

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

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PAUL MORINVILLE and GILBERT HYATT,

Plaintiffs,

v.

UNITED STATES PATENT AND TRADEMARK  
OFFICE,

Defendant.

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Civil Action No. 1:19-cv-01779

**DEFENDANT'S MOTION TO DISMISS**  
**PLAINTIFFS' FIRST AMENDED COMPLAINT**

Defendant United States Patent and Trademark Office hereby moves to dismiss Plaintiffs' First Amended Complaint for failure to state a claim upon which relief can be granted, pursuant to Civil Rule 12(b)(6). In support of the motion, Defendants submit the accompanying memorandum of law, exhibits, and proposed order.

Dated: November 15, 2019

Respectfully submitted,

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**MEMORANDUM IN SUPPORT OF DEFENDANT'S  
MOTION TO DISMISS PLAINTIFFS' FIRST AMENDED COMPLAINT**

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## INTRODUCTION

Congress directs the United States Patent and Trademark Office (“PTO”) to “cause an examination to be made” of every patent application it receives, 35 U.S.C. § 131, but leaves to PTO the task of determining how best to allocate the resources at its disposal to evaluate the hundreds of thousands of applications it receives every year. In 1994, PTO developed the Sensitive Application Warning System, or SAWS, “to allow patent examiners to alert leadership when a patent might issue on a sensitive matter” and ensure additional quality checks were performed on the patent application prior to final denial or issuance under the patent laws. *Sensitive Application Warning System*, U.S. Pat. & Trademark Office (Mar. 2, 2015), <https://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system>. In 2015, PTO shuttered the program after concluding SAWS “ha[d] only been marginally utilized and provide[d] minimal benefit.” *Id.*

PTO’s policy interest in ensuring sensitive patent applications received additional review prior to a final decision on patentability is far removed from the concerns of the Privacy Act, 5 U.S.C. § 552a, which seeks “to protect the privacy of *individuals* identified in information systems maintained by Federal agencies” by “regulat[ing] the collection, maintenance, use, and dissemination of information by such agencies.” Privacy Act of 1974, § 2(a)(5), 88 Stat. 1896, Pub. L. No. 93-579, (emphasis added). Notwithstanding this disconnect, Plaintiffs, inventors who allege their patent applications were selected for review under SAWS, seek monetary damages against PTO under the Privacy Act based on its alleged failure to include SAWS flags and reports in Plaintiffs’ patent application files. Plaintiffs’ First Amended Complaint (“First Am. Compl.”), ECF No. 10, attempts to shoehorn SAWS into three theories of liability under the Privacy Act. But all of these theories are premised on similar fundamental errors in distinguishing between inventors and the inventions they put forward for patenting, and the nature of the SAWS program as described by Plaintiffs.

Plaintiffs’ first theory is that PTO, by omitting SAWS flags and SAWS reports from patent

application files, failed to accurately maintain records “concerning any individual.” *See* 5 U.S.C. § 552a(g)(1)(C). But patent application files and SAWS information are about proposed inventions, not individual inventors. Moreover, a claim under the Privacy Act’s civil remedy provision, § 552a(g)(1)(C), requires Plaintiffs to show that PTO’s failure to include SAWS flags and reports in Plaintiffs’ patent application files caused an “adverse determination.” Plaintiffs allege various harms as a result of being flagged for review, but little harm from the failure to actually include the flag and SAWS reports in the patent application files accessible to Plaintiffs. The only harm they claim that failure caused (and thus that they claim the failure to accurately maintain their records caused) is that they were unable to challenge the flagging of their applications. The inability to challenge a decision is not, however, an “adverse determination” for purposes of a Privacy Act claim.

Plaintiffs’ second theory is that SAWS flags and SAWS reports violate the Privacy Act’s prohibition on “maintain[ing] . . . record[s] describing how any individual exercises rights guaranteed by the First Amendment.” 5 U.S.C. § 552a(e)(7). SAWS files and SAWS reports are not “records” because they are about inventions, not inventors, so this claim fails for the same reasons Plaintiffs’ first claim fails. But even if that were not the case, Plaintiffs have not explained in what sense the “filing of a patent application is the exercise of rights guaranteed by the First Amendment,” and how the SAWS system describes the exercise of those rights, as opposed to the subject matter of the purported invention. PTO is aware of no case recognizing a First Amendment guaranteed right to file a patent application, and this Court should not extend relief to Plaintiffs under the Privacy Act on such a scant legal theory.

Finally, Plaintiffs assert that SAWS runs afoul of the Privacy Act’s requirement that agencies collect information that may result in adverse determinations about an individual directly from the individual, to the greatest extent practicable. 5 U.S.C. § 552a(e)(2). Plaintiffs’ theory here is that PTO collects SAWS data through Internet research, rather than from Plaintiffs directly. But Plaintiffs do



not explain how they are adversely impacted by PTO using the Internet to compile SAWS reports, as required for a civil remedy based on this claim. Patent rights are evaluated by applying the law to the record created by examination of the Plaintiffs' applications, and the manner in which PTO collects information that is not a part of that record is of no concern to Plaintiffs.

Two further defects with Plaintiffs' complaint merit dismissal of the First Amended Complaint, at least in part, at the pleadings stage. First, one of the Plaintiffs, Mr. Morinville, does not allege when he learned that his patent applications were subject to a SAWS flag or when he was unable to challenge the flag, a fact critical to determining whether Mr. Morinville filed suit within the Privacy Act's two-year statute of limitations. Second, in addition to their civil damages claims, Plaintiffs seek a declaratory judgment, but "the [Privacy] Act precludes other forms of declaratory and injunctive relief." *Doe v. Stephens*, 851 F.2d 1457, 1463 (D.C. Cir. 1988).

Accordingly, the Court should grant PTO's motion to dismiss for failure to state a claim and dismiss the complaint with prejudice.

## **BACKGROUND**

### **I. Patent Application Files**

PTO "is the federal agency responsible for examining patent applications and for issuing U.S. patents." First Am. Compl. ¶ 5. It receives hundreds of thousands of applications for new utility patents, the most common form of patent protection, each year. See *U.S. Patent Statistics Chart Calendar Years 1963-2015*, U.S. Pat. & Trademark Office, [https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us\\_stat.htm](https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm) (Sept. 25, 2019) (noting 285,096 domestic utility patent applications and 293,706 foreign utility patent applications in 2014, the last full year of the SAWS program). Completed applications are substantively reviewed, or examined, by PTO in order to determine whether a patent should be awarded. "The examination of the application consists of a study of the application for compliance with the legal requirements and a search through

U.S. patents, publications of patent applications, foreign patent documents, and available literature, to see if the claimed invention is new, useful and non-obvious and if the application meets the requirements of the patent statute and rules of practice.” *General Information Concerning Patents*, U.S. Pat. & Trademark Office (Oct. 2015), <https://www.uspto.gov/patents-getting-started/general-information-concerning-patents>.

The three necessary components of a complete patent application are defined by statute. *See* 35 U.S.C. § 111(a)(2). First, applicants must provide a “specification,” which “contain[s] a written description of the invention, and of the manner and process of making and using it,” and must “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.” *Id.* § 112(a)–(b). Second, “[t]he applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.” *Id.* § 113. Third, each inventor must “execute an oath or declaration in connection with the application” that affirms the applicant “was authorized to be made by the affiant or declarant” and that the “individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.” *Id.* § 115(a)–(b). If an inventor is deceased, incapacitated, unavailable, or unwilling to submit the oath or declaration, a patent applicant can submit a “substitute statement” in lieu of the oath. *Id.* § 115(d).

Examiners provide written notice of their decisions regarding the patentability of an application’s claims through “office actions” sent to the patent applicant. *See General Information Concerning Patents*. If PTO decides against awarding a patent on the claimed invention, it is required to provide the applicant with “the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.” 35 U.S.C. § 132(a). The applicant can reply to an adverse office action by modifying their claims in response to the examiner’s concerns, or by providing specific reasons

why the examiner's conclusions regarding patentability are in error. The iterative process continues until a patent is awarded, the applicant appeals the examiner's decision to PTO's Patent Trial and Appeal Board ("Board") after the examiner rejects any claims in the application twice, or the applicant abandons the application.

## II. PTO's Privacy Act Notice Regarding Patent Application Files

A patent application and the applicant's subsequent interactions with PTO, including office actions and any appeals to the Board, all become part of the patent application file. *See* U.S. Patent & Trademark Off., Manual of Patent Examining Procedure § 719 (Jan. 2018). PTO's most recent Privacy Act system of records notice on patent applications (*Privacy Act of 1974; System of Records*, 78 Fed. Reg. 19,243 (Mar. 29, 2013)), acknowledges "Patent Application Files" are a "system of records [that] maintains information on patent applicants and their authorized representatives." The only "records" in this system are the "[o]ath or declaration of applicant including name, citizenship, residence, [and] post office address," "other information pertaining to the applicant's activities in connection with the invention for which a patent is sought," and "[s]tatements containing various kinds of information with respect to inventors who are deceased or incapacitated, or who are unavailable or unwilling to make application for patent." *Id.*

This description tracks the requirements of § 115 for an inventor's oath or other appropriate substitute statement. PTO's Privacy Act notice explains that § 115 is a "source of authority" for maintaining patent application files as a system of records under the Privacy Act. *Id.* It further states that the purpose of patent application files is "[t]o carry out the duties of the USPTO to grant and issue patents, including the collection of the inventor's oath or declaration under 35 U.S.C. § 115." *Id.* The Privacy Act notice does not make reference to the substantive aspects of patent applications, such as the written description and drawings, or to the communications exchanged by the inventor and the examiner during the course of the prosecution. And it certainly does not contemplate internal flags

or deliberative communications between patent examiners.

### III. The Sensitive Application Warning System

PTO created SAWS in 1994. First Am. Compl. ¶ 18; *see also* *Huntington v. U.S. Dep’t of Commerce*, 234 F. Supp. 3d 94, 98–99 (D.D.C. 2017) (providing additional background detail about the SAWS program). Plaintiffs allege the program was not disclosed to the public until 2014, *id.* ¶ 19, and PTO discontinued it a year later, *see Sensitive Application Warning System*.

As alleged in the First Amended Complaint, SAWS directed “PTO personnel . . . to flag ‘sensitive’ applications through various tracking mechanisms, including databases maintained by PTO examination groups and the PTO’s Patent Application Location and Monitoring (“PALM”) database.” First Am. Compl. ¶ 20. “Sensitive” applications were described as applications “that, if issued [as patents], would potentially generate high publicity or would potentially have a strong impact in the patent community.” *Id.* ¶ 22. The First Amended Complaint alleges several types of sensitive applications that might have been flagged for review under SAWS, based on direct quotations from documents released by the PTO in response to Freedom of Information Act requests for records about the SAWS program:<sup>1</sup>

- Applications which have old effective filing dates (pre 6/8/1995, i.e. pre-[General Agreement on Tariffs and Trade]) and claims of broad scope (submarines). *Id.* ¶ 23. (Plaintiffs allege that “‘submarine’ is a pejorative term that refers to a patent application that has been purposefully delayed or manipulated by an applicant so as to emerge after the technology it covers is in wide use.” *Id.* ¶ 24.)
- Applications “with pioneering scope.” *Id.* ¶ 25.
- Applications “dealing with inventions, which if issued would potentially generate

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<sup>1</sup> These documents are part and parcel of the complaint and should have been attached thereto. *See Cause of Action Inst. v. Eggleston*, 224 F. Supp. 3d 63, 70 (D.D.C. 2016). Because PTO’s FOIA release included thousands of pages of internal guidance regarding SAWS, much of it overlapping, discerning which documents Plaintiffs relied upon is impossible. Nonetheless, in an effort to provide context for Plaintiffs’ allegations, PTO has attached to its motion, as Exhibit A, sample documents from its FOIA releases describing the SAWS program containing language that matches the quotes that appear in Plaintiffs’ complaint.

extensive media coverage.” *Id.* ¶ 25.

