AUSTRALIA

Interchange of Patent Rights and Technical Information for Defense Purposes: Filing of Classified Patent Applications

Agreement effected by exchange of notes
Signed at Washington September 13 and October 2, 1961;
Entered into force October 2, 1961.

The Secretary of State to the Australian Ambassador

DEPARTMENT OF STATE
WASHINGTON
September 13, 1961

EXCELLENCY:

I have the honor to refer to the Agreement between the Government of the United States of America and the Government of Australia to Facilitate Interchange of Patent Rights and Technical Information for Defense Purposes, which was signed in Washington on January 24, 1958,[1] and to the discussions between representatives of our two Governments regarding procedures for the reciprocal filing of classified patent applications under the terms of Articles III and VI of this Agreement. I enclose a copy of the procedures prepared during the course of these discussions and agreed to by those representatives.

I am now instructed to inform you that the enclosed procedures have been agreed to by the Government of the United States of America. I would appreciate it if you would confirm that they are also acceptable to your Government. Upon receipt of such confirmation, my Government will consider that these procedures shall thereafter govern the reciprocal filing of classified patent applications, in accordance with the terms of the aforesaid Agreement.

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[1] TIAS 3974; 9 UST 5.

Accept, Excellency, the renewed assurances of my highest consideration.

For the Secretary of State:
EDWIN M. MARTIN

Enclosure:
Procedures.

His Excellency
The Honorable
Sir HOWARD BEALE, K.B.E., Q.C.,
Ambassador of Australia.

PROCEDURES FOR RECIPROCAL FILING OF CLASSIFIED PATENT APPLICATIONS IN THE UNITED STATES OF AMERICA AND THE COMMONWEALTH OF AUSTRALIA

1. General

The following procedures are in implementation of Article III of the Agreement between the Government of the United States of America and the Government of the Commonwealth of Australia to Facilitate Interchange of Patent Rights and Technical Information for Defense Purposes which was signed and entered into force on January 24, 1958.

The purpose of these procedures is to facilitate the filing of a patent application involving classified subject matter of defense interest by an inventor in one country in the other country and to provide adequate security arrangements in each country for the invention disclosed by such application.

These procedures are based upon the following understandings with respect to basic security requirements:

(a) Each Government has authority within its jurisdiction to impose secrecy on or prohibition of publication of an invention of defense interest which it considers to involve classified subject matter.

(b) The authority of each Government, when acting as the originating Government, to impose, modify or remove a secrecy or prohibition order shall be exercised only at the request, or with the concurrence, of a defense official of that Government, or pursuant to criteria established by a defense agency of that Government.

(c) A secrecy or a prohibition order shall apply to the subject matter of an application for a patent or to an invention and

shall prohibit unauthorized disclosure or publication of the same by any person having access thereto.

(d) Adequate physical security arrangements shall be provided in each Government Department, including the Patent Office, handling an invention of defense interest and each person in the Department and Office required to handle such an invention shall have been security cleared.

(e) Each Government shall take all possible steps to prevent an unauthorized foreign filing of a patent application which may involve classified subject matter of defense interest.

(f) Permission for foreign filing of a patent application involving classified subject matter of defense interest shall remain discretionary with each Government.

(g) The recipient Government shall assign to the invention concerned a classification corresponding to that given in the country of origin and shall take effective measures to provide security protection appropriate to this classification.

(h) Where a patent application covered by a secrecy or prohibition order is handled by a patent agent or attorney in private practice, arrangements shall be made for the security clearance of the agent or attorney and for all of their appropriate employees prior to handling such an application or information relating thereto, as well as for adequate physical security measures in his office.

(i) When secrecy or prohibition of publication has been imposed on an invention in one country and the inventor has been given permission to apply for a patent in the other country, a communication with respect to the classified aspects of the invention shall pass through diplomatic or other secure channels.

