

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
Secrecy and License to Export
OMB Control Number 0651-0034

Background

In the interest of national security, patent laws and regulations place certain limitations on the disclosure of information contained in patents and patent applications and on the filing of applications for patents in foreign countries.

Secrecy Orders

Whenever the publication or disclosure of an invention by the publication of an application or by the granting of a patent is, in the opinion of the head of an interested Government agency, determined to be detrimental to national security, the Commissioner for Patents at the United States Patent and Trademark Office (USPTO) must issue a secrecy order and withhold the publication of a patent application and the grant of a patent for such period as the national interest requires. A patent will not be issued on the application, nor will the application be published, as long as the secrecy order is in force. If a secrecy order is applied to an international application, the application will not be forwarded to the International Bureau as long as the secrecy order is in effect.

The Commissioner for Patents can issue three types of secrecy orders, each of a different scope. The first type, Secrecy Order and Permit for Foreign Filing in Certain Countries, is intended to permit the widest utilization of the technical data in the patent application while still controlling any publication or disclosure that would result in an unlawful exportation. The second type, the Secrecy Order and Permit for Disclosing Classified Information, is to treat classified technical data presented in a patent application in the same manner as any other classified material. The third type of secrecy order is used where the other types of orders do not apply, including orders issued by direction of agencies other than the Department of Defense.

Under the provision of 35 U.S.C. § 181, a secrecy order remains in effect for a period of one year from its date of issuance. A secrecy order may be renewed for additional periods of not more than one year upon notice by a government agency that the national interest continues to so require. The applicant is notified of such renewal.

When the USPTO places a secrecy order on a patent application, the regulations authorize the applicant to petition the USPTO for permits to allow disclosure, modification, or rescission of the secrecy order, or to obtain a general or group permit. In each of these circumstances, the petition is forwarded to the appropriate defense agency for decision. Also, the Commissioner for Patents at the USPTO may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the disclosure of the invention is no longer deemed detrimental to the national security.

Unless expressly ordered otherwise, action on the application and prosecution by the applicant will proceed during the time the application is under secrecy order to a specific point as indicated under 37 CFR 5.3. Applications under secrecy order that 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 specifically indicated by the Commissioner of Patents at the USPTO, will not be set for hearing until the secrecy order is removed.

Foreign Filing License

This information collection also covers information gathered with respect to foreign filing licenses. The filing of a patent application is considered a request for a foreign filing license. However, in some instances an applicant may need a license for filing patent applications in foreign countries prior to a filing in the USPTO or sooner than the anticipated licensing of a pending patent application.

For such circumstances, this information collection covers petitions for a foreign filing license either with or without a corresponding United States application. In addition, this information collection covers petitions to change the scope of a license and petitions for a retroactive license for instances when a patent application is filed through error in a foreign country without the appropriate filing license.

This information collection includes the information needed by the USPTO to review the various types of petitions regarding secrecy orders and foreign filing licenses. This collection of information is required by 35 U.S.C. 181-183 and 184-186 and administered by the USPTO through 37 CFR 5.1-5.5, 5.11-5.15, and 5.18-5.25.

In support of RIN 0651-AD64 (Setting and Adjusting Patent Fees During Fiscal Year 2025; 89 FRN 91898)¹, the USPTO is changing 12 fees in this information collection.

Table 1: Changes in Fee Amount

Item No	Fee Code	Item	Current Fee	New Fee	Changes in Fee Amount
4	1463	Petition for Expedited Handling of License (no corresponding application) (undiscounted entity)	\$220	\$235	+\$15
4	2463	Petition for Expedited Handling of License (no corresponding application) (small entity)	\$88	\$94	+\$6
4	3463	Petition for Expedited Handling of License (no corresponding application) (micro entity)	\$44	\$47	+\$3

