

# DUBIOUSLY CONSTITUTIONAL, PARTIALLY OBSOLETE: PATENT SECRECY ORDERS AND THE PRIVATE INVENTOR

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## ABSTRACT

*The Invention Secrecy Act of 1951 took World War II national security provisions for classifying patent applications and extended them into times of peace. These secrecy orders prevent the patent applicant from disclosing any information about their invention and theoretically allow for the inventor to request compensation for the ensuing damages. The vast majority of secrecy orders are imposed on government inventors or inventors working on a government contract, but private inventors with no notice about the threat their invention may pose are subject to them as well.*

*This article identifies two main problems with the Invention Secrecy Act: (1) a decrease in efficacy due to increased exceptions for disclosures before filing after the enactment of the America Invents Act in 2013, and (2) potential unconstitutionality through prior restraints on speech and the accompanying procedural due process issues arising from difficulties in getting such arguments in front of the court. This article proposes: (1) decreased disclosure exceptions for inventions falling under the Act with an accompanying increase in notice to inventors on*

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*what sort of inventions are at the most risk of a secrecy order, (2) refined judicial mechanisms for examining a case still under a secrecy order, and (3) preserved standing, like tolling on a statute of limitations, for applicants who cannot bring their First Amendment argument to court before the rescission of their secrecy order.*

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## INTRODUCTION

Gandalf the Grey of Lord of the Rings fame once said “keep it secret, keep it safe,”<sup>1</sup> but how does this principle hold up for a private inventor suddenly and unexpectedly confronted with a secrecy order on their invention that they want to bring into the world?

The Invention Secrecy Act of 1951 took World War II national security provisions for classifying patent

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<sup>1</sup> THE FELLOWSHIP OF THE RING, Amazon Prime, at 26:25–26:30 (New Line Entertainment 2001) (“[K]eep it secret, keep it safe[.]”); EXTENDED EDITION: THE FELLOWSHIP OF THE RING, HBO Max, at 31:54–31:57 (New Line Entertainment 2002) (“[K]eep it secret, keep it safe[.]”); J.R.R. TOLKIEN, THE FELLOWSHIP OF THE RING 40 (2nd ed. 1993) (“[K]eep it safe, and keep it secret!”)

applications and extended them into times of peace.<sup>2</sup> These secrecy orders prevent the patent applicant from disclosing any information about their invention and (on their face) allow for the inventor to request compensation for the ensuing damages.<sup>3</sup> The vast majority of secrecy orders are imposed on government inventors or inventors working on a government contract, but private inventors are also subject to them, and House Report No. 96-1540 (an analysis of the “classification of private ideas” released in 1980) indicated that “the statutory right of an inventor to just compensation for secrecy order damages appears more illusory than real.”<sup>4</sup>

The policy behind the Invention Secrecy Act was to prevent foreign adversaries from acquiring knowledge of inventions which may create national security threats.<sup>5</sup> Now declassified inventions that were subject to secrecy orders include anything from warhead production to paint.<sup>6</sup> The current list of topics that may cause an invention to be reviewed for a possible secrecy order is itself classified.<sup>7</sup> Additionally, court rulings such as those in the Pentagon Papers Case (discussed in Section III) indicate that, while national security can be a legitimate reason to prevent

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<sup>2</sup> Sabing H. Lee, *Protecting the Private Inventor under the Peacetime Provisions of the Invention Secrecy Act*, 12 BERKELEY TECH. L.J. 345, 352 (1997).

<sup>3</sup> *Id.* at 353.

<sup>4</sup> COMM. ON GOV'T OPERATIONS, THE GOVERNMENT'S CLASSIFICATION OF PRIVATE IDEAS, H.R. REP. NO. 96-1540, at 2 (1980); MPEP § 120(I) (9th ed., Rev 01.2024, Nov. 2024).

<sup>5</sup> COMM. ON GOV'T OPERATIONS, *supra* note 4, at 2.

<sup>6</sup> *Id.* at 3; Arvind Dilawar, *The U.S. Government's Secret Inventions*, SLATE (May 9, 2018, 9:00 AM), <https://slate.com/technology/2018/05/the-thousands-of-secret-patents-that-the-u-s-government-refuses-to-make-public.html> [<https://perma.cc/Q8W3-CJLB>].

<sup>7</sup> ARMED SERVS. PAT. ADVISORY BD., PATENT SECURITY CATEGORY REVIEW LIST (1971), <https://sgp.fas.org/othergov/invention/psrcl.pdf> (including the most recent review list that actually discloses the content within) [<https://perma.cc/YT5A-RQLK>].

speech, it has First Amendment limitations when imposing a prior restraint.<sup>8</sup>

First, secrecy orders, as applied to the patent applications of private inventors, have been made less effective by increased exceptions for disclosures before filing upon the enactment of the America Invents Act in 2013. Second, secrecy orders may act as an unconstitutional prior restraint on speech, an argument that itself is extremely difficult to get heard by a court, which may in turn violate the constitutional right of due process.

