

# Chapter 100 Secrecy, Access, National Security, and Foreign Filing

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## 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 under this title 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 under this title 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. As used in this subsection, the term "office" does not include the office held by any person as a retired officer of the Armed Forces of the United States.

### 37 CFR 1.14. Patent applications preserved in confidence.

(a) Patent applications are generally preserved in confidence pursuant to 35 U.S.C. 122. No information will be given concerning the filing, pendency, or subject matter of any application for patent, and no access will be given to, or copies furnished of, any application or papers relating thereto, except as set forth in this section.

(1) Status information includes information such as whether the application is pending, abandoned, or patented, as well as the application number and filing date (or international filing date or date of entry into the national stage).

(i) Status information concerning an application may be supplied:

(A) When copies of, or access to, the application may be provided pursuant to paragraph (a)(3) of this section;

(B) When the application is identified by application number or serial number and filing date in a published patent document or in a U.S. application open to public inspection; or

(C) When the application is the national stage of an international application in which the United States of America has been indicated as a Designated State.

(ii) Status information concerning an application may also be supplied when the application claims the benefit of the filing date of an application for which status information may be provided pursuant to paragraph (a)(1)(i) of this section.

(2) Copies of an application—as-filed may be provided to any person, upon written request accompanied by the fee set forth in § 1.19(b)(1), without notice to the applicant, if the application is incorporated by reference in a U.S. patent.

(3) Copies of (upon payment of the fee set forth in § 1.19(b)(2)), and access to, an application file wrapper and contents may be provided to any person, upon written request, without notice to the applicant, when the application file is available and:

(i) It has been determined by the Commissioner to be necessary for the proper conduct of business before the Office or warranted by other special circumstances;

(ii) The application is open to the public as provided in § 1.11(b);

(iii) Written authority in that application from the applicant, the assignee of the application, or the attorney or agent of record has been granted; or

(iv) The application is abandoned, but not if the application is in the file jacket of a pending application under § 1.53(d), and is:

(A) Referred to in a U.S. patent;

(B) Referred to in a U.S. application open to public inspection;

(C) An application which claims the benefit of the filing date of a U.S. application open to public inspection; or

(D) An application in which the applicant has filed an authorization to lay open the complete application to the public.

(b) Complete applications (§ 1.51(a)) which are abandoned may be destroyed and hence may not be available for access or copies as permitted by paragraph (a)(3)(iv) of this section after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation.

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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, especially in corridors and elevators, to ensure that applications and related papers are always under 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 ensure the prompt receipt thereof at destination. See MPEP § 508.01 and § 508.03.

All Patent and Trademark Office employees should bear in mind at all times the critical importance of ensuring 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 ensuring the confidentiality of information revealed by a searcher when requesting field of search assistance. See MPEP § 1701. 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 application 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.

#### TELEPHONE AND IN-PERSON REQUESTS FOR INFORMATION CONCERNING PENDING OR ABANDONED APPLICATIONS

Normally no information concerning pending or abandoned patent applications (except reissue applications and reexamination proceedings) may be given to the public without the authorization of the applicant, the assignee of record, or the attorney or agent of record. See 35 U.S.C. 122 and 37 CFR 1.14. Other exceptions are specified in 37 CFR 1.14.

When handling an incoming telephone call or an in-person request for information regarding a pending or abandoned patent application, no information should be disclosed until the identity of the requester can be adequately verified as set forth below. Particular care must be exercised when a request is made for the issue date or patent number assigned to a pending patent application. If the issue date is later than the current date (i.e., the date of the request), such information may be given only to the applicant, or the assignee of record, or the attorney or agent of record.

The following procedure should be followed before any information about a pending or abandoned patent application is given over the telephone:

(A) Obtain the caller's full name, the application number, and the caller's telephone number. Ask the caller if there is an attorney or agent of record.

(1) If there is an attorney or agent of record, ask for his or her registration number. If the registration number is not known, ask for the name of the attorney or agent of record. Inform caller that an attorney or agent of record will be called after verification of his/her identity and that information concerning the application will be released to that attorney or agent.

(2) If there is no attorney or agent of record, ask the caller why he or she is entitled to information concerning the application. If the caller identifies himself or herself as an applicant or an authorized representative of the assignee of record, ask for the

correspondence address of record and inform caller that his or her association with the application must be verified before any information concerning the application can be released and that he or she will be called back. If the caller indicates that he or she is not an applicant or an authorized representative of the assignee of record then status information may only be given pursuant to MPEP § 102.

(B) Then, verify that information concerning the application can be released by checking PALM or the application file.

(1) If the caller stated there was an attorney or agent of record, PALM Intranet or the 2954 PALM screen should be used to verify the registration number given or to obtain the registration number of an attorney or agent of record. Then PALM Intranet or the 3552 PALM screen (using the registration number) should be used to obtain a telephone number for an attorney or agent of record.

(2) If the caller identified himself or herself as an applicant or an authorized representative of the assignee of record, PALM Intranet or the 2950 PALM screen should be used to verify the correspondence address of record. PALM Intranet or the 2954 PALM screen should be used to determine if there is an attorney or agent of record. If there is an attorney or agent of record, their telephone number can be obtained from PALM Intranet or the 3552 PALM screen.

(C) Then, return the call using the telephone number as specified below.

(1) If an attorney or agent is of record in the application, information concerning the application should only be released by calling the attorney's or agent's telephone number obtained from PALM Intranet or the 3552 PALM screen.

(2) If the applicant or an authorized representative of the assignee of record requests information, and there is no attorney or agent of record and the correspondence address of record has been verified, information concerning the application can be released to the caller using the telephone number given by the caller. If the caller's association with the application cannot be verified, no information concerning the application will be released. However, the caller should be informed that the caller's association with the application could not be verified.

In handling an in-person request, ask the requester to wait while verifying their identification as in (B) above.

## 102 Information as to Status of an Application

*37 CFR 1.14. Patent applications preserved in confidence.*

(a) Patent applications are generally preserved in confidence pursuant to 35 U.S.C. 122. No information will be given concerning the filing, pendency, or subject matter of any application for patent, and no access will be given to, or copies furnished of, any application or papers relating thereto, except as set forth in this section.

(1) Status information includes information such as whether the application is pending, abandoned, or patented, as well as the application number and filing date (or international filing date or date of entry into the national stage).

(i) Status information concerning an application may be supplied:

(A) When copies of, or access to, the application may be provided pursuant to paragraph (a)(3) of this section;

(B) When the application is identified by application number or serial number and filing date in a published patent document or in a U.S. application open to public inspection; or

(C) When the application is the national stage of an international application in which the United States of America has been indicated as a Designated State.

(ii) Status information concerning an application may also be supplied when the application claims the benefit of the filing date of an application for which status information may be provided pursuant to paragraph (a)(1)(i) of this section.

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Status information of an application means only the following information:

(A) whether the application is pending, abandoned, or patented;

(B) the application number and filing date; and

(C) whether one or more applications claim the benefit of the filing date of the identified application, and if there is such other application(s), the application number(s), filing date(s) and whether the other application(s) is (are) pending, abandoned or patented.

A requester seeking status information regarding an application should contact the File Information Unit (see MPEP § 1730). The File Information Unit will check the relevant Office records and will inform the requester whether the application has issued as a patent, and if the application has issued as a patent, the patent number, issue date and classification. If the application has not issued as a patent, but is pending or abandoned then the File Information Unit should determine whether the requester is:

- (A) an inventor;
- (B) the attorney or agent of record in the application;
- (C) the assignee of record in the application; or
- (D) a person with written authority from (A), (B), or (C).

If the requester is (A), (B), (C), or (D), as set forth above, then the requester is entitled to status information. If the requester is inquiring about whether a reply was received or when an Office action can be expected, the requester should be directed to call the Examining Group to which the application is assigned. The assignment of an application to a Group can be determined from PALM Intranet or the 2952 PALM screen.

