

OGC Has Reviewed



I have sent you a copy of EO 10104 which is still in force. It has not been amended or changed. I checked this with the Federal Register people to be sure. EO 10104 is not related to EO 10501 which I have not sent. EO 10501 was superceded by 11652 which you have.

I have also sent the regulations from the Code of Federal Regulations that relate to the secrecy of inventions. Basically the CFR outlines the procedures that must be followed when dealing with secret patents. The law itself is set out at 35 USC 181 et seq. a copy of which is attached.

If this does not answer your questions please phone.



Librarian, OGC

and by section 1753 of the Revised Statutes of the United States, and as President of the United States, it is ordered that Executive Order No. 9721 of May 10, 1946, authorizing the transfer, under certain conditions, of civilian employees in the Executive branch of the Federal Government to public international organizations in which the United States Government participates, be, and it is hereby, amended in the following respects:

1. Section 1 is amended, effective as of May 10, 1946, by adding at the end thereof the following sentence:

"Any employee so transferred shall, for a period not to exceed three years from the date of transfer and while employed by the said international organization, be considered as being on leave of absence from his employment by the Federal Government: *Provided*, that the employee is subsequently reemployed by the Federal Government in accordance with section 3 of this order."

2. Section 2, which by its terms became inoperative on May 10, 1949, is revived and amended, effective as of that date, to read as follows:

"Any employee serving under a war-service indefinite appointment who is transferred to a public international organization pursuant to this order and, while serving in such organization and within three years from the date of such transfer, is either reached in regular order for probational appointment from a civil-service register appropriate for filling the position in which he was serving or could, with the approval of the head of such agency, have been given a competitive status under Civil Service Rule III if he had remained in the position in which he last served in a Federal agency, shall be considered as having acquired a competitive status as of the date he is reached for probational appointment or classification. Any employee transferred to a public international organization pursuant to this order who was serving in such organization on September 30, 1949, and had served continuously therein from the date of his transfer shall be considered, so far as Executive Order No. 10080 of September 30, 1949,¹ is concerned, as having been in an active-duty status on September 30, 1949, in the position in the Federal Government from which he was transferred

and as having had continuous service with the Federal Government from the date of his transfer to September 30, 1949."

HARRY S. TRUMAN

THE WHITE HOUSE,
February 1, 1950.

EXECUTIVE ORDER 10104

DEFINING CERTAIN VITAL MILITARY AND NAVAL INSTALLATIONS AND EQUIPMENT AS REQUIRING PROTECTION AGAINST THE GENERAL DISSEMINATION OF INFORMATION RELATIVE THERETO

WHEREAS section 795 of title 18 of the United States Code provides:

"(a) Whenever, in the interests of national defense, the President defines certain vital military and naval installations or equipment as requiring protection against the general dissemination of information relative thereto, it shall be unlawful to make any photograph, sketch, picture, drawing, map, or graphical representation of such vital military and naval installations or equipment without first obtaining permission of the commanding officer of the military or naval post, camp, or station, or naval vessels, military and naval aircraft, and any separate military or naval command concerned, or higher authority, and promptly submitting the product obtained to such commanding officer or higher authority for censorship or such other action as he may deem necessary.

"(b) Whoever violates this section shall be fined not more than \$1,000 or imprisoned not more than one year, or both."

AND WHEREAS section 797 of title 18 of the United States Code provides:

"On and after thirty days from the date upon which the President defines any vital military or naval installation or equipment as being within the category contemplated under section 795 of this title, whoever reproduces, publishes, sells, or gives away any photograph, sketch, picture, drawing, map, or graphical representation of the vital military or naval installations or equipment so defined, without first obtaining permission of the commanding officer of the military or naval post, camp, or station concerned, or higher authority, unless such photograph, sketch, picture, drawing, map, or graphical representation has clearly indicated thereon that it has been censored by the proper military or naval authority, shall be fined not more than \$1,000 or imprisoned not more than one year, or both."

NOW, THEREFORE, by virtue of the authority vested in me by the foregoing statutory provisions, and in the interests of national defense, I hereby define the

¹ 3 CFR, 1949 Supp., p. 124.