This article's analysis of the efficacy and constitutional issues posed by secrecy orders as applied to private inventors was conducted based on a series of assumptions. First, that the multitudes of national security threats in this modern-day age are legitimate and ever-increasing in scope.<sup>9</sup> Despite criticisms of the secrecy order framework in this article, at no point should this legitimacy be perceived as minimized. Second, the classified nature of how an administrative body decides whether to institute a secrecy order makes it difficult to analyze various aspects of procedure. The burden of examining this rests on declassified documents and historical examples, and as such, this article will presume that current classified procedures operate similarly. Third, given the complex nature of the sciences and how the same invention may simultaneously be used for peace as much as for war, this article will assume that, unless otherwise shown (i.e. by the inventor pointing out the threat or the

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<sup>8</sup> *New York Times Co. v. United States*, 403 U.S. 713, 714 (1971).

<sup>9</sup> See generally *Terrorism and National Security Threats*, DEP'T OF HOMELAND SEC., <https://www.dhs.gov/hsi/investigate/terrorism-and-national-security-threats> [<https://perma.cc/RZ28-8BNB>] (listing examples of modern-day national security threats); *National Security Defined*, EPA, <https://www.epa.gov/national-security/national-security-defined> [<https://perma.cc/W7RX-FF4Q>] (listing examples of modern-day national security threats).

invention having little to no peaceful alternatives), the private inventor was unaware that their invention posed such a drastic national security threat as to receive a secrecy order.

In Section I, this article introduces the history and procedure for patent secrecy orders, including the philosophy behind them and the different types of inventors they may apply to. Section II analyzes the partial obsolescence of the Invention Secrecy Act in light of increased exceptions for disclosures before filing upon the enactment of the America Invents Act in 2013. Finally, Section III discusses (1) the potential unconstitutionality of secrecy orders on private inventors under the doctrine of prior restraints and (2) the potential procedural due process violations that stem from the difficulty of getting such an argument before the court.

## **I. THE HISTORY OF THE INVENTION SECRECY ACT**

Science and war have been so heavily twisted together for centuries that it sometimes becomes hard to distinguish where the line between pure science and warfare application lies. The Nazi V-2 missile that killed thousands of people in World War II was the same technology that helped put humanity on the moon.<sup>10</sup> Telescopes were almost immediately used for warfare as much as they were used to look at the stars.<sup>11</sup> The Fast Fourier Transform, an algorithm that has revolutionized signal processing, was rediscovered by scientists trying to

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<sup>10</sup> *V-2 Missile*, SMITHSONIAN NATIONAL AIR AND SPACE MUSEUM, [https://airandspace.si.edu/collection-objects/missile-surface-surface-v-2-4/nasm\\_A19600342000](https://airandspace.si.edu/collection-objects/missile-surface-surface-v-2-4/nasm_A19600342000) [<https://perma.cc/G9HN-YZY9>] (last visited Feb. 5, 2025).

<sup>11</sup> NEIL DEGRASSE TYSON & AVIS LANG, *ACCESSORY TO WAR: THE UNSPOKEN ALLIANCE BETWEEN ASTROPHYSICS AND THE MILITARY*, 108 (2018).

detect nuclear tests.<sup>12</sup> Put succinctly by a British Brigadier General following the Treaty of Versailles: “[h]ow are you to distinguish between war explosives and ‘commercial’ explosives? The dynamite which serves to blast a quarry is as useful to the sapper in war as to the quarrymen in peace.”<sup>13</sup>

A critical aspect for patentability in the United States is that the invention must be described in such detail that a person having ordinary skill in the art is able to make and use it.<sup>14</sup> The danger of this robust disclosure led to the first secrecy orders on inventions in World War I.<sup>15</sup> These temporary wartime secrecy procedures were once again put in place in World War II, and the subsequent Invention Secrecy Act of 1951 solidified their existence to this day with the philosophy that “[i]nventions useful in war are made and developed during times of peace.”<sup>16</sup> Looming over the enactment of the Act was the fact that the United States was soon to sign the Treaty of Peace with Japan, a trigger that would have automatically led to the disclosure of the patents then under secrecy orders once the country was considered to be in a time of peace.<sup>17</sup>

The Invention Secrecy Act of 1951 provides that, upon submission of a provisional, nonprovisional, PCT, or

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<sup>12</sup> Michael Heideman, Don Johnson, & C. Sidney Burrus, *Gauss and the History of the Fast Fourier Transform*, 34 ARCHIVE FOR HISTORY OF EXACT SCIENCES 265, 266 (1985); Veritasium, *The Most Important Algorithm of All Time*, YOUTUBE, (Nov. 3, 2022), at 0:00–0:30, <https://www.youtube.com/watch?v=nmgFG7PUHfo> [<https://perma.cc/45JW-RAJ6>]. The signal processing that this enables even allows for a different type of internet warfare. See e.g., Rick Astley, *Never Gonna Give You Up (Official Music Video)*, YOUTUBE (Oct. 25, 2009), <https://www.youtube.com/watch?v=dQw4w9WgXcQ> [<https://perma.cc/GMX6-UKED>].