- Applications with “financially important subject matter,” including consideration of whether “the stock of the invention’s owner [is] publicly traded” or any “press releases.” *Id.* ¶ 32.
- Applications with “subject matter which may raise legal or ethical objections.” *Id.* ¶ 32.
- Applications involving politically charged subject matter, such as abortion. *Id.* ¶¶ 25, 32.
- Applications “which have objectionable or derogatory subject matter in the specification and/or drawing(s).” *Id.* ¶ 25.

Plaintiffs also allege that applications are flagged “based on the identity of the applicant or applicants,” *id.* ¶ 26, but do not quote or cite any PTO document that actually lists this as a basis for flagging a patent under SAWS.

The First Amended Complaint further alleges that within each examination group at PTO, a “SAWS [point of contact] was responsible for flagging SAWS-designated applications in the PTO’s tracking system, typically at the direction of the Supervisory Patent Examiner (‘SPE’), who had [s]ignatory [a]uthority to make such substantive determinations on behalf of the agency, determinations that would prevent sending a Notice of Allowance or an issuance of a patent.” *Id.* ¶ 29. “[P]atent examiners were directed to ‘report potential SAWS cases to their SPE,’ and, with the SPE’s approval and direction, the SAWS [point of contact] would flag the application in the PTO’s tracking system.” *Id.* ¶ 30. PTO personnel were subsequently “directed to prepare reports . . . identifying the factual basis for flagging applications under SAWS, including an ‘Impact Statement.’” *Id.* ¶ 32. That information could include “financially important subject matter . . . politically charged subject matter, and subject matter which may raise legal or ethical objections.” *Id.* Patent examiners “perform[ed] research to prepare SAWS reports,” which could include “conducting a Google search of the invention, the inventors, and owner or assignee.” *Id.* ¶ 33. SAWS reports could be retrieved

by using the name of the patent applicant. *Id.* ¶ 34.

SAWS applications were “reported to the Group Directors for transmittal to the Office of the Deputy Commissioner.” *Id.* ¶ 39. SAWS materials were also disclosed to the Board if an applicant appealed a patent rejection, and there was a special “review process” on appeal for SAWS-flagged applications. *Id.* ¶¶ 46–58.

#### **IV. Plaintiffs’ Claims**

Plaintiffs are inventors who have obtained patents and have numerous patent applications pending before PTO. First Am. Compl. ¶¶ 3–4. They claim that a SAWS flag had the effect of blocking a patent from issuing, irrespective of whether the statutory requirements for patentability were met. *Id.* ¶¶ 36, 50. They characterize this action as “constructive denial of or objection to a patent application.” *Id.* ¶ 38. They also allege “SAWS flags were themselves, and contributed to, determinations adverse to patent applications whose applications were flagged, including determinations to subject those applications to procedures resulting in additional scrutiny beyond the typical patent-examination process.” *Id.* ¶ 53. Plaintiffs assert that their applications have been subjected to SAWS flags, *id.* ¶¶ 57, 60; that SAWS flags and reports were not included in their patent application files accessible to them, *id.* ¶¶ 44, 58, 61, and that they therefore “had no ability to challenge the flagging of their applications or the PTO’s basis for such flagging.” *Id.* ¶ 55. Plaintiffs alleged that their SAWS-flagged applications have been delayed and subjected to additional scrutiny, but do not allege they were ultimately denied patent protection as a result of SAWS. *Id.* ¶¶ 59, 62.

The complaint asserts three claims under the Privacy Act. First, it asserts a claim for failure to maintain accurate records. The complaint alleges that by omitting SAWS information from patent application files of flagged applications, the PTO failed to maintain those files “with such accuracy, relevance, timeliness, and completeness as is necessary to assure fairness in determinations relating to patent applicants’ procedural and substantive rights under the Privacy Act,” in violation of 5 U.S.C. §

552a(e)(5). *Id.* ¶¶ 73–74, 76. The complaint seeks civil damages against PTO, pursuant to 5 U.S.C. § 552a(g)(1)(C), and declaratory relief, for this claim. *Id.* ¶¶ 70–80.

Second, the complaint asserts a claim for maintenance of prohibited records concerning First Amendment rights. Here the complaint alleges that an applicant’s filing of a patent application is an exercise of rights guaranteed by the First Amendment, *id.* ¶ 83, and that “SAWS flags and SAWS reports describe patent applicants’ exercise of rights guaranteed by the First Amendment.” *Id.* ¶ 84. Thus, Plaintiffs allege, PTO’s maintenance of SAWS flags and SAWS reports violates 5 U.S.C. § 552a(e)(7) (requiring agencies to “maintain no record describing how any individual exercises rights guaranteed by the First Amendment unless expressly authorized by statute or by the individual about whom the record is maintained or unless pertinent to and within the scope of an authorized law enforcement activity.”). *Id.* ¶ 86. Plaintiffs therefore assert that they are “entitled to relief under the Privacy Act” for this claim under 5 U.S.C. § 552a(g)(1)(D). *Id.* ¶ 87.

Third, the complaint alleges that under SAWS, PTO collected information regarding patent applicants and applications by conducting Google searches, rather than from the patent applicants themselves, and that that information may result in adverse determinations about patent applicants’ rights, benefits and privileges under the Patent Act. *Id.* ¶¶ 89-90. Thus, Plaintiffs claim PTO violated the Privacy Act’s requirement that agencies “collect information to the greatest extent practicable directly from the subject individual when the information may result in adverse determinations about an individual’s rights, benefits, and privileges under Federal programs,” 5 U.S.C. § 552a(e)(2). *Id.* ¶ 91. For this claim, Plaintiffs also seek “relief under the Privacy Act.” *Id.* ¶ 92.

### **STANDARD OF REVIEW**

Dismissal under Civil Rule 12(b)(6) is appropriate if, assuming the truth of all well-pled factual allegations, Plaintiffs have failed to state a claim upon which relief can be granted. To pass muster, a complaint must contain “sufficient factual matter” to “state a claim to relief that is plausible on its

face.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). A complaint that “tenders ‘naked assertion[s]’ devoid of ‘further factual enhancement’” warrants dismissal. *Id.* (quoting *Twombly*, 550 U.S. at 557). Although a court must accept well-pleaded factual allegations as true and construe them in the light most favorable to the plaintiff, it need not accept “legal conclusions” or “mere conclusory statements.” *Id.* In addition to the facts alleged, a court may consider “documents attached as exhibits or incorporated by reference in the complaint, or documents upon which the plaintiff’s complaint necessarily relies.” *Cause of Action Inst. v. Eggleston*, 224 F. Supp. 3d 63, 70 (D.D.C. 2016) (internal quotation marks omitted). A court is not required to accept as true a complaint’s factual allegations if they “contradict exhibits to the complaint or matters subject to judicial notice.” *Kaempe v. Myers*, 367 F.3d 958, 963 (D.C. Cir. 2004).

### **ARGUMENT**

#### **I. Plaintiffs Fail to State a Claim Under § 552a(g)(1)(C) of the Privacy Act for Failure to Accurately Maintain Records**

The Privacy Act requires an agency to “maintain all records which are used by the agency in making any determination about any individual with such accuracy, relevance, timeliness, and completeness as is reasonably necessary to assure fairness to the individual in the determination.” 5 U.S.C. § 552a(e)(5). A civil remedy for failure to accurately maintain records, however, is only available when an agency:

fails to maintain any record *concerning any individual* with such accuracy, relevance, timeliness, and completeness as is necessary to assure fairness in any determination relating to the qualifications, character, rights, or opportunities of, or benefits to the individual that may be made on the basis of such record, *and consequently a determination is made which is adverse to the individual*;

*Id.* § 552a(g)(1)(C) (emphasis added). Construing this statute, courts in this Circuit apply a four-part inquiry to Privacy Act claims under subsection (g)(1)(C): (1) the individual was “aggrieved by an adverse determination”; (2) the agency “failed to maintain [the individual’s] records with the degree of accuracy necessary to assure fairness in the determination”; (3) “the [agency’s] reliance on the



inaccurate records was the proximate cause of the adverse determination”; and (4) “the [agency] acted intentionally or willfully in failing to maintain accurate records.” *Deters v. U.S. Parole Comm’n*, 85 F.3d 655, 657 (D.C. Cir. 1996).

Plaintiffs’ complaint fails to make out a Privacy Act civil damages claim for failure to maintain accurate records for two principal reasons. First, the thing Plaintiffs claim PTO failed to properly maintain, whether construed as either the patent application files or the SAWS information itself, is not a “record concerning any individual,” 5 U.S.C. § 552a(g)(1)(C). Both application files and SAWS information concern proposed inventions, not inventors as individuals. Second, Plaintiffs have not pled that the failure to include SAWS flags or records in patent application files caused any adverse determinations to be made. Rather, they only claim that the omission of the SAWS information impeded their ability to challenge the SAWS determination itself, which does not amount to an adverse determination under the Privacy Act.

**A. Neither Patent Application Files, nor SAWS Flags and Reports, Are Records Concerning an Individual**

A threshold question in any Privacy Act case under subsection (g)(1)(C) is whether the information that the agency allegedly failed to maintain constitutes a “record concerning any individual.” The Privacy Act defines a “record” to mean “any item, collection, or grouping of information about an individual that is maintained by an agency . . . and that contains his name [or other identifying information].” *Id.* § 552a(a)(4) (emphasis added). That definition “include[s], but [is] not limited to,” the individual’s “education, financial transactions, medical history, and criminal or employment history and that contains his name, or the identifying number, symbol, or other identifying particular assigned to the individual, such as a finger or voice print or a photograph.” *Id.* Data must be both (1) “‘about’ an individual” and (2) “contain the individual’s name or other identifying particular” to be considered a Privacy Act “record.” *Tobey v. NLRB*, 40 F.3d 469, 471 (D.C. Cir. 1994). That definition of course comports with the phrase “records concerning any

individual” in subsection (g)(1)(C).

*Tobey* illustrates how the distinction between information “about an individual” and other types of information works in practice. In that case, the National Labor Relations Board used information from its case management system in a labor grievance proceeding against the plaintiff. 40 F.3d at 470. The case management system was “capable of tracking and monitoring unfair labor practice and representation case data, including case names, allegations made, dates of significant events and the initials or identifying number of the field examiner assigned to the case.” *Id.* The system could be used to “retrieve files on cases assigned to that field examiner,” but contained “no express evaluation of the field examiner’s work.” *Id.* The plaintiff alleged that NLRB had violated the Privacy Act by not providing appropriate notice that its case management system was a “system of records.” But the D.C. Circuit disagreed, holding that the system “contain[ed] information ‘about’ NLRB cases,” and simply because the files “include[] the numbers and initials of the field examiner assigned to the case” did not mean the files were “about” the field examiners. *Id.* at 471.