If the requester is not (A), (B), (C), or (D), as set forth above, and the application is (1) identified by application number (or serial number and filing date) in a published patent document, or (2) an application claiming the benefit of the filing date of an application identified by application number (or serial number and filing date) in a published patent document, then a written request including a copy of a published patent document (United States or foreign) which refers to the specific application must be provided when requesting status information for the application. If the published patent document is not in English, then a translation of the pertinent part thereof must also be included. The published patent document may be presented in person to the File Information Unit or in written correspondence to the Patent and Trademark Office, for example, by facsimile transmission. Any written correspondence must include a return address or facsimile number. If the application is referred to by application number or serial number and filing date in a published patent document, pursuant to 37 CFR 1.14(a)(1)(i)(B), the requester is entitled to status information for the application. (The published patent document will at least identify the application from which the patent itself was issued.) PALM Intranet or the 2960 PALM screen should be used to determine the status of the application. If the requester asks whether there are any applications on file which claim the benefit of the filing date of the identified application, pursuant to 37 CFR 1.14(a)(1)(ii), status information (application number, filing date and whether the application is pending, abandoned or patented) for the applications claiming benefit of the identified application may be given to the requester as well. PALM Intranet or the 2962 PALM

screen should be used to determine the application number and filing date of any applications claiming the benefit of the filing date of the identified application. The requester should be informed of the national applications listed in the "child" section of the screen. If the child application is not shown to have been patented on the 2962 PALM screen, the 2960 PALM transaction should be used to determine whether the application is pending or abandoned. Alternatively, the 2963 PALM transaction may be used with the patent number for continuity data for the patent. Other information contained on the screen, such as whether it is a C-I-P, continuation or divisional application, the date of abandonment of the application and issue date may be confidential information and should not be communicated. As to the extent of the chain of applications for which status information is available, the rule applies only to subsequent and not prior applications.

Furthermore, if the requester is not (A), (B), (C), or (D), as set forth above, but the application is a national stage application or any application claiming the benefit of the filing date of a published international application and the United States of America has been indicated as a Designated State in the international application, pursuant to 37 CFR 1.14(a)(1)(i)(C), the requester is entitled to status information for the national stage application as well as any application claiming the benefit of the filing date of the published international application. A copy of the published international application must be supplied with the status request. If the requester asks whether a national stage application has been filed, then the 3133 PALM screen should be used and the requester should be informed of any national stage application indicated. If status information is requested for any application claiming the benefit of the filing date of the referenced published international application, there is no single PALM transaction for this request. The status request should be forwarded to the PCT Help desk for a response to this inquiry (see MPEP § 1730). Alternatively, inquiries relating to applications claiming the benefit of the filing date of a published international application may be directed to the PCT Help desk. Only the serial number and filing date, or application number, as well as whether it is pending, abandoned, or patented may be given for the national stage application and for any applications claiming the benefit of the filing date of the referenced published international application. Other information contained on the screen, such as whether

it is a C-I-P, continuation or divisional application, the date of abandonment of the application and issue date may be confidential information and should not be communicated.

**STATUS LOCATION INFORMATION FOR OFFICE PERSONNEL**

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

However, inasmuch as all 06 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 File Information Unit (see MPEP § 1730) 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 or a statutory invention registration has been published, the specification, drawings, and all papers relating to the case in the file of the patent or statutory invention registration are open to inspection by the public, and copies may be obtained upon paying the fee therefor. See § 2.27 for trademark files.

(b) All reissue applications, all applications in which the Office has accepted a request to open the complete application to inspection by the public, and related papers in the application file, are open to inspection by the public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications, other than continued prosecution applications under § 1.53(d) 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 reissue 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.

(e) The file of any interference involving a patent, a statutory invention registration, a reissue application or an application on which a patent has been issued or which has been published as a statutory

invention registration, is open to inspection by the public, and copies may be obtained upon paying the fee therefor, if: (1) the interference has terminated, or (2) an award of priority or judgment has been entered as to all parties and all counts.

**OBTAINING A COPY OF A PENDING APPLICATION THAT IS INCORPORATED BY REFERENCE IN A UNITED STATES PATENT**

*37 CFR 1.14. Patent applications preserved in confidence.*

(a) Patent applications are generally preserved in confidence pursuant to 35 U.S.C. 122. No information will be given concerning the filing, pendency, or subject matter of any application for patent, and no access will be given to, or copies furnished of, any application or papers relating thereto, except as set forth in this section.

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(2) Copies of an application—as—filed may be provided to any person, upon written request accompanied by the fee set forth in § 1.19(b)(1), without notice to the applicant, if the application is incorporated by reference in a U.S. patent.

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The incorporation by reference of a pending application in a printed United States patent constitutes a special circumstance under 35 U.S.C. 122 warranting that a copy of the application—as—filed be provided upon written request. The written request, including a copy of the page of the United States patent including the incorporation by reference, and the requisite fee set forth in 37 CFR 1.19(b)(1), should be directed to Certification Division. However, an incorporation by reference that is made as part of a transmittal letter for the application, or as part of text of the application that is later canceled and which does not appear as part of the printed patent, may not be relied upon to obtain a copy of the application as originally filed. A petition for access with an explanation of special circumstances other than the not—printed incorporation by reference will be required.

**APPLICATION FILES AVAILABLE UPON REQUEST**

*37 CFR 1.14. Patent applications preserved in confidence.*

(a) Patent applications are generally preserved in confidence pursuant to 35 U.S.C. 122. No information will be given concerning the filing, pendency, or subject matter of any application for patent, and no access will be given to, or copies furnished of, any application or papers relating thereto, except as set forth in this section.

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(3) Copies of (upon payment of the fee set forth in § 1.19(b)(2)), and access to, an application file wrapper and contents may be provided to any person, upon written request, without notice to the applicant, when the application file is available and:

(i) It has been determined by the Commissioner to be necessary for the proper conduct of business before the Office or warranted by other special circumstances;

(ii) The application is open to the public as provided in § 1.11(b);

(iii) Written authority in that application from the applicant, the assignee of the application, or the attorney or agent of record has been granted; or

(iv) The application is abandoned, but not if the application is in the file jacket of a pending application under § 1.53(d), and is:

(A) Referred to in a U.S. patent;

(B) Referred to in a U.S. application open to public inspection;

(C) An application which claims the benefit of the filing date of a U.S. application open to public inspection; or

(D) An application in which the applicant has filed an authorization to lay open the complete application to the public.

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Certain applications are available to the public without a petition for access. ABANDONED applications meeting the requirements of 37 CFR 1.14(a)(3)(iv) and any application that is open to the public under 37 CFR 1.11 may be obtained by any person upon written request to the File Information Unit without the specific written authority of the applicant, assignee, attorney or agent of record or Commissioner. The following abandoned applications are available from the File Information Unit: (1) An ABANDONED application referred to in the application which issued as a patent; and (2) a pending File Wrapper Continuation application (FWC) filed under former 37 CFR 1.62 of an abandoned application that meets the requirements of 37 CFR 1.14(a)(3)(iv). Under former 37 CFR 1.62(f), where access is permitted to an application within the file wrapper of a FWC application, the applicant has waived the right to keep all other applications in the same file wrapper in confidence.

An abandoned application that is in the file wrapper of a pending Continued Prosecution Application (CPA) filed under 37 CFR 1.53(d) is not available without the specific written authority of the applicant, assignee, attorney or agent of record, or Commissioner. 37 CFR 1.14(a)(3)(iv).

37 CFR 1.14(a)(3)(iv)(B) relates only to United States applications that are open to public inspection. Published applications, such as PCT applications, are not United States applications that are open to public inspection under 37 CFR 1.14(a)(3)(iv)(B). Accordingly, if the application is mentioned in a published PCT application as a priority document, access is not available under 37 CFR 1.14(a)(3).

An ABANDONED application referenced in a U.S. patent or referenced in a U.S. application that is open to public inspection may be ordered for inspection by any member of the public through the File Information Unit. Furthermore, an abandoned U.S. application which claims the filing date of a U.S. application open to public inspection may also be ordered by any member of the public through the File Information Unit. Orders for files stored in repositories within the Crystal City (Arlington, Virginia) area are normally filled within 4 to 8 hours. Orders for files stored at the Federal Records Center in Suitland, Maryland, are normally filled within 4 to 5 days. An abandoned file received by a member of the public must be returned to the charge counter in the File Information Unit before closing the same day it is received. If the abandoned application is contained within a pending FWC application, the requester will generally be routed to the appropriate examining group to inquire as to the availability of the pending FWC application. If the pending FWC application is available, then it will be forwarded to the File Information Unit for the requester to pick-up.