<sup>13</sup> TYSON & LANG, *supra* note 11, at 138.

<sup>14</sup> 35 U.S.C. § 112(a).

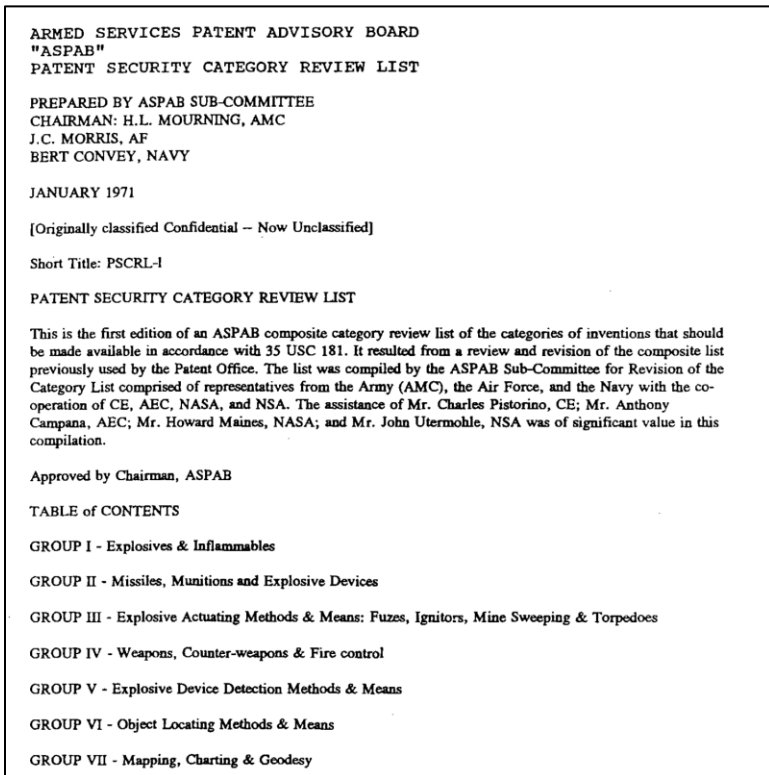
<sup>15</sup> Lee, *supra* note 2, at 346.

<sup>16</sup> COMM. ON GOV'T OPERATIONS, *supra* note 4, at 1, 60.

<sup>17</sup> S. REP. NO. 82-1001, at 1322 (1951).

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international design application, the invention is reviewed by a group at the Patent Office that screens applications for potential national security threats.<sup>18</sup> Patent Security Category Review Lists document the groups of inventions and related subtopics that may trigger the Patent Office to send the application to a corresponding government agency for their determination of the threat.<sup>19</sup>



*Figure 1: An image of the first page of the ASPAB Patent Security Category Review List from 1971.<sup>20</sup>*

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<sup>18</sup> 37 C.F.R. § 5.1 (2026); COMM. ON GOV'T OPERATIONS, *supra* note 4, at 17.

<sup>19</sup> ARMED SERVS. PAT. ADVISORY BD., *supra* note 7, at 1–2.

<sup>20</sup> *Id.*

The Patent Security Category Review List from 1971 (as shown above in Figure 1) was released through a FOIA request by the Federation of American Scientists, and subsequent attempts to get more modern-day lists have resulted in almost wholly redacted documents, rendering them unusable.<sup>21</sup> Examples of these subtopics on the 1971 Review List include chemical warfare agents, solar photovoltaic generators, inflatable boats or rafts, noise devices for psychological warfare, and “weapons system using any component or components that would bring about a unique result or results.”<sup>22</sup> If it is found by the government agency that reviews the application that disclosure of the invention “would be detrimental to the national security,” the application will be placed under a secrecy order.<sup>23</sup>

Secrecy orders must be renewed every year during peacetime, but until the order is lifted on an invention (even if the application is in condition for allowance), the inventor, and anyone who knows of the invention, is prevented from disclosing any information about it, and the issuance of their patent is delayed.<sup>24</sup> This prevention from disclosure is enforced by threats of fines, imprisonment, and the abandonment of their patent.<sup>25</sup> The applicant can petition for the order to be rescinded and upon denial can appeal to the Secretary of Commerce, but given that the applicant may not know *why* their application was selected

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<sup>21</sup> ARMED SERVS. PAT. ADVISORY BD., *supra* note 7; ARMED SERVS. PAT. ADVISORY BD., PATENT SECURITY CATEGORY REVIEW LIST (2009), <https://sgp.fas.org/othergov/invention/pscr1-2009-red.pdf> [<https://perma.cc/8C2Q-YU79>].

<sup>22</sup> ARMED SERVS. PAT. ADVISORY BD., *supra* note 7, at 5, 14–15, 19–20.

<sup>23</sup> 35 U.S.C. § 181.

<sup>24</sup> MPEP § 120 (9th ed., Rev 01.2024, Nov. 2024).

<sup>25</sup> 35 U.S.C. § 182, 186.