This Court built upon the definition of what constitutes information “about an individual” in *Fisher v. Nat’l Inst. of Health*, 934 F. Supp. 464 (D.D.C. 1996). The plaintiff in *Fisher* was the chairman of a medical research group that performed studies comparing the effectiveness of different forms of breast cancer surgery. 934 F. Supp. at 466. The research group discovered that one of the researchers contributing to these studies had engaged in misconduct by altering patient records, leading to investigations by Congress and the Office of Research Integrity. *Id.* at 466–67. In the meantime, annotations began appearing in databases of medical literature maintained by NIH noting that studies published by the research group and its chairman were being reanalyzed due to misconduct allegations. *Id.* at 467. The chairman challenged the annotations as a violation of the Privacy Act, but this Court, relying on *Tobey*, concluded “that the database files are ‘about’ the articles and not Dr. Fisher or the other authors listed,” even if “a user of the database files could infer that the annotations placed on

the database files were meant to indicate that Dr. Fisher had been found guilty of scientific misconduct.” *Id.* at 470.

The correct result in this case follows naturally from *Tobey* and *Fisher*. Plaintiffs allege that the entire patent application file is a “record” that has not been adequately maintained, presumably based on the allegation that patent application files are a “system of records,” citing 78 Fed. Reg. at 19,243. First Am. Compl. ¶¶ 13, 74. But a Privacy Act claim cannot be maintained simply because a piece of information “happens to be contained in [or left out of] a system of records.” *Sussman v. U.S. Marshall Serv.*, 494 F.3d 1106, 1121 (D.C. Cir. 2007). Rather, the information challenged must actually describe the individual in some way. *Id.* Patent application files do not fit this criteria because they are not “about” inventors personally; rather, they are about the purported invention on which patent protection is sought. *See Shenchun v. U.S. Customs Serv.*, No. 88-2967, 1989 WL 7351, at \*1 (D.D.C. Jan. 11, 1989) (“The letter may tangentially implicate a property interest that belongs to [plaintiff], but it does not contain information ‘about’ [the plaintiff].”).

Even though application files do contain some information about individuals, such as the inventor’s oath, that does not make the entire patent application file a “record” for Privacy Act purposes, as PTO’s Privacy Act notice recognizes. Plaintiff cites the PTO’s Privacy Act notice, First Am. Compl. ¶ 11, but that notice expressly provides that the only Privacy Act “records” in patent application files primarily relate to the inventor’s oath, one of the three required parts of a patent application. The Privacy Act notice narrowly describes the “records” within patent application files as the “[o]ath or declaration of applicant including name, citizenship, residence, post office address and other information pertaining to the applicant’s activities in connection with the invention for which a patent is sought,” as well as information the applicant must provide to PTO in lieu of an inventor’s oath when an inventor is incapacitated or deceased, or is unwilling or unable to make a patent application. 78 Fed. Reg. at 19,243. The notice correctly excludes from its scope the written

description and the drawings, the other parts of the patent application that actually describe the claimed invention.

Plaintiffs allege that the patent application, by law, must contain the name of the patent applicant. First Am. Compl. ¶ 15. But although a name or similar identifying information is a necessary part of a Privacy Act record, it is not sufficient on its own to create a record. Information is only covered by the Privacy Act if it is about the individual in question. In *Tobey*, the case files at issue contained “[t]he number and initials of the examiner assigned” to the case, and the NLRB retrieved information about the cases the plaintiff was handling by doing “a field search using [plaintiff’s] initials.” 40 F.3d at 471. But the examiner’s name and identification number were simply “part of the overall *case* information,” not information “about” the plaintiff. *Id.* Likewise, the mere presence of inventor names on patent applications does not transform the entire application file into a Privacy Act record.

SAWS flags and SAWS reports are, likewise, about patent applications, rather than inventors. The vast majority of reasons Plaintiffs note in their amended complaint for flagging an application under SAWS explicitly relate to specific characteristics of the *claimed invention*: claim scope, priority date, subject matter, potential economic impact, and the like. First Am. Compl. ¶¶ 24–25, 32. Such information is not analogous to information about a person’s medical, educational, financial, criminal, or employment history that Congress sought to protect when it limited the scope of the Privacy Act’s civil remedy provision to records “concerning any individual.” As is true of patent applications, it is not relevant for Privacy Act purposes that “SAWS reports contain . . . the patent applicant’s name” and that “SAWS reports can be and have been retrieved based on the identity of patent applicants.” *Id.* ¶¶ 34–35. The same facts were present in *Tobey*, and the Court nonetheless rejected Plaintiffs’ Privacy Act claims. And even if some of the reasons for flagging an application could be perceived as “pejorative” to inventors, *id.* ¶ 20, there is no Privacy Act claim when information that is not “about”

an individual could be used to draw unfavorable inferences or conclusions about that individual's work. *Fisher*, 934 F. Supp. at 470.

The First Amended Complaint also alleges that PTO flagged applications “based on the identity of the applicant or applicants.” First Am. Compl. ¶ 26. Unlike other SAWS categories described in the complaint, Plaintiffs do not quote any PTO document that states an applicant's identity alone could give rise to a SAWS flag, despite the PTO's extensive public disclosure of the sorts of conditions that could give rise to a SAWS flag. Naked assertions of this sort cannot advance a complaint past the motion-to-dismiss stage. *Iqbal*, 556 U.S. at 678. But even if a SAWS flag was initiated because a particular inventor or group of inventors were attached to an application, that flag or report would only become a Privacy Act record if it contained, or generated, a file of information “about” the inventors, as opposed to their patent applications. That is simply not the case here. According to Plaintiffs' own allegations, SAWS was created to identify “[patent] applications that, if issued, would generate high publicity or would potentially have a strong impact in the patent community.” First Am. Compl. ¶ 22. Plaintiffs do not allege what personal information about the *inventor*, as opposed to the *patent application*, is created by this flag such that it would fall under the ambit of the Privacy Act.

The First Amended Complaint also alleges that examiners were instructed to do research to prepare SAWS reports by, among other things, conducting Internet searches for “the invention, the inventors, and owner or assignee,” and that, “[a]ccordingly, information about the inventors, owners, and assignees of SAWS-flagged applications was included in SAWS reports.” *Id.* ¶ 33. But this conclusion does not follow from its premise. “[T]he factual basis for flagging applications” relates to the “subject matter” of the inventions, not the inventors. *Id.* ¶ 32. The complaint does not allege that PTO examiners used these Google searches to collect information about inventors, as opposed to

information about the subject matter of their inventions.<sup>2</sup> *Id.* ¶ 33. Because both SAWS flags and SAWS reports ultimately refer back to the “subject matter” of the invention itself, not the inventors personally, they do not contain the sort of information the Privacy Act is concerned about, and Plaintiffs claims must be dismissed.

**B. The Omission of SAWS Flags and Reports Is Not the “Proximate Cause” of any “Adverse Determination”**

One of the elements of a claim for damages under subsection (g)(1)(C) of the Privacy Act is that the agency’s reliance on the inaccurate records was the proximate cause of the adverse determination against an individual. A determination is “adverse” if it “result[s] in the denial of a right, benefit, entitlement, or employment by an agency which the individual could reasonably have been expected to have been given if the record had not been deficient.” *Privacy Act Implementation: Guidelines and Responsibilities*, 40 Fed. Reg. 28,949, 28,969 (July 9, 1975). Plaintiffs allege that the omission of SAWS information from patent application files of flagged applications “contributed to determinations by the PTO that were adverse to patent applicants whose applications were flagged under SAWS, including the SAWS flag itself, determinations affected by the SAWS flag, and denial of issuance of patent claims.” First Am. Compl. ¶ 75. While this formulation is somewhat opaque, Plaintiffs make clear elsewhere in the First Amended Complaint that their theory is that if PTO had

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<sup>2</sup> This point is more evident when the passage Plaintiffs appear to be relying on from PTO’s FOIA release regarding SAWS is quoted in full:

Upon agreement that the applications 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.

*See* Exhibit A, at 11–12.

included the information in the application files accessible to Plaintiffs, Plaintiffs could have “challenge[d] the flagging of [their] applications and the adverse consequences of the flagging, or even to dispute the factual basis for the PTO’s determination to flag applications.” *Id.* ¶¶ 1, 55, 58, 61.

The Privacy Act does not, however, provide a remedy for mishandling information in the abstract. For instance, in *Hubbard v. U.S. Env’tl Prot. Agency*, the plaintiff pursued a Privacy Act claim based on inaccurate statements contained in a “passover document” generated by an agency after it denied him employment. 809 F.2d 1, 3 (D.C. Cir. 1986). Although “the Privacy Act permits a federal job applicant to recover damages for an adverse personnel action actually caused by an inaccurate or incomplete record,” it was undisputed that the passover document was not prepared until *after* the decision not to hire the plaintiff was made. *Id.* at 5–6. That doomed the plaintiff’s Privacy Act claim: “although the hiring decision caused the passover document to be prepared, the passover document did not cause the hiring decision,” and the requisite causal relationship was not present. *Id.* at 6.

Plaintiffs make numerous allegations as to how the SAWS program unfairly prejudiced the prosecution of their patent applications. But Plaintiffs only have a Privacy Act damages claim for failure to maintain accurate records if PTO’s alleged failure to include SAWS information in their application files accessible to them proximately caused PTO to make an “adverse determination” regarding Plaintiffs. Plaintiffs claim that the SAWS flag designation itself, not the exclusion of information about that designation from the patent application file accessible to Plaintiffs, blocked an application from issuing, and that “SAWS flags thereby denied applicants their rights under the Patent Act.” First Am. Compl. ¶ 50. But the only harm Plaintiffs allege from the *omission* of SAWS information from patent application files is that Plaintiffs were unable to contest PTO’s classification of their patent applications as “sensitive” and avoid the delays and heightened scrutiny associated with the SAWS program. *Id.* ¶ 55. Since they could not contest the SAWS flag, Plaintiffs contend that the “omissions contributed to determinations by the PTO that were adverse to patent applicants whose

applications were flagged under SAWS, including the SAWS flag itself, determinations affected by the SAWS flag, and denial of issuance of patent claims.” *Id.* ¶ 75. Importantly, however, Plaintiffs do not claim that any of their patent applications were actually denied. The most they claim is that their applications have been delayed, and that they have been unable to challenge the flagging of their applications. *Id.* ¶¶ 3-4, 57-62.

These alleged harms fall well short of the “denial of a right, benefit, entitlement, or employment by an agency” necessary to constitute an “adverse determination.” Privacy Act Guidelines, 40 Fed. Reg. 28,949-01, 28,969 (July 9, 1975). For instance, in *Chambers v. U.S. Dep’t of Interior*, the Interior Department lost an employee’s performance appraisal, and the employee sued, alleging that the lost appraisal “had an ‘adverse effect’ in that it has ‘hampered [her] in her ability to apply for jobs in the federal government by the lack of a performance appraisal.’” 568 F.3d 998, 1007 (D.C. Cir. 2009). The D.C. Circuit held this was “not enough to make out a claim under subsection (g)(1)(C), which requires a specific ‘adverse determination’ resulting from an agency’s failure to maintain accurate records.” *Id.* And in *Fletcher v. U.S. Dep’t of Justice*, the plaintiff made a FOIA request for his grand jury indictment and arrest warrant in order to “challenge his conviction or assist in his . . . parole hearing,” but his case file had been destroyed decades prior to the request. 905 F. Supp. 2d 263, 265, 268 (D.D.C. 2012). He sought damages for the destruction of records under the Privacy Act, but this Court, applying *Chambers*, rejected the argument that he had sustained an “adverse determination,” holding that his “need[] [for] the information” to seek post-conviction remedies was “insufficient.” *Id.* at 268.

