

Chapter 100 Secrecy and Access

- 101 General
- 102 Information as to Status of an Application
- 103 Right of Public to Inspect Patent Files and Some Application Files
- 104 Power to Inspect Application
- 105 Disbarred Attorney Cannot Inspect
- 106 Control of Inspection by Assignee
- 106.01 Rights of Assignee of Part Interest
- 107 "Secrecy Order" Cases
- 107.01 "Review" of Applications for Secrecy Order
- 107.02 Prosecution of "Secrecy Order" Cases
- 108 Applications relating to Atomic Energy
- 109 Security Markings
- 110 Confidential Nature of International Applications

101 General

35 U.S.C. 122. *Confidential status of applications.* Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

18 U.S.C. 2071. *Concealment, removal, or mutilation generally.* (a) Whoever willfully and unlawfully conceals, removes, mutilates, obliterates, or destroys, or attempts to do so, or, with intent to do so takes and carries away any record, proceeding, map, book, paper, document, or other thing, filed or deposited with any clerk or officer of any court of the United States, or in any public office, or with any judicial or public officer of the United States, shall be fined not more than \$2,000 or imprisoned not more than three years, or both.

(b) Whoever, having the custody of any such record, proceeding, map, book, document, paper or other thing, willfully and unlawfully conceals, removes, mutilates, obliterates, falsifies, or destroys the same, shall be fined not more than \$2,000 or imprisoned not more than three years, or both; and shall forfeit his office and be disqualified from holding any office under the United States.

37 CFR 1.14. *Patent application preserved in secrecy.* (a) Except as provided in § 1.11(b) pending patent applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority in that particular application from the applicant or his assignee or attorney or agent of record, unless the application has been identified by serial number in a published patent document or the United States of America has been indicated as a Designated State in a published international application, in which case status information such as whether it is pending, abandoned or patented may be supplied, or unless it shall be necessary to the proper conduct of business before the Office or as provided by this part. Where an application has been patented, the patent number and issue day may also be supplied.

All Patent and Trademark Office employees are legally obligated to preserve pending applications for patents in confidence. 35 U.S.C. 122 and 18 U.S.C. 2071 impose statutory requirements which cover the handling of patent applications and related documents. Suspension, removal, and even criminal penalties may be imposed for violations of these statutes.

In order to provide prompt and orderly service to the public, application files must be readily available to authorized Patent and Trademark Office employees at all times. Accordingly, in carrying or transporting applications and related papers, care must be exercised by Patent and Trademark Office employees, es-

pecially in corridors and elevators, to insure that applications and related papers are always free from employee surveillance and control. Application files must not be displayed or handled so as to permit perusal or inspection by any unauthorized member of the public.

Interoffice mail must be sent in appropriate envelopes.

No part of any application or paper related thereto should be reproduced or copied except for official purposes.

No patent application or related document may be removed from the premises occupied by the Patent and Trademark Office, except for handling as required by the issue process, unless specifically authorized by the Commissioner. If such authorization is given, the employee having custody will be responsible for maintaining confidentiality and otherwise conforming with the requirements of law.

Applications must not be placed in desk drawers or other locations where they might be easily overlooked or are not visible to authorized personnel.

Whenever an application is removed from the operating area having custody of the file, a charge on the PALM system must be properly and promptly made.

Papers arriving within the groups must be properly and promptly placed within the appropriate files. If papers are received with faulty identifications, this should be corrected at once. If papers are received at a destination for which they are not intended due to faulty identification or routing, appropriate corrective action should be taken at once to insure the prompt receipt thereof at the intended destination. See §§ 508.01 and 508.03.

All Patent and Trademark Office employees should bear in mind at all times the critical importance of insuring the confidentiality and accessibility of patent application files and related documents, and in addition to the specific procedures referred to above, should take all appropriate action to that end.

Examiners, classifiers and other Patent and Trademark Office employees who assist public searchers by outlining or indicating a field of search, should also bear in mind the critical importance of insuring the confidentiality of information revealed by a searcher when requesting field of search assistance. See § 713.02. Statutory requirements and curbs regarding the use of information obtained by an employee through Government employment are imposed by 15 U.S.C. 15(b) and 18 U.S.C. 1905.

Examiners, while holding interviews with attorneys and applicants, should be careful to prevent exposures of files and drawings of other applicants.

Extreme care should be taken to prevent inadvertent disclosure of the filing date or serial number of any application filed by another party. This applies not only to Office actions but also to notes (usually in pencil) in the file wrapper.

A number of lithographic and drafting firms in the Washington, D.C. area file bonds each year with the Patent and Trademark Office for the privilege of temporarily withdrawing certain drawings from the Office in order that drawings may be corrected or copies prepared for foreign filing.

Patent and Trademark Office employees are authorized to release drawings to representatives of these firms provided they: (1) Have an unexpired identification card, (2) Present an order signed by a party of record in the application, and (3) Leave a receipt which can be filed as a charge card.

Normally, drawings will be returned within three days. Any drawings which have not been returned within five days or which are returned in damaged condition should be reported immediately to the Office of Publications (557-3794).

102 Information as to Status of an Application

Status information of an application means only the following information:

1. that the application is abandoned, or
2. that the application is pending, or
3. that the application was issued as a patent and the patent number, issue date and classification of such patent.

PATENTED

If an application on which status information is requested has matured into a patent, the fact that the application is patented and the patent number, issue date and classification relative to the application may be given to anyone.

PENDING OR ABANDONED, NO REFERENCE

If an application is in pending or abandoned status and has not been referred to by number and date in a United States or foreign patent or printed application, status information indicating only that the application is pending or abandoned may be given only to Patent and Trademark Office employees and parties of record such as:

- (a) The applicant.
- (b) The attorney or agent of record in the application.
- (c) The assignee of record in the Patent and Trademark Office.
- (d) Anyone who has and furnishes written authority from a, b, or c.