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in the first place, this rescission is unlikely.<sup>26</sup> Mechanisms (which will be described in Section III) do exist for applicants to sue for compensation, but it has been found that this right to compensation “is more illusory than real,”<sup>27</sup> something that is decidedly contrary to the Act’s supposed “strong concern that inventors be encouraged to discover inventions having military value and to submit them to the United States.”<sup>28</sup>

Secrecy orders can apply to inventions made by the government, under government contracts, or by private inventors.<sup>29</sup> According to data reported by the Federation of American Scientists, over the past five years there have been an average of 6115 secrecy orders in effect each year with an average of 15 new secrecy orders applied to private inventors each year.<sup>30</sup> While only a relatively small number of these orders are placed on unsuspecting private inventors, the result is that secrecy orders are rarely challenged in court, and even less of them attempt to question the Invention Secrecy Act from a constitutional angle. This means that the Invention Secrecy Act has not been held properly accountable for the many concerns that have been raised about its legitimacy under the Constitution.

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<sup>26</sup> 37 C.F.R. § 5.4 (2026); Richard Mark, *The Patent Secrecy Act of 1952*, 15 COLUM. J.L. & SOC. PROBS. 359, 379 (1980).

<sup>27</sup> COMM. ON GOV’T OPERATIONS, *supra* note 4, at 6.

<sup>28</sup> *Halpern v. United States*, 258 F.2d 36, 39 (2d Cir. 1958).

<sup>29</sup> MPEP § 120 (9th ed., Rev 01.2024, Nov. 2024).

<sup>30</sup> *Invention Secrecy Activity FY 05 – FY 24*, FEDERATION OF AMERICAN SCIENTISTS, <https://sgp.fas.org/othergov/invention/stats-24.pdf> (last visited Mar. 30, 2025) (averages calculated using the data provided herein) [<https://perma.cc/BY5S-39HR>].

## II. AN ARGUMENT FOR DECREASED EFFICACY AFTER THE IMPLEMENTATION OF THE AIA

### A. *Private Inventors Lack Notice About What Inventions May be Examined for a Potential Secrecy Order*

Inventors unaffiliated with a juristic entity are allowed to represent themselves *pro se* before the USPTO without a registered patent practitioner.<sup>31</sup> While the knowledge that the average patent practitioner has about secrecy orders is limited, these *pro se* inventors are even more in the dark.

In the application process for a patent, the applicant must complete an Application Data Sheet (hereinafter “ADS”), which contains logistical information such as the inventor’s name, their address, any assignees, etc.<sup>32</sup> On the ADS form sits the following section:<sup>33</sup>

<p><b>Secrecy Order 37 CFR 5.2:</b></p> <p><input type="checkbox"/> Portions or all of the application associated with this Application Data Sheet may fall under a Secrecy Order pursuant to 37 CFR 5.2 (Paper filers only. Applications that fall under Secrecy Order may not be filed electronically.)</p>
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*Figure 2: An image of the secrecy order check box on the standard USPTO ADS form as of February 2025.*<sup>34</sup>

But when one looks at the referenced regulation (37 C.F.R. § 5.2), it essentially states that: (a) a secrecy order may be placed if the invention would be detrimental to national security, (b) compensation may be requested from the agency that asked for the secrecy order, and (c)

<sup>31</sup> 37 C.F.R. § 1.31.

<sup>32</sup> MPEP § 601.05 (9th ed., Rev 01.2024, Nov. 2024).

<sup>33</sup> *Application Data Sheet (37 CFR 1.76)*, USPTO, (Jan. 2022), <https://www.uspto.gov/patents/apply/forms/important-information-completing-application-data-sheet-ads> (provided link has the downloadable ADS) [<https://perma.cc/HS7H-5MD8>].

<sup>34</sup> *Id.*

subsequent applications following from applications under a secrecy order (i.e. a continuation, continuation in-part, etc.) should check the box.<sup>35</sup> There is nothing in the regulation or in the ADS that explains *what* might constitute a national security threat. Now, if a private inventor is submitting something called the Death Widget 5000, one would hope that they know that it is likely a national security threat, but there is nothing here in the notice that, for example, would alert an inventor in the 1970s that their inflatable raft might be reviewed as a threat.<sup>36</sup>

Additionally, the U.S. Government's varied definitions of national security threats are, understandably, far from specific. Examples of threats range from physical attacks to cyber-attacks, bioweapons to AI, supply chain management to food supply, and even to the theft of intellectual property.<sup>37</sup> Seemingly anything could be a threat to national security, which makes any current version of "notice" given to an inventor about the possibility almost meaningless.

***B. Harms to the Efficacy of the Invention Secrecy Act Through the Implementation of the America Invents Act***

**1. The Pre-AIA v. AIA Exceptions for Disclosures Before Filing**

The Invention Secrecy Act of 1951 was put into place almost concurrently with the Patent Act of 1952 (hereinafter "pre-AIA"). This patent regime was substantially changed in certain areas when the America Invents Act (hereinafter "AIA") moved the patent system

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<sup>35</sup> 37 C.F.R. § 5.2 (2026).