Even assuming the confidential nature of the SAWS program may have prevented Plaintiffs from disputing the classification of their patent applications and pretermittting the delay and additional layers of review attendant to SAWS review, prosecution delay and additional quality checks are not “adverse determinations.” At most, they are “adverse effects” of SAWS materials remaining



confidential. Plaintiffs attempt to recast these delays as “constructive denial of or objection to a patent application” in order to avoid this problem, First Am. Compl. ¶ 38, but a patent application that is under examination, even a SAWS flagged one, has not been denied, constructively or otherwise. It is simply undergoing prosecution.

Plaintiffs have no right to a decision on patentability within a certain time frame, or subject to a particular set of PTO procedures. In *Hyatt v. U.S. Patent & Trademark Off.*, 146 F. Supp. 3d 771 (E.D. Va. 2015), Mr. Hyatt brought an Administrative Procedure Act claim against PTO, alleging it had “unreasonably delayed final agency action on 80 of plaintiff’s approximately 400 pending patent applications.” 146 F. Supp. 3d at 773. The district court held there was “no agency action to compel, and therefore no need to assess whether delay was unreasonable, because PTO had fulfilled its statutory mandate of putting the applications under examination.” *Id.* at 780–86. Beyond that, “PTO is under no legal obligation to cause an expeditious—or even an efficient—examination of a patent application.” *Id.* at 783.<sup>3</sup> It is PTO’s role to determine “how to effectuate Congress’s goal [of effective review] as to a given claim set,” and “even if a court were to disagree with the PTO’s decision to cause an examination in a certain manner . . . that disagreement with the PTO’s decision is not sufficient, absent some contrary legal edict, to interfere with the agency’s process.” *Id.* at 784.

Accordingly, because the omission of SAWS flags and SAWS reports from Plaintiffs’ patent

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<sup>3</sup> Although not relevant to Plaintiffs’ failure to maintain accurate records claim, the SAWS flag or information itself does not lead to any “adverse determination.” The D.C. Circuit has been “skeptical” of efforts to categorize . . . preliminary assessments as “adverse determinations.” *See Deters v. U.S. Parole Comm’n*, 85 F.3d 655, 659 (D.C. Cir. 1996) (raising doubts that preliminary assessments of parole applications were “adverse determinations” when the assessment did not result in parole being granted, because the preliminary assessment was “a determination that the prisoner must follow the standard course and appear at a hearing” before parole could be granted, “not a decision to deny parole”). SAWS merely flagged patents for additional review prior to a final decision on the application, and was not a basis for ultimately denying or granting patent protection. As such, SAWS information “determines” nothing of legal significance under the patent laws, and does not meet the legal test for an “adverse determination.”

application files accessible to them is not a proximate cause of any adverse determination that could be the focus of a Privacy Act claim, Plaintiffs' claim for civil damages for failure to maintain accurate records must be dismissed.

## **II. Plaintiffs Fail to State a Claim Under § 552a(g)(1)(D)**

The First Amended Complaint alleges two claims pursuant to § 552a(g)(1)(D), which provides for civil remedies whenever an agency “fails to comply with any other provision of this section . . . in such a way as to have an adverse effect on an individual.” Plaintiffs allege that the SAWS program violates two agency requirements under the Privacy Act. First, Plaintiffs assert that SAWS created improper “record[s] describing how any individual exercises rights guaranteed by the First Amendment.” *Id.* § 552a(e)(7). Second, Plaintiffs claim that by collecting information on patent applications through Google searches, PTO violated the Privacy Act's requirement that agencies “collect information to the greatest extent practicable directly from the subject individual when the information may result in adverse determinations about an individual's rights, benefits, and privileges under Federal programs.” *Id.* § 552a(e)(2). As explained below, neither claim has merit.

### **A. The SAWS Program Does Not Violate § 552a(e)(7)**

Subsection (e)(7) of the Privacy Act provides that an agency maintaining a system of records shall “maintain no record describing how any individual exercises rights guaranteed by the First Amendment unless expressly authorized by statute or by the individual about whom the record is maintained or unless pertinent to and within the scope of an authorized law enforcement activity.” 5 U.S.C. § 552a(e)(7). Plaintiffs' claim fails as a matter of law for two independent reasons.

First, Plaintiffs fail to state a claim under § 552a(e)(7) for the same reason they fail to state a claim under § 552a(g)(1)(C): neither patent applications, nor SAWS data, constitutes a “record” under the Privacy Act. As explained above, other than the name of the inventor and the limited information about her collected through the inventor's oath, patent application files are about the purported

invention, not the inventor, and do not fall within the scope of the Privacy Act. SAWS flags do not add any information “about” the inventor to the patent file that is relevant for Privacy Act purposes, and as the First Amended Complaint concedes, SAWS reports are intended to describe why the “subject matter” of a flagged patent is concerning, because, among other reasons, it is “financially important,” “politically charged,” or could “raise legal or ethical objections.” First Am. Compl. ¶ 32.

Second, Plaintiffs fail to state a claim under § 552a(e)(7) because SAWS does not “describe[e] how any individual exercises rights guaranteed by the First Amendment.” Plaintiffs assert that the “filing of a patent application is the exercise of rights guaranteed by the First Amendment,” and that SAWS reports, by “describ[ing] patent applicants’ exercise of rights guaranteed by the First Amendment,” violate the Privacy Act. First Am. Compl. ¶¶ 83–84. But the patent system is a discretionary creation of Congress, which has the power under Article I to “secur[e] for limited Times to . . . Inventors the exclusive Right to their respective . . . Discoveries,” *see* U.S. Const. art. I, § 8, cl. 8. Making a filing with the government for patent protection is therefore a statutory right, and not one the First Amendment guarantees. PTO is aware of no case in which the filing of a patent was found to be an exercise of rights guaranteed by the First Amendment, or concluding that patent application files implicate section 552a(e)(7) of the Privacy Act, and this case should not be the first.

Moreover, even if one were to assume that seeking patent protection involves the exercise of First Amendment rights, SAWS data does not “describe the exercise of First Amendment rights” by inventors, nor do Plaintiffs explain what this allegation means. Rather, SAWS reports describe “the factual basis for flagging applications under SAWS,” which, as the First Amended Complaint alleges, is based on the “subject matter” of the patent application, not the First Amendment activities of the inventor. First Am. Compl. ¶ 32. The Privacy Act did not intend to capture such records. For instance, in *England v. Commissioner of Internal Revenue*, the Ninth Circuit agreed that IRS records labeling the plaintiff a “tax protestor” did not run afoul of § 552a(e)(7) because the “internally generated

reports relat[ed] to the filing of facially illegal returns.” 798 F.2d 350, 352 (9th Cir. 1986). Like the tax filings at issue in *England*, neither patent application files nor SAWS data implicate “the congressional concern behind subsection 552a(e)(7), to prevent ‘collection of protected information not immediately needed, about law-abiding Americans, on the off-chance that Government or the particular agency might possibly have to deal with them in the future.’” *Id.* (quoting *Clarkson v. Commissioner*, 678 F.2d 1372, 1375 (11th Cir. 1982)).

Plaintiffs’ complaint does not adequately allege that SAWS data constitutes records, and they cannot establish the dubious proposition that SAWS “describe[es] how any individual exercises rights guaranteed by the First Amendment.” Accordingly, the Court should dismiss Plaintiffs’ claim for maintenance of prohibited records concerning First Amendment rights (Count 3 of the First Amended Complaint).

**B. The SAWS Program Does Not Violate § 552a(e)(2)**

Section 552a(e)(2) requires federal agencies “to collect information to the greatest extent practicable directly from the subject individual when the information may result in adverse determinations about an individual’s rights, benefits, and privileges under Federal programs.” Plaintiffs allege that by collecting SAWS data through internet research, rather than the Plaintiffs directly, PTO has violated this provision. First Am. Compl. ¶¶ 89–92. Like Plaintiffs’ claim for failure to maintain accurate records under § 552a(g)(1)(C), this claim requires that the information at issue be the sort of information that “may result in adverse determinations,” that is, “the denial of a right, benefit, entitlement, or employment by an agency.” 40 Fed. Reg. at 28,961, 28,969; *see also Chambers*, 568 F.3d at 1007. And Plaintiffs must sustain an “adverse effect” as a result of this process. 5 U.S.C. § 552a(g)(1)(D). Plaintiffs cannot meet this requirement, as the complaint lacks allegations that describe how the Googling of information to complete a SAWS report, as opposed to collecting that information from Plaintiffs directly, has an adverse effect on Plaintiffs. Their rote conclusory

recitation of the statutory standard in paragraph 90 of the First Amended Complaint does not contain sufficient factual matter to survive a motion to dismiss. *Iqbal*, 556 U.S. at 678.

Plaintiffs' assertion that they are harmed by the collection of information through a Google search, rather than directly from them, is also difficult to square with the context of patent prosecution. PTO is bound to defend decisions to deny patent protection on the factual bases it discloses and relies upon. 35 U.S.C. § 132(a); *In re Applied Materials, Inc.*, 692 F.3d 1289, 1294 (Fed. Cir. 2012) ("The [Patent Trial and Appeal Board's] judgment must be reviewed on the grounds upon which the Board actually relied."). Plaintiffs' complaint fails to explain how they are harmed by PTO seeking information for SAWS reports from one source or another, as SAWS materials are confidential, deliberative, and not a basis for making the "adverse determination" of denying patent rights. It also fails to explain how collecting information for a SAWS report directly from the Plaintiffs would alter PTO's concerns about the sensitive nature of the claimed subject matter and the need for additional quality checks prior to a final decision from the patent examiner. *See Gard v. U.S. Dep't of Educ.*, 789 F. Supp. 2d 96, 109 (D.D.C. 2011) (granting summary judgment to defendant agency because Plaintiff "has not produced evidence to suggest how an interview with him would have altered the substance of his records in any way that would have averted the agency's decision to place him on administrative leave."). Accordingly, Count IV of Plaintiffs' First Amended Complaint should also be dismissed.