Chapter II—Executive Orders

E. O. 10105

following as vital military and naval installations or equipment requiring protection against the general dissemination of information relative thereto:

1. All military, naval, or air-force installations and equipment which are now classified, designated, or marked under the authority or at the direction of the President, the Secretary of Defense, the Secretary of the Army, the Secretary of the Navy, or the Secretary of the Air Force as "top secret", "secret", "confidential", or "restricted", and all military, naval, or air-force installations and equipment which may hereafter be so classified, designated, or marked with the approval or at the direction of the President, and located within:

(a) Any military, naval, or air-force reservation, post, arsenal, proving ground, range, mine field, camp, base, airfield, fort, yard, station, district, or area.

(b) Any defensive sea area heretofore established by Executive order and not subsequently discontinued by Executive order, and any defensive sea area hereafter established under authority of section 2152 of title 18 of the United States Code.

(c) Any airspace reservation heretofore or hereafter established under authority of section 4 of the Air Commerce Act of 1926 (44 Stat. 570; 49 U. S. C. 174) except the airspace reservation established by Executive Order No. 10092 of December 17, 1949.¹

(d) Any naval harbor closed to foreign vessels.

(e) Any area required for fleet purposes.

(f) Any commercial establishment engaged in the development or manufacture of classified military or naval arms, munitions, equipment, designs, ships, aircraft, or vessels for the United States Army, Navy, or Air Force.

2. All military, naval, or air-force aircraft, weapons, ammunition, vehicles, ships, vessels, instruments, engines, manufacturing machinery, tools, devices, or any other equipment whatsoever, in the possession of the Army, Navy, or Air Force or in the course of experimentation, development, manufacture, or delivery for the Army, Navy, or Air Force which are now classified, designated, or marked under the authority or at the direction of the President, the Secretary of Defense, the

Secretary of the Army, the Secretary of the Navy, or the Secretary of the Air Force as "top secret", "secret", "confidential", or "restricted", and all such articles, materials, or equipment which may hereafter be so classified, designated, or marked with the approval or at the direction of the President.

3. All official military, naval, or air-force books, pamphlets, documents, reports, maps, charts, plans, designs, models, drawings, photographs, contracts, or specifications which are now marked under the authority or at the direction of the President, the Secretary of Defense, the Secretary of the Army, the Secretary of the Navy, or the Secretary of the Air Force as "top secret", "secret", "confidential", or "restricted", and all such articles or equipment which may hereafter be so marked with the approval or at the direction of the President.

This order supersedes Executive Order No. 8381 of March 22, 1940,² entitled "Defining Certain Vital Military and Naval Installations and Equipment".

HARRY S. TRUMAN

THE WHITE HOUSE,
February 1, 1950.

EXECUTIVE ORDER 10105

CREATING AN EMERGENCY BOARD TO INVESTIGATE A DISPUTE BETWEEN THE DENVER AND RIO GRANDE WESTERN RAILROAD COMPANY AND CERTAIN OF ITS EMPLOYEES

WHEREAS a dispute exists between the Denver and Rio Grande Western Railroad Company, a carrier, and certain of its employees represented by the Brotherhood of Railroad Trainmen, a labor organization; and

WHEREAS this dispute has not heretofore been adjusted under the provisions of the Railway Labor Act, as amended; and

WHEREAS this dispute, in the judgment of the National Mediation Board, threatens substantially to interrupt interstate commerce to a degree such as to deprive a large section of the country of essential transportation service:

NOW, THEREFORE, by virtue of the authority vested in me by section 10 of the Railway Labor Act, as amended (45 U. S. C. 160), I hereby create a board of three members, to be appointed by me, to

¹ 3 CFR, 1949 Supp., p. 131.

² 3 CFR, 1943 Cum. Supp.

PART 4—FORMS FOR TRADEMARK CASES

CODIFICATION NOTE: Part 4 is placed in a separate grouping of parts pertaining to trademarks. It appears on page 157 of this volume.

