

GOVERNMENT PATENTS BOARD

Office of the Chairman

Administrative Order No. 4March 12, 1951FOREIGN PATENT PROTECTION PROCEDURESection 1. Purpose:

The purpose of this order is to prescribe procedures for effectuating the policy of the Government, as set forth in Executive Order 9865, with respect to the administration of the program for patent protection abroad of inventions resulting from Government-financed research to which the Government has acquired title or the right to file foreign patent applications thereon.

Section 2. Authority:

Authority for the issuance of this order is provided in Executive Order 9865, dated June 14, 1947 (12 F.R. 3907) and Executive Order 10096, dated January 23, 1950 (15 F.R. 389).

Section 3. Scope:

This order applies to any invention to which the Government has acquired or may acquire title or the right to seek patent protection abroad, except any invention officially classified for reasons of the national security and any invention within the jurisdiction of the Atomic Energy Commission which is not specifically authorized by said Commission for inclusion within the terms of this order.

Section 4. Reports and Recommendations:

(a) Immediately upon filing an application for United States patent and receiving from the Commissioner of Patents the serial number of such application on an invention in and to which the Government has obtained title or the right to file foreign patent applications thereon, or holds an option to obtain such right, the Government agency concerned shall inform the Office of Technical Services, Department of Commerce, and furnish the information specified in subparagraph (b) below concerning each such invention.

(b) The Government agency concerned shall furnish the Office of Technical Services, through the use of Foreign Patent Protection Reporting Form TSl2, the following information concerning each invention:

(1) Whether or not the reporting agency recommends that the invention should receive patent protection abroad by the United States and, if so, in what foreign jurisdictions such

patent protection should be sought, together with the reasons for the recommendation to file or not to file for foreign patent protection, or to cause disclosure of the invention in accordance with Section 8 below, and an indication of the immediate or future industrial, commercial or other value of the invention, including its value to public health.

(2) The other information specified in Form TSl2, including an abstract of the invention, which shall consist of a clear and concise summary of the invention containing, in 100 words or less of simple language (non-technical where possible), information concerning the specific form or embodiment of the invention with special reference to its novel features and giving the permissible variations unless they are obvious. The abstract should cover:

- (i) what the invention is or to what it relates;
- (ii) its construction, if a machine, apparatus, device or article; its identity, if a chemical compound, or its ingredients, if a mixture, including the production thereof if not obvious; or the procedure involved, if a process;
- (iii) its manner of operation (how it works), if a machine, apparatus, device or article; and
- (iv) what it accomplishes or is intended to accomplish over the known prior art.

Unessential details and theoretical matters and discussions should be omitted, but the abstract should be sufficiently complete to serve as a disclosure of the invention.

Section 5. The Secretary of Commerce:

Under Administrative Order No. 2, issued by the Chairman of the Government Patents Board on September 6, 1950, which delegated to the Secretary of Commerce certain of the functions and duties transferred to the Chairman of the Government Patents Board under Executive Order 10096, it is the responsibility of the Secretary of Commerce, as represented by the Office of Technical Services, Department of Commerce, upon receipt of the information specified under Section 4 above:

(a) To consult fully with United States industry and commerce, with the Chairman of the Government Patents Board, with the Department of State, and with other Government agencies familiar with technical, scientific, industrial, commercial or other economic or social factors affecting the invention involved;

(b) Upon the basis of such consultation and after consideration of the availability of valid patent protection in the countries determined to be immediate or potential markets for, or producers of, products, processes, or services covered by or relating to the invention, to determine whether or not and in what foreign jurisdictions the United States should seek patent protection of such inventions and, to the extent of available funds therefor, to procure foreign patent protection of such inventions, taking all action, consistent with existing law, necessary to acquire and maintain patent rights abroad on such inventions;

(c) To administer foreign patents acquired by the United States under the terms of this order, subject to the approval of the Chairman of the Government Patents Board on all matters of policy;

(d) To issue licenses under such patents as prescribed in Section 7 below and in accordance with law;

(e) To maintain adequate records, and other necessary files, to provide readily available information on all the inventions included under the program, with special reference to patent applications pending, patents issued, and licenses granted; and

(f) To submit to the Chairman of the Government Patents Board a written report quarterly, or otherwise as the Chairman may request, on all operations of this program during the preceding calendar quarter or other period designated.

Section 6. The Department of State:

Pursuant to Executive Orders 9865 and 10096, it is the responsibility of the Department of State, in consultation with the Chairman of the Government Patents Board and the Secretary of Commerce, to seek arrangements among governments under which each government and its nationals shall have access to the foreign patents of the other participating governments.

Section 7. Licensing of Foreign Patents:

(a) Licenses under foreign patents issued to the United States shall be granted by the Secretary of Commerce to nationals of the United States on a nonexclusive, revocable, royalty-free basis except in such cases as the Secretary of Commerce with the approval of the Chairman of the Government Patents Board shall determine it to be inconsistent with the public interest to issue such licenses on a nonexclusive, royalty-free basis.

(b) Licenses under foreign patents issued to the United States may be granted by the Secretary of Commerce to foreign countries or to nationals of foreign countries pursuant to any arrangements which may come into force with such countries as provided in Section 6 above, or, in the absence of such arrangements, on such terms as the Secretary of Commerce, with the approval of the Chairman of the Government Patents Board, shall determine, in accordance

with law and on the recommendation of the Secretary of State, would be in the public interest, subject to outstanding licenses.

(c) With respect to foreign patents relating to matters of public health, licenses under such patents issued to the United States may be granted by the Secretary of Commerce to foreign countries or to nationals of foreign countries on a nonexclusive, revocable, royalty-free basis unless the Chairman of the Government Patents Board, on the recommendation of the Secretary of State, shall determine otherwise, regardless of whether a country is a party to the arrangements specified in Section 6 above.

Section 8. Disclosure of Inventions:

(a) The Secretary of Commerce may, in cooperation with the Government agency concerned and with the approval of the Chairman of the Government Patents Board, cause prompt disclosure of any invention falling within the scope of this order, with respect to which a patent application has been filed in the United States, and concerning which a secrecy order has not been issued by the United States Commissioner of Patents, in such manner as may be necessary, or useful and feasible, to insure maximum protection to the interest of the United States.

(b) The Secretary of Commerce may, in cooperation with the Government agency concerned and with the approval of the Chairman of the Government Patents Board, cause prompt disclosure of any invention falling within the scope of this order, with respect to which a determination has been made that a patent application will not be filed in the United States, in such manner as may be necessary, or useful and feasible, to insure maximum protection to the interest of the United States, upon determination by the Secretary of Commerce, after consultation with all interested departments and agencies and with the approval of the Chairman of the Government Patents Board, that such disclosure would not be contrary to the national interest or security and that the invention is of sufficient novelty and significance to require such protection.

Section 9. Foreign Filing by Inventor:

When the foreign patent rights in an invention are not assigned to the Government but the Government may, at its option or on request, acquire such rights and the Secretary of Commerce, as represented by the Office of Technical Services, Department of Commerce, fails to cause an application to be filed in any particular foreign country on behalf of the Government, or determines not to seek a foreign patent in such country, within six months of the filing of an application for United States patent on the invention, such failure to cause an application to be filed, or determination not to seek a foreign patent, shall constitute a decision by the Government not to acquire the patent rights in

such foreign country, subject to the provisions of paragraph 6 of Executive Order 9865. After the decision by the Government the inventor may apply for patent in such country, subject to the reservation to the Government of a nonexclusive, irrevocable, royalty-free license in the invention for all governmental purposes.



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Chairman