<sup>36</sup> ARMED SERVS. PAT. ADVISORY BD., *supra* note 7, at 14.

<sup>37</sup> DEP'T OF HOMELAND SEC., *supra* note 9; EPA, *supra* note 9.

from first-to-invent to first-to-file in 2013.<sup>38</sup> These changes increase the importance of the date that an application is filed on and present obstacles to the efficacy of secrecy orders.

In an ideal world, an inventor files a patent application before releasing any information about their invention to the public, and this is the world that the Invention Secrecy Act lives in. Much to the chagrin of patent practitioners everywhere, this is not always the case. Built into the structure of both the pre-AIA and AIA regimes are exceptions that allow an inventor who publicly disclosed the subject matter of their invention before filing to file within a certain time frame and secure their patent rights despite these pre-filing disclosures.<sup>39</sup> When the AIA switched the patent system to first-to-file, these exceptions were extended, particularly for foreign disclosures.<sup>40</sup> If a disclosure does not fall within the exceptions, the released information counts as prior art and can be used to counter the patentability of the application, something that must be avoided as much as possible.<sup>41</sup>

Under the pre-AIA regime, an inventor could publicly disclose their invention and still maintain patentability if (1) the invention was patented or published in the U.S. or a foreign country within one year of filing, or (2) the invention was publicly used or on sale in the U.S. within one year of filing.<sup>42</sup> This disclosure could be done by the inventor, a joint inventor, or a third party who

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<sup>38</sup> *First Inventor to File (FITF) Resources*, USPTO, <https://www.uspto.gov/patents/first-inventor-file-fitf-resources> (last visited Mar. 31, 2025) [<https://perma.cc/TDV3-NH7A>].

<sup>39</sup> 35 U.S.C. § 102; 35 U.S.C. § 102 (pre-AIA).

<sup>40</sup> 35 U.S.C. § 102.

<sup>41</sup> *Id.*

<sup>42</sup> 35 U.S.C. § 102 (pre-AIA).

acquired the information from the inventor or the joint inventor.<sup>43</sup>

Under the AIA regime, an inventor can publicly disclose their invention and still maintain patentability even if the invention was patented, published, in public use, on sale, or “otherwise available to the public” in the U.S. or a foreign country within one year of filing.<sup>44</sup> This disclosure can be done by the inventor, a joint inventor, or a third party who acquired the information from the inventor or the joint inventor.<sup>45</sup>

As shown, the AIA greatly expanded the universe of subject matter disclosure exceptions for U.S. applications. First, it extended the geographical regions of disclosure for all categories of prior art to be international, allowing inventors to feel more comfortable using or selling their inventions in foreign countries. Second, disclosure of the subject matter by a completely independent individual can be excluded as prior art if the inventor, a joint inventor, or a third party had disclosed the subject matter before the independent disclosure, almost adding an *incentive* to disclose subject matter in the AIA world.<sup>46</sup> Third, the catch-all prior art class of “otherwise available to the public” allows for more types of disclosure which may have not fit as neatly into the pre-AIA prior art categories.

Now, any invention that has already been disclosed is likely to not have a secrecy order imposed on it, a sentiment evoked by the Director of the NSA in 1979 when

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<sup>43</sup> 35 U.S.C. § 102 (pre-AIA); MPEP § 2132.01(I).

<sup>44</sup> 35 U.S.C. § 102.

<sup>45</sup> *Id.*

<sup>46</sup> 35 U.S.C. § 102; *Shifting Strategies: Public Disclosure Under the AIA*, BARLEY SNYDER (Nov. 6, 2013), <https://www.barley.com/shifting-strategies-public-disclosure-under-the-aia/> [<https://perma.cc/4YEL-VJ7K>] (showing an example of the incentive to disclose theory being discussed in the IP community a few months after the enactment of the AIA).

he stated that, “[i]f the individual had elected to publish in academic journals ... there would have been no question of a secrecy order.”<sup>47</sup> But that does not change the fact that these disclosure exceptions present a very large barrier for the efficacy of secrecy orders. The AIA changes, with their greater allowance for foreign disclosure, make the exceptions even more damning to the purpose of the Invention Secrecy Act: preventing foreign adversaries from accessing potentially national security threatening inventions. See Figure 3 below for a timeline illustrating this issue.

