

*Patent Laws and Regulations**[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]***PROSECUTION BY ASSIGNEE****37 CFR 3.71 Prosecution by assignee.**

The assignee of record of the entire right, title and interest in an application for patent is entitled to conduct the prosecution of the patent application to the exclusion of the named inventor or previous assignee. The assignee of a registered trademark or a trademark for which an application to register has been filed is entitled to conduct the prosecution of the trademark application or registration to the exclusion of the original applicant or previous assignee.

*[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]***37 CFR 3.73 Establishing right of assignee to prosecute.**

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application unless there is an assignment.

(b) When the assignee of the entire right, title, and interest seeks to take action in a matter before the Office with respect to a patent application, trademark application, patent registration, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. Ownership is established by submitting to the Office documentary evidence of a chain of title from the original owner to the assignee or by specifying (e.g. reel and frame number, etc.) where such evidence is recorded in the Office. Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office. In addition, the assignee of a patent application or patent must submit a statement specifying that the evidentiary documents have been reviewed and certifying that, to the best of assignee's knowledge and belief, title is in the assignee seeking to take the action.

*[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]***ISSUANCE TO ASSIGNEE****37 CFR 3.81 Issue of patent to assignee.**

(a) For a patent application, if an assignment of the entire right, title, and interest is recorded before the issue fee is paid, the patent may issue in the name of the assignee. If the assignee holds an undivided part interest, the patent may issue jointly to the inventor and the assignee. At the time the issue fee is paid, the name of the assignee must be provided if the patent is to issue solely or jointly to that assignee.

(b) If the assignment is submitted for recording after the date of payment of the issue fee, but prior to issuance of the patent, the assignee may petition that the patent issue to the assignee. Any such petition must be accompanied by the fee set forth in § 1.17(i) of this Chapter.

*[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]***37 CFR 3.85 Issue of registration to assignee.**

The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the application file.

*[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]*

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**PART 5 — SECRECY OF CERTAIN INVENTIONS AND  
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**SECRECY ORDERS**

**37 CFR 5.1      Defense inspection of certain applications.**

(a) The provisions of this part shall apply to both national and international applications filed in the Patent and Trademark Office and, with respect to inventions made in the United States, to applications filed in any foreign country or any international authority other than the United States Receiving Office. The (1) filing of a national or an international application in a foreign country or with an international authority other than the United States Receiving Office, or (2) transmittal of an international application to a foreign agency or an international authority other than the United States Receiving Office is considered to be a foreign filing within the meaning of Chapter 17 of title 35, United States Code.

(b) In accordance with the provisions of 35 U.S.C. 181, patent applications containing subject matter the disclosure of which might be detrimental to the national security are made available for inspection by defense agencies as specified in said section. Only applications obviously relating to national security, and applications within fields indicated to the Patent and Trademark Office by the

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defense agencies as 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 access accepting the condition that information obtained from the inspection will be used for no purpose other than the administration of 35 U.S.C. 181-188. 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:

- (1) All copies will be returned to the Patent and Trademark Office promptly if no secrecy order is imposed, or upon rescission of such order if one is imposed, and
- (2) 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 Department of Energy as specified in § 1.14 of this chapter.

[43 FR 20470, May 11, 1978]

**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 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 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 subject matter of the application 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 material such as would be urged in a petition to rescind secrecy orders on either of the applications.

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

(b) An interference will not be declared involving national applications under secrecy order. However, if an applicant whose application is under secrecy order seeks to provoke an interference with an issued patent, a notice of that fact will be placed in the file wrapper of the patent. (See § 1.607(d)).

(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 response 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 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

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search copies would be transmitted to the international authorities or the applicant.

[43 FR 20470, May 11, 1978; amended 43 FR 28479, June 30, 1978; para. (b) amended 53 FR 23736, June 23, 1988, effective Sept. 12, 1988]

**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. The petition must 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.

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

**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 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 the subject matter is 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.

**37 CFR 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.

**37 CFR 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

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as to the department or agency which caused the secrecy order to be issued.

**37 CFR 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 EXPORTING AND FILING**

**37 CFR 5.11            License for filing in a foreign country an application on an invention made in the United States or for transmitting international application.**

(a) A license from the Commissioner of Patents and Trademarks 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 patent office or any foreign patent agency or any international agency other than the United States Receiving Office, 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 of Patents and Trademarks referred to in paragraph (a) would also authorize the export of technical data abroad for purposes relating to the preparation, filing or possible filing and prosecution of a foreign patent application without separately complying with the regulations contained in 22 CFR Parts 121 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR Part 379 (Regulations of the Office of Export Administration, International Trade Administration, Department of Commerce) and 10 CFR Part 810 (Foreign Atomic Energy Programs of the Department of Energy).