PART 5—SECURITY OF CERTAIN INVENTIONS AND LICENSES TO FILE APPLICATIONS IN FOREIGN COUNTRIES**SECURITY ORDERS**

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 - 5.2 Secrecy order.
 - 5.3 Prosecution of application under secrecy order; withholding patent.
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- 5.17 Who may use license.
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GENERAL

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- 5.23 Correspondence.

AUTHORITY: 35 U.S.C. 6, 181-187, 188.

SOURCE: 24 FR 10381, Dec. 22, 1959, unless otherwise noted.

SECURITY ORDERS

- § 5.1 Defense inspection of certain applications.

In accordance with the provisions of 35 U.S.C. 181, patent applications con-

taining subject matter the disclosure of which might be detrimental to national security are made available for inspection by defense agencies specified in said section. Only applications obviously relating to national security, and applications within the scope indicated to the Patent and Trademark Office by the defense agencies so related, are made available. The inspection will be made only by responsible representatives authorized by the agency to review applications. Such representatives are required to sign a dated acknowledgment of acceptance of the condition that information obtained from the inspection will be used for no purpose other than the administration of 35 U.S.C. 181. Copies of applications may be made available to such representatives for inspection outside the Patent and Trademark Office under conditions assuring that the confidentiality of the applications will be maintained, including the conditions that: (a) All copies will be returned to the Patent and Trademark Office promptly if a secrecy order is imposed, or upon rescission of such order if one is imposed, and (b) no additional copies will be made by the defense agencies. A record of the removal and return of copies made available for defense inspection will be maintained by the Patent and Trademark Office. Applications relating to atomic energy are made available to the Atomic Energy Commission as specified in § 1.14 of this chapter.

[35 FR 16043, Oct. 13, 1970]

§ 5.2 Secrecy order.

(a) When notified by the chief officer of a defense agency that publication or disclosure of the invention by the granting of a patent would be detrimental to the national security, an order that the invention be kept secret will be issued by the Commissioner of Patents and Trademarks.

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

(c) A copy of the secrecy order will be forwarded to each principal of

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record in the application and accompanied by a receipt, identifying the particular principal, to be returned.

(d) The secrecy order is directed to the subject matter of the application. Where any other application disclosing a significant part of the subject matter of the application is under secrecy order, the other application and the common subject matter should be called to the attention of the Patent and Trademark Office. Such a notice may include any action such as would be urged in order to rescind secrecy orders on the applications.

§ 5.3 Prosecution of application under secrecy order; withholding patent.

Unless specifically ordered otherwise, action on the application by the Patent and Trademark Office and prosecution by the applicant will proceed during the term of the application is under secrecy order. At the point indicated in this section:

(a) Applications under secrecy order which come to a final rejection may be appealed or otherwise prosecuted to avoid abandonment. Appeals must be completed by the applicant but unless otherwise ordered by the Commission, the hearing will be set for hearing until the secrecy order is removed.

(b) An interference will be declared involving applications under secrecy order. However, if an application is under secrecy order, copies of an issued patent, a notice of allowance, or a notice of opposition will be placed in the file of the patent.

(c) When the application is in condition for allowance, the applicant and the agency which issued the secrecy order to be issued. This notice (which is of allowance under § 1.311 of this chapter) does not require the applicant and place the application in a condition of allowance. The secrecy order is rescinded. The Patent and Trademark Office will issue a notice of allowance under § 1.311 of this chapter.

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the secrecy order will
to each principal of

record in the application and will be
accompanied by a receipt, identifying
the particular principal, to be signed
and returned.

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

§ 5.3 Prosecution of application under se-
crecy order; withholding patent.

Unless specifically ordered other-
wise, action on the application by the
Office and prosecution by the appli-
cant will proceed during the time an
application is under secrecy order to
the point indicated in this section:

(a) Applications under secrecy order
which come to a final rejection must
be appealed or otherwise prosecuted to
avoid abandonment. Appeals in such
cases must be completed by the appli-
cant but unless otherwise specifically
ordered by the Commissioner will not
be set for hearing until the secrecy
order is removed.