Furthermore, copies of a patent application—as-filed and the contents of a patent application file wrapper may be ordered from Certification Division with a facsimile request and payment of the appropriate fee under 37 CFR 1.19(b) by PTO Deposit Account, MasterCard or Visa by any person having a right to access to the originally filed application or patent. Regular service requests for an application—as-filed are processed in about 17 days, and expedited requests for an application as filed are processed in about 7 days. Copies of a patent related file wrapper are generally made in about 25 days.

The Office does not provide for access to non-United States applications.

## PETITION FOR ACCESS

37 CFR 1.14. *Patent applications preserved in confidence.*

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(e) Any request by a member of the public seeking access to, or copies of, any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or 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.

(Note, see § 1.612(a) for access by an interference party to a pending or abandoned application.)

Any interested party may file a petition, accompanied by the petition fee, to the Commissioner for access to an application. Inasmuch as the post office address is necessary for the complete identification of the petitioner, it should always be included complete with zip code number. Petitions for access are handled in the Special Program Law Office, unless the application is involved an interference. See MPEP 1002.02(a).

The petition may be filed either with proof of service of copy upon the applicant, assignee of record, or attorney or agent of record in the application to which access is sought, or the petition may be filed in duplicate, in which case the duplicate copy will be sent by the Office to the applicant, assignee of record, or attorney or agent of record in the application (hereinafter "applicant"). A separate petition, with fee, should be filed for each application to which access is desired. Each petition should show not only why access is desired, but also why petitioner believes he or she is entitled to access. The applicant will normally be given a limited period such as 3 weeks within which to state any objection to the granting of the petition for access and reasons why it should be denied. If applicant states that he or she has no objection to the requested access, the petition will be granted. If objection is raised or applicant does not respond, the petition will be decided on the record. A determination will be made whether "special circumstances" are present which warrant a grant of access under 35 U.S.C. 122. See below when the application is the basis of a claim for benefit of an earlier filing date under 35 U.S.C. 120 or part of the application is incorporated by reference in a United States patent. "Special circumstances" could be found where an applicant has relied upon his or her application as a means to interfere with a competitor's business or customers. See *In re Crossman*, 187 USPQ 367 (PTO Solicitor 1975); *In re Trimless Cabinets*, 128 USPQ 95 (Comm'r Pat. 1960); and *Ex parte Bonnie-B Co.*, 1923 C.D. 42, 313 O.G. 453 (Comm'r Pat. 1922). Furthermore, "special circumstances" could be found where an attorney of record in an application in which a provisional double patenting rejection is made does not have power of attorney in the copending application having a common assignee or inventor. However, a more expeditious means of obtaining access would be getting a power to inspect from an assignee or inventor. See MPEP § 104 and § 106.01.

**ACCESS WHERE PATENT CLAIMS 35 U.S.C. 120 BENEFIT**

Whenever a patent relies on 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. *In re Dreyfus*, 137 USPQ 475 (Comm'r Pat. 1961). If applicant objects to the petition for access, he or she must submit along with the objection two sets of a copy of the portion of the application that relates to the common subject matter including all materials relating to the prosecution in the application of the subject matter claimed in the patent. Failure to submit these materials will result in the entire application file being made available to petitioner. The Office will not attempt to separate the noted materials from the remainder of the application. Compare *In re Marsh Eng'g. Co.*, 1913 C.D. 183 (Comm'r Pat. 1913).

**ACCESS TO PROVISIONAL APPLICATIONS**

In provisional applications, access or certified copies will only be given to parties with written authority from a named inventor, the assignee of record, or the attorney or agent of record. Since provisional applications do not require an oath or declaration, there may be no power of attorney in the application. If the person requesting a certified copy is not a named inventor, assignee of record, or an attorney or agent of record, the requested certified copy will be supplied to the correspondence address of the provisional application. Provisional applications are also available in the same manner as any other application. For example, an application that is relied upon for priority in a U.S. patent and is abandoned is available under 37 CFR 1.14(a)(3)(iv)(A).

**ACCESS WHERE PART OF AN APPLICATION IS INCORPORATED BY REFERENCE IN A UNITED STATES PATENT**

37 CFR 1.14(a)(2) permits a member of the public, without a petition for access, to obtain a copy of a pending application, as originally filed, when the application is incorporated by reference in a United States patent upon filing of the appropriate request and payment of the required fee. However, if only part of the application is incorporated by reference, for example, where an application states, "the disclosure of a valve on page 5, lines 5-35, of application No. XX/YYYY,YYY, is hereby in-

incorporated by reference," then a petition for access is required to obtain access to or a copy of the incorporated material. Incorporation by reference of part of an application in a United States patent constitutes a special circumstance under 35 U.S.C. 122 warranting that access to that part of the original disclosure of the application be granted on petition. The incorporation by reference will be interpreted as a waiver of confidentiality of only that part of the original disclosure, as filed, and not the entire application file. *In re Gallo*, 231 USPQ 496 (Comm'r Pat. 1986). If applicant objects to access to the entire application file, two copies of the information incorporated by reference must be submitted along with the objection. In the example given, applicant would be required to provide two copies of page 5, lines 5–35 of the XX/YYYY,YYY application. Failure to provide the material within the period provided will result in the entire application (including prosecution) being made available to petitioner. The Office will not attempt to separate the noted materials from the remainder of the application. Compare *In re Marsh Eng'g. Co.*, 1913 C.D. 183 (Comm'r Pat. 1913).

#### APPLICATION AT BOARD OF PATENT APPEALS AND INTERFERENCES

The Board of Patent Appeals and Interferences handles all petitions for access to applications involved in an interference. See 37 CFR 1.612.

#### PUBLISHED DOCUMENTS

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 MPEP § 711.06.

#### REISSUE APPLICATIONS

37 CFR 1.11(b) opens all reissue applications filed after March 1, 1977 to inspection by the general public. 37 CFR 1.11(b) also provides for announcement of the filings of reissue applications in the *Official Gazette* (except for continued prosecution applications filed under 37 CFR 1.53(d)). This announcement will give interested members of the public an opportunity to submit to the examiner information pertinent to patentability of the reissue application.

The filing of a continued prosecution application under 37 CFR 1.53(d) of a reissue application will not be

announced in the *Official Gazette*. Although the filing of a continued prosecution application of a reissue application constitutes the filing of a reissue application, the announcement of the filing of such continued prosecution application would be redundant in view of the announcement of the filing of the prior reissue application in the *Official Gazette*.

37 CFR 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 Special Program Examiner 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—

(A) The filing of reissue applications will be announced in the *Official Gazette* (except for continued prosecution applications filed under 37 CFR 1.53(d) and will include certain identifying data as specified in 37 CFR 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 File Information Unit (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.

(B) The pending 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. No access will be permitted while the application is actively being processed.

(C) 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.

(D) The reissue application file is not available to the public once the reissue application file has been released and forwarded by the examining group for publication of the reissue patent. This would include any reissue application files which have been selected for a quality review check at the Office of Quality Review. Unless prosecution is reopened pursuant to a quality review check, the reissue application files are not



available to the public until the reissue patent issues. This is because the reissue application file has been put into a special format for printing purposes and to prevent disruption of the publication process.

(E) Requests for copies of papers in the reissue application file must be in writing addressed to Box 10, Commissioner of Patents and Trademarks, Washington, DC 20231 and may be either mailed or delivered to the Customer Service Window. The price for a copy of an application as filed is set forth in 37 CFR 1.19(a)(3). Since no useful purpose is seen for retaining such written request for copies of papers in reissue applications, 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 37 CFR 1.520 will be published in the *Official Gazette*. Procedures for access and obtaining copies are normally the same as those for reissue applications indicated above. See also MPEP § 2232 for certain times when the reexamination file is not available for public inspection.

### DECISIONS OF PATENT AND TRADEMARK OFFICE

37 CFR 1.14. *Patent applications preserved in confidence.*

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(d) Any decision of the Board of Patent Appeals and 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.