2. Application Originating in the United States

The following provisions shall apply when, for defense purposes, a United States patent application has been placed in secrecy under the provisions of Title 35, United States Code, Section 181,[1] and the applicant wishes to file a corresponding application in the Commonwealth of Australia:

(a) The applicant shall petition the United States Commissioner of Patents for modification of the secrecy order to permit filing in the Commonwealth of Australia.

(b) Permission to file a corresponding patent application in the Commonwealth of Australia shall be conditional upon the applicant agreeing to:

[1] 66 Stat. 805.

(i) Make the invention involved and such information relating thereto as may be necessary for its evaluation for defense purposes available to the Commonwealth Government for purposes of defense under the conditions set forth in the Agreement of January 24, 1958.

(ii) Waive any right to compensation under the laws of the Commonwealth of Australia for damage which might arise from the mere imposition of a prohibition order on his invention in the Commonwealth of Australia, but reserving any right to institute action for compensation under the laws of the Commonwealth of Australia for use by the Commonwealth Government or for unauthorized disclosure of the invention forming the subject of the patent application.

(c) Upon obtaining permission to file an application for a patent in the Commonwealth of Australia, the applicant shall forward the documents for the foreign application to the defense agency which initiated the secrecy order.

(d) The defense agency shall transmit, through diplomatic channels, the documents received from the applicant, simultaneously, as follows:

(i) One copy to the Head of the Australian Joint Services Staff in the United States for use by the Commonwealth Government for defense purposes; and

(ii) two copies to the appropriate section of the American Embassy in the Commonwealth of Australia.

The letter accompanying the documents to the American Embassy in the Commonwealth of Australia shall (1) indicate the security classification given to the application in the United States, (2) state that the invention concerned and such information relating thereto as may be necessary for its evaluation for defense purposes has been made available to the Commonwealth Government for purposes of defense under the conditions set forth in the Agreement of January 24, 1958, and (3) that the applicant has authority to file a corresponding application in the Commonwealth of Australia under the provisions of Title 35, United States Code, Section 184. It shall also (4) include instructions for the Embassy to inquire of the Secretary of the Department of External Affairs whether the attorney in Australia designated by the applicant is security cleared in accordance with the provisions of subparagraph 1(h) supra.

(e) When a security cleared attorney or agent has been designated, the Embassy shall transmit the documents to him by personal delivery or in any other manner consistent with Commonwealth security requirements. The selected attorney or agent shall then file the application in the Australian Patent Office.

(f) If the designated attorney or agent is not security cleared, the Secretary of the Department of External Affairs shall so inform the Embassy. It shall then be necessary for the designated attorney or agent to become security cleared, if time permits, or for the applicant to select another attorney or agent and submit his name through the Embassy to the Secretary of the Department of External Affairs. If delay in locating a security cleared attorney or agent would result in inadvisable delay in filing the Australian application, the United States Government may, at the request of the applicant, transmit the application to the Australian Patent Office for filing, in a manner consistent with Commonwealth security requirements.

(g) The Commissioner of Patents shall then prohibit the publication of information with respect to the subject matter of the application.

(h) The applicant shall inform as soon as possible the initiating agency of the serial number and filing date of the foreign application.

3. Application Originating in the Commonwealth of Australia

The following provisions shall apply when, for defense purposes, the Commissioner of Patents has made an order under Section 131 of the Patents Act 1952–1955 prohibiting or restricting the publication of information with respect to the subject matter of an application made for the grant of a patent and the applicant wishes to file a corresponding application in the United States of America:

(a) The applicant shall send a written request to the Commissioner of Patents asking for permission to file an application in the United States of America.

(b) Permission to file a corresponding patent application in the United States shall be conditional upon the applicant agreeing to:

(i) Make the invention involved and such information relating thereto as may be necessary for its evaluation for defense purposes available to the United States Government for purposes of defense under the conditions set forth in the Agreement of January 24, 1958.

