Foreign Filing Requirements for Patents in Europe

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I Introduction

This report deals with the requirements for filing patent applications in Europe on inventions that are or may be subject to secrecy protection. More specifically, it summarizes and compares the national requirements of Belgium, Germany, Spain, France, Italy, The Netherlands, and United Kingdom, with regard to the first filing of secret patent applications at the respective national authorities and/or obtaining foreign filing licences for filing such patent applications in respective other countries.

Each of the investigated countries has a more or less strict first filing requirement, and national authorizations are in general required for filing secret patent applications in other countries (see, in particular, the comparison table at the end of this report). For inventions that are made or considered to be made in several countries, e.g., by means of cooperations between nationals of different countries, this may lead to conflicts between the respective national regulations of the involved countries. Such conflicts can, in the most general case, not be resolved solely by national law since national regulations dealing with such conflicts are often missing. Therefore, it is advisable to plan for such situations in beforehand, in particular by defining the legal cooperation structures by contract law. Apart from this, if a potentially secret invention has been made in different countries, it is advisable to contact the responsible authorities of each involved country to clarify the required procedures for the individual case, in order to avoid the penalties provided in each country for violating the respective national secrecy protection measures.

The following Section II summarizes the national regulations concerning secret inventions in each of the investigated countries, while the final Section III summarizes some main aspects of this report by a comparison table between the different countries.

II Country information

II.A Belgium (BE)

II.A.1 What inventions are subject to secrecy protection?

II.A.1.1 General definition

The applicable legal provisions concern trade secrets and inventions, the divulgation of which would be contrary to the interests of the defense of the territory or the security of the state (art. 1 Secrecy Act).

II.A.1.2 Which technical fields do such inventions primarily belong to?

The applicable legal provisions are not limited to any particular technical fields. Trade secrets and inventions with a clear potential for military application (weaponry, ammunition, blasting, surveillance) are undoubtedly within the scope of the law, but other fields are not excluded.

II.A.1.3 May even non-patentable inventions be subject to secrecy protection?

Yes, the law explicitly covers “trade secrets and inventions” (art. 1 Secrecy Act).

II.A.1.4 What other IP rights (apart from patents) may be subject to secrecy protection?

Besides patents, non-patented inventions (trade secrets) may also be subject to secrecy protection (art. 1 Secrecy Act). No other intellectual property rights are in scope.

II.A.2 If an invention subject to secrecy protection has been made, what obligations are imposed on the inventor or applicant?

II.A.2.1 General secrecy obligations

The divulgation of such a trade secret or invention is prohibited (art. 1 Secrecy Act).

II.A.2.2 Does a first filing requirement apply?

The filing of a patent application that can concern the defense of the territory or the security of the state, in a state other than Belgium, would constitute a prohibited divulgation of the invention. Accordingly, the first filing of a patent application must take place in Belgium (art. 4 Secrecy Act).

II.A.2.3 Does a foreign filing licence requirement apply?

The Secrecy Act does not contain any explicit provisions regarding the issuance of a foreign filing license.

If the Minister of Defense takes up an invention for which a patent application has been filed in Belgium for investigation under the Secrecy Act, foreign filings are prohibited unless explicit permission is given (art. 5 Secrecy Act).

If, after investigation, the Minister of Defense indicates that no protective measures are necessary, or if the Minister of the Economy and the Minister of Defense jointly decide not to take any measures, the patent grant proceedings will resume and foreign filings will be permitted. If, after the assessment by the Minister of Defense, the Minister of the Economy and the Minister of Defense jointly take further measures to protect the interests of the defense of the territory or the security of the state, the extent of these measures will determine whether foreign filings are possible. (Art. 5 Secrecy Act)

If the patent application remains subject to a secrecy order, it may still be possible to obtain permission to file (secret) foreign patent applications in the contracting states of the Agreement for the Mutual Safeguarding of Secrecy of Inventions Relating to Defense and for Which Applications for Patents Have Been Made, done at Paris September 21, 1960, in the context of NATO.

II.A.2.4 Will an invention that constitutes a state secret be expropriated and transferred to the government?

If less restrictive measures prove to be insufficient, the Minister of the Economy and the Minister of Defense can jointly claim for the government the exclusive right to exploit a patent or demand the transfer of the knowledge concerning a trade secret (art. 3 Secrecy Act).

The Belgian state may also negotiate an (exclusive) license agreement with the applicant.

II.A.3 Responsible authorities

II.A.3.1 Which authorities are responsible for examining whether an invention is subject to secrecy protection?

The Minister of the Economy and the Minister of Defense can jointly declare that divulgation of a trade secret or an invention is contrary to the interests of the defense of the territory or the security of the state, and prohibit the divulgation of said trade secret or invention for a certain time (art. 2 Secrecy Act).

The Minister of the Economy (assisted by the Bureau for Civil Defense Plans, see Clerix et al., section 3.1.7.1) can notify the Minister of Defense of any patent applications for which measures to protect the interests of the defense of the territory or the security of the state may be necessary (art. 4 Secrecy Act).

The Minister of Defense (or an officer appointed by the Minister, see Clerix et al., section 3.1.7.1) can also *ex officio* inspect any filed patent applications for the same purpose.

II.A.3.2 If an invention is subject to secrecy protection, at which authorities must a national patent application containing this invention be filed?

The Service for Intellectual Property, the department of the Federal Public Service Economy, responsible for the grant of all Belgian patents.

II.A.3.3 At which authorities must a European patent application containing such an invention be filed?

A European patent application by persons that have Belgian citizenship or that have their residence or establishment in Belgium and that can concern the defense of the territory or the security of the state, must be filed with the Service (art. 75(1)(b) European Patent Convention and art. XI.82, §2, Code of Economic Law).

II.A.3.4 At which authorities must an international patent application containing such an invention be filed?

An international patent application by persons that have Belgian citizenship or that have their residence or establishment in Belgium and that can concern the defense of the territory or the security of the state, must be filed with the Service (Rule 19.1 Patent Cooperation Treaty and art. XI.91, §2, Code of Economic Law).

II.A.3.5 At which authorities must a request for foreign filing licenses be filed?

The Secrecy Act does not contain any explicit provisions regarding the issuance of a foreign filing license.

II.A.4 Is there any compensation for the applicant in the event of restrictions due to secrecy protection?

II.A.4.1 Amount of compensation

The Secrecy Act does not specify the amount of compensation. On the basis of general principles of civil law, the compensation should cover the actual damage suffered by the applicant.

II.A.4.2 Conditions for receiving compensation

The Secrecy Act does not specify the conditions for receiving compensation. On the basis of general principles of civil law, the compensation can only be claimed for damages insofar as they were caused by the measures taken by the authorities.

II.A.4.3 At which authorities may compensation be claimed?

The Belgian state is liable for the damages. If a dispute arises regarding the amount or payment of the compensation, an attempt at mediation before a special commission is mandatory (art. 10 Secrecy Act).

The court of first instance (Brussels) is competent for any claims for compensation in the event that the mandatory mediation attempt is unsuccessful (art. 11 Secrecy Act).

II.A.5 Requirements for filing a secret patent application or a request for foreign licences

II.A.5.1 Requirements for filing a secret patent application

The normal formal requirements for patent applications apply.

All normal means of communication with the Service are permitted: filing in person, by courier, by mail, by fax, or by on-line filing.

In case of the filing of a European patent application or an international patent application, only those means of communication may be used which ensure that the Service is the immediate receiving office.

II.A.5.2 Requirements for filing a request for foreign licences

The Secrecy Act does not contain any explicit provisions regarding the issuance of a foreign filing license.

II.A.6 Granting of secret patents: When it is determined that a patent application contains an invention subject to secrecy protection, how will the patent application be handled?

II.A.6.1 How is substantive examination performed for applications containing an invention subject to secrecy protection? Will a patent be granted on such applications?

If the Minister of Defense takes up an invention for which a patent application has been filed in Belgium for investigation under the Secrecy Act, the grant proceedings may be

suspended as necessary (art. 5 Secrecy Act). A decision on the need for protective measures should be taken within 3 months (art. 6 Secrecy Act).

If, after referral by the Minister of Defense, the Minister of the Economy and the Minister of Defense jointly take further measures to protect the interests of the defense of the territory or the security of the state, the grant proceedings remain suspended (art. XI.23, §8, Code of Economic Law). The joint decision to apply protective measures should be taken within 6 months from the filing date (art. 6 Secrecy Act).

If no further protective measures are deemed necessary, or if the protective measures are lifted *ex officio* or at the request of the Applicant, the grant proceedings are resumed (art. 8 Secrecy Act).

II.A.6.2 How is access to the patent application and/or the granted patent restricted?

During the investigation of the application and for the duration of any protective measures jointly taken by the Minister of the Economy and the Minister of Defense, the Service will keep the patent application or patent concerned secret (art. 7 Secrecy Act).

II.A.7 Granting of foreign filing licenses

II.A.7.1 When the responsible authority receives a request for a foreign filing licence, how will the request be handled? In particular, how long will it take until the request is admitted or rejected?

The Secrecy Act does not contain any explicit provisions regarding the issuance of a foreign filing license.

II.A.7.2 Which criteria are applied by the responsible authority in deciding whether a foreign filing licence is granted or not?

The Secrecy Act does not contain any explicit provisions regarding the issuance of a foreign filing license.

II.A.8 Penalties

II.A.8.1 If an invention is subject to secrecy protection, what penalties are imposed on applicants or inventors for divulging any information regarding the invention to other countries?

Divulgation of trade secrets or inventions within the scope of the Secrecy Act, even through negligence, is a criminal offence, if it is proven that the divulging party could not be unaware of the fact that such divulgation would be contrary to the interests of the defense of the territory or the security of the state (art. 1 Secrecy Act).

Deliberate divulgation is punishable by imprisonment of up to 5 years and/or a fine of up to 40 000 euro (art. 13 Secrecy Act).

Divulgation as a result of negligence is punishable by imprisonment of up to 1 year and/or a fine of up to 8 000 euro (art. 13 Secrecy Act).

II.A.8.2 If an invention is subject to secrecy protection, what penalties are imposed on applicants not complying with first filing and/or foreign filing licences requirements?

The Secrecy Act does not distinguish between divulgation of the trade secret or invention by way of direct communication or by way of the unpermitted filing of a patent application in a foreign country. The penalties specified under section II.A.8.1 would apply.

II.A.9 Which regulations apply to inventions that are made in different countries, e.g., by means of cooperations between nationals of different countries, in particular if these countries have conflicting regulations regarding first filing requirements and/or foreign filing licences?

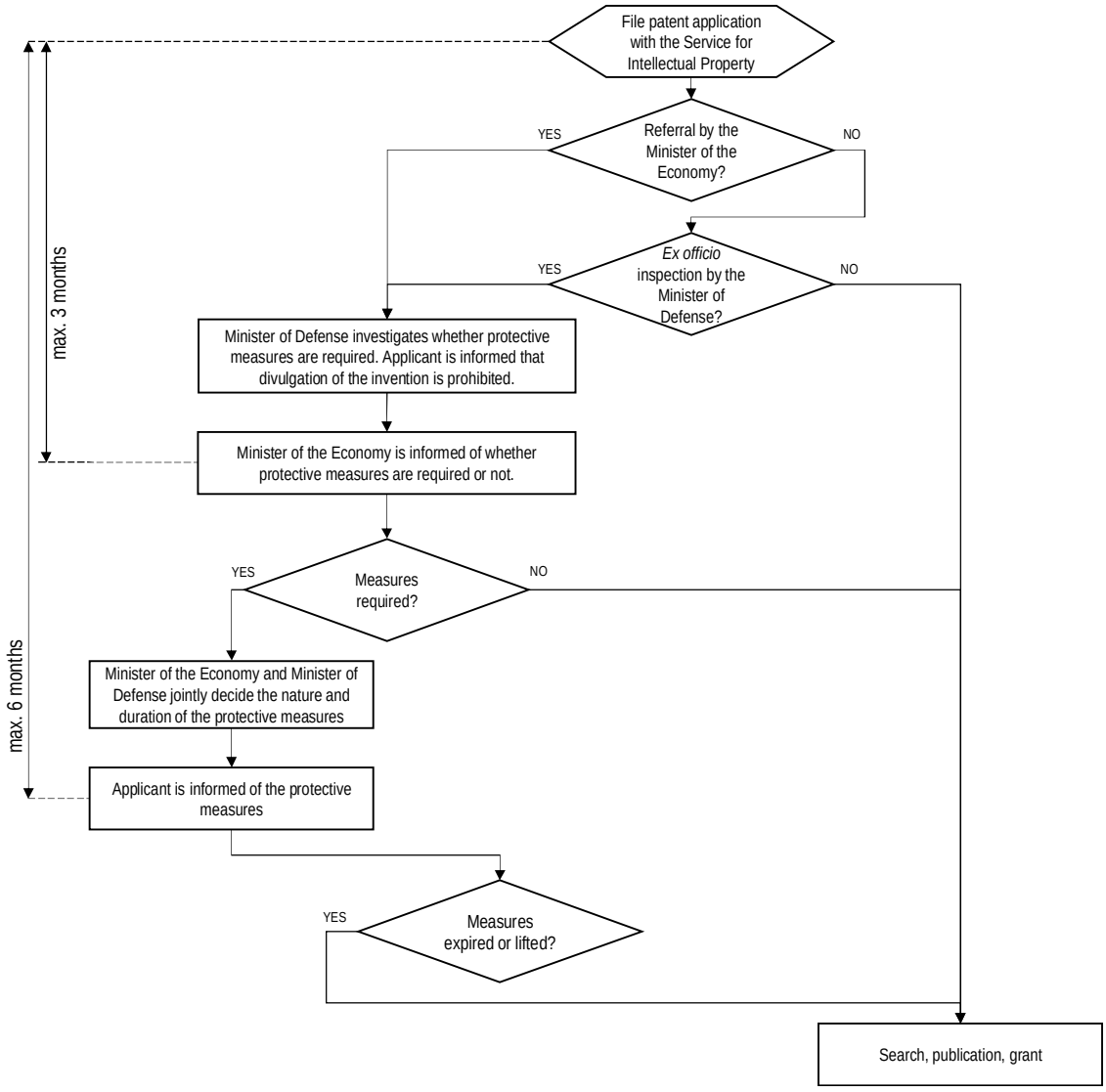
The Secrecy Act does not contain any explicit provisions regulating such situations.

