

**Chapter 17.—SECURITY OF CERTAIN INVENTIONS
AND FILING APPLICATIONS IN FOREIGN
COUNTRY**

**REGULATIONS RELATING TO SECURITY OF CER-
TAIN INVENTIONS AND LICENSES TO FILE
APPLICATIONS IN FOREIGN COUNTRIES**

As amended to December 31, 1960

Title 37, Part 5, Code of Federal Regulations

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AUTHORITY: §§ 5.1 to 5.23 issued under 35 U.S.C. 6, 188. Interpret or apply 35 U.S.C. 181—187.

SECURITY ORDERS

§ 5.1. Defense inspection of certain applications.

In accordance with the provisions of 35 U.S.C., section 181, applications for patent containing subject matter the disclosure of which might be detrimental to the national security are made available for inspection by defense agencies as specified in said section. Only applications obviously relating to national security, and applications within fields indicated to the Patent Office by the defense agencies as so related, are made available. Such inspection must be at the Patent Office and by responsible representatives of the agency who are required to sign a dated acknowledgment of such access accepting the condition that information obtained from the inspection will be used for no other purpose than in the administration of sections 181—188 of Title 35, U.S. Code. Applications relating to atomic energy are made available to the Atomic Energy Commission as specified in § 1.14 of this chapter.

§ 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.

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

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

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

§ 5.3. Prosecution of application under secrecy order; 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) 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) Interferences may be declared involving an application under secrecy order but unless otherwise specifically ordered or permitted such interferences are suspended after the approval of the preliminary statements.

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

§ 5.4. Petition for rescission of secrecy order.

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

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

(c) The petition must identify any contract between the Government and any of the principals,

under which the subject matter of the application or any significant part thereof was developed, or to which the subject matter is otherwise related. If there is no such contract, the petition must so state.

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

§ 5.5. Permit to disclose or modification of secrecy order.

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

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

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

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

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

§ 5.6 General and group permits.

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

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

§ 5.7 Compensation.

Any request for compensation as provided in 35 U.S.C. 183 must not be made to the Patent Office but should be made directly to the department or agency

which caused the secrecy order to be issued. Upon written request persons having a right to such information will be informed as to the department or agency which caused the secrecy order to be issued.

§ 5.8 Appeal to Secretary.

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

LICENSES FOR FOREIGN FILING

§ 5.11. License for filing application in foreign country.

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

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

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

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

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

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

(c) When a secrecy order has been issued under § 5.2, an application cannot be filed in a foreign country in any case except in accordance with § 5.5.

§ 5.12. Petition for license.

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

§ 5.13. Petition for license; no corresponding U.S. application.

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

§ 5.14. Petition for license; corresponding U.S. application.

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

(b) Two or more United States applications should not be referred to in the same petition for license unless they are to be combined in the foreign 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 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 must be furnished with the petition. If, however, all new matter in the 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.

§ 5.15. Scope of license.

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

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

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

§ 5.16. Effect of secrecy order.

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

§ 5.17. Who may use license.

Licenses may be used by anyone interested in the foreign filing for or on behalf of the inventor or his assigns.

§ 5.18. Arms, ammunition, and implements of war.

(a) The exportation of technical data relating to arms, ammunition, and implements of war is subject to the licensing jurisdiction of the Department of State, as set forth in its pertinent regulations (22 CFR 121.1 to 128.2). The articles designated as arms, ammunition, and implements of war are enumerated in 22 CFR 121.21, this list being known as the United States Munitions List. The exportation of technical data relating to articles on this list with any application for foreign patent is generally subject to the licensing requirements of the Secretary of State, 22 CFR 125.13.

(b) When a petition for license is received by the Commissioner, during the time in which a license from the Commissioner is required (see § 5.11a), and it is determined that the subject matter involved also falls under the jurisdiction of the Secretary of State, the applicant will be so notified and given whatever information may be deemed appropriate. The petition for license will be referred by the Patent Office to the Department of State for its action. Action by the Patent Office on the petition will be deferred pending the Department of State consideration.

(c) If an application for patent for subject matter on the Munitions List (22 CFR 121.21) is subject to a secrecy order under § 5.2 and a petition under § 5.5 for a modification of the secrecy order to permit filing abroad is made, compliance with Department of State regulation 22 CFR 125.4 is also required.

(d) When no license from the Commissioner is required, see § 5.11(b), relating to the exportation of such technical data with applications for foreign patents, the specific provisions of the regulations issued by the Secretary of State cited above must be complied with.

GENERAL**§ 5.21. Effect of modification rescission or license.**

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

§ 5.22. Papers in English language.

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

§ 5.23. Correspondence.

All correspondence in connection with this part, including petition, should be addressed to "Commissioner of Patents (Attention Patent Security Division), Washington 25, D.C."