(ii) Waive any right to compensation under the laws of the United States for damage which might arise from the mere imposition of secrecy on his invention in the United States, but reserving any right to institute action for compensation under the laws of the United States for use by the United States Government or for unauthorized disclosure of the invention forming the subject of the patent application.

(c) Upon obtaining permission to file an application for a patent in the United States, the applicant shall forward to the Secretary of the Department of Supply, three copies of the foreign patent application, all in conformity with Commonwealth security requirements.

(d) The Secretary of the Department of Supply shall transmit, through approved safehand channels, the documents received from the applicant, simultaneously, as follows:

(i) One copy to the appropriate Armed Forces Attache in the American Embassy in the Commonwealth of Australia for use by the United States Government for defense purposes; and

(ii) two copies to the Australian Joint Services Staff in the United States.

The letter accompanying the documents to the Australian Joint Services Staff in the United States shall indicate the security classification given to the application in the Commonwealth of Australia, state that the invention concerned and such information relating thereto as may be necessary for its evaluation for defense purposes has been made available to the United States Government for purposes of defense under the conditions set forth in the Agreement of January 24, 1958 and that the applicant has authority to file a corresponding application in the United States of America. It shall also include instructions for the Australian Joint Services Staff to inquire of the Secretary, Armed Services Patent Advisory Board, Patents Division, Office of the Judge Advocate General, Department of the Army, Washington 25, D.C., whether the attorney or agent in the United States designated by the applicant is security cleared in accordance with the provisions of subparagraph 1(h) supra.

(e) When a security cleared attorney or agent has been designated, the Australian Joint Services Staff shall transmit the documents to him by personal delivery or in any other manner consistent with United States security requirements. The selected attorney or agent shall then file the application in the

United States Patent Office and shall forward to the Secretary of the Armed Services Patent Advisory Board a copy of the application as filed and a copy of the prohibition order issued by the Commissioner of Patents in Australia permitting publication of the application to a class of persons in the United States.

(f) If the designated attorney or agent is not security cleared, the Secretary of the Armed Services Patent Advisory Board shall so inform the Australian Joint Services Staff. It shall then be necessary for the designated attorney or agent to become security cleared, if time permits, or for the applicant to select another attorney or agent and submit his name through the Australian Joint Services Staff to the Secretary of the Armed Services Patent Advisory Board. If delay in locating a security cleared attorney or agent would result in inadvisable delay in filing the United States application, the Commonwealth Government may, at the request of the applicant, transmit the application to the United States Patent Office for filing, in a manner consistent with United States security regulations.

(g) The Government of the United States shall then place the application in secrecy.

(h) The applicant shall inform as soon as possible the Secretary of the Department of Supply of the serial number and filing date of the foreign application.

4. Subsequent Correspondence between Applicant and Foreign Patent Office

(a) All subsequent correspondence of a classified nature between an applicant in either country and the Patent Office in the other country shall be sent through the same Government channels as the original application and accompanying documents were sent.

(b) An unclassified formal notification such as a statement of fees or an extension of time limit may be sent by the Patent Office concerned direct to the applicant or his authorized representative without any special security arrangements.

5. Removal of Secrecy or Prohibition of Publication

(a) A secrecy or prohibition order shall be removed only on the request of the originating Government.

(b) The originating Government shall give the other Government six weeks' notice of its intention to remove the secrecy or prohibition order and shall take into account, as far as possible, any representations made by the other Government during this period.

6. Notification of Changes in Laws and Regulations

Each Government shall give the other Government prompt notice through the Technical Property Committee of any changes in its laws or regulations affecting these procedures.

The Australian Ambassador to the Secretary of State

AUSTRALIAN EMBASSY
WASHINGTON, D.C.
2nd October, 1961

No. 501/61

SIR,

I have the honour to refer to your note of September 13, 1961, concerning discussions which have taken place between representatives of our two Governments regarding procedures for the reciprocal filing of classified patent applications under the terms of Articles III and VI of the Agreement between the Government of the United States of America and the Government of the Commonwealth of Australia to Facilitate Interchange of Patent Rights and Technical Information for Defense Purposes, which was signed in Washington on January 24, 1958.

