

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

<b>101</b>	<b>General</b>
<b>102</b>	<b>Information as to Status of an Application</b>
<b>103</b>	<b>Right of Public To Inspect Patent Files and Some Application Files</b>
<b>104</b>	<b>Power to Inspect Application</b>
<b>105</b>	<b>Suspended or Excluded Practitioner Cannot Inspect</b>
<b>106</b>	<b>Control of Inspection by Assignee</b>
<b>106.01</b>	Rights of Assignee of Part Interest
<b>107-109</b>	[Reserved]
<b>110</b>	<b>Confidential Nature of International Applications</b>
<b>111-114</b>	[Reserved]
<b>115</b>	<b>Review of Applications for National Security and Property Rights Issues</b>
<b>116-119</b>	[Reserved]
<b>120</b>	<b>Secrecy Orders</b>
<b>121</b>	<b>Handling of Applications under Secrecy Order and/or Bearing National Security Markings</b>
<b>122-129</b>	[Reserved]
<b>130</b>	<b>Examination of Secrecy Order Cases</b>
<b>131-139</b>	[Reserved]
<b>140</b>	<b>Foreign Filing Licenses</b>
<b>141-149</b>	[Reserved]
<b>150</b>	<b>Statements to DOE and NASA</b>
<b>151</b>	<b>Content of the Statements</b>

## 101 General [R-07.2022]

### 35 U.S.C. 122 Confidential status of applications; publication of patent applications.

(a) CONFIDENTIALITY.— Except as provided in subsection (b), 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 an Act of Congress or in such special circumstances as may be determined by the Director.

#### (b) PUBLICATION.—

##### (1) IN GENERAL.—

(A) Subject to paragraph (2), each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title. At the request of the applicant, an application may be published earlier than the end of such 18-month period.

(B) No information concerning published patent applications shall be made available to the public except as the Director determines.

(C) Notwithstanding any other provision of law, a determination by the Director to release or not to release information concerning a published patent application shall be final and nonreviewable.

#### (2) EXCEPTIONS.—

(A) An application shall not be published if that application is—

(i) no longer pending;

(ii) subject to a secrecy order under [section 181](#);

(iii) a provisional application filed under [section 111\(b\)](#); or

(iv) an application for a design patent filed under [chapter 16](#).

(B)(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) An applicant may rescind a request made under clause (i) at any time.

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned.

(iv) If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

(v) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign filed applications corresponding to an application filed in the Patent and Trademark Office or the description of the invention in such foreign filed applications is less extensive than the application or description of the invention in the application filed in the Patent and Trademark Office, the applicant may submit a redacted copy of the application filed in the Patent and Trademark Office eliminating any part or description of the invention in such application that is not also contained in any

of the corresponding applications filed in a foreign country. The Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title. The provisions of [section 154\(d\)](#) shall not apply to a claim if the description of the invention published in the redacted application filed under this clause with respect to the claim does not enable a person skilled in the art to make and use the subject matter of the claim.

(c) **PROTEST AND PRE-ISSUANCE OPPOSITION.**— The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

(d) **NATIONAL SECURITY.**— No application for patent shall be published under subsection (b)(1) if the publication or disclosure of such invention would be detrimental to the national security. The Director shall establish appropriate procedures to ensure that such applications are promptly identified and the secrecy of such inventions is maintained in accordance with [chapter 17](#).

(e) **PREISSUANCE SUBMISSIONS BY THIRD PARTIES.**—

(1) **IN GENERAL.**—Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of—

(A) the date a notice of allowance under [section 151](#) is given or mailed in the application for patent; or

(B) the later of—

(i) 6 months after the date on which the application for patent is first published under [section 122](#) by the Office, or

(ii) the date of the first rejection under [section 132](#) of any claim by the examiner during the examination of the application for patent.

(2) **OTHER REQUIREMENTS.**—Any submission under paragraph (1) shall—

(A) set forth a concise description of the asserted relevance of each submitted document;

(B) be accompanied by such fee as the Director may prescribe; and

(C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.

### **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 1.11 Files open to the public.**

(a) The specification, drawings, and all papers relating to the file of: A published application; a patent; or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in § [1.19\(b\)\(2\)](#). If an application was published in redacted form pursuant to § [1.217](#), the complete file wrapper and contents of the patent application will not be available if: The requirements of paragraphs (d)(1), (d)(2), and (d)(3) of § [1.217](#) have been met in the application; and the application is still pending. See § 2.27 of this title for trademark files.

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

(a) *Confidentiality of patent application information.* Patent applications that have not been published under [35 U.S.C. 122\(b\)](#) are generally preserved in confidence pursuant to [35 U.S.C. 122\(a\)](#). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § [1.11](#) or in this section.

(1) Records associated with patent applications (see paragraph (g) of this section for international applications and paragraph (j) of this section for international design applications) may be available in the following situations:

(i) *Patented applications and statutory invention registrations.* The file of an application that has issued as a patent or published as a statutory invention registration is available to the public as set forth in § [1.11](#). A copy of the patent application-as-filed, the file contents of the application, or a specific document in the file of such an application may be provided upon request and payment of the appropriate fee set forth in § [1.19\(b\)](#).

(ii) *Published abandoned applications.* The file of an abandoned published application is available to the public as set forth in § [1.11\(a\)](#). A copy of the application-as-filed, the file contents of the published application, or a specific document in the file of the published application may be provided to any person upon request and payment of the appropriate fee set forth in § [1.19\(b\)](#).

(iii) *Published pending applications.* A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending published application may be provided to any person upon request and payment of

the appropriate fee set forth in § [1.19\(b\)](#). If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy. The Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (i) of this section.

(iv) *Unpublished abandoned applications (including provisional applications) that are identified or relied upon.* The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title, and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request, and payment of the appropriate fee (§ [1.19\(b\)](#)).

(v) *Unpublished pending applications (including provisional applications) whose benefit is claimed.* A copy of the file contents of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)), if the benefit of the application is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, or in an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed, or a specific document in the file of the pending application may also be provided to any person upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vi) *Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.* A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an

international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vii) *When a petition for access or a power to inspect is required.* Applications that were not published or patented, that are not the subject of a benefit claim under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3), or are not identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States, are not available to the public. If an application is identified in the file contents of another application, but not the published patent application or patent itself, a granted petition for access (see paragraph (i)) or a power to inspect (see paragraph (c) of this section) is necessary to obtain the application, or a copy of the application.

(2) Information concerning a patent application may be communicated to the public if the patent application is identified in a published patent document or in an application as set forth in paragraphs (a)(1)(i) through (a)(1)(vi) of this section. The information that may be communicated to the public (*i.e.*, status information) includes:

(i) Whether the application is pending, abandoned, or patented;

(ii) Whether the application has been published under [35 U.S.C. 122\(b\)](#);

(iii) The application “numerical identifier” which may be:

(A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or

(B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage; and

(iv) Whether another application claims the benefit of the application (*i.e.*, whether there are any applications that claim the benefit of the filing date under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365](#), or [386](#) of the application), and if there are any such applications, the numerical identifier of the application, the specified relationship between the applications (*e.g.*, continuation), whether the application is pending, abandoned or patented, and whether the application has been published under [35 U.S.C. 122\(b\)](#).

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All U.S. Patent and Trademark Office employees are legally obligated to preserve pending applications for patents in confidence until they are published or patented in accordance with [35 U.S.C. 122](#) and [37 CFR 1.14](#), [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.

Any employee having custody of a patent application or related documents will be responsible for maintaining confidentiality and otherwise conforming with the requirements of law. No part of any application or paper related thereto should be reproduced or copied except for official purposes. Application files must not be displayed or handled so as to permit perusal or inspection by any unauthorized member of the public.

Whenever a paper application (non-electronic), or an artifact file in an Image File Wrapper (IFW) application, is removed from the operating area having custody of the file, a charge on the Patent Data Portal system must be properly and promptly made. Applications, artifact files, and official papers for which there is no electronic file must not be placed in desk drawers or other locations where they might be easily overlooked or are not visible to authorized personnel. Interoffice mail must be sent in appropriate envelopes.

Official papers are accepted only at the Customer Service Window, except for certain papers that have been specifically exempted from the central delivery policy. See [MPEP § 502](#). Appropriate corrective action for IFW messages with faulty identifications or incorrect routing should be taken at once to ensure the prompt receipt thereof at the appropriate destination.

All U.S. 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 U.S. 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 5 CFR 2635.701- 2635.703 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 and/or inappropriate disclosure of the filing date or application number of any application. This applies not only to Office actions but also to notes in the file or in the artifact folder of IFW applications.

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

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

(a) *Confidentiality of patent application information.* Patent applications that have not been published under [35 U.S.C. 122\(b\)](#) are generally preserved in confidence pursuant to [35 U.S.C. 122\(a\)](#). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in [§ 1.11](#) or in this section.

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(2) Information concerning a patent application may be communicated to the public if the patent application is identified in a published patent document or in an application as set forth in paragraphs (a)(1)(i) through (a)(1)(vi) of this section. The information that may be communicated to the public (*i.e.*, status information) includes:

(i) Whether the application is pending, abandoned, or patented;

(ii) Whether the application has been published under [35 U.S.C. 122\(b\)](#);

(iii) The application “numerical identifier” which may be:

(A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or

(B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage; and



(iv) Whether another application claims the benefit of the application (*i.e.*, whether there are any applications that claim the benefit of the filing date under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365](#), or [386](#) of the application), and if there are any such applications, the numerical identifier of the application, the specified relationship between the applications (*e.g.*, continuation), whether the application is pending, abandoned or patented, and whether the application has been published under [35 U.S.C. 122\(b\)](#).

