Section 2. SECRECY

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2-1. General

<u>Rule 3.4 Applications preserved in secrecy.</u> Pending applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without authority of the applicant, or his attorney or agent or assignee if any, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules.

Abandoned applications are likewise not open to public inspection, except that if an application referred to in an issued United States patent is abandoned, it may be inspected, if not destroyed, by any person or copies obtained without notice to the applicant on request in writing. Abandoned applications may be destroyed after twenty years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

Decisions of the Commissioner in any application, and of the Board of Appeals in abandoned applications, may be published or made available for inspection or publication in the Commissioner's discretion.

<u>Rule [illegible] Notice of reissue application.</u> When an application for a reissue is filed, there will be placed in the file of the original patent a notice stating that an application for reissue has been filed, giving its serial number and filing date. When the reissue is granted or the reissue application is otherwise terminated the fact will be added to the notice in the file of the original patent.

A notice of the filing of a reissue application will be published in the Official

Gazette. Reissue applications are not preserved in secrecy in the same manner as original applications, and access will ordinarily be granted on request in writing.

Some Examiners, while holding interviews with attorneys and applicants, are careless in permitting exposures of files and drawings in such a way as to be embarrassing, inasmuch as it is practically impossible to avoid obtaining information not desired and not intended to be conveyed.

Special care should be exercised to keep drawings and files out of view on such occasions.

2-1-1. **"Secret" Case**

The Act of October 6, 1917 and amended Act of July 1, 1940, 54 Stat. 710, provide that whenever the publication or disclosure of an invention by the granting of a patent might, in the opinion of the Commissioner of Patents, be detrimental to the public safety or defense he may order that the invention be kept secret and withhold the grant of a patent for such a period or periods as in his opinion the national interest requires.

A "secret" case is one which is adjudged to be for an invention whose publication might be detrimental to the public safety or defense. It is examined as in other cases, but may not be passed for issue; nor does an interference involving one or more secret cases proceed beyond the filing of the preliminary statements.

In case of a final rejection, while such action must be properly responded to within the six months' period, an appeal if filed will not be set for hearing by the Board of Appeals; for if the appeal were heard and adversely passed on appellant in order to conserve his rights would have to go into open court with his case.

2-1-2. **D-10 Notice**

When a secret case is in condition for allowance the D-10 notice is issued, thus closing the prosecution. Any amendments received thereafter are treated as are amendments filed after final rejection in an ordinary case, i.e., they may be entered if found free from objection; otherwise they are denied admission. The applicant should be advised of their entry or non-entry, and in the latter case the reasons therefor.

2-1-3. "Special Handling" Case

During the war there were filed by one of the Government Agencies certain applications for patents on inventions relating to the prosecution of the war, which at the request of the agency were not placed under secrecy orders, but were handled in such manner as to preclude their coming to the general knowledge of the examining corps or of the division to which such case was assigned. Extra precautions were taken for safeguarding them in the Office. These cases became known as "Special Handling" or super-secret cases.

They are acted on by the Examiner much as "secret" cases are except in the matter of their being passed for issue.

In a "special handling" case and a Government-owned three-year case the Commissioner has approved (Apr. 3, 1946) the practice of informally notifying the agency involved of the proposed allowance of the case. Such notification may be given either directly or through the War Division.

If delay of the issue of the patent is desired in the interest of security or for other reason, appropriate action, as placing the case under secrecy order, or invoking in a Government-owned case the three-year proviso of R.S. 4894, may be taken.

2-1-4. Request for Secrecy and Recording Assignments of Government-Owned Cases

With applications in which request is made for secrecy, there must be an assignment to the Government of the United States to comply with the provisions of Sec. 4894 R.S. This assignment will be recorded and placed in a volume provided exclusively for assignments filed in connection with these cases. On the file of these applications, the entry will be made: "U.S. Government Assignment."

The cards in the index under the "Assignee," "Assignor" and "Inventor" headings will give the name of the inventor and the assignee as the "United States Government as represented by Secretary of   " and identify the application by serial number. The Digest will give this information and nothing more and will refer by page to the volume in which the assignment has been placed. This volume will under no circumstance be permitted to be examined by any one except upon the written authority of the head of the department or independent bureau to which the application is assigned, and this written authority must be approved by the Commissioner of Patents. The letter of authority will be retained by the Assignment Branch as authority for the inspection of the assignment. Upon the presentation of the proper authority,

as above indicated, the authorized assignment only will be shown to the party presenting the letter, and the inspection must take place in the presence of the Chief or the Assistant Chief of the Assignment Branch. No other assignment except the one specified may be examined.

Other assignments to the Government of the United States and assignments in cases placed under the provisions of Sec. 4894 where no request for secrecy is made will be recorded in the regular way.

