further an important governmental interest; indeed, it was not rationally related to any legitimate governmental interest whatsoever.

73. The S.A.W.S. program unconstitutionally burdened and penalized the affected U.S. patent applicants' fundamental rights and protected interests, in violation of the Fifth Amendment's guarantee of substantive due process.

74. Once the unconstitutional portions of the S.A.W.S. program have been severed from the overall scheme, the implied contract under 35 U.S.C. § 132 (a), 37 C.F.R. § 1.104 (a) (2) and 37 C.F.R. § 1.17 entitle Plaintiffs and the Class to a monetary award of a return of their official fees and reasonable attorney fees paid after the applications had been designated under or associated with the S.A.W.S. program.

**REQUEST FOR CLASS CERTIFICATION WITH
REQUEST TO HOLD IN ABEYANCE BRIEFING ON CLASS CERTIFICATION**

75. Plaintiffs hereby request class certification in accordance with Court of Federal Claims Rule 23 and respectfully request that the Court hold in abeyance briefing on class certification until after the parties have conducted discovery.

LAW ON CLASS-ACTION TOLLING

76. 28 U.S.C. § 2501 provides that "[e]very claim of which the United States Court of Federal Claims has jurisdiction shall be barred unless the petition thereon is filed within six years after such claim first accrues."

77. Plaintiff is not aware if or when any claims of any of the Class members might have, by any means, first accrued. However, in the event any claims of any Class members have already begun to accrue, Plaintiff seeks to preserve the rights of these Class members by seeking class-action tolling via this Complaint.

78. In *Bright v. United States*, 603 F. 3d 1273, (Fed. Cir. 2010), the Federal Circuit held that the six-year time limit in 28 U.S.C. § 2501 is subject to "class-action tolling" for potential class members. Under *Bright*, when "a class action complaint is filed within the six-year limitations period of 28 U.S.C. § 2501 as to one named plaintiff, putative class members are permitted to opt in under RCFC 23 after expiration of the limitations period, when class certification is sought prior to expiration of the period." *Id.* at 1290. *Bright* did not address whether class-action tolling would apply for potential class members if a motion for class certification were filed after the class member's statutes of limitations had expired. See *id.* at 1290, n.9.

79. In *Toscano v. United States*, 98 Fed. Cl. 152, (Fed. Cl. 2011), the Court of Federal Claims held that when a complaint requesting class certification is timely filed, but a motion for class certification is not filed until after the limitations period under 28 U.S.C. § 2501 has run, the complaint tolls the statute if the complaint: (1) specifically requests certification of the proposed class, (2) the complaint alerts the government of the type of claim

brought, (3) the complaint identifies the specific act giving rise to the claim, (4) the complaint specifies the matter at issue with respect to each class member, and (5) the complaint requests certification of a class consisting of the class members. *id.* at 154.

80. Plaintiffs contend that this Complaint meets all the requirements under *Toscano* and that class-action tolling should apply from the date this Complaint is filed to preserve the claims of any potential class member whose claim may have first accrued prior to the filing of this Complaint.

REASONS WHY THE REQUEST SHOULD BE GRANTED

81. Plaintiffs respectfully request class certification at this time and request that briefing on the certification request be held in abeyance in order to ensure that potential class members are protected by class-action tolling in accordance with *Bright* and *Toscano*. The proposed class in this case satisfies the requirements for bringing a class action pursuant to RCFC 23. Before a class can be certified, however, Plaintiffs anticipate that the parties will have to engage in discovery concerning, *inter alia*, the identification of potential class members, the establishment and administration of the S.A.W.S. program, the impact of the S.A.W.S. program on potential class members, and the injury suffered by the potential class. Such information is exclusively within the custody and control of the government.

82. Although discovery has not yet taken place, Plaintiffs are concerned that any additional delay in filing a separate motion for class certification at a later time could prejudice the rights of the potential class members whose six-year statutes of limitations could expire before discovery is completed. Plaintiffs accordingly request class certification at this time and

respectfully requests that the Court defer consideration of the certification request until class-action discovery has taken place. By granting Plaintiffs request to hold the certification request in abeyance, the Court would ensure that potential class members would, at a minimum, retain the ability to opt in to the class if their claims accrued on or after six years before the date of this filing, in accordance with *Bright* and *Toscano*. The Court will thus retain the ability to manage the case in the most efficient way possible while still protecting the rights of potential class members whose statutes of limitations might otherwise expire.

CONCLUSION

83. For these reasons, Plaintiffs hereby request class certification in accordance with RCFC 23 and respectfully request that the Court hold in abeyance briefing on class certification until after the parties have conducted discovery. In the alternative, Plaintiffs request a status conference in order to discuss alternative measures that could be taken to protect the claims of potential class members.

PRAYER FOR RELIEF

WHEREFORE: Plaintiffs and the Class respectfully pray for the following relief:

- A. A monetary award of a return to Plaintiffs and the Class of fees paid, under 37 C.F.R. § 1.17, and any reasonable attorney fees paid in the prosecution of their applications after the applications were designated under or associated with the S.A.W.S. program;
- B. That Plaintiffs and the Class be awarded pre-judgment and post-judgment interest

at the highest legal rate from and after the date of service of this Complaint to the extent provided by law;

- C. Reasonable costs, expenses, and attorneys' fees pursuant to 28 U.S.C. § 2412 and;
- D. Any further relief that the Court deems just and proper.

Dated: June 17, 2015

Respectfully submitted,

/s/ Joseph J. Zito

Joseph J. Zito

Attorney of Record

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Attorneys for Plaintiff



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

October 9, 2014

VIA U.S. MAIL

Ms. Kate Gaudry
5503 Charlcoate Road
Bethesda, MD 20817

Re: *Freedom of Information Act (FOIA) Request No. F-15-00004*

Dear Ms. Gaudry:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated October 2, 2014, in which you posed the following questions, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

- 1) What are the currently identified potential SAWS subject matters (e.g., subject matters of special interest for each technology center and coprs-wide potential SAWS subject matter); and
- 2) For applications determined to contain SAWS material, what is the protocol for review of the application? For example, who is involved in searching for prior art, identifying whether a rejection is to be made, determining whether an application is to be allowed, and/or reviewing a draft Act (e.g., Office Action or Notice of Allocance).

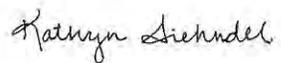
Please be aware that the FOIA is a means by which members of the public can obtain Agency records in existence at the time of the request. It cannot provide answers to questions or create new records in order to respond to FOIA requests. See Hudgins v. Internal Revenue Serv., 620 F. Supp. 19, 21 (D.D.C. 1985).

However, the USPTO has identified forty-three (43) pages of records that it believes are responsive to your request. A copy of this material is enclosed.

Your request is considered complete with full disclosure. However, you have the right to appeal this initial determination to the General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 30 calendar days from the date of this letter. See 37 C.F.R. § 102.10(a). The appeal must be in writing. You must include a copy of your original request, this letter, and a statement of the reasons why this response is deficient. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal."

The cost of this request was less than \$20.00 and is therefore waived. See 37 C.F.R. § 102.11(d)(4).

Sincerely,

A handwritten signature in cursive script that reads "Kathryn Siehndel".