### **III. Plaintiffs' Claims for Declaratory Relief Should Be Dismissed**

In addition to their civil damages claims, Plaintiffs seek a declaration "that the PTO's omission of SAWS materials from patent application files violates the Privacy Act," invoking the Privacy Act and the Declaratory Judgment Act, presumably to prompt PTO to include SAWS materials in patent application files that were reviewed under the program. First Am. Compl. pg. 14 (prayer for relief); *see also id.* ¶¶ 78–80 (Count 2). This claim is also subject to dismissal because "the Privacy Act 'authorizes entry of injunctive relief in only two specific situations': (1) when an individual succeeds

in a suit for amendment of the individual's records pursuant to § 552a(g)(1)(A), and (2) when an individual succeeds in a suit for disclosure of agency records pursuant to § 552a(g)(1)(B). . . . 'In so doing, . . . the [Privacy] Act precludes other forms of declaratory and injunctive relief,' including such relief for suits under § 552a(g)(1)(C)." *Kursar v. Transp. Sec. Admin.*, 581 F. Supp. 2d 7, 19 (D.D.C. 2008) (quoting *Stephens*, 851 F.2d at 1463); *see also Christian v. Sec'y of the Army*, No. 11-0276, 2011 WL 345945, at \*1 (D.D.C. Jan. 31, 2011) (ordering that plaintiff's complaint requesting the correction of his military records be construed as an action under the Privacy Act because it "provides an adequate remedy for addressing plaintiff's claims" that displaces, *inter alia*, writs of mandamus and the Declaratory Judgment Act). As such, Count 2 is subject to dismissal, as are the general claims for "relief under the Privacy Act" scattered throughout the complaint to the extent that includes injunctive relief. First Am. Compl. ¶¶ 77, 78–80, 87, 92; *id.* ¶¶ B, E (prayer for relief).

#### **IV. Mr. Morinville Has Not Alleged His Claims Fall Within the Privacy Act's Statute of Limitations**

The Privacy Act employs a two-year statute of limitations from the date on which "the plaintiff knows or should know of the alleged violation." *Tijerina v. Walters*, 821 F.2d 789, 798 (D.C. Cir. 1987); *see also* 5 U.S.C. § 552a(g)(5). But the complaint at issue here does not contain sufficient factual allegations to establish that Mr. Morinville filed suit within this two-year window. Mr. Morinville alleges that he has had 26 patent applications pending before the PTO since February 2000, First Am. Compl. ¶ 3, but he does not provide any indication of when he learned that his patent applications were flagged under SAWS or when he was prevented from challenging the flagging. *See id.* ¶ 57–59. Because the complaint does not contain sufficient factual matter to establish Mr. Morinville satisfied the statute of limitations, particularly in light of the SAWS program being retired in 2015, it should be dismissed for failure to state a claim upon which relief can be granted as to Mr. Morinville.

**CONCLUSION**

For these reasons, the Court should grant PTO's motion and dismiss the First Amended Complaint with prejudice.

Dated: November 15, 2019

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# EXHIBIT A



Technology Center 2600  
Special Applications Warning System  
(SAWS)

This program applies to all pending applications, including Re-exams and applications being forwarded to the BPAI.

**REMINDER: 01/11/08**

**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 Re-exams and applications being forwarded to the BPAI.

**Purpose:**

The SAWS program is designed as an information gathering system to apprise various segments of the PTO of patent applications that include subject matter of special interest.

**Operational Overview:**

The SAWS program is based upon a tiered process of application identification. This approach utilizes the Examiner, the SPE, and the SAWS Panel (Reinhard Eisenzopf, Tommy Chin, John Peng, Krista Zele, Ken Wieder, Wellington Chin, Mike Horabik, TQASs). 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:

1. Examiner identification
2. SPE review/screening of Application information
3. SAWS Panel review/screening of Application information forwarded from the SPE
4. Director level review and forwarding

**1. Examination Identification.** In order to provide the broadest recognition of applications of interest, the 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 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 is intended to cast a broad net for cases of interest. It has been past practice that in many applications the examiner prepares the SAWS report at the time of allowance. However, in certain applications, the SAWS report is needed at other stages of prosecution:

- For Re-exams, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced.
- For applications being forwarded to the BPAI, the SAWS report should be prepared no later than the examiner's answer.
- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.

**2. 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 make a determination as to whether or not the Application should be forwarded to the SAWS Panel member who coordinates the SAWS program (currently Reinhard Eisenzopf). 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 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 Reinhard Eisenzopf, TQAS (Tommy Chin, 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 which have old effective filing dates (pre 6/8/1995, i.e. pre-Gatt) and claims of broad scope (submarines);
2. Applications with pioneering scope;
3. Applications dealing with inventions, which if issued would potentially generate extensive media coverage;
4. Applications which have objectionable or derogatory subject matter in the specification and/or drawing(s);
5. Applications having claims defining inventions which would endanger individuals, the environment, harm the security of our nation or threaten public safety;
6. Commissioner-ordered-re-exams, except those ordered because of prior art timely filed, but not Considered, before the patent issued, or for prior art submitted under 37CFR §1.501;
7. Applications claiming a method or apparatus to take a human life (e.g. suicide machine, abortion);
8. Applications claiming a motor or power plant, which is self sustaining (perpetual motion) or appears to violate the laws of physics (e.g. antigravity, faster than the speed of Light, etc.);
9. Applications claiming the prevention or curing of diseases which were previously considered Impossible to prevent or cure; and
10. Human cloning methods.
11. Re-examination cases in which:
  - Litigation involving the Supreme Court.
  - Litigation where the judgement on a patent was either favorable or unfavorable and a high dollar amount was awarded to either party.

- Technology/Companies that are recognized by the public and there is a high probability that the media would report it.

Technology Center 2100  
Sensitive Applications Warning System  
(SAWS)

**Introduction:**

This memo is intended to remind the Technology Center 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.**

**PROGRAM OVERVIEW:**

The SAWS program is designed to assist in processing of patent applications identified as claiming subject matter of special interest that, if issued, would potentially generate high publicity or would potentially have a strong impact in the patent community. It is also an information gathering system to apprise various segments of the USPTO of these patent applications.

As a program to assist in processing of patent applications, it is intended to ensure that the examination standards and guidelines are applied properly to such applications that include sensitive or noteworthy subject matter.

As an information gathering system, the SAWS program should be identifying applications that, if issued as a patent, would be controversial or noteworthy.

The initial identification of SAWS applications is performed by the examiners (may also include managers and classifiers). Therefore, it is important that examiners are well informed about this program and the identification criteria.

Independent of the SAWS program, examiners should be encouraged to bring to their supervisor's attention any application that raises issues that they are uncertain how to handle. **Supervisors are responsible for determining which applications proceed through the SAWS program versus those applications having other issues which are normally addressed by existing examination procedures and established examination guidelines.**

**Operational Overview:**

The SAWS program is based upon a tiered process of application identification. This approach utilizes the Examiner, the SPE, and the QAS Shop. Applications identified and verified as containing SAWS material are reported to the Group Directors for transmittal

to the Office of the Deputy Commissioner for Patent Operations or to the Board of Appeals. 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.

To maximize application identification, the following protocol has been developed:

1. Examiner case identification
2. SPE review/screening of Application information
3. QAS review/screening of Application information forwarded from the SPE
4. Director level review and forwarding

#### **1. Examiner case identification**

In order to provide the broadest recognition of applications of interest, the 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 below). **This list is non-exhaustive.** Examiners 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 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 QAS shop. 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 a case is to be reported as SAWS, the following information should be included in an email report that should be forwarded to the QAS Shop via Vincent Trans, Rehana Perveen, Brian L. Johnson, Kakali Chaki, Manorama Padmanbanabhan, or Gail Hayes.

|                                       |                    |
|---------------------------------------|--------------------|
| 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. **Secondary review**

Once submitted to the QAS shop, the report will be reviewed. If necessary, a panel will be convened to verify SAWS subject matter. 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.

At time of allowance the application must be forwarded to the QAS shop after counting or preferably before counting for a review to determine if sufficient examination resources have been expended in it's examination and that the claims are truly allowable. Applications identified as SAWS applications will be placed in a PALM Expo personal grouping entitled **SAWS-TC\_2100** preventing the mailing of the Notice of Allowance.

## **SAWS Application Identification Subject Matter**

### **Corps-wide Potential SAWS Subject Matter**

The following subject matter has been determined to be criteria for identifying potential SAWS applications throughout the Patent Corps.

1. **(Submarines)** Applications which have old effective filing dates (pre 6/8/1995, i.e. pre-GATT) and claims of broad scope;
2. **(Industry Forming)** Applications with pioneering scope;
3. **(Media Sensitive)** Applications dealing with inventions, which if issued would potentially generate extensive media coverage;
4. **(Objectionable/Derogatory Subject Matter)** Applications which have objectionable or derogatory subject matter in the specification and/or drawing(s);
5. **(Public Safety)** Applications having claims defining inventions which would endanger individuals, the environment, harm the security of our nation or threaten public safety;
6. **(Commissioner Order Rexams)** Commissioner-ordered re-exams, 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;
7. **(Taking a Human life)** Applications claiming a method or apparatus to take a human life (e.g. suicide machine, abortion);

8. **(Violates the laws of physics)** Applications claiming a motor or power plant which is self-sustaining (perpetual motion) or appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.);
9. **(Miracle Cures)** Applications claiming the prevention or curing of diseases which were previously considered impossible to prevent or cure;
10. **(Human Cloning)** Human cloning; and
11. **(High Profile Reexams)** Reexams on patents that have hit the news already or are likely to or have had litigation involving high dollars or the Supreme Court has decided on a related case.

#### **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) **(Business Methods)** Applications reciting business methods;
  - 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 or Trademark Processes or Systems)** Applications reciting a processes that PTO employees or IP attorneys practice, or a system the PTO or IP attorneys use.



## TC 2100 SAWs Template Review

Serial No: \_\_\_\_\_ Date Returned to SPE: \_\_\_\_\_  
 Art Unit: \_\_\_\_\_ Date Reviewed: \_\_\_\_\_

SPE Initials If Agree      Reviewer Comment

### 1. Reasons for Allowance:

\_\_\_\_\_ Clear statement of Reasons for Allowance  
 \_\_\_\_\_ Indicate how claims distinguish over the closest prior art  
 \_\_\_\_\_ Claim groups of differing scope having a separate RFA

Comments: \_\_\_\_\_

### 2. Search Areas and Tools:

\_\_\_\_\_ US Classified Search  
 \_\_\_\_\_ US Patents Text Search - EAST/WEST and/or STN USPATFULL  
 \_\_\_\_\_ Foreign Patent Documents – WEST/Derwent WPI and/or Epoque II  
 \_\_\_\_\_ NPL Search – PTO NPL, Dialog, STN, etc.  
 \_\_\_\_\_ Internet Sites – (optional)

Comments: \_\_\_\_\_

### 3. Search Query:

\_\_\_\_\_ Text Search – Strategy to search concepts/key words  
 \_\_\_\_\_ Separate strategies for each search area (US, Foreign, NPL)  
 \_\_\_\_\_ Recordation of Search in file wrapper with annotation

Comments: \_\_\_\_\_

### 4. Reference Citations:

\_\_\_\_\_ Best art in each category (US, Foreign, NPL) listed on 892 or 1449  
 \_\_\_\_\_ Clear indication of why the reference was cited

Comments: \_\_\_\_\_

### 5. Other Problems:

\_\_\_\_\_ Sensitive Application Warning system issues  
 \_\_\_\_\_ Broad claims  
 \_\_\_\_\_ 35 USC 101 issues

Comments: \_\_\_\_\_

Other: \_\_\_\_\_

***Please Complete and Return This Sheet To The QAS Box After Disposition***



Must be within **2 weeks** of receiving QAS comments

Disposition Date: \_\_\_\_\_

Disposition  
(Check one)



Reopened

Sent to Pubs

Other - Explain \_\_\_\_\_

# Technology Center 1600

## Sensitive Application Warning System (SAWS)

UPDATED: December 2014

### 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 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 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, 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.