(c) Where technical data in the form of a patent application, or in any form, is being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign patent application, without the license from the Commissioner of Patents and Trademarks 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 121 through 130 ((International Traffic in Arms Regulations of the Department of State), 15 CFR Part 379 (Regulations of the Office of Export Administration, International Trade Administration, Department of Commerce) and 10 CFR Part 810 (Foreign Atomic Energy Programs 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 Parts 121 through 130, 15 CFR Part 379 and 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 patent application if:
  - (i) a license is not, or was not, required under paragraph (e)(2) of this section

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for the foreign patent application;

- (ii) the corresponding United States application was not required to be made available for inspection under 35 U.S.C. 181 and § 5.1; 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 and § 5.1.

(f) A license pursuant to paragraph (a) of this section can be revoked at any time upon written notification by the Patent and Trademark Office. An authorization to file a foreign patent 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.

[49 FR 13461, Apr. 4, 1984; paras. (a) and (e), 56 FR 1924, Jan. 18, 1991, effective Feb. 19, 1991]

**37 CFR 5.12      Petition for license.**

(a) Filing of an application for patent for inventions 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 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) Petitions for license should be presented in letter form and must include the required fee (§ 1.17(h)). If expedited handling of the petition is also sought, the petitioner's address and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner.

[48 FR 2714, Jan. 20, 1983; amended 49 FR 13462, Apr. 4, 1984]

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

If no corresponding national or international application has been filed in the United States, the petition for license under § 5.12(b) must be accompanied by the required fee (§ 1.17(h)), if expedited handling of the petition is sought, and a legible copy of the material upon which license is desired. This copy will be retained as a 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 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.

[43 FR 20471, May 11, 1978; 49 FR 13462, Apr. 4, 1984]

**37 CFR 5.14      Petition for license; corresponding U.S. application.**

(a) Where there is a corresponding United States application on file, a petition for license under § 5.12(b) must include the required fee (§ 1.17(h)), if expedited handling of the petition is also sought, and 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 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 in the foreign country or international application which is to be transmitted to a foreign international or national agency for filing in the Receiving Office, must be furnished with the petition. If, however, all new matter in the foreign or international application to be filed is readily identifiable, the new matter may be submitted in detail and the remainder by

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reference to the pertinent United States application or applications.

[43 FR 20471, May 11, 1978; 49 FR 13462, Apr. 4, 1984]

**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 and § 5.1, will be eligible for a license of the scope provided in this paragraph. This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign patent 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 and § 5.1. This license also covers the inventions disclosed in foreign applications which had been granted a license under this part prior to April 4, 1984, and which were not subject to security inspection under 35 U.S.C. 181 and § 5.1. Grant of this license authorizes the export and filing of an application in a foreign country or the transmitting of an international application to any foreign patent agency or international patent agency when the subject matter of the foreign or international application corresponds to that of the domestic application. This license includes authority:

- (1) To export and file all duplicate and formal application papers in foreign countries or with international agencies;
- (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 or international application provided that the adding of subject matter or taking of any action under paragraphs (a)(1) and (2) of this section which does not change the general nature of the invention disclosed in the application in a manner which would require such application to have been made available for inspection under 35 U.S.C. 181 and § 5.1 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 121 through 130; or
  - (ii) Restricted Data, sensitive nuclear technology or technology useful in the production or utilization of special nuclear material or atomic energy, the 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 Unclassified Activities in Foreign Atomic Energy Programs, 10 CFR Part 810, in effect at the time of foreign filing.

(b) Applications or other materials which were required to be made available for inspection under 35 U.S.C. 181 and 5.1 will be eligible for a license of the scope provided in this paragraph. Grant of this license authorizes the export and filing of an application in a foreign country or the transmitting of an international application to any foreign patent agency or international patent agency. Further, this license includes authority to export and file all duplicate and formal papers in foreign countries or with foreign and international patent agencies and to make amendments, modifications, and supplements to, file divisions of, and take any action in the prosecution of the foreign or international 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(h)), 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

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U.S.C. 181 and § 5.1. 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 the foreign application or transmit the international application, no license is required to file papers in connection with the prosecution of the foreign or international application not involving the disclosure of additional subject matter.