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37 CFR 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 Appeals and Interferences and the Commissioner. The section is applicable to decisions deemed by the Commissioner to involve an interpretation of patent laws or regulation 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.

37 CFR 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 1.15. *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 the rules in this part shall be made in writing, with the envelope and the letter clearly marked "Freedom of Information Request." Each such request, so marked, should be submitted by mail addressed to the "Patent and Trademark Office, Freedom of Information Request Control Desk, Box 8, Washington, D.C. 20231," or hand delivered to the Office of the Solicitor, Patent and Trademark Office, Arlington, Virginia. The request will be processed in accordance with the procedures set forth in Part 4 of Title 15, Code of Federal Regulations.

(b) Any person whose request for records has been initially denied in whole or in part, or has not been timely determined, may submit a written appeal as provided in § 4.8 of Title 15, Code of Federal Regulations.

(c) Procedures applicable in the event of service of process or in connection with testimony of employees on official matters and production of official documents of the Patent and Trademark Office in civil legal proceedings not involving the United States shall be those established in parts 15 and 15a of Title 15, Code of Federal Regulations.

### ACCESSIBILITY OF NONFINAL DISCOVERY OPINIONS AND ORDERS ISSUED BY THE BOARD OF PATENT APPEALS AND INTERFERENCES

A number of inquiries have been received from the patent bar and other interested persons relating to discovery practice in interferences before the Board of Patent Appeals and Interferences. The inquiries indicate a need for making available to the public nonfinal Board opinions, including concurring and dissenting

opinions, as well as orders, made in the adjudication of discovery matters before the Board. While nonfinal opinions need not be made available to the public (5 U.S.C. 552(a)(2)), in order to satisfy the need, copies of non-final opinions issued by the Board will be kept in a collection 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 collection may be reviewed by the public during normal business hours (8:30 A.M. to 5:00 P.M.). Copies of opinions may be ordered at the cost set forth in 37 CFR 1.19(b)(3).

In view of the provisions of 35 U.S.C. 122 and 37 CFR 1.14(a)(3)(iii), 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 collection 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 collection, 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 collection may be directed to the Board.

The initial index is as follows:

### INDEX

- 1.00 Discovery in general [37 CFR 1.673]
- 1.10 Requests and service under 37 CFR 1.673
- 1.20 Requests under 37 CFR 1.687(b)
- 1.30 Motions for additional discovery under 37 CFR 1.687(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 37 CFR 1.673(c)

## 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, associate attorney, or agent 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), former 37 CFR 1.62(f), 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.

A person acting in a representative capacity under 37 CFR 1.34(a) may not execute a power to inspect an application. For a discussion of power of attorney in an application, see MPEP § 402.

Approval by the primary examiner of a power to inspect is *not* required. The technical support staff 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 it into the file. If the power to inspect is unacceptable, notification of non-entry is written by the technical support staff 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 Patent Appeals and Interferences, and the Publishing Division of the Office of Patent Publication, 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.

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

Where an applicant relied on his or her 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.*, 1923 C.D. 42, 313 O.G. 453, (Comm'r Pat. 1922). Such permission is via petition for access under 37 CFR 1.14(e).

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 or her connection with the application.

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

### ACCESS TO PATENT APPLICATIONS PROVISIONAL AND NONPROVISIONAL AND INTERFERENCE FILES

In order to ensure that access to patent applications, other than reissue applications filed after March 1, 1977, and interference files is given only to persons who are en-

titled thereto or who are specially authorized to have access under 37 CFR 1.14 and to ensure 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:

(A) Access, as provided for in the rules, 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.

(B) 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 (A) above to any registered member or employee of the firm who has signatory power for the firm.

(C) Unregistered employees of attorneys or agents, public stenographers, and all other persons not within the provisions of paragraphs (A) and (B) above will be given access only upon presentation of a *written authorization for access* (power to inspect) signed by a person specified in paragraph (A) above, which authorization will be entered as a part of the official file. The power to inspect must *specifically* name the person who is entitled to inspect and copy the application. An associate or representative of the named person is not entitled to access to the application on behalf of the authorized person. Further, the power to inspect must specifically identify the application by application number and be limited to a single application.

(D) In provisional applications, access or certified copies will only be given to parties with written authority from a named inventor, the assignee of record, or the attorney or agent of record. Since provisional applications do not require an oath or declaration, there may be no power of attorney in the application. If the person requesting a certified copy is not a named inventor, assignee of record, or an attorney or agent of record, the requested certified copy will be supplied to the correspondence address of the provisional application.

### 105 Suspended or Excluded Practitioner Cannot Inspect

Patent and Trademark Office employees are forbidden to hold either oral or written communication with an attorney or agent who has been suspended or excluded

from practice regarding an application unless it be one in which said attorney or agent is the applicant. Power to inspect given to such an attorney or agent will not be accepted.

### 106 Control of Inspection by Assignee

The assignee of record of the entire interest in an application may intervene in the prosecution of the case, appointing an attorney of his or her own choice. See 37 CFR 3.71. 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. Any request to prevent the inventor from obtaining access to the file should be filed as a separate paper, 37 CFR 1.4(c), and should be directed to the Office of Petitions. If the request is granted, the inventor will be informed that he or she will only be permitted to inspect the application on sufficient showing why such inspection is necessary to conserve his or her rights. *In re The Kellogg Switchboard & Supply Company*, 1906 C.D. 274 (Comm'r Pat. 1906).

### 106.01 Rights of Assignee of Part Interest

While it is only the assignee of record 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. See also MPEP § 402.10 for applications accorded status under 37 CFR 1.47.

### 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 and Trademark 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 made 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 and Trademark Office when acting as a Receiving Office, International Searching Authority, or International Preliminary Examining Authority, may not disclose the contents of such application to anyone not authorized to receive such disclosure.

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.

## 115 Review of Applications for National Security and Property Rights Issues

All applications filed in the Patent and Trademark Office are screened for subject matter the disclosure of which might impact the national security based on information provided by the Armed Services Patent Advisory Board (ASPAB), the Department of Energy

(DOE), and the National Aeronautics and Space Administration (NASA). Such applications are referred to the appropriate agencies. Authority for this referral can be found in 35 U.S.C. 181 which provides, in part:

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Whenever the publication or disclosure of an invention by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

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If the agency concludes that disclosure of the invention would be detrimental to the national security, the Commissioner is notified. The Commissioner then issues a Secrecy Order and withholds the grant of a patent for such period as the national interest requires.

For those applications in which the Government has a property interest, responsibility for notifying the Commissioner of the need for a Secrecy Order resides with the agency having that interest.

A second purpose for the screening of all applications is to identify inventions in which DOE or NASA might have property rights. See 42 U.S.C. 2182 and 42 U.S.C. 2457 and MPEP § 150.

A third function of the screening procedure is to process foreign filing license petitions under 37 CFR 5.12(a). See MPEP § 140.

Some applications have a label (Form PTO-1305) on the upper right hand corner of the face of the file wrapper. A Notice of Allowance and Issue Fee Due may not be mailed for those applications if the "REV" on the label is circled (although the Examiner may be given credit for a disposal). Such cases must be forwarded to Licensing and Review to have the security review completed before the Notice of Allowance can be mailed. Cases in which only "DOE" and/or "NASA" is circled should be counted for allowance and the notice of allowance mailed before being sent to Licensing and Review for processing under the Atomic Energy and Space Acts.

While the initial screening is performed only by designated personnel, all examiners have a responsibility to be alert for obviously sensitive subject matter either in the original disclosure or subsequently introduced, for example, by amendment. Such applications should be forwarded to Licensing & Review. It would be helpful if the examiner would identify the significant subject matter such as by a check mark in the margin of the paper.

## 120 Secrecy Orders

### 37 CFR 5.1. Correspondence.

All correspondence in connection with this part, including petitions, must be addressed to "Assistant Commissioner for Patents (Attention Licensing and Review), Washington, DC 20231."

### 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) Any request for compensation as provided in 35 U.S.C. 183 must not be made to the Patent and Trademark Office, but directly to the department or agency which caused the secrecy order to be issued.

