

X Patent Practitioners

Re: Absence of Foreign Filing License Grant Information in Official Filing Receipts

Dear Director Vidal,

The signers of this letter, directly or through their respective firms or corporations, have paid more than X dollars to the USPTO in the past ten years and have received more than X filing receipts for patent applications filed in the USPTO in the past ten years.

We write to draw your attention to the recent trend of patent application filing receipts not including any indication that a foreign filing license has been granted, even in technology areas that we would not expect to trigger heightened review due to national security interests and for applications in which all the listed inventors are clearly foreign nationals living and working abroad. We also draw your attention to the recent trend of patent application filing receipts receiving an indication that a foreign filing license has been granted, but the date shown is an obvious error (e.g., stating that “If Required, Foreign Filing License Granted: 12/31/1969” in an application that was filed on August 23, 2022).

Per 37 C.F.R. § 5.12(a), the filing of a patent application “will be considered to include a petition for license under 35 U.S.C. 184 for the subject matter of the application.” Critically, “[t]he filing receipt or other official notice will indicate if a license is granted.” *Id.*

Until recently, in most technology areas, it was unusual to receive a filing receipt that did not include an indication that a foreign filing license had been granted. Recently, however, this indication has been missing from several filing receipts, even for applications disclosing subject matter that seemingly could have no conceivable impact on national security. The default interpretation is, of course, that no foreign filing license has been granted.

It is unclear whether (a) the USPTO is suddenly not granting (or is taking much longer to grant) foreign filing licenses, even in technology areas that we would not expect to trigger additional review, or (b) the absence of this information in filing receipts is an error being made by the USPTO.

When a filing receipt does not include an indication that the foreign filing license has been granted, applicants can either (i) wait six months to file a foreign application (35 U.S.C. § 184), or (ii) take remedial action. The available remedial actions are the informal step of contacting the USPTO to try to find out the foreign filing license status, or the formal step of filing a petition under 37 C.F.R. § 5.12(b). Both actions require both practitioner and USPTO time, and the petition option requires payment of a fee. Additionally, both actions are particularly onerous for

foreign applicants who desire to file foreign applications claiming priority to the filed United States application shortly after filing.

We respectfully request that you determine why there has been a dramatic increase in the number of filing receipts that do not include foreign filing license information. If the USPTO's foreign filing license evaluation procedure has changed such that applicants should expect heightened review more often than before, we respectfully request an official USPTO communication saying so to allow applicants to plan accordingly. And if the absence of foreign filing license information on filing receipts is in error, we respectfully request that you address whatever has caused the foreign filing license grant information to be excluded from filing receipts.

Thank you for your consideration.

Sincerely,

X Patent Practitioners