REFERENCED APPLICATION

If an application has been referred to by number and date in a United States or foreign patent or printed application, status information may be given to Patent and Trademark Office employees and to anyone who furnishes the Patent and Trademark Office with a written request citing the application in question by serial number and date of filing. The source document (a United States or foreign patent or printed application) must be identified in the written request by the country, number and date of such patent or application.

REFERENCED APPLICATION, SOURCE DOCUMENT NOT PRESENTED

If a written request for status information is presented without a copy of the source document, Patent and Trademark Office employees will check to see that the source document and the application in question are properly identified and that the source document refers to the application in question before supplying the status information. Requests for information not accompanied with a copy of the source document may require the Office to obtain a copy of the source document for verification before status information can be supplied. This may result in some delay before the desired status information can be forwarded to the requester.

REFERRED APPLICATION, SOURCE DOCUMENT PRESENTED

If a copy of the source document is presented, the Office will verify that the United States application in question is cited therein. After checking, status information may be immediately given and the source document copy may be returned to the requester. In either case, at the time the status information is supplied, the person supplying the status information marks the request "Information furnished", the date and his or her name. The request is then placed in the file wrapper or forwarded to the appropriate area (group art unit, abandoned files, etc.) for inclusion in the file wrapper as part of the official record of the application. The applicant is not consulted. See § 203.08

STATUS LOCATION INFORMATION FOR OFFICE PERSONNEL

When it is desired to determine the current location or status of an application, office personnel should use their PALM terminal.

However, inasmuch as all 60 series applications prior to 714,000 are not currently in the PALM system, Office personnel requesting status/location information on those applications determined not to be in the PALM system will be requested to contact the Record Services Branch at 557-3181 where the numerical index records of the above mentioned applications are maintained.

103 Right of Public to Inspect Patent Files and Some Application Files

37 CFR 1.11. Files open to the public. (a) After a patent has been issued, the specification, drawings, and all papers relating to the case in the file of the patent are open to inspection by the general public, and copies may be obtained upon paying the fee therefor. After an award of priority by the Board of Patent Interferences as to all parties, or after termination if no such award is made, the file of any interference which involved a patent, or an application on which a patent has issued, is similarly open to public inspection and procurement of copies. See § 2.27 for trademark files.

(b) All reissue applications and all applications in which the Office has accepted a request filed under § 1.139, and related papers in the application file, are open to inspection by the general public, and copies may be obtained upon paying the fee therefor. The filing of reissue applications will be announced in the *Official Gazette*. The announcement shall include at least the filing date, reissue

application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and examining group to which the re-issue application is assigned.

(c) All requests for reexamination for which the fee under § 1.20(c) has been paid, will be announced in the *Official Gazette*. Any reexaminations at the initiative of the Commissioner pursuant to § 1.520 will also be announced in the *Official Gazette*. The announcement shall include at least the date of the request, if any, the reexamination request control number or the Commissioner initiated order control number, patent number, title, class and subclass, name of the inventor, name of the patent owner of record, and the examining group to which the reexamination is assigned.

(d) All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public, and copies may be furnished upon paying the fee therefor.

37 C.F.R. 1.14 Patent applications preserved in secrecy.

(e) Any request by a member of the public seeking access to, or copies of, any pending or abandoned application preserved in secrecy pursuant to paragraphs (a) and (b) of this section, or of any papers relating thereto, must (1) be in the form of a petition and be accompanied by the petition fee set forth in § 1.17(i) or (2) include written authority granting access to the member of the public in that particular application from the applicant or the applicant's assignee or attorney or agent of record.

Whenever a patent relies upon the filing date of an earlier but still pending application, the public is entitled to see the portion of the earlier application that relates to the common subject matter, and also what prosecution, if any, was had in the earlier application of subject matter claimed in the patent. The interested party may file a petition, accompanied by the petition fee, to the Commissioner for access to the application. (See § 1002.02(k).)

Inasmuch as the Post Office address is necessary for the complete identification of the petitioner, it should always be included complete with the ZIP Code number.

The petition may be filed either with proof of service of a copy upon the applicant, owner or attorney of record, if known, in the application to which access is sought, or may be filed in duplicate, in which case the duplicate copy is sent by the Solicitor to the applicant, attorney or owner of the application, who is given a limited period, as a week or ten days, within which to state any objection he may have to the granting of the petition. If no objection is raised, the petition is approved by the Solicitor. If there is no objection the petitioner is permitted to see the entire parent application. Otherwise, the petitioner is allowed to order a copy of only that portion of the parent application that relates to the common subject matter. A separate petition should be filed for each application to which access is desired, or sufficient extra copies provided so there may be one for placement in each application file, if the petition be granted, and one for service upon each attorney of record, if the applicant has different attorneys in his applications. Each petition should show not only why access is desired, but also why petitioner believes he is entitled to access.

The Solicitor also handles all petitions for access to applications involved in an interference or having an interference background.

If a defensive publication, an abstract or an abbreviation has been published, the entire application is available to the public for inspection and obtaining copies, see § 711.06.

REISSUE APPLICATIONS

37 CFR § 1.11(b) opens all reissue applications filed after March 1, 1977 to inspection by the general public. Section 1.11(b) also provides for announcement of the filings of reissue applications in the *Official Gazette*. This announcement will give interested members of the public an opportunity to submit to the examiner information pertinent to patentability of the reissue application.

Section 1.11(b) is applicable only to those reissue applications filed on or after March 1, 1977. Those reissue applications previously on file will not be automatically open to inspection but a liberal policy will be followed by the Office of the Solicitor in granting petitions for access to such applications.