¹ <https://www.govinfo.gov/content/pkg/FR-2024-11-20/pdf/2024-26821.pdf>

5	146 3	Petition for Expedited Handling of License (corresponding U.S. application) (undiscounted entity)	\$220	\$235	+\$15
5	246 3	Petition for Expedited Handling of License (corresponding U.S. application) (small entity)	\$88	\$94	+\$6
5	346 3	Petition for Expedited Handling of License (corresponding U.S. application) (micro entity)	\$44	\$47	+\$3
6	146 3	Petition for Changing Scope of License (undiscounted entity)	\$220	\$235	+\$15
6	246 3	Petition for Changing Scope of License (small entity)	\$88	\$94	+\$6
6	346 3	Petition for Changing Scope of License (micro entity)	\$44	\$47	+\$3
7	146 3	Petition for Retroactive License (undiscounted entity)	\$220	\$235	+\$15
7	246 3	Petition for Retroactive License (small entity)	\$88	\$94	+\$6
7	346 3	Petition for Retroactive License (micro entity)	\$44	\$47	+\$3

Table 2: Proposed Burden

Item No.	Fee Code	Item	Responses (a)	New Fee (b)	New Non-hour Cost Burden (a) x (b) = (c)
4	146 3	Petition for Expedited Handling of License (no corresponding application) (undiscounted entity)	5,600	\$235	\$1,316,000
4	246 3	Petition for Expedited Handling of License (no corresponding application) (small entity)	1,260	\$94	\$118,440
4	346 3	Petition for Expedited Handling of License (no corresponding application) (micro entity)	140	\$47	\$6,580
5	146 3	Petition for Expedited Handling of License (corresponding U.S. application) (undiscounted entity)	240	\$235	\$56,400
5	246 3	Petition for Expedited Handling of License (corresponding U.S. application) (small entity)	54	\$94	\$5,076
5	346 3	Petition for Expedited Handling of License (corresponding U.S. application) (micro entity)	6	\$47	\$282
6	146 3	Petition for Changing Scope of License (undiscounted entity)	1	\$235	\$235
6	246 3	Petition for Changing Scope of License (small entity)	1	\$94	\$94
6	346 3	Petition for Changing Scope of License (micro entity)	1	\$47	\$47
7	146 3	Petition for Retroactive License (undiscounted entity)	160	\$235	\$37,600
7	246	Petition for Retroactive License	36	\$94	\$3,384

	3	(small entity)			
7	346 3	Petition for Retroactive License (micro entity)	4	\$47	\$188
		Totals	7,503	- - -	\$1,544,326

Table 3: Changes in Cost

Item No.	Fee Code	Items	Current Cost (a)	New Cost (b)	Change in Non-hour Cost Burden (b) – (a) = (c)
4	1463	Petition for Expedited Handling of License (no corresponding application) (undiscounted entity)	\$1,232,000	\$1,316,000	+\$84,000
4	2463	Petition for Expedited Handling of License (no corresponding application) (small entity)	\$110,880	\$118,440	+\$7,560
4	3463	Petition for Expedited Handling of License (no corresponding application) (micro entity)	\$6,160	\$6,580	+\$420
5	1463	Petition for Expedited Handling of License (corresponding U.S. application) (undiscounted entity)	\$52,800	\$56,400	+\$3,600
5	2463	Petition for Expedited Handling of License (corresponding U.S. application) (small entity)	\$4,752	\$5,076	+\$324
5	3463	Petition for Expedited Handling of License (corresponding U.S. application) (micro entity)	\$264	\$282	+\$18
6	1463	Petition for Changing Scope of License (undiscounted entity)	\$220	\$235	+\$15
6	2463	Petition for Changing Scope of License (small entity)	\$88	\$94	+\$6
6	3463	Petition for Changing Scope of License (micro entity)	\$44	\$47	+\$3
7	1463	Petition for Retroactive License (undiscounted entity)	\$35,200	\$37,600	+\$2,400
7	2463	Petition for Retroactive License (small entity)	\$3,168	\$3,384	+\$216
7	3463	Petition for Retroactive License (micro entity)	\$176	\$188	+\$12
		Totals	\$1,445,752	\$1,544,326	+\$98,574

Summary of Changes

The aforementioned rulemaking results in the revision of 12 fees, with an increase of \$98,574 in annual non-hourly costs to collection 0651-0034.

Changes in Burden

Burden Type	Currently Approved	Proposed Change	New Estimate
Non-hourly Cost Burden	\$1,446,446	+\$98,574	\$1,545,020

0651-0034's revised burden is as follows:

- 7,524 annual responses (unchanged)
- 4,503 annual hourly burden (unchanged)

- \$1,545,020 in annual non-hourly burden costs