The PTO's Document Disclosure Program: Boon or Boondoggle?

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Since it was founded, the Office has surely received many applications prepared by independent inventors. Such applicants and applications often pose serious problems.

For example, as an examiner in the mid-60s, I heard an apocryphal story of one inventor who, promising to stay there until his patent issued, parked himself outside the Commissioner's office. I have no idea when that supposedly happened. But, given the inspiration provided by countless cartoons, something of the kind may well be frequent. In the same vein, I assume that Senators and Representatives often call on behalf of constituents who want to know why their applications have been refused or their patents have not issued.

In 1969, possibly to alleviate such problems, the PTO instituted a Document Disclosure Program. As explained in its descriptive brochure, the Office retains informal invention disclosures for two years upon payment of a $10 fee.

It is doubtful that administrative costs are recovered, but submitters could find the charge reasonable and the benefit clear. As the brochure states, submission "should provide a more credible form of evidence than that provided by the mailing of a disclosure to oneself or another person by registered mail."

Much further along, however, the Office warns that "in establishing priority of invention, an affidavit or testimony… must usually also establish diligence in completing the invention or in filing the patent application…." Moreover, it warns (in boldface): "Inventors are also reminded that any public use or sale in the United States or publication of the invention anywhere in the world more than one year prior to the filing of a patent application on that invention will prohibit the granting of a U.S. patent on it. Foreign patent laws in this regard may be much more restrictive than U.S. laws." Given the cryptic nature of its advice, it is good that the brochure goes on to

recommend that those unfamiliar with patent law consult registered practitioners.

Were submitters capable of understanding and heeding that advice, the program would confer a benefit on those who, according to an AIPLA estimate, make 20-30,000 submissions annually. But do submitters understand the need for diligence; do they understand the significance of time bars in the U.S. and elsewhere? If they are amateurs whose submissions do not qualify, or only marginally qualify as applications, such understanding is doubtful. How many, despite warnings, believe that the program confers meaningful rights? If the PTO knows, it has not taken advantage of several opportunities to say.

As the risk of forfeiture goes up, a marginally positive program becomes ever less acceptable. At a fairly low threshold, painful as it may be for all concerned, the Office would better serve the public interest by simply advising tyros that professional help is needed to protect their inventions.

In 1998, the Office sought public comment on a proposal to eliminate the Program; 63 Fed. Reg. 53498, 53527-28. According to Dennis Crouch (Patently-O), it again sought comment in 2004. On April 6, 2006, 71 Fed. Reg. 17399, it once more proposed to abolish the Program. The time for comment expired on May 8. Nevertheless, in light of the PTO's observations in its notice and a May 3d AIPLA response (the only other related item discovered with a Google search), it will be interesting to see what happens.

The current notice makes no reference to anything that may have transpired in 2004, but it states that in 1998: "The Office received a number of comments supporting the elimination of the… Program, but did not receive any input from the independent inventor community and, therefore, decided to delay eliminating [it]."

AIPLA's response refers to "evidence that some so-called invention developers have been misleading small inventors as to the value of the Document Disclosure Program." It also says: "While we struggle to find any value in the continuation of the

Document Disclosure Program, the independent inventor community should be consulted and is in a better position to determine whether there is value in the continuation of this program."

The extent of PTO efforts to seek independent inventors' views is unknown, but publication in the Federal Register should not be expected to serve that end. Google and ipFrontline searches revealed nothing relevant. And only one unrelated reference to the program was found at the United Inventors Association.

Indeed, it is difficult to find the PTO's April notice at its website. Surprisingly, the notice is not linked to information about the program. Given little evidence of outreach beyond the Federal Register and an exceedingly brief 32-day response period, it is difficult to take seriously the Office's expression of interest in receiving public views, much less those of independent inventors.

Hence, I wonder whether the program was continued after 1998 because of internal benefits, rather than doubts about external benefits Indeed, it would be useful to know what fraction of the many thousands of documents credited to the program were initially submitted and failed as patent applications. That fraction need not be large to justify continuation of a facially money-losing program.

Still, even if all document disclosure filings were originally so intended, we should wonder about the sophistication of those who use the program. The less sophisticated they are, the more likely they are to misunderstand its limitations and forfeit protection under 35 U.S.C. § 102(b). Further, of course, the less sophisticated inventors are, the less useful their evaluation of the program. The PTO, if it chooses not to eliminate it now, should consider such matters more closely.