For those reissue applications filed on or after March 1, 1977, the following procedure will be observed:

- (1) The filing of reissue applications will be announced in the *OFFICIAL GAZETTE* and will include certain identifying data as specified in § 1.11(b). Any member of the general public may request access to a particular reissue application filed after March 1, 1977. Since no record of such request is intended to be kept, an oral request will suffice. In the Record Room only the regular application charge card need be completed and submitted. The charge card will not be made part of a pending or abandoned reissue application.
- (2) The reissue application files will be maintained in the examining groups and inspection thereof will be supervised by group personnel. Although no general limit is placed on the amount of time spent reviewing the files, the Office may impose limitations, if necessary, e.g., where the application is actively being processed.
- (3) Where the reissue application has left the examining group for administrative processing, requests for access should be directed to the appropriate supervisory personnel in the division or branch where the application is currently located.
- (4) Requests for copies of papers in the reissue application file must be in writing addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 and may be either mailed or delivered to the Office mailroom. The price for a copy of an application as filed is \$18.00 for each 50 pages or fraction thereof (37 CFR 1.19(a)(3)), or 30 cents a page for portions of the application file. Since no useful purpose is seen for retaining such written request for copies of papers in reissue applica-

tions, they should be destroyed after the order has been completed.

REQUEST FOR REEXAMINATION

All requests for reexamination and related patent files are available to the public. An announcement of the filing of each request in which the entire fee has been paid and of each reexamination ordered at the initiative of the Commissioner under § 1.520 will be published in the Official Gazette. Procedures for access and obtaining copies are the same as those for reissue applications indicated above. See also § 2232.

Extract from 37 CFR 1.14. Patent applications preserved in secrecy.

(b) Except as provided in § 1.11(b) abandoned applications are likewise not open to public inspection, except that if an application referred to in a U.S. patent, or in an application which is open to inspection pursuant to § 1.139, is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant. Abandoned applications may be destroyed after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

(d) Any decision of the Board of Appeals or the Board of Patent Interferences, or any decision of the Commissioner on petition, not otherwise open to public inspection shall be published or made available for public inspection if: (1) The Commissioner believes the decision involves an interpretation of patent laws or regulations that would be of important precedent value; and (2) the applicant, or any party involved in the interference, does not, within two months after being notified of the intention to make the decision public, object in writing on the ground that the decision discloses a trade secret or other confidential information, if a decision discloses such information, the applicant or party shall identify the deletions in the text of the decision considered necessary to protect the information. If it is considered the entire decision must be withheld from the public to protect such information the applicant or party must explain why. Applicants or parties will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of decisions are made public over their objection. See § 2.27 for trademark applications.

Section 1.14(d) makes explicit the conditions under which significant decisions of the Patent and Trademark Office will be made available to the public, and includes reference to decisions of the Board of Patent Interferences, in addition to decisions of the Board of Appeals and the Commissioner.

The section is applicable to decisions deemed by the Commissioner to involve an interpretation of patent laws or regulations that would be of significant precedent value, where such decisions are contained in either pending or abandoned applications or in interference files not otherwise open to the public. It is applicable whether or not the decision is a final decision of the Patent and Trademark Office.

Section 1.14(d) is considered to place a duty on the Patent and Trademark Office to identify significant decisions and to take the steps necessary to inform the public of such decisions, by publication of such decisions, in whole or in part. It is anticipated, however, that no more than a few dozen decisions per year will

be deemed of sufficient importance to warrant publication under the authority of this section.

37 CFR 1.14(b) allows public inspection of abandoned applications referred to in defensive publications.

Access to abandoned patent applications forming a part of a streamlined continuation application is governed by 37 CFR 1.14(b) and requires a written request. However, such access must be limited to those papers which were part of the abandoned application. Access to abandoned parent applications in an application under § 1.62 are available to the extent that access is available to any prior application or continuing application in the § 1.62 application.

37 CFR 1.15 Requests for identifiable records. (a) Requests for records not disclosed to the public as part of the regular informational activity of the Patent and Trademark Office and which are not otherwise dealt with in these rules in this part may be made by completing Form CD-244, "Application to Inspect Department Records," and submitting this form, in person or by mail, to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. A nonrefundable application fee of \$2 must accompany each application. Copies of Form CD-244 are available in the Central Reference and Records Inspection Facility, Room 2122, Department of Commerce Building, Washington, D.C. 20230, the search room of the Patent Reference Branch of the Patent and Trademark Office, the search room of the Trademark Examining Operation, and in many public information offices and field offices of the Department of Commerce. If the requested record is identifiable, the request will be reviewed by the appropriate official authorized to make an initial determination of the availability of the record. If it is determined that the material is not to be made available to the requesting person, said person shall be notified in writing of that fact and the reasons why the record will not be disclosed. If the record is to be made available, inspection will be permitted in the appropriate Patent and Trademark Office search room. Fees for copies of records and for searches and related services are payable in accordance with the schedule of fees and charges established in § 4.8 of Title 15, Code of Federal Regulations.

(b) Any person whose application to inspect a record has been refused may request a reconsideration of the initial denial by completing and submitting the appropriate section of the Form CD-244. The request for reconsideration should be made within 30 days of the date of the original denial. In submitting such request the party should include any written argument he desires to support his belief that the record requested should be made available. No personal appearance, oral argument, or hearing shall be permitted. The decision upon such request shall be made by the Commissioner of Patents and Trademarks, and shall be based upon the original request, the denial, and any written argument submitted by the person seeking access to the record. The decision upon review shall be promptly made in writing and communicated to the person seeking access. If the decision is wholly or partly in favor of availability, the requested record to such extent shall be made available for inspection as described in paragraph (a) of this section. To the extent that the decision is adverse to the request, the reasons for the denial shall be stated. A decision upon review completed as provided herein shall constitute the final decision and action of the Patent and Trademark Office as to the availability of a requested record, except as may be required by court proceedings initiated pursuant to 5 U.S.C. 552(a)(3). Reconsiderations resulting in final decisions as prescribed herein shall be indexed and made available in the search room of the Patent Reference Branch.

