

# Chapter 100 Secrecy and Access

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## 101 General

*Extract from Rule 14 Application preserved in secrecy.* (a) Pending applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without 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.

[Old Rule 15]

Examiners, while holding interviews with attorneys and applicants, should be careful to prevent exposures of files and drawings of other applicants. (Notice of June 12, 1918, Revised.)

## 102 Information as to Status of an Application

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

(A) a prior application of which a patented application was a continuation or division.

(B) an application referred to in a patent.

Such information can be had on written request to the Commissioner of Patents.

## 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.

[Old Rule 16]

As a continuation, continuation-in-part or a division patent relies on the filing date of an earlier filed application, the public is entitled to see that portion of the earlier filed application relied upon even though the earlier filed application is still pending. Also the public is entitled to see what prosecution, if any, of the subject matter of the patent claim of a continuation, continuation-in-part, or division patent was had in the parent case. In such situations where the parent application is still pending, the usual procedure is for the interested party to file a petition in duplicate to the Commissioner for access to the parent application. The duplicate copy is sent by the law examiner to the owner of the parent application, who is given a limited period, as ten days, within which to state any objection he may have to the granting of the petition. If no objection is raised, the petition is approved by the law examiner; otherwise a decision is rendered by the Commissioner. If the applicant does not object the petitioner is permitted to see the entire parent application. If the applicant does object to the petitioner seeing the entire application the petitioner is given a certified copy of only that portion of the parent application that relates to the common subject matter.

*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.

## 104 Power to Inspect Application

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

also become a part of the record of the case. (Order No. 1271)

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

Power to inspect or to make copies presented at the Attorneys' and Record Room or to the Manuscript and Lithographic Branch must be approved in writing by the head of the Attorneys' and Record Room or the Manuscript and Lithographic Branch, both of whom are hereby authorized to permit inspection or supply copies to authorized persons. (Extract from Commissioner's Administrative Order No. 10, Dec. 16, 1946)

If the application is under a "Secrecy Order" (see 107), a power to inspect said application must be approved by Div. 70 before it may be recognized. (Extract from Notice of Aug. 22, 1949.)

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 a disbarred attorney regarding an application unless it be one in which said attorney is the applicant. Power to inspect given a disbarred attorney will not be accepted by the Examiner.

### 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 knowledge of the steps being taken in such prosecution.

### 107 "Secrecy Order" Case

The Act of October 6, 1917, as amended, 35 U. S. C. 42, provides that whenever the publication or disclosure of any invention or discovery by the granting of a patent might, in the opinion of the Commissioner of Patents, be detrimental to the public safety or defense he may order that the invention be kept secret and withhold the grant of a patent for such a period or periods as in his opinion the national interest requires. A "Secrecy Order" case is one which is adjudged to be for an invention whose publication might be detrimental to the public safety or defense.

If the Examiner finds any application that appears at all worthy of consideration for a "Secrecy Order" he should submit the same to Division 70. Applications that pertain to atomic energy (706.03 (b)) are one of the types of cases that should be submitted to Division 70. (Extract from Memorandum of February 1, 1949.)

"Secrecy Order" Cases are examined as in other cases, but may not be passed for issue; nor does an interference involving one or more secret cases proceed beyond the approval of the preliminary statements.

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

In case of an Interference involving a "Secrecy Order" case see 1111.04.

Orders for copies of "Secrecy Order" applications should be approved and endorsed in Division 70 before copies are supplied. (Extract from Notice of Aug. 22, 1949.)

### 107.01 D-10 Notice

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 treated as are amendments filed after final rejection in an ordinary case; i. e., they may be entered if found free from objection; otherwise they are

est should be determined before allowance is reached and such applications are reviewed in the usual way.

To assure that early consideration is given to defense inventions, and to avoid unnecessary conflict between review and examination functions, applications should be forwarded for review when originally filed or as soon thereafter as their content is determined. To wait until the application is allowable, defeats the desired security schedule and causes trouble in clearing date cases due to delays in processing.

Where a "division date" case is held up by review processing in Div. 70, and the next normal action would be allowance, a memorandum should be prepared stating the situation and when the application was submitted for review. Such a memorandum should be delivered to Div. 70 in duplicate, one copy to serve as a request to expedite the processing, and the second copy to be forwarded to the Supervisory Examiner after having been marked by Div. 70 to show the progress that has been made. This second copy will serve to explain the weekly report standing of the affected division. Any further action to be taken in the case for the purpose of advancing the division date must be arranged through the Supervisory Examiner. Such a case may be obtained from Div. 70 for the purpose of examination. The examiner in charge of the division requesting an application must sign a receipt for the application when it is taken from Div. 70, and his responsibility for its security and safekeeping will continue until returned to Div. 70. It must be returned to Div. 70 by 4:30 each day. If the next step in the examining operation on an application in this category requires leaving the application with other divisions or branches of the Office, the application should be returned to Div. 70 with a note indicating the routing desired so that responsibility for the application may be properly shown on the records of Div. 70. (Extracts from Notices of March 15, 1950, and Oct. 9, 1950.)

"Secrecy Order" Cases are examined as in other cases, but may not be passed for issue; nor does an interference involving one or more secret cases proceed beyond the approval of the preliminary statements.

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

In the case of an Interference involving a "Secrecy Order" case, see 1111.04.

Orders for copies of "Secrecy Order" applications should be approved and endorsed in Div. 70 before copies are supplied. (Extract from Notice of Aug. 22, 1949.)

### 107.01 D-10 Notice

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 treated as are amendments filed after final rejection in an ordinary case; i. e., they may be entered if found free from objection; otherwise they are denied admission. The applicant will not ordinarily be advised of their non-entry, and the reasons therefor until the application is released from the "Secrecy Order."

### 108 "Special Handling" Cases

By agreement between the Commissioner of Patents and certain Government Agencies, specified applications of interest to national security are designated as "Special Handling" when filed in the Patent Office. While such applications are not ordinarily immediately placed under a "Secrecy Order," it is generally accepted that they are of a super-secret nature. The Patent Office has agreed to treat such applications with special safeguards and to conduct their examination in a way to make their contents known to the minimum number of persons necessary for their proper treatment. Where the Agency involved has the inventor, attorney and assignee (if any) under contract or other control, security may best be served by not preparing and mailing the formal papers normally required under the provisions of 35 U. S. C. 42.

### 109 Government Owned "3-Year" Response Cases and Suspended Action Cases

Government owned "Three Year" (R. S. 4894; 35 U. S. C. 37) applications (see 710.03) and government owned suspended action cases (see 709) may be obtained from Division 70 for the purpose of examination. The examiner in charge of the division requesting an application must sign a receipt for the application when it is taken from Division 70, and his responsibility for its security and safekeeping will continue until eventually returned to Division 70.

These applications may be retained in the examining division for limited periods provided adequate lock means are available for their protection during non-working hours. Where the examining operation requires the submission of an application in this category to other divisions or branches of the Office, the application must be hand-carried to the desired destination and a signed receipt obtained from a responsible party. (Extract from Notice of March 15, 1950.)

All applications under this section must be referred to Division 70 for clearance before allowance.