



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

September 5, 2014

The Honorable Jerry Moran
United States Senator
P.O. Box 067
Manhattan, KS 66502

Attn: Megan Henry

Dear Senator Moran:

Thank you for your inquiry on behalf of your constituent (b) (6) regarding the Sensitive Applications Warning System (SAWS) in place at the United States Patent and Trademark Office (USPTO). (b) (6) asked eight questions which are listed below along with our responses.

1. Please explain in detail the policy and guidelines relating to the USPTO's Sensitive Application Warning System ("SAWS"), including but not limited to: the details of the role of the patent examiner in administering SAWS policy, the purpose of SAWS memoranda, and the role of the Patent Trial and Appeal Board in administering SAWS policy.

The SAWS program assists the USPTO in processing patent applications of special interest, i.e., those having the potential to generate high publicity or have a strong impact in the patent community.

Each technology center (TC) distributes to its examiners a biannual SAWS memo listing potential SAWS subject matter areas specific to their TC. Managers discuss the memo with examiners at this time, encouraging them to bring to management's attention any application they believe might be identified as a SAWS application. Cases indicated as SAWS go through a screening process which includes being flagged in the Patent Application Location and Monitoring system (PALM).

The Patent Trial and Appeal Board (PTAB) has no role in the SAWS program. However, TCs do notify the PTAB if an application on appeal is a SAWS application.

2. Does the USPTO maintain a list that identifies patent applications and/or patents in SAWS ("the SAWS list")? If so, how is this list used?

SAWS applications are flagged in PALM. A monthly report is generated of all Patent Corps SAWS applications and forwarded to all TC directors and TC SAWS points of contact (POCs) for monitoring.

3. Is every application filed at the USPTO screened for possible inclusion in SAWS?

No, but examiners are encouraged to bring to the attention of their supervisors any application they believe might be identified as a SAWS application.

4. **Are there instances when patent applications are treated as though in SAWS but not identified on the SAWS list? What determines whether or not to include on the SAWS list an application that is being treated as though in SAWS?**

No. TC managers and group directors decide whether an application should be identified as a SAWS application once an examiner has brought it to their attention.

5. **What is the average pendency time for a patent application in SAWS compared to other cases in the art unit of that application?**

There are very few SAWS cases at the art unit level, so no meaningful comparison of average pendency can be made.

6. **Does the USPTO ever base a decision not to allow a patent application on the basis of prior art while at the same time not citing that prior art in examination of the patent application? Please explain.**

No, prior art relied upon during the examination of an application will be cited on a Notice of References Cited (PTO-892) or on an Information Disclosure Statement. If the application is allowed, the prior art cited will be printed in the patent. More information on the citation of references can be found in chapter 707.05 of the Manual of Patent Examining Procedure (MPEP).

7. **Do Patent Examiners do their own prior art searching for applications in SAWS? If not, who is available to assist Patent Examiners with prior art searching?**

An examiner must conduct a thorough search of the prior art in all applications. Examiners may also ask their direct manager, a quality assurance specialist, or another examiner for search assistance if necessary. Examiners are also encouraged to use the services of trained professional on-line search personnel located in the TCs. More information on general search guidelines can be found in chapter 904.02 of the MPEP.

8. **Please explain the people involved (by position; name not necessary), the factors considered, and the procedures used to make a determination that a patent application or issued patent should be removed from SAWS?**

An application flagged as a SAWS application can be issued. A SAWS designation does not prohibit the allowance of an application, but instead brings to the agency's attention applications of special interest, those that would generate high publicity or have a strong impact on the patent community. If during prosecution the sensitive nature of the application has changed, the SAWS POC can remove the application from the SAWS database.

We trust the foregoing will be useful in responding to your constituent.

Sincerely,



Dana Robert Colarulli
Director
Office of Governmental Affairs