(c) Procedures applicable in the event of a subpoena, order, or other compulsory process or demand of a court or other authority shall be those set forth in Section 7 of Department Order 64 (32 F.R. 9734, July 4, 1967).

ACCESSIBILITY OF NON-FINAL DISCOVERY OPINIONS AND ORDERS ISSUED BY THE BOARD OF PATENT INTERFERENCES

A number of inquiries have been received from the patent bar and other interested persons relating to discovery practice under 37 C.F.R. § 1.287 before the Board of Patent Interferences. The inquiries indicate a need for making available to the public non-final Board opinions, including concurring and dissenting opinions, as well as orders, made in the adjudication of discovery matters before the Board. While non-final opinions need not be made available to the public [5 U.S.C. § 552(a)(2)], in order to satisfy the need, copies on non-final opinions issued by the Board will be kept in a file in the Service Branch of the Board in the U.S. Patent and Trademark Office (Crystal Gateway 2, 1225 Jefferson Davis Highway, Room 10C01, Arlington, Virginia). Opinions in the file may be reviewed by the public during normal business hours (8:30 A.M. to 5:00 P.M.). Copies of opinions may be made by the public on reproducing equipment in the Service Branch with tokens at a cost of \$0.20 per page or copies may be ordered at a cost of \$0.30 per page [37 CFR 1.21(g) and 37 CFR 1.19(a)(5)].

In view of the provisions of 35 U.S.C. § 122 and 37 CFR § 1.11(a), a consent will be obtained by the Office from all parties in an interference before an opinion issued in connection with the interference is placed in the file if the interference file is not otherwise available to the public. Preliminary indications are that the parties and their counsel generally consent.

In order to obtain optimum dissemination of the information contained in the file, opinions placed therein will be indexed according to specific topics. Copies of the index will be updated from time to time as the need occurs. Specific questions relating to the index and file may be directed to the Patent Interference Examiners.

The initial index is as follows:

INDEX

- 1.00 Discovery in general [37 CFR § 1.287]
 - 1.10 Requests and service under § 1.287(a)
 - 1.20 Requests under § 1.287(b)
 - 1.30 Motions for additional discovery under § 1.287(c)
 - 1.31 Related to derivation
 - 1.32 Related to abandonment, suppression, and concealment
 - 1.33 Related to inequitable conduct
 - 1.34 Other
 - 1.40 Motions under § 1.287(d)(1)
 - 1.50 Action under § 1.287(d)(2)
 - 1.60 Agreements under § 1.287(e)

104 Power to Inspect Application

No person but the applicant (any one of joint applicants), applicant's legal representative, the assignee whose assignment is of record, or the attorney, agent or associate attorney of record will be permitted to have access to the file of any pending application, except as provided for under 37 CFR 1.11(b) or under

the interference rules, unless written authority from one of the above indicated parties, identifying the application to be inspected and the name of the person authorized to have access, is made of record, or upon the written order of the Commissioner, which will also become a part of the record of the case.

Approval by the primary examiner of a power to inspect is *not* required. The clerk of the group to which the application is assigned ascertains that the power is properly signed by one of the above indicated parties, and if acceptable, enters in into the file. If the power to inspect is unacceptable, notification of non-entry is written by the clerk to the person who signed the power.

When a power to inspect is received while a file is under the jurisdiction of a service branch, such as the Customer Services Division, the Service Branch of the Board of Appeals, and the Patent Issue Division, the question of permission to inspect is decided by the head of the branch who, if he or she approves, indicates the approval directly on the power.

Power to inspect may be granted when a duplicate copy of a filed power to inspect is hand delivered. The copy with indication of approval is placed in the file.

A "power to inspect" is, in effect, the same as a "power to inspect and make copies."

Where an applicant relied upon his application as a means to interfere with a competitor's business or customers, permission to inspect the application may be given the competitor by the Commissioner. (Ex Parte Bonnie-B Co. Inc., 1923 C.D. 42; 313 O.G. 453.)

An unrestricted power to inspect given by an applicant is, under existing practice, recognized as good until and unless rescinded. The same is true in the case of one given by the attorney or assignee so long as such attorney or assignee retains his connection with the application.

Permission to inspect given by the Commissioner, however, is not of a continuing nature, since the conditions that justified the permit to inspect when given may not obtain at a later date.

ACCESS TO PATENT APPLICATION AND INTERFERENCE FILES

In order to insure that access to patent applications, other than reissue applications filed after March 1, 1977, and interference files is given only to persons who are entitled thereto or who are specially authorized to have access under 37 CFR 1.14 and to insure also that the file record identifies any such specially authorized person who has been given access to a file, the following practice will be observed by all personnel of the Patent and Trademark Office:

1. Access, as provided for in the Rules of Practice, will be given on *oral request* to any applicant, patentee, assignee, or attorney or agent of record in an application or patent only upon *proof of identity* or upon recognition based on personal acquaintance.

2. Where a power of attorney or authorization of agent was given to a registered firm prior to July 2,

1971, access will be given upon oral request as in paragraph 1 above to any registered member or employee of the firm who has signatory power for the firm.

3. Unregistered employees of attorneys or agents, public stenographers, and all other persons not within the provisions of paragraphs 1 and 2 above will be given access only upon presentation of a written authorization for access signed by a person specified in paragraph 1 above, which authorization will be entered as a part of the official file.

105 Disbarred Attorney Cannot Inspect

Patent and Trademark Office employees are forbidden to hold either oral or written communication with an attorney who has been suspended or excluded from practice regarding an application unless it be one in which said attorney is the applicant. Power to inspect given to such an attorney will not be accepted.

106 Control of Inspection by Assignee

The assignee of the entire interest in an application may intervene in the prosecution of the case, appointing an attorney of his own choice. (See 37 CFR 1.32.) Such intervention, however, does not exclude the applicant from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect. Even when such request is made, the applicant may be permitted to inspect the case on sufficient showing why such inspection is necessary to conserve his rights. In re The Kellogg Switchboard & Supply Company, 1906 C.D. 274.