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Except as provided in [35 U.S.C. 122\(b\)](#), no information concerning pending or abandoned patent applications (except applications which have been published, reissue applications and reexamination proceedings) may be given to the public without appropriate written authorization. See [35 U.S.C. 122](#) and [37 CFR 1.14](#).

When handling an incoming telephone call or an in-person request for information regarding an unpublished 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 publication date or publication number, or issue date and patent number assigned to a *pending* patent application. If the publication or issue date is later than the current date (*i.e.*, the date of the request), such information may be given *only* to the applicant, an inventor, the assignee of record, or the attorney or agent of record.

The following procedure should be followed before any information about an unpublished 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 a patent practitioner (attorney or agent) of record.

(1) If there is a patent practitioner of record, ask for the patent practitioner's registration number. If the registration number is not known, ask for the name of the patent practitioner of record. Inform the caller that a patent practitioner of record will be called after verification of their identity and that information concerning the application will be released to that patent practitioner.

(2) If there is no patent practitioner of record, ask the caller why they are entitled to information concerning the application. If the caller identifies themselves as an inventor, an applicant or an authorized representative of the assignee of record, ask for the correspondence address of record and inform caller that their association with the application must be verified before any information concerning the application can be released and that they will be called back. If the caller indicates that they are not an inventor, applicant or an authorized representative of the assignee of record then status information may only be given pursuant to [MPEP § 102](#).

(B) Verify that information concerning the application can be released by checking Patent Data Portal or the application file.

(1) If the caller stated there was a patent practitioner of record, Patent Data Portal should be used to verify the registration number given or to obtain the registration number of a patent practitioner of record. Then Patent Data Portal (using the registration number) should be used to obtain a telephone number for a patent practitioner of record.

(2) If the caller identified themselves as an inventor, applicant or an authorized representative of the assignee of record, Patent Data Portal should be used to verify the correspondence address of record. Patent Data Portal should be used to determine if there is a patent practitioner of record. If there is a patent practitioner of record, their telephone number can be obtained from Patent Data Portal.

(C) Return the call using the telephone number as specified below.

(1) If a patent practitioner is of record in the application, information concerning the application should only be released by calling the patent practitioner's telephone number obtained from Patent Data Portal.

(2) If the inventor, applicant or an authorized representative of the assignee of record requests information, and there is no patent practitioner 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 [R-07.2022]

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

(a) *Confidentiality of patent application information.* Patent applications that have not been published under [35 U.S.C. 122\(b\)](#) are generally preserved in confidence pursuant to [35 U.S.C. 122\(a\)](#). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § [1.11](#) or in this section.

(1) Records associated with patent applications (see paragraph (g) of this section for international applications and paragraph (j) of this section for international design applications) may be available in the following situations:

(i) *Patented applications and statutory invention registrations.* The file of an application that has issued as a patent or published as a statutory invention registration is available to the public as set forth in § [1.11\(a\)](#). A copy of the patent application-as-filed, the file contents of the application, or a specific document in the file of such an application may be provided upon request and payment of the appropriate fee set forth in § [1.19\(b\)](#).

(ii) *Published abandoned applications.* The file of an abandoned published application is available to the public as set forth in § [1.11\(a\)](#). A copy of the application-as-filed, the file contents of the published application, or a specific document in the file of the published application may be provided to any person upon request and payment of the appropriate fee set forth in § [1.19\(b\)](#).

(iii) *Published pending applications.* A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending published application may be provided to any person upon request and payment of the appropriate fee set forth in § [1.19\(b\)](#). If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy. The Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (i) of this section.

(iv) *Unpublished abandoned applications (including provisional applications) that are identified or relied upon.* The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application

designating the United States. An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title, and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)).

(v) *Unpublished pending applications (including provisional applications) whose benefit is claimed.* A copy of the file contents of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)), if the benefit of the application is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, or in an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed or a specific document in the file of the pending application may also be provided to any person upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vi) *Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.* A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vii) *When a petition for access or a power to inspect is required.* Applications that were not published or patented, that are not the subject of a benefit claim under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an

international registration under Hague Agreement Article 10(3), or are not identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States, are not available to the public. If an application is identified in the file contents of another application, but not the published patent application or patent itself, a granted petition for access (see paragraph (i)) or a power to inspect (see paragraph (c) of this section) is necessary to obtain the application, or a copy of the application.

(2) Information concerning a patent application may be communicated to the public if the patent application is identified in a published patent document or in an application as set forth in paragraphs (a)(1)(i) through (a)(1)(vi) of this section. The information that may be communicated to the public (*i.e.*, status information) includes:

(i) Whether the application is pending, abandoned, or patented;

(ii) Whether the application has been published under [35 U.S.C. 122\(b\)](#);

(iii) The application “numerical identifier” which may be:

(A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or

(B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage; and

(iv) Whether another application claims the benefit of the application (*i.e.*, whether there are any applications that claim the benefit of the filing date under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365](#), or [386](#) of the application), and if there are any such applications, the numerical identifier of the application, the specified relationship between the applications (*e.g.*, continuation), whether the application is pending, abandoned or patented, and whether the application has been published under [35 U.S.C. 122\(b\)](#).

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Status information of an application means only the following information:

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

(B) whether the application has been published;

(C) the application number or the serial number plus any one of the filing date of the national application, the international filing date or the date of entry into the national stage; and

(D) whether another application claims the benefit of the application (*i.e.*, whether there are any

applications that claim the benefit of the filing date under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365](#), or [386](#) of the application), and if there are any such applications, status information therefor as set forth in [37 CFR 1.14\(a\)\(2\)\(iv\)](#).

A requester seeking status information regarding an application should check Patent Center or Private Patent Application Information Retrieval (PAIR) on the USPTO website at [www.uspto.gov](#). Alternatively, an authorized requester may contact the Application Assistance Unit (AAU) for applications in pre-examination or post-examination processing via email at [HelpAAU@uspto.gov](mailto:HelpAAU@uspto.gov); phone at 571-272-4000 or toll free at 888-786-0101 (Hours: Weekdays, 8:30 a.m. to 5 p.m. ET); or at [www.uspto.gov/learning-and-resources/support-centers/application-assistance-unit-aaU](#) (see [MPEP § 1730](#)). If the application has not been published, but is pending or abandoned then the AAU will determine whether the requester is:

(1) the applicant;

(2) a patent practitioner of record;

(3) the assignee or an assignee of an undivided part interest;

(4) the inventor or a joint inventor; or

(5) a registered attorney or agent named in the papers accompanying the application papers filed under [37 CFR 1.53](#) or the national stage documents filed under [37 CFR 1.495](#), if a power of attorney has not been appointed under [37 CFR 1.32](#).

If the requester is any of (1) - (5) as set forth above, or if the application contains written authority granting access to the requester signed by any of (1) - (5) as set forth above, then the requester is entitled to status information. See [37 CFR 1.14\(c\)](#) and [MPEP § 104](#) for additional information pertaining to who can provide written authority granting access to such 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 Technology Center (TC) to which the application is assigned. The assignment of an application to a TC can be determined from Patent Data Portal. If the requester is not any of (1) - (5) or a person with written authority from any of (1) - (5) as set forth above, the requester may utilize Patent Center to obtain status information.

Furthermore, if the requester is not any of (1) - (5) or a person with written authority from any of (1) - (5) 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\(a\)\(2\)\(iv\)](#), 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 first page of the published international application or of the corresponding page of the PCT Gazette must be supplied with the status request. The status request should be made in writing to the International Patent Legal Administration (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 the application 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 continuity data screen, such as whether the application is a CIP, continuation or divisional application, the date of abandonment of the application and issue date may be confidential information and should not be communicated.

If the requester is not any of (1) - (5) or a person with written authority from any of (1) - (5) as set forth above, but the application is an international design application maintained by the Office in its capacity as a designated office ([37 CFR 1.1003](#)) for national processing, pursuant to [37 CFR 1.14\(a\)\(2\)\(iv\)](#), the requester is entitled to status information for the international design application as well as any application claiming the benefit of the filing date of the published international design application. With respect to an international design application maintained by the Office in its capacity as an office of indirect filing ([37 CFR 1.1002](#)), status information may be made available where contained in the file of the international design application maintained by the Office for national processing.

## STATUS LOCATION INFORMATION FOR OFFICE PERSONNEL

When it is desired to determine the current location or status of an application, Office personnel should use Patent Data Portal. If the application is an Image File Wrapper (IFW) application, no location is associated with the file.

## 103 Right of Public To Inspect Patent Files and Some Application Files [R-07.2022]

### *37 CFR 1.11 Files open to the public.*

(a) The specification, drawings, and all papers relating to the file of: A published application; a patent; or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in [§ 1.19\(b\)\(2\)](#). If an application was published in redacted form pursuant to [§ 1.217](#), the complete file wrapper and contents of the patent application will not be available if: The requirements of paragraphs (d)(1), (d)(2), and (d)(3) of [§ 1.217](#) have been met in the application; and the application is still pending. See [§ 2.27](#) of this title 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 all the requirements of [§ 1.510](#) or [§ 1.915](#) have been satisfied will be announced in the *Official Gazette*. Any reexaminations at the initiative of the Director 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 Director 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) Except as prohibited in [§ 41.6\(b\)](#), [§ 42.14](#) or [§ 42.410\(b\)](#), the file of any interference or trial before the Patent Trial and Appeal Board is open to public inspection and copies of the file may be obtained upon payment of the fee therefor.

