would be transmitted to the international authorities or the applicant.

(Pub. L. 94–131, 89 Stat. 685)

[43 FR 20470, May 11, 1978, as amended at 53 FR 23736, June 23, 1988; 62 FR 53203, Oct. 10, 1997; 69 FR 50002, Aug. 12, 2004; 77 FR 46629, Aug. 6, 2012; 80 FR 17969, Apr. 2, 2015]

§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.

(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) 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 sixty 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.

[24 FR 10381, Dec. 22, 1959, as amended at 62 FR 53204, Oct. 10, 1997]

§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.

(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) 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.

[24 FR 10381, Dec. 22, 1959, as amended at 62 FR 53204 Oct. 10, 1997]

§§5.6–5.8 [Reserved]

LICENSES FOR FOREIGN EXPORTING AND FILING

§5.11 License for filing in, or exporting to, a foreign country an application on an invention made in the United States or technical data relating thereto.

(a) A license from the Commissioner for Patents 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 country or in a foreign or international intellectual property authority (other than the United States Patent and Trademark Office acting as a Receiving Office for international applications (35 U.S.C. 361, 37 CFR 1.412) or as an office of indirect filing for international design applications (35 U.S.C. 382, 37 CFR 1.1002)), 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 for Patents referred to in paragraph (a) of this section would also authorize the export of technical data abroad for purposes related to:

(1) The preparation, filing or possible filing, and prosecution of a foreign application; and

(2) The use of a World Intellectual Property Organization online service for preparing an international application for filing with the United States Patent and Trademark Office acting as a Receiving Office (35 U.S.C. 361, 37 CFR 1.412) without separately complying with the regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy).

(c) Where technical data in the form of a patent application, or in any form, are being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign application, without the license from the Commissioner for Patents 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 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations 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 part 120, 15 CFR part 734, and activities covered by 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 application if:

(i) A license is not, or was not, required under paragraph (e)(2) of this section for the foreign application;

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

(f) A license pursuant to paragraph (a) of this section can be revoked at any time upon written notification by the United States Patent and Trademark Office. An authorization to file a foreign 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, as amended at 56 FR 1928, Jan. 18, 1991; 62 FR 53204, Oct. 10, 1997; 70 FR 56129, Sept. 26, 2005; 80 FR 17969, Apr. 2, 2015; 85 FR 61607, Sept. 30, 2020]

§5.12 Petition for license.

(a) Filing of an application in the United States Patent and Trademark Office on an invention 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 or other official notice 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) A petition for license must include the fee set forth in §1.17(g) of this chapter, the petitioner's address, and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner. The petition should be presented in letter form.

[48 FR 2714, Jan. 20, 1983, as amended at 49 FR 13462, Apr. 4, 1984; 62 FR 53204, Oct. 10, 1997; 65 FR 54683, Sept. 8, 2000; 69 FR 56546, Sept. 21, 2004; 80 FR 17970, Apr. 2, 2015; 85 FR 61607, Sept. 30, 2020]

§5.13 Petition for license; no corresponding application.

If no corresponding national, international design, or international application has been filed in the United States, the petition for license under §5.12(b) must also be accompanied by a legible copy of the material upon which a license is desired. This copy will be retained as a measure of the license granted.

[80 FR 17970, Apr. 2, 2015]

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

(a) When there is a corresponding United States application on file, a petition for license under §5.12(b) must also identify this application by application number, filing date, inventor, and title, but 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.

(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 or exported abroad, must be furnished with the petition. If, however, all new matter in the application to be filed or exported is readily identifiable, the new matter may be submitted in detail and the remainder by reference to the pertinent United States application or applications.

(Pub. L. 94–131, 89 Stat. 685)

[43 FR 20471, May 11, 1978, as amended at 49 FR 13462, Apr. 4, 1984; 62 FR 53204, Oct. 10, 1997; 80 FR 17970, Apr. 2, 2015]

§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, will be eligible for a license of the scope provided in this paragraph (a). This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign application, if such changes to the application do not alter the general nature of the invention in a manner that would require the United States application to have been made available for inspection under 35 U.S.C. 181. Grant of this license authorizes the export of technical data pursuant to §5.11(b) and the filing of an application in a foreign country or with any foreign or international intellectual property authority when the technical data and the