Kathryn Siehndel
USPTO FOIA Officer
Office of General Law

Enclosure

Sensitive Application Warning System (SAWS) Project Charter
SAWS Strategic Planning Committee

ADC/PM on project: <i>(may not be same as committee structure)</i>	
Project lead: <i>Director's name</i>	John LeGuyader
Team members: <i>All involved</i>	Kathleen Bragdon (1600), Peter Paras (1600), Patrick Ryan (1700), Jill Warden (1700), Vincent Trans (2100), Rehana Perveen (2100), Emmanuel Moise (2400), Tod Swann (2400), Daniel Swerdlow (2600), Hien Phan (2800), Diane Lee (2800), Terry Melius (3600), Robert Weinhardt (3600), Thomas Hughes (3700), Janet Baxter (3700), Greg Vidovich (3700), Henry Yuen (3700), Caron Veynar (2900), Gregory Morse (CRU)
Purpose: <i>Reason for project (background)</i>	The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter.
Project scope: <i>Overall team objective</i>	This program applies to all pending patent applications that disclose potential SAWS subject matter identified by the TCs as being sensitive in nature, including Reexams, Reissues and applications being forwarded to the BPAI.
Cost/benefit: <i>Potential loss/gain; strategic initiative impacts?</i>	
Project goals/deliverables: <i>High-level goals/deliverables</i>	
Project timeline: <i>Due dates for major milestones (detailed timeline should be prepared separately)</i>	On-going program with biannual updates in the TCs.
Project resources: <i>Monetary and human resources</i>	
Evaluation factors: <i>Projected measurements for success</i>	
Project priority: <i>High – immed deliverables Mod – important, but no immed deliv Low – ongoing, as possible</i>	Low
Links to other projects: <i>Overlaps with other proj/comm.</i>	None
Stakeholders: <i>All impacted parties</i>	

Technology Center 1600 Sensitive Application Warning System (SAWS)

UPDATED: January 2013

PURPOSE:

The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memo reminds Technology Center 1600 of the on-going SAWS program. The following overview presents our current procedure. **Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.**

OPERATIONAL OVERVIEW:

This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexams, Reissues and applications being forwarded to the BPA1.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner and home SPE in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgment and are encouraged to be *liberal* (erring to identify rather than not) in their identification as to whether or not an application contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims, title and cover figure or drawing. **Upon agreement that an application could be considered as a SAWS application, the SAWS POC is alerted as early in prosecution as possible.** The alert should be a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

With this alert, the application is entered into a SAWS database and flagged by the SAWS POC. If during prosecution, the sensitive nature of the application has changed (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC can be notified to remove the application from the SAWS database and unflag.

Prosecution of SAWS applications should proceed just as with any other application (i.e., where necessary - review by primary, conference with SPE, and/or consult with QAS). Unless the nature of the subject matter is particularly sensitive, the SAWS POC and/or the SAWS QAS need *not* be particularly consulted about the prosecution of the application. When completed, the Office action should be approved for counting in eRF as usual.

Due to the flagging procedure, allowances on SAWS applications are not mailed directly by an LIE (the flag only prevents allowances from being mailed-all other actions are mailed). After the allowance is counted, the Team Leader will return the allowance to the SAWS POC and send an accompanying email alerting the posting. Allowances remain counted but not mailed (and not scanned into eDan) until a SAWS report has been completed and considered by appropriate areas of the PTO. If an allowance of a SAWS application is

mistakenly mailed prior to the SAWS report, the SAWS POC should be notified immediately.

Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS POC as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint.

The SAWS report completed by the home SPE is then considered by the SAWS POC who amends the report, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Often this amending process requires input from the home SPE; your timeliness in responding to SAWS requests for information is greatly appreciated. Further, the SAWS POC consults the SAWS QAS in this process.

The SAWS report is then considered by the Director before it is forwarded to various areas of the PTO for consideration/comment. Any questions/concerns about the sensitive subject matter and/or the prosecution of the application are addressed prior to mailing the allowance.

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares report when necessary
3. SAWS POC and SAWS QAS reviews SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

1. **Examiner Identification of Potential SAWS Applications.** In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see attached). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be liberal in their identification as to whether or not an application contains potential SAWS material. This initial identification by the Examiner is intended to cast a broad net for applications of interest.

2. **Home SPE Review and SAWS Report Preparation.** The home SPE should discuss the sensitive nature of the application with the Examiner. The SPE should use their judgment and be liberal in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS QAS.

Upon agreement that the application should be reported as SAWS, the home SPE must complete the SAWS report in the detail required by the attached template. The Impact Statement can be prepared by performing an Internet search to find external information indicating the sensitivity of the subject matter. One way to do this is via a Google search of the invention, the inventors, and owner or assignee. Such information may include, but is not limited to,

financially important subject matter (Is the stock of the invention's owner publicly traded? Have there been press releases about the invention?), politically charged subject matter, and subject matter which may raise legal or ethical objections.

As noted above, the home SPE typically prepares the SAWS report at the time of allowance. Exceptions to this rule are as follows:

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexams meeting the listed SAWS criteria, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexams in the TC because most of these are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS Appeal Specialist and/or the Interference Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time of the Examiner's answer or interference papers (PTO-850, claims and count).

3. **SAWS POC and SAWS QAS Review.** Once submitted, the SAWS report will be reviewed by the SAWS POC and the SAWS QAS and amended, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Note that in some instances, it may be necessary to review the actual application file. However, the intent is to minimize any direct impact on the examination process. The SAWS report is then forwarded to the TC Directors for subsequent action.

4. **Director Review and Forwarding.** The TC Directors review the SAWS report. Any further questions concerning the subject matter and/or prosecution are addressed. The Directors make the final decision on forwarding the SAWS report to other areas of the PTO. In the event that a SAWS report is not forwarded, the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would be addressed via the SAWS POC and/or SAWS QAS.

Technology Center 1600 Specific Potential SAWS Subject Matter (May 2012):

1. Applications disclosing seemingly frivolous or silly or controversial subject matter – paying special attention to the title, abstract and cover drawing.

2. Subject matter currently generating extensive media coverage:
 - AIDS/HIV vaccines and/or methods of prevention

 - Human fetal cell or fetal tissue based inventions, including use of fetal cells to treat humans
 - Human gametes
 - Germ-line gene therapy
 - Human embryonic stem (ES) cells and methods of making and using the same (this does not include all stem cells, just ES cells)
 - Induced pluripotent technology

 - Claims either specifically directed to or encompassing Human Beings, including:
 - Human Beings,
 - Human embryos,
 - Human/animal chimeras,
 - Methods of making or cloning human beings or human embryos,
 - Methods of *in utero* genetic manipulation of humans,
 - Methods of genetically altering humans via *in vitro* fertilization (IVF) or other methodologies (gene therapy),
 - Methods using or manipulating human embryos or fetuses

 - Human parthenogenesis (asexual female reproduction)

 - *In vitro* fertilization (IVF)

 - Methods or compositions for prolonging life or preventing aging

 - Cells/cell lines from indigenous peoples

 - Native plant, plant extract or plant/animal products; indigenous therapies, traditional medicine using native plants
 - Plant terminator technology
 - Tobacco plant genetically engineered for increased nicotine production

 - Synthetic or wholly engineered bacterial or viral genomes

 - Diagnosis, screening, or treatments limited by race or ethnicity, in particular exclusion of races (e.g. personalized medicine)

- Treatments to enhance intelligence
 - Products and/or methods of using controlled substances (Schedule I and II drugs), such as cocaine, PCP, LSD, barbiturates, amphetamines, opiates and their derivatives
3. Applications having claims defining inventions which could endanger individuals, the environment, harm the security of our nation or threaten public safety.
- Processes or products useful as biological weapons; detection or treatment of same (see attached chart from the Centers for Disease control outlining biological agents involved in biowarfare and bioterrorism).