106.01 Rights of Assignee of Part Interest

While it is only the assignee of the entire interest who can intervene in the prosecution of an application or interference to the exclusion of the applicant, an assignee of a part interest or a licensee of exclusive right is entitled to inspect the application.

107 "Secrecy Order" Cases

Title 35, United States Code, section 181 provides, in part, that any invention in which the Government does not have a property interest, and whose publication or disclosure by the granting of a patent might, in the opinion of the Commissioner, be detrimental to the national security, shall be made available to the defense agencies. Upon notification by the defense agencies, the Commissioner is directed to order that such inventions be kept secret and to withhold the grant of a patent for such period as the national interest requires. Where the Government has a property interest, the interested Government agency determines whether to notify the Commissioner to keep the invention secret.

35 U.S.C. 184, *Filing of application in foreign country.* Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181

of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

37 CFR 5.1 Defense inspection of certain applications.

(a) The provisions of this part shall apply to both national and international applications filed in the Patent and Trademark Office and, with respect to inventions made in the United States, to applications filed in any foreign country or any international authority other than the United States Receiving Office. The (1) filing of a national or an international application in a foreign country or with an international authority other than the United States Receiving Office, or (2) transmittal of an international application to a foreign agency or an international authority other than the United States Receiving Office is considered to be a foreign filing within the meaning of Chapter 17 of Title 35, United States Code.

(b) In accordance with the provisions of 35 U.S.C. 181, patent applications containing subject matter the disclosure of which might be detrimental to the national security are made available for inspection by defense agencies as specified in said section. Only applications obviously relating to national security, and applications within fields indicated to the Patent and Trademark Office by the defense agencies as so related, are made available. The inspection will be made only by responsible representatives authorized by the agency to review applications. Such representatives are required to sign a dated acknowledgement of access accepting the condition that information obtained from the inspection will be used for no purpose other than the administration of 35 U.S.C. 181-188. Copies of applications may be made available to such representatives for inspection outside the Patent and Trademark Office under conditions assuring that the confidentiality of the applications will be maintained, including the conditions that: (1) all copies will be returned to the Patent and Trademark Office promptly if no secrecy order is imposed, or upon rescission of such order if one is imposed, and (2) no additional copies will be made by the defense agencies. A record of the removal and return of copies made available for defense inspection will be maintained by the Patent and Trademark Office. Applications relating to atomic energy are made available to the Department of Energy as specified in § 1.14 of this chapter.

37 CFR 5.2 Secrecy order.

(a) When notified by the chief officer of a defense agency that publication or disclosure of the invention by the granting of a patent would be detrimental to the national security, an order that the invention be kept secret will be issued by the Commissioner of Patents and Trademarks.

(b) The secrecy order is directed to the applicant, his successors, any and all assignees, and their legal representatives; hereinafter designated as principals.

(c) A copy of the secrecy order will be forwarded to each principal of record in the application and will be accompanied by a receipt, identifying the particular principal, to be signed and returned.

(d) The secrecy order is directed to the subject matter of the application. Where any other application in which a secrecy order has not been issued discloses a significant part of the subject matter of the application under secrecy order, the other application and the common subject matter should be called to the attention of the Patent and Trademark Office. Such a notice may include any material such as would be urged in a petition to rescind secrecy orders on either of the applications.

37 CFR 5.3 Prosecution of application under secrecy orders; withholding patent.

Unless specifically ordered otherwise, action on the application by the Office and prosecution by the applicant will proceed during the time an application is under secrecy order to the point indicated in this section:

(a) National applications under secrecy order which come to a final rejection must be appealed or otherwise prosecuted to avoid abandonment. Appeals in such cases must be completed by the applicant but unless otherwise specifically ordered by the Commissioner will not be set for hearing until the secrecy order is removed.

(b) An interference will not be declared involving national applications under secrecy order. However, if an applicant whose application under secrecy order copies claims from an issued patent, a notice of that fact will be placed in the file wrapper of the patent. (See § 1.205(c)).

(c) When the national application is found to be in condition for allowance except for the secrecy order the applicant and the agency which caused the secrecy order to be issued will be notified. This notice (which is not a notice of allowance under § 1.311 of this chapter) does not require response by the applicant and places the national application in a condition of suspension until the secrecy order is removed. When the secrecy order is removed the Patent and Trademark Office will issue a notice of allowance under § 1.311 of this chapter, or take such other action as may then be warranted.

(d) International applications under secrecy order will not be mailed, delivered or otherwise transmitted to the international authorities or the applicant. International applications under secrecy order will be processed up to the point where, if it were not for the secrecy order, record and search copies would be transmitted to the international authorities or the applicant.

37 CFR 5.4 Petition for rescission of secrecy order.

(a) A petition for rescission or removal of a secrecy order may be filed by, or on behalf of, any principal affected thereby. Such petition may be in letter form, and it must be in duplicate. The petition must be accompanied by one copy of the application or an order for the same, unless a showing is made that such a copy has already been furnished to the department or agency which caused the secrecy order to be issued.

(b) The petition must recite any and all facts that purport to render the order ineffectual or futile if this is the basis of the petition. When prior publications or patents are alleged the petition must give complete data as to such publications or patents and should be accompanied by copies thereof.

(c) The petition must identify any contract between the Government and any of the principals, under which the subject matter of the application or any significant part thereof was developed, or to which the subject matter is otherwise related. If there is no such contract, the petition must so state.

(d) Unless based upon facts of public record, the petition must be verified.

37 CFR 5.5 Permit to disclose or modification of secrecy order.

(a) Consent to disclosure, or to the filing of an application abroad, as provided in 35 U.S.C. 182, shall be made by a "permit" or "modification" of the secrecy order.