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



(a) *Confidentiality of patent application information.* Patent applications that have not been published under [35 U.S.C. 122\(b\)](#) are generally preserved in confidence pursuant to [35 U.S.C. 122\(a\)](#). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § [1.11](#) or in this section.

(1) Records associated with patent applications (see paragraph (g) of this section for international applications and paragraph (j) of this section for international design applications) may be available in the following situations:

(i) *Patented applications and statutory invention registrations.* The file of an application that has issued as a patent or published as a statutory invention registration is available to the public as set forth in § [1.11\(a\)](#). A copy of the patent application-as-filed, the file contents of the application, or a specific document in the file of such an application may be provided upon request and payment of the appropriate fee set forth in § [1.19\(b\)](#).

(ii) *Published abandoned applications.* The file of an abandoned published application is available to the public as set forth in § [1.11\(a\)](#). A copy of the application-as-filed, the file contents of the published application, or a specific document in the file of the published application may be provided to any person upon request and payment of the appropriate fee set forth in § [1.19\(b\)](#).

(iii) *Published pending applications.* A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending published application may be provided to any person upon request and payment of the appropriate fee set forth in § [1.19\(b\)](#). If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy. The Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (i) of this section.

(iv) *Unpublished abandoned applications (including provisional applications) that are identified or relied upon.* The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title, and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3). A copy of

the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)).

(v) *Unpublished pending applications (including provisional applications) whose benefit is claimed.* A copy of the file contents of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)), if the benefit of the application is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, or in an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed or a specific document in the file of the pending application may also be provided to any person upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vi) *Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.* A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vii) *When a petition for access or a power to inspect is required.* Applications that were not published or patented, that are not the subject of a benefit claim under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3), or are not identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States, are not available to the public. If an application is identified in the file contents of another application, but not the published patent application or patent itself, a granted petition for access (see paragraph (i)) or a power to inspect (see paragraph (c) of this section) is necessary to obtain the application, or a copy of the application.

(2) Information concerning a patent application may be communicated to the public if the patent application is

identified in a published patent document or in an application as set forth in paragraphs (a)(1)(i) through (a)(1)(vi) of this section. The information that may be communicated to the public ( *i.e.*, status information) includes:

(i) Whether the application is pending, abandoned, or patented;

(ii) Whether the application has been published under [35 U.S.C. 122\(b\)](#);

(iii) The application “numerical identifier” which may be:

(A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or

(B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage; and

(iv) Whether another application claims the benefit of the application (*i.e.*, whether there are any applications that claim the benefit of the filing date under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365](#), or [386](#) of the application), and if there are any such applications, the numerical identifier of the application, the specified relationship between the applications (*e.g.*, continuation), whether the application is pending, abandoned or patented, and whether the application has been published under [35 U.S.C. 122\(b\)](#).

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## I. ACCESS TO IMAGE FILE WRAPPER (IFW) APPLICATIONS

The Image File Wrapper (IFW) system uses image technology to replace the paper processing of patent applications in the Office. Paper components of these application files (including the specification, oath or declaration, drawings, information disclosure statements, amendments, Office actions, and file jacket notations) have been scanned to create electronic image files. For patent applications in the IFW system, the IFW file is the Official file and no access is granted to the original paper document sheets used to create the IFW file. All processing and examination is conducted using the electronic images instead of the paper source documents.

If an IFW file has been created for a patented application, published application, or an application to which a patented or published application claims domestic benefit, the IFW file (with the exception of non-patent literature) is accessible through Patent Center. All patent applications filed after June 30, 2003, have been scanned into the IFW system and are available in Patent Center upon publishing or

patenting. Pending applications filed before June 30, 2003, were scanned into IFW as incoming papers were received in the Office.

## II. PUBLISHED APPLICATIONS

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

(a) *Confidentiality of patent application information.* Patent applications that have not been published under [35 U.S.C. 122\(b\)](#) are generally preserved in confidence pursuant to [35 U.S.C. 122\(a\)](#). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § [1.11](#) or in this section.

(1) Records associated with patent applications (see paragraph (g) of this section for international applications and paragraph (j) of this section for international design applications) may be available in the following situations:

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(ii) *Published abandoned applications.* The file of an abandoned published application is available to the public as set forth in § [1.11\(a\)](#). A copy of the application-as-filed, the file contents of the published application, or a specific document in the file of the published application may be provided to any person upon request and payment of the appropriate fee set forth in § [1.19\(b\)](#).

(iii) *Published pending applications.* A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending published application may be provided to any person upon request and payment of the appropriate fee set forth in § [1.19\(b\)](#). If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy. The Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (i) of this section.

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If a patent application has been published pursuant to [35 U.S.C. 122\(b\)](#), then a copy of the specification, drawings, and all papers relating to the file of that published application (whether abandoned or pending) may be provided to any person upon written request and payment of the fee set forth in [37 CFR 1.19\(b\)](#). See [37 CFR 1.14\(a\)\(1\)\(ii\) and \(iii\)](#). Pursuant to [35 U.S.C. 374](#) and [35 U.S.C. 390](#), the publication by the International Bureau of an international application under the PCT or an international design application designating the United States under the Hague Agreement is deemed to be a publication under [35 U.S.C. 122\(b\)](#). Note that the U.S. is automatically designated in all

international applications under the PCT filed on or after January 1, 2004.

If a redacted copy of the application was used for the patent application publication, the copy of the application will be limited to the redacted copy of the application and the redacted materials provided under [37 CFR 1.217\(d\)](#).

See paragraph I., above, for information pertaining to access to Image File Wrapper (IFW) applications. Published applications maintained in the IFW system are available on the USPTO website in Patent Center. If the published patent application is pending and it is not maintained in the IFW system, the paper application file itself will not be available to the public for inspection. Only copies of the application file may be obtained pursuant to [37 CFR 1.14\(a\)\(1\)\(iii\)](#). If the published patent application is abandoned, the entire application is available to the public for inspection and obtaining copies. See [37 CFR 1.11\(a\)](#).

**III. UNPUBLISHED ABANDONED AND PENDING APPLICATIONS (INCLUDING PROVISIONAL APPLICATIONS) THAT ARE IDENTIFIED**

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

(a) *Confidentiality of patent application information.* Patent applications that have not been published under [35 U.S.C. 122\(b\)](#) are generally preserved in confidence pursuant to [35 U.S.C. 122\(a\)](#). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in [§ 1.11](#) or in this section.

(1) Records associated with patent applications (see paragraph (g) of this section for international applications and paragraph (j) of this section for international design applications) may be available in the following situations:

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(iv) *Unpublished abandoned applications (including provisional applications) that are identified or relied upon.* The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title, and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of

the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request and payment of the appropriate fee ([§ 1.19\(b\)](#)).

(v) *Unpublished pending applications (including provisional applications) whose benefit is claimed.* A copy of the file contents of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee ([§ 1.19\(b\)](#)), if the benefit of the application is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, or in an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed or a specific document in the file of the pending application may also be provided to any person upon written request and payment of the appropriate fee ([§ 1.19\(b\)](#)). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vi) *Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.* A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee ([§ 1.19\(b\)](#)), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

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Abandoned applications meeting the requirements of [37 CFR 1.14\(a\)\(1\)\(iv\)](#) and any application that is open to the public under [37 CFR 1.11](#) may be obtained by any person through the Patent and Trademark Copy Fulfillment Branch Certified Copy Center (CCC). The following abandoned applications are available: (A) An abandoned application referred to in a U.S. patent application publication or U.S.

patent; and (B) 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\(a\)\(1\)\(iv\)](#). 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 earlier filed applications in the same file wrapper in confidence.

[37 CFR 1.14\(a\)\(1\)\(i\)](#) relates only to United States applications that are open to public inspection. See [37 CFR 1.14\(g\)\(3\)-\(5\)](#) for access to international applications where the U.S. is designated. See also [MPEP § 110](#). See [37 CFR 1.14\(j\)](#) for access to international design applications. If an abandoned application is referred to in an international publication of an international application under [PCT Article 21\(2\)](#), or in a publication of an international registration under Hague Agreement Article 10(3), access to the abandoned application is available under [37 CFR 1.14\(a\)\(1\)\(iv\)](#).

An abandoned non-IFW application identified in a U.S. patent application publication, U.S. patent or a U.S. application that is open to public inspection may be ordered for inspection by any member of the public through the Patent and Trademark Copy Fulfillment Branch Certified Copy Center (CCC).

The incorporation by reference of a pending application in a U.S. patent application publication, a U.S. patent, a published international application published in accordance with [PCT Article 21\(2\)](#), a publication of an international registration under Hague Agreement Article 10(3), or a statutory invention registration constitutes a special circumstance under [35 U.S.C. 122](#) warranting that a copy of the application-as-filed be provided upon written request as provided in [37 CFR 1.14\(a\)\(1\)\(vi\)](#). In addition, if a U.S. patent application publication, a U.S. patent, a published international application, or a published international registration claims benefit under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365](#), or [386](#) to a U.S. patent application, a copy of that application-as-filed may be provided upon written request (see [37 CFR 1.14\(a\)\(1\)\(v\)](#)), or be available through Patent Center if the application is maintained in the IFW system. A benefit claim in an international design application that does not

designate the United States is not a claim under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365](#) or [386](#). The written request, including a copy of the page of the patent application publication, U.S. patent, published international application, or published international registration including the incorporation by reference or specific reference under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365](#), or [386](#) and the requisite fee set forth in [37 CFR 1.19\(b\)\(1\)](#), should be directed to the Patent and Trademark Copy Fulfillment Branch of the Public Records Division. However, an incorporation by reference that is made as part of a transmittal letter for the application, or that is a part of the text of the application that has been 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. See [37 CFR 1.14\(a\)\(1\)\(vii\)](#).

