

Memorandum Concerning the Eighteen-Month-Publication of US-Patent-Applications

Since the middle of March 2001, the United States Patent and Trademark Office (USPTO) publishes US-patent applications as an "A1"-document. Said publication, generally effected 18 months after either the date of application or the earliest priority date, represents its first publication for the information of the interested public. This ends the "period of secrecy" and, as of the publication date, third parties may inspect the file and follow the examination proceedings. However, the USPTO does not on its own motion send a copy of said "A1"-document to the applicant; it is the applicant himself who has to procure one.

The publication includes the patent specification in its originally submitted version, regardless of the present state of the application, and any revised parts of the description or patent claims submitted in the course of the proceedings. Once issued, the publication is a public document and must be regarded as such in patent grant proceedings.

As of the publication date, the applicant can demand compensation, appropriate to the circumstances, from a party that has used the subject matter of the application if he knew or should have known that the invention he used was the subject of the application. Neither a claim for damages nor an injunction is possible as these remedies can only be claimed for an examined or granted patent.

Quantitatively, an award of compensation is assessed at a lower rate than damages and will generally be below the amount obtainable under an appropriate licence had the protection right been finally examined. The amount of compensation awarded depends on the circumstances of the case, i.e. the extent of use, the advantages achieved by the user, and the disadvantages resulting for the applicant are all taken into consideration.

However, an award of compensation cannot be made if the subject matter of the application is obviously not patentable. Furthermore, a compensation claim becomes void retroactively if the application is later withdrawn, rejected or is considered as being withdrawn.