### 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 is under secrecy order seeks to provoke an interference with an issued patent, a notice of that fact will be placed in the file wrapper of the patent. (See § 1.607(d)).

(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 reply 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.

(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) 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 sixty 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.

### 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.

(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) 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.

## SECURITY ORDER TYPES

Three types of Secrecy Orders, each of a different scope, are issued as follows:

(A) Secrecy Order and Permit for Foreign Filing in Certain Countries — to be used for those patent applications that contain technical data whose export is controlled by the guidelines contained in DoD Directive

5230.25 dated November 6, 1984 which reviews export control under 10 U.S.C. 140(c) and the Militarily Critical Technology List (MCTL).

(B) Secrecy Order and Permit for Disclosing Classified Information — to be used for those patent applications which contain technical data that is properly classified or classifiable (no Government interest) under a security guideline where the patent application owner has a current DoD Security Agreement, DD Form 441. If the application is classifiable, this secrecy order allows disclosure of the technical information as if it were classified as prescribed in the Industrial Security Manual (ISM).

(C) Secrecy Order — to be used for those patent applications that contain technical data properly classifiable under a security guideline where the patent application owner does not have a DoD Security Agreement. The order prevents disclosure of the subject matter to anyone without an express written consent from the Commissioner. However, quite often this type of secrecy order includes a permit "Permit A" which relaxes the disclosure restrictions as set forth in the permit.

The first Secrecy Order is intended to permit the widest utilization of the technical data in the patent application while still controlling any publication or disclosure which would result in an unlawful exportation. This type of Secrecy Order is based on the applicable export controls in either the Commodity Control List (CCL) or the Munitions Lists of the International Traffic in Arms Regulation (ITAR), and identifies the countries where corresponding patent applications may be filed. Countries with which the United States has reciprocal security agreements are: Australia, Belgium, Canada, Denmark, France, Germany, Greece, Italy, Japan, Luxembourg, Netherlands, Norway, Portugal, Spain, Sweden, Turkey and the United Kingdom. Please note that applications subject to a secrecy order cannot be filed directly with the European Patent Office since no reciprocal security agreement with this organization exists. Applications must be filed in the individual EPO member countries identified above.

The intent of the second Secrecy Order is to treat classified technical data presented as a patent application in the same manner as any other classified material. Accordingly, this Secrecy Order will include a notification

of the classification level of the technical data in the application.

The third type of Secrecy Order is used where the other types of Orders do not apply, including Orders issued by direction of agencies other than the Department of Defense.

A Secrecy Order should not be construed in any way to mean that the Government has adopted or contemplates adoption of the alleged invention disclosed in an application; nor is it any indication of the value of such invention.

#### RELATED SUBJECT MATTER

The Secrecy Orders apply to the subject matter of the invention, not just to the patent application itself. Thus, the Secrecy Order restricts disclosure or publication of the invention in any form. Furthermore, other patent applications already filed or later filed which contain any significant part of the subject matter of the application also fall within the scope of the Order and must be brought to the attention of Licensing & Review if such applications are not already under Secrecy Order by the Commissioner.

The effects of a Secrecy Order are detailed in the notifying letter and include restrictions on disclosure of the invention and delay of any patent grant until the Order is rescinded.

#### CORRESPONDENCE

When the Secrecy Order issues, the law specifies that the subject matter or any material information relevant to the application, including unpublished details of the invention, shall not be published or disclosed to any person not aware of the invention prior to the date of the Order, including any employee of the principals except as permitted by the Secrecy Order. The law also requires that all information material to the subject matter of the application be kept in confidence, unless written permission to disclose is first obtained from the Commissioner of Patents and Trademarks except as provided by the Secrecy Order. Therefore, all correspondence to be filed in an application which is subject to a secrecy order and which is directly related to the subject matter covered by the secrecy order must be transmitted to the Office in a manner which would preclude disclosure to unauthorized individuals and addressed as set forth in 37 CFR 5.1. Use of facsimile transmission is not permitted. 37 CFR 1.6(d)(6).

Subject matter under Secrecy Order must be safeguarded under conditions that will provide adequate protection and prevent access by unauthorized persons.

When applicants desire to change the Power of Attorney in an application under Secrecy Order, the name, date of birth and Social Security number of the new attorney(s) should be included in the change notice so that Licensing and Review may conduct the necessary access security clearance checks.

Applicants should also ensure that the correspondence address (37 CFR 1.33) of any application under Secrecy Order represents a location suitable for the receipt of security information.

### **PCT APPLICATIONS**

If the 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 time limit under PCT Rule 22.3, the international application will be considered 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 withdrawal.

### **CHANGES IN SECRECY ORDERS**

Applicants may petition for rescission or modification of the Secrecy Order. For example, if the applicant believes that certain existing facts or circumstances would render the Secrecy Order ineffectual, he or she may informally contact the sponsoring agency to discuss these facts or formally petition the Commissioner to rescind the Order. The applicant may also petition the Commissioner for a permit to disclose the invention to another or to modify the Secrecy Order stating fully the reason or purpose for disclosure or modification. An example of such a situation would be a request to file the application in a foreign country. The requirements for petitions are described in 37 CFR 5.4 and 5.5. The law also provides that if an appeal is necessary, it may be taken to the Secretary of Commerce. Any petition or appeal should be addressed to the Assistant Commissioner for Patents, Attention: Licensing and Review, Washington, DC 20231.

### **IMPROPER OR INADVERTENT DISCLOSURE**

If, prior to or after the issuance of the Secrecy Order, any significant part of the subject matter or material information relevant to the application has been or is revealed to any U.S. citizen in the United States, the principals must promptly inform such person of the Secrecy Order and the penalties for improper disclosure. If such part of the subject matter was or is disclosed to any person in a foreign country or foreign national in the U.S., the principals must not inform such person of the Secrecy Order, but instead must promptly furnish to the Assistant Commissioner for Patents, Patent and Trademark Office, Attention: Licensing and Review Washington, D.C. 20231 the following information to the extent not already furnished: date of disclosure; name and address of the discloser; identification of such subject matter; and any authorization by a U.S. government agency to export such subject matter. If the subject matter is included in any foreign patent application or patent, this should be identified.

### **EXPIRATION**

Under the provision of 35 U.S.C. 181, a Secrecy Order remains in effect for a period of 1 year from its date of issuance. A Secrecy Order may be renewed for additional periods of not more than 1 year upon notice by a government agency that the national interest so requires. The applicant is notified of any such renewal.

The expiration of or failure to renew a Secrecy Order does not lessen in any way the responsibility of the principals for the security of the subject matter if it is subject to the provisions of Exec. Order No. 12,958 or the Atomic Energy Act of 1954, as amended, 42 U.S.C. 141 *et. seq.* and 42 U.S.C. 2181 *et. seq.* or other applicable law unless the principals have been expressly notified that the subject patent application has been declassified by the proper authorities and the security markings have been authorized to be canceled or removed.

### **121 Handling of Applications and Other Papers Bearing Security Markings**

Under Executive Order for Classified National Security Information (Exec. Order No. 12,958, 60 FR 19,825 (April 20, 1995)) standards are prescribed 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 3640 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(v).

### 130 Examination of Secrecy Order Cases

All applications in which a Secrecy Order has been imposed are examined in Group 3640. If the Order is imposed subsequent to the docketing of an application in another group, the application will be transferred to Group 3640.

Secrecy Order cases are examined for patentability 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 classified or under Secrecy Order. See MPEP § 2309.06. When requested to do so by examiners outside Group 3640, examiners in Group 3640 will conduct the interference searches of those interference files containing briefcards from classified or Secrecy Order cases.

In case of a final rejection, while such action must be properly replied 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 Patent Appeals and Interferences 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.

Due to the additional administrative burdens associated with handling papers in Secrecy Order cases, the full

statutory period for reply will ordinarily be set for all Office actions issued on such cases.

Sometimes applications bearing security markings but no Secrecy Order come up for examination. In this case, the examiner should require the applicant to seek imposition of a Secrecy Order or authority to cancel the markings. This should preferably be done with the first action and, in any event, prior to final disposition of the application.

### 140 Foreign Filing Licenses

#### 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 filed abroad through error and without deceptive intent 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.