(b) Petitions for a permit or modification must fully recite the reason or purpose for the proposed disclosure. Where any proposed disclosee is known to be cleared by a defense agency to receive classified information, adequate explanation of such clearance should be made in the petition including the name of the agency or department granting the clearance and the date and degree thereof. The petition must be filed in duplicate and be accompanied by one copy of the application or an order for the same, unless a showing is made that such a copy has already been furnished to the department or agency which caused the secrecy order to be issued.

(c) In a petition for modification of a secrecy order to permit filing abroad, all countries in which it is proposed to file must be made known, as well as all attorneys, agents and others to whom the material will be consigned prior to being lodged in the foreign patent office. The petition should include a statement vouching for the loyalty and integrity of the proposed disclosees and where their clearance status in this or the foreign country is known all details should be given.

(d) Consent to the disclosure of subject matter from one application under secrecy order may be deemed to be consent to the disclosure of common subject matter in other applications under secrecy order so long as not taken out of context in a manner disclosing material beyond the modification granted in the first application.

(e) The permit or modification may contain conditions and limitations.

37 CFR 5.6 General and group permits.

(a) Organizations requiring consent for disclosure of applications under secrecy order to persons or organizations in connection with repeated routine operation may petition for such consent in the form of a general permit. To be successful such petitions must ordinarily recite the security clearance status of the disclosees as sufficient for the highest classification of material that may be involved.

(b) Where identical disclosees and circumstances are involved, and consent is desired for the disclosure of each of a specific list of applications, the petitions may be joined.

37 CFR 5.7 Compensation.

Any request for compensation as provided in 35 U.S.C. 183 must not be made to the Patent and Trademark Office but should be made directly to the department or agency which caused the secrecy order to be issued. Upon written request persons having a right to such information will be informed as to the department or agency which caused the secrecy order to be issued.

37 CFR 5.8 Appeal to Secretary.

Appeal to the Secretary of Commerce, as provided by 35 U.S.C. 181, from a secrecy order cannot be taken until after a petition for rescission of the secrecy order has been made and denied. Appeal must be taken within 60 days from the date of the denial, and the party appealing, as well as the department or agency which caused the order to be issued will be notified of the time and place of hearing. The appeal will be heard and decided by the Secretary or such officer or officers as he may designate.

37 CFR 5.11 License for filing application in foreign country or for transmitting international application.

(a) When no secrecy order has been issued under § 5.2, a license from the Commissioner of Patents and Trademarks under 35 U.S.C. 184 is required before filing any application for patent or for the registration of a utility model, industrial design, or model, in a foreign country, or transmitting an international application to any foreign patent agency or any international agency other than the United States Receiving Office, or causing or authorizing such filing or transmittal, with respect to an invention made in the United States if:

(1) The foreign application is to be filed or its filing caused or authorized before a national or international application for patent is filed in the United States, or

(2) The foreign application is to be filed, or its filing caused or authorized, or the transmittal of the international application is caused or authorized, prior to the expiration of six months from the filing of the application in the United States.

(b) When there is no secrecy order in effect, a license under 35 U.S.C. 184 is not required if:

(1) The invention was not made in the United States, or

(2) The foreign application is to be filed or the international application is to be transmitted, or its filing or transmittal caused or authorized, after the expiration of six months from the filing of the national application in the United States.

(c) When a secrecy order has been issued under § 5.2, an application cannot be filed in a foreign country, nor can an international application be transmitted to any agency other than the United States Receiving Office except in accordance with § 5.5.

37 CFR 5.12 Petition for license.

(a) Filing of an application for patent for inventions made in the United States will be considered to include a petition for license under 35 U.S.C. 184 for the subject matter of the application. The filing receipt will indicate if a license is granted. If the initial automatic petition is not granted, a subsequent petition may be filed under paragraph (b) of this section.

(b) Petitions for license under 35 U.S.C. 184 should be presented in letter form and should include petitioner's address, and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner.

37 CFR 5.13 Petition for license; no corresponding application.

Where there is no corresponding national or international application, the petition for license must be accompanied by a legible copy of the material upon which license is desired. This copy will be retained as a measure of the license granted. For assistance in the identification of the subject matter of each license so issued, it is suggested that the petition or requesting letter be submitted in duplicate and provide a title and other description of the material. The duplicate copy of the petition will be returned with the license or other action on the petition. Where an international application is being filed in the United States Receiving Office, the petition may accompany the international application.

37 CFR 5.14 *Petition for license; corresponding U.S. application.*

(a) Where there is a corresponding United States application on file the petition for license must identify this application by serial number, filing date, inventor, and title, and a copy of the material upon which the license is desired is not required. The subject matter licensed will be measured by the disclosure of the United States application. Where the title is not descriptive, and the subject matter is clearly of no interest from a security standpoint, time may be saved by a short statement in the petition as to the nature of the invention.

(b) Two or more United States applications should not be referred to in the same petition for license unless they are to be combined in the foreign or international application, in which event the petition should so state and the identification of each United States application should be in separate paragraphs.

(c) Where the application to be filed or transmitted abroad contains matter not disclosed in the United States application or applications, including the case where the combining of two or more United States applications introduces subject matter not disclosed in any of them, a copy of the application as it is to be filed in the foreign country or international application which is to be transmitted to a foreign international or national agency as it is to be filed in the Receiving Office must be furnished with the petition. If, however, all new matter in the foreign or international application to be filed is readily identifiable, the new matter may be submitted in detail and the remainder by reference to the pertinent United States application or applications.

37 CFR 5.15 *Scope of license.*

(a) A license to file an application in a foreign country or transmit an international application to any foreign or international agency other than the United States Receiving Office, when granted, includes authority to forward all duplicate and formal papers to the foreign country or international agencies and to make amendments and take any action in the prosecution of the foreign or international application, provided subject matter additional to that covered by the license is not involved. In those cases in which no license is required to file the foreign application or transmit the international application, no license is required to file papers in connection with the prosecution of the foreign or international application not involving the disclosure of additional subject matter. Any paper filed abroad or with an international agency following the filing of a foreign or international application which involves the disclosure of additional subject matter must be separately licensed in the same manner as a foreign or international application.