Biological agents involved in bioterrorism or biocrimes

From "Emerging Infectious Diseases", Centers for Disease Control, Volume 13, Number 12–December 2007

Pathogens: *Ascaris suum*, *Bacillus anthracis*, *Coxiella burnetii*, *Francisella tularensis*, *Giardia lamblia*, HIV, *Rickettsia prowazekii*, typhus, *Salmonella typhimurium*, *Salmonella typhi*, *Shigella* species, *Schistosoma* species, Smallpox, *Vibrio cholerae*, Viral encephalitides, Viral hemorrhagic fevers (Ebola), Yellow fever virus, *Yersinia enterocolitica*, *Yersinia pestis*

Toxins: Botulinum, Cholera endotoxin, Diphtheria toxin, Ricin, Snake toxin, Staphylococcal enterotoxin B, Tetrodotoxin

Anti-crop Agents: Rice blast, Rye stem rust, Wheat stem rust

3. Applications claiming the prevention or curing of diseases which were previously considered impossible to prevent or cure, such as these non-limiting examples:
- Alzheimer's disease
 - common cold
 - dementia
 - mental retardation
 - HIV infection

Technology Center 1700 Sensitive Application Warning System (SAWS)

PURPOSE:

The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memo reminds Technology Center 1700 of the on-going SAWS program. The following overview presents our current procedure.

Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.

OPERATIONAL OVERVIEW:

This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexams, Reissues and applications being forwarded to the BPAI.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner and home SPE in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgement and are encouraged to be *liberal* (erring to identify rather than not) in their identification as to whether or not an applications contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title. Upon agreement that an application could be considered as a SAWS application, the SAWS POC is alerted as early in prosecution as possible. The alert should be a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
 2. Home SPE considers sensitivity and prepares report, when necessary
 3. SAWS POCs (Patrick Ryan, Jill Warden) and SAWS QAS (Greg Mills) reviews SAWS report from the home SPE
 4. Director level review and forwarding to areas of PTO
1. **Examiner Identification of Potential SAWS Applications.** In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see attached). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be *liberal* in their identification as to whether or not an application contains potential SAWS material. This

Current 01/31/2013

**Technology Center 1700
Sensitive Application Warning System (SAWS)**

initial identification by the Examiner is intended to cast a broad net for applications of interest.

2. **Home SPE Review and SAWS Report Preparation and**
3. **SAWS POC and SAWS QAS Review.**

The home SPE should discuss the sensitive nature of the application with the Examiner. The SPE should use their judgment and be liberal in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS QAS. Any application containing subject matter on the TC-1700 SAWS list should be discussed by the home SPE and one of the SAWS POCs, Patrick Ryan or Jill Warden, as soon as it is identified. The alert can include a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

If it is determined that the application contains sensitive subject matter, it will be placed in the TC SAWS grouping which will prevent a Notice of Allowance in the application from being mailed and the home SPE will complete a SAWS report in the detail required by the attached template.

As a general rule, the home SPE typically prepares the SAWS report no later than the time of allowance. For some cases, sooner is better.

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexams meeting the listed SAWS criteria, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexams in the TC because most of these are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS Appeal Specialist and/or the Interference Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time of the Examiner's answer or interference papers (PTO-850, claims and count).

Prosecution of SAWS applications should proceed just as with any other application (i.e., where necessary - review by primary, conference with SPE, and/or consult with QAS). Unless the nature of the subject matter is particularly sensitive, the SAWS POC need *not* be particularly consulted about the prosecution of the application.

Technology Center 1700
Sensitive Application Warning System (SAWS)

If during prosecution, the sensitive nature of the application changes (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC can be notified to remove the application from the SAWS grouping.

It would be a best practice if the examiner, upon determination that the application is in condition for allowance, schedule a meeting with the home SPE and the SAWS POC, or, in their absence, the SAWS QAS to discuss any remaining SAWS issues.

Once submitted, the SAWS report will be reviewed by the SAWS POC and the SAWS QAS and amended, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. The SAWS report is then forwarded to the TC Directors for any subsequent action.

4. Director Review and Forwarding. The TC Directors review the SAWS report. Any further questions concerning the subject matter and/or prosecution are addressed. The Directors make the final decision on forwarding the SAWS report to other areas of the PTO. In the event that a SAWS report is not forwarded, the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would be addressed via the SAWS POC and/or SAWS QAS.

**SENSITIVE APPLICATION WARNING SYSTEM (SAWS) TOPICS
TC 1700**

- ❖ Applications which would potentially generate unwanted media coverage (i.e., news, blogs, forums).
- ❖ Applications with pioneering scope
- ❖ Applications claiming inventions which seem trivial, mundane, frivolous. Silly or extremely basic, such as crimped peanut butter and jelly sandwiches, methods of swinging on a swing in a tree, etc. On these, – pay special attention to the **title, abstract and cover drawing**.
- ❖ Room temperature superconductors
- ❖ Health or medicine related patent applications subject to extensive media coverage, such as:
 - Panacea cure for a disease or condition not known to be curable, such as AIDS, cancer, baldness, "mad cow" disease, etc.
 - Human cloning or chimeras
 - Stem Cell or Germ line gene therapy
 - Method or Machines to take human life (suicide)
 - Claiming prevention or curing of diseases which were previously considered impossible to prevent or cure
- ❖ Motor, Power plant, or other device which is self-sustaining (perpetual motion) or appears to violate the laws of chemistry or physics
- ❖ Cold Fusion, "hydrino" reaction, or "magnecule" as an energy source or any other production of excess heat outside of known chemistry or physics
- ❖ Anti-Global Warming devices or any other device operating at the global scale
- ❖ Inventions which would endanger individuals, the environment, harm the security of our nation or threaten public safety.
- ❖ Applications with claims to computer programs or algorithms which have been rejected under 35 USC 101. Claims with computer programs or algorithms should be reviewed by TC SAWS POC or SAWS QAS before the first Office Action
- ❖ Controversial, Illegal, objectionable, or derogatory subject matter. Examples include marijuana cigarettes and pornography
- ❖ Compound claims only by functional characteristics - no structure claimed
- ❖ Third Party takeover of patent prosecution (not owner, not assignee, not inventor) usually unnamed, uncooperative inventor
- ❖ Applications related to patents presently being litigated
- ❖ Business Method claims
- ❖ Nanotechnology without specific disclosure as to appropriate method of manufacture
- ❖ Applications with long pendencies or multiple continuations going back 5 or more years (Submarine type applications)

SENSITIVE APPLICATION WARNING SYSTEM (SAWS) TOPICS
TC 1700

- ❖ Applications specifying race in the claims
- ❖ Applications identified as containing claims which would be subject to a 101 rejection in view of the Mayo v. Prometheus Decision
- ❖ Reexamination and Reissue cases in which:
 - Litigation involves the Supreme Court,
 - Litigation where the judgment on a patent was either favorable or unfavorable and a high dollar amount was award to either party, or
 - Technology/Companies that are recognized by the public or have been reported in the media or there is a high probability that the media would report on it in the future based on any action taken by the PTO.
 - Commissioner-ordered reexams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501.

Technology Center 2100
Sensitive Applications Warning System
(SAWS)

Introduction:

This memo is intended to remind the Technology Center 2100 of the existence of the SAWS program and to transmit information relating to potentially sensitive applications to appropriate contacts within the Office. The following overview presents our current procedure. **This memo should be forwarded to all staff.**

An application is considered a SAWS application when it contains or references subject matter that may have the potential to be controversial, offensive to certain populations, subject to ridicule or attracts unusual media attention.

The SAWS program applies to all pending applications, including re-examination proceedings and applications being forwarded to the BPAI.

The purpose of this program is to track the progress of potentially sensitive applications docketed in the TC and to keep TC Directors informed, through the appropriate chain-of-command, when a potentially sensitive application is ready for allowance. The TC 2100 SAWS Panel consists of the following WQASes: Brian L. Johnson, Vincent Trans, Eddie Lee, Mano Padmanabhan, and Gail Hayes. All TC 2100 SPEs and Examiners should be aware of our SAWS program and assist in the identification of potentially sensitive applications.

OVERVIEW:

The SAWS program is based upon a tiered process of application identification. This approach utilizes the Examiner, the SPE, and the WQAS. The program is designed to allow for the earliest possible time of identification of an application as "SAWS" and includes the ability to flag applications both during prosecution and at the time of indication of allowable subject matter.