All requests for secrecy will be sent marked "Attention of the Solicitor" and will be forwarded by him to the Assignment Branch. The assignments will be returned by the Solicitor to the sender.

Upon the removal of the application from the secrecy provision or when the patent issues, the assignment will be recorded in the regular way.

2-2-1. Right to Inspect An Application

Any member of the public may inspect:

(1) a patented file,

(2) the file of any terminated interference that involved a patent or an application which matured into a patent,

(3) ordinarily a reissue application on request in writing (Rule 22.9).

The Office will give information to any member of the public as to the present status of an application in the matter of its being patented or abandoned where that application is:

(1) a prior application of which a patented application was a continuation or division,

(2) an application referred to in a patent.

Such information can be had on application to the Docket Branch.

A reference in a divisional application to the parent case makes the latter a document relating to the patent issued on the divisional case. As such, the parent is open to inspection by the public, even though still pending before the Office, since the public is entitled to see what prosecution, if any, of the subject matter of the patent claims was had in the parent case, and to ascertain whether the patent is entitled to the filing date of the earlier case.

Thus, where a reference patent which purports to be a continuation, a continuation-in-part, or a division of an earlier application is to be overcome under Rule 18.1 antedated under Rule 23.4, the applicant has a right to inspect the earlier case to determine for himself whether its disclosure entitled the later case to the relationship which it claims to the earlier case. In such a situation, the usual procedure is to file a petition in duplicate to the Commissioner for access to the parent case. The duplicate copy is sent by the Law Examiner to the owner of the parent case who is given a limited period, such as ten days, within which to state any objection he may have to the granting of the petition. If no objection is raised, the petition is O.K.'d by the Law Examiner, otherwise a decision is rendered by the Commissioner.

The assignment records of the Office are open to public inspection; and to this extent pending cases that are assigned are removed from the protection of the rule of secrecy so far as concerns their serial number, filing date and title, if these data are all given in the assignment papers. The Office will accept as sufficient identification of a case for the assignment records, the filing date of the application and the date of execution of the oath.

Files of cases carried to the courts, either by appeal to the Court of Customs and Patent Appeals or by suit in equity in the District Court for the District of Columbia, are not opened by the Patent Office to the public.

In the case of an appeal to the Court of Customs and Patent Appeals, a transcript of the record must be filed with the court within the specified 40-day period following the decision of the Board of Appeals. The decision of the court is published; but unless the application becomes a patent, the public is not given access to the application file itself. Since a transcript of the application becomes a part of the court record, it may, of course, be inspected by anyone.

Where relief from the adverse decision of the Patent Office is sought by way of a suit in equity, the applicant is required to furnish the court a certified copy of the file wrapper and contents at the time of the trial. If the suit is dismissed before coming to trial, no disclosure of the application to the public necessarily results from the filing of the suit. Unlike an appeal to the U. S. Court of Customs and Patent Appeals, the filing of a suit in equity does not require the immediate filing of a transcript of the application. The complaint is open to the public.

Files subpoenaed by a court may be sent to the court in care of a Patent Office employee along with a certified copy, under stipulation that the copy be retained by the

court and the original brought back to the Office by said employee.

2-2-2. Power to Inspect Application

No person except the applicant, the assignee, whose assignment is of record, or the attorney of record will be permitted to have access to the file of any application, except as provided for under the interference rules, unless written authority from the applicant, assignee, or attorney, identifying the application to be inspected, is filed in the case to become a part of the record thereof, or upon the written order of the Commissioner, which will also become a part of the record of the case.

Every power to inspect must be approved in writing by the Examiner in charge of the division to which the application is classified before permission to inspect is granted, with the exception of the Attorneys' and Record Room and the Manuscript and Lithographic Branch.

Power to inspect or to make copies presented at the Attorneys' and Record Room or to the Manuscript and Lithographic Branch must be approved in writing by the head of the Attorneys' and Record Room or the Manuscript and Lithographic Branch, both of whom are hereby authorized to permit inspection or supply copies to authorized persons.

Where an applicant uses his application as a means to interfere with a competitor's business or customers, permission to inspect the application may be given the competitor by the Commissioner.

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

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

2-2-3. Disbarred Attorney Cannot Inspect

Patent Office employees are forbidden to hold either oral or written communication with a disbarred attorney regarding an application unless it be one in which said attorney is the applicant. Power to inspect given a disbarred attorney will not be accepted by the Examiner.

2-2-4. Control of Inspection by Assignee

The assignee of the entire interest in an application may intervene in the prosecution of the case, appointing an attorney of his own choice. Such intervention, however, does not exclude the inventor from access to the application to see that it is being properly prosecuted, unless the assignee makes specific requests to that effect. Even where such request is made, the applicant may be permitted to inspect the case on sufficient showing why such inspection is necessary to conserve his rights.