(b) Licenses separately granted in connection with two or more United States applications may be exercised by combining or dividing the disclosures, as desired, provided additional subject matter is not introduced.

(c) A license does not apply to acts done before the license was granted unless the petition specifically requests and describes the particular acts and the license is worded to apply to such acts.

37 CFR 5.16 *Effect of secrecy order.*

Any license obtained under 35 U.S.C. 184 is ineffective if the subject matter is under a secrecy order, and a secrecy order prohibits the exercise of or any further action under the license unless separately specifically authorized by a modification of the secrecy order in accordance with § 5.5.

37 CFR 5.17 *Who may use license.*

Licenses may be used by anyone interested in the foreign filing or international transmittal for or on behalf of the inventor or the inventor's assigns.

37 CFR 5.18 *Arms, ammunition, and implements of war.*

(a) The exportation of technical data relating to arms, ammunition, and implements of war generally is subject to the International Traffic in Arms Regulations of the Department of State (22 CFR Parts 121-128); the articles designated as arms, ammunition, and implements of war are enumerated in the U.S. Munitions List, 22 CFR 121.01. However, if a patent applicant complies with regulations issued by the Commissioner of Patents and Trademarks under 35 U.S.C. 184, no separate approval from the Department of State is required unless the applicant seeks to export technical data exceeding that used to support a patent application in a foreign country. This exemption from Department of State regulations is applicable regardless of whether a license from the Commissioner is required by the provisions of §§ 5.11 and 5.15 (22 CFR 125.04(b), 125.20(b)).

(b) When a patent application containing subject matter on the Munitions List (22 CFR 121.01) is subject to a secrecy order under § 5.2 and a petition is made under § 5.5 for a modification of the secrecy order to permit filing abroad, a separate request to the Department of State for authority to export classified information is not required (22 CFR 125.05(d)).

37 CFR 5.19 *Export of technical data.*

(a) Under regulations (15 CFR 370.10(j)) established by the U.S. Department of Commerce, International Trade Administration, Office of Export Administration, a validated export license is not required in any case to file a patent application or part thereof in a foreign country if the foreign filing is in accordance with the regulations (37 CFR 5.11-5.23) of the Patent and Trademark Office.

(b) A validated export license is not required for data contained in a patent application prepared wholly from foreign-origin technical data where such application is being sent to the foreign inventor to be executed and returned to the United States for subsequent filing in the U.S. Patent and Trademark Office (15 CFR 379.3(c)).

(c) Inquiries concerning the export control regulations for the foreign filing of technical data other than patent applications should be made to the Office of Export Administration, International Trade Administration, Department of Commerce, Washington, D.C. 20230.

GENERAL

37 CFR 5.21 *Effect of modification, rescission or license.*

Any consent, rescission or license under the provisions of this part does not lessen the responsibilities of the principals in respect to any Government contract or the requirements of any other Government agency.

37 CFR 5.22 *Papers in English language.*

All papers submitted in connection with petitions must be in the English language, or be accompanied by an English translation and a translator's certificate as to the true, faithful and exact character of the translation.

37 CFR 5.23 *Correspondence.*

All correspondence in connection with this part, including petitions, should be addressed to "Commissioner of Patents and Trademarks (Attention Patent Security Division), Washington, D.C. 20231."

All licenses granted by the Commissioner of Patents and Trademarks to file patent applications in foreign countries are made of record in the application to which they correspond. A petition for a license and the license resulting therefrom are given paper numbers and endorsed on the file wrapper. Petitions for licenses which are not approved are recorded and placed in the application file wrapper.

If a secrecy order is applied to an international application, the application will not be forwarded to the International Bureau as long as the secrecy order remains in effect. If the secrecy order remains in effect at the end of the 15th month after the priority date of the international application, the international applica-

tion will be declared withdrawn (abandoned) because the Record Copy of the international application was not received in time by the International Bureau (37 CFR 5.3(d), PCT Article 12(3), and PCT Rule 22.3). If the United States of America has been designated, however, it is possible to save the U.S. filing date, by fulfilling the requirements of 35 U.S.C. 371(c) prior to the end of the 15th month.

107.01 "Review" of Applications for Secrecy Order

Under 35 U.S.C. 181 the obligation is directly on the Patent and Trademark Office to appreciate the possible interest of the defense agencies in pending applications and to take steps to make them available to such agencies.

All new applications received in the Patent and Trademark Office are screened by Group 220 personnel to determine which applications should be made available for review or treated under the Atomic Energy and Space Acts for property interests.

All applications that have been screened by Group 220 will be stamped "LICENSING & REVIEW" inside the file wrapper. This stamp simply indicates that the application has been initially screened and is not to be considered as a conclusive indication of the security status of the application or as an indication that a license for foreign filing will be granted.

All papers subsequently filed must be inspected by the examiner to determine whether matter of an obvious defense interest which requires a security review or matters of obvious property right interest under the Atomic Energy or Space Acts has been introduced into the application. In such applications forwarded to the Licensing and Review Section of Group 220, it is helpful if a check mark is placed in the margin opposite to the part which is significant in suggesting security or property right review.

Applications in Group 220 for the review thereof by the appropriate defense agency may be borrowed by the examiner when reached for action. Allowable applications requiring consideration for processing under Section 152 of the Atomic Energy Act (42 U.S.C. 2182) and/or Section 305c of the Space Act (42 U.S.C. 2457c) are processed to issue, including counting of the issue, and forwarded through Group 220 to the Patent Issue Division. When the security status of the application cannot be promptly decided, Group 220 will report the progress that has been made to the group director. Any action to be taken in the case, for the purpose of advancing said group date, must be arranged through the group director:

107.02 Prosecution of "Secrecy Order" Cases

"Secrecy Order" Cases are examined as in other cases, but may not be passed to issue; nor will an interference be declared where one or more of the conflicting cases is secret. See § 1111.04.