The SAWS identification process is continual in nature. All applications within the Technology Center are reviewed under the following process:

1. Examiner/SPE application identification
2. WQAS review/screening of application information forwarded from the examiner/SPE
3. TC Director level review and forwarding

1. Examiner/SPE application identification

In order to provide the broadest recognition of applications of interest, the Examiners and SPEs have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see below). **This list is non-exhaustive.** Examiners and SPEs are encouraged to be **liberal** in their determination as to whether or not an application might contain SAWS material. This initial determination by the Examiner/SPE is intended to cast a broad net for cases of interest.

Having identified a potential SAWS application, the examiner should consult with their SPE either by Email or in person. The SPE should review the information and makes a determination as to whether or not the application should be forwarded to the WQAS. The SPE may add impact statements as appropriate. The SPE is instructed to be **liberal** in application identification, but to screen out applications that are clearly of a routine nature.

If an application is to be reported as SAWS, the following information should be included in an email report that should be forwarded to the WQAS.

Serial Number	Prosecution Status
Actual Filing Date	Title
Effective Filing Date	Inventor(s)
Assignee	Key Words
Primary Examiner	Assistant Examiner
SPE	Sample Claim
Short summary of technology	
Technical impact statement (optional)	
Political impact statement (optional)	

2. WQAS review/screening

Once submitted to the WQAS, the report will be reviewed. If the report is found to identify a SAWS application, the application identified as SAWS application will be flagged and placed in a PALM Expo personal grouping such as **SAWS 2100** to review the first action and any ultimate Notice of Allowance. The result of identifying SAWS application will be communicated to the home SPE and Examiner. Note that in some instances, it may be necessary to review the actual application file. However, the intent is to minimize any direct impact on the examination process.

A **final review** to determine whether the application is "SAWS" will occur **at allowance**, and if it is determined that it is still "SAWS," the report (or an amended version of it) will be forwarded to the TC Directors.

3. TC Director Level Review and Forwarding

The TC Directors will review the SAWS report and any further questions concerning the subject matter and/or prosecution will be addressed. The Directors will decide on whether or not to forward the SAWS report to the Office of the Commissioner for Patents (particularly the Assistant Commissioner for Patent and the Assistant Commissioner for Patent Examination Policy). In the event that the TC Directors do not forward the SAWS report, the related information is saved for future use. If forwarded, any further questions concerning the subject matter and/or prosecution will be addressed by the SAWS POC, WQAS, and/or home SPE.

Technology Center 2100 Specific Subject Matter

- 1) **(Automating a Known Process)** Applications dealing with automating a known manual process;
- 2) **(Litigation)** Non Reexam/Reissue applications containing references to litigations;
- 3) **(Industry Forming/influencing)** Applications with pioneering scope;
- 4) **(High Court Decisions)** Applications having a CAFC or higher court decision in them;
- 5) **(Homeland Security Specials)** Applications having been made special containing subject matter dealing with homeland security being examined more than 12 months earlier than it would have been;
- 6) **(Advocacy Group Prosecution)** Applications in which a third party (usually unnamed) takes over prosecution of the patent application (not owner, assignee/licensee or inventor); and
- 7) **(Affidavits)** Applications containing broad claims and relying on affidavits of commercial success to overcome an otherwise proper §103 rejection.
- 8) **(Patent/Trademark Processes or Systems)** Applications reciting a process that PTO employees or IP attorneys practice, or a system the PTO or IP attorneys use.
- 9) Applications claiming inventions including explicit recitations of race, ethnicity, origin, or other prescribed populations etc. [newly added]

Technology Center 2400 Sensitive Application Warning System (SAWS)

UPDATED: EOY 2011
Redistributed: May 2012

TC 2400 SAWS POC: Emmanuel L Moise
TC 2400 SAWS WQASs: Chris Grant, Chau Nguyen, Beatriz Prieto, and Tod Swann

PURPOSE:

The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memo reminds Technology Center 2400 of the on-going SAWS program. The following overview presents our current procedure. **Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.**

OPERATIONAL OVERVIEW:

This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexams, Reissues and applications being forwarded to the BPAL.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner and home SPE in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgment and are encouraged to be *liberal* (erring to identify rather than not) in their identification as to whether or not an applications contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title. Upon agreement that an application could be considered as a SAWS application, the SAWS POC and respective WQAS are alerted as early in prosecution as possible. The alert should be a short email to the SAWS POC and respective WQAS that you are considering an application as potentially SAWS, including a short explanation of why.

With this alert, the application is entered into a SAWS database and flagged by the respective WQAS. If during prosecution, the sensitive nature of the application has changed (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC and respective WQAS can be notified to remove the application from the SAWS database and unflag.

Prosecution of SAWS applications should proceed just as with any other application (i.e., where necessary - review by primary, conference with SPE, and/or consult with respective WQAS). Unless the nature of the subject matter is particularly sensitive, the SAWS POC and respective WQAS need *not* be particularly consulted about the prosecution of the application. When completed, the Office action should be approved for counting in eRF as usual.

Due to the flagging procedure, allowances remain counted but not mailed (and not scanned into eDAN) until a SAWS report and review have been completed and considered by appropriate areas of the PTO. If an allowance of a SAWS application is mistakenly mailed prior to the SAWS report, the SAWS POC and respective WQAS should be notified *immediately*.

Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS POC and respective WQAS as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint.

The SAWS report completed by the home SPE is then considered by the SAWS POC and respective WQAS who amend the report, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Often this amending process requires input from the home SPE; your timeliness in responding to SAWS requests for information is greatly appreciated.

If the SAWS review and report indicate that the SAWS report should be forwarded to various areas of the PTO for consideration/comment, the TC director is involved. Any questions/concerns about the sensitive subject matter and/or the prosecution of the application are addressed prior to mailing the allowance.

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares report when necessary
3. SAWS POC and SAWS QAS review SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

1. **Examiner Identification of Potential SAWS Applications.** In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see attached). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be liberal in their identification as to whether or not an application contains potential SAWS material. This initial identification by the Examiner is intended to cast a broad net for applications of interest.

2. **Home SPE Review and SAWS Report Preparation.** The home SPE should discuss the sensitive nature of the application with the Examiner. The SPE should use their judgment and be liberal in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS WQAS.

Upon agreement that the application should be reported as SAWS, the home SPE must complete the SAWS report in the detail required by the attached template. The Impact Statement can be prepared by performing an Internet search to find external information indicating the sensitivity of the subject matter. One way to do this is via a Google search of the invention, the inventors, and owner or assignee. Such information may include, but is not limited to, financially important subject matter (Is the stock of the invention's owner publicly traded? Have there been press releases about the invention?), politically charged subject matter, and subject matter which may raise legal or ethical objections.

As noted above, the home SPE typically prepares the SAWS report at the time of allowance. Exceptions to this rule are as follows:

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexams meeting the listed SAWS criteria, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexams in the TC because most of these are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS Appeal Specialist and/or the Interference Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time of the Examiner's answer or interference papers (PTO-850, claims and count).

3. **SAWS POC and SAWS QAS Review.** Once submitted, the SAWS report and application file will be reviewed by the SAWS POC and SAWS QAS and amended, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. If the SAWS review and report indicate that the SAWS report should be forwarded to various areas of the PTO for consideration/comment, the TC director is involved.

4. **Director Review and Forwarding.** The TC Directors review the SAWS report and application file. Any further questions concerning the subject matter and/or prosecution are addressed. The Directors make the final decision on forwarding the SAWS report to other areas of the PTO. In the event that a SAWS report is not forwarded, the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would be addressed via the SAWS POC and/or SAWS QAS.