(e) Any paper filed abroad or transmitted to an international patent agency following the filing of a foreign or international application which changes the general nature of the subject matter disclosed at the time of filing in a manner which would require such application to have been made available for inspection under 35 U.S.C. 181 and § 5.1 or which involves the disclosure of subject matter listed in paragraphs (a)(3)(i) or (ii) of this section must be separately licensed in the same manner as a foreign or international application. Further, if no license has been granted under § 5.12(a) on filing the corresponding United States application, any paper filed abroad or with an international patent agency which involves the disclosure of additional subject matter must be licensed in the same manner as a foreign or international 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.

*[49 FR 13462, Apr. 4, 1984; paras. (a) - (c), (e) and (f), 56 FR 1924, Jan. 18, 1991, effective Feb. 19, 1991]*

### **37 CFR 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 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.

### **37 CFR 5.17 Who may use license.**

Licenses may be used by anyone interested in the export, foreign filing, or international transmittal for or on behalf of the inventor or the inventor's assigns.

*[49 FR 13463, Apr. 4, 1984]*

### **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 121 through 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]*



*Patent Laws and Regulations***37 CFR 5.19      Export of technical data.**

(a) Under regulations (15 CFR 770.10(j)) established by the U.S. Department of Commerce, Bureau of Export Administration, Office of Export Licensing, a validated export 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 (37 CFR 5.11 through 5.33) of the Patent and Trademark Office.

(b) A validated 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 379.3(c)).

(c) Inquiries concerning the export control regulations for the foreign filing of technical data other than patent applications should be made to the Office of Export Administration, International Trade Administration, Department of Commerce, Washington, D.C. 20230.

*[45 FR 72654, Nov. 3, 1980; para. (a) revised, 58 FR 54504, Oct. 22, 1993, effective Jan 3, 1994]*

**37 CFR 5.20      Export of technical data relating to sensitive nuclear technology.**

(a) Under regulations (10 CFR 810.7) established by the United States Department of Energy, an application filed in accordance with the regulations (37 CFR 5.11 through 5.33) of the United States 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.

(b) Inquiries concerning the export of sensitive nuclear technology other than related to the filing or prosecution of a foreign patent application should be made to the Attention: Secretary, United States Department of Energy, Office of International Security Affairs, Washington, D.C. 20858.

*[49 FR 13463, Apr. 4, 1984]*

**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, 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 inadvertently filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
- (4) The required fee (§ 1.17(h)).

The above explanation must include a showing of facts rather than a mere allegation of action through error and without deceptive intent. 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 without deceptive intent should cover the period leading up to and including each of the prescribed foreign filings.

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(b) 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

(c) The granting of a retroactive license does not excuse any violation of the export regulations contained in 22 CFR Parts 121 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR Part 379 (Regulations of Office of Export Administration, International Trade Administration, Department of Commerce) and 10 CFR Part 810 (Foreign Atomic Energy Programs of the Department of Energy) which may have occurred because of the failure to obtain an appropriate license prior to export.

[49 FR 13463, Apr. 4, 1984; para. (a), 56 FR 1924, Jan. 18, 1991, effective Feb. 19, 1991]

**GENERAL****37 CFR 5.31      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 Government contract or the requirements of any other Government agency.

[24 FR 10381, Dec. 22, 1959; Redesignated at 49 FR 13463, Apr. 4, 1984]

**37 CFR 5.32      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.

[24 FR 10381, Dec. 22, 1959; Redesignated at 49 FR 13463, Apr. 4, 1984]

**37 CFR 5.33      Correspondence.**

All correspondence in connection with this part, including petitions, should be addressed to "Commissioner of Patents and Trademarks (Attention Licensing and Review), Washington, D.C. 20231."

[49 FR 13463, Apr. 4, 1984]

## PART 7—REGISTER OF GOVERNMENT INTERESTS IN PATENTS

Sec.

- 7.1 Requirements.
- 7.2 Assignments.
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### 37 CFR 7.1 Requirements.

(a) Executive Order 9424 (3 CFR 1943-1948 Comp.) requires the several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, to forward promptly to the Commissioner of Patents and Trademarks for recording all licenses, assignments, or other interests of the Government in or under patents or applications for patents.