In case of a final rejection, while such action must be properly responded to, and an appeal, if filed, must be completed by the applicant to prevent abandonment, such appeal will not be set for hearing by the

Board of Appeals until the secrecy order is removed, unless specifically ordered by the Commissioner.

When a "Secrecy Order" Case is in condition for allowance, a notice of allowability [Form D-10] is issued, thus closing the prosecution. Any amendments received thereafter are not entered or responded to until such time as the secrecy order is rescinded. At such time amendments which are free from objection will be entered; otherwise they are denied entry.

108 Applications Relating to Atomic Energy

37 CFR 1.14(c) reads as follows:

"Applications for patents which disclose or which appear to disclose, or which purport to disclose, inventions or discoveries relating to atomic energy are reported to the Department of Energy, which Department will be given access to such applications, but such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or an invention or discovery or that such application in fact discloses subject matter in categories specified by sections 151(c) and 151(d) of the Atomic Energy Act of 1954, 68 Stat. 919; 42 U.S.C. 2181 (c) and (d)."

The Atomic Energy Act of 1954 requires that the Commissioner of Patents and Trademarks shall notify the Department of Energy of all applications for patent which, in his opinion, disclose inventions or discoveries required to be reported under subsection 151(c) (42 U.S.C. 2181(c)) which reads in part as follows:

"... any invention or discovery useful in the production or utilization of special nuclear material or atomic energy. . . ."

The term "atomic energy" is defined as all forms of energy released in the course of nuclear fission or nuclear transformation (42 U.S.C. 2014(c)).

All applications received in the Patent and Trademark Office are sent to Licensing and Review for screening by Group 220 personnel in order for the Commissioner to fulfill his responsibilities under section 151(d) (42 U.S.C. 2181(d)) of the Atomic Energy Act, now administered by the Department of Energy. Papers subsequently added must be inspected promptly by the examiner when received to determine whether the application has been amended to relate to atomic energy and those so related must be promptly forwarded to Licensing and Review.

When applications are forwarded to Group 220 for consideration of the above requirements, it is helpful if a check mark is made in the margin opposite to the part of the paper which is significant in suggesting that the application be reported.

In considering applications under the terms of 37 CFR 1.14(c), the relation of the subject matter to national security under § 107.01 is not a significant factor. EVEN applications using a well-known radioactive source for any purpose or which disclose inventions having special relation to atomic energy MUST BE SUBMITTED TO Group 220. See § 706.03(b).

109 Security Markings

Under Executive Order 11652, 37 Federal Register, Number 48, pages 5212 et seq., standards are pre-

scribed for the marking, handling, and care of official information which requires safeguarding in the interest of security.

Papers marked as prescribed in the Executive Order, and showing that such marking is applied by, or at the direction of, a Government Agency, are accepted in patent applications. All applications or papers in the Patent and Trademark Office bearing words such as "Secret," or "Confidential," must be promptly referred to Group 220 for clarification or security treatment. Under no circumstances can any such application, drawing, exhibit, or other paper be placed in public records, such as the patented files, until all security markings have been considered and declassified or otherwise explained.

Authorized security markings may be placed on the patent application drawings when filed provided that such markings are outside the illustrations and that they are removed when the material is declassified, 37 CFR 1.84(l).

110 Confidential Nature of International Applications

PCT ARTICLE 30

Confidential Nature of the International Application

(1)(a) Subject to the provisions of subparagraph (b), the International Bureau and the International Searching Authorities shall not allow access by any person or authority to the international application before the international publication of that application, unless requested or authorized by the applicant.

(b) The provisions of subparagraph (a) shall not apply to any transmittal to the competent International Searching Authority, to transmittals provided for under Article 13, and to communications provided for under Article 20.

(2)(a) No national Office shall allow access to the international application by third parties, unless requested or authorized by the applicant, before the earliest of the following dates:

- (i) date of the international publication of the international application,
- (ii) date of the receipt of the communication of the international application under Article 20,

(iii) date of the receipt of a copy of the international application under Article 22.

(b) The provisions of subparagraph (a) shall not prevent any national Office from informing third parties that it has been designated, or from publishing that fact. Such information or publication may, however, contain only the following data: identification of the receiving Office, name of the applicant, international filing date, international application number, and title of the invention.

(c) The provisions of subparagraph (a) shall not prevent any designated Office from allowing access to the international application for the purposes of the judicial authorities.

(3) The provisions of paragraph (2)(a) shall apply to any receiving Office except as far as transmittals provided for under Article 12(1) are concerned.

(4) For the purposes of this Article, the term "access" covers any means by which third parties may acquire cognizance, including individual communication and general publication, provided, however, that no national Office shall generally publish an international application or its translation before the international publication or, if international publication has not taken place by the expiration of 20 months from the priority date, before the expiration of 20 months from the said priority date.

35 U.S.C. 368. *Secrecy of certain inventions; filing international applications in foreign countries.* (a) International applications filed in the Patent Office shall be subject to the provisions of chapter 17 of this title.

(b) In accordance with article 27(8) of the treaty, the filing of an international application in a country other than the United States on the invention named in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17 of this title, whether or not the United States is designated in that international application.

(c) If a license to file in a foreign country is refused or if an international application is ordered to be kept secret and a permit refused, the Patent Office when acting as a Receiving Office or International Searching Authority, or both, may not disclose the contents of such application to anyone not authorized to receive such disclosure.

37 CFR 1.14(a) relating to access to international applications is found in § 101.

Although most international applications are published soon after the expiration of 18 months from the priority date, PCT Article 21(2)(a), such publication does not open up the Home Copy or Search Copy to the public for inspection.