Technology Center 2400 Specific Subject Matter:

1. Applications reciting business methods (Business Methods) or E-commerce systems that would significantly impact the industry (e.g., video or music distribution over network or phone);
2. Applications reciting processes the PTO employees or IP attorneys practice, or a system the PTO or IP attorneys use;
3. Applications or related applications involved in litigation;
4. Applications dealing with personal digital assistants (PDAs);
5. Convergence inventions: combinations of previously distinct devices or functions in a single device (e.g., smart phones, phones with media players);
6. Digital, internet or wireless versions of prior art devices (e.g., fax over internet telephony, wireless sub-woofers);
7. Applications having been made special containing subject matter dealing with homeland security being examined more than 12 months earlier than ordinary (Homeland Security Specials);
8. Applications dealing with automating a known manual process (Automating a known Process); and
9. Applications containing broad claims and relying on affidavits of commercial success to overcome an otherwise proper (Affidavits).

Technology Center 2600
Special Applications Warning System (SAWS)

2012 MIDYEAR REMINDER

Introduction:

This memo is intended to remind the Technology Center of the on-going SAWS program and to transmit information relating to potentially sensitive applications to appropriate contacts within the Office. The following overview presents our current procedure. This memo should be forwarded to all staff. This program applies to all pending applications, including Reexams and applications being forwarded to the BPAL.

Purpose:

The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memo reminds Technology Center 2600 of the on-going SAWS program. The following overview presents our current procedure. Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.

Operational Overview:

This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexams, Reissues and applications being forwarded to the BPAL.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner, the home SPE and the SAWS Panel (Daniel Swerdlow, Wellington Chin, Mike Horabik, John Peng, Doris To and Ken Wieder) in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgment and are encouraged to be liberal (erring to identify rather than not) in their identification as to whether an application contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title. Upon agreement that an application could be considered as a SAWS application, the SAWS POC, currently Dan Swerdlow for TC 2600, is alerted as early in prosecution as possible. The alert should be a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

Applications identified and verified as containing SAWS material are reported to the Group Directors for transmittal to the Office of the Deputy Commissioner. The program is designed to allow for the earliest possible time of identification of an application as "SAWS" and includes the ability to flag applications both during prosecution and at the time of indication of allowable subject matter.

The SAWS identification process is continual in nature and 100% of applications within the Technology Center are reviewed under the following process guidelines:

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares report when necessary
3. SAWS POC and SAWS QAS reviews SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

1. **Examiner Identification of Potential SAWS Applications.** In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see attached). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be liberal in their identification as to whether or not an application contains potential SAWS material. This initial identification by the Examiner is intended to cast a broad net for applications of interest. Suggestions for updating the list should be communicated to the SAWS coordinator.

2. **Home SPE Review and SAWS Report Preparation.** The home SPE should discuss the sensitive nature of the application with the Examiner. SPEs should use their judgment and be liberal in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS QAS.

Upon agreement that the application should be reported as SAWS, the home SPE must complete the SAWS report in the detail required by the attached template. The Impact Statement can be prepared by performing an Internet search to find external information indicating the sensitivity of the subject matter. One way to do this is via a Google search of the invention, the inventors, and owner or assignee. Such information may include, but is not limited to, financially important subject matter (Is the stock of the invention's owner publicly traded? Have there been press releases about the invention?), politically charged subject matter, and subject matter which may raise legal or ethical objections.

As noted above, the home SPE typically prepares the SAWS report at the time of allowance. Exceptions to this rule are as follows:

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexams meeting the listed SAWS criteria, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexams in the TC because most of these are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS Appeal Specialist and/or the Interference Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications

identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time of the Examiner's answer or interference papers (PTO-850, claims and count).

If a case is to be reported as SAWS, the following information should be included in an email report that should be forwarded to the SAWS Panel via Daniel Swerdlow, TQAS (Doris To, backup).

- Serial Number
- Prosecution Status
- Actual Filing Date
- Title
- Effective Filing Date
- Inventor(s)
- Assignee
- Key Words
- Primary Examiner
- Assistant Examiner
- SPE
- Sample Claim
- Short summary of technology
- Technical impact statement (optional)
- Political impact statement (optional)

3. Secondary review

Once submitted to the SAWS Panel, the report will be reviewed. If the report is found to identify a SAWS application, the report will be forwarded to the TC Directors for subsequent action. Note that in some instances, it may be necessary to review the actual application file. However, the intent is to minimize any direct impact on the examination process.

SAWS Application Subject Matter

Corps-wide Potential SAWS Subject Matter:

1. Applications dealing with inventions, which, if issued, would potentially generate unwanted **media coverage** (i.e., **news, blogs, forums**).
2. Applications disclosing seemingly **frivolous or silly** subject matter – paying special attention to the **title, abstract and cover drawing**.
3. Applications with claims of broad or domineering scope and/or which have old effective filing dates (submarines).
4. Applications with claims of pioneering scope.

5. Applications that have objectionable or derogatory subject matter in the specification and/or drawing(s) and/or claims.
6. Applications claiming inventions, which would endanger individuals, the environment, the security of our nation, or public safety.
7. Applications claiming inventions that include explicit recitations of race, ethnicity, origin, or other prescribed populations.
8. Applications claiming a method/apparatus to take a human life (e.g. suicide machine).
9. Applications claiming a method or apparatus for abortion.
10. Applications claiming a motor or power plant, which is self-sustaining (perpetual motion machine, etc.) or which appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.).
11. Applications claiming the prevention or curing of diseases, which were previously considered impossible to prevent or cure.
12. Applications about human cloning.
13. Commissioner-ordered reexams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501.
14. Reexamination and Reissue cases in which:
 - Litigation involves the Supreme Court,
 - Litigation where the judgment on a patent was either favorable or unfavorable and a high dollar amount was awarded to either party, or
 - Technology/Companies that are recognized by the public or have been reported in the media or there is a high probability that the media would report on it in the future based on any action taken by the PTO.

Examples of categories of potential SAWS subject matter specific to TC2600 include:

1. Smartphones and other convergence-intensive devices.
2. Digital telephony and voice over IP or Internet systems.
3. Internet-enabled systems (e.g., podcasting).
4. E-commerce-related systems (e.g., music download sales).

Suggestions for additions to this list should be forwarded to the TC2600 SAWS coordinator named above.

Examples of categories of potential SAWS subject matter specific to TC2600 include:

1. Smartphones and other convergence-intensive devices.
2. Digital telephony and voice over IP or Internet systems.
3. Internet-enabled systems (e.g., podcasting).
4. E-commerce-related systems (e.g., music download sales).



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Technology Center 2800
SENSITIVE APPLICATION WARNING SYSTEM (SAWS)
FY 2012

PURPOSE:

The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memorandum reminds Technology Center 2800 personnel of the on-going SAWS program. The following overview presents our current procedure. **Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.**

OPERATIONAL OVERVIEW:

This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexamination proceedings (Reexams), Reissues and applications being forwarded to the BPAI.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner and home SPE in considering whether an application discloses subject matter that is sensitive. **Examiners and managers should use their judgment and are encouraged to be liberal (erring to identify rather than not) in their identification as to whether or not an application contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title.** Upon agreement that an application could be considered as a SAWS application, the SAWS Point of Contact (POC) is alerted as early in prosecution as possible. The alert should be a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

With this alert, the application is entered into a SAWS database and flagged by the SAWS POC. If during prosecution, the sensitive nature of the application has changed (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC can be notified to remove the application from the SAWS database and unflag.

Prosecution of SAWS applications should proceed just as with any other application (i.e., where necessary - review by primary, conference with SPE, and/or consult with QAS). Unless the nature of the subject matter is particularly sensitive, the SAWS POC and/or the SAWS QAS need *not* be particularly consulted about the prosecution of the application. When completed, the Office action should be approved for counting in eRF as usual.