UNITED STATES PATENT and TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND  
TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
WWW.USPTO.GOV

DATE: August 20, 2001

TO: Esther M. Kepplinger  
Deputy Commissioner for Patent Operations

FROM: Jasemine C. Chambers  
Director, Technology Center 1600  
Coordinator, Sensitive Applications Warning System (SAWS)

RE: Status Report on Efforts to Revitalize SAWS

Per your earlier request, I have taken the following steps toward revitalizing the SAWS program:

- Met with representatives from all Technology Centers (TC) to brainstorm ideas for improving the SAWS procedures originally outlined by Deputy Commissioner for Patent Examination Policy Stephen Kunin in his memo to former Commissioner Bruce Lehman (see Attachment A).
- Proposed revised SAWS procedures that incorporated input from all TC representatives. The proposal also included an updated list of corps-wide SAWS criteria as well as lists of TC-specific SAWS criteria. See Attachment B.
- Submitted the issue of release of SAWS materials under the FOIA to Deputy General Counsel Bernard Knight for analysis. The DGC's analysis was set forth in a memo dated May 23, 2001. See Attachment C.
- Instructed members of the SAWS committee to continue with their existing TC practices for identifying and monitoring potential SAWS applications, and to raise examiners' awareness of the SAWS program by issuing quarterly reminders.

Attachments: Memorandum by Stephen Kunin dated January 14, 1994  
Revised SAWS Procedures recommended by the SAWS Committee  
Memorandum by Bernard Knight dated May 23, 2001  
List of SAWS Committee members as of August 2001

## **ATTACHMENT B: REVISED SAWS PROCEDURES**

### **SUMMARY:**

- I. Operational Overview
  - A. Potential SAWS Subject Matter
  - B. Technology Center Recommended Practices
- II. Miscellaneous Issues
  - A. Pre-Grant Publication (PG-PUBS)
  - B. Freedom of Information Act (FOIA)
- III. Appendix A: SAWS Application Identification Subject Matter
- IV. Appendix B: SAWS Application Processing Guidelines
- V. Appendix C: Proposed SAWS Database

### **I. OPERATIONAL OVERVIEW:**

It is recommended that the SAWS program be based upon a tiered process of application identification. This approach utilizes the Examiner, the SPE, and in some technology centers a SAWS screening committee comprised of SPEs drawn from across that Technology Center. Applications which are identified and verified as containing SAWS material by a TC SAWS screening committee or other TC specific mechanism are reported to the SAWS Coordinator quarterly, or as needed, for transmittal to the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy.

#### **A. Potential SAWS Subject Matter**

The following subject matter has been identified as criteria, which will assist in identifying potential SAWS applications throughout the Patent Corps.

1. Applications which have old effective filing dates but claims of broad scope (submarines);
2. Applications with extremely broad or pioneering scope;
3. Applications dealing with inventions subject to extensive media coverage;
4. Applications which have objectionable or derogatory subject matter in the specification and/or drawing(s);
5. Applications having claims defining inventions which would endanger individuals, public safety or the environment;
6. Commissioner-ordered re-exams;
7. Applications claiming a business method [add definition];

8. Applications claiming a method or apparatus to take a life (e.g. suicide machine, abortion);
9. Applications claiming a motor or power plant which is self-sustaining (perpetual motion) or appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.);
10. Applications in which a third party (usually unnamed) takes over prosecution of patent application (not owner, assignee/licensee or inventor);
11. Applications claiming the prevention, treatment or curing of diseases which were previously considered impossible to prevent or cure; and
12. Applications involving bioinformatics and contain sensitive material (biotechnology in combination with computer technology).

**B. Technology Center Recommended Practices:**

- 1) Examiners should be the first line of review since they will be the most knowledgeable about the pending claims and application issues. Examiners will report suspected SAWS cases to their SPE. Upon approval of the SPE, a person designated by the technology center will enter the SAWS case into the database.
- 2) Quarterly reminders to examiners help to affirm the importance of SAWS application identification.
- 3) Flagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed.
- 4) Utilizing a TC specific screening method to remove non-sensitive applications from SAWS designation. (This step may not be needed if it is decided that the database will contain all potential SAWS cases.)
- 5) Utilizing a SPRE and/or QAS for uniformity and process improvements.
- 6) Generating a single database that contains potential SAWS applications for the entire patent corps.
- 7) Utilizing Classifiers to place a PALM Flag on subject classes which encompass sensitive subject matter until a review of these cases is performed upon allowance (such as business methods, class 705).

**1 & 2) Examiner as First Line of Review**

Utilizing the Examiner as the first line of review will ensure that the SAWS identification process is continual in nature and that 100% of applications within the Patent Corps are reviewed under the processing guidelines set forth below in Appendix B. Appendix A, which identifies potential SAWS subject matter throughout the Patent Corps will be distributed to each examiner to

assist the examiner in identifying SAWS applications. Additionally, quarterly reminders to examiners helps to ensure that examiners continually remember to keep abreast of SAWS issues and report potential SAWS cases to their SPE. Once identified, the technology appointed designee will enter the application into a SAWS database (see Appendices B & C).

**3) PALM Flag**

Utilizing a PALM flag will assure that applications that have been identified as potential SAWS applications have been reported to the appropriate segments of the PTO prior to issuance of the application.

**4) Screening Mechanism**

Each technology center will devise a screening mechanism to review SAWS applications entered into the SAWS database. This screening mechanism permits a second review and will result in a recommendation as to whether the application contains SAWS subject matter. The screening mechanism can be a committee made up of SPEs representing a cross section of the Technology Center and could include a SPRE or a QAS. The chairperson of this screening committee is responsible for collection of the application reports, dissemination of such to the committee members, and transmittal of the final report to the SAWS Coordinator.

**5) Quality Assurance**

A SPRE and/or a QAS from each TC should be appointed to periodically review the SAWS processing guidelines and criteria (set forth in Appendix B) to continually update and revise the program as needed. This quality assurance may be most easily dealt with as being incorporated into the screening committee set forth above.

**6) Patent SAWS Database**

A SAWS database will permit access to the appropriate parties to search for application information on SAWS applications/patents using a keyword searching platform. Further information on the database is set forth below.

**II. MISCELLANEOUS ISSUES**

**A. Pre-Grant Publication**

Pre-grant publication should not warrant special SAWS consideration. Pre-grant publication will be publication of the application as filed. This



application is, therefore, a pending US application for which the USPTO should not be commenting on. Additionally, the claims, which are published, have not gone through any examination consideration and there is no indication that the claims as published will bear any resemblance to the claims as issued in a US Patent.

It is noted that the Pre-grant publication issue is similar to PCT applications filed under 37 C.F.R. § 1.371 which have not raised any increased interest from the public.

**B. Freedom of Information Act (FOIA) and the SAWS Database<sup>1</sup>**

(b) (5)



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<sup>1</sup> See Attachment C: Memorandum by Bernard Knight on the Release of SAWS Material under FOIA.

## **Appendix A: SAWS Application Identification Subject Matter**

### **Generally:**

- 1) Applications which have old effective filing dates but claims of broad scope (submarines);
- 2) Applications with extremely broad or pioneering scope;
- 3) Applications dealing with inventions subject to extensive media coverage;
- 4) Applications which have objectionable or derogatory subject matter in the specification and/or drawing(s);
- 5) Applications having claims defining inventions which would endanger individuals, public safety or the environment;
- 6) Commissioner-ordered re-exams;
- 7) Applications claiming a business method [add definition];
- 8) Applications claiming a method or apparatus to take a life (e.g. suicide machine, abortion);
- 9) Applications claiming a motor or power plant which is self-sustaining (perpetual motion) or appears to violate the laws of physics physics (e.g. antigravity, faster than the speed of light, etc.);
- 10) Applications in which a third party (usually unnamed) takes over prosecution of patent application (not owner, assignee/licensee or inventor);
- 11) Applications claiming the prevention, treatment or curing of diseases which were previously considered impossible to prevent or cure claimed; and
- 12) Applications involving bioinformatics and contain sensitive material (biotechnology in combination with computer technology).
- 13) Applications containing inventions which on its face seem trivial, mundane or extremely basic.
- 14) Re-issues, Re-exams and Litigation involved in the Examination.
- 15) Applications claiming illegal drugs, or materials involving drug paraphernalia.

### **Technology Center Specific Subject Matter:**

**TC1600**      **Contact: Brian Stanton (308-2801), Karen Hauda (305-6608); Johann Richter (308-4532), or Robert Hill (308-4314)**

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

- AIDS diagnostics and treatments
- alternative medicine/homeopathy
- cells/cell lines from indigenous peoples
- cloning of humans
- expressed sequence tags (ESTs)
- fetal cell or fetal tissue based invention
- germline gene therapy
- human/large animal chimeras
- human embryonic stem cell technology
- human tissue or organ
- *in utero* therapy, including *in utero* gene therapy
- single nucleotide polymorphisms (SNPs)
- methods or compositions for prolonging life or preventing aging
- plant, plant extract or plant product from plant native to 3rd world country claimed
- plant terminator technology
- bioinformatics and computer based inventions
- business methods

2) Applications claiming the prevention, treatment or curing of diseases which were previously considered impossible to prevent or cure, such as:

- Alzheimer's disease
- many forms of cancer
- common cold
- dementia
- mental retardation
- viral infection
- somatic cell based animal cloning

3) Compounds/Compositions claimed only by their properties with no exemplary showings of structure or constituents.

**TC 1700**      **Contact: Bill Krynski (308-2376), Upendra Roy (308-0843)**

1) Compounds/Compositions claimed only by their properties with no exemplary showings of structure or constituents.

**TC 2100      Contact: Jack Harvey (305-9705)**

- 1) Applications in which the preamble recites: "a program embodied on a computer readable medium for"
- 2) The concept of online business practices and software including the fields of:
  - banking/finance
  - coupon redemption
  - auctions
  - e-commerce or electronic shopping in general, such as those associated to selling a product, i.e. Amazon.com
  - point of sale terminals
  - on-line credit

**TC 2600      Contact: Tommy Chin (305-4715)**

- 1) Applications claiming communication with the dead
- 2) Subject matter encompassing unusual transmission medium - e.g. rock, mirror, brain wave, gravitational wave and faster than light wave
- 3) Applications involving internet communications comprising the following:
  - making telephone/Fax calls over the internet
  - requesting a telephone callback
  - wireless remote access to internet

**TC 2800      Contact: Hien Phan (308-7502), Clayton LaBalle (308-0519)**

- 1) Applications claiming:
  - perpetual motion machines
  - antigravity machines
  - room-temperature superconductivity
  - free energy, "tachyons", etc.
  - general violations of the laws of physics

**TC 3600      Contact: Randy Reese (308-2121), Ken Dorner 9308-0866), or Steve Meyers (308-3868), Dave Mitchell (308-0361), Terry Melius (308-2171)**

- 1) Applications encompassing cold fusion as an energy source.
- 2) Applications with special Licensing and Review issues (e.g., disputes with DOD or DOE.)