II.A.10 What points of attention should be considered by inventors or applicants, in particular regarding the procedures of filing patent applications and requesting foreign filing licences for inventions subject to secrecy protection?

A Belgian applicant should always proactively assess whether their invention potentially concerns the interests of the defense of the territory or the security of the Belgian state. If this is the case, the first filing of a patent application should be performed in Belgium (as a national Belgian patent application, or as European/international patent application filed with the Belgian Service for Intellectual Property).

If the invention does not concern the interests of the defense of the territory or the security of the Belgian state, the provisions of the Secrecy Act and of art. XI.82, §2 and XI.91, §2, of the Code of Economic Law do not apply and the first filing of a patent application may be performed in any other state.

II.A.11 Flowchart illustrating the procedural order relating to first filing and/or foreign filing licence requirements



II.A.12 Abbreviations

Clerix et al. *Octrooien in België, een praktische leidraad*, Brugge: Die Keure, 2020.

Secrecy Act Law of 10 January 1955 concerning the divulgation and application of inventions and trade secrets that concern the defense of the territory or the security of the state

Service The Service for Intellectual Property, department of the Federal Public Service Economy, responsible for the grant of Belgian patents.

II.B Germany (DE)

II.B.1 What inventions are subject to secrecy protection?

II.B.1.1 General definition

Inventions which constitute a German state secret are subject to secrecy protection [§ 50(1) PatG; § 9(1) GebrMG]. State secrets are facts, objects or knowledge which are only accessible to a limited number of people, and which must be kept secret from a foreign power to prevent the risk of serious detriment to the external security of the Federal Republic of Germany [§ 93(1) StGB]. However, facts which violate the free democratic basic order, or which violate international arms control agreements when kept secret from the treaty partners of the Federal Republic of Germany are not state secrets [§ 93(2) StGB].

Moreover, secrecy protection also applies to inventions which are kept secret by a foreign state for defence reasons and are entrusted to the German Federal Government, with its consent, on the condition that they be kept secret [§ 50(4) PatG]. This ensures that German patents can be granted to foreign nationals for inventions which constitute a state secret of the foreign state.

Based on reciprocity agreements, German nationals can also obtain patents in foreign states on inventions that constitute a German state secret. In these cases, secrecy is usually ensured by intergovernmental agreements or treaties that oblige reciprocal secrecy. Especially relevant examples for such agreements are the NATO Agreement on Safeguarding Defence-Related Inventions, the Euratom Treaty, as well as bilateral treaties between Germany and Belgium, Canada, France, Greece, Italy, Netherlands, Sweden, or the USA [Benkard, § 50, Nos. 8-8a; Schulte, § 50, footnote 7; and references therein].

II.B.1.2 Which technical fields do such inventions primarily belong to?

Applications from the following technical fields may primarily contain state secrets [GPTO leaflet]:

- Defence and armaments technology, e.g., armour, explosives, ammunition, direction finding and measuring devices
- Nuclear energy technology, e.g., gas ultracentrifuges, fusion reactors, plasma nuclear technology
- Valuable and security documents, e.g., securities, banknotes, identity cards
- Cryptology, e.g., coding/decoding systems, communications technology.

II.B.1.3 May even non-patentable inventions be subject to secrecy protection?

Yes [Benkard, § 50, No. 6].

II.B.1.4 Which other IP rights (apart from patents) may be subject to secrecy protection?

Only patent and utility model applications can contain state secrets. Trademark and design applications cannot contain state secrets [GPTO leaflet].

II.B.2 If an invention subject to secrecy protection has been made, what obligations are imposed on the inventor or applicant?

II.B.2.1 General secrecy obligations

State secrets – both domestic and foreign – are to be made accessible only to a limited group of persons. Only those persons may gain knowledge of the so-called classified information for whom it is indispensable for compelling professional reasons. This limited group of persons, which also includes patent attorneys, must undergo a security check by the German domestic intelligence services. The limited access must be ensured by organizational measures and security installations, where normal electronic communication is in general not permissible [GPTO leaflet].

In particular, if an application containing a state secret is filed with the German patent and Trademark office (GPTO) and a secrecy order is issued (see Section II.B.3.1), neither the applicant nor the GPTO is allowed to publish the application or the resulting patent document for the duration of the secrecy order (generally for an unlimited period). Moreover, the invention may only be commercially exploited under certain conditions [GPTO leaflet].

Handling state secrets requires special care, since violations constitute criminal offenses according to the German Criminal Act (see Section II.B.8).

II.B.2.2 Does a first filing requirement apply?

A patent application which contains a state secret should be filed first with the GPTO, since in this way it directly receives a filing date. This may be used as a priority date for subsequent foreign applications, which may be filed provided that the Federal Ministry of Defence grants the permission (see Section II.B.2.3).

Furthermore, the GPTO examines the application and issues a secrecy order if it finds that the application contains a state secret (see Section II.B.3.1). This information is essential for the applicant to decide on further filing strategies and, if a secrecy order is issued, to comply with the respective secrecy regulations.

According to the literature, it would in principle also be possible to directly request the authorization for foreign patent applications from the Federal Ministry of Defence, i.e., even without previously filing an application with the GPTO [Benkard, § 52, No. 3; Schulte, § 52, No. 2]. However, according to our experience, the Federal Ministry of Defence will in this case not grant the authorization.

In summary, it is in fact necessary to first file the application with GPTO, since otherwise one will not obtain the permission to file the application abroad.

II.B.2.3 Does a foreign filing licence requirement apply?

A patent application containing a state secret may be filed outside of the Federal Republic of Germany only with the written authorization of the Federal Ministry of Defence (BMVg). The authorization may be given subject to conditions [§ 52(1) PatG].

Such conditions depend on the individual case and the respective intergovernmental agreement. Typically, the applicant must waive any claims for damages against the foreign states e.g., for pecuniary loss caused by the secrecy protection in these states. The applicant must further comply with the respective secrecy protection regulations, in particular by providing any documents for the subsequent foreign application only to representatives who are authorized to handle secret applications in accordance with the security regulations of the respective states. Furthermore, a copy of the application documents must be provided to the governmental authority responsible for defence in the receiving country.

II.B.2.4 Will an invention that constitutes a state secret be expropriated and transferred to the government?

No. The character of an invention as a state secret constitutes a restriction on exploitation that is not based on expropriation [Schulte, § 55, No. 2].

II.B.3 Responsible authorities

II.B.3.1 Which authorities are responsible for examining whether an invention is subject to secrecy protection?

All patent and utility model applications received by the GPTO from certain classes of the International Patent Classification (IPC) are first forwarded to the so-called Office 99, i.e., the central office of the DPMA for patent and utility model matters for which secrecy proceedings are pending or for which a secrecy order has been issued. Here, the applications not requiring secrecy are “screened out” in several steps. In this process, the GPTO also cooperates with other authorities such as the Federal Ministry of Defence and the Federal Ministry of Economics and Technology [GPTO leaflet].

If an application is filed which contains a state secret, the Examining Section issues a secrecy order after first hearing the applicant [GPTO leaflet].

The secrecy order is issued within a time limit of four months, in exceptional cases six months, after receipt of the application. If, after this period, no decision has been taken by the GPTO, the applicant can assume that the application does not constitute a state secret [§ 53 PatG].

If a secrecy order has been issued, the GPTO reviews annually whether the secrecy of the application or patent must continue to exist. If this is not the case, the secrecy order is lifted ex officio. The applicant or patent holder may also request that the secrecy order is lifted [GPTO leaflet; Benkard § 50 No. 16].

II.B.3.2 If an invention is subject to secrecy protection, at which authorities must a national patent application containing this invention be filed?

To obtain a German patent or utility model for an invention which constitutes a state secret, a patent or utility model application must be filed with the GPTO.

In particular, if the patent or utility model application may contain a state secret, it is not permissible to file it with a patent information centre [§ 34(2) S. 2 PatG; § 4(2) S. 2 GebrMG].

II.B.3.3 At which authorities must a European patent application containing such an invention be filed?

European patent applications which may contain a state secret must be filed with a corresponding notice at the GPTO, which examines the applications to determine whether they contain a state secret. If an application contains a state secret, the GPTO orders that the application shall not be forwarded to the EPO. Upon the order becoming final, the application concerned is deemed to be a national application for which a secrecy order has been issued [Art. II § 4 IntPatÜbkG].

The direct filing of a patent application containing a German state secret with the European Patent Office is punishable [Art. II § 14 IntPatÜbkG].

II.B.3.4 At which authorities must an international patent application containing such an invention be filed?

International patent applications which may contain a state secret must be filed with a corresponding notice at the GPTO, which examines the applications to determine whether they contain a state secret. If an application contains a state secret, the GPTO orders that the application shall not be forwarded to the International Bureau. Upon the

order becoming final, the application concerned is deemed to be a national application for which a secrecy order has been issued [Art. III § 2 IntPatÜbkG].

II.B.3.5 At which authorities must a request for foreign filing licences be filed?

At the German Federal Ministry of Defence [§ 56 PatG; Benkard, § 56, No. 1].

II.B.4 Is there any compensation for the applicant in the event of restrictions due to secrecy protection?

II.B.4.1 Amount of compensation

The character of an invention as a state secret constitutes a restriction on exploitation that is not based on expropriation. The compensation is intended to compensate approximately for the resulting pecuniary loss of the patent holder, insofar as it is unreasonable, on grounds of equity [Schulte, § 55, No. 2].

II.B.4.2 Conditions for receiving compensation

An applicant, a proprietor of a patent or his successor in title is entitled to compensation from the Federal Republic of Germany if each of the following conditions is fulfilled [§ 55 PatG; Schulte, § 55; Benkard, § 55]:

- the application was first filed with the GPTO;
- the invention constitutes a German state secret;
- a secrecy order was issued by the GPTO;
- the invention is patentable;
- the invention can be used for peaceful purposes;
- the invention is not used because of the secrecy order;
- the non-use of the invention results in a pecuniary loss of the patent holder; and
- the pecuniary loss is unreasonable (in view of e.g., the economic situation of the patent holder, the amount of expenses afforded for the development of the invention, the fact that the inventor knew or had to know the secrecy requirement, and the actual use of the invention for other than peaceful purposes).

The compensation can only be claimed in retrospect and for periods no shorter than one year [§ 55(1) PatG].

II.B.4.3 At which authorities may compensation be claimed?

The claim for compensation must be filed with the Federal Ministry of Defence. If it is denied, the claim may be filed with a Regional Court [§ 55(2) PatG; Benkard, § 55, No. 24].

Foreign filing licences are granted under the condition that the foreign states are released from claims for damages. Therefore, compensation cannot be claimed against these foreign states, but only against the Federal Republic of Germany [Mitt. 2018, 50].

II.B.5 Requirements for filing a secret patent application or a request for foreign licences

II.B.5.1 Requirements for filing a secret patent application

The same documents must be used for an application including a state secret as for a "normal" patent or utility model application. If there are concrete indications that an application may contain a state secret, this should be indicated in the application and on the envelope sent to the GPTO. This marked envelope must then be placed in another unmarked envelope and sent to the GPTO [GPTO leaflet].

The outer envelope may contain only the information necessary for delivery. It must not contain any additions that could be used to infer its contents or that could indicate a special treatment of the consignment [GPTO leaflet].

The patent application and the entire communication with the GPTO must be filed in paper form, since electronic filing is not permissible [GPTO leaflet].

II.B.5.2 Requirements for filing a request for foreign licences

A written request with all application documents and naming of the country in which the application is to be filed is required [Schulte, § 52, No. 4].

The formal and material precautions for the protection of secrets must be complied with [Benkard, § 52, No. 4]. In particular, electronic communication is in general not permissible.

If an application has been filed with the GPTO and the applicant intends to file subsequent foreign applications claiming priority of the German application under the PCT, the request for foreign filing licences must be filed in sufficient time such that the examination by the Federal Ministry of Defence can be completed early enough before the priority year expires [Benkard, § 52, No. 4; Mitt. 2018, 50].

II.B.6 Granting of secret patents: When it is determined that a patent application contains an invention subject to secrecy protection, how will the patent application be handled?

II.B.6.1 How is substantive examination performed for applications containing an invention subject to secrecy protection? Will a patent be granted on such applications?

Substantive examination is performed by the Examining Division in the same way as for "normal" applications. If the invention is found patentable, a patent will be granted.

II.B.6.2 How is access to the patent application and/or the granted patent restricted?

If a secrecy order is issued by the GPTO, the patent application will not be disclosed. Granted patents for which a secrecy order exists are entered in a special register and are also not disclosed. Furthermore, in this case, the GPTO only grants inspection of files under certain conditions [GPTO leaflet].

When the secrecy order is lifted (see Section II.B.3.1), the patent application or patent will be published [GPTO leaflet].

II.B.7 Granting of foreign filing licences

II.B.7.1 When the responsible authority receives a request for a foreign filing licence, how will the request be handled? In particular, how long will it take until the request is admitted or rejected?

From our experience, for patent applications for which a secrecy order was issued by the GPTO, the authorization from the Federal Ministry of Defence for subsequent foreign filings is usually granted within 1-2 weeks of filing the request.

II.B.7.2 Which criteria are applied by the responsible authority in deciding whether a foreign filing licence is granted or not?

As a rule, foreign filing licences are granted for countries with which the Federal Republic of Germany has a respective secrecy agreement (see Section II.B.1.1). However, examination is performed on a case-by-case basis.

II.B.8 Penalties

II.B.8.1 If an invention is subject to secrecy protection, what penalties are imposed on applicants or inventors for divulging any information regarding the invention to other countries?