The scope of a license shall permit subsequent modifications, amendments, and supplements containing additional subject matter if the application upon which the request for the license is based is not, or was not, required to be made available for inspection under section 181 of this title and if such modifications, amendments, and supplements do not change the general nature of the invention in a manner which would require such application to be made available for inspection under such section 181. In any case in which a license is not, or was not, required in order to file an application in any foreign country, such subsequent modifications, amendments, and supplements may be made, without a license, to the application filed in the foreign country if the United States application was not required to be made available for inspection under section 181 and if such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require the United States application to have been made available for inspection under such section 181.

#### 35 U.S.C. 185. *Patent barred for filing without license.*

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such a person, his successors, assigns, or legal representatives shall be invalid, unless the failure to procure such license was through error and without deceptive intent, and the patent does not disclose subject matter within the scope of section 181 of this title.



*35 U.S.C. 186. Penalty.*

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever willfully, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than \$10,000 or imprisoned for not more than two years, or both.

The amendments made to 35 U.S.C. 184, 185, and 186 by Public Law 100-418 apply to all United States patents granted before, on, or after August 23, 1988, to all applications for United States patents pending on or filed after August 23, 1988, and to all licenses under 35 U.S.C. 184 granted before, on, or after August 23, 1988.

More specifically, paragraphs (c) and (d) of section 9101 of Public Law 100-418 read as follows:

Sec. 9101. INCREASED EFFECTIVENESS OF PATENT LAW

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(c) REGULATIONS.-- The Commissioner of Patents and Trademarks shall prescribe such regulations as may be necessary to implement the amendments made by this section.

(d) EFFECTIVE DATE.-- (1) Subject to paragraphs (2), (3), and (4) of this subsection, the amendments made by this section shall apply to all United States patents granted before, on, or after the date of enactment of this section, to all applications for United States patents pending on or filed after such date of enactment, and to all licenses under section 184 granted before, on, or after the date of enactment of this section.

(2) The amendments made by this section shall not affect any final decision made by a court or the Patent and Trademark Office before the date of enactment of this section with respect to a patent or application for patent, if no appeal from such decision is pending and the time for filing an appeal has expired.

(3) No United States patent granted before the date of enactment of this section shall abridge or affect the right of any person or his successors in business who made, purchased, or used, prior to such date of enactment, anything protected by the patent, to continue the use of, or sell to others to be used or sold, the specific thing so made, purchased, or used, if the patent claims were invalid or otherwise unenforceable on a ground obviated by this section and the person made, purchased, or used the specific thing in reasonable reliance on such invalidity or unenforceability. If a person reasonably relied on such invalidity or unenforceability, the court before which such matter is in question may provide for the continued manufacture, use, or sale of the thing made, purchased, or used as specified, or for the manufacture, use, or sale of which substantial preparation was made before the date of enactment of this section, and it may also provide for the continued practice of any process practiced, or for the practice of which substantial preparation was made, prior to the date of enactment of this section, to

the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before such date of enactment.

(4) The amendments made by this section shall not affect the right of any party in any case pending in court on the date of enactment of this section to have its rights or liabilities --

(A) under any patent before the court, or

(B) under any patent granted after such date of enactment which is related to the patent before the court by deriving priority right under section 120 or 121 of title 35, United States Code, from a patent or an application for patent common to both patents, determined on the basis of the substantive law in effect before the date of enactment of this section.

*35 U.S.C. 187. Nonapplicability to certain persons*

The prohibitions and penalties of this chapter shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

*35 U.S.C. 188. Rules and regulations, delegation of power.*

The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective department or agency to carry out the provisions of this chapter, and may delegate any power conferred by this chapter.

*37 CFR 5.11. License for filing in a foreign country an application on an invention made in the United States or for transmitting an international application.*

(a) A license from the Commissioner of Patents and Trademarks under 35 U.S.C. 184 is required before filing any application for patent including any modifications, amendments, or supplements thereto or divisions thereof or for the registration of a utility model, industrial design, or model, in a foreign patent office or any foreign patent agency or any international agency other than the United States Receiving Office, if the invention was made in the United States and:

(1) An application on the invention has been filed in the United States less than six months prior to the date on which the application is to be filed, or

(2) No application on the invention has been filed in the United States.

(b) The license from the Commissioner of Patents and Trademarks referred to in paragraph (a) would also authorize the export of technical data abroad for purposes relating to the preparation, filing or possible filing and prosecution of a foreign patent application without separately complying with the regulations contained in 22 CFR parts 121 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR part 779 (Regulations of the Office of Export Administration, International Trade Administration, Department of Commerce) and 10 CFR part 810 (Foreign Atomic Energy Programs of the Department of Energy).

(c) Where technical data in the form of a patent application, or in any form, is being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign patent application, without the license from the Commissioner of Patents and Trademarks referred to in paragraphs (a) or (b) of this section, or on an invention not made in the United States, the export regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 768-799 (Export Administration Regulations of the Department of Commerce) and 10 CFR part 810

(Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy) must be complied with unless a license is not required because a United States application was on file at the time of export for at least six months without a secrecy order under § 5.2 being placed thereon. The term "exported" means export as it is defined in 22 CFR part 120, 15 CFR part 779 and activities covered by 10 CFR part 810.

(d) If a secrecy order has been issued under § 5.2, an application cannot be exported to, or filed in, a foreign country (including an international agency in a foreign country), except in accordance with § 5.5.

(e) No license pursuant to paragraph (a) of this section is required:

- (1) If the invention was not made in the United States, or
- (2) If the corresponding United States application is not subject to a secrecy order under § 5.2, and was filed at least six months prior to the date on which the application is filed in a foreign country, or
- (3) For subsequent modifications, amendments and supplements containing additional subject matter to, or divisions of, a foreign patent application if:

(i) A license is not, or was not, required under paragraph (e)(2) of this section for the foreign patent application;

(ii) The corresponding United States application was not required to be made available for inspection under 35 U.S.C. 181 and

(iii) Such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require any corresponding United States application to be or have been available for inspection under 35 U.S.C. 181.

(f) A license pursuant to paragraph (a) of this section can be revoked at any time upon written notification by the Patent and Trademark Office. An authorization to file a foreign patent application resulting from the passage of six months from the date of filing of a United States patent application may be revoked by the imposition of a secrecy order.

#### 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 should be presented in letter form, and must include the petitioner's address and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner. If expedited handling of the petition under this paragraph is sought, the petition must also include the fee set forth in § 1.17(h).

#### 37 CFR 5.13. *Petition for license; no corresponding application.*

If no corresponding national or international application has been filed in the United States, the petition for license under § 5.12(b) must also be accompanied by a legible copy of the material upon which a license is desired. This copy will be retained as a measure of the license granted.

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

(a) When there is a corresponding United States application on file, a petition for license under § 5.12(b) must also identify this application by application number, filing date, inventor, and title, but 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.

(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 exported 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 for filing 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) Applications or other materials reviewed pursuant to §§ 5.12 through 5.14, which were not required to be made available for inspection by defense agencies under 35 U.S.C. 181, will be eligible for a license of the scope provided in this paragraph. This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign patent application, if such changes to the application do not alter the general nature of the invention in a manner which would require the United States application to have been made available for inspection under 35 U.S.C. 181. Grant of this license authorizing the export and filing of an application in a foreign country or the transmitting of an international application to any foreign patent agency or international patent agency when the subject matter of the foreign or international application corresponds to that of the domestic application. This license includes authority:

(1) To export and file all duplicate and formal application papers in foreign countries or with international agencies;

(2) To make amendments, modifications, and supplements, including divisions, changes or supporting matter consisting of the illustration, exemplification, comparison, or explanation of subject matter disclosed in the application; and

(3) To take any action in the prosecution of the foreign or international application provided that the adding of subject matter or taking of any action under paragraphs (a)(1) or (2) of this section does not change the general nature of the invention disclosed in the application in a manner which would require such application to have been made available for inspection under 35 U.S.C. 181 by including technical data pertaining to:

(i) Defense services or articles designated in the United States Munitions List applicable at the time of foreign filing, the unlicensed exportation of which is prohibited pursuant to the Arms Export Control Act, as amended, and 22 CFR parts 121 through 130; or

(ii) Restricted Data, sensitive nuclear technology or technology useful in the production or utilization of special nuclear material or atomic energy, dissemination of which is subject to restrictions of the Atomic Energy Act of 1954, as amended, and the Nuclear Non-Proliferation Act of 1978, as implemented by the regulations for Unclassified Activities in Foreign Atomic Energy Programs, 10 CFR part 810, in effect at the time of foreign filing.

