

 Intellectual Property Office

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Secure Patents; Information for the insecure...



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Topics covered

- What are 'secret' S22 patents?
- What does the IPO do with S22 patents?
- Living and working work with S22 patents
- Administrative and legal considerations
- Identifying relevant technologies
- Other Defence technology-related issues

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S22 of Patents Act 1977

- Commonly called ‘secure’ or ‘secret’ patents
- Rare – only around 100 applications per year in the UK
- Most Patent Agents/Attorneys will work their entire career without needing to deal with s22
- Awareness still needed, however...

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Why do we have secure patents?

- Patent applications are normally published as a routine part of their processing
- Some disclosures could be ‘damaging’ if technical details of them were made public
- IPO has obligation under the Act to give ‘directions’ prohibiting disclosure of such a patent application (S22 directions or ‘prohibition’)

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Reasons for prohibition

- The patent would be prejudicial to national security – s22(1)



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- The patent would be prejudicial to the safety of the public – s22(2). This is rarely, if ever, used and I will not discuss this further



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What is ‘prejudicial’ to national security?

- The nature of national security means that there are no precise definitions
- It depends on what ‘threatens’ the body politic of the United Kingdom at any given moment
- The nature of world events means that what is considered prejudicial can change over time
- Some technologies, however, will always be problematic

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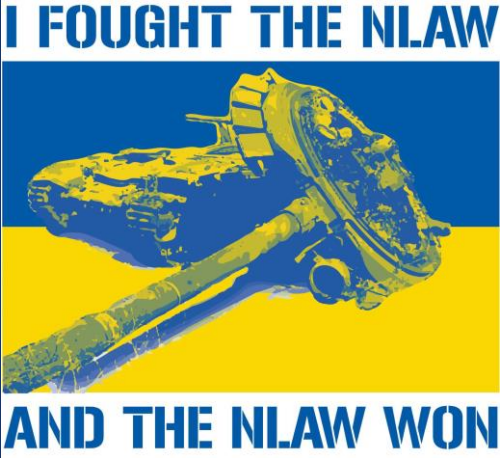
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Some threats are temporary, and may reflect current geopolitical trends and events;





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Others, such as nuclear weapon technologies, are permanent;



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What are S22 directions?

S22(1) & (2) directions are a blanket ban on the disclosure of an application’s content and prohibit;

- the publication of the *information* in the patent application
- the *communication* of that information to any person in any way

- Please note that there is no right to, or mechanism allowing, an appeal about a decision to give S22 directions – s97(1)(c)
- MOD review (discussed later) functions as a surrogate to an appeal process

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Identifying S22 applications

- Every application filed at the IPO - GB, EPC and PCT - is checked by security section Examiners
- All types of filing are checked – paper and electronic
- 4 patent examiners work on a rota system
- Over 30 000 applications per year
- We may miss some – this is where your vigilance and help is necessary!

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The ‘Stop List’

- The Security Section is provided with a guide to technologies that are considered of potential interest by the Ministry of Defence (MOD)
- The full list is classified - and therefore not available to the public or other IPO staff - but a simplified (and unclassified) version is on our website for your reference
- <http://www.ipo.gov.uk/p-securitylist.pdf>
- As a guide, it is defence-related technology - not merely technology ‘suitable for’ military use that **may** be subject to S22 directions (or provisions).

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Secret filings

- Some applicants (normally defence contractors) deal with technology they know will fall within S22
- They will file directly with Security Section, Room GR70, Concept House, Cardiff Road, Newport, NP10 8QQ
- Marked FAO Huw Jones
- Can now also file online at screening@ipo.gov.uk

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Processing S22 applications

- Once subject to S22 directions a patent application is separated out from the normal workstream at the IPO
- The agent/applicant is notified within 6 weeks of filing
- S22 applications are held and processed within Security Section
- The application is searched and examined as normal but will *not* be published or granted while the s22 directions are in force – s22(3)(a)

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MOD Review

- Once identified, an application may be forwarded to MOD for review of the IPO's decision if they request it S22 – S22(5)
- But only 18 months from priority date – S22(6)(b)
- This rarely (never!) happens
- Applicant can, however, ask for early review before 18 months using Form DP2
- MOD may remove the directions –application 'released' and normal processing resumes
- MOD may confirm S22 directions
- Protective marking (more later!) may rise or fall

Protective marking scheme

Since 2014 the following protective markings have been applied as appropriate;

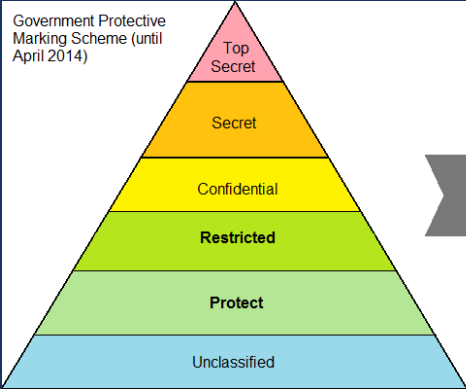
- Official
- Official Sensitive
- Secret
- Top secret
- Other caveats (e.g. "UK Eyes Only") may apply

Documents classified under the old scheme (Protect, Restricted, Confidential, Secret, Top Secret etc.) retain their markings under the old scheme unless or until their protective marking comes up for review.