Penalty of imprisonment or a fine according to Sections 94 et seq. of the German Criminal Code [GPTO leaflet].

II.B.8.2 If an invention is subject to secrecy protection, what penalties are imposed on applicants not complying with first filing and/or foreign filing licences requirements?

Penalty of imprisonment or a fine [§ 52(2) PatG].

II.B.9 Which regulations apply to inventions that are made in different countries, e.g., by means of cooperations between nationals of different countries, in particular if these countries have conflicting regulations regarding first filing requirements and/or foreign filing licences?

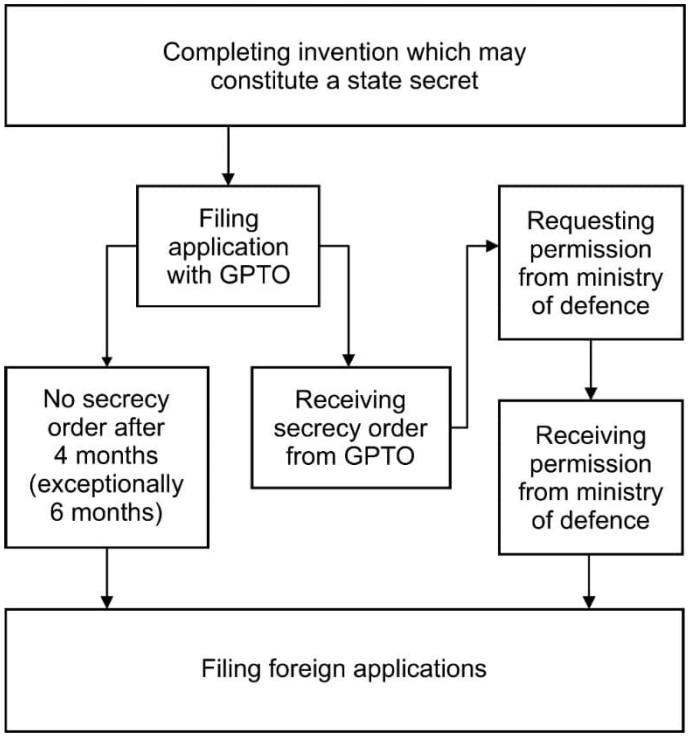
In general, such conflicts between national regulations of different states may not be resolved by law. Only for special cases (e.g., for a joint military project between different states) may regulations exist in the respective intergovernmental agreements. In general, it is therefore advisable to contact the responsible authorities in the respective countries and ask for the necessary procedures in the individual case.

II.B.10 What points of attention should be considered by inventors or applicants, in particular regarding the procedures of filing patent applications and requesting foreign filing licences for inventions subject to secrecy protection?

Any communication regarding an invention that constitutes a state secret must fulfil strict requirements of secrecy protection. In particular, the documents for the subsequent foreign application and the subsequent correspondence with the foreign IP offices, insofar as its content is secret, must be forwarded from government to government via the Federal Ministry of Defence and using diplomatic channels. The applicant should plan for the time-consuming courier routes to avoid any loss of right.

Furthermore, any documents for the subsequent foreign application may only be provided to representatives who are authorized to handle classified information in accordance with the security regulations of their respective countries. The timely appointment of such foreign representatives lies in the responsibility of the applicant.

II.B.11 Flowchart illustrating the procedural order relating to first filing and/or foreign filing licence requirements



II.B.12 Abbreviations

GPTO	German Patent and Trademark Office [*DPMA, Deutsches Patent- und Markenamt*]
BMVg	German Federal Ministry of Defence [*Bundesministerium für Verteidigung*]

II.B.13 Sources

PatG	German Patent Act [*Patentgesetz*]
GebrMG	German Utility Model Act [*Gebrauchsmustergesetz*]
IntPatÜbkG	German Act on International Patent Conventions [*Gesetz über internationale Patentübereinkommen*]
StGB	German Criminal Code [*Strafgesetzbuch*]

GPTO leaflet	German Patent and Trademark Office: Patente und Gebrauchsmuster für Geheimpatente, https://www.dpma.de/docs/patente/geheimschutz.pdf
Schulte	Schulte, R.: Patentgesetz mit Europäischem Patentübereinkommen, 11. Auflage, Carl Heymanns, 2021
Benkard	Benkard, G.: Patentgesetz, 11. Auflage, C. H. Beck, 2015
Mitt. 2018, 50	Pflughoefft, Wolke: Praktische Hinweise zum Umgang mit Geheimpatenten, Mitteilungen der deutschen Patentanwälte 2018, 50

II.C Spain (ES)

II.C.1 What inventions are subject to secrecy protection?

II.C.1.1 General definition

The contents of all patent applications, independently of their field, must be kept secret until one month has elapsed from the date of filing. Before the end of that period the SPTMO can extend it up to four months, if it considers that the invention may be of interest to national defense, notifying the applicant of the extension and immediately making a copy of the application for the patent filed available to the Ministry of Defense, so that it can rule on whether the object of the patent application is of interest to national defense. [§ 111(1)(3) L24/2015; §47(1)(2)(3) RD24/2015].

For the aforementioned purposes, the necessary coordination will be established between the Ministry of Defense and the SPTMO to determine when an invention may be of interest to national defense. The Ministry of Defense has access, if they so wish, to all applications submitted. [§ 111(2) L24/2015; and 47(3) RD24/2015.

If they consider an application of interest, they will request the SPTMO to put it under secrecy [§ 111(3) L24/2015].

The SPTMO, after a favorable report from the Ministry of Defense, may lift the secrecy imposed on an application or on a specific patent. [§ 111(5) L24/2015; § 47(3) RD24/2015].

The patent applications or patents that have been declared secret in a country belonging to the North Atlantic Treaty and that claiming the right of priority are presented in Spain, will be kept secret until said regime has been lifted in the country that declared it. Such patent applications may not be withdrawn without the express permission of the authority which declared the secrecy. [§ 111(6) L24/2015; § 48(1) RD24/201

Since national defense is in continuous evolution, no specific list of technical fields which may be regarded as subject to contain state secrets is contemplated under the Spanish Law. Same will be assessed by the SPTMO and the Ministry of Defense case by case. There are some technological fields more prone to be considered secret (e.g. bullets, guns, etc.) but there is no limitation in Spanish law.

II.C.1.2 May even non-patentable inventions be subject to secrecy protection?

Yes, since an eventual decision to consider a patent application of interest for national defense and thus, to be treated as secret, will be taken prior to perform the technical examination of the invention stating if same complies with patentability requirements.

As mentioned above a patent application declared secret may not be withdrawn – not even if it turns out not to be patentable.

II.C.1.3 Which other IP rights (apart from patents) may be subject to secrecy protection?

Only patent and utility model applications can be put under secrecy by order of the Ministry of Defense. The laws and regulations on trademarks, designs, semiconductor topographies and vegetal varieties do not foresee a special regime to be examined for national defense purposes nor to be put under secrecy.

II.C.2 If an invention subject to secrecy protection has been made, what obligations are imposed on the inventor or applicant?

II.C.2.1 General secrecy obligations

While the patent application or patent is subject to secrecy, the applicant or owner must refrain from any action that may allow unauthorized persons to know the invention. The Ministry of Defense, at the request of the holder, may authorize acts aimed at the total or partial exploitation of the subject matter of the application or patent, indicating the conditions to which such acts will be subject. [§ 111(4) L24/2015].

Intentionally disclosing the contents of an invention declared secret is a criminal offense, punished with up to two years in prison and a fine of 6 to 24 months if it damages national defense [§ 277 of the Criminal Code].

Patent applications or patents subject to secrecy may not be withdrawn, waived, revoked or restricted without the express authorization of the authority that declared the secrecy. [§ 53(1) RD24/2015].

II.C.2.2 Does a first filing requirement apply?

There is a requirement to file first in Spain when the invention was made in our country unless a foreign filing license is obtained by the SPTMO. [§ 50(1)(3) RD24/2015].

In this sense, there are no limitations in Spanish Patent Law on “where to file” based merely on the citizenship of the inventor. The citizenship as such of the inventor is not by itself an essential issue when determining whether a first application should be filed through the SPTMO. The important issue to determine whether a first application should be filed through the SPTMO is if the invention was made in our country and to certain extent, the place of residence of the applicant.

When the applicant has his domicile, registered office or habitual residence in Spain, it will be presumed unless proven otherwise, that the invention was made in Spanish territory. [§ 115(3) L24/2015].

Likewise, in the case of inventions made in Spain and the priority of a previous filing in Spain is not claimed, a patent may not be applied for in any foreign country before the expiration of 1 month, unless it has been done with the express authorization of the SPTMO. [§ 115(1), (2) L24/2015]; [§ 49(1) RD24/2015].

II.C.2.3 Does a foreign filing licence requirement apply?

In the case of inventions made in Spain, the interested party may not file a patent application as a first application abroad, unless expressly authorized by the SPTMO. Likewise, no application can be filed abroad claiming priority from a fist filing at the SPTMO until 1 month has elapsed without the corresponding authorization. The here-concerned authorizations must be requested by the interested party at the SPTMO. [§ 115(1), (2) L24/2015]; [§ 49(1), 50(1)(3) RD24/2015].

If the SPTMO considers that the invention could be of interest to national defense, it will deny authorization to file a first application abroad and notify the interested party. In this case, the authorization will only be granted if the interested party provides express authorization from the Ministry of Defense. [§ 49(2), § 50(4) RD24/2015].

In accordance with the Framework Agreement between France, Germany, Italy, Spain, Sweden, Great Britain and Ireland concerning measures to Facilitate the Restructuring and Operation of the European Defense Industry (Farnborough Agreement), requesting first filing authorization by the Spanish Patent Office to file abroad would not be required if all applicants are resident in one of these countries. A similar exception is contemplated for NATO countries. [SPTMO leaflet].

II.C.2.4 Will an invention that constitutes a state secret be expropriated and transferred to the government?

Any patent or patent application already granted may be expropriated for reasons of public utility or social interest, against fair compensation. [§ 81(1) L24/2015].

The expropriation may be done in order that the invention falls into the public domain and can be freely exploited by anyone, without the need to request licenses (which will not be the case if the public utility is national defense), or in order to be exploited exclusively by the State, which will acquire, in this case, the ownership of the patent. [§ 81(2) L24/2015].

The public utility or social interest shall be declared by the Law ordering the expropriation, which shall provide whether the invention is to fall into the public domain or whether the State is to acquire ownership of the patent or application. The case to be examined shall comply in all respects, including the fixing of the appraisal, with the general procedure laid down in the Law of 16 December 1954 on Compulsory Expropriation. [§ 81(3) L24/2015].

II.C.3 Responsible authorities

II.C.3.1 Which authorities are responsible for examining whether an invention is subject to secrecy protection?

The Ministry of Defense, with the support of the Patent Office. All patent and utility model applications received by the SPTMO are put at the disposal of the Ministry of Defense, so it can decide whether the object of the patent application is of interest to national defense. If he SPTMO considers that the application might be of interest it will specifically point it out to the Ministry of Defense. [§ 111(1)(3) L24/2015; § 47(1)(2)(3) RD24/2015].

The procedures related to patent applications processed in secrecy regime will be recorded in the Registry of Secret Patents, which will only be accessible to authorized personnel in accordance with the current regulations on the protection of classified information of the Ministry of Energy, Tourism and Digital Agenda. [§ 51(2) RD24/2015].

Once the secrecy has been lifted, the SPTMO will continue with the corresponding procedures provided for in Title I of these Regulations. The entries made in the Register of Secret Patents shall be transferred to the SPTMO. [§ 51(3) RD24/2015].

Both patent applications that are in the process of secrecy and those patent applications that have been denied under this form of processing, will keep this regime secret until the Ministry of Defense agrees to lift the secrecy, if it does so. [§ 52(2) RD24/2015].

Secret patents granted during their processing under the secrecy regime shall be kept under the same regime from the date of grant, for automatically renewable years, until the Ministry of Defense communicates the lifting of the secrecy. The SPTMO will then notify the patent holder. [§ 52(2) RD24/2015]. Secret patents do not pay annuities [§ 114 (1) L24/2015].

II.C.3.2 If an invention is subject to secrecy protection, at which authorities must a national patent application containing this invention be filed?

To obtain a Spanish patent or utility model for an invention which constitutes a state secret, a patent or utility model application must be filed with the SPTMO, as any other patent. It is the State who decides if it is to be kept secret, not the applicant.

II.C.3.3 At which authorities must a European patent application containing such an invention be filed?

European patent applications under first filing requirements must be filed with the SPTMO, which will make a copy of the application for the patent filed available to the Ministry of Defense so that it can rule on whether the object of the patent application is of interest to national defense.

II.C.3.4 At which authorities must an international patent application containing such an invention be filed?

International patent applications under first filing requirements must be filed with the SPTMO, which will make available to the Ministry of Defense a copy of the application for the patent filed so that it can rule on whether the object of the patent application is of interest to national defense.

II.C.3.5 At which authorities must a request for foreign filing licences be filed?

Request for foreign filing licenses must be submitted by the interested party to the SPTMO. [§ 50(1) RD24/2015].

If the SPTMO considers that the invention could be of interest to national defense, it will deny authorization to file a first application abroad and notify the interested party. [§ 49(2), § 50(4) RD24/2015].

II.C.4 Is there any compensation for the applicant in the event of restrictions due to secrecy protection?

II.C.4.1 Amount of compensation

Secret patents will not be subject to the payment of annuities. [§ 114(1) L24/2015; § 53(2) RD24/2015].

Once the secrecy has been lifted, the owner of the patents must pay the annuities that accrue from the publication of the grant in the Official Gazette of Industrial Property. [§ 53(2) RD24/2015].

The owner of the patent may claim compensation from the State for the time in which it was kept secret. This compensation, which may be claimed for each year elapsed, shall be agreed between the parties. If no agreement is reached, the compensation shall be fixed by the courts, taking into account the importance of the invention and the benefit that the owner could have obtained from the free exploitation of it. [§ 114(2) L24/2015].