(b) Applications or other materials which were required to be made available for inspection under 35 U.S.C. 181 will be eligible for a license of the scope provided in this paragraph. Grant of this license authorizes the export and filing of an application in a foreign country or

the transmitting of an international application to any foreign patent agency or international patent agency. Further, this license includes authority to export and file all duplicate and formal papers in foreign countries or with foreign and international patent agencies and to make amendments, modifications, and supplements to, file divisions of, 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.

(c) A license granted under § 5.12(b) pursuant to § 5.13 or § 5.14 shall have the scope indicated in paragraph (a) of this section, if it is so specified in the license. A petition, accompanied by the required fee (§ 1.17(h)), may also be filed to change a license having the scope indicated in paragraph (b) of this section to a license having the scope indicated in paragraph (a) of this section. No such petition will be granted if the copy of the material filed pursuant to § 5.13 or any corresponding United States application was required to be made available for inspection under 35 U.S.C. 181. The change in the scope of a license will be effective as of the date of the grant of the petition.

(d) 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.

(e) Any paper filed abroad or transmitted to an international patent agency following the filing of a foreign or international application which changes the general nature of the subject matter disclosed at the time of filing in a manner which would require such application to have been made available for inspection under 35 U.S.C. 181 or which involves the disclosure of subject matter listed in paragraphs (a)(3)(i) or (ii) of this section must be separately licensed in the same manner as a foreign or international application. Further, if no license has been granted under § 5.12(a) on filing the corresponding United States application, any paper filed abroad or with an international patent agency which involves the disclosure of additional subject matter must be licensed in the same manner as a foreign or international application.

(f) Licenses separately granted in connection with two or more United States applications may be exercised by combining or dividing the disclosures, as desired, provided:

(1) Subject matter which changes the general nature of the subject matter disclosed at the time of filing or which involves subject matter listed in paragraphs (a)(3)(i) or (ii) of this section is not introduced, and

(2) In the case where at least one of the licenses was obtained under § 5.12(b), additional subject matter is not introduced.

(g) A license does not apply to acts done before the license was granted. See § 5.25 for petitions for retroactive licenses.

*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 120 through 130); the articles designated as arms, ammunitions, and implements of war are enumerated in the U.S. Munitions List (22 CFR part 121). 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 5.12 (22 CFR part 125).

(b) When a patent application containing subject matter on the Munitions List (22 CFR part 121) 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 part 125).

*37 CFR 5.19. Export of technical data.*

(a) Under regulations (15 CFR 770.10(j)) established by the Department of Commerce, a 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 (§§ 5.11 through 5.25) of the Patent and Trademark Office.

(b) An 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 779A.3(e)).

*37 CFR 5.20. Export of technical data relating to sensitive nuclear technology.*

Under regulations (10 CFR 810.7) established by the United States Department of Energy, an application filed in accordance with the regulations (§§ 5.11 through 5.25) of the Patent and Trademark Office and eligible for foreign filing under 35 U.S.C. 184, is considered to be information available to the public in published form and a generally authorized activity for the purposes of the Department of Energy regulations.

*37 CFR 5.25. Petition for retroactive license.*

(a) A petition for a retroactive license under 35 U.S.C. 184 shall be presented in accordance with § 5.13 or § 5.14(a), and shall include:

(1) A listing of each of the foreign countries in which the unlicensed patent application material was filed.

(2) The dates on which the material was filed in each country,

(3) A verified statement (oath or declaration) containing:

(i) An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,

(ii) A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and

(iii) An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and

(4) The required fee (§ 1.17(h)).

The above explanation must include a showing of facts rather than a mere allegation of action through error and without deceptive intent. The showing of facts as to the nature of the error should include statements by those persons having personal knowledge of the acts regarding filing in a foreign country and should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. The acts which are alleged to constitute error without deceptive intent should cover the period leading up to and including each of the proscribed foreign filings.

(b) If a petition for a retroactive license is denied, a time period of not less than thirty days shall be set, during which the petition may be renewed. Failure to renew the petition within the set time period will result in a final denial of the petition. A final denial of a petition stands unless a petition is filed under § 1.181 within two months of the date of the denial. If the petition for a retroactive license is denied with respect

to the invention of a pending application and no petition under § 1.181 has been filed, a final rejection of the application under 35 U.S.C. 185 will be made.

In the interests of national security, the United States government imposes restrictions on the export of technical information. These restrictions are administered by the Departments of Commerce, State, and/or Energy depending on the subject matter involved. For the filing of patent applications in foreign countries, the authority for export control has been delegated to the Commissioner of Patents and Trademarks.

There are two ways in which permission to file a patent application abroad may be obtained: either a petition for a foreign filing license may be granted (37 CFR 5.12) or an applicant may wait 6 months after filing a patent application in the PTO (35 U.S.C. 184) at which time a license on that subject matter is no longer required as long as no Secrecy Order has been imposed. 37 CFR 5.11(e)(2).

There are several means by which a foreign filing license may be issued. First, every U.S. origin application filed in the PTO is considered to include an implicit petition for a foreign filing license. The grant of a license is not immediate or even ensured. If the application is not marked by the security screeners, the petition is granted. This is indicated to the applicant by the presence on the filing receipt of the phrase "Foreign Filing License Granted" and a date. The license becomes effective on the date shown. Further, grant of this license is made of record in the application file by means of a similar notation on the file wrapper of the application below the "Foreign/PCT Applications" data or on the PALM bib-data sheet. The scope of this license is quite broad as set forth in 37 CFR 5.15(a).

Explicit petitions for foreign filing licenses will also be accepted in accordance with 37 CFR 5.12(b). Applicants may be interested in such petitions in cases:

- (A) in which the filing receipt license is not granted;
- (B) in which the filing receipt has not yet been issued (37 CFR 5.14(a) or (b));
- (C) in which there is no corresponding U.S. application (37 CFR 5.13);
- (D) in which subject matter additional to that already licensed is sought to be licensed (37 CFR 5.14(c) and 5.15(e)); or
- (E) in which expedited handling is requested.

The scope of any license granted on these petitions is indicated on the license. If applicants desire expedited processing (turn around time of 3 business days or less starting with the date of receipt of the petition in Licensing and Review) or, if the petition covers subject matter corresponding to a U.S. application in which the filing receipt has not yet been issued, a fee is charged. See 37 CFR 1.17(h). There is no fee for other petitions under 37 CFR 5.12(b).

Petitions under 37 CFR 5.14(a) or (b) as well as any license granted on the petition are given paper numbers and endorsed on the file wrapper. Petitions under 37 CFR 5.14(c) are not ordinarily made of record in the file.

Applicants granted a license under 37 CFR 5.12(b) having the relatively narrow scope indicated in 37 CFR 5.15(b) may petition under 37 CFR 5.15(c) to convert the license to the broad scope of 37 CFR 5.15(a). A fee is charged for such a petition. See 37 CFR 1.17(h). If the petition is granted, the change in the scope of the license is effective as of that day.

Finally, a retroactive license may be sought if an unlicensed foreign filing has occurred through error and without deceptive intent. However, the requirements of 37 CFR 5.25 must be fulfilled in order for such a petition to be granted. Note that licenses under 37 CFR 5.25 are only made retroactive with respect to specific acts of foreign filing, and therefore the countries, the actual dates of filing and the establishing of the nature of the error must be provided for each act of proscribed foreign filing for which a retroactive license is sought. Also, the required verified statement must be in oath or declaration form.

