Chapter 100 Secrecy and Access

101 General

Extract from Rule 14. Patent applications preserved in secrecy. **(a) Pending patent applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority of the applicant, or his assignee or attorney or agent, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules.**

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

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

102 Information as to Status of an Application

Information will be given as to the pendency, abandonment or patent number of any U.S. application identified by Serial Number in a U.S. or foreign patent. A written request for such information must be made, identifying the source (the U.S. or foreign patent) by country and number. See 203.08.

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

Rule 11. Patent files open to the public. **After a patent has been issued, the specification, drawings, and all papers relating to the case in the file of the patent are open to inspection by the general public, and copies may be furnished upon paying the fee therefor. The file of any terminated interference involving a patent, or an application on which a patent has subsequently issued, is similarly open to public inspection and procurement of copies.**

Whenever a patent relies upon the filing date of an earlier application (see 35 U.S.C. 120), the public is entitled to see the portion of the earlier application that relates to the common subject matter, and also what prosecution, if any, was had in the earlier application of subject matter claimed in the patent. The interested party may file a petition to the Commissioner for access.

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

The petition may be filed either with proof of service of a copy upon the attorney of record, if known, in the application to which access is sought, or may be filed in duplicate, in which case the duplicate copy is sent by the Law Examiner to the attorney or owner of the application, who is given a limited period, as a week or ten days, within which to state any objection he may have to the granting of the petition. If no objection is raised, the petition is approved by the Law Examiner; otherwise a decision is rendered by the Commissioner. If there is no objection the petitioner is permitted to see the entire parent application. Otherwise, the petitioner is allowed to order a copy of only that portion of the parent application that relates to the common subject matter. A separate petition should be filed for each application to which access is desired, or sufficient extra copies provided so there may be one for placement in each application file, if the petition be granted, and one for service upon each attorney of record, if, as sometimes happens, the same applicant has different attorneys in different of his applications. Each

petition should show not only why access is desired, but also why petitioner believes he is entitled to access.

The entire application, an abstract or an abbreviature of which has been published, is available to the public for inspection and obtaining copies. See 711.06.

Extract from Rule 14. (b) Abandoned applications are likewise not open to public inspection, except that if an application referred to in a United States patent is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant. Abandoned applications may be destroyed after twenty years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

Rule 14(d) authorizes publication of decisions of the Board of Appeals or of the Commissioner, in abandoned applications, under certain conditions.

Rule 15. Requests for identifiable records. (a) Requests for records not disclosed to the public as part of the regular informational activity of the Patent Office and which are not otherwise dealt with in these rules may be made by completing Form CD-244, "Application to Inspect Department Records," and submitting this form, in person or by mail, to the Commissioner of Patents, Department of Commerce Building, Washington, D.C., 20231. A non-refundable application fee of $2.00 must accompany each application. Copies of Form CD-244 are available in the Central Reference and Records Inspection Facility, Room 2122, Department of Commerce Building, Washington, D.C., 20230, the search room of the Patent Reference Branch of the Patent Office, the search room of the Trademark Examining Operation, and in many public information offices and field offices of the Department of Commerce. If the requested record is identifiable, the request will be reviewed by the appropriate official authorized to make an initial determination of the availability of the record. If it is determined that the material is not to be made available to the requesting person, said person shall be notified in writing of that fact and the reasons why the record will not be disclosed. If the record is to be made available, inspection will be permitted in the appropriate Patent Office search room. Fees for copies of records and for searches and related services are payable in accordance with the schedule of fees and charges established in Section 4.8 of Title 15, Code of Federal Regulations.

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

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

104 Power to Inspect Application

No person except the applicant (any one of joint applicants), applicant's legal representative, the assignee whose assignment is of record, or the attorney, agent or associate attorney of record will be permitted to have access to the file of any application, except as provided for under the interference rules, unless written authority from one of the above indicated parties, identifying the application to be inspected, is filed in the case to become a part of the record thereof, or upon the written order of the Commissioner, which will also become a part of the record of the case.

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

When a power to inspect is received while a file is under the jurisdiction of a Service Branch, such as the Patent Reference Branch, the Document Services Branch, the Service Section of the Board of Appeals, and the Issue and Gazette Branch, permission to inspect is granted by the Head of the Branch who indicates the approval directly on the power.

Power to inspect may be granted when a duplicate copy of a filed power to inspect is

hand delivered. The copy with indication of approval is placed in the file.

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

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

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

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

105 Disbarred Attorney Cannot Inspect

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

106 Control of Inspection by Assignee

The assignee of the entire interest in an application may intervene in the prosecution of the case, appointing an attorney of his own choice. (See Rule 32.) Such intervention, however, does not exclude the inventor from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect. Even when such request is made, the applicant may be permitted to inspect the case on sufficient showing why such inspection is necessary to conserve his rights.