II.C.4.2 Conditions for receiving compensation

An applicant, a proprietor of a patent or his successor in title is entitled to compensation from the SPTMO if:

- the application was first filed with the SPTMO;
- the invention constitutes a Spanish state secret;
- a secrecy order was issued by the Ministry of Defense;
- the invention is patentable;
- the invention is not used as a consequence of the secrecy order;
- the non-use of the invention results in a pecuniary loss of the patent holder.

If the invention that is the subject of the secret patent has been disclosed due to the fault or negligence of its owner, the latter shall lose the right to compensation, without prejudice to any criminal liability that may arise. [§ 114(3) L24/2015].

II.C.4.3 At which authorities may compensation be claimed?

The owner of the patent may claim compensation from the State for the time in which it was kept secret. This compensation, which may be claimed at the SPTMO for each year elapsed, shall be agreed between the parties. If no agreement is reached, the compensation shall be fixed by the courts, taking into account the importance of the invention and the benefit that the owner could have obtained from its free exploitation. [§ 114(2) L24/2015].

II.C.5 Requirements for filing a secret patent application or a request for foreign licences

II.C.5.1 Requirements for filing a secret patent application

The same documents must be used for an application including a state secret as for a “normal” patent or utility model application. The applicant does not know, when he applies for a patent, whether it will be declared secret.

II.C.5.2 Requirements for filing a request for foreign licences

A written request including complete information regarding applicant and inventors as well as the text of the invention in Spanish must be submitted with the SPTMO.

II.C.6 Granting of secret patents: When it is determined that a patent application contains an invention subject to secrecy protection, how will the patent application be handled?

II.C.6.1 How is substantive examination performed for applications containing an invention subject to secrecy protection? Will a patent be granted on such applications?

Patent applications subject to secrecy will follow a procedure similar to those not secret, except for disclosure and publication, informing the Ministry of Defense and the holder of the application or his representative of the procedures in any case. [§ 112(1) L24/2015].

While the secrecy regime is maintained, the deadlines due from the publication of the report on the state of the art (namely, submission of a reply to the results of the search and the written opinion as well as requesting technical examination) shall not begin to run until the SPTMO informs the applicant on the possibility of carrying out same. [§ 112(2) L24/2015].

The period for filing opposition against the grant of the patent will not be open until the secrecy regime has been lifted and the grant is published in the "Official Gazette of Industrial Property", if secrecy is at any time actually lifted [§ 112(3) L24/2015].

II.C.6.2 How is access to the patent application and/or the granted patent restricted?

The patent whose grant has been processed in secret will be registered in a Secret Registry of the SPTMO and will be kept under this regime for one year from the date of grant. This term may be renewed annually; the owner of the patent is informed accordingly. [§ 113(1) L24/2015].

The SPTMO may lift the secrecy regime imposed for an application or patent following a favorable report from the Ministry of Defense. [§ 113(1) L24/2015].

II.C.7 Granting of foreign filing licences

II.C.7.1 When the responsible authority receives a request for a foreign filing licence, how will the request be handled? In particular, how long will it take until the request is admitted or rejected?

In accordance with our experience, foreign filing licences are usually granted by the SPTMO within one (1) week from filing the request.

II.C.7.2 Which criteria are applied by the responsible authority in deciding whether a foreign filing licence is granted or not?

When the SPTMO considers that the invention may be of interest to national defense, it will transfer same to the Ministry of Defense and shall not grant the foreign filing license until the Ministry of Defense expressly authorizes it or the interested party provides the SPTMO with a specific authorization issued by the Ministry of Defense. [§ 111(1)(3) L24/2015; § 49(2), 50(4) RD24/2015].

II.C.8 Penalties

II.C.8.1 If an invention is subject to secrecy protection, what penalties are imposed on applicants or inventors for divulging any information regarding the invention to other countries?

Anyone who intentionally disclosed an invention which is the subject to secret regime in contravention of the provisions of Spanish patent law, shall be punished by imprisonment from six months to two years and a fine of six to twenty-four months, provided that this disclosure is detrimental to national defense. [§ 277 LO10/1995].

II.C.8.2 If an invention is subject to secrecy protection, what penalties are imposed on applicants not complying with first filing and/or foreign filing licences requirements?

Apart from penalties as specified under epigraph II.C.8.1, failure to meet this obligation would have the consequence that the corresponding patent would have no effects in Spain. [§ 152(2), 163(2) L24/2015].

II.C.9 Which regulations apply to inventions that are made in different countries, e.g., by means of cooperations between nationals of different countries, in particular if these countries have conflicting regulations regarding first filing requirements and/or foreign filing licences?

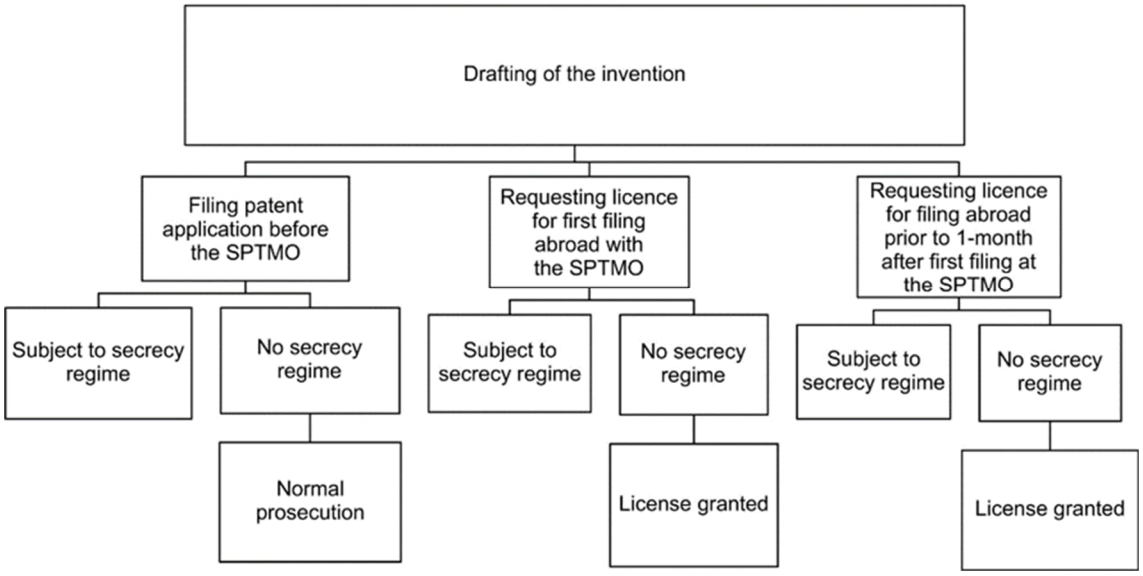
In general, such conflicts between national regulations of different states may not be resolved by the national law of one of the countries involved only. In general, it is therefore advisable to contact the responsible authorities in the respective countries and ask for the necessary procedures in the individual case.

In this sense, as stated under epigraph II.C.2.3, requesting foreign filing authorization before the SPTMO would not be required for applicants which are resident in one of the countries members of Farnborough Agreement or NATO.

II.C.10 What points of attention should be considered by inventors or applicants, in particular regarding the procedures of filing patent applications and requesting foreign filing licences for inventions subject to secrecy protection?

Any communication regarding an invention that constitutes a state secret must fulfill strict requirements of secrecy protection. Furthermore, any documents for patent application filing and/or requesting foreign filing license must only be provided to representatives who are authorized to handle classified information in accordance with the security regulations of their respective countries. The timely appointment of such foreign representatives lies in the responsibility of the applicant.

II.C.11 Flowchart illustrating the procedural order relating to first filing and/or foreign filing licence requirements



II.C.12 Abbreviations

SPTMO	Spanish Patent and Trademark Office [OEPM, *Oficina Española de Patentes y Marcas*]

II.C.13 Sources

L24/2015	Spanish Patent Law [*Ley 24/2015 de 24 julio*]
RD316/2017	Royal Decree for the application of the Patent Law [*Reglamento de Ejecución RD 316/2017 de 31 marzo*]
LO10/1995	Spanish Criminal Law [Ley Orgánica 10/1995, de 23 de noviembre, del Código Penal]

SPTMO leaflet	Spanish Patent and Trademark Office: http://www.oepm.es/es/propiedad_industrial/preguntas_frecuentes/Faq_Ley_24_2015_Invenciones55.html

II.D France (FR)

II.D.1 What inventions are subject to secrecy protection?

II.D.1.1 General definition

Inventions "*likely to be of interest to national defense"* and "*sensitive or allegedly sensitive inventions*", both considered in a broad sense, are subject to secrecy measures.

The scope of inventions "*likely of interest to national defense"* exceeds the field of war materials and is evolutive. An invention made during the course of a public procurement contract notified by the Ministry of the Armed Forces (Ministère des Armées) will for instance be deemed to be of interest to the national defense.

The scope of inventions qualified "*sensitive or presumed sensitive*" encompass those implementing a technology related to defence and security interests. A non exhaustive list of these technologies, without being exhaustive, is found in various legal texts such as:

- An order of 2016 listing war equipments subject to prior export /tranfer authorisations;
- Certain equipments listed in the French code on domestic security;
- The EU Regulation n°388/2012 of April 12, 2012 creating an EU regime of exports controls, brokering and transit of dual use equipments.

The terms and conditions of disclosure and exploitation of these inventions are found in various French laws and administrative texts such as:

- The Penal Code
- The Intellectual Property Code
- The Defense Code (article L2332-6)
- The interministerial instruction n°9062/DN/CAB of February 13, 1973
- The general interministerial instruction on the protection of national defense secrets n°1300/SGDN/PSE/SSD of 30 November 2011.
- The 2017 Guide to the uses of intellectual property in defense security released by the French DGA (Direction Générale à l'Armement)

In addition, the following agreements define the possible conditions for the extension abroad of patent applications that have been the subject of measures prohibiting disclosure and free exploitation:

- NATO Agreement of September 21, 1960 for the mutual safeguarding of the secrecy of inventions and which have been the subject of patent applications,
- Agreement between the Government of the French Republic and the Government of the Kingdom of Sweden of Sweden for the Mutual Safeguarding of the Secrecy of Inventions of Interest to the Defense which have been the subject of patent applications of 15 March 1984.

– "Letter of Intent" signed on 27 July 2000 by Ministry of the Armed Forces with its counterparts in Germany, Spain, Italy, the United Kingdom and Sweden to facilitate the patent protection of classified information based on these international agreements.

II.D.1.2 Which technical fields do such inventions primarily belong to?

Such inventions relate to weapons and war materials but also to materials and goods which may be related notably to:

– nuclear materials;
– special materials and related equipment (including chemical or biological materials listed in EU regulation no. 388/2009);
– materials processing;
– electronics; computers, telecommunications and information
– security, sensors and lasers, navigation and aeroelectronics;
– marine, aerospace and propulsion.

To facilitate the identification by the BPI (IP Office of the Ministry of Armed Forces) of patent applications likely to be of interest for national defense, art L 2332-6 of the French Defense Code compels the companies producing war and/or dual use materials or which require export permits, to declare to the DGA (Direction Générale de l'Armement of the Ministry) the filing of corresponding patent applications within eight days.

II.D.1.3 May even non-patentable inventions be subject to secrecy protection?

For instance, the content of documents describing inventions or designs or sensitive information can be protected by secrecy or restrictive disclosure. A recent publication of an Interministerial instruction n° 1300 of August 9, 2021 updates the level of protection of various sensitive documents distinguishing now 2 levels of classification "Secret and Very Secret".

The French law n°2018-670 of 30 July 2018 on protection of trade secrets also protects commercially valuable scientific information against undue disclosure and use.

II.D.1.4 Which other IP rights (apart from patents) may be subject to secrecy provisions?

French Utility Certificates; possibly certain designs *under design law*.

II.D.2 If an invention subject to secrecy protection has been made, what obligations are imposed on the inventor or applicant?

II.D.2.1 General secrecy obligations

Following receipt of a patent application on an invention likely of interest to national defense, the INPI forwards the patent application for examination to the Intellectual Property Office (BPI) of the Directorate General of Armament (DGA) of the Ministry of Armed Forces which then verifies within 5 months (possibly extended to one year, renewable) whether the invention is of interest for national defense. In any event, the BPI is entitled to consult all patent applications filed with INPI. Furthermore, companies producing war equipments broadly construed must inform the DGA of their patent filing within the 8 following days (art L 2332-6 Defense Code).

If the DGA does not decide that the content of the patent application should remain secret, then the administration sends a disclosure authorization to the applicant or his representative.

On the contrary, if the DGA considers that the invention interests national defense, then the application must be filed exclusively by paper. This is usually the case if the invention:

- stems from the performance of a contract approved by the Ministry of Defense, or concerns a sensitive area, or is covered by the secrecy of a foreign government;
- is a sensitive or presumably sensitive invention.

II.D.2.2 Does a first filing requirement apply?

First filing outside France, of a patent application likely to be of interest for the French National defense or which is sensitive or likely sensitive, must be either (i) beforehand authorized by the French BPI (IP Bureau of the DGA) or (ii) is possible if the applicant is a French national or resident and the invention was partly realized in one of the 5 other countries which signed the Letter of Intent (Germany, Spain, Italy, United Kingdom, Sweden). However, the procedures for communicating the invention and for filing in this country are determined in this case by the BPI.

II.D.2.3 Does a foreign filing license requirement apply?

A patent application likely to be of interest to the French National defense or which is sensitive or likely sensitive, may be filed outside of France only with the written authorisation of the French Ministry of Defence. The authorisation may be given subject to conditions which depend on the specific context and technology.

II.D.2.4 Will an invention that constitutes a trade secret be expropriated and transferred to the government?