Management Guidelines for Sensitive Application Warning System (SAWS) Program

The flagging procedure ensures that when an allowance of a SAWS application is counted, the Notice of Allowance (NOA) is not mailed (and not scanned into eDAN) until a SAWS report has been completed and considered by appropriate areas of the PTO. If the NOA of a SAWS application is mistakenly mailed prior to the SAWS report, the SAWS POC should be notified *immediately*.

Upon an allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS POC as a Word document attachment. A template of the required SAWS report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint.

The SAWS report completed by the home SPE is then considered by the SAWS POC who reviews and amends the report, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Often this amending process requires input from the home SPE; the timeliness in responding to SAWS requests for information is greatly appreciated. Further consultation with other TC managers maybe necessary in this process.

The SAWS report is then considered by the Director before it is forwarded to various areas of the PTO for consideration/comment. Any questions/concerns about the sensitive subject matter and/or the prosecution of the application are addressed prior to mailing the allowance.

A. Technology Center 2800 Practice:

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares the SAWS report when necessary
3. SAWS POC and SAWS QAS reviews SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

TC 2800 SAWS POC: Diane Lee (2-2399)

TC 2800 SAWS POC: Andrew Schechter (2-2302)

TC 2800 SAWS QAS: Hien Phan (2-1606)

1. **Examiner Identification of Potential SAWS Applications:** In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (attached to this memo). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be liberal in their identification as to whether or not an

Management Guidelines for Sensitive Application Warning System (SAWS) Program

application contains potential SAWS material. This initial identification by the Examiner is intended to cast a broad net for applications of interest.

2. Home SPE Review and SAWS Report Preparation: The home SPE should discuss the sensitive nature of the application with the Examiner. The SPE should use their judgment and be liberal in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS QAS.

Upon agreement that the application should be reported as SAWS application, the home SPE must complete the SAWS report in the detail required by the attached template. The required Impact Statement can be prepared after performing an Internet search to find external information indicative of the sensitivity of the subject matter. One way to do this is via a Google search of the invention, the inventors, and owner or assignee. Such information may include, but is not limited to, financially important subject matter (Is the stock of the invention's owner publicly traded? Have there been press releases about the invention?), politically charged subject matter, and subject matter which may raise legal or ethical objections.

As noted above, the home SPE typically prepares the SAWS report at the time of allowance. Exceptions to this rule are as follows:

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexamination proceedings meeting the listed SAWS criteria, the SAWS report should be completed prior to each new office action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexamination proceedings in the TC because most of them are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS, Appeal Specialist and/or the Interference Practice Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time the Examiner's Answers or interference papers (PTO-850) are prepared.

3. SAWS POC and SAWS QAS Review: Once the SAWS report is submitted, the SAWS report will be reviewed by the SAWS POC and the SAWS QAS for entering the application number into the TC 2800 SAWS tracking system. Upon allowance of a SAWS application, a SAWS screening committee will review the application to ensure all appropriate actions have been taken and searches have been properly made. The SAWS screening committee comprises the home SPE, at least one of the following managers in the TC 2800: the SAWS POC, the SAWS QAS, and another TC 2800 management official. The SAWS report is then forwarded to the TC Directors for subsequent action.

Management Guidelines for Sensitive Application Warning System (SAWS) Program

4. **Director Review and Forwarding:** The TC Directors review the SAWS report. The Directors make the final decision on forwarding the SAWS report to other areas of the PTO. In the event that a SAWS report is not forwarded, the information is saved for future reference. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would be addressed by the home SPE in consultation with the SAWS POC and/or SAWS QAS with the approval of the directors.

B. Subject matter of special interest in TC 2800

1. Perpetual motion machines
2. Anti-gravity devices
3. Room temperature superconductivity
4. Free energy – Tachyons, etc.
5. Gain-Assisted Superluminal Light Propagation (faster than the speed of light)
6. Other matters that violate the general laws of physics.
7. Applications containing claims to subject matter which, if issued, would generate unfavorable publicity for the USPTO.
8. Applications reciting business methods or E-commerce system that would significantly impact the industry.
9. Emerging technologies implementing metamaterials- Application implementing metamaterials having negative refractive index to currently existing and know art in the invention to achieve an invisible, cloaking device around the object rendering the object invisible over certain band of wavelengths.

Corps-wide Potential SAWS Subject Matter:

1. Applications with claims of **broad** or **domineering scope** and/or which have **old effective filing dates** (submarines).
2. Applications with claims of **pioneering** scope.

Management Guidelines for Sensitive Application Warning System (SAWS) Program

3. Applications dealing with inventions, which, if issued, would potentially generate extensive **media coverage**.
4. Applications that have **objectionable or derogatory** subject matter in the specification and/or drawing(s) and/or claims.
5. Applications dealing with inventions, which would endanger individuals, the environment, the security of our nation, or public safety.
6. Applications claiming inventions including explicit recitations of race, ethnicity, origin, or other prescribed populations etc.
7. Applications claiming a method or apparatus to take a human life (e.g. suicide machine).
8. Applications claiming a method or apparatus for abortion.
9. Applications claiming a motor or power plant, which is self-sustaining (perpetual motion machine, etc.) or which appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.).
10. Applications claiming the prevention or curing of diseases, which were previously considered impossible to prevent or cure.
11. Human cloning.
12. Commissioner-ordered reexams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501.
13. Reexamination and Reissue cases in which:
 - Litigation involves the Supreme Court.
 - Litigation where the judgment on a patent was either favorable or unfavorable and a high dollar amount was awarded to either party, or
 - Technology/Companies that are recognized by the public or have been reported in the media or there is a high probability that the media would report on it in the future based on any action taken by the PTO.

A. Subject matter of special interest in TC 2800

1. Perpetual motion machines
2. Anti-gravity devices
3. Room temperature superconductivity
4. Free energy – Tachyons, etc.
5. Gain-Assisted Superluminal Light Propagation (faster than the speed of light)
6. Other matters that violate the general laws of physics.
7. Applications containing claims to subject matter which, if issued, would generate unfavorable publicity for the USPTO.
8. Applications reciting business methods or E-commerce system that would significantly impact the industry.
9. Emerging technologies implementing metamaterials- Application implementing metamaterials having negative refractive index to currently existing and know art in the invention to achieve an invisible, cloaking device around the object rendering the object invisible over certain band of wavelengths.

Technology Center 2900 Sensitive Application Warning System (SAWS)

UPDATED: End of Year FY 2011

PURPOSE:

The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memo reminds Technology Center 2900 of the on-going SAWS program. The following overview presents our current procedure. **Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.**

OPERATIONAL OVERVIEW:

This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexams, Reissues and applications being forwarded to the BPAI.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner and home SPE in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgement and are encouraged to be *liberal* (erring to identify rather than not) in their identification as to whether or not an application contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title. Upon agreement that an application could be considered as a SAWS application, the SAWS POC is alerted as early in prosecution as possible. The alert should be a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

With this alert, the application is entered into a SAWS database and flagged by the SAWS POC. If during prosecution, the sensitive nature of the application has changed (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC can be notified to remove the application from the SAWS database and unflag.

Prosecution of SAWS applications should proceed just as with any other application (i.e., where necessary - review by primary, conference with SPE, and/or consult with QAS). Unless the nature of the subject matter is particularly sensitive, the SAWS POC and/or the SAWS QAS need *not* be particularly consulted about the prosecution of the application. When completed, the Office action should be approved for counting in eRF as usual.

Due to the flagging procedure, Office actions on SAWS applications are not mailed directly by an LIE. After the Office action is counted, the LIE or Team Leader will return the Office action to the Examiner. The Examiner should then post the Office action to the SAWS POC and send an accompanying email alerting the posting. The SAWS POC will then have the Office action timely mailed *unless* it is an allowance. Allowances remain counted but not mailed (and not scanned into eDan) until a SAWS report has been completed and considered by appropriate areas

of the PTO. If an allowance of a SAWS application is mistakenly mailed prior to the SAWS report, the SAWS POC should be notified *immediately*.

Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS POC as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint.

The SAWS report completed by the home SPE is then considered by the SAWS POC who amends the report, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Often this amending process requires input from the home SPE; your timeliness in responding to SAWS requests for information is greatly appreciated. Further, the SAWS POC consults the SAWS QAS in this process.

The SAWS report is then considered by the Director before it is forwarded to various areas of the PTO for consideration/comment. Any questions/concerns about the sensitive subject matter and/or the prosecution of the application are addressed prior to mailing the allowance.

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares report when necessary
3. SAWS POC and SAWS QAS reviews SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

1. **Examiner Identification of Potential SAWS Applications.** In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see attached). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be liberal in their identification as to whether or not an application contains potential SAWS material. This initial identification by the Examiner is intended to cast a broad net for applications of interest.

2. **Home SPE Review and SAWS Report Preparation.** The home SPE should discuss the sensitive nature of the application with the Examiner. The SPE should use their judgment and be liberal in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS QAS.

Upon agreement that the application should be reported as SAWS, the home SPE must complete the SAWS report in the detail required by the attached template. The Impact Statement can be prepared by performing an Internet search to find external information indicating the sensitivity of the subject matter. One way to do this is via a Google search of the invention, the inventors, and owner or assignee. Such information may include, but is not limited to,

financially important subject matter (Is the stock of the invention's owner publicly traded? Have there been press releases about the invention?), politically charged subject matter, and subject matter which may raise legal or ethical objections.

As noted above, the home SPE typically prepares the SAWS report at the time of allowance. Exceptions to this rule are as follows:

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexams meeting the listed SAWS criteria, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexams in the TC because most of these are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS Appeal Specialist and/or the Interference Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time of the Examiner's answer or interference papers (PTO-850, claims and count).

3. **SAWS POC and SAWS QAS Review.** Once submitted, the SAWS report will be reviewed by the SAWS POC and the SAWS QAS and amended, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Note that in some instances, it may be necessary to review the actual application file. However, the intent is to minimize any direct impact on the examination process. The SAWS report is then forwarded to the TC Director for subsequent action.

4. **Director Review and Forwarding.** The TC Director review the SAWS report. Any further questions concerning the subject matter and/or prosecution are addressed. The Director makes the final decision on forwarding the SAWS report to other areas of the PTO. In the event that a SAWS report is not forwarded, the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would addressed via the SAWS POC and/or SAWS QAS.

TC 2900 SAWS Subject Matter List

SAWS POC: Caron Veynar
SAWS QAS: Joel Sincavage
10/27/2011

1. Subject matter which is:
 - Sexually explicit,
 - controversial,
 - illegal,
 - inflammatory,
 - offensive or derogatory, such as those which include caricatures or depictions.
 - Explicit recitations of race, ethnicity, origin, or other prescribed populations.
2. Simple Shapes
3. Applications dealing with inventions, which, if issued, would potentially generate extensive **media coverage (i.e., news, blogs, forums)**.
4. If the **title** states an apparatus to take a human life (e.g. suicide machine) or an apparatus for abortion.
5. If the **title** states the invention is a motor or power plant, which is self-sustaining (e.g. perpetual motion machine, etc.) or which appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.).
6. Reexamination and Reissue cases in which:
 - Litigation involves the Supreme Court,
 - Litigation where the judgment on a patent was either favorable or unfavorable and a high dollar amount was awarded to either party, or
 - Technology/Companies that are recognized by the public or have been reported in the media or there is a high probability that the media would report on it in the future based on any action taken by the PTO.

TC-3600
Sensitive Applications Warning System (SAWS)
Processing Guidelines

1) Examiner Case Identification

The SAWS program is based on a tiered process of application identification. This approach first utilizes the judgment of the Examiner and then the home SPE in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgment and are encouraged to be *liberal* in their identification as to whether or not an application contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title. In order to provide the broadest recognition of applications of interest, the Examiners will be provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specifically identified "of interest" subject matter (see attached). This list is considered non-exhaustive. This initial determination by the Examiner is intended to cast a broad net for cases of interest.

The Examiners, upon discovery of an application containing potential SAWS material, should report the case information to their immediate Supervisory Patent Examiner (serial number and a brief reason why they consider the application to be a SAWS case).

2) SPE Review/Screening of Application Information

Having received an initial SAWS report from the Examiner, the SPE reviews the information and makes a determination as to whether or not the Application contains SAWS subject matter. If the SPE determines the case does potentially contain SAWS subject matter, the SPE will report the case information, as early in prosecution as possible, to the SAWS committee database manager (TC SAWS POC) for review and entry into the TC SAWS database.

The following information should be forwarded by the SPE:

1. Serial Number
2. Examiner Name
3. Art Unit
4. Brief statement as to why this application should be listed in the SAWS database

The SPE may add impact statements as appropriate. The SPE is instructed to be liberal in case identification, but to screen out cases that are clearly of a routine nature.

If the SPE determines that the application is routine in nature, no database entry is necessary and the case may be returned to the examiner.

3) SAWS Review/Screening of Application Information Forwarded from the SPE

The SAWS Committee database manager will flag/group the application in PALM Expo. The Saws Committee Chairman will prepare reports to be forwarded to the TC Director (as requested).

If necessary, the SAWS manager may convene the Committee to review the application data report and make a recommendation as to whether the application contains SAWS information. The Committee will consist of the TQASs and the BPSP, but can include SPEs representing a cross section of the Technology Center. The chairperson of this committee is responsible for collection of the application reports and dissemination as necessary.

4) Director Level Review and Forwarding

The TC Director will review the reports. Following this review, if determined appropriate, the information will be forwarded to the Office of the Commissioner for Patents (particularly the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy).

The TC Director at his/her discretion may call for or participate in any SAWS Committee meeting to consider SAWS designation. The Director will also review each SAWS application that is in condition for allowance and determine if a report is to be sent to the Office of the Commissioner for Patents prior to mailing of the Notice of Allowance (NOA).

5) Handling of Applications to be Forwarded to the Board of Patent Appeals and Interferences (BPAI)

The TC-3600 Appeal Conference Specialists will cross-check the application for each appeal with the current list of SAWS applications in the TC. If/when a match is found and the application is in condition to be forwarded to the BPAI, the Appeal Conference Specialist will forward an e-mail message to the Point-of-Contact (POC) for the BPAI (currently the POC is Ms. Kimberly Jordan). The e-mail will include: 1) the application serial number and 2) A statement verifying that the identified application is a SAWS application.

SAWS Application Identification Subject Matter**Corps-wide Potential SAWS Subject Matter:**

1. Applications dealing with inventions, which, if issued, would potentially generate unwanted **media coverage** (i.e., **news, blogs, forums**).
2. Applications disclosing seemingly **frivolous or silly** subject matter – paying special attention to the **title, abstract and cover drawing**.
3. Applications with claims of broad or domineering scope and/or which have old effective filing dates (submarines).
4. Applications with claims of pioneering scope.
5. Applications that have objectionable or derogatory subject matter in the specification and/or drawing(s) and/or claims.
6. Applications claiming inventions, which would endanger individuals, the environment, the security of our nation, or public safety.
7. Applications claiming inventions that include explicit recitations of race, ethnicity, origin, or other prescribed populations.
8. Applications claiming a method/apparatus to take a human life (e.g. suicide machine).
9. Applications claiming a method or apparatus for abortion.
10. Applications claiming a motor or power plant, which is self-sustaining (perpetual motion machine, etc.) or which appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.).
11. Applications claiming the prevention or curing of diseases, which were previously considered impossible to prevent or cure.
12. Applications about human cloning.
13. Commissioner-ordered reexams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501.
14. Reexamination and Reissue cases in which:
 - Litigation involves the Supreme Court,
 - Litigation where the judgment on a patent was either favorable or unfavorable and a high dollar amount was awarded to either party, or

6) SAWS Database Management and Application Tracking

The status of all designated applications must be updated in the database at the time of allowance or abandonment. The PALM Expo flag, once applied to the application, will prevent mailing at the time of disposal. The application serial number must be sent to the SAWS data base manager to remove the flag (can be sent by the SPE or the docket clerk **after counting and before mailing**). This procedure will not hold up Examiner's counts (**the work credit will be given when the work was performed**).