I confirm that the procedures set out in the enclosure to your note referred to above are acceptable to the Government of the Commonwealth of Australia. It is agreed that henceforth those procedures shall govern the reciprocal filing of classified patent applications in accordance with the terms of the aforesaid Agreement.

Accept, Sir, the renewed assurances of my highest consideration.

HOWARD BEALE

(Howard Beale)
Ambassador

The Honourable
THE SECRETARY OF STATE,
Department of State,
Washington, D.C.

U. S. GOVERNMENT PRINTING OFFICE: 1961

AUSTRALIA

Interchange of Patent Rights and Technical Information for Defense Purposes

Agreement, with exchange of notes,
Signed at Washington January 24, 1958;
Entered into force January 24, 1958.

AGREEMENT TO FACILITATE INTERCHANGE OF PATENT RIGHTS AND TECHNICAL INFORMATION FOR DEFENSE PURPOSES

The Government of the United States of America and the Government of Australia,

Having agreed in the Security Treaty signed at San Francisco on September 1, 1951 to maintain and develop their individual and collective capacity to resist armed attack by means of continuous and effective self-help and mutual aid; TIAS 2493. 3 UST, pt. 3, p. 3420.

Desiring generally to assist in the production of equipment and materials for defense, by facilitating and expediting the interchange of patent rights and technical information; and

Acknowledging that the rights of private owners of patents and technical information should be fully recognized and protected in accordance with the law applicable to such patents and technical information;

Agree as follows:

ARTICLE I

Each Contracting Government shall, whenever practicable without undue limitation of, or impediment to, defense production, facilitate the use of patent rights, and encourage the flow and use of privately owned technical information, as defined in Article VIII, for defense purposes—

(a) Through the medium of any existing commercial relationships between the owners of such patents or technical information or those to whom rights have been ceded by the said owners on the one hand, and the user on the other, whether this user be a private person, a firm or a Government body; and

(b) In the absence of such commercial relationships, by encouraging the parties to enter into them.

However, the commercial relationships referred to in paragraphs (a) and (b) shall not be contrary to security requirements, and their provisions shall remain subject to the applicable laws of each of the Contracting Governments.

ARTICLE II

When technical information is supplied for defense purposes by one Contracting Government to the other, unless otherwise stipulated, the recipient Government shall treat the technical information as supplied for information only and use its best endeavors to insure that the information is not dealt with in any manner likely to prejudice the rights of the owner thereof to obtain patent or other like statutory protection therefor.

ARTICLE III

When technical information made available for purposes of defense by one Contracting Government to the other discloses an invention which is the subject of a patent or patent application held in secrecy in the country of origin, the recipient Government will, to the fullest extent possible under its laws, accord similar treatment to a corresponding patent application to be filed in the recipient country. The Contracting Governments agree to develop appropriate procedures to facilitate the carrying out of this Article.

ARTICLE IV

(a) Where privately owned technical information

(i) has been communicated by or on behalf of the owner thereof to the Contracting Government of the country of which he is a national, and

(ii) is subsequently disclosed by that Government to the other Contracting Government for the purposes of defense and is used or disclosed by the latter Government without the express or implied consent of the owner,

the Contracting Governments agree that, where any compensation is paid to the owner by the Contracting Government first receiving the information, such payment shall be without prejudice to any arrangements which may be made between the two Governments regarding the assumption as between them of liability for compensation. The Technical Property Committee established under Article VI of this Agreement will discuss any

make recommendations to the Governments concerning such arrangements.

(b) When, for the purposes of defense, technical information is made available by a national of one Contracting Government to the other Government at the latter's request and use or disclosure is subsequently made of that information for any purpose whether or not for defense, the recipient Government shall, at the owner's request, take such steps as may be possible under its laws to provide prompt, just, and effective compensation for such use or disclosure to the extent that the owner may be entitled thereto under such laws.