The Ministry of the Armed Forces may:

- at any time by decree, expropriate in whole or in part, for the needs of national defense, inventions which are the subject of patent applications or patents (art L613 - 20 IPC), subject to payment of an indemnity;
- obtain ex officio, at any time, for itself or for a partner, for the needs of national defense, a license for the exploitation of an invention that is the subject of a patent application or patent, whether such exploitation is carried out by itself or on its behalf. (art L 613-19 of the IP code).

The ex officio license shall be granted at the request of the Minister responsible for defense by order of the Minister responsible for industrial property. The said order shall lay down the conditions of the license (art L 613-19 IP code). The amount of royalties shall be set by the court if it is disputed.

II.D.3 Responsible authorities

II.D.3.1 Which authorities are responsible for examining whether an invention is subject to secrecy protection

The main authority is the Ministry of Armed Forces which enjoys specific prerogatives with respect to patents of interest to national defense: (i) taking cognizance of all deposits; (ii) prohibition of disclosure and free exploitation; (iii) granting of an ex officio license and (iv) expropriation.

Art. R. 612-26 of the IP code provides that *"Delegates of the Minister of Defense, specially empowered for this purpose and whose names and capacities have been brought to the attention of the Director of the National Institute of Industrial Property and of the Minister in charge of industrial property by the "Minister of Defense", shall take cognizance on the premises of the National Institute of Industrial Property of the patent applications filed including where they are filed in the form of a provisional application, and where appropriate of any additional documents submitted as long as the authorization provided for in Article L. 612-9 has not been obtained".*

"These shall be presented to them within a period of fifteen days from the date of their receipt at the National Institute of Industrial Property". -

During this period, the patent application cannot be passed on to any third party and the applicant cannot implement the invention unless with explicit authorization.

II.D.3.2 If an invention is subject to secrecy protection, at which authorities must a national patent application containing this invention be filed?

The application must always be filed with the French IP Office (INPI) to obtain a French patent.

II.D.3.3 At which authorities must a European patent application containing such an invention be filed?

If the initial patent application is filed with the French Patent Office, the applicant must wait the decision of the BPI of the French Defense Ministry before filing the application with the EPO.

II.D.3.4 At which authorities must an international patent application containing such an invention be filed?

If the initial patent application is filed with the French Patent Office, the applicant must wait the decision of the BPI of the French Defense Ministry before filing an international application.

If the foreign initial application has been lawfully filed and disclosed abroad, then it is unlikely that the French Defense Ministry will prohibit its disclosure.

If the foreign initial application was prohibited from disclosure on grounds of national defense, then the application in France will not be disclosed until the foreign authority has lifted the secrecy and approved in writing the filing in France.

II.D.3.5 At which authorities must a request for foreign filing licenses be filed?

At the French Intellectual Property Bureau of the French Defense Minister for all inventions interesting national defense.

All communications between France and abroad regarding patent applications prohibited from disclosure must follow strict confidentiality rules and essentially transit through diplomatic channels.

II.D.4 Is there is any compensation for the applicant in the event of restrictions due to secrecy protection?

II.D.4.1 Amount of compensation

Since 2020, pursuant to art L 612-10 of the French IP code, the Ministry of Defense may decide to extend for one renewable year the secrecy of the invention which entitles the

applicant to be paid an indemnity for the damage suffered resulting from the extension. In case of disagreement, the indemnity will be set in court in private hearings. The update of the indemnity may be sought one (1) year after the final judgment setting the initial amount of the indemnity.

For the sake of clarity, the secrecy of the patent application does not prohibit all exploitation of the invention which may be put in practice subject to prior approval of the DGA and to the protection of its secrecy (i.e. strictly personal uses).

II.D.4.2 Conditions for receiving compensation

The DGA (Ministry of Armed Forces) may decide to prohibit the disclosure of the patent application and thus to prevent its publication. The DGA must specify in an administrative order the requested level of classification (Secret or Very Secret), access restrictions and indicate whether foreign extensions are permitted.

II.D.4.3 At which authorities may compensation be claimed?

The compensation must be claimed with the Ministry of Armed Forces.

II.D.5 Requirements for filing a secret patent application or a request for foreign licences

II.D.5.1 Requirements for filing a secret patent application

The initial patent application sent to INPI contains the same documents as a standard patent application, but it is mandatory to submit it on paper to the French IP office whenever it contains sensitive elements or content likely of interest to national defense. Besides, for applications with sensitive content, the applicant must include a letter to the Ministry of the Armed Forces proposing an articulated prohibition of disclosure (based on an instruction from an approved authority, or on a security annex of a public procurement contract, or on the prohibited disclosure of similar devices...).

II.D.5.2 Requirements for filing a request for foreign licences

If the initial application is filed in France for an invention interesting the national defense or deemed sensitive and the applicant intends to file subsequent foreign applications, it is important to schedule these steps taking into account the time necessary for the review of the application by the BPI of the Ministry of Armed Forces.

II.D.6 Granting of secret patents: when it is determined that a patent application contains an invention subject to secrecy protection, how will the patent application be handled?

II.D.6.1 How is substantive examination performed for applications containing an invention subject to secrecy protection? Will a patent be granted on such applications?

The application will be screened by the French IP Office and reviewed by the Delegates of the Minister of Defense, specially empowered for this purpose and whose names and capacities have been brought to the attention of the Director of the National Institute of Industrial Property and of the Minister in charge of industrial property by the Minister of Defense.

II.D.6.2 How is access to the patent application and/or the granted patent restricted?

Access to the patent application is limited to INPI personal and specific persons from the Ministry of Armed Forces.

II.D.7 Granting of foreign filing licenses

II.D.7.1 When the responsible authority receives a request for a foreign filing license, how will the request be handled? In particular, how long will it take until the request is admitted or rejected?

When the patent application is filed in the foreign country of origin and if disclosure has been authorized, the Defense Ministry can no longer ensure confidentiality of said patent.

When the extension in France of a patent application is prohibited from disclosure in the country of first filing, the French Defense Ministry could exercise its control in principle.

The management of the priority of the filings is complex and does not always allow the Ministry of the Armed Forces to impose on due course the confidentiality of the invention.

II.D.7.2 Which criteria are applied by the responsible authority in deciding whether a foreign filing licence is granted or not?

As a general rule, foreign filing licenses are granted in countries where both countries cooperate and have similar standards for protection of business secrecies.

II.D.8 Penalties

II.D.8.1 If an invention is subject to secrecy protection, what penalties are imposed on applicants or inventors for divulging any information regarding the invention to other countries?

The penal code (art 413- 10 & 11) provides for very heavy penalties (min 5 years' jail and heavy fines) for the disclosure, destruction, misappropriation, subtraction, reproduction of a national defense secret. The attempt of these same acts is punished by the same penalties (art 413-12 penal code).

II.D.8.2 If an invention is subject to secrecy protection, what penalties are imposed on applicants not complying with first filing and /or foreign filing licenses requirements?

See above.

II.D.9 Which regulations apply to inventions that are made in different countries, e.g., by means of cooperations between nationals of different countries, in particular if these countries have conflicting regulations regarding first filing requirements and/or foreign filing licences?

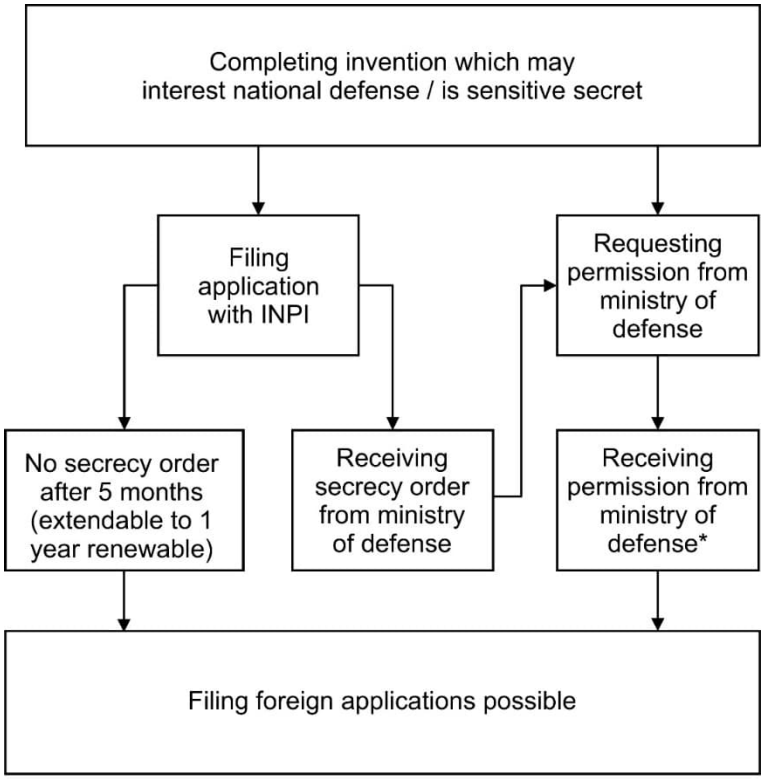
International cooperation in R&D matters involving diverse skills, profiles and nationalities and often different territories compels a careful analysis of international patent laws and a thorough analysis and planification of expected work product and corresponding regulations. Contract law allows to define the legal cooperation structure fit for successful results. Planification is key.

II.D.10 What points of attention should be considered by inventors or applicants, in particular regarding the procedures of filing patent applications and requesting foreign filing licences for inventions subject to secrecy protection?

The red flags concern mainly:

- the definition and compliance with the confidentiality protocol applying to documentation and individuals,
- the need to plan long in advance the filing strategy: localization of the valuable workforce and output, management of filing dates, comparing procedural and practical aspects of protection of trade secrets/ national defense secrets, ownership of results and inventory of most convenient countries, organizing the substantial correspondence with IP offices and national defense authorities and their authorized agents.

II.D.11 Flowchart illustrating the procedural order relating to first filing and/or foreign filing licence requirements



* Permission will likely not be granted unless applicant is French national or resident and invention was partly realized by one LOI country

II.E Italy (IT)

II.E.1 What inventions are subject to secrecy constraint?

II.E.1.1 General definition

Objects which would be (i) either eligible for a patent, utility model or semiconductor topography protection or (ii) intended for an exhibition within the Country and, additionally, which could be useful for the defence of the Country, are subject to secrecy constraints [§ 198 IP Code]. No specific definition is given for what is considered "useful for the defence".

Moreover, upon request of a foreign Country applying reciprocity of treatment, secrecy constraint also applies to patent applications already filed abroad and which are kept secret by said foreign Country [§ 198(9) IP Code].

Exceptions to the general principle of secrecy constraint are provided in relation to invention made under intergovernmental agreements or treaties that oblige reciprocal secrecy. Especially relevant examples for such agreements are the NATO Agreement on Safeguarding Defence-Related Inventions, the Euratom Treaty, "Accordo Quadro" signed in Farnborough on 27 July 2000 and ratified on 26 June 2003 between Italy and France, Germany, Spain, Sweden, United Kingdom and Ireland, plus various bilateral agreements.

II.E.1.2 Which technical fields do such inventions primarily belong to?

Applications from the following technical fields are primarily subject to secrecy constraint [Defence Leaflet]:
MR – multifunctional radar
AM – nanotechnologies
C4I – control, communication, IT
S – sensors
ELT – electronics
NBC – defence and personal protection
S&P – structures and platforms
P – propulsion
H&B – hydrodynamic and ballistics
PB – ballistics protection and advanced materials
EX – explosives
M – microelectronics
UAV&UCAV – unmanned vehicles and robotics
ST – satellite technology.

II.E.1.3 May even non-patentable inventions be subject to secrecy protection?

Yes, since rules apply before the application is examined/granted. Even objects intended to be exhibited at exhibitions are subjects to these rules [§ 198(17-21) IP Code].

II.E.1.4 Which other IP rights (apart from patents) may be subject to secrecy constraint?

Only patent, utility model and semiconductor topographies are subject to secrecy constraint. Trademark and design applications are not subjects to these rules.

II.E.2 If applicants completed inventions eligible as "useful for the defence", what obligations shall be imposed on the applicants? If applicable, specify restrictions.

II.E.2.1 General obligations upon applicants

Subjects who/which are under the obligations to comply with secrecy constraints are (i) residents in Italy (ii) having a right to the patent [R. 45 IP Code Rules]. Accordingly, inventions made by inventors residing abroad who, however, have obligation to assign (for example under labour law) to residents in Italy, are under the obligation to respect secrecy constraints.

Said subjects cannot file exclusively before foreign Offices or European Patent Office or WIPO as receiving office, their applications for patent, utility model or semiconductor topography if they include objects useful for the defence of the Country. Said subjects cannot even file such foreign applications before 90 days either from the application date in Italy (at the Italian Patent Office acting either as national authority or receiving office for EPO/WIPO) or from the request of a foreign filing license. If 90 days have been passed without any order to keep secret the object of the application, an authorization to file abroad shall be considered implicitly granted.

If said object is considered useful for the defence of the Country, the Defence Administration can request deferment of publication and granting of the application. Within 8 months the Defence Administration can request an additional deferment for a period not exceeding 3 years (1 year for utility models and even more then 3 years for applications already filed abroad and upon request of a foreign Country under reciprocity agreement) since the filing date: in such a case the inventor or its successor in title has a right to a compensation defined under the general rules of expropriation [A. 141-143 IP Code].

The applicant is also bound by the obligation not to disclose the object useful to the defence of the Country both if the application is expropriated and if the application is allowed to proceed to grant under secrecy constraint [R. 45(6) and A. 198(12, 16) IP Code]. Violation of this obligation is punished under criminal law [A. 262 of the Criminal Code].

The subject having a right to the patent can also decide to file the application before the military patent service submitting a proposal for a secrecy classification level. After granting of the correct secrecy level - if the application is not expropriated - the applicant can file, through the military patent service, corresponding foreign (classified) applications in the Countries allowing reciprocity. [R. 45(7) IP Code]

II.E.2.2 Secrecy obligations for third parties

State secrets – both domestic and foreign – are to be made accessible only to a limited group of persons. Only those persons may gain knowledge of the so-called classified information for whom it is indispensable for compelling professional reasons. This limited group of persons, which also includes patent attorneys, must undergo a security check by the Italian domestic intelligence services which can issue a special authorization [NOSI certificate].