**TC 3700      Contact: Paul Sewell (308-2126), Hank Recla (308-1382) or  
Michael Buiz (308-0871), Cliff Crowder (308-0949)**

- 1) Applications involving or claiming the following:
  - antigravity machines
  - perpetual motion machines
  - applications reciting “faster than the speed of light”
  - surgical applications involving a fetus
  - applications containing devices for sexual activity
  - heating devices which are purported to cure disease or cause weight loss

**Jasemine Chambers (308-2035) or Brian Hearn (305-1820) may also be contacted with SAWS questions.**

## **Appendix B: Processing Guidelines**

### **1) Examiner Case Identification**

In order to provide the broadest recognition of applications of interest, the Examiners have been 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. Examiners 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 is intended to cast a broad net for cases of interest.

The Examiners should report the case information to their immediate Supervisory Patent Examiner.

### **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 contact the technology center designee to have the case information entered into the SAWS database (see appendix C for database contents) and should then forward the case to the SAWS committee.

The technology center designee should include the following information in the database:

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

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. The SPE then forwards the completed/updated data entry form to a mailbox that has been established and dedicated for SAWS information.

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.

If the SPE determines that the application contains SAWS subject matter, the SPE should flag the case as a SAWS case in PALM.

If a SAWS case is ready to be allowed, and a flag has been placed on the application, the SPE should take the case to a PALM troubleshooter. The PALM troubleshooter should remove the flag so the case can be processed for allowance and either the PALM troubleshooter or the SPE should notify the appropriate SAWS point of contact set up by the TC. This person will notify the SAWS Coordinator that the allowed application is a SAWS application. It is noted this procedure will not hold up Examiner's counts and, therefore, should avoid any POPA issues.

### **3) SAWS review/screening of Application information forwarded from the SPE**

Once submitted to the SAWS mailbox, the chairperson of the TC SAWS screening committee will compile the individual SAWS reports for consideration by the SAWS screening committee.

The SAWS screening committee should meet as necessary to review the application data reports and make a recommendation as to whether the application contains SAWS information. The screening committee will be formed pursuant to technology specific needs, but can be made up of SPEs representing a cross section of the Technology Center and include a SPRE or a Quality Assurance member. The chairperson of this committee is responsible for collection of the application reports and dissemination of such to the SAWS Coordinator.

Designation of an application as "SAWS" is arrived at after review of all available information. If necessary, the application will be physically reviewed and the examiner and/or SPE consulted. Following any discussion, the members of the SAWS screening committee will be polled. A single affirmative vote is sufficient to designate an application as falling under the SAWS designation.

Each month, or as necessary, the data for those applications will be forwarded to the SAWS Coordinator.

### **4) Director level review and forwarding**

Once the SAWS application reports are collated within the TC in electronic form, the screening committee chair may forward the report to the Group Directors for review. Following such review (if desired), the reports will be forwarded to the SAWS Coordinator who will forward the report to the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy.

### **Appendix C: The SAWS Database**

The SAWS database will include the following:

- 1) A PALM information retrieval section that will automatically insert the following information once an Application Serial Number or Patent Number is entered:
  - a) Serial Number/Patent Number
  - b) Filing Date
  - c) Applicant's name(s)
  - d) Assignee Information
  - e) Priority document information
  - f) Continuation or related applications that are currently present in the PALM data screen
  - g) Correspondence address
  - h) Attorney(s) name(s) and Docket number
  - i) Foreign Application Data
- 2) In addition, fields will be included for:
  - a) A sample claim or claims,
  - b) A statement of technical impact, and
  - c) A statement of reason for public interest
- 3) For Administrative purposes, the following check fields should be considered for tracking SAWS case review
  - a) Review by SPE
  - b) Review by TC representative
  - c) Review by Director
  - d) Designation as SAWS application
  - e) Transmitted to Reviewing authority
- 4) The Database development should also include a provision for a one (1) page printout of all pertinent information that is formatted such that the information is easily assimilated.
- 5) The Database should include a keyword entry field and search capability which permit identification of applications directed to a particular subject matter.

Given the substance of the information to be entered and stored, the database used for SAWS tracking purposes should include a provision for limited access and security such that only designated individuals (Technology Center Director level and their designates) will have unrestricted access.



**ATTACHMENT D: LIST OF SAWS COMMITTEE MEMBERS**

**Technology Center 1600**

Brian Stanton  
Karen Hauda  
Robert Hill  
Johann Richter

**Technology Center 1700**

Bill Krynski  
Upendra Roy

**Technology Center 2100**

Jack Harvey

**Technology Center 2600**

Tommy Chin

**Technology Center 2800**

Hien Phan  
Clayton LaBalle

**Technology Center 3600**

Randy Reese  
Ken Dorner  
Steve Meyers  
Dave Mitchell  
Terry Melius

**Technology Center 3700**

Paul Sewell  
Hank Recla  
Michael Buiz  
Cliff Crowder

**Office of Petitions**

Brian Hearn

### **SAWS Application Identification Subject Matter**

#### **General Corps-wide:**

- 1) Applications which have old effective filing dates but claims of broad scope (submarines);
- 2) Applications with extremely broad or pioneering scope;
- 3) Applications dealing with inventions subject to extensive media coverage;
- 4) Applications which have objectionable or derogatory subject matter in the specification and/or drawing(s);
- 5) Applications having claims defining inventions which would endanger individuals, public safety or the environment;
- 6) Commissioner-ordered re-exams;
- 7) Applications claiming a business method [add definition];
- 8) Applications claiming a method or apparatus to take a life (e.g. suicide machine, abortion);
- 9) Applications claiming a motor or power plant which is self-sustaining (perpetual motion) or appears to violate the laws of physics physics (e.g. antigravity, faster than the speed of light, etc.);
- 10) Applications in which a third party (usually unnamed) takes over prosecution of patent application (not owner, assignee/licensee or inventor);
- 11) Applications claiming the prevention, treatment or curing of diseases which were previously considered impossible to prevent or cure claimed; and
- 12) Applications involving bioinformatics and contain sensitive material (biotechnology in combination with computer technology).
- 13) Applications containing inventions which on its face seem trivial, mundane or extremely basic.
- 14) Re-issues, Re-exams and Litigation involved in the Examination.
- 15) Applications claiming illegal drugs, or materials involving drug paraphernalia.

**Technology Center Specific Subject Matter:**

**TC1600      Contact: Brian Stanton (308-2801), Karen Hauda (305-6608); Johann Richter (308-4532), or Robert Hill (308-4314)**

- 1) Applications claiming subject matter which are controversial and/or newsworthy, for example:
  - AIDS diagnostics and treatments
  - alternative medicine/homeopathy
  - cells/cell lines from indigenous peoples
  - cloning of humans
  - expressed sequence tags (ESTs)
  - fetal cell or fetal tissue based invention
  - germline gene therapy
  - human/large animal chimeras
  - human embryonic stem cell technology
  - human tissue or organ
  - *in utero* therapy, including *in utero* gene therapy
  - single nucleotide polymorphisms (SNPs)
  - methods or compositions for prolonging life or preventing aging
  - plant, plant extract or plant product from plant native to 3rd world country claimed
  - plant terminator technology
  - bioinformatics and computer based inventions
  - business methods
- 2) Applications claiming the prevention, treatment or curing of diseases which were previously considered impossible to prevent or cure, such as:
  - Alzheimer's disease
  - many forms of cancer
  - common cold
  - dementia
  - mental retardation
  - viral infection
  - somatic cell based animal cloning
- 3) Compounds/Compositions claimed only by their properties with no exemplary showings of structure or constituents.

**TC 1700      Contact: Bill Krynski (308-2376), Upendra Roy (308-0843)**

- 1) Compounds/Compositions claimed only by their properties with no exemplary showings of structure or constituents.

**TC 2100      Contact: Jack Harvey (305-9705)**

- 1) Applications in which the preamble recites: "a program embodied on a computer readable medium for"
- 2) The concept of online business practices and software including the fields of:
  - banking/finance
  - coupon redemption
  - auctions
  - e-commerce or electronic shopping in general, such as those associated to selling a product, i.e. Amazon.com
  - point of sale terminals
  - on-line credit

**TC 2600      Contact: Tommy Chin (305-4715)**

- 1) Applications claiming communication with the dead
- 2) Subject matter encompassing unusual transmission medium - e.g. rock, mirror, brain wave, gravitational wave and faster than light wave
- 3) Applications involving internet communications comprising the following:
  - making telephone/Fax calls over the internet
  - requesting a telephone callback
  - wireless remote access to internet

**TC 2800      Contact: Hien Phan (308-7502), Clayton LaBalle (308-0519)**

- 1) Applications claiming:
  - perpetual motion machines
  - antigravity machines
  - room-temperature superconductivity
  - free energy, "tachyons", etc.
  - general violations of the laws of physics

**TC 3600      Contact: Randy Reese (308-2121), Ken Dorner 9308-0866), or Steve Meyers (308-3868), Dave Mitchell (308-0361), Terry Melius (308-2171)**

- 1) Applications encompassing cold fusion as an energy source.

- 2) Applications with special Licensing and Review issues (e.g., disputes with DOD or DOE.)

**TC 3700      Contact: Paul Sewell (308-2126), Hank Recla (308-1382) or Michael Buiz (308-0871), Cliff Crowder (308-0949)**

- 1) Applications involving or claiming the following:
  - antigravity machines
  - perpetual motion machines
  - applications reciting “faster than the speed of light”
  - surgical applications involving a fetus
  - applications containing devices for sexual activity
  - heating devices which are purported to cure disease or cause weight loss



## LMR Issues

1. *Is this a new or revised program?*  
No. The SAWS program has formally be in place since Jan. 14, 1994 memo.
2. *Is asking examiners to be aware of the listed SAWS issues and to notify their supervisor a new duty?*  
No, it has been a part of the SAWS program since it's inception. It only requires an examiner to bring the case to the attention of their supervisor. Any impact would be *de minimus*.
3. *Why did the TC1600 SAWS email (March 22, 2001) refer to the program as "interim"?*  
The term "interim" was in reference to the process of supervisory review, not in reference to any change in the requirement of examiners to bring such cases to the attention of their supervisor.
4. *Does identifying a case under SAWS delay the examiner's counts?*  
Not normally. Any review occurs during prosecution and does not normally delay the counting.
5. *Does identifying a case under SAWS put a case under more supervisory scrutiny?*  
It does create an additional level of review. However, every application has a unique set of facts that needs to be analyzed. It is well-established practice that certain applications have more complex issues that require consultation and assistance. The ultimate purpose is to ensure a proper examination and handling of sensitive cases.
6. *What if an examiner identifies a SAWS case and then participates in a meeting (s) to discuss the issues. Will they get other time?*  
It is up to the supervisor to determine any reasonable other time.

**TC Procedures Currently in Place (3/12/02)**

- TC1600
  - Emails a Quarterly reminder to all examiners and SPEs
  - That reminder includes a listing of SAWS sensitive subject matter
- TC1700
  - Handed out a listing of SAWS sensitive subject matter January 2002
  - SPEs reminded at staff meetings at least Quarterly
- TC2100
  - Focus has been on Business Methods, all subject to 2nd pair of eyes review
  - For non-business methods issues, SAWS program discussed verbally
  - Working on a TC SAWS memo for distribution
  - Will start reminder memos twice yearly
- TC2600
  - QAS reminders SPEs verbally at Quarterly meetings
  - SPEs asked to remind examiners Quarterly
  - Directors verbally announced SAWS program at all-employee State-of-TC meeting on Jan. 2002
  - No written memo has been issued
- TC2800
  - SPEs reminded at least twice a year
  - No written memo to examiners
- TC3600
  - SPEs reminded at staff meetings, expect them to disseminate to examiners
  - Hasn't been done on a regular basis
  - SAWS procedures specifically related to Business Methods claims has been developed
- TC3700
  - All examiners given SAWS reminder last year in conjunction with 101 training, including listing of SAWS sensitive subject matter
  - TC SAWS reps supposed to give SPEs quarterly reminder, who will give examiner verbal reminder.
  - No written memo to examiners being used as a reminder



# 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 (Bill Krynski) 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 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.

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.

- ❖ 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 un-named, 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)

- ❖ Applications specifying race in the claims
- ❖ Applications identified as containing claims which would be subject to a 101 rejection in view of the Mayo or Myriad decisions
- ❖ 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.



Commissioner for Patents  
Washington, DC 20231  
[www.uspto.gov](http://www.uspto.gov)

DATE: February 06, 2003

TO: TC 2800 managers

FROM: Janice A. Falcone, Group Director  
Sharon Gibson, Group Director  
Howard N. Goldberg, Group Director  
Richard K. Seidel, Group Director  
Arthur T. Grimley, Acting Group Director

SUBJECT: TC 2800 Guidelines for Sensitive Application Warning System (SAWS)  
Program Reminder

Technology Center 2800 has in place a SAWS program based on the following guidelines. All TC 2800 managers must remind their examiners of this program and its implementation.

- I. Program Overview
- II. Operational Overview
  - A. Technology Center 2800 Practice
  - B. SAWS subject matter in TC 2800

#### **I. PROGRAM OVERVIEW:**

The SAWS program was designed to assist in processing of patent applications identified as claiming subject matter of special interest that, if issued, would potentially generate high publicity or would potentially have a strong impact in the patent community. It is also an information gathering system to apprise various segments of the USPTO of these patent applications.

As a program to assist in processing of patent applications, it is intended to ensure that the examination standards and guidelines are applied properly to such applications that include sensitive or noteworthy subject matter.

As an information gathering system, the SAWS program should identify applications that, if issued as a patent, would be controversial or noteworthy.

The initial identification of SAWS applications is performed by the examiners (may also include managers and classifiers). Therefore, it is important that examiners stay informed about this program and the identification criteria.

**Independent of the SAWS program, examiners should be encouraged to bring to their supervisor's attention any application that raises issues that they are uncertain how to handle.** Supervisors are responsible for determining which applications proceed through the SAWS program versus those applications having other issues which are normally addressed by existing examination procedures and established examination guidelines.

## **II. OPERATIONAL OVERVIEW:**

TC 2800 handles the SAWS program based upon a tiered process of application identification. This process relies on Examiners and SPEs to identify these applications, and a SAWS screening committee to verify their status. The SAWS screening committee comprises the home SPE, at least one of the following managers in the TC 2800 Quality Center: Cassandra Spyrou, Clayton LaBalle and Hien H. Phan, and another TC 2800 management official.

Applications which have been identified and verified as containing SAWS material are reported the TC Group Directors, and as needed, forwarded to the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy prior to allowance.

### **A. Technology Center 2800 Practice:**

1. Examiners are the first line of review since they are the most knowledgeable about the pending claims and application issues. Examiners will report potential SAWS applications to their SPE. Upon approval of the SPE, the case will be brought by the SPE to Clayton LaBalle, Cassandra Spyrou or Hien H. Phan for entering the SAWS application number into the TC 2800 tracking system.
2. Flagging an identified SAWS application in PALM to ensure that the application cannot be issued until the flag has been removed.
3. TC 2800 has established a screening mechanism to remove non-SAWS applications from their SAWS designation. This screening mechanism permits a second review and will result in a recommendation as to whether the application contains SAWS subject matter. The SAWS screening committee will perform the screening mechanism.

4. Applications that have been through the TC screening mechanism and have been identified as SAWS applications will be brought to the attention of the TC Group Directors. The Group Director will bring them to the attention of the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy.
5. For uniformity and process improvements, a SPRE, QAS, or a SAWS TC-screening committee must be utilized. A SPRE, QAS, or a SAWS TC-screening committee will be tasked to periodically review the SAWS processing guidelines and criteria to continually update and revise the program as needed.
6. Placing a PALM Flag on subject classes, which encompass sensitive subject matter until a review of these cases is performed upon allowance (such as business methods, class 705).
7. A reminder and an updated SAWS criteria list will be distributed, at least semi-annually, to examiners to stress the importance of SAWS application identification. All newly hired examiners should be made aware of this TC 2800 SAWS program

**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. Other matters that violate the general laws of physics.
6. Applications containing claims to subject matter which, if issued, would generate unfavorable publicity for the USPTO.



## BOARD OF PATENT APPEALS AND INTERFERENCES

### STANDARD OPERATING PROCEDURE 8

#### ASSIGNMENT OF JUDGES TO EX PARTE MERITS PANELS

This Standard Operating Procedure (SOP) describes the process by which judges are assigned to merits panels in *ex parte* appeals by the Chief Judge's designee(s).

This Standard Operating Procedure creates internal norms for the administration of the Board of Patent Appeals and Interferences (Board) and complements Standard Operating Procedure 1 (SOP 1), *Assignment of judges to merits panels, motions panels, and expanded panels*. It does not create any legally enforceable rights.

#### I. Chief Judge's Authority to Delegate

The Director's authority under 35 U.S.C. § 6 to designate panels has been delegated to the Chief Judge. *See Manual of Patent Examining Procedure* § 1002.02(f) (8th ed., rev.6, September 2007).

#### II. Chief Judge's Designee(s)

A. At the discretion of the Chief Judge, at least one employee, hereinafter designee, may be delegated the task of assigning merits panels (designations under 35 U.S.C. § 6) to *ex parte* appeals at such times as the Chief Judge deems appropriate.

B. Employees selected to serve as designees will be notified of their selection by the Chief Judge.

C. The delegation to a designee of the task of assigning merits panels is a temporary delegation and is for a time period within the discretion of the Chief Judge.

D. Designee(s) will become familiar with the guidance of SOP 1.

E. Designee(s) will follow the assignment guidance provided by the Working Document accompanying this SOP.

F. At all times, the Chief Judge has the discretion to limit or expand the scope of a designee's delegation.

### III. Discipline Reviewer

A. The Chief Judge has the discretion of appointing at least one employee to review ex parte appeals in a discipline to facilitate the assignment process, at such times as the Chief Judge deems appropriate.

B. Employees selected to serve as discipline reviewers will be notified of their selection by the Chief Judge.

C. The appointment to serve as a discipline reviewer is temporary and is for a time period within the discretion of the Chief Judge.

D. Discipline reviewers are to become familiar with the issues of interest to the Chief Judge.

E. Designee(s) are to follow the assignment guidance provided by the accompanying Working Document.

F. At all times, the Chief Judge has the discretion to limit or expand the scope of the tasks to be performed by a discipline reviewer.

## **ASSIGNMENT OF JUDGES TO EX PARTE MERITS PANELS**

### **WORKING DOCUMENT**

#### **Assignment of On Brief Cases**

##### **I. Delegations**

A. The following employees are designated as Discipline Reviewers for the purposes of reviewing the ex parte appeals:

1. Dale Shaw- Communications/Electrical
2. Paul Edgell- Mechanical/Business methods
3. Krista Zele- Computer
4. Merrell Cashion- Chemical/Biotech

B. The following employees (designees) are delegated the task of assigning merits panels to ex parte appeals:

The Chief Appeals Administrator, Deputy Chief Appeals Administrator, Appeals Manager and Discipline Lead Paralegals under the supervision of the Chief Appeals Administrator

##### **II. Review and Assignment Process**

###### **Location of Folders**

1. Each discipline will have an “Unassigned” folder located at the S drive containing the electronic Working File for the discipline. The “Unassigned” folder will have two (2) sub-folders:
  - a. “Ready to Assign” folder - where cases that have cleared the high level review are placed for panel assignment
  - b. “For Further Review” folder - where cases that have not cleared the high level review are placed for additional consideration.

## REVIEW PROCESS

2. Discipline Reviewer conducts high level review of electronic Working file (eWf) for a given discipline, including a review for Ghuman issues.

## ASSIGNMENT PROCESS

3. **If the eWf clears the high level review**, the Discipline Reviewer will place the eWf in the “Ready to Assign” folder.
4. The lead paralegal for the discipline will access the eWf from the “Ready to Assign” folder and determine if a panel needs to be assigned.
5. The lead paralegal performs a cursory review of the eWf.
6. If the eWf clears the cursory review and a panel has not been assigned, the lead paralegal, using the Assignment Sheet for the discipline provided by the Chief Appeals Administrator, will assign a random panel to the eWf.
7. Once the panel is assigned, the lead paralegal completes processing of the eWf to place the assigned eWf in the “Assigned” folder.
8. If the eWf does not clear the cursory review, the lead paralegal will have a remand prepared.

## REVIEW PROCESS

9. **If the eWf DOES NOT clear the high level review**, the Discipline Reviewer will place the eWf in the “For Further Review” folder for further consideration.
10. At a time of the Discipline Reviewer’s choosing, he/she will conduct a second review of an eWf placed in the “For Further Review” folder to determine if there are any special issues that merit consideration by the Chief Judge.

11. If a Ghuman issue is present in the eWf, the Discipline Reviewer will do the following:

- a. Note the Ghuman issue by modifying the file name of the eWf to add “Ghuman” at the end of it; and
- b. Place the renamed eWf in the folder “Review for Possible Remand” located at S:\Appeals Processing\Working Files\Unassigned Cases for the Paralegal to prepare a remand.

#### ASSIGNMENT PROCESS

12. If special issues are **not** identified, the Discipline Reviewer will place the eWf in the “Ready to Assign” folder as a cleared eWf.

13. Repeat Steps 4 through 8.

#### REVIEW PROCESS

14. If special issues are identified, the Discipline Reviewer will schedule a meeting with the Chief Judge to consider the special issue and discuss a panel assignment.

#### ASSIGNMENT PROCESS

15. If the Chief Judge determines that no special issue is present, the Discipline Reviewer will place the eWf in the “Ready to Assign” folder as a cleared eWf.

16. Repeat Steps 4 through 8.

#### REVIEW PROCESS

17. If the Chief Judge determines that a special issue is present, the Chief Judge will designate the panel to be assigned.

#### ASSIGNMENT PROCESS

18. If the Chief Judge designates the panel, the Discipline Reviewer will enter the panel in ACTS.

19. Once the Discipline Reviewer enters the panel in ACTS, the Discipline Reviewer will place the eWf in the “Ready to Assign” folder as a cleared eWf.

20. Repeat Steps 4 through 8.

#### SENSITIVE APPLICATION WARNING SYSTEM (SAWS) REVIEW PROCESS

21. Board Contact forwards TC notification of SAWS case to all Discipline Reviewers.

22. Discipline Reviewers ascertain discipline of SAWS case and whether an appeal number has been assigned.

23. If the SAWS case has been assigned an appeal number and the case has been placed in a discipline folder, the Discipline Reviewer will proceed with steps 2-20, as necessary, paying particular attention to the special issues raised by the TC.