Copies of a patent application-as-filed and the contents of a patent application file wrapper may be ordered on-line or requested by facsimile from the Patent and Trademark Copy Fulfillment Branch. Payment of the appropriate fee under [37 CFR 1.19\(b\)](#) may be made by USPTO Deposit Account, American Express®, Discover®, MasterCard®, or Visa® by any person having a right to access to the originally filed application or patent. The Office does not provide for access to non-United States applications.

Form PTO/SB/68 may be used to request access, which is available at [www.uspto.gov](http://www.uspto.gov).

#### **IV. ACCESS WHERE PART OF AN APPLICATION IS INCORPORATED BY REFERENCE IN A U.S. PATENT APPLICATION PUBLICATION OR A U.S. PATENT**

[37 CFR 1.14\(a\)\(1\)\(vi\)](#) 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 U.S. patent application publication or a U.S. patent, upon the filing of an appropriate request and the 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/YYY,YYY, is hereby 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 U.S. patent application publication or a U.S. patent constitutes a special circumstances under [35 U.S.C. 122\(a\)](#) 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, applicant must file two copies of the information incorporated by reference 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/YYY,YYY application. Failure to provide the material within the time period provided will result in the entire application content (including prosecution history) being made available to the 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).

**V. PETITION FOR ACCESS BY THIRD PARTY**

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

(a) *Confidentiality of patent application information.* Patent applications that have not been published under [35 U.S.C. 122\(b\)](#) are generally preserved in confidence pursuant to [35 U.S.C. 122\(a\)](#). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § [1.11](#) or in this section.

(1) Records associated with patent applications (see paragraph (g) of this section for international applications and paragraph (j) of this section for international design applications) may be available in the following situations:

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(vii) *When a petition for access or a power to inspect is required.* Applications that were not published or patented, that are not the subject of a benefit claim under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3), or are not identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under

[PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States, are not available to the public. If an application is identified in the file contents of another application, but not the published patent application or patent itself, a granted petition for access (see paragraph (i)) or a power to inspect (see paragraph (c) of this section) is necessary to obtain the application, or a copy of the application.

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(i) *Access or copies in other circumstances.* The Office, either *sua sponte* or on petition, may also provide access or copies of all or part of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. Any petition by a member of the public seeking access to, or copies of, all or part of any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include:

(1) The fee set forth in § [1.17\(g\)](#); and

(2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application.

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Any interested party may file a petition, accompanied by the petition fee, to the Director 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. In addition, telephone and facsimile numbers should be provided to expedite handling of the petition. Petitions for access are handled in the Office of Patent Legal Administration, unless the application is involved in an interference, derivation proceeding, or trial before the Patent Trial and Appeal Board. See [MPEP § 1002.02\(b\)](#), item 21.

The petition may be filed either with proof of service of copy upon the inventor, applicant in an application filed on or after September 16, 2012, 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 inventor, applicant in an application filed on or after September 16, 2012, assignee of record, or attorney or agent of record in the application (hereinafter “applicant”). A separate petition, with fee, must be filed for each application file to which access is desired. Each petition should show not only why

access is desired, but also why petitioner believes they are 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 they have 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. If access is granted to the application, any objections filed by the applicant will be available to the petitioner since these papers are in the application file. If access to the application is denied, petitioner will not receive copies of any objections filed by the applicant. 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 the applicant's application as a means to interfere with a competitor's business or customers. See, e.g., *In re Crossman*, 187 USPQ 367 (PTO Solicitor 1975); and *In re Trimless Cabinets*, 128 USPQ 95 (Comm'r Pat. 1960). Furthermore, “special circumstances” could be found where an attorney or agent 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 to obtain power to inspect from an assignee or inventor. See [MPEP §§ 104](#) and [106.01](#).

## VI. ACCESS WHERE PATENT CLAIMS [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) BENEFIT

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

(a) *Confidentiality of patent application information.* Patent applications that have not been published under [35 U.S.C. 122\(b\)](#) are generally preserved in confidence pursuant to [35 U.S.C. 122\(a\)](#). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § [1.11](#) or in this section.

(1) Records associated with patent applications (see paragraph (g) of this section for international applications and paragraph (j) of this section for international design applications) may be available in the following situations:

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(iv) *Unpublished abandoned applications (including provisional applications) that are identified or relied upon.* The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title, and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)).

(v) *Unpublished pending applications (including provisional applications) whose benefit is claimed.* A copy of the file contents of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)), if the benefit of the application is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in an application that has issued as a U.S. patent, or in an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed or a specific document in the file of the pending application may also be provided to any person upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vi) *Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.* A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ [1.19\(b\)](#)), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

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Whenever a patent relies on the filing date of an earlier but still pending application, the Office permits an applicant to obtain a copy of the prior application, either as originally filed or of the pending file history, upon written request (to the Patent and Trademark Copy Fulfillment Branch of the Public Records Division) and payment of the appropriate fee. Furthermore, after publication of a U.S. patent, a U.S. patent application publication, a statutory invention registration, an international application under [PCT Article 21\(2\)](#), or an international registration under Hague Agreement Article 10(3), the file contents of any abandoned application identified or relied upon in such a publication are available pursuant to [37 CFR 1.14\(a\)\(1\)\(iv\)](#). If the application is pending and benefit of the application is claimed pursuant to [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in such a patent document, then the file contents of the application are available pursuant to [37 CFR 1.14\(a\)\(1\)\(v\)](#). Such a patent application is available through Patent Center if the application is maintained in the IFW system.

#### VII. ACCESS TO PROVISIONAL APPLICATIONS

Provisional applications are not published under [35 U.S.C. 122\(b\)](#) and are generally preserved in confidence pursuant to [35 U.S.C. 122\(a\)](#), as with any other unpublished application. Therefore, access to or copies of all or part of a provisional application are customarily only made available to the public under the limited circumstances provided in [37 CFR 1.14\(a\)\(1\)\(iv\)-\(vi\)](#) and [1.14\(i\)](#). See subsections III-VI above. For example, a provisional application that is relied upon for priority in a U.S. patent and is abandoned is available under [37 CFR 1.14\(a\)\(1\)\(iv\)](#) and, as a result, may be available through Patent Center. For information on obtaining access to or copies of a provisional application using a power to inspect signed by an authorized person associated with the provisional application, see [37 CFR 1.14\(c\)](#) and [MPEP § 104](#).

#### VIII. APPLICATION AT THE PATENT TRIAL AND APPEAL BOARD

The Patent Trial and Appeal Board handles all requests for access to, or copies of Office records directly related to, applications involved in interferences, derivation proceedings, or trials. See [37 CFR 41.109](#) and [37 CFR 42.3](#). See also [MPEP Chapter 2300](#).

#### IX. DEFENSIVE PUBLICATIONS

The entire application file of a defensive publication is available to the public for inspection and obtaining copies. See [MPEP § 711.06](#).

#### X. REISSUE APPLICATIONS

[37 CFR 1.11\(b\)](#) opens reissue applications 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 gives interested members of the public an opportunity to submit to the examiner information pertinent to patentability of the reissue application.

IFW reissue application files are open to inspection by the general public by way of Patent Center via the USPTO Internet site. In viewing the images of the files, members of the public will be able to view the entire content of the reissue application file history. Access to Patent Center is available at [www.uspto.gov/PatentCenter](http://www.uspto.gov/PatentCenter).

#### XI. REQUEST FOR REEXAMINATION

An announcement of the filing of each request for reexamination in which the entire fee has been paid, and of each reexamination ordered at the initiative of the Director under [37 CFR 1.520](#), will be published in the *Official Gazette*. A reexamination file is normally NOT open to inspection by the general public until the file has been scanned into the IFW system, at which point the file is open to inspection by the public by way of Patent Center via the USPTO Internet site. In viewing the images of the reexamination proceedings, members of the public will be able to view the entire contents of the

reexamination file with the exception of non-patent literature. See also [MPEP § 2232](#).

## XII. DECISIONS BY THE DIRECTOR

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

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(e) *Decisions by the Director.* Any decision by the Director that would not otherwise be open to public inspection may be published or made available for public inspection if:

(1) The Director believes the decision involves an interpretation of patent laws or regulations that would be of precedential value; and

(2) The applicant is given notice and an opportunity to object in writing within two months on the ground that the decision discloses a trade secret or other confidential information. Any objection must identify the deletions in the text of the decision considered necessary to protect the information, or explain why the entire decision must be withheld from the public to protect such information. An applicant or party will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of a decision are made public under this paragraph over his or her objection

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### *37 CFR 41.6 Public availability of Board records.*

#### (a) *Publication.*

(1) *Generally.* Any Board action is available for public inspection without a party's permission if rendered in a file open to the public pursuant to § [1.11](#) of this title or in an application that has been published in accordance with §§ [1.211](#) to [1.221](#) of this title. The Office may independently publish any Board action that is available for public inspection.

