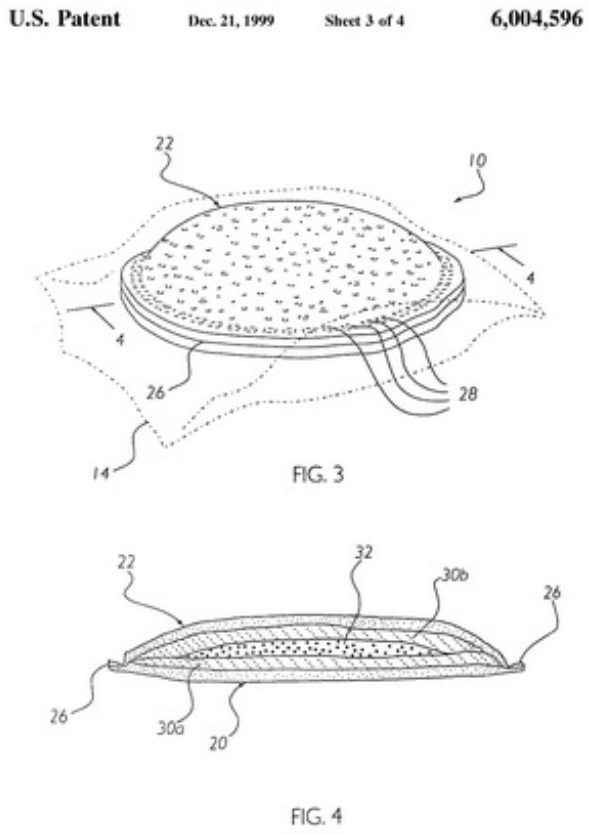
USPTO ends “warning system” for outlandish patents

By Joe Mullin

The Patent Office created a "sensitive application" program to avoid embarrassments like US Patent No. 6,004,596, pictured above. Examiners were told to quietly flag applications that are "silly or extremely basic, such as a crimped peanut butter and jelly sandwiches."
US Patent and Trademark Office



Earlier this week, leadership at the US Patent and Trademark Office distributed a memo indicating they were retiring the "Sensitive Application Warning System," or SAWS, a little-known program inside the USPTO since 1994.

SAWS was meant to identify patent applications that claimed controversial material, give them additional review, and alert leadership to them. To win approval, SAWS patents had to be authorized by a Technology Center leader or upper Patent Office management. That slowed some applications to a crawl. The patent office has maintained that SAWS wasn't a "secret program," but it's hard to see it any other way, since examiners were instructed not to talk about it.

Mostly, the program was meant to rope in patent applications that were simply outrageous. Examiners were advised to flag claims to have cured AIDS or the common cold, perpetual motion machines, cold fusion, and room temperature superconductors. One technology group advised examiners to submit applications containing "controversial, illegal, objectionable or derogatory subject matter," such as marijuana or pornography, to SAWS. Other examiners received memos suggesting they submit patents being used in litigation, or that had produced high-dollar awards.

The bizarre and wide-ranging criteria became public last year, after attorney Thomas Franklin had a client whose application was thrown into the SAWS system. Franklin insisted on finding out more, and his interest was piqued when the examiner revealed the reason for the delay, then quickly backtracked.

"That's secret, I'm not supposed to say it," the examiner said, according to Franklin's account of the conversation.

Knowing the name of the secret program, Franklin filed a Freedom of Information Act request with the Patent Office, and got back 43 pages of documents. In December he gave them to a Yahoo News reporter.

Treatments to enhance intelligence

The program's existence was unknown even to most patent attorneys, and the news spread quickly on popular

patent blogs like Patently-O and IP Watchdog. In January, the USPTO said it would review the program.

SAWS was never more than a small band-aid of a measure—just 0.4 percent of patents went in, according to the USPTO. Still, the small size of the program is hardly reassuring. It was an attempt to simply quiet down the most ridiculous aspects of a system run amok. Some details of the half-hearted attempt are actually suggestive of how out-of-control patents have become.

The purpose of SAWS seems to have been to eliminate, or at least bog down, applications that would embarrass the US Patent Office or the patent system generally. That was made explicit in a few of the memos to examiners. The first bullet point in the memo to Technology Center 1700, for example, told examiners to flag applications "which would potentially generate unwanted media coverage (i.e. news, blogs, forums.)"

After that, dozens of other SAWS topics are listed, which encompass a potpourri of concerns. The memos for TC 1600 and 1700 say to flag inventions that "seem trivial, mundane, frivolous... silly or extremely basic, such as crimped peanut butter and jelly sandwiches, methods of swinging on a swing, etc." (Both examples of granted patents that produced critical news coverage.)

The memos go on to list items that are simply fantastical, including:

- Room temperature superconductors
- Panacea cure for a disease or condition not known to be curable, such as AIDS, cancer, baldness, 'mad cow' disease, etc.
- Methods or compositions for prolonging life or preventing aging
- 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 productive of excess heat outside of known chemistry or physics
- Treatments to enhance intelligence

Other SAWS-appropriate claims are ones that might simply alarm people, like any "Method or Machines to take human life (suicide)," "human cloning or chimeras," and "controversial, illegal, objectionable, or derogatory subject matter." Examples in the last category include "marijuana cigarettes and pornography." Also of concern: "applications specifying race in the claims," or patent claims using "cell lines from indigenous peoples."

Finally, examiners are suggested to use SAWS in a variety of cases that might be controversial because of concerns about how the patent system is operating—the kind of coverage that's been heavy on Ars and elsewhere in the tech press. Those include:

- Applications with claims to computer programs or algorithms which have been rejected under 35 USC 101. [The section of law that bars abstract patents, ruled by the Supreme Court to include "do it on a computer"-style claims.]
- 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
- Applications with long pendencies or multiple continuations going back 5 or more years (Submarine type applications)

- 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
    - 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.

These last examples tend to prove the office's point that the program was rarely used, since if SAWS was applied to every "business method" patent, or patents used in high-profile lawsuits, it would have been a much larger program.

While the program wasn't used much, the list of things the patent office found embarrassing is a notably long and confusing one. SAWS is gone, but some of those embarrassments will likely remain. Hundreds of thousands of patents are granted each year, and the system of granting them is paid for by the people who want them. Examiners have 19 hours on average to evaluate a claimed invention. It's hard to discern when an exclusive right will foster innovation, and when it will backfire, or just look bad.

That's not a new problem. "I know well the difficulty of drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not," wrote Thomas Jefferson in 1813. He went on to consider whether we'd be better off without them entirely: "Generally speaking, other nations have thought that these monopolies produce more embarrassment than advantage to society; and it may be observed that the nations which refuse monopolies of invention, are as fruitful as England in new and useful devices."

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