(b) An interference will not be de-
clared involving applications under se-
crecy order. However, if an application
under secrecy order copies claims from
an issued patent, a notice of that fact
will be placed in the file wrapper of
the patent.

(c) When the application is found to
be in condition for allowance except
for the secrecy order the applicant
and the agency which caused the se-
crecy order to be issued will be noti-
fied. This notice (which is not a notice
of allowance under § 1.311 of this
chapter) does not require response by
the applicant and places the applica-
tion 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 warrant-
ed.

[24 FR 10381, Dec. 22, 1959, as amended at
38 FR 10006, Apr. 23, 1973]

§ 5.4 Petition for rescission of secrecy
order.

(a) A petition for rescission or re-
moval of a secrecy order may be filed
by, or on behalf of, any principal af-
fected thereby. Such petition may be
in letter form, and it must be in dupli-
cate. The petition must be accompa-
nied by one copy of the application or
an order for the same, unless a show-
ing is made that such a copy has al-
ready been furnished to the depart-
ment or agency which caused the se-
crecy order to be issued.

(b) The petition must recite any and
all facts that purport to render the
order ineffectual or futile if this is the
basis of the petition. When prior pub-
lications or patents are alleged the pe-
tition 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 devel-
oped, or to which the subject matter is
otherwise related. If there is no such
contract, the petition must so state.

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

§ 5.5 Permit to disclose or modification of
secrecy order.

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

(b) Petitions for a permit or modifi-
cation 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 informa-
tion, adequate explanation of such
clearance should be made in the peti-
tion including the name of the agency

or department granting the clearance and the date and degree thereof. The petition must be filed in duplicate and be accompanied by one copy of the application or an order for the same, unless a showing is made that such a copy has already been furnished to the department or agency which caused the secrecy order to be issued.

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

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

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

§ 5.6 General and group permits.

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

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

§ 5.7 Compensation.

Any request for compensation as provided in 35 U.S.C. 183 must not be

made to the Patent and Trademark Office but should be made directly to the department or agency which caused the secrecy order to be issued. Upon written request persons having a right to such information will be informed as to the department or agency which caused the secrecy order to be issued.

§ 5.8 Appeal to Secretary.

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

LICENSES FOR FOREIGN FILING

§ 5.11 License for filing application in foreign country.

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

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

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

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

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

(2) The foreign application was filed, or its filing caused, after the expiration from the filing of the application in the United States.

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

§ 5.12 Petition for license.

Petitions for license under 35 U.S.C. 184 may be presented and should include a statement of address, and full instructions of the requested license to be delivered to the applicant.

§ 5.13 Petition for license in foreign country.

Where there is a secrecy order in effect, a United States application for license must be filed, and a legible copy of the application which license is desired must be retained as the basis for the license granted. For identification of the application in each license so issued, the petition or application must be submitted in duplicate, with a title and other descriptive material. The duplicate will be returned to the applicant or other action on the application.

§ 5.14 Petition for license in foreign country.

(a) Where there is a secrecy order in effect, a United States application for license must be filed, and a legible copy of the application which license is desired must be retained as the basis for the license granted. For identification of the application in each license so issued, the petition or application must be submitted in duplicate, with a title and other descriptive material. The duplicate will be returned to the applicant or other action on the application.

(b) Two or more applications for license should not be filed in the same petition if they are to be combined.

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Chapter I—Patent and Trademark Office

§ 5.16

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

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

§ 5.12 Petition for license.

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

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

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

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

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

(b) Two or more United States applications should not be referred to in the same petition for license unless they are to be combined in the foreign

application, in which event the petition should so state and the identification of each United States application should be in separate paragraphs.

(c) Where the application to be filed abroad contains matter not disclosed in the United States application or applications, including the case where the combining of two or more United States applications introduces subject matter not disclosed in any of them, a copy of the application as it is to be filed in the foreign country must be furnished with the petition. If, however, all new matter in the application to be filed is readily identifiable, the new matter may be submitted in detail and the remainder by reference to the pertinent United States application or applications.

§ 5.15 Scope of license.

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

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

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

§ 5.16 Effect of secrecy order.