All the people who had access to applications or documents relating to patents or who received information thereabout due to their role in the Office, are bound to the secrecy constraint [A. 198(5) IP Code]

Handling state secrets requires special care, since violations constitute criminal offenses under Italian Criminal Law.

II.E.2.3 Does a first filing requirement apply?

Yes, an application which includes objects useful for the defence of the Country shall be filed first with the Italian PTO, either as a national application or EP/PCT application (through the Italian PTO as receiving Office).

The military patent service quickly examines the application for a security check and (i) either release the application for examination by the Italian PTO or (ii) issues a secrecy order.

II.E.2.4 Does a foreign filing licence requirement apply?

An application containing an object useful for the defence of the Country may be first filed outside of Italy only if a foreign filing license has been granted by the military patent service.

The foreign filing license is granted either explicitly (which is the standard procedure) or implicitly if the request for foreign filing license is filed and no answer is received after 90 days from the filing date [A. 198(1) IP Code].

II.E.2.5 Can an invention that constitutes an object useful for defence of the Country be expropriated?

Yes. If the application is expropriated [A. 198(22) IP Code] the general rules on expropriation and reasonable compensation apply.

II.E.3 Responsible authorities

II.E.3.1 Which authorities are responsible for examining whether an invention is subject to secrecy protection?

All applications received by the Italian PTO are immediately forwarded to the military patent service [A. 198(3) IP Code]. If the military patent service considers that any application is regarding an object to be submitted to secrecy constraint, it so informs the Italian PTO accordingly, which issues a secrecy order to the applicant.

The secrecy order is issued within a time limit of 90 days. If, after this period, no decision has been issued by the Italian PTO, the applicant can assume that the application does not include an object useful for the defence of the Country.

II.E.3.2 At which authorities must a European patent application containing such an invention be filed?

European patent applications which may contain an object useful for defence of the Country must be filed with the Italian PTO as receiving office, which involves the military patent service for advice. If the application actually falls within the secrecy constraint, the Italian PTO orders that the application shall not be forwarded to the EPO.

The direct filing of a patent application containing an object useful for the defence of the Country with the European Patent Office is punishable as a criminal offense at least with a penalty fee not below 77,47 euro or arrest [A. 198(2) IP Code].

Divisional European applications are not subject to the above restriction, if at least 90 days have been passed since the filing date of the parent application and no secrecy order has been issued (R. 45(3) IP Code].

II.E.3.3 At which authorities must an international patent application containing such an invention be filed?

International patent applications which may contain an object useful for defence of the Country must be filed with the Italian PTO as receiving office, which involves the military patent service for advice. If the application actually falls within the secrecy constraint, the Italian PTO orders that the application shall not be forwarded to the WIPO.

The direct filing of a patent application containing an object useful for the defence of the Country with the WIPO is punishable as a criminal offense at least with a penalty fee not below 77,47 euro or arrest [A. 198(2) IP Code].

II.E.3.4 At which authorities must a request for foreign filing licences be filed?

At the Italian PTO.

II.E.4 Is there any compensation for the applicant in the event of restrictions due to secrecy protection?

II.E.4.1 Amount of compensation

There is no specific rule for compensation under a secrecy order. General rules under A. 141-143 IP Code apply. The amount of compensation is generally established based on "market value" of IP right, having also considered an opinion of the Board of Appeal. Arbitration is allowed if the applicant is not satisfied of the compensation decided by the Italian PTO [A. 143(1) IP Code].

A reasonable compensation is also allowed to the applicant if priority right is lost owed to delays in handling consideration of secrecy/expropriation order by the Office [A. 143(2) IP Code].

II.E.4.2 At which authorities may compensation be claimed?

The claim for compensation must be filed with the Ministry having issued the order for expropriation, i.e. the Ministry of Defence.

II.E.5 Requirements for filing a secret patent application or a request for foreign licences

II.E.5.1 Requirements for filing a secret patent application

The same documents must be used for an application including object useful for defence as for a "normal" application.

II.E.5.2 Requirements for filing a request for foreign licences

A written request including either the real application intended to be filed abroad (with its Italian translation) or an enhanced abstract (including drawings and claims).

II.E.6 Granting of secret patents: When it is determined that a patent application contains an invention subject to secrecy protection, how will the patent application

be handled at the authorities?

II.E.6.1 How is substantive examination performed for applications containing an invention subject to secrecy protection? Will a patent be granted on such applications?

Substantive examination (for national applications) is performed by the Examining Division in the same way as for “normal” applications, except that:

- deferment of publication/grant would imply longer examination time,
- search report (which is usually issued by the EPO on behalf of the IPTO) may not be established in the usual way, if at all.

If the invention is found patentable, a patent will be granted (but not published, until the secrecy order is lifted).

II.E.6.2 How is access to the patent application and/or the granted patent restricted?

If a secrecy order is issued by the Italian PTO, the patent application will not be published. Granted patents for which a secrecy order exists are entered in a special register and are also not disclosed. Furthermore, in this case, the Italian PTO only grants inspection of files under certain conditions.

When the secrecy order is lifted [A. 198(13) IP Code], the patent application or patent can be published.

II.E.7 Granting of foreign filing licences

II.E.7.1 When the responsible authority receives a request for a foreign filing licence, how will the request be handled? In particular, how long will it take until the request is admitted or rejected?

From our experience, the process of examining the request and issuing foreign filing license usually takes around 2-6 weeks. Accordingly, the request for foreign filing licence should be filed with sufficient advance time with respect to the intended filing date of the application abroad.

II.E.7.2 Which criteria are applied by the responsible authority in deciding whether a foreign filing licence is granted or not?

As a rule, foreign filing licences are granted only if the object is not considered to be useful for the defence of the Country. Exception to this principle applies only for applications to be filed in Countries bound to the agreement 'Accordo Quadro' signed in Farnborough on 27 July 2000.

II.E.8 Penalties

II.E.8.1 If an invention is subject to secrecy protection, what penalties are imposed on applicants or inventors for divulging any information regarding the invention to other countries?

Penalty provides imprisonment or a fine according to A. 198 of IP Code and A. 262 of the Italian Criminal Law.

II.E.8.2 If an invention is subject to secrecy protection, what penalties are imposed on applicants not complying with first filing and/or foreign filing licences requirements?

Penalty provides imprisonment or a fine [see above].

II.E.9 Which regulations apply to inventions that are made in different countries, e.g., by means of cooperations between nationals of different countries, in particular if these countries have conflicting regulations regarding first filing requirements and/or foreign filing licences?

In general, such conflicts between national regulations of different states may not be resolved by law. Only for special cases (e.g. for a joint military project between different states) may regulations exist in the respective intergovernmental agreements. In general, it is therefore advisable to contact the responsible authorities in the respective countries and ask for the necessary procedures in the individual case. It is advisable to request foreign filing license in both countries involved, because even the law in each country may entail different parameters (invention made by resident applicant, invention made by resident inventor, invention made on the territory of the Country,...)

II.E.10 What points of attention should be considered by inventors or applicants, in particular regarding the procedures of filing patent applications and requesting foreign filing licences for inventions subject to secrecy protection?

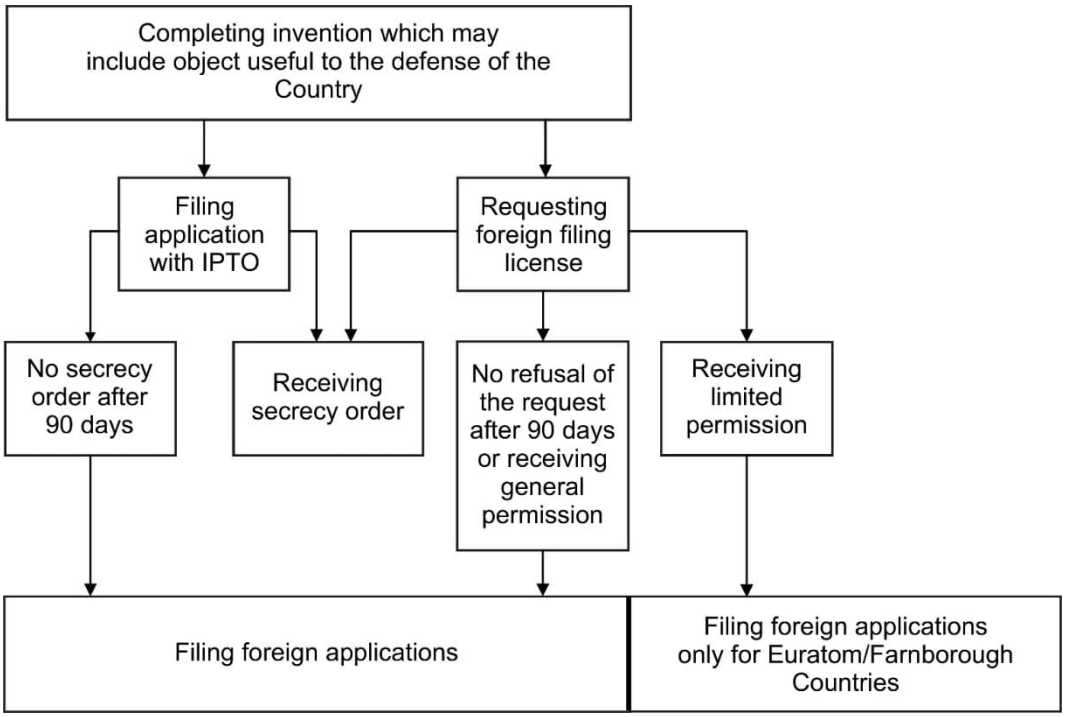
First of all, if any subject involved in the development and exploitation of an invention is residing in Italy, care shall be taken any time the object of the invention is intended to be exhibited at an exhibition or included in a patent/utility model/topography application abroad.

A preliminary check shall be done to consider whether said object could be useful for the defence of the Country. In the affirmative, a request for foreign filing license should be timely filed.

If it is already well clear (for example because of previous similar applications having been submitted to secrecy orders) that said object is useful for the defence of the Country,

it is advisable to involve professionals who are allowed to handle classified information for taking care of the prosecution of the application.

II.E.11 Flowchart illustrating the procedural order relating to first filing and/or foreign filing licence requirements



II.E.12 Abbreviations

IPTO	Italian Patent and Trademark Office [UIBM, Ufficio Italiano Brevetti e Marchi]

II.E.13 Sources

IP Code Articles	“Decreto legislativo 10 febbraio 2005, n. 30” and subsequent updates
IP Code Rules	“Decreto 13 gennaio 2010, n. 33” and subsequent updates
Defence Leaflet	https://www.difesa.it/InformazioniDellaDifesa/periodico/periodico_2014/Documents/R3_2014/04_15_R3_2014.pdf
Military Patent Service	https://www.difesa.it/SGD-DNA/Staff/Reparti/V/Pagine/BrevettiePropriet%C3%A0Intellettuale.aspx
NOSI Certificate	Special authorization to handle classified information

(https://ucse.sicurezzanazionale.gov.it/portaleucse.nsf/AbilitazioniSicurezza.xsp)

II.F The Netherlands (NL)

II.F.1 What inventions are subject to secrecy protection?

Inventions in the field of defense technology, such as armor, ammunition, radar, (de)coding, as well as in the field of nuclear energy technology, such as enrichment equipment, and security technology, for example, may be kept secret *in the interest of the defense of The Netherlands or its allies*. There is no exhaustive list of such inventions.

II.F.2 If an invention subject to secrecy protection has been made, what obligations are imposed on the inventor or applicant?

II.F.2.1 Does a first filing requirement apply?

As far as a European patent application is concerned, an applicant being a national of The Netherlands or residing or being established in The Netherlands, who knows or should reasonably know that the contents thereof should be kept secret in the interest of the defense of The Netherlands or its allies, must file such application with the Dutch Patent Office instead of the European Patent Office. Such applications usually concern defense technology, nuclear technology et cetera. Reference is made to article 46 of the Dutch Patent Act.

As far as a Dutch national application is concerned, the Dutch Patent Office may be of the opinion that the secrecy of the contents of such patent application may be in the interest of the defense of The Netherlands or its allies. The Minister of Defense may give directions to the Dutch Patent Office on whether or not there is such an interest. Reference is made to article 40 of the Dutch Patent Act.

II.F.2.2 Does a foreign filing licence requirement apply?

In The Netherlands there are no legal provisions regarding foreign filing licenses in case of patent applications the contents whereof should be kept secret in the interests of the defense of The Netherlands or its allies.

II.F.3 Responsible authorities

The Dutch Patent Office in cooperation with the Minister of Defense is responsible for judging whether or not the contents of a patent application may be in the interest of the defense of The Netherlands or its allies, as well as for the subsequent handling of such patent application.

II.F.4 Is there any compensation for the applicant in the event of restrictions due to secrecy protection?

Any person whose patent application has become subject to the above procedure shall, at his request, be awarded compensation by the Dutch State for any damage he has sustained through the enforcement of these legal secrecy provisions. The amount of the compensation shall be determined on the termination of the suspension. If, however, the term of suspension has been extended, the amount of the compensation shall be determined, at the request of the applicant, in installments, the first relating to the period prior to the commencement of the first extension, the next to the period between two successive extensions and the last to the period from the commencement of the last extension to the termination of the suspension; the amounts shall be determined upon expiration of the relevant periods. The amount of the compensation shall be determined, if possible, by mutual consent between the Minister of Defense and the applicant. If no agreement has been reached within six months from the date of the expiry of the period to which the compensation relates, the Dutch Court in The Hague would decide. Reference is made to article 42 of the Dutch Patent Act.

II.F.5 Granting of secret patents: When it is determined that a patent application contains an invention subject to secrecy protection, how will the patent application be handled?