ARTICLE V

(a) When an invention owned by one Contracting Government is used by the other Contracting Government for defense purposes, such use shall, to the extent that no liability is incurred by either Government to any private owner of a proprietary or other legal interest in the invention, be without cost to such other Government.

(b) Whenever either Contracting Government can grant to the other Contracting Government for defense purposes a license to use an invention not covered by (a) above without incurring liability to any private owner of a proprietary or other legal interest therein, it shall do so without cost to such other Government.

(c) Nothing in this Article shall affect any licensing or other agreement already in force at the date of this Agreement or any royalty or other compensation paid or agreed to be paid thereunder.

ARTICLE VI

Each Contracting Government shall designate a representative to meet with the representative of the other Contracting Government to constitute a Technical Property Committee. Each Government shall have the right to appoint special advisors for its representative. It shall be the function of this Committee:

(a) To consider and make recommendations on such matters relating to the subject of this Agreement as may be brought before it by either Contracting Government;

(b) To make recommendations to the Contracting Governments concerning any question, brought to its attention by either Government, relating to patent rights and technical information which arises in connection with the mutual defense program;

(c) To assist, where appropriate, in the negotiation of commercial or other agreements for the use of patent rights and technical information in the mutual defense program;

(d) To take note of pertinent commercial or other agreements for the use of patent rights and technical information in the mutual defense program, and, where necessary, to obtain the views of the two Governments on the acceptability of such agreements;

(e) To assist, where appropriate, in the procurement of licenses and to make recommendations, where appropriate, respecting payment of indemnities covering inventions used in the mutual defense program;

(f) To encourage projects for technical collaboration between and among the armed services of the two Contracting Governments and to facilitate the use of patent rights and technical information in such projects;

(g) To keep under review all questions concerning the use, for the purposes of the mutual defense program, of all inventions which are, or hereafter come, within the provisions of Article V;

(h) To make recommendations to the Contracting Governments, either with respect to particular cases or in general, on the means by which any disparities between the laws of the two countries governing the compensation for or otherwise concerning technical information made available for defense purposes might be remedied.

ARTICLE VII

Upon request, each Contracting Government shall, as far as practicable, supply to the other Government all necessary information and other assistance required for the purposes of:

(a) affording the owner of technical information made available for defense purposes the opportunity of protecting and preserving any rights he may have in the technical information; and

(b) assessing payments and awards arising out of the use of patent rights and technical information made available for defense purposes.

ARTICLE VIII

(a) "Technical information" as used in this Agreement means information originated by or peculiarly within the knowledge of

the owner thereof and those in privity with him and not available to the public.

(b) The term "use" includes manufacture by or for a Contracting Government.

(c) Nothing in this Agreement shall apply to patents, patent applications and technical information in the field of atomic energy.

(d) Except for Article IV (a), nothing in this Agreement shall contravene present or future security arrangements between the Contracting Governments. Nothing in this Agreement shall relieve the nationals of either country from the obligations placed upon them under the internal security laws and regulations of their respective Governments.

ARTICLE IX

(a) This Agreement shall enter into force on the date of signature.

(b) The terms of this Agreement may be reviewed at any time at the request of either Contracting Government.

(c) This Agreement will terminate six months after written notice of termination has been given by either Contracting Government to the other, but without prejudice to obligations and liabilities which have then accrued pursuant to the terms of this Agreement.

IN WITNESS WHEREOF the undersigned, being duly authorized thereto by their respective Governments, have signed the present Agreement.

DONE in duplicate at Washington this twenty-fourth day of January, 1958.

FOR THE GOVERNMENT OF THE UNITED STATES OF AMERICA:
THOMAS C. MANN

FOR THE GOVERNMENT OF AUSTRALIA:
PERCY C SPENDER