

Reminder of the Proper Procedure for Filing Confidential Information Pursuant to MPEP 724.02

In filing patent applications, applicants and their representatives should carefully review the application papers to ensure that trade secret information, proprietary information, and protective order materials that should be kept confidential are not included unless they are clearly marked and submitted in compliance with Manual of Patent Examining Procedure (MPEP), Section 724.02 (8th ed. 2001) (Rev. 1, Feb. 2003). If information is not submitted in compliance with MPEP 724.02, the information will be scanned along with the application into the Image File Wrapper (IFW) system. This may be undesirable from applicant's perspective, because once information is included in the IFW system, it will only be permanently deleted for national security concerns.

In general, patent applications, and papers related to the application, are scanned and maintained in an IFW. Application documents that are not scanned include documents that the United States Patent and Trademark Office (Office) is unable to scan (e.g., certain photographs and documents submitted in electronic form, such as the Computer Readable form for a Sequence Listing) and documents that are clearly marked and submitted in compliance with MPEP 724.02. Application documents that are not scanned are maintained in an artifact folder, and are not available as part of the IFW in the Patent Application Information Retrieval (PAIR) system. If the application file and contents are available to the public pursuant to 37 CFR §§ 1.11 or 1.14, any materials submitted pursuant to MPEP

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724.02 will be in an artifact folder and will be released to the public with any other application papers if a petition to expunge (37 CFR § 1.59) was either filed and denied, or not filed, by the time the application was allowed or a notice of abandonment is mailed. With the mailing of the notice of allowance or notice of abandonment, the examiner will review the patent application file and determine if a petition to expunge is in the file but not acted upon. If a petition to expunge was dismissed as being premature since the application was not yet allowed, the petition will be acted upon again, even if applicant had previously been required to resubmit the petition after allowance. If the application is being allowed, and the information is found to not be important to a reasonable examiner in deciding on patentability (see MPEP 724.04(A)-(C)), the petition to expunge will be granted and the information will be expunged. If the information is found to be important to a reasonable examiner in deciding on patentability, the petition to expunge will be denied and the information will become part of the application record and will be available to the public upon issuance of the application as a patent. With the mailing of the notice of abandonment, if a petition to expunge has been filed, irrespective of whether the information is found to be important or not to a reasonable examiner in deciding on patentability, the petition to expunge will be granted and the information expunged. Publication of the application as a patent application publication, or, if a reissue application or reexamination proceeding, in the Official Gazette will not cause the information to be made available to the public because a decision as to materiality cannot be made until a notice of allowance is mailed.

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Use Care In Submitting Information to the Office

Patent applications are generally published before a patent issues. Applicants should consider whether personal information is necessary in a document to be included in a patent application, before submitting the information to the Office. The Office does not require the Social Security Number of an inventor, and there is no need to include this type of personal information in a patent application. Even where the Office does require some degree of confidential information, applicants can still take steps to protect their privacy. For example, a copy of a cancelled check may be necessary to show that a payment was made, but the copy can be redacted before it is submitted to the Office to block the routing number on the check. In addition, since patent applications are published with the correspondence address of the application on the patent application publication, applicants, particularly those applicants who are not using a patent attorney or patent agent, may wish to consider using a business address rather than a home address to preserve privacy.

Once private information is included in a patent application file by scanning a document and adding an image of the document to the patent application's IFW, the document will only be removed from the IFW for national security concerns. For example, if an applicant includes the wrong application number on some correspondence, and the Office scans the paper and adds the paper to the application file corresponding to the number given, when a petition to expunge (37 CFR § 1.59) is granted, the document is not removed from the IFW. Instead of removing the document, the Office will mark the document "hidden," so

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if the IFW is available to the public, the document will not display. The document can also be “un-hidden” and reappear in the IFW. Similarly, if an applicant does not follow the procedures of MPEP 724.02, and submits proprietary information to the Office commingled with other documents, when a petition to expunge is granted, the proprietary information will be “hidden” but not permanently deleted from the IFW.

When filing trade secret information, proprietary information, or protective order materials is necessary to comply with the duty of disclosure pursuant to 37 CFR § 1.56, applicants seeking to ensure that the information is not made public should follow the procedure set forth in MPEP 724.02. For example, a Confidential Information Disclosure Statement (Confidential IDS) should be prepared, listing the confidential document on an information disclosure statement (e.g., PTO/SB/08). The document to be maintained in confidence must be placed in an envelope or container clearly labeled, for example:

**TRADE SECRET MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY
BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK
OFFICE EMPLOYEE.**

DO NOT SCAN

In re Application of
Application No.
Filed:
For: (Title of Invention)
TC Art Unit:
Examiner:

Materials submitted in compliance with MPEP 724.02 should be mailed to the Office or hand carried to the Customer Window as set forth in “Centralized Delivery and Facsimile

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Transmission Requirements for Patent Application Related Correspondence,” 1275 Off. Gaz. Patent Office Notices 200 (Oct. 28, 2003), in order to ensure appropriate processing of the documents.

Questions regarding this notice should be directed to Karin Ferriter, Senior Legal Advisor, Office of Patent Legal Administration, at (703)308-6906, or to PatentPractice@uspto.gov.

Date: April 23, 2004

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