If the Dutch Patent Office is of the opinion that the secrecy of the contents of a patent application may be in the interest of the defense of The Netherlands or its allies, it shall notify the applicant thereof as soon as possible, but no later than three months from the date of filing of the application. At the same time as the notification is sent, the Dutch Patent Office shall send a copy thereof and of the description and drawings pertaining to the application to the Minister of Defense. The entry of the application in the patent register shall be suspended. Reference is made to article 40 of the Dutch Patent Act.

Within eight months of the filing of a patent application as referred to above, the Minister of Defense shall notify the Dutch Patent Office whether the contents of the application are to be kept secret in the interest of the defense of The Netherlands or its allies. Notification in the affirmative shall have the effect of suspending the entry of the application in the patent register for a period of three years from the date of notification of said decision. Notification in the negative shall terminate such suspension. The absence of any notification shall be treated as a notification in the negative. The Minister of Defense may extend the term of suspension within six months preceding its expiry for periods of three years at a time by notifying the Dutch Patent Office that the contents of the application are to be kept secret in the interest of the defense of The Netherlands or its allies. The Minister of Defense may at any time notify the Dutch Patent Office that the contents of the application need no longer be kept secret. Such a notification shall terminate the suspension. The Dutch Patent Office shall inform the applicant without

delay of any notification mentioned above. The Dutch Patent Office shall also inform the applicant without delay of the absence of any notification as referred to above. For as long as the suspension has not been terminated the Dutch Patent Office shall send the Minister of Defense, at his request, copies of all the relevant documents exchanged between the Dutch Patent Office and the applicant. If the suspension ends, the application shall nevertheless not be entered in the patent register until a period of three months has elapsed, unless the applicant requests otherwise. Reference is made to article 40 of the Dutch Patent Act.

II.F.6 Granting of foreign filing licences

In The Netherlands there are no legal provisions regarding foreign filing licenses in case of patent applications the contents whereof should be kept secret in the interests of the defense of The Netherlands or its allies.

II.F.7 Penalties

II.F.7.1 If an invention is subject to secrecy protection, what penalties are imposed on applicants or inventors for divulging any information regarding the invention to other countries?

Article 98 of the Dutch Penal Code applies (imprisonment or fine).

II.F.7.2 If an invention is subject to secrecy protection, what penalties are imposed on applicants not complying with first filing and/or foreign filing licences requirements?

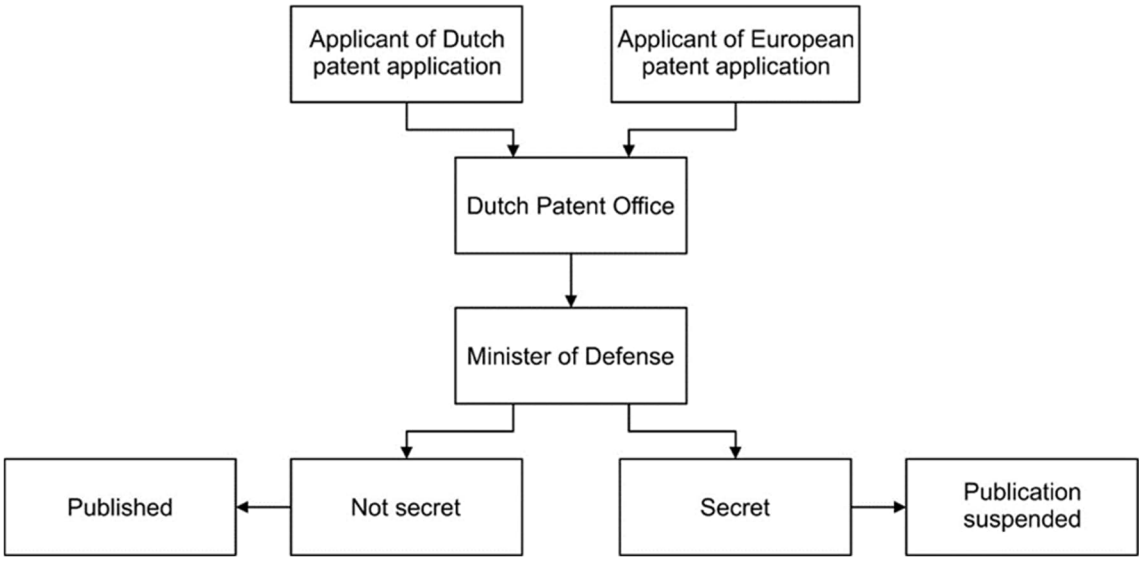
We are not aware of any penalty.

II.F.8 What points of attention should be considered by inventors or applicants, in particular regarding the procedures of filing patent applications and requesting foreign filing licences for inventions subject to secrecy protection?

Where the Minister of Defense is of the opinion that it is in the interest of the defense of The Netherlands for the State to use, put into practice or cause to be used or to be put into practice the subject matter of a patent application referred to above, he may take measures to that effect after notifying the applicant thereof. The notification shall contain a precise account of the acts that the State must perform or cause to be performed. The State shall compensate the applicant for the use or the putting into practice of the subject matter of the application. The amount of this compensation shall be fixed, if possible, by mutual consent between the Minister of Defense and the applicant. If no agreement has been reached within six months following the date of the notification, the Dutch Court in The Hague would decide. Reference is made to article 44 of the Dutch Patent Act.

If an applicant requests that the contents of a patent application be kept secret in the interest of the defense of some other State, or if the government of that State makes such a request, the Dutch Patent Office shall, provided the applicant has stated in writing that he renounces any compensation for damages he might sustain by reason of the enforcement of this provision, send without delay a copy of that request and of the specification and drawings pertaining to the application as well as the aforementioned statement of renunciation to the Minister of Defense. In such a case, the entry of the application in the patent register shall be suspended. In the absence of a statement of renunciation, the Office shall notify the Minister of Defense thereof without delay. Within three months following the date of filing of the request, the Minister of Defense may notify the Dutch Patent Office that the contents of the application are to be kept secret in the interest of the defense of the State concerned, provided that he has ascertained that secrecy has been imposed on the applicant by that State and that the applicant was given permission by the same State to file an application the subject matter of which has been made secret. A notification shall result in the entry of the application in the patent register being suspended until the Minister of Defense notifies the Dutch Patent Office that the contents of the application need no longer be kept secret. Absence of the said notification shall end the suspension. Reference is made to article 43 of the Dutch Patent Act.

II.F.9 Flowchart illustrating the procedural order relating to first filing and/or foreign filing licence requirements



II.G United Kingdom (UK)

II.G.1 What inventions are subject to secrecy protection?

II.G.1.1 General definition

Section 22 and 23 of the UK Patent Act (the Act) cover "Information prejudicial to national security or safety of public", and "Restrictions on applications abroad by UK residents" respectively.

Where an application for a patent is filed under the UK Patents Act or any other treaty or international convention to which the UK is a party and the application contains information the publication of which might be prejudicial to **national security**, the comptroller may give directions prohibiting or restricting publication of that information or its communication. Similarly, if the application contains information the publication of which might be prejudicial to the **safety of the public**, the comptroller may prohibit or restrict the publication of that information or its communication. *(§22 UKPA)*

Further, no person resident in the United Kingdom shall, without written authority granted by the comptroller, file or cause to be filed outside the United Kingdom, an application for a patent for an invention which relates to **military technology** or for any other reasons publication of the information might be prejudicial to national security, or the application contains information the publication of which might be prejudicial to the safety of the public. *(§23 UKPA)*

Arrangements exist between the United Kingdom and certain other countries, notably those in the North Atlantic Treaty Organization, for the mutual safeguarding of patent applications subject to prohibition orders. For filing in these countries, the permission of the UK-IPO should be sought. Under the NATO arrangements it appears to be a precondition for the permission to be granted that an application covering the invention shall have been filed in the United Kingdom. Similar arrangements also exist with a few non-NATO countries. At the present time, countries where it may be possible to file include: Australia, Belgium, Canada, Denmark, France, Germany, Italy, the Netherlands, New Zealand, Norway, Spain, Sweden and the USA. *(§23.09 Cole & Davis, 2016)*

II.G.1.2 Which technical fields do such inventions primarily belong to?

A list of information whose publication the Secretary of State might consider prejudicial to national security can be found at:

https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/307009/p-securitylist.pdf.

The categories include, but are not limited to:

- aircraft design
- anti-submarine warfare
- atomic energy,
- armour and protection devices,
- certain alloys,
- chemical and biological warfare,
- cyphers and codes,
- electronics (e.g. band-width compression techniques, microwave power oscillators and amplifiers and miniature rugged devices useful in shells, rockets and bombs),
- engineering and construction (e.g. assault, defence or demolition devices, bridging, temporary harbours and barriers such as tank traps),
- engines (e.g. gas turbines, ram-jet and rocket motors),
- explosives and propellants,
- fighting vehicles,
- certain infra-red devices,
- radar,
- scientific instruments and computers,
- ships and underwater craft.

(§22.03 Cole & Davis, 2016)

II.G.1.3 May even non-patentable inventions be subject to secrecy protection?

Yes. Section 22 of the Act recites that secrecy protection directions may be put in place if it appears that the application contains information which might be prejudicial to national security or public safety if published. It does not specify that said information must form a patentable invention. *(§22 UKPA)*

II.G.1.4 Which other IP rights (apart from patents) may be subject to secrecy protection?

Section 23 of the act extends to applications for designs and utility models, if such an application can be said to be for "protection of an invention". *(§23.04 Cole & Davis, 2016)*

II.G.2 If an invention subject to secrecy protection has been made, what obligations are imposed on the inventor or applicant?

II.G.2.1 General secrecy obligations

The Comptroller is empowered to give directions if the application contains information that has relevance for national security or the safety of the public to prohibit or restrict publication of information concerning the application, though consent may be sought for

disclosure to specified persons via a "variation order". The directions will also restrict the filing of corresponding applications in other countries. *(§22.03 Cole & Davis, 2016)*

Correspondence concerning applications subject to a prohibition order, and any other matters involving Sections 22 and 23, should be addressed or delivered by hand to the Security Section of the UK-IPO, the documents being enclosed in an envelope clearly marked "For the attention of Room GR70", and being transmitted in accordance with the relevant security classification. Persons delivering such documents should indicate to the receptionist that a Room GR70 filing is required. *(§22.09 Cole & Davis, 2016)*

When a prohibition order is imposed before or within six weeks after filing an application, no details of that application appear either in the Patents Journal or in the register of patent applications. However, if the prohibition order is lifted during the five-year period an entry is made in the register of patent applications, but no entry is made in the Journal. *(§22.09 Cole & Davis, 2016)*

II.G.2.2 Does a first filing requirement apply?

Yes. No person resident in the United Kingdom shall, without written authority granted by the comptroller, file outside the United Kingdom an application for a patent for an invention, unless an application for a patent for the same invention has been filed in the Patent Office not less than six weeks before the application outside the United Kingdom; and either no directions have been given under section 22 in relation to the application in the United Kingdom or all such direction have been revoked. (§23(1) UKPA) This applies if the application contains information which relates to:

- Military technology or for any other reasons publication of the information might be prejudicial to national security;
- Information that might be prejudicial to the safety of the public.

(§23(1A) UKPA)

II.G.2.3 Will an invention that constitutes a state secret be expropriated and transferred to the government?

While the directions are in force the patent will not be granted, however, if the application has been brought into order for grant, the invention can be used for the services of the Crown, and the use is to be treated as though the patent had been granted. *(§22.06 Cole & Davis, 2016)*

II.G.3 Responsible authorities

II.G.3.1 Which authorities are responsible for examining whether an invention is subject to secrecy protection?

Upon receiving an application, the Comptroller is empowered to give secrecy or prohibition orders (directions) if the application contains information that has relevance for national security or for safety of the public. The criteria by which relevance to national security is decided are notified to the Comptroller by the Secretary of State. *(§22.03 Cole & Davis, 2016)*

If such directions are given, the Comptroller shall give notice of the application and of the directions to the Secretary of State. Upon receipt of the notice the Secretary of State shall consider whether the publication or communication of the information in question would be prejudicial to national security or the safety of the public. If the Secretary of State makes such consideration, the Comptroller shall be notified to maintain their directions until they are revoked. If the publication of the application or the publication or communication of that information is deemed to be prejudicial to national security or safety of the public, the Secretary of State shall reconsider that question during the period of 9 months from the date of filing the application and at least once in every subsequent period of 12 months. *(§22(5) UKPA)*

To decide if restrictions shall be applied, the Secretary of State may do the following:

1. If the application contains information relating to the production or use of atomic energy or research into matters connected with such production or use:

    i. inspect the application and any documents sent to the comptroller in connection with it;

    ii. authorize a government body with responsibility for the production of atomic energy or for research into matters connected with its production or use, or a person appointed by such a government body, to inspect the application and any documents sent to the comptroller in connection with it.

2. In any other case, the Secretary of State may inspect the application and any such documents, at any time after (or, with the applicant's consent, before) the end of the period of eighteen months from the declared priority date or, where priority is not claimed, the filing date. *(§22(6) UKPA)*

Where a government body or a person appointed by a government body carries out an inspection which the body or person is authorized to carry out under 1. above, the body

or the person shall report on inspection to the Secretary of State as soon as practicable. *(§22(6) UKPA)*

II.G.3.2 If an invention is subject to secrecy protection, at which authorities must a national patent application containing this invention be filed?

Any matters involving sections 22 and 23, should be addressed or delivered by hand to "The UK-IPO, Room GR70, Concept House, Newport, South Wales NP10 8QQ", where the Security Section of the UK-IPO is located, the documents being enclosed in an envelope clearly marked "For the attention of Room GR70", and being transmitted in accordance with the relevant security classification. Applications and documents to which section 22 applies, or may apply, may also be delivered by hand to the London Office of the UK-IPO during the opening hours of that office, likewise in envelopes marked "For the attention of Room GR70". Persons delivering such documents should indicate to the receptionist that a Room GR70 filing is required. *(§22.09 Cole & Davis, 2016)*

II.G.3.3 At which authorities must a European patent application containing such an invention be filed?