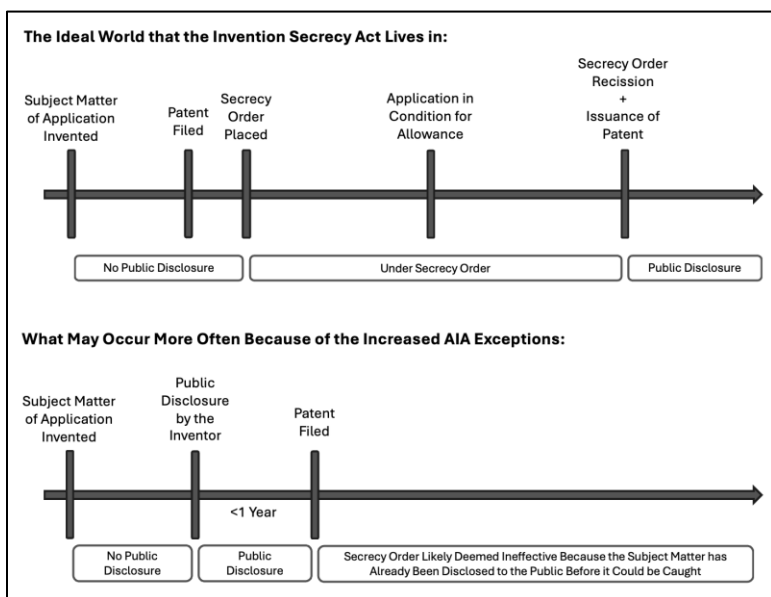


Figure 3: A visualization of (top) the ideal world that the Invention Secrecy Act lives in for preventing public disclosure and (bottom) situations that may occur more often due to the implementation of the AIA.

<sup>47</sup> COMM. ON GOV'T OPERATIONS, *supra* note 4, at 21.

## **2. An Illustration of These Issues with the Death Widget 5000**

As an example, consider a private inventor, completely unaffiliated with the government or any government contracts, who creates the Death Widget 5000. If this inventor wants to sell this invention, they must consider either trade secrets or the patent system in order to protect their rights as they market their invention, or else they will be at risk of the Arrow information paradox. This is the idea that an inventor has to disclose information about their product in order to sell it, but by doing so they are essentially giving the information away for free unless they have legal protection over the material.<sup>48</sup> Having a patent on their invention is an essential way to overcome this paradox.

If this is a sophisticated inventor with knowledge about the patent system or one who has a patent practitioner advising them on the best strategies, they will likely end up going down the ideal path that the Invention Secrecy Act presumes. This is particularly true for inventors who want to file internationally as well as in the United States. While the United States provides these exceptions to early disclosure, other countries do not. A disclosure in the United States may allow for an inventor to still file in-country and preserve their patentability, but this may prevent them from filing, for example, in China or certain European countries where the qualifications for a grace period are much stricter.<sup>49</sup> With globalization's drastic

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<sup>48</sup> OREN BAR-GILL & GIDEON PARCHOMOVSKY, INTELLECTUAL PROPERTY AND THE BOUNDARIES OF THE FIRM, HARVARD LAW SCHOOL DISCUSSION PAPER NO. 480 (2004).

<sup>49</sup> World Intellectual Property Organization [WIPO], *Certain Aspects of National/Regional Patent Laws* (Aug. 2024), [https://www.wipo.int/export/sites/www/scp/en/national\\_laws/grace\\_period.pdf](https://www.wipo.int/export/sites/www/scp/en/national_laws/grace_period.pdf) [<https://perma.cc/8PK8-LQFA>].

increase since the Invention Secrecy Act was put in place, one may argue that the Act is more relevant than ever.

That kind of thinking is flawed. A preventative measure is not effective if it is only accounting for ideal conditions. The Invention Secrecy Act relies on inventors who abide by these ideal non-disclosure scenarios, but that ignores both (1) inventors who accidentally disclose and (2) inventors who may disclose on purpose to take advantage of the AIA exceptions, particularly that of cutting off independent third-party prior art by disclosing before them.

These exceptions exist, and the ability of the Invention Secrecy Act to catch the Death Widget 5000 is diminished by the fact that the inventor could have revealed the Death Widget 5000 before filing their patent. The Invention Secrecy Act is there to try and catch Death Widget 5000s because they hold a greater danger of (1) being deliberately sold/marketed, and (2) having an air of legitimacy about them through the act of having a patent. A Death Widget 5000 randomly posted on the internet is arguably less threatening than a Death Widget 5000 with the force of a patent behind it that will likely be marketed at some point (despite the fact that a patented invention does not technically have to work).

With the AIA exceptions, a Death Widget 5000 is more likely to be disclosed and *then* filed, thus eating away at the efficacy of the Invention Secrecy Act.

### **3. A Solution of Limiting Disclosure Exceptions for Inventions Placed Under Secrecy Orders Needs to be Accompanied by Increased Notice for Inventors**

Possible solutions to this efficacy issue due to the disclosure exceptions are limited and deeply unfair to inventors. Someone who is very focused on national security above all else may jump to the conclusion of

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repealing the exceptions entirely, but to do that to increase the efficacy of orders that only cover less than 0.003% of all patent applications in the U.S. would be absolutely devastating and wreak havoc on the first-to-file world because of the extreme reliance on filing dates and the necessity for these safety nets to protect inventors who may make disclosure mistakes.<sup>50</sup>

As a much less devastating alternative, there could be a repeal of disclosure exceptions purely for those applications that could end up under a secrecy order, placing their patentability status on the condition of no prior disclosures. This is also unfair to inventors, especially because their potential compensation for a secrecy order depends on their application being patentable, and it is already hard enough for them to secure proper compensation.<sup>51</sup>

The only way this solution of limited disclosure exceptions would be remotely fair is if inventors were more on notice about *what* type of inventions are under the most scrutiny for a secrecy order.

