
The Office of Licensing and Review

Licensing and Review

- Located within Technology Center 3600.
- The L&R staff consists of:
 - Licensing and Review administrative staff.
 - Workgroup SPE's of 3640 & 3660
 - Various patent examiners (screeners)

Our Purpose:

- To **screen** patent applications for subject matter that, if published, would be detrimental to National Security.

Our Purpose:

- **Administer Secrecy Orders**
pursuant to 35 U.S.C 181.

Our Purpose:

- **License applications** and inventions for export of foreign filing pursuant to 35 U.S.C. 184.

Our Purpose:

- **Police Government Property Rights** for Department of Energy and National Aeronautics and Space Administration pursuant to 42 U.S.C. 2182 and 2457.

Screening

...Whenever the publication or disclosure of an invention by the publication of an application or by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner of Patents, 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... (35 USC 181)

Screening

- All Provisionals, Utilities, Designs and PCT's are screened.
- Foreign language applications are screened, where possible.

Screening

1st, 2nd and 3rd level reviews

- 1st – Automated screening in OIPE
- 2nd – Manual screening by Examiners
- 3rd - Final decision by Defense agencies

Screening

- Defense Agencies
 - Defense Threat Security Administration
 - Army, Air Force, Navy, NSA
 - Department of Energy
 - Homeland Security
 - Department of Justice
 - NASA

Secrecy Orders

...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 publication of an application or 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 of Patents and the Commissioner of Patents shall order that the invention be kept secret and shall withhold the publication of the application or the grant of a patent for such period as the national interest requires, and notify the applicant thereof....

Secrecy Orders

- A Secrecy Order is an administrative tool for preventing the publication of a patent application.
 - The result of a third level review of an application to a defense agency found to have security concerns.
 - The result of a classified application.
 - The result of an application filed thru bi-lateral secrecy agreements with a number of foreign countries and/or NATO.

Secrecy Orders

- Different types of secrecy order to ease handling/disclosure of material.
- Permits for foreign filing in countries via bi-lateral secrecy agreements.
 - Must be planned in advance thru the defense agency sponsoring the secrecy order.
- Permits for disclosure.

Secrecy Orders

- The majority of applications are examined up until the point of allowance or appeal.
- Patent term extension begins at the time the application is found allowable as per 37CFR 5.3(c) or mailing of an examiners answer.

Licensing

Except when authorized by a license obtained from the Commissioner of Patents a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country... (35 USC 184)

Licensing

Notification of License

- Applicants are notified of a foreign filing license as a result of filing an application.
 - Indicated on the filing receipt.

Licensing

Notification of License

- Upon Expedited Request (37CFR 5.12)
 - US patent application on file (37CFR 5.13)
 - No application on file (37CFR 5.14)
 - 3 day turnaround

Licensing

Notification of License

- Retroactively (37CFR 5.25)
 - thru error and without deceptive intent

Licensing

- A License is not required if:
 - The invention was not made in the U.S.;
 - The corresponding US application is not subject to a secrecy order and was filed at least 6 months prior to the date on which the application is filed in a foreign country.
 - The application is a PCT application filed in the U.S. Receiving Office.

Gov't Property Rights

Gov't Property Rights

- Department of Energy (42 U.S.C 2182)
 - “Useful in the production or utilization of special nuclear material or atomic energy”
 - Life science issues

Gov't Property Rights

- NASA (42 U.S.C. 2457)
- "...have significant utility in the conduct of aeronautical and space activities..."

Gov't Property Rights

- Statement requires statement by the *applicants*.
- 30 days statutory, non-extendable, time limit to respond.
- Office sends 45 day “heads-up” notice.
- Statements are sent to Agencies at time of allowance.
- Any adverse decision may be appealed to Board of Patent Appeals and Interferences.

Commonly asked questions

- Must a case first be filed in the U.S. prior to filing abroad?
- No
- Does a foreign filing license from the USPTO apply to any country? – Yes, however applicant must be mindful of other requirements/prohibitions for filing in certain countries.
- Does a foreign filing license from the USPTO allow one to send information abroad for the preparation of a patent application to be filed first in the US? –No

Questions?