(2) *Determination of special circumstances.* Any Board action not publishable under paragraph (a)(1) of this section may be published or made available for public inspection if the Director believes that special circumstances warrant publication and a party does not, within two months after being notified of the intention to make the action public, object in writing on the ground that the action discloses the objecting party's trade secret or other confidential information and states with specificity that such information is not otherwise publicly available. If the action discloses such information, the party shall identify the deletions in the text of the action considered necessary to protect the information. If the affected party considers that the entire action must be withheld from the public to protect such information, the party must explain why. The party will be given time, not less than twenty days, to request reconsideration and seek court review before any contested portion of the action is made public over its objection.

#### (b) *Record of proceeding.*

(1) The record of a Board proceeding is available to the public unless a patent application not otherwise available to the public is involved.

(2) Notwithstanding paragraph (b)(1) of this section, after a final Board action in or judgment in a Board proceeding, the record of the Board proceeding will be made available to the public if any involved file is or becomes open to the public under § [1.11](#) of this title or an involved application is or becomes published under §§ [1.211](#) to [1.221](#) of this title.

[37 CFR 1.14\(e\)](#) states the conditions under which significant decisions by the Director that would not otherwise be open to public inspection will be made available to the public. [37 CFR 41.6](#) describes the procedure for making a decision of the Patent Trial and Appeal Board available to the public. These sections are applicable to decisions deemed by the Director to involve an interpretation of patent laws or regulation that would be of significant precedential value, where such decisions are contained in either pending or abandoned applications or in Board records not otherwise open to the public. It is applicable whether or not the decision is a final decision of the U.S. Patent and Trademark Office.

[37 CFR 1.14\(e\)](#) and [37 CFR 41.6](#) are considered to place a duty on the U.S. 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.

## XIII. FOIA REQUESTS

### *37 CFR 102.4 Requirements for making requests.*

(a) A request for USPTO records that are not customarily made available to the public as part of USPTO's regular informational services must be in writing, and shall be processed under FOIA, regardless of whether FOIA is mentioned in the request. Requests should be sent to the USPTO FOIA Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450 (records FOIA requires to be made regularly available for public inspection and copying are addressed in § [102.2\(c\)](#)). For the quickest handling, the request letter and envelope should be marked "Freedom of Information Act Request." For requests for records about oneself, § [102.24](#) contains additional requirements. For requests for records about another individual, either a written authorization signed by that individual permitting disclosure of those records to the requester or proof that individual is deceased (for example, a copy of a death certificate or an obituary) facilitates processing the request.

(b) The records requested must be described in enough detail to enable USPTO personnel to locate them with a



reasonable amount of effort. Whenever possible, a request should include specific information about each record sought, such as the date, title or name, author, recipient, and subject matter of the record, and the name and location of the office where the record is located. Also, if records about a court case are sought, the title of the case, the court in which the case was filed, and the nature of the case should be included. If known, any file designations or descriptions for the requested records should be included. In general, the more specifically the request describes the records sought, the greater the likelihood that USPTO will locate those records. If the FOIA Officer determines that a request does not reasonably describe records, the FOIA Officer will inform the requester what additional information is needed or why the request is otherwise insufficient. The FOIA Officer also may give the requester an opportunity to discuss the request so that it may be modified to meet the requirements of this section.

Many decisions of the Office are available on the FOIA section of the USPTO website at [www.uspto.gov/learning-and-resources/ip-policy/electronic-freedom-information-act-e-foia](http://www.uspto.gov/learning-and-resources/ip-policy/electronic-freedom-information-act-e-foia). See [37 CFR Part 102, Subpart A](#), “Freedom of Information Act,” for rules pertaining to FOIA requests.

**104 Power to Inspect Application [R-07.2022]**

**I. AUTHORITY TO GRANT ACCESS - APPLICATION FILED ON OR AFTER SEPTEMBER 16, 2012**

*37 CFR 1.14 Patent applications preserved in confidence.*

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(c) *Power to inspect a pending or abandoned application.* Access to an application may be provided to any person if the application file is available, and the application contains written authority (e.g., a power to inspect) granting access to such person. The written authority must be signed by:

- (1) The applicant;
- (2) A patent practitioner of record;
- (3) The assignee or an assignee of an undivided part interest;
- (4) The inventor or a joint inventor; or
- (5) A registered attorney or agent named in the papers accompanying the application papers filed under § [1.53](#) or the national stage documents filed under § [1.495](#), if a power of attorney has not been appointed under § [1.32](#).

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For applications filed on or after September 16, 2012, the applicant, a patent practitioner of record, the assignee or an assignee of an undivided part

interest, or an inventor may provide a written authority for access to a pending or abandoned application kept in confidence under [35 U.S.C. 122\(a\)](#), except as provided in [37 CFR 1.11](#), [1.14](#), [41.6](#), or [42.412](#). The written authority must identify the application to be inspected and the name of the person authorized to have access, and will be made of record. Access provided upon the written order of the Director will also become a part of the record of the application.

A person acting in a representative capacity under [37 CFR 1.34](#) may execute a power to inspect an application only if the patent practitioner was named in the application transmittal papers filed under [37 CFR 1.53](#) or the national stage documents filed under [37 CFR 1.495](#) and a power of attorney has not been appointed under [37 CFR 1.32](#). Once a power of attorney has been filed, any previously filed power to inspect signed by a patent practitioner who does not have a power of attorney will cease to have effect. For a discussion of power of attorney in an application, see [MPEP § 402](#).

**II. AUTHORITY TO GRANT ACCESS - APPLICATION FILED BEFORE SEPTEMBER 16, 2012**

*37 CFR 1.14 (pre-AIA) Patent applications preserved in confidence.*

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(c) *Power to inspect a pending or abandoned application.* Access to an application may be provided to any person if the application file is available, and the application contains written authority (e.g., a power to inspect) granting access to such person. The written authority must be signed by:

- (1) An applicant;
- (2) An attorney or agent of record;
- (3) An authorized official of an assignee of record (made of record pursuant to § 3.71 of this chapter); or
- (4) A registered attorney or agent named in the papers accompanying the application papers filed under § 1.53 or the national stage documents filed under § 1.495, if an executed oath or declaration pursuant to § 1.63 or § 1.497 has not been filed.

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For applications filed prior to September 16, 2012, if an executed oath or declaration pursuant to [37 CFR 1.63](#) or [1.497](#) has been filed, no person but the applicant (any one of joint applicants), an attorney

or agent of record (if a power of attorney was filed), or an assignee whose assignment is of record will be permitted to have access to the file of any pending application kept in confidence under [35 U.S.C. 122\(a\)](#), except as provided for under [37 CFR 1.11, 1.14, 41.6, or 42.412](#), 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 Director, which will also become a part of the record of the application.

A person acting in a representative capacity under [37 CFR 1.34](#) may execute a power to inspect an application only if the attorney or agent was named in the application transmittal papers filed under [37 CFR 1.53](#) or the national stage documents filed under [37 CFR 1.495](#) and an executed oath or declaration has not been filed. Once an executed oath or declaration has been filed, any previously filed power to inspect signed by a registered attorney or agent who does not have a power of attorney will cease to have effect. For a discussion of power of attorney in an application, see [MPEP § 402](#).

### III. POWER TO INSPECT

Powers to inspect are not accepted in Image File Wrapper (IFW) applications. IFW applications are available through the Private Patent Application Information Retrieval (PAIR) system, and pro se applicants and attorneys of record have direct access to the IFW through Private PAIR (when a Customer Number is associated with the correspondence address for the application, and the applicant or attorney has access to Private PAIR for the customer number). In addition, IFW application files of published applications or patents are available at least through Patent Center. If for some reason an applicant, inventor, assignee, or attorney or agent of record cannot view an IFW application through Private PAIR or Patent Center, then a copy of the application must be purchased from the Patent and Trademark Copy Fulfillment Branch of the Public Records Division. A "power to inspect" is, in effect, the same as a "power to inspect and make copies."

Where an applicant relied on the applicant's 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 Director. Such permission is via petition for access under [37 CFR 1.14\(i\)](#).

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

Permission to inspect given by the Director, 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.

### IV. ACCESS TO PATENT APPLICATIONS (PROVISIONAL AND NONPROVISIONAL) AND BOARD RECORDS

In order to ensure that access to patent applications, other than applications that are available pursuant to [37 CFR 1.11](#) or [1.14](#), and Board records are given only to persons who are entitled thereto or who are specially authorized to have access under [37 CFR 1.11, 1.14](#) and [41.6](#) 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 U.S. Patent and Trademark Office:

(A) Access, as provided for in the rules, will be given on *oral request* to any applicant, inventor, 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. Form PTO/SB/67 may be used for this purpose.

(D) In provisional applications, access or certified copies may only be requested by parties with written authority from a named inventor, the applicant, the assignee of record, or the attorney or agent of record, unless the application is available pursuant to [37 CFR 1.14\(a\)\(1\)\(iv\)-\(vi\)](#). 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, the applicant, 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 [R-11.2013]**

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

**106 Control of Inspection by Assignee [R-11.2013]**

The applicant or assignee of record of the entire interest in an application may file an application or intervene in the prosecution of the application, appointing an attorney or agent of his or her own choice. See [37 CFR 1.46](#) and [3.71](#). Such an application filing or intervention, however, does not exclude the inventor from access to the application to see that it is being prosecuted properly, unless the applicant or 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. Of course, after the application has published pursuant to [35 U.S.C. 122\(b\)](#), the application will be available to the public and any restriction on the inventor to access his or her application previously granted will no longer be in effect.