Upon written notification from the Patent and Trademark Office, any foreign filing license required by 37 CFR 5.11(a) may be revoked. Ordinarily, revocation indicates that additional review of the licensed subject matter revealed the need for referral of the application to the appropriate defense agencies. Revocation of a filing receipt license (37 CFR 5.12(a)) does not necessarily mean that a petition under 37 CFR 5.12(b) for a license of narrower scope will not be granted. The revocation becomes effective on the date on which the notice is mailed. Foreign filings which occurred prior to revocation need not be abandoned or otherwise specially treated; however, additional filings without a license are not permitted unless 6 months have elapsed from the filing of any corresponding U.S. application. Papers and

other documents needed in support of prosecution of foreign applications may be sent abroad if they comply with any pertinent export regulations. Of course, if and once a Secrecy Order is issued, the restrictions thereof must immediately be observed.

Only the imposition of a Secrecy Order will cause revocation of the authority which arises from 35 U.S.C. 184 to file a foreign patent application 6 months or later after the date of filing of a corresponding U.S. patent application.

The penalties for failing to obtain any necessary license to file a patent application abroad are set forth in 35 U.S.C. 182, 35 U.S.C. 185, and 35 U.S.C. 186 and include loss of patenting rights in addition to possible fine or imprisonment.

## 150 Statements to DOE and NASA

37 CFR 1.14. Patent applications preserved in secrecy.

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(c) 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).

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Title 42 United States Code, Section 2182 reads in part:

No patent for any invention or discovery, useful in the production or utilization of special nuclear material or atomic energy, shall be issued unless the applicant files with the application, or within thirty days after request therefor by the Commissioner of Patents (unless the Commission advises the Commissioner of Patents that its rights have been determined and that accordingly no statement is necessary) a statement under oath setting forth the full facts surrounding the making or conception of the invention or discovery described in the application and whether the invention or discovery was made or conceived in the course of or under any contract, subcontract, or arrangement entered into with or for the benefit of the Commission, regardless of whether the contract, subcontract, or arrangement involved the expenditure of funds by the Commission. The Commissioner of Patents shall as soon as the application is otherwise in condition for allowance forward copies of the application and the statement to the Commission.

Similarly, 42 U.S.C. 2457 provides in part:

(c) *Patent application.* No patent may be issued to any applicant other than the Administrator for any invention which appears to the Commissioner of Patents to have significant utility in the conduct of

aeronautical and space activities unless the applicant files with the Commissioner, with the application or within thirty days after request therefor by the Commissioner, a written statement executed under oath setting forth the full facts concerning the circumstances under which such invention was made and stating the relationship (if any) of such invention to the performance of any work under any contract of the Administration. Copies of each statement and application to which it relates shall be transmitted forthwith by the Commissioner to the Administrator.

Property rights statements to DOE or NASA may be filed at any time but should be updated if necessary to accurately reflect property rights at the time the application is allowed.

Shortly after filing, an informal request for a property rights statement will be mailed to those applicants whose applications have been marked by the security screeners as being of interest to DOE or NASA. While no formal time period is set, a response by applicants within 45 days will expedite processing. If the statement submitted during this period is defective, another letter is sent from Licensing and Review detailing the deficiencies and giving applicant another opportunity to respond during this period of informal correspondence.

If no response to the initial so called 45-Day Letter is received or if repeated efforts to correct a defective statement evidence an absence of cooperation on the part of the applicant, a formal request for a statement in accordance with the statutes will be made. A 30-day statutory period for response is then set. There is no provision for an extension of this time period. If no proper and timely statement is received, the application will be held abandoned and the applicant so notified. Such applications may be revived under the provisions of 35 U.S.C. 137. *In re Rutan*, 231 USPQ 864 (Comm'r Pat. 1986).

Any papers pertaining to property rights under section 152 of the Atomic Energy Act, 42 U.S.C. 2182, (DOE), or section 305(c) or the National Aeronautics and Space Act, 42 U.S.C. 2457, (NASA), that have not been associated with the application file, or have not been made of record in the file and processed by the Licensing and Review section, must be sent to the Licensing and Review section immediately.

## 151 Content of the Statements

The law requires the statement to set forth "the full facts" surrounding the conception and making of the invention. These facts should include those which are unique to that invention. The use of form paragraphs or printed forms which set forth only broad generalized

statements of fact is not ordinarily regarded as meeting the requirements of these statutes.

The word "applicant" in both of these statutes has been construed to mean the inventor or joint inventors in person. Accordingly, in the ordinary situation, the statements must be signed by the inventor or the joint inventors, if available. This construction is consistent with the fact that no other person could normally be more knowledgeable of the "full facts concerning the circumstances under which such invention was made," (42 U.S.C. 2457) or, "full facts surrounding the making or conception of the invention or discovery" (42 U.S.C. 2182). If a petition under 37 CFR 1.48 for correction of inventorship is granted during pendency of an application in which a property rights statement has been filed, a supplemental statement executed by any added inventor(s) is required and should promptly be filed with the Licensing and Review section.

In instances where an applicant does not have first-hand knowledge whether the invention involved work under any contract, subcontract, or arrangement with or for the benefit of the Atomic Energy Commission, or had any relationship to any work under any contract of the National Aeronautics and Space Administration, and includes in his or her statement information of this nature derived from others, his or her statement should identify the source of his or her information. Alternatively, the statement by the applicant could be accompanied by a supplemental declaration or oath, as to the contractual matters, by the assignee or other person, e.g., an employee thereof, who has the requisite knowledge.

When an applicant is deceased or incompetent, or where it is shown to the satisfaction of this Office that he or she refuses to furnish a statement or cannot be reached after diligent efforts, declarations or statements under oath setting forth the information required by the statutes may be accepted from an officer or employee of the assignee who has sufficient knowledge of the facts. The offer of such substitute statements should be based on the actual unavailability of or refusal by the applicant, rather than mere inconvenience. Where it is shown that one of the joint inventors is deceased or unavailable, a statement by all of the other inventor(s) may be accepted.

The following is an acceptable format for statements to DOE or NASA assuming that no government funds or other considerations were involved in the making or conception of the invention. It is important that the infor-

mation provided in the statement be an accurate reflection of the fact situation at the time the statement is made. While the sample below is in the form of a declaration, a sworn oath is equally acceptable.

Note that the statement must be in the form of an oath or declaration. Further note that the statement must be signed by all the inventors. See also the notice entitled "Statements Filed Under Atomic Energy Act and NASA Act" published in 914 O.G. 1 (Sept. 4, 1973) for further information.

I (We) \_\_\_\_\_ citizens of \_\_\_\_\_ residing at \_\_\_\_\_ declare: That I (we) made and conceived the invention described and claimed in patent application number \_\_\_\_\_ filed in the United States of America on \_\_\_\_\_ titled \_\_\_\_\_.

(Include completed I. or II. below)

I. (for Inventors Employed by an Organization)

That I (we) made and conceived this invention while employed by \_\_\_\_\_.

That the invention is related to the work I am (we are) employed to perform and was made within the scope of my (our) employment duties;

That the invention was made during working hours and with the use of facilities, equipment, materials, funds, information and services of \_\_\_\_\_.

Other relevant facts are: \_\_\_\_\_.

That to the best of my (our) knowledge and belief based upon information provided by \_\_\_\_\_ of \_\_\_\_\_ :

—OR—

II. (For Self-Employed Inventors)

That I (we) made and conceived this invention on my (our) own time using only my (our) own facilities, equipment, materials, funds, information and services.

Other relevant facts are \_\_\_\_\_.

That to the best of my (our) knowledge and belief:

(Include III. and/or IV. below as appropriate)

III. The invention or discovery was not made or conceived in the course of, or in connection with, or under the terms of any contract, subcontract or arrangement entered into with or for the benefit of the United States Atomic Energy Commission or its successors Energy Research and Development Administration or the Department of Energy.

—AND/OR—

IV. The invention was not made under nor is there any relationship of the invention to the performance of any work under any contract of the National Aeronautics and Space Administration.

V. The undersigned inventor(s) declare(s) further that all statements made herein of his or her (their) own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine

or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor's Signature \_\_\_\_\_

Post Office Address \_\_\_\_\_

Date \_\_\_\_\_

Inventor's Signature \_\_\_\_\_

Post Office Address \_\_\_\_\_

Date \_\_\_\_\_



MANUAL OF PATENT EXAMINING PROCEDURE