A version of the Patent Security Category Review List must be released to the public in a way that inventors and patent practitioners may be on notice. Of course, there are some things that the government cannot reveal, and that is entirely reasonable given the sheer scale and confidentiality of some threats. This, however, does not mean that *nothing* can be revealed.

Consider the 1971 Patent Security Category Review List: it states the very broad sections that an invention may

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<sup>50</sup> Calculated using the average of 15 secrecy orders each year and the total number of utility patent applications filed in 2020 (597,175). See *Invention Secrecy Activity FY 05 – FY 24*, *supra* note 30; *U.S. Patent Statistics Chart Calendar Years 1963-2020*, USPTO (May 2021), [https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us\\_stat.htm](https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm) [<https://perma.cc/YMZ5-WTDZ>].

<sup>51</sup> Lee, *supra* note 2, at 367.

be found under, and then provides more specific examples in each category.<sup>52</sup> For example, Group XIV is vehicles.<sup>53</sup> Within this group are narrowed categories such as, “[l]and or amphibious combat vehicle components or accessories employing new principles,” “[f]uel tank, aircraft, self-sealing,” and “[u]nusual configurations of waterborne vehicles (for reducing wave or frictional drag, etc.).”<sup>54</sup> Stating that an invention about land or amphibious *combat* vehicles may be something of interest to the government does not seem very damaging to national security on its face, so why could phrasings such as that not be able to be provided as a form of notice to inventors?

The redacted 2009 Patent Security Category Review List that was released through a FOIA request only reveals the broader groups (e.g. “Explosives & Inflammables,” “Vehicles,” and “Power Supply”) which match up exactly with the broader groups in the 1971 list.<sup>55</sup> There is no information revealed about the sub-groups aside from a general estimation of how many may be in each group, depending on the size of the redaction square over the text, as shown in Figure 4 below.<sup>56</sup> In order to provide proper notice, these broad groups are far from enough.

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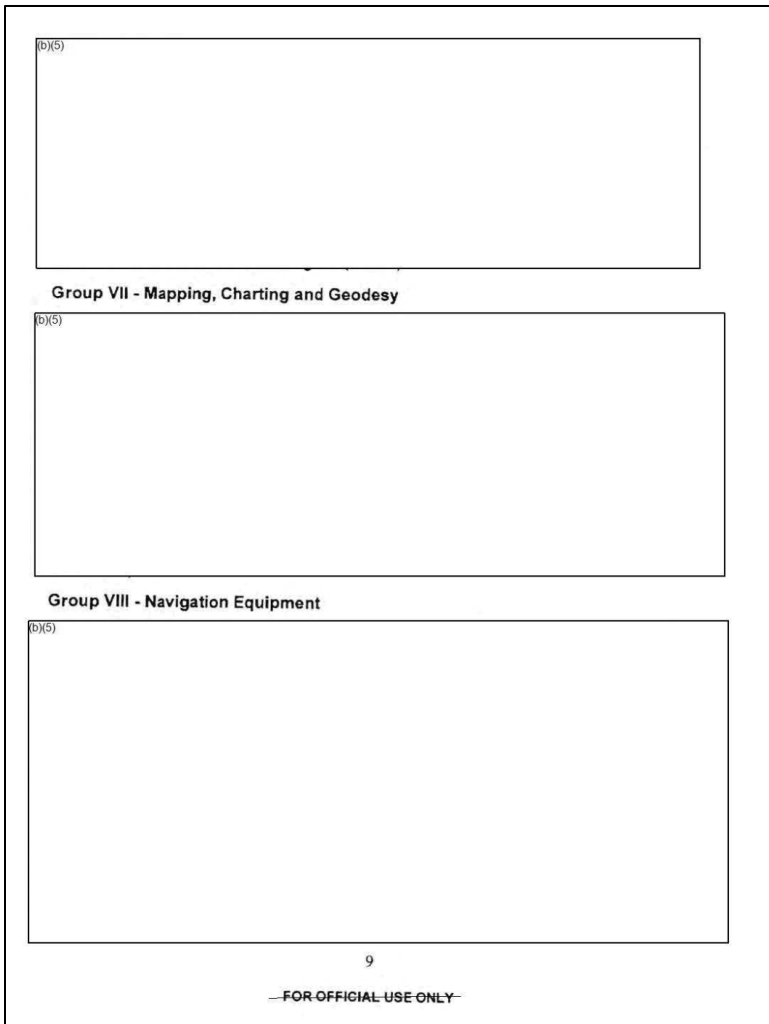
<sup>52</sup> ARMED SERVS. PAT. ADVISORY BD., *supra* note 7.

<sup>53</sup> *Id.* at 14.

<sup>54</sup> *Id.* at 14–15.

<sup>55</sup> ARMED SERVS. PAT. ADVISORY BD., *supra* note 21, at 2, 16, 20.