**106.01 Rights of Assignee of Part Interest [R-11.2013]**

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 (or, for applications filed on or after September 16, 2012, can prosecute the application after becoming the applicant under [37 CFR 1.46](#)), an assignee of a part interest or a licensee of exclusive right is entitled to inspect the application. For information pertaining to prosecution by the assignee, see [MPEP § 324](#) (for applications filed before September 16, 2012) and [MPEP § 325](#) (for applications filed on or after September 16, 2012).

**107-109 [Reserved]**

**110 Confidential Nature of International Applications [R-07.2015]**

*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 receipt of the communication of the international application under [Article 20](#),

(iii) date of 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 so 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.

### ***PCT Article 38***

#### ***Confidential Nature of the International Preliminary Examination.***

(1) Neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of [Article 30\(4\)](#) to the file of the international preliminary examination by any person or authority at any time, except by the elected Offices once the international preliminary examination report has been established.

(2) Subject to the provisions of paragraph (1) and [Articles 36\(1\) and \(3\)](#) and [37\(3\)\(b\)](#), neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, give information on the issuance or non-issuance of an international preliminary examination report and on the withdrawal or non-withdrawal of the demand or of any election.

#### **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](#).

(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](#), 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, except as provided in [37 CFR 1.14\(g\)](#).

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

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#### ***(g) International applications.***

(1) Copies of international application files for international applications which designate the U.S. and which have been published in accordance with [PCT Article 21\(2\)](#), or copies of a document in such application files, will be furnished in accordance with [PCT Articles 30](#) and [38](#) and [PCT Rules 94.2](#) and [94.3](#), upon written request including a showing that the publication of the application has occurred and that the U.S. was designated, and upon payment of the appropriate fee (see [§ 1.19\(b\)](#)), if:

(i) With respect to the Home Copy (the copy of the international application kept by the Office in its capacity as the Receiving Office, see [PCT Article 12\(1\)](#)), the international application was filed with the U.S. Receiving Office;

(ii) With respect to the Search Copy (the copy of an international application kept by the Office in its capacity as the International Searching Authority, see [PCT Article 12\(1\)](#)), the U.S. acted as the International Searching Authority, except for the written opinion of the International Searching Authority which shall not be available until the expiration of thirty months from the priority date; or

(iii) With respect to the Examination Copy (the copy of an international application kept by the Office in its capacity as the International Preliminary Examining Authority), the United States acted as the International Preliminary Examining Authority, an International Preliminary Examination Report has issued, and the United States was elected.

(2) A copy of an English language translation of a publication of an international application which has been filed in the United States Patent and Trademark Office pursuant to [35 U.S.C. 154\(d\)\(4\)](#) will be furnished upon written request including a showing that the publication of the application in accordance with [PCT Article 21\(2\)](#) has occurred and that the U.S. was designated, and upon payment of the appropriate fee ([§ 1.19\(b\)\(4\)](#)).

(3) Access to international application files for international applications which designate the U.S. and which



have been published in accordance with [PCT Article 21\(2\)](#), or copies of a document in such application files, will be permitted in accordance with [PCT Articles 30](#) and [38](#) and PCT Rules 44 *ter*. 1, [94.2](#) and [94.3](#), upon written request including a showing that the publication of the application has occurred and that the U.S. was designated.

(4) In accordance with [PCT Article 30](#), copies of an international application-as-filed under paragraph (a) of this section will not be provided prior to the international publication of the application pursuant to [PCT Article 21\(2\)](#).

(5) Access to international application files under paragraphs (a)(1)(i) through (a)(1)(vi) and (g)(3) of this section will not be permitted with respect to the Examination Copy in accordance with [PCT Article 38](#).

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[37 CFR 1.14\(g\)](#) applies to international applications having an international filing date on or after November 29, 2000. After publication of an application under [35 U.S.C. 122\(b\)](#), the USPTO will make available copies of the application files and also allow for access to those files in accordance with [37 CFR 1.14\(a\)](#). Therefore, after publication of an international application designating the U.S. under [PCT Article 21](#), the USPTO will make available copies of, and allow access to, those international application files which are kept in the USPTO (see [37 CFR 1.14\(g\)](#) ).

[37 CFR 1.14\(g\)\(1\)](#) sets forth those conditions upon which copies of international application files may be provided to the public. [37 CFR 1.14\(g\)\(1\)\(i\)](#) and (ii) address the situation where the U.S. acted as the receiving Office and the International Searching Authority, respectively. Under these provisions, copies of the Home and Search Copies of the international file will be provided upon request. However, the written opinion established by the International Searching Authority will not be available until the expiration of 30 months from the priority date. [37 CFR 1.14\(g\)\(1\)\(iii\)](#) addresses the situation in which the U.S. acted as the International Preliminary Examining Authority (IPEA), the U.S. was elected, and the international preliminary examination report (IPER) has issued. [PCT Rule 94.2](#) provides that after issuance of the IPER, the IPEA shall provide copies of any documents in the examination file to the elected Offices upon request. [PCT Rule 94.3](#) permits the elected Offices to provide access to any documents in its files after international publication has occurred. Therefore, the USPTO

acting in its capacity as an elected Office, will provide a copy of the examination file in an international application to a third party upon submission of a request complying with the requirements of [37 CFR 1.14\(g\)\(1\)\(iii\)](#). Requests for copies of an international application file under [37 CFR 1.14\(g\)\(1\)](#) must be in the form of a written request sent to the International Patent Legal Administration and must include a showing that the international application has been published and that the U.S. was designated. Such a showing should preferably be in the form of the submission of a copy of the front page of the published international application. Additionally, requests for copies of international application files must also be accompanied by the appropriate fee ([37 CFR 1.19\(b\)](#)).

[37 CFR 1.14\(g\)\(2\)](#) provides that copies of English language translations of international applications, which were published in a non-English language and which designated the U.S., and which have been submitted to the Office pursuant to [35 U.S.C. 154\(d\)\(4\)](#), will also be available to the public. The USPTO will not provide general notification to the public of the filing of English language translations under [35 U.S.C. 154](#). Under [35 U.S.C. 154](#), it is the responsibility of the applicant to notify any possible infringers for the purposes of obtaining provisional rights.

[37 CFR 1.14\(g\)\(3\)](#) addresses access to the Home Copy and the Search Copy of the international application. Access to the Examination Copy of the international application is prohibited under [37 CFR 1.14\(g\)\(5\)](#) as required by [PCT Article 38](#).

**111-114 [Reserved]**

**115 Review of Applications for National Security and Property Rights Issues [R-07.2022]**

**35 U.S.C. 181 Secrecy of certain inventions and withholding of patent.**

Whenever publication or disclosure by the publication of an application or by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental

to the national security, the Commissioner of Patents upon being so notified shall order that the invention be kept secret and shall withhold the publication of an application or the grant of a patent therefor under the conditions set forth hereinafter.

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All provisional applications filed under [35 U.S.C. 111\(b\)](#), nonprovisional applications filed under [35 U.S.C. 111\(a\)](#), international applications filed under the PCT, and international design applications filed under the Hague Agreement, in the U.S. Patent and Trademark Office (USPTO) are reviewed for the purposes of issuance of a foreign filing license pursuant to [35 U.S.C. 184](#). See also [37 CFR 5.1\(b\)](#). These applications are screened upon receipt in the USPTO for subject matter that, if disclosed, might impact the national security. Such applications are referred to the appropriate agencies for consideration of restrictions on disclosure of the subject matter as provided for in [35 U.S.C. 181](#).

If a defense agency concludes that disclosure of the invention would be detrimental to the national security, a secrecy order is recommended to the Commissioner for Patents. The Commissioner then issues a Secrecy Order and withholds the publication of the application or the grant of a patent for such period as the national interest requires.

For those applications in which the Government has a property interest (including applications indicating national security classified subject matter), responsibility for notifying the Commissioner for Patents of the need for a Secrecy Order resides with the agency having that interest. Applications that are national security classified (see [37 CFR 1.9\(i\)](#)) may be so indicated by use of authorized national security markings (e.g., “Confidential,” “Secret,” or “Top Secret”). National security classified documents filed in the USPTO must be either hand-carried to Licensing and Review or mailed to the Office in compliance with [37 CFR 5.1\(a\)](#) and Executive Order 13526 of December 29, 2009. However, the Office will accept such applications filed with the USPTO via the Department of Defense Secret Internet Protocol Router Network (SIPRNET) and consider them as filed via the USPTO patent electronic filing system for purposes of [37 CFR 1.16\(t\)](#) and [37 CFR 1.445\(a\)\(ii\)](#). As set forth in [37 CFR 5.1\(d\)](#), the

applicant in a national security classified patent application must obtain a secrecy order from the appropriate defense agency or provide authority to cancel the markings. A list of contacts at the appropriate defense agency can be obtained by contacting Licensing and Review.

A second purpose for the screening of all applications, with an exception for provisional applications, is to identify inventions in which DOE or NASA might have property rights. See 42 U.S.C. 2182, 51 U.S.C. 20135, 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](#).

Provisional applications filed in a foreign language are also screened under these provisions. The Office will make an attempt to determine the subject matter of the application, but the applicant may be required to provide at least an English language abstract of the information for screening purposes. It is strongly recommended that if the applicant is in possession of an English language description of the technology, it should be filed with the provisional application to prevent screening delays.

All applications are required to be cleared from secrecy review before forwarding to issue. If the L&R code on the general information display does not equal 1, then in an IFW application, a message should be sent to LREVINCOMINGDOCS.

The Patent Data Portal (PDP) System's general information display discloses the current Licensing and Review status. The indicator “L&R code” displays the current status of the application while the indicators “Third Level Review” and “Secrecy Order” display the historical status of the application. An L&R code of “3” or a “Third Level Review” of “Yes” indicates that application is/has been considered for security screening.