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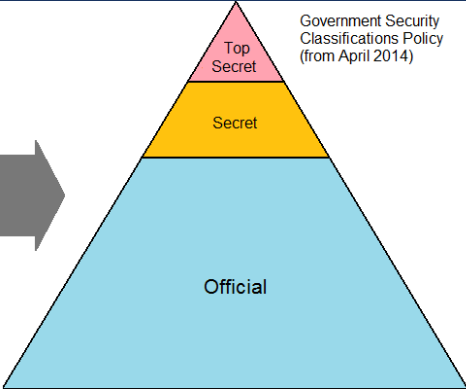
• Old scheme v's current scheme for reference

Government Protective Marking Scheme (until April 2014)





Government Security Classifications Policy (from April 2014)



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Working with secret patents

- 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



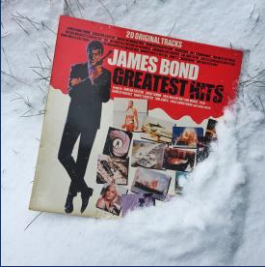
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Security Clearance

- To handle protectively marked material, you **must** hold the correct security clearance from *United Kingdom Security Vetting*; <https://www.gov.uk/government/organisations/united-kingdom-security-vetting>
- There are 3 levels – basic check, Security Check (SC) and Developed Vetting (DV)
- Staff in IPO Security Section hold *at least* SC clearance



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But I'm not cleared!

- If you are not cleared for S22 work, check with your employer's Security Controller to see who is cleared at your practice - *immediately*
- If no one at your practice has clearance to work on S22 material you must contact the IPO so that the application can be transferred to another practice - *immediately*



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Working with us on S22

- All correspondence relating to S22 applications must be sent to us direct by post/courier or fax
- Double enveloped; do not draw attention by writing “TOP SECRET” on the outer envelope...
- Security Section
Room GR70
Concept House
Cardiff Road
Newport
NP10 8QQ
- fax: 01633 814415 (for communication purposes only NOT for new applications)
- Regular online e-filing services must not be used
- *Ever*

- *You can, however apply by email (understanding the security risks thereof) at screening@ipo.gov.uk.*

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How long do directions last?

- S22 directions last indefinitely – oldest are 80 years plus!
- The MOD reconsiders all S22 applications ‘periodically’
- At *any* time the directions can be lifted and the case is ‘released’
- If released with time remaining on the 20 year term, grant can occur – provided all usual requirements have been met
- If there is no time left on the 20 year patent term, the application will still be published for prior art effect once released if it meets the usual requirements
- Some technologies (e.g. Uranium enrichment) are such that applications will never be released from S22 restrictions

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Withdrawal and S22

- An application subject to S22 directions can be withdrawn by the applicant at any time.
- Withdrawal before release prevents publication
- Allows agent and applicant copies and papers to be destroyed
- **Official IPO guidance:** Please withdraw and destroy any and all S22 applications with no patent term remaining or that the applicant has no desire to proceed with

- 1949 Patents Act applications can be withdrawn *even if the sealing fee was paid*.

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Breaching S22

- The most important slide?
- Breach of S22 is a **criminal offence**
- Punishable by up to 2 years imprisonment
- Or a fine
- Or both...



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Variation orders

- s22 directions prohibit *communication of the information* in an application to third parties
- Sometimes communication is essential – the applicant may wish to engage in commercial negotiations etc.
- Variation orders allow this to happen (under agreed terms)



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Compensation?

- What if the applicant suffers hardship because an application is placed under s22 directions?
- The Crown may compensate – s22(7)
- This is *very rare indeed!*
- On the other hand, there is no need to pay renewal fees while s22 applies – s22(8)

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Filing abroad and Section 23

- Governs the ability for United Kingdom **residents** (of **any** nationality) who are **applicants** or **inventors** to file **abroad**.
- **Only** applies to subject matter (military technology, national security, safety of the public) to which S22 directions would apply if a UK patent was filed
- This is *very rare indeed!*
- Applicant must either file in UK and wait six weeks to see if S22 directions are imposed **or else** contact the IPO for written permission to file abroad.
- **REMINDER:** S23 **only** applies to subject matter (military technology, national security, safety of the public) to which S22 directions might apply. There are **no restrictions** on applying abroad for subject matter not related to national security and/or military technology and no need to seek permission.

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Other patent-related issues

- Please be aware of special measures regarding the following:
 - Landmines
 - Cluster munitions
 - Chemical weapons



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Landmines Act

- The Landmines Act 1998 made anti-personnel and ‘booby-trap’ mines illegal in the UK
- Any act to “transfer” prohibited landmine technology (e.g. writing a patent specification) is a **criminal** offense
- The IPO **will not process** any application relating to an anti-personnel mine - they are *immoral* S1(3)



Cluster Munitions Act

- The Cluster Munitions (Prohibitions) Act 2010 makes cluster weapons illegal in the UK
- As with landmines, transfer of knowledge is a criminal offense and the IPO **will not process** any application relating to cluster-munition technology.



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Chemical and biological weapons

- The Chemical Weapons Act 1996 and the Biological Weapons Act 1974 made certain aspects of such weapons illegal in the UK
- Contact Security Section for more information if needed.



Alexander Petrov

Rustan Boshirov

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How can you help?

- If you think a case may be subject to S22 please contact us before filing for advice on best practice
- Remember - it is specific defence-related technology, not technology suitable for military use that attracts S22 provisions – but we’re always happy to chat!
- Don’t hang on to S22 case files if there is no commercial need – you are Patent Attorneys, not the National Archive!

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Summary

- We've had a brief introduction to S22 patents, what they are and how they work
- We've looked at how you as patent professionals work with them - including your legal obligations
- We've briefly looked at what is 'military technology'
- We've had a look at other defence-technology patent issues

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Questions?

- mike.leaning@ipo.gov.uk
- Direct line 01633 813795



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