Any license obtained under 35 U.S.C. 184 is ineffective if the subject matter is under a secrecy order, and a secrecy

§ 5.17

Title 37—Patents, Trademarks, and Copyrights

order prohibits the exercise of or any further action under the license unless separately specifically authorized by a modification of the secrecy order in accordance with § 5.5.

§ 5.17 Who may use license.

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

§ 5.18 Arms, ammunition, and implements of war.

(a) The exportation of technical data relating to arms, ammunition, and implements of war generally is subject to the International Traffic in Arms Regulations of the Department of State (22 CFR Parts 121-128); the articles designated as arms, ammunition, and implements of war are enumerated in the U.S. Munitions List, 22 CFR 121.01. However, if a patent applicant complies with regulations issued by the Commissioner of Patents and Trademarks under 35 U.S.C. 184, no separate approval from the Department of State is required unless the applicant seeks to export technical data exceeding that used to support a patent application in a foreign country. This exemption from Department of State regulations is applicable regardless of whether a license from the Commissioner is required by the provisions of §§ 5.11 and 5.15 (22 CFR 125.04(b), 125.20(b)).

(b) When a patent application containing subject matter on the Munitions List (22 CFR 121.01) 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 125.05(d)).

[35 FR 6430, Apr. 22, 1970]

§ 5.19 Export of technical data.

(a) Under regulations established by the U.S. Department of Commerce, a validated export license from the Bureau of International Commerce may be required for the foreign filing of a patent application, under certain conditions. The pertinent regulations

are set forth in 15 CFR Parts 370-372 and 379.

(b) A validated export license is required for the foreign filing of patent applications:

(1) Containing certain technical data, unless such foreign filing is in accordance with the regulations of the U.S. Patent and Trademark Office (15 CFR 379.4(c), (d)); or

(2) In certain designated countries or areas, if the application contains any restricted technical data not exportable under provisions of 15 CFR 379.3.

(c) A validated export license is not required for the foreign filing of a patent application in any case where:

(1) The data contained in the patent application is generally available to the public in any form (15 CFR 379.3(a)); or

(2) The foreign filing is in accordance with the regulations of the U.S. Patent and Trademark Office and (i) the patent application has been previously filed abroad in one of the "early publication countries," or (ii) the data contained in the application is the same as that in an application for which the U.S. Patent and Trademark Office has issued a notice that the patent has been scheduled for printing and publication (15 CFR 379.3(c)(2)).

(d) A validated export license is not required for data contained in a patent

*Albania, Bulgaria, China (Mainland) (including Inner Mongolia, the provinces of Tsinghai and Sikang, Sinkiang, Tibet, and Manchuria (includes the former Kwantung Leased Territory, the present Port Arthur Naval Base Area, and Liaoning Province), but excluding Republic of China (Taiwan) (Formosa) and Outer Mongolia), Communist-controlled area of Vietnam, Cuba, Czechoslovakia, East Germany (Soviet Zone of Germany and the Soviet Sector of Berlin), Estonia, Hungary, Latvia, Lithuania, North Korea, Outer Mongolia, Poland (including Danzig), Rumania, Southern Rhodesia, and Union of Soviet Socialist Republics (15 CFR Part 370, Supplement No. 1).

*15 CFR 379.4 (a), (b).

*Belgium, Costa Rica, Denmark, Ecuador, Finland, France, Honduras, Iceland, Jamaica, Luxembourg, Netherlands, Nicaragua, Norway, Panama, Portugal, Sweden, Trinidad, Turkey, Republic of South Africa, Uruguay, Venezuela, and West Germany (Federal Republic of Germany) (15 CFR 379.3(c)(2)).

Chapter I—Pa

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[35 FR 6430, Apr

§ 5.21 Effect of license.

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PART 6—C
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PART 7—REGIS
INTERES

Sec.
7.1 Requirements
7.2 Assignments.
7.3 Licenses.