A Secrecy Code of “4” indicates that application is currently under Secrecy Order. In this case, the application has been converted to a paper application file and there should be no images maintained in the Image File Wrapper system (IFW).

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. If the examiner is aware of subject matter which should be subject to screening by appropriate office personnel, this should be brought to the attention of Licensing and Review.

## 116-119 [Reserved]

## 120 Secrecy Orders [R-07.2022]

### 37 CFR 5.1 Correspondence.

(a) All correspondence in connection with this part, including petitions, should be addressed to: Mail Stop L&R, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

#### (b) Definitions.

(1) Application as used in this part includes provisional applications (§ 1.9(a)(2) of this chapter), nonprovisional applications (§ 1.9(a)(3)), international applications (§ 1.9(b)), or international design applications (§ 1.9(n)).

(2) Foreign application as used in this part includes, for filing in a foreign country or in a foreign or international intellectual property authority (other than the United States Patent and Trademark Office acting as a Receiving Office for international applications (35 U.S.C. 361, 37 CFR 1.412) or as an office of indirect filing for international design applications (35 U.S.C. 382, 37 CFR 1.1002)) any of the following: An application for patent, international application, international design application, or application for the registration of a utility model, industrial design, or model.

(c) Patent applications and documents relating thereto that are national security classified (see § 1.9(i) of this chapter) and contain authorized national security markings (e.g., “Confidential,” “Secret” or “Top Secret”) are accepted by the Office. National security classified documents filed in the Office must be either hand-carried to Licensing and Review or mailed to the Office in compliance with paragraph (a) of this section.

(d) The applicant in a national security classified patent application must obtain a secrecy order pursuant to § 5.2(a). If a national security classified patent application is filed without a notification pursuant to § 5.2(a), the Office will set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application. If evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency is submitted by the applicant within the time period set by the Office, but the application has not been declassified or placed under a secrecy order pursuant

to § 5.2(a), the Office will again set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to again obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application.

(e) An application will not be published under § 1.211 of this chapter or allowed under § 1.311 of this chapter if publication or disclosure of the application would be detrimental to national security. An application under national security review will not be published at least until six months from its filing date or three months from the date the application was referred to a defense agency, whichever is later. A national security classified patent application will not be published under § 1.211 of this chapter or allowed under § 1.311 of this chapter until the application is declassified and any secrecy order under § 5.2(a) has been rescinded.

(f) Applications on inventions made outside the United States and on inventions in which a U.S. Government defense agency has a property interest will not be made available to defense agencies.

### 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 for Patents.

(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.

(c) An application disclosing any significant part of the subject matter of an application under a secrecy order pursuant to paragraph (a) of this section also falls within the scope of such secrecy order. Any such application that is pending before the Office must be promptly brought to the attention of Licensing and Review, unless such application is itself under a secrecy order pursuant to paragraph (a) of this section. Any subsequently filed application containing any significant part of the subject matter of an application under a secrecy order pursuant to paragraph (a) of this section must either be hand-carried to Licensing and Review or mailed to the Office in compliance with § 5.1(a).

### 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 for Patents will not be set for hearing until the secrecy order is removed.

(b) An interference or derivation will not be instituted involving a national application under secrecy order. An applicant whose application is under secrecy order may suggest an interference (§ 41.202(a) of this title), but the Office will not act on the request while the application remains under a secrecy order.

(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 and international design 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.

### **I. SECRECY 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 (Type I secrecy order)— to be used for those patent applications that disclose critical technology with military or space application in accordance with DoD Directive 5230.25 “Withholding of Unclassified Technical Data From Public Disclosure,” based on 10 U.S.C. 130 “Authority to Withhold From Public Disclosure Certain Technical Data.”

(B) Secrecy Order and Permit for Disclosing Classified Information (Type II secrecy order)— to be used for those patent applications which contain data that is properly classified or classifiable 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 National Industrial Security Program Operating Manual (NISPOM).

(C) General Secrecy Order (Type III secrecy order)— to be used for those patent applications that contain data deemed detrimental to national security



if published or disclosed, including that 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 for Patents. 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 Type I 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 also 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, Republic of Korea, 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. Applicant must arrange filing of such subject matter through the agency sponsoring the secrecy order.

The intent of the Type II Secrecy Order is to treat classified and classifiable 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 Type III 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.

## II. 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.

## III. 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 for Patents 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\(a\)](#). 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,

applicant is required to provide a statement that the new attorney(s) has been apprised of the secrecy order.

In the case of applications bearing National Security Classification markings pursuant to an Executive Order, e.g., “Confidential” or “Secret,” applicants must provide a DoD cage code as evidence of the ability to accept and store classified information. Applicants no longer need to provide individual personal information to ensure a proper security clearance. Personnel controlling the cleared correspondence address bear the burden of ensuring that individuals obtaining classified information from the correspondence address follow the proper procedures for handling classified information.

#### **IV. INTERNATIONAL APPLICATIONS (PCT) AND INTERNATIONAL DESIGN APPLICATIONS**

If the Secrecy Order is applied to an international application or an international design application, the application will not be mailed, delivered, or otherwise transmitted to the international authorities or the applicant as long as the Secrecy Order remains in effect.

An international application will be considered withdrawn (abandoned) if the Secrecy Order remains in effect at the end of the time limit under [PCT Rule 22.3](#) 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.

#### **V. 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, they may informally contact the sponsoring agency to discuss these facts or formally petition the Commissioner for Patents to rescind the Order. Rescission of a Secrecy Order may also be effected in some circumstances by expunging the

sensitive subject matter from the disclosure, provided the sensitive subject matter is not necessary for an enabling disclosure under [35 U.S.C. 112](#). See [MPEP § 724.05](#). The defense agency identified with the Secrecy Order as sponsoring the Order should be contacted directly for assistance in determining what subject matter in the application is sensitive, and whether the agency would agree to rescind the Order upon expunging this subject matter. The applicant may also petition the Commissioner for Patents 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 Mail Stop L&R, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, 22313-1450.

#### **VI. 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 Mail Stop L&R, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, 22313-1450 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.

#### **VII. 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. 12958 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 under Secrecy Order and/or Bearing National Security Markings [R-07.2022]**

Applications subject to Secrecy Order will be deleted from any image file system within the USPTO, converted to paper and held with Licensing and Review. The application will be transferred to an examiner designated by Licensing and Review for examination. Under the current Executive Order for Classified National Security Information, 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 Orders 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, including non-patent literature, in the U.S. Patent and Trademark Office bearing words such as “Secret,” “Confidential,” “ITAR” or similar must be promptly referred to Licensing and Review 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. For applications filed with the Office bearing what appears to be National Security Markings, the applicant will be so notified by Licensing and Review and asked to explain the markings, remove such markings if improper, or

obtain a Secrecy Order, if necessary. If markings are found improper and removed, the application may be referred to a defense agency if deemed necessary for review under the second paragraph of [35 U.S.C. 181](#). Any application filed directly with Licensing and Review, not bearing proper security markings or Secrecy Order will be transmitted to scanning for incorporation as an electronic file in IFW and treated as a normal application.

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\(v\)](#).

### **122-129 [Reserved]**

### **130 Examination of Secrecy Order Cases [R-11.2013]**

All applications in which a Secrecy Order has been imposed are examined in a secure location by examiners possessing national security clearances under the control of Licensing and Review. If the Order is imposed subsequent to the docketing of an application in another TC, the application will be transferred to an examiner designated by Licensing and Review.

Secrecy Order cases are examined for patentability as in other cases, but will not be passed to issue; nor will an interference or derivation be instituted where one or more of the conflicting cases is classified or under Secrecy Order. See [37 CFR 5.3](#) and [MPEP § 2306](#).

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 Patent Trial and Appeal Board until the Secrecy Order is removed, unless specifically ordered by the Commissioner for Patents.

When a Secrecy Order case is in condition for allowance, a notice of allowability (Form D-10) is issued, thus closing the prosecution. See [37 CFR](#)

[5.3\(c\)](#). 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 national 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. Pursuant to [37 CFR 5.1\(d\)](#), if no Secrecy Order has issued in a national security classified patent application, the Office will set a time period within which the applicant must take one of the following three actions in order to prevent abandonment of the application:

- (A) obtain a Secrecy Order;
- (B) declassify the application; or
- (C) submit evidence of a good faith effort to obtain a Secrecy Order pursuant to [37 CFR 5.2\(a\)](#).

Pursuant to [37 CFR 5.1\(e\)](#), a national security classified patent application will not be allowed until the application is declassified and any Secrecy Order pursuant to [37 CFR 5.2\(a\)](#) has been rescinded.

## 131-139 [Reserved]

## 140 Foreign Filing Licenses [R-07.2022]

### 35 U.S.C. 182 Abandonment of invention for unauthorized disclosure.

The invention disclosed in an application for patent subject to an order made pursuant to [section 181](#) may be held abandoned upon its being established by the Commissioner of Patents that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner of Patents. The

abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner of Patents shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

### 35 U.S.C. 184 Filing of application in foreign country.

(a) FILING IN FOREIGN COUNTRY.—Except when authorized by a license obtained from the Commissioner of Patents 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 of Patents pursuant to [section 181](#) 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 the application does not disclose an invention within the scope of [section 181](#).

