



## UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

October 9, 2014

**VIA U.S. MAIL**

Ms. Kate Gaudry  
5503 Charlcoate Road  
Bethesda, MD 20817

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

Dear Ms. Gaudry:

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

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

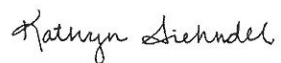
Please be aware that the FOIA is a means by which members of the public can obtain Agency records in existence at the time of the request. It cannot provide answers to questions or create new records in order to respond to FOIA requests. See *Hudgins v. Internal Revenue Serv.*, 620 F. Supp. 19, 21 (D.D.C.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

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

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

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

Sincerely,

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

Kathryn Siehndel  
USPTO FOIA Officer  
Office of General Law

Enclosure

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

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

# Technology Center 1600

## Sensitive Application Warning System (SAWS)

UPDATED: January 2013

### PURPOSE:

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

### OPERATIONAL OVERVIEW:

This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexams, Reissues and applications being forwarded to the 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 application contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims, title and cover figure or drawing. **Upon agreement that an application could be considered as a SAWS application, the SAWS POC is alerted as early in prosecution as possible.** The alert should be a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

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

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

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



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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

1. Applications disclosing seemingly frivolous or silly or controversial subject matter – paying special attention to the title, abstract and cover drawing.
2. Subject matter currently generating extensive media coverage:
  - AIDS/HIV vaccines and/or methods of prevention
  - Human fetal cell or fetal tissue based inventions, including use of fetal cells to treat humans
  - Human gametes
  - Germ-line gene therapy
  - Human embryonic stem (ES) cells and methods of making and using the same (this does not include all stem cells, just ES cells)
    - Induced pluripotent technology
  - Claims either specifically directed to or encompassing Human Beings, including:
    - Human Beings,
    - Human embryos,
    - Human/animal chimeras,
    - Methods of making or cloning human beings or human embryos,
    - Methods of *in utero* genetic manipulation of humans,
    - Methods of genetically altering humans via *in vitro* fertilization (IVF) or other methodologies (gene therapy),
    - Methods using or manipulating human embryos or fetuses
  - Human parthenogenesis (asexual female reproduction)
  - *In vitro* fertilization (IVF)
  - Methods or compositions for prolonging life or preventing aging
  - Cells/cell lines from indigenous peoples
  - Native plant, plant extract or plant/animal products; indigenous therapies, traditional medicine using native plants
  - Plant terminator technology
  - Tobacco plant genetically engineered for increased nicotine production
  - Synthetic or wholly engineered bacterial or viral genomes
  - Diagnosis, screening, or treatments limited by race or ethnicity, in particular exclusion of races (e.g. personalized medicine)

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

**Biological agents involved in bioterrorism or biocrimes**

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

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

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

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

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

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

### PURPOSE:

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

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

### OPERATIONAL OVERVIEW:

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

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

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

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares report, when necessary
3. SAWS POCs (Patrick Ryan, Jill Warden) and SAWS QAS (Greg Mills) reviews SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

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

Current 01/31/2013

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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



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

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

## **Technology Center 2100 Sensitive Applications Warning System (SAWS)**

### **Introduction:**

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

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

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

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

### **OVERVIEW:**

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

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

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

## 1. Examiner/SPE application identification

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

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

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

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

## 2. WQAS review/screening

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

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

**3. TC Director Level Review and Forwarding**

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

## **Technology Center 2100 Specific Subject Matter**

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

# Technology Center 2400

## Sensitive Application Warning System (SAWS)

UPDATED: EOY 2011  
Redistributed: May 2012

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

### PURPOSE:

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

### OPERATIONAL OVERVIEW:

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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



**Technology Center 2400 Specific Subject Matter:**

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

Technology Center 2600  
Special Applications Warning System (SAWS)

2012 MIDYEAR REMINDER

Introduction:

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

Purpose:

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

Operational Overview:

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

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

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

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

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

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

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

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

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

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

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

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

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

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

### 3. Secondary review

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

SAWS Application Subject Matter

Corps-wide Potential SAWS Subject Matter:

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

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

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

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

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

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

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



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

**PURPOSE:**

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

**OPERATIONAL OVERVIEW:**

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

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

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

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

*Management Guidelines for Sensitive Application Warning System (SAWS) Program*

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

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

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

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

**A. Technology Center 2800 Practice:**

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

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

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

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

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

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



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

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

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

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

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

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

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

**B. Subject matter of special interest in TC 2800**

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

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

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

*Management Guidelines for Sensitive Application Warning System (SAWS) Program*

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

**A. Subject matter of special interest in TC 2800**

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

## Technology Center 2900 Sensitive Application Warning System (SAWS)

UPDATED: End of Year FY 2011

### PURPOSE:

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

### OPERATIONAL OVERVIEW:

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

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner and home SPE in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgement and are encouraged to be *liberal* (erring to identify rather than not) in their identification as to whether or not an 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.

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

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

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

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

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

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

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

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

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares report when necessary
3. SAWS POC and SAWS QAS reviews SAWS report from the home SPE
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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.
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- For applications under Appeal, the home SPE, QAS Appeal Specialist and/or the Interference Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time of the Examiner's answer or interference papers (PTO-850, claims and count).

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

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

## TC 2900 SAWS Subject Matter List

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

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



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

**1) Examiner Case Identification**

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

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

**2) SPE Review/Screening of Application Information**

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

The following information should be forwarded by the SPE:

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

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

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

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

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

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

**4) Director Level Review and Forwarding**

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

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

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

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

## **SAWS Application Identification Subject Matter**

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

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

**6) SAWS Database Management and Application Tracking**

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

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

**TC-3600 Specific Subject Matter:**

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

# Technology Center 3700 Sensitive Application Warning System (SAWS)

## **Definition of a SAWS Application**

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

## **Introduction:**

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

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

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

## **Operational Overview:**

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

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

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

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

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

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

#### **1. Examiner/SPE/TQAS identification of SAWS applications**

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

#### **2. Screening/Identification by TC 3700 SAWS Panel**

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

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

### **3. Technology Center Directors Notification**

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

#### **TC 3700 SAWS Panel Members**

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



**Technology Center 3700 Specific Subject Matter**

(Updated September 2010)

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

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

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