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gnated countries or cation contains any data not export-ns of 15 CFR 379.3. Export license is not foreign filing of a n any case where: tained in the patent erally available to y form (15 CFR

filing is in accor-ulations of the U.S. mark Office and (i) on has been previ- in one of the "early ries," or (ii) the the application is n an application for ent and Trademark a notice that the eduled for printing CFR 379.3(c)(2)). Export license is not ontained in a patent

China (Mainland) (In-olla, the provinces of Sinkiang, Tibet, and the former Kwantung e present Port Arthur d Liaoning Province), lic of China (Taiwan) r Mongolia), Commu- of Vietnam, Cuba, Germany (Soviet Zone he Soviet Sector of ngary, Latvia, Lithua-ter Mongolia, Poland Rumania, Southern of Soviet Socialist Re- 370, Supplement No.

ca, Denmark, Ecuador, duras, Iceland, Jamal-therlands, Nicaragua, rtugal, Sweden, Trini- e of South Africa, Uru- West Germany (Fed- Germany) (15 CFR

application prepared wholly from for-ign 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 Trade-mark Office (15 CFR 379.3(c)(1)).

(e) Inquiries concerning the export control regulations for the foreign filing of patent applications should be made to the Office of Export Control, Bureau of International Commerce, Department of Commerce, Washing-ton, D.C. 20230.

[35 FR 6430, Apr. 22, 1970]

GENERAL

§ 5.21 Effect of modification, rescission or license.

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

§ 5.22 Papers in English language.

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

§ 5.23 Correspondence.

All correspondence in connection with this part, including petitions, should be addressed to "Commissioner of Patents and Trademarks (Attention Patent Security Division), Washing-ton, D.C., 20231."

PART 6—CLASSIFICATION OF GOODS AND SERVICES UNDER THE TRADEMARK ACT

CODIFICATION NOTE: Part 6 is placed in a separate grouping of parts pertaining to trademarks. It appears on page 167 of this volume.

PART 7—REGISTER OF GOVERNMENT INTERESTS IN PATENTS

Sec.

- 7.1 Requirements.
7.2 Assignments.
7.3 Licenses.

Sec.

- 7.4 Abbreviated copy.
7.5 Instruments already on record.
7.6 Access to register.
7.7 Secret register.

AUTHORITY: E.O. 9424, Feb. 18, 1944, 9 FR 1959; 3 CFR 1943-1948 Comp.

SOURCE: 24 FR 10383, Dec. 22, 1959, unless otherwise noted.

§ 7.1 Requirements.

Executive Order 9424 (3 CFR 1943-1948 Comp.) requires the several de-partments and other executive agen-cies of the Government, including Government-owned or Government-controlled corporations, to forward promptly to the Commissioner of Pat-ents and Trademarks for recording all licenses, assignments, or other inter-ests of the Government in or under patents or applications for patents.

§ 7.2 Assignments.

The original of an assignment or other instrument which conveys to the Government only the title to a patent or to an application for patent shall be forwarded to the Commissioner of Patents and Trademarks. The instru-ment will be recorded, endorsed, and returned.

§ 7.3 Licenses.

A copy of any license or instrument other than an assignment which con-veys to or gives the Government any interest in or under a patent or an ap-plication for patent shall be forwarded for recording. The copy will be re-tained by the Patent and Trademark Office but, when desired, the original will be endorsed and returned.

§ 7.4 Abbreviated copy.

If an instrument deals with matters in addition to rights and interests in patents or in applications for patents, or in inventions disclosed therein, a copy of only those portions of the in-strument dealing with such rights and interests need be forwarded. In such case, a statement giving the general nature of the entire instrument, the parties involved, the date of the in-strument, the place where it is usually filed, and any docket or identifying number, must be attached to the copy.

CHAPTER 17.—SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

- Sec. 181. Secrecy of certain inventions and withholding of patent.
- 182. Abandonment of invention for unauthorized disclosure.
- 183. Right of compensation.
- 184. Filing of application in foreign country.
- 185. Patent barred for filing without license.
- 186. Penalty.
- 187. Nonapplicability to certain persons.
- 188. Rules and regulations, delegation of power.