(b) APPLICATION.—The term “application” when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

(c) SUBSEQUENT MODIFICATIONS, AMENDMENTS, AND SUPPLEMENTS.—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](#) 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](#), 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 person, his successors, assigns, or legal representatives shall be invalid, unless the



failure to procure such license was through error, and the patent does not disclose subject matter within the scope of [section 181](#).

**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](#), 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](#), 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.

**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, or exporting to, a foreign country an application on an invention made in the United States or technical data relating thereto.***

(a) A license from the Commissioner for Patents 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 country or in a foreign or international intellectual property authority (other than the United States Patent and Trademark Office acting as a Receiving Office for international applications ([35 U.S.C. 361, 37 CFR 1.412](#)) or as an office of indirect filing for international design applications ([35 U.S.C. 382, 37 CFR 1.1002](#))), 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 for Patents referred to in paragraph (a) of this section would also authorize the export of technical data abroad for purposes related to:

(1) The preparation, filing or possible filing, and prosecution of a foreign application; and

(2) The use of a World Intellectual Property Organization online service for preparing an international application for filing with the United States Patent and Trademark Office acting as a Receiving Office ([35 U.S.C. 361, 37 CFR 1.412](#)) without separately complying with the regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy).

(c) Where technical data in the form of a patent application, or in any form, are being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign application, without the license from the Commissioner for Patents 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 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, 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 734 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 application if:

(i) A license is not, or was not, required under paragraph (e)(2) of this section for the foreign 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 United States Patent and Trademark Office. An authorization to file a foreign 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 in the United States Patent and Trademark Office on an invention 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 or other official notice 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) A petition for license must include the fee set forth in [§ 1.17\(g\)](#) of this chapter, the petitioner's address, and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner. The petition should be presented in letter form.

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

If no corresponding national, international design, 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 or exported abroad, must be furnished with the petition. If, however, all new matter in the application to be filed or exported 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 (a). This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign 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 authorizes the export of technical data pursuant to [§ 5.11\(b\)](#) and the filing of an application in a foreign country or with any foreign or international intellectual property authority when the technical data and the subject matter of the foreign application correspond to that of the application or other materials reviewed pursuant to [§§ 5.12](#) through [5.14](#), upon which the license was granted. This license includes the authority:

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

(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 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 that 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 120 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 Assistance to Foreign Atomic Energy Activities, 10 CFR part 810, in effect at the time of foreign filing.

(b) Applications or other materials that 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 (b). Grant of this license authorizes the export of technical data pursuant to [§ 5.11\(b\)](#) and the filing of an application in a foreign country or with any foreign or international intellectual property authority. Further, this license includes the authority to export and file all duplicate and formal papers in foreign countries or with foreign or international intellectual property authorities and to make amendments, modifications, and supplements to; file divisions of; and take any action in the prosecution of the foreign 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(g) of this chapter), 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 or export the foreign application, no license is required to file papers in connection with the prosecution of the foreign application not involving the disclosure of additional subject matter.

(e) Any paper filed abroad or transmitted to a foreign or international intellectual property authority following the filing of a foreign application that changes the general nature of the subject matter disclosed at the time of filing in a manner that would require such application to have been made available for inspection under 35 U.S.C. 181 or that involves the disclosure of subject matter listed in paragraph (a)(3)(i) or (ii) of this section must be separately licensed in the same manner as a foreign application. Further, if no license has been granted under § 5.12(a) after filing the corresponding United States application, any paper filed abroad or with a foreign or international intellectual property authority that involves the disclosure of additional subject matter must be licensed in the same manner as a foreign 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 for Patents 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 for Patents 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 734.3(b)(1)(v)) 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 U.S. 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 734.10(a)).

**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 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 [sic], 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 without the required license under § 5.11 first having been obtained, and

(4) The required fee (§ 1.17(g) of this chapter).

(b) The explanation in paragraph (a) of this section must include a showing of facts rather than a mere allegation of action through error. 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 should cover the period leading up to and including each of the proscribed foreign filings.

(c) 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 and registrations of industrial designs in foreign countries, the authority for export control has been delegated to the Commissioner for Patents (note that the term “Commissioner of Patents” is used in Chapter 17 of title 35 of the U.S. Code, but “Commissioner for Patents” is used in most of the remainder of the statute and throughout title 37 of the Code of Federal Regulations; both titles are understood to represent the same individual). Note that the export of subject matter abroad for purposes not related to foreign filing of a patent application or a registration of an industrial design, such as preparing an application in a foreign country for subsequent filing in the USPTO is not covered by any license from the USPTO. Applicants are directed to the Bureau of Industry and Security at the Department of Commerce for the appropriate clearances. For information on the requirements to export technical data abroad for purposes relating to the use of a World Intellectual Property Organization online service (ePCT) for preparing an international application for filing with the United States Receiving Office, see MPEP §§ [1821](#) and [1832](#).

There are two ways in which permission to file an 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 an application in the USPTO ([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 USPTO 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. The filing receipt or other official notice will indicate if a foreign filing license is granted. The license becomes effective on the date shown. Further, grant of this license is made of record in the application file. The scope of this license is quite broad as set forth in [37 CFR 5.15\(a\)](#).

#### **I. PETITIONS FOR FOREIGN FILING LICENSE UNDER [37 CFR 5.12\(b\)](#)**

Pursuant to [37 CFR 5.12\(a\)](#), the filing of an application on an invention made in the United States will be implicitly considered to include a petition for license under [35 U.S.C. 184](#) for the subject matter of the application. Explicit petitions for foreign filing licenses will also be accepted in accordance with [37 CFR 5.12\(b\)](#). Such petitions may be hand carried to the Office, faxed to Licensing and Review, or submitted via EFS-Web. See [MPEP §§ 502, 502.01](#) and [502.05](#). 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.



Petitions under [37 CFR 5.14\(a\) or \(b\)](#) as well as any license granted on the petition are made of record in the application file. Petitions under [37 CFR 5.14\(c\)](#) are not ordinarily made of record in the application 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\(g\)](#). If the petition is granted, the change in the scope of the license is effective as of that day.

Generally, a license will be granted, if there is no national security concern, within 3 business days from receipt of the petition filed under [37 CFR 5.12\(b\)](#) in Licensing and Review. Applicants are strongly encouraged to hand deliver or fax the license request directly to Licensing and Review at 571-270-9959 (preferred) or 571-273-0185. Applicants should also provide a contact number or fax number to which the license should be sent. Without this information, the license will be mailed to the requester, thereby delaying the receipt of the license.

## II. RETROACTIVE LICENSES

A petition for a retroactive filing license may be filed under [37 CFR 5.25](#) if an unlicensed foreign filing has occurred through error. However, the requirements of [37 CFR 5.25](#) must be fulfilled in order for such a petition to be granted. Note that for petitions filed prior to September 16, 2012, the petition must specify that the error occurred without deceptive intent (see [pre-AIA 37 CFR 5.25\(a\)\(3\)\(iii\) and \(b\)](#)). 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 USPTO, 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 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. Petitions for retroactive foreign filing licenses are processed by Licensing and Review and decided by the Office of Petitions. See [MPEP § 1002.02\(b\)](#). If applicant also wishes an expedited license for future filings, a separate expedited license request must be filed with Licensing and Review.

## III. IMPROPER FILING WITHOUT A FOREIGN FILING LICENSE

If, upon examining an application, the examiner learns of the existence of a corresponding foreign application which appears to have been filed before the United States application had been on file for 6 months, and if the invention apparently was made in this country, the examiner shall refer the application to Licensing and Review calling attention to the foreign application. Pending investigation of the possible violation, the application may be returned to the TC for prosecution on the merits. When it is otherwise in condition for allowance, the

application will be again submitted to Licensing and Review unless the latter has already reported that the foreign filing involves no bar to the United States application.

If it should be necessary to take action under [35 U.S.C. 185](#), Licensing and Review will request transfer of the application to it.

## 141-149 [Reserved]

## 150 Statements to DOE and NASA [R-11.2013]

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

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#### (d) *Applications reported to Department of Energy.*

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

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

### **42 U.S.C. 2182 Inventions conceived during Commission contracts; ownership; waiver; hearings**

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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 Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (unless the Commission advises the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office 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 Under Secretary of Commerce for Intellectual Property and Director of the United States Patent

and Trademark Office shall as soon as the application is otherwise in condition for allowance forward copies of the application and the statement to the Commission.

\*\*\*\*\*

Similarly, Title 51 United States Code, section 20135 provides in part:

### **51 U.S.C. 20135 Property rights in inventions**

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(d) Patent Application. - No patent may be issued to any applicant other than the Administrator for any invention which appears to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (hereafter in this section referred to as the "Director") to have significant utility in the conduct of aeronautical and space activities unless the applicant files with the Director, with the application or within 30 days after request therefor by the Director, a written statement executed under oath setting forth the full facts concerning the circumstances under which the invention was made and stating the relationship (if any) of the invention to the performance of any work under any contract of the Administration. Copies of each such statement and the application to which it relates shall be transmitted forthwith by the Director 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 nonprovisional applications have been marked by the USPTO security screeners as being of interest to DOE or NASA. Provisional applications are not subject to DOE or NASA property rights review. 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 [37 CFR 1.137](#). *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 [R-11.2013]**

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 is construed by the Office to mean the inventor or joint inventors in person, or an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter. Accordingly, in the ordinary situation, the statements must be signed by the inventor or the joint inventors, or an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter 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 request 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 Licensing and Review.

In instances where an applicant does not have firsthand 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 inventor applicant is deceased or legally incapacitated, 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 information 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 OG 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.

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 \_\_\_\_\_