If it is desired to file applications for patents in EPC countries for an invention covered by a prohibition order, an applicant may wish to consider filing an application for a European patent with the Security Section at the UK-IPO, designating the EPC Member States for which a permit has been given, and requesting that the prospective European application should be made subject to a prohibition order under section 22. Such an application will not be forwarded to the EPO and, eventually, a notice of withdrawal will be issued by the EPO. The application may then be converted to national applications under the EPC by a request made (for the United Kingdom) within three months of the date of notice of withdrawal. *(§23.09 Cole & Davis, 2016)*

II.G.3.4 At which authorities must an international patent application containing such an invention be filed?

No formal equivalent conversion procedure to II.G.3.3 exists for international applications filed under the PCT but, in the United States, it is theoretically possible to enter the national phase based on a classified international application by filing a continuation application, provided that the international application had a filing number and date and had designated the United States. Other than in the United States, and the United Kingdom, no formal procedure has been identified for allowing an international application on which a prohibition order is imposed to be converted to a national filing. *(§23.09 Cole & Davis, 2016)*

Although no formal conversion procedure exists for international applications filed under the PCT, it appears possible to achieve the same effect for some countries, including

the United Kingdom. Under the PCT, in the case of a classified international application, the applicant can expect to receive a notification from the receiving office, between the 13th and shortly after the expiry of the 16th month from priority, that the international application is no longer to be treated as such. Before that notice is received, and subject to securing the necessary permits, it appears possible to enter the national phase in those countries designated with whom the United Kingdom has reciprocal security arrangements. *(§23.10 Cole & Davis, 2016)*

II.G.3.5 At which authorities must a request for foreign filing licences be filed?

File a request at the Security Section of the UK-IPO. European and International applications containing material restricted by section 23, must be filed with the International Unit of the UK-IPO. *(§23.02 Cole & Davis, 2016)*

II.G.4 Is there any compensation for the applicant in the event of restrictions due to secrecy protection?

II.G.4.1 Amount of compensation

The payment is to be one considered "reasonable" by the Secretary of State and the Treasury having regard to the "inventive merit" of the invention, as well as its "utility" and "the purpose for which it is designed" and any other relevant circumstances. *(§23.06 Cole & Davis, 2016)*

II.G.4.2 Conditions for receiving compensation

Where the prohibition direction is considered by the Secretary of State to have caused hardship, a payment by way of compensation can be made to the applicant. *(§23.06 Cole & Davis, 2016)*

Where a patent has not been granted for an invention of an employee-inventor because of the subsistence of directions under sections 22 or 23, it would seem that the employee cannot make an application for compensation, even though the employer may well have derived benefit from the patent application brought into order for grant. *(§23.06 Cole & Davis, 2016)*

II.G.4.3 At which authorities may compensation be claimed?

The claim for compensation must be filed with either the Comptroller or the court.

II.G.5 Requirements for filing a secret patent application or a request for foreign licences

II.G.5.1 Requirements for filing a secret patent application

Any matters involving sections 22 and 23, should be addressed or delivered by hand to "The UK-IPO, Room GR70, Concept House, Newport, South Wales NP10 8QQ", where the Security Section of the UK-IPO is located, the documents being enclosed in an envelope clearly marked "For the attention of Room GR70", and being transmitted in accordance with the relevant security classification. Applications and documents to which s. 22 applies, or may apply, may also be delivered by hand to the London Office of the UK-IPO during the opening hours of that office, likewise in envelopes marked "For the attention of Room GR70". Persons delivering such documents should indicate to the receptionist that a Room GR70 filing is required. *(§22.09 Cole & Davis, 2016)*

II.G.5.2 Requirements for filing a request for foreign licences

Clearance may be sought, and is usually obtainable quite quickly, by application to the Security Section of the UK-IPO. A certificate will normally be despatched from Newport the same day; and, if this is not sufficient, enquiry should be made by telephone.

Where application for security clearance for permitted foreign filing is made by post, it is desirable to mark the envelope "For the URGENT attention of Security Section, Room GR70": otherwise, delays have been known to occur. *(§23.08 Cole & Davis, 2016)*

II.G.6 Granting of secret patents: When it is determined that a patent application contains an invention subject to secrecy protection, how will the patent application be handled?

II.G.6.1 How is substantive examination performed for applications containing an invention subject to secrecy protection? Will a patent be granted on such applications?

While secrecy directions are in force, the normal examination procedure is to be followed. However, if the application is for a European patent, it must not be sent to the EPO and, if it is an international application, it must not be forwarded to WIPO or the international searching authority. Information concerning an application for a European patent may be sent to the EPO by the Comptroller, but only if it is his duty so to do.

If the imposition of directions prevents an application for a European patent from being received by the EPO within 14 months from the declared priority date conversion of the European application into national applications is possible, provided that consent to the filing of foreign applications can be obtained. There is no corresponding provision for conversion of an international application which have been prevented from being

received in due time by the International Bureau so that it is then deemed to be withdrawn. *(§22.04 Cole & Davis, 2016)*

II.G.6.2 How is access to the patent application and/or the granted patent restricted?

When a prohibition order is imposed before or within six weeks after filing an application, no details of that application appear either in the Patents Journal or in the register of patent applications. However, if the prohibition order is lifted during the five-year period an entry is made in the register of patent applications, but no entry is made in the Journal. *(§22.09 Cole & Davis, 2016)*

II.G.7 Granting of foreign filing licences

II.G.7.1 When the responsible authority receives a request for a foreign filing licence, how will the request be handled? In particular, how long will it take until the request is admitted or rejected?

Clearance may be sought, and is usually obtainable quite quickly, by application to the Security Section of the UK-IPO. A certificate will normally be despatched from Newport the same day; and, if this is not sufficient, enquiry should be made by telephone. *(§23.08 Cole & Davis, 2016)*

In order to secure protection abroad for an invention in respect of which a prohibition order under section 22 is in force, an approach should be made to the Security Section at the UK-IPO for a permit under section 23 as soon as the proposed filing programme is known. A minimum period of 16 weeks before the desired filing date is suggested. The UK-IPO will provide guidance notes on the requirements for foreign filing together with the required permits. Documents for foreign filing of an application subject to a prohibition order should be transmitted solely through officially recognised, adequately secure communication channels. They should be received by the Ministry of Defence at the address given on the UK-IPO permit at least 14 weeks before the desired filing date. *(§23.09 Cole & Davis, 2016)*

II.G.7.2 Which criteria are applied by the responsible authority in deciding whether a foreign filing licence is granted or not?

While a prohibition order is in force on a United Kingdom application, the filing abroad of corresponding patent applications is not impossible. Arrangements exist between the United Kingdom and certain other countries, notably those in the North Atlantic Treaty Organization, for the mutual safeguarding of patent applications subject to prohibition orders. For filing in these countries, the permission of the UK-IPO should be sought. Under the NATO arrangements it appears to be a precondition for the permission to be granted that an application covering the invention shall have been filed in the United

Kingdom. Similar arrangements also exist with a few non-NATO countries. At the present time, countries where it may be possible to file include: Australia, Belgium, Canada, Denmark, France, Germany, Italy, the Netherlands, New Zealand, Norway, Spain, Sweden and the USA. *(§23.09 Cole & Davis, 2016*)

The UK-IPO will provide guidance notes on the requirements for foreign filing together with the required permits.

II.G.8 Penalties

II.G.8.1 If an invention is subject to secrecy protection, what penalties are imposed on applicants or inventors for divulging any information regarding the invention to other countries?

A person who fails to comply with any direction under this section shall be liable—

(a) on summary conviction, to a fine not exceeding the prescribed sum [£ 1000]; or

(b) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both.

(§22(9) UKPA)

II.G.8.2 If an invention is subject to secrecy protection, what penalties are imposed on applicants not complying with first filing and/or foreign

A person who fails to comply with any direction under this section shall be liable—

(a) on summary conviction, to a fine not exceeding the prescribed sum; or

(b) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both. *(§23(3) UKPA)*

Breach will only lead to a criminal penalty if an applicant (or his/her agent), either of whom is “resident” in the United Kingdom, files an application abroad either initially or without waiting until the six-week period has expired without seeking consent from the UK-IPO for foreign filing of an application when he/she knows, or ought to have known, that the application contains information relating to military technology or which “might” be prejudicial to national security or the safety of the public. Thus, an honestly held and considered view that filing abroad would not contravene the Act absolves a person from criminal penalty even if that view turns out to have been erroneous. *(§23.07 Cole & Davis, 2016*)

II.G.9 Which regulations apply to inventions that are made in different countries, e.g., by means of cooperations between nationals of different countries, in particular if these countries have conflicting regulations regarding first filing requirements and/or foreign filing licences?

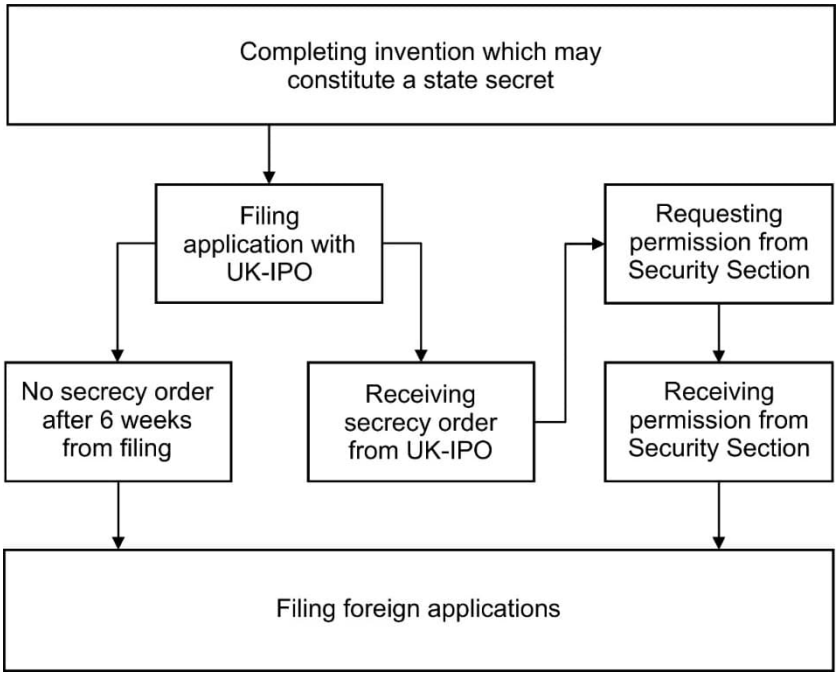
The restrictions also apply in the case of joint inventorship with a non-United Kingdom resident or where a United Kingdom resident seeks to be a co-applicant for a foreign patent application. In the case of a joint application with foreign companies or inventors, compliance with this section of the Act may bring about a conflict between United Kingdom law and equivalent provisions in foreign law, especially those of the United States. In such a situation the Security Section of the UK-IPO may usefully be contacted. *(§23.03 Cole & Davis, 2016*)

The laws of several foreign countries contain similar provisions to those of this section of the Act. This can cause complications when inventions are made jointly by a United Kingdom resident and a resident of some other country which imposes a similar restriction against foreign patent filing without prior clearance through home filing and delay or the grant of a clearance certificate. For example, in the United States there is a six-month prohibition on foreign filing without a clearance certificate. It should be noted that breach of this restriction against prior communication of inventions outside the United States without first filing a United States patent application, or obtaining a foreign filing licence from the United States Patent and Trademark Office, leads to invalidity of the corresponding United States patent. Thus, where an invention is made by an employee of a United States subsidiary of a British company, and it is desired to file the application first in the United Kingdom, or even have a British patent attorney prepare or review the application prior to filing, the precaution should be taken of obtaining an export licence from that Office. *(§23.06 Cole & Davis, 2016*)

II.G.10 What points of attention should be considered by inventors or applicants, in particular regarding the procedures of filing patent applications and requesting foreign filing licences for inventions subject to secrecy protection?

Anyone working on or handling an application that is protectively marked must be cleared to the appropriate level and store the application in an appropriate manner. To handle protectively marked material, you must hold the correct security clearance from United Kingdom Security Vetting. For more information visit https://www.gov.uk/government/organisations/united-kingdom-security-vetting.

II.G.11 Flowchart illustrating the procedural order relating to first filing and/or foreign filing licence requirements



II.G.12 Definitions and Abbreviations

UNITED KINGDOM	includes the Isle of Man (s.132(2)) and the territorial waters of the United Kingdom (s.132(3)) but does not include the Channel Islands.
SECRETARY OF STATE	one of Her Majesty's Principal Secretaries of State. Specifically to these section of the act, the Secretary of State for Defence shall be understood.
UK-IPO	United Kingdom Intellectual Property Office

II.G.13 Sources

UKPA	UK Patents Act 1977
Cole & Davis 2016	Cole, Paul, and Richard Davis. *CIPA Guide to the Patents Acts*. Sweet & Maxwell, 2016.

III Comparison Table

	Is there a first filing requirement for secret inventions?	Is there a foreign filing licences requirement?	At which authorities must a secret (national, European, or international) patent application be filed?	At which authorities must a request for foreign filing licences be filed?
BE	Yes	Not applicable	Belgian Service for Intellectual Property	Not applicable
DE	Effectively yes (otherwise foreign filing will not be authorized)	Yes	German Patent and Trademark Office	German Federal Ministry of Defence
ES	Yes, unless foreign filing license is obtained	Yes	Spanish Patent and Trademark Office	Spanish Patent and Trademark Office
FR	Yes, unless foreign filing license is obtained	Yes	French IP Office	French IP Bureau of the French Ministry of Armed Forces
IT	Yes, unless foreign filing license is obtained	Yes	Italian Patent and Trademark Office (exception for European divisional applications)	Italian Patent and Trademark Office
NL	Yes	Not applicable	Dutch Patent Office	Not applicable
UK	Effectively yes (§23 UKPA)	Yes	United Kingdom Intellectual Property Office	Security section of the United Kingdom Intellectual Property Office

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