<sup>56</sup> *Id.* at 9.



*Figure 4: A section of the 2009 Patent Security Category Review List released through a FOIA request and redacted.<sup>57</sup>*

Seen below in Figure 5, a very similar review list from 2008 comes from the United Kingdom after a request

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<sup>57</sup> *Id.*

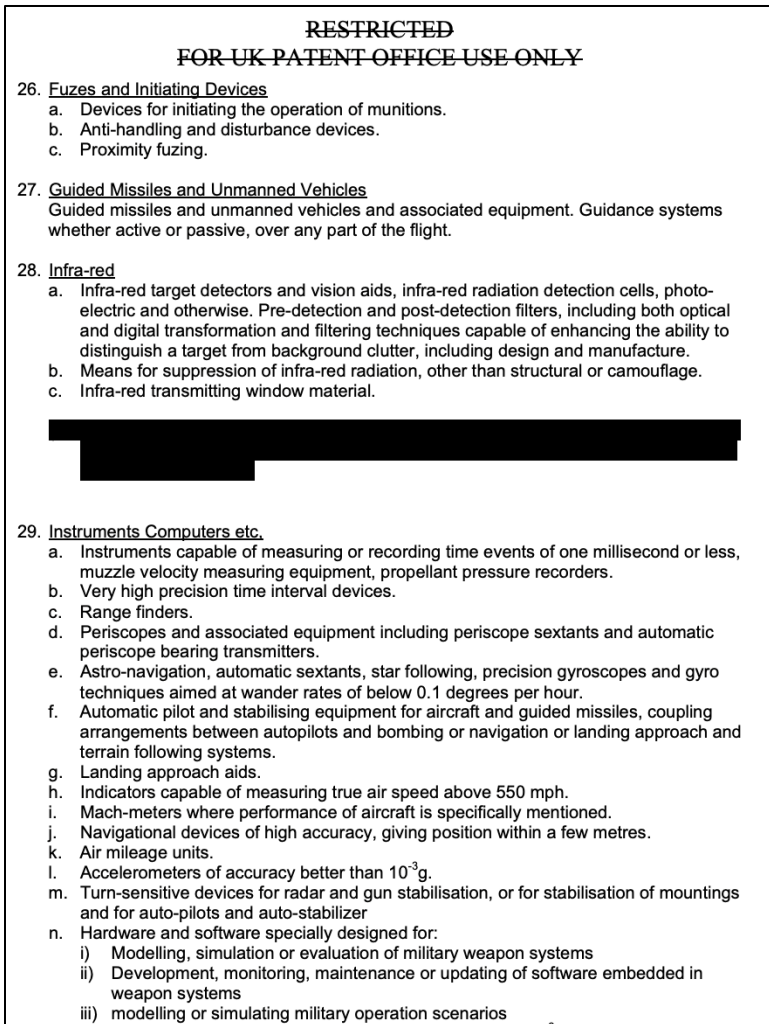
through their analog to the Freedom of Information Act.<sup>58</sup> The document, “Technology Which May Be Subject to Section 22 of The Patents Act 2004,” covers a list of topics which range in specificity from “amphibious equipment” to “[s]ystems or devices having special features to reduce the effect of atomic acoustic or intense electro-magnetic radiation, including protection of micro-wave receivers against very high incident mean power.”<sup>59</sup> The United Kingdom is one of the countries with which the United States has a reciprocal patent security relationship, and an application that has a Type I (the least restrictive) United States patent secrecy order placed on it can be filed in the United Kingdom as well (and vice versa).<sup>60</sup> It can be presumed that the technologies of the review lists are relatively similar, so the minimally redacted United Kingdom list from 2008 makes the United States list from 2009 questionable in terms of redaction necessity.

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<sup>58</sup> *Technology prejudicial to national security or public safety*, INTELL. PROP. OFF. (Feb. 25, 2008), <https://www.gov.uk/government/publications/technology-prejudicial-to-national-security-or-public-safety> [<https://perma.cc/R5UN-E5YY>].

<sup>59</sup> UK PAT. OFF., TECHNOLOGY WHICH MAY BE SUBJECT TO SECTION 22 OF THE PATENTS ACT 2004, at 3, 6 (2008), <https://assets.publishing.service.gov.uk/media/5a7e3545ed915d74e33f0c01/p-securitylist.pdf> [<https://perma.cc/Z49K-745G>].

<sup>60</sup> MPEP § 120(I).



*Figure 5: A section of the 2008 UK “Technology Which May Be Subject to Section 22 of The Patents Act 2004” list, released through their equivalent to FOIA and minimally redacted.<sup>61</sup>*

<sup>61</sup> UK PAT. OFF., *supra* note 59, at 7.

The counter argument to this rests, ultimately, in the mosaic theory for national security which is the idea that even small pieces of seemingly harmless information can be pieced together in a “mosaic” that can reveal a vulnerability in our national security.<sup>62</sup> While this is a legitimate worry in the information age with increasing technological capabilities to search for and assemble data, scholars have criