

June 18, 2012

Mr. James Moore
Office of Policy and External Affairs
Mail Stop Congressional Relations
P.O. Box 1450
Alexandria, VA 22313-1450

Via email: SecrecyOrder.Comments@USPTO.gov

RE: Request for Comments on the Feasibility of Placing Economically Significant Patents Under a Secrecy Order and the Need to Review Criteria Used in Determining Secrecy Orders Related to National Security, 77 Fed. Reg. 23662, 4/20/2012

Dear Mr. Moore:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the “Request for Comments on the Feasibility of Placing Economically Significant Patents Under a Secrecy Order and the Need to Review Criteria Used in Determining Secrecy Orders Related to National Security” as published in the Federal Register (77 Fed. Reg. 23662) on April 20, 2012 (the “Notice”). Pursuant to a request from Congress, the USPTO is seeking comments as to whether the United States should identify and bar from publication and issuance certain patent applications as detrimental to the nation’s economic security. The USPTO is also seeking comments on the desirability of changes to the existing procedures for reviewing applications that might be detrimental to national security.

AIPLA is a U.S.-based national bar association with approximately 14,000 members who are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law affecting intellectual property.

The Notice requested comments on whether, and under what circumstances, the United States should extend the current framework for placing patent applications under a secrecy order to establish an additional screening program based on economic factors. In addition, the Notice lists a number of questions directed toward economic security-based and national security-based secrecy orders.

AIPLA opposes extending the current framework for placing patent applications under a secrecy order based on economic factors for a number of reasons, such as:

- (1) Placement of a secrecy order on a patent application, with its associated disclosure restrictions, would significantly impair or prevent commercialization of the invention. The result would be to deprive the public of the benefit of the invention since most inventions are readily ascertainable by direct observation or via reverse-engineering of the commercialized product or service embodying or utilizing the invention. Further, inventions that are not readily ascertainable by direct observation or via reverse-engineering of the commercialized product or service embodying or utilizing the invention are often kept as a trade secret (in a sense a self-imposed secrecy order), which is even more advantageous now given the expanded prior user rights afforded under the Leahy-Smith America Invents Act (“AIA”).¹
- (2) It is not clear how it would be feasible to define or articulate what is an economically significant invention, particularly given that, in the end, this is established by the marketplace. For example, this could depend on how a product or service embodying or utilizing the invention is marketed, or on the availability of alternative choices at the time the invention is commercialized. The proposal could even have the perverse effect in that the more valuable and widespread a particular invention is, the more likely it would be negatively impacted by this proposal.
- (3) As mentioned in the Notice, placement of a secrecy order on a patent application severely restricts the applicant's ability to obtain patent coverage outside of the United States. It is not clear how restricting an applicant's ability to seek patent protection outside of the United States aids the applicant or the U.S. public in a way consistent with the purpose of placing a secrecy order on economically significant patent applications.

In view of the preceding comments, AIPLA is not addressing the enumerated questions directed toward economic security-based and national security-based secrecy at this time.

Thank you for allowing AIPLA the opportunity to provide comments on this Notice. AIPLA looks forward to further dialogues with the USPTO in finding solutions and defining programs to maintain and enhance the USPTO's mission.

Sincerely,

A handwritten signature in black ink, appearing to read "William G. Barber", with a long, sweeping horizontal line extending to the right.

William G. Barber
AIPLA President

¹ Publ. L. No. 112-29, 125 Stat. 284.