§ 181. Secrecy of certain inventions and withholding of patent

Whenever publication or disclosure 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 upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

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

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Commissioner and the Commissioner shall order that the invention be kept secret and shall withhold the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Commissioner shall thereupon maintain the application in a sealed condition and notify the

applicant there placed under a order to the S

An invention patent withheld sioner shall re renewal period by the head of caused the ord been made the order in effect, war, shall rem year following during a nation in effect for th thereafter. Th tion by the he agencies who disclosure of national secur

Reviser's Note. S.C., 1946 ed., § 15 1, 60 Stat. 8, 4).

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§ 182. A

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17 **SECRETRY OF INVENTIONS** 35 § 182

applicant thereof. The owner of an application which has been made under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the grant of a patent withheld for a period of more than one year. The Commissioner shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Commissioner may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security. July 19, 1952, c. 950, § 1, 66 Stat. 805.

Historical and Revision Notes

Reviser's Note. Based on Title 35, U.S.C., 1946 ed., § 151 (Feb. 1, 1952, c. 4, § 1 (Stat. 3, 4). Language is changed.

Prior Law. For prior law on the subject of this section, see former section 151 of this title, set out in Appendix II at the end of this title.

Defense Agencies. The Department of Justice was designated as a defense agency of the United States for the purposes of this chapter by Executive Order No. 10457, May 28, 1953, 18 F.R. 3083.

Rules of Practice in the Patent Office

rules relating to secrecy of certain inventions and licenses to file applications in foreign countries, see rules §§ 5.1-5.23, set out under section 188 of this title.

Notes of Decisions

Government's rights and liabilities. Absence of showing that Commissioner of Patents ordered that plaintiff's invention should be kept secret and withheld grant of patent to plaintiff for reason that publication or disclosure of plaintiff's invention by grant of patent would be detrimental to national security, United States would not be liable for alleged use of plaintiff's invention prior to issuance of patent. *Gearon v. U. S.*, Ct.Cl.1953, 115 F.Supp. 910.

§ 182. Abandonment of invention for unauthorized disclosure

The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner 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, or legal representa-

35 § 182: PATENTABILITY—GRANT OF PATENTS

tives, or anyone in privity with him or them, without the consent of the Commissioner. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner shall not be given without the concurrence of the heads of the department 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 any one in privity with him or them, of all claims against the United States based upon such invention. July 19, 1952, c. 950, § 1, 66 Stat. 806.

Historical and Revision Notes

Reviser's Note. Based on Title 35, U.S.C., Prior Law. For prior law (on the C., 1946 ed., § 152 (Feb. 1, 1952, c. 4, § 2, subject of this section, see former § 152 of this title, set out in Appendix 66 Stat. 4). Made obsolete by the act of Feb. 1, 1952, at the end of this title. Language is changed.

§ 183. Right to compensation

An applicant, his successors, assigns, or legal representative whose patent is withheld as herein provided, shall have the right beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance on February 1, 1952, whichever is later, and ending six years after patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of a claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. The settlement agreement shall be conclusive for all purposes notwithstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers as compensation for the damage and/or use. A claimant may bring suit against the United States in the Court of Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon application that was subject to a secrecy order issued pursuant to section 181 of this title, who did not apply for compensation as provided, shall have the right, after the date of issuance of the patent, to bring suit in the Court of Claims for just compensation for the damage caused by reason of the order of secrecy.

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PATENTS Ch. 17

without the consent of the Commissioner shall be in the order to be issued for forfeiture by the representatives, or any person, against the United States, c. 950, § 1, 66 Stat.

or prior law on the subject, see former section 153 of this title, set out in Appendix II of this title.

representatives, shall have the right, except for such allowance, or six years after a patent is granted, to receive compensation for the use of the invention. The right to enter into an agreement, or legal representative, or assign, or to sue for infringement, shall not be affected by the fact that the Commissioner has issued an order for forfeiture of the patent. If full settlement is made, the Commissioner may bring suit in the District Court for the district in which the claimant is domiciled, or in which the award shall be made, to enforce the invention. The Commissioner may issue an order for forfeiture of the patent as above provided, and the issuance of such order shall not constitute a bar to the award of compensation for secrecy and/or

35 § 184

disclosed by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section the United States may avail itself of all defenses it may plead in an action under section 1498 of title 28. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based. July 19, 1952, c. 950, § 1, 66 Stat. 806.