106.01 Rights of Assignee of Part Interest

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

107 "Secrecy Order" Cases

Title 35, United States Code, section 181 provides, in part, that any invention in which the Government does not have a property interest, and whose publication or disclosure by the granting of a patent might, in the opinion of the Commissioner, be detrimental to the national security, shall be made available to the

defense agencies. Upon notification by the defense agencies, the Commissioner is directed to order that such inventions be kept secret and to withhold the grant of a patent for such period as the national interest requires. Where the Government has a property interest, the interested Government agency determines whether to notify the Commissioner to keep the invention secret.

35 U.S.C. 184, *Filing of application in foreign country.* Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

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

107.01 "Review" of Applications for Secrecy Order

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

IN ORDER FOR DESIRED CONTROLS TO BE EFFECTIVE AGAINST FOREIGN FILING, THESE STEPS MUST BE TAKEN AT THE TIME THE APPLICATION IS RECEIVED IN THE EXAMINING GROUP AS A NEW APPLICATION. See Executive Examiner's Notice of Feb. 5, 1952.

It is the responsibility of the Primary Examiner to see that all applications are screened for this purpose and that the applications selected for "review" are promptly forwarded to Group 220, Licensing and Review. It is helpful if a check mark is made in the margin opposite to the part of the specification which is significant in suggesting security review.

The defense agencies also make known to the Patent Office specified technical fields or categories in which they have a particular interest. These are transmitted by Group 220 to the groups directly concerned. The Primary Examiners are responsible for submitting all applications within these fields or categories to Group 220 for review. When an application has been so "reviewed" the Primary Examiner is relieved of responsibility in the event any protest based on security breach follows from the issuance of a patent.

Applications in which the Government has an interest need not be reviewed under 35 U.S.C. 181 in the Patent Office. Unusual situations should be brought to the attention of Group 220. (For treatment of security markings see 109.)

Applications in the process of being reviewed by Group 220 may be borrowed by the examiner when reached for action. If applications are submitted for review as soon after filing as possible, they will ordinarily be returned in time for examination purposes. If an application is returned having a label affixed to the file wrapper marked "Submit to Group 220" (formerly the Patent Security Division) the application cannot be sent to issue by Examining Groups until it has been submitted to Group 220 for consideration of processing under Section 152 of the Atomic Energy Act (42 U.S.C. 2182) and/or Section 305c of the Space Act (42 U.S.C. 2547). When an Examiner finds an application in condition for allowance labeled as indicated above he should promptly make a complete interference search in the manner indicated in section 1302.08, prepare and mail a status letter to applicant and forward the application with Form PO–488 to Group 220. Where an application holding the group date, in which review is necessary or has not been completed, is found to be allowable, the situation should be called to the attention of Group 220. When the security status of the application cannot be promptly decided, Group 220 will report the progress that has been made to the Group Supervisory Examiner. Any action to be taken in the case, for the purpose of advancing said group date, must be arranged through the Group Supervisory Examiner.

107.02 Prosecution of "Secrecy Order" Cases

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

In case of a final rejection, while such action must be properly responded to within the six months' period. and an appeal, if filed, must be completed by the applicant, such appeal will not be set for hearing by the Board of Appeals until the secrecy order is removed, unless specifically ordered by the Commissioner.

In the situation where one or more conflicting cases is a "Secrecy Order" case, see 1111.04.

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

108 Applications Relating to Atomic Energy

Rule 14(c) reads as follows:

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

The Atomic Energy Act of 1954 requires that the Commissioner of Patents shall notify the Atomic Energy Commission of all applications for patent which, in his opinion, disclose inventions or discoveries required to be reported under subsection 151c which reads as follows:

"Any invention or discovery useful (1) in the production or utilization of special nuclear material or atomic energy. . . ."

The term "atomic energy" is defined as all forms of energy released in the course of nuclear fission or nuclear transformation.

It is helpful if a check mark is made in the margin opposite to the part of the specification which is significant in suggesting that the application be reported.

To carry out the responsibilities of the Commissioner under the Act, applications must be inspected promptly when received and those which appear to relate to Atomic Energy MUST BE PROMPTLY submitted to Group 220 even though the applications are owned or prosecuted by the United States or, indeed, the Atomic Energy Commission. In considering applications under the terms of Rule 14(c), the relation of the subject matter to national security under Sec. 107.01 is not a significant factor. EVEN applications using a well-known radioactive source for any purpose or which disclose inventions having special relation to atomic energy MUST BE SUBMITTED TO Group 220. See 706.03(b). (Basis: Notice of April 25, 1956.)

109 Security Markings

Under Executive Order 10,501, 18 Federal Register Number 220, page 7049, standards are prescribed for the marketing, handling, and care of official information which requires safeguarding in the interest of security.

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