Technology Center 3600

3/11/13

- Technology/Companies that are recognized by the public or have been reported in the media or there is a high probability that the media would report on it in the future based on any action taken by the PTO.

TC-3600 Specific Subject Matter:

- 1) Applications with special Licensing and Review issues (e.g., disputes with DOD or DOE.)
- 2) Security Vault Applications.
- 3) Applications with claims specifically reciting statutes, or governmental functions, including functions of the USPTO.
- 4) Applications dealing with tax strategies.

Technology Center 3700
Sensitive Application Warning System
(SAWS)

Definition of a SAWS Application

An application is considered a SAWS application when it contains or references subject matter that may have the potential to be controversial, offensive to certain populations, subject to ridicule or attract unusual media attention.

Introduction:

This memo is intended to outline the Technology Center 3700 SAWS program and to set forth the procedures for transmitting information relating to potentially sensitive applications to appropriate contact areas within the Office. The following overview represents our current procedure.

The SAWS program applies to all pending applications, including reissue applications, re-examination proceedings and applications being forwarded to the BPAI.

The purpose of this program is to track the progress of potentially sensitive applications docketed in the TC and to keep TC Directors informed, through the appropriate chain-of-command, when a potentially sensitive application is ready for allowance. The TC 3700 SAWS Panel consists of the following TQASs: Greg Morse, Janet Baxter and Robin Evans. All TC 3700 managers and examiners should be aware of our SAWS program and assist in the identification of potentially sensitive applications.

Operational Overview:

The SAWS program is based upon a tiered process of sensitive application identification. This approach utilizes examiners, SPEs, TQASs and the TC 3700 SAWS Panel to identify potential sensitive applications prior to and during examination on the merits. Examiners and managers should use their judgment and are encouraged to be *liberal* (erring to identify rather than not) in their initial identification as to whether or not an application contains potential SAWS material. A commonsense approach should be used to scrutinize the general nature of the invention, the claims and the title. Upon agreement that an application could be considered as a SAWS application, the SAWS Panel should be alerted as early in prosecution as possible. The alert should be an email to at least one member of the SAWS Panel that you are considering an application as potentially SAWS, including a short explanation of why. SAWS applications are placed in a special PALM grouping by any member of the SAWS panel. When a potential application, which has been identified and verified as containing SAWS material, is either in condition for allowance or about to be indicated as allowable, the examiner/manager will bring

the application to the attention of the SAWS panel. After counting and before mailing of the notice of allowance, the panel will review the application to ensure all appropriate actions have been taken. The application is then reported to the TC Directors for possible transmittal to the Office of the Deputy Commissioner for Patents. The program is designed to provide for the earliest possible identification of a potential "SAWS" application and to bring these applications to the attention of TC and USPTO management prior to issuance of the patent.

Applications should be reviewed for potential sensitive material at the time of classification and assignment (docketing), and also throughout pendency of the application.

If an application being classified for Pre-Grant publication is deemed to contain sensitive material, please contact a member of the TC3700 SAWS panel.

The following process has been developed to effectively identify potential sensitive applications:

- 1 Examiner/SPE/TQAS identification
- 2 TC 3700 SAWS Panel screening/identification
- 3 Technology Center Directors notification

1. Examiner/SPE/TQAS identification of SAWS applications

In order to provide the broadest recognition of potential SAWS applications, the Examiners, SPEs and TQASs have been provided with a list of subject matter areas (attached to this memo) that are considered to be controversial and/or newsworthy, or are directed to specific items of interest. This list is non-exhaustive. Examiners, SPEs and TQASs should use their judgment and are encouraged to be liberal in their initial determination as to whether or not an application might contain SAWS material. This initial determination by the Examiner, SPE and TQAS is intended to cast a broad net for cases of interest. Examiners, SPEs and TQASs are strongly encouraged to seek guidance from the SAWS Panel for potential SAWS applications as early in prosecution as possible. After an application has been identified as a SAWS application, and in addition to a full and complete examination on the merits by the examiner, it is recommended that the examiner assigned to a SAWS application order a full NPL search to be performed by the EIC TC 3700 prior to a first action on the merits or as early in prosecution as practical. The examiner should sit down with the EIC searcher in an attempt to fully explain the full scope of prior art sought and the sensitive nature of the application. SPEs will receive an updated list for their art unit of all SAWS applications and their status on a monthly basis and will also receive an e-mail update whenever a particular SAWS application assigned to their art unit changes status. SPEs will communicate this information to the examiners assigned to these applications.

2. Screening/Identification by TC 3700 SAWS Panel

Once an application is identified as containing sensitive subject matter, the examiner/SPE/TQAS will consult with a member of the SAWS panel, who will then place the application in the TC 3700 SAWS grouping. When an application containing sensitive subject matter is in condition

for allowance, the examiner and their SPE is requested to bring the application to the attention of a SAWS panel member prior to counting to schedule a SAWS conference to review search history, prosecution history and claim interpretation issues. After the examiner allows the application, the SAWS panel will review the application to ensure all appropriate actions have been taken and searches have been made. The SAWS panel will review all allowed SAWS applications and will either contact the SPE of the examiner to discuss potential further action that needs to be taken in the application or will contact a Technology Center Director if the application is in condition for allowance.

3. Technology Center Directors Notification

Any application which has been allowed and which is considered a SAWS application will be reported to the TC Directors. The TC Directors make the final decision on forwarding a report of the SAWS application to the office of the Deputy Commissioner for Patents. The status of all applications identified as SAWS applications will be tracked by the SAWS Panel.

TC 3700 SAWS Panel Members

- Greg Morse (2-3838)
- Janet Baxter (2-5013)
- Robin Evans (2-4777)
- Tom Hughes (2-4357)

November, 2011

Technology Center 3700 Specific Subject Matter

(Updated September 2010)

Applications claiming subject matter which are controversial and/or newsworthy, for example:

- Processes and apparatus involving Education (class 434)
- Applications involving obscene or pornographic material
- Processes or products useful as biological weapons
- Fetal cell or fetal tissue based invention
- Claims either specifically directed to or encompassing human beings
- Methods using or manipulating human embryos or fetuses
- Embryonic stem cell technology and methods of using same
- Human tissue or organ
- Methods or compositions for prolonging life or preventing aging
- *In vitro* fertilization
- Detection of, or treatment for, bio-terrorism agents such as anthrax, small pox, etc.
- Applications claiming the prevention or curing of diseases which were previously considered impossible to prevent or cure, such as:
 - Alzheimer's disease
 - common cold
 - dementia
 - mental retardation
 - HIV infection
- Business methods
- Applications claiming inflammatory or offensive subject matter
- Applications claiming games played in outer space
- Perpetual motion machines and processes
- Inventions directed towards telepathic communication/control systems
- Weather modification
- Circumventing governmental regulation of licensed gambling.
- Forms of gambling for minors.
- Forms of electronic entertainment which capitalize on gambling addiction.
- Erotic sex toys specifically adapted for minors.
- Games or electronic apparatus involving cruelty to animals.

Note: These lists are not all encompassing for all potential SAWS applications. If you believe that a specific application has the potential to be a SAWS application for any reason, please contact your SPE or a TC 3700 SAWS panel member.