Historical and Revision Notes

Reviser's Note. Based on Title 35, U.S.C., 1946 ed., § 153 (Feb. 1, 1952, c. 4, § 1, 66 Stat. 4, 5).
Prior Law. For prior law on the subject of this section, see former section 153 of this title, set out in Appendix II at the end of this title.

Language is changed.

§ 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. July 19, 1952, c. 950, § 1, 66 Stat. 807.

Historical and Revision Notes

Reviser's Note. Based on Title 35, U.S.C., 1946 ed., § 154 (Feb. 1, 1952, c. 4, § 1, 66 Stat. 5).
Prior Law. For prior law on the subject of this section, see former section 154 of this title, set out in Appendix II at the end of this title.

Language is changed.

Rules of Practice in the Patent Office

Rules relating to licenses for foreign filing, see rules §§ 5.11-5.17, set out under section 188 of this title.

35 § 185. PATENTABILITY—GRANT OF PATENTS Ch. 17

§ 185. Patent barred for filing without license

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid. July 19, 1952, c. 950, § 1, 66 Stat. 807.

Historical and Revision Notes

Reviser's Note. Based on Title 35, U.S.C., 1946 ed., § 155 (Feb. 1, 1952, c. 4, § 5, 66 Stat. 5). **Prior Law.** For prior law on the subject of this section, see former section 155 of this title, set out in Appendix II at the end of this title.

Language is changed.

§ 186. Penalty

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States shall, upon conviction, be fined not more than \$10,000 or imprisoned for not more than two years, or both. July 19, 1952, c. 950, § 1, 66 Stat. 807.

Historical and Revision Notes

Reviser's Note. Based on Title 35, U.S.C., 1946 ed., § 156 (Feb. 1, 1952, c. 4, § 6, 66 Stat. 5, 6). **Prior Law.** For prior law on the subject of this section, see former section 156 of this title, set out in Appendix II at the end of this title.

Language is changed.

Ch. 17

§ 187.

The prohibitions of this section shall apply to any officer or employee of the Government or any contractor or subcontractor of the Government or any person acting in the interest of the Government or any person who has received information from the Government or any contractor or subcontractor of the Government or any person acting in the interest of the Government.

Reviser's Note. Based on Title 35, U.S.C., 1946 ed., § 157 (Feb. 1, 1952, c. 4, § 7, 66 Stat. 6). Language is changed.

§ 188.

The Atomic Energy Commission, the National Aeronautics and Space Administration, the Government Printing Office, the United States Patent and Trademark Office, and the United States Customs Service shall be authorized to carry out the provisions of this title in order to carry out the provisions of this title.

Reviser's Note. Based on Title 35, U.S.C., 1946 ed., § 158 (Feb. 1, 1952, c. 4, § 8, 66 Stat. 6). Language is changed.

Language is changed.

Prior Law. For prior law on the subject of this section, see former section 158 of this title.

§ 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. July 19, 1952, c. 950, § 1, 66 Stat. 808.

Historical and Revision Notes

Reviser's Note. Based on Title 35, U.S.C. 1946 ed., § 157 (Feb. 1, 1952, c. 4, § 7, 66 Stat. 808). Prior Law. For prior law on the subject of this section, see former section 157 of this title, set out in Appendix II at the end of this title.

§ 188. Rules and regulations, delegation of power

The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other 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. July 19, 1952, c. 950, § 1, 66 Stat. 808.

Historical and Revision Notes

Reviser's Note. Based on Title 35, U.S.C. 1946 ed., § 158 (Feb. 1, 1952, c. 4, § 8, 66 Stat. 808). 158 of this title, set out in Appendix II at the end of this title. Defense Agencies. The Department of Justice was designated as a defense agency of the United States for the purposes of this chapter by Executive Order No. 10457, May 28, 1953, 18 F.R. 3083.

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