(b) An instrument relating to a patent must identify the patent by the patent number. An instrument relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number, e.g., 07/123,456) or the serial number and filing date. An instrument relating to an international patent application which designates the United States of America must identify the international application by the international application number (e.g., PCT/US90/01234). If an assignment is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended.

(c) Each instrument submitted to the Office for recording must be accompanied by at least one cover sheet as specified in paragraph (d) of this section referring to those patent applications and patents against which the instrument is to be recorded. Only one set of instruments and cover sheets to be recorded should be filed. If an instrument to be recorded is not accompanied by a completed cover sheet, the instrument and any incomplete cover sheet will be returned for proper completion of a cover sheet and resubmission of the instrument and a completed cover sheet.

(d) Each cover sheet required by paragraph (c) of this section must contain:

- (1) the name of the party conveying the interest;
- (2) the name and address of the party receiving the interest;
- (3) a description of the interest conveyed or transaction to be recorded;
- (4) each application number or patent number against which the instrument is to be recorded, or an indication that the instrument is filed together with a patent application;
- (5) the name and address of the party to whom correspondence concerning the request to record the instrument should be mailed;
- (6) the number of applications or patents identified in the cover sheet and the total fee;
- (7) the date the instrument was executed;
- (8) a statement by the party submitting the instrument that to the best of the person's knowledge and belief, the information contained on the cover sheet is true and correct and any copy submitted is a true copy of the original instrument; and
- (9) the signature of the party submitting the instrument.

(e) Each patent cover sheet required by paragraph (c) of this section seeking to record a

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government interest as provided by paragraph (a) of this section must:

- (1) indicate that the instrument is to be recorded on the governmental register, and, if applicable, that the instrument is to be recorded on the Secret Register. See § 7.7.
- (2) indicate, if applicable, that the instrument to be recorded is not an instrument affecting title. See paragraph (j) of this section.
- (f) An error in a cover sheet recorded pursuant to this Part will be corrected only if:
  - (1) the error is apparent when the cover sheet is compared with the recorded instrument to which it pertains, and
  - (2) a corrected cover sheet accompanied by the recording fee set forth in paragraph (i) of this section and either the original recorded instrument or a copy of the original recorded instrument is filed for recordation.
- (g) The Office will accept and record non-English language instruments only if accompanied by a verified English translation signed by the individual making the translation.
- (h) Instruments and cover sheets to be recorded should be addressed to the Commissioner of Patents and Trademarks, Box Assignment, Washington, D.C. 20231.
- (i) All requests to record instruments must be accompanied by the appropriate fee. Except as provided in paragraph (j) of this section, a recording fee set forth in § 1.21 (h) of this chapter fee is required for each application and patent against which the instrument is recorded as identified in the cover sheet.
- (j) No fee is required for each patent application and patent against which an instrument required by Executive Order 9424 (3 CFR 1943 - 1948 Comp.) to be filed if:
  - (1) the instrument does not effect title and is so identified in the cover sheet (see paragraph (e) of this section); and
  - (2) the cover sheet is filed in a format approved by the Office.

*[Amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995]*

### **37 CFR 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 instrument will be recorded, endorsed, and returned.

### **37 CFR 7.3 Licenses.**

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

### **37 CFR 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 instrument 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 instrument, the place where it is usually filed, and any docket or identifying number, must be attached to the copy.

### **37 CFR 7.5 Instruments already on record.**

Instruments which have been recorded prior to the adoption of §§ 7.1 to 7.7 and are on the general assignment records of the Patent and Trademark Office need not be forwarded for recording.

### **37 CFR 7.6 Access to register.**

The register will not be open to public inspection. It will be available for examination and

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inspection by duly authorized representatives of the Government, subject to the provisions of § 7.7. Public examination will be restricted to those instruments which the department or agency or origin has so authorized in writing.

**37 CFR 7.7            Secret register.**

Any instrument to be recorded will be placed on a secret record or register at the request of the department or agency submitting the same. No information will be given concerning any instrument in such record or register, and no examination or inspection thereof or of the index thereto will be permitted, except on the written authority of the head of the department or agency which submitted the instrument and requested secrecy, and the approval of such authority by the Commissioner of Patents and Trademarks. No instrument or record other than the one specified may be examined, and the examination must take place in the presence of a designated official of the Patent and Trademark Office. When the department or agency which submitted an instrument no longer requires secrecy with respect to that instrument, it will be recorded or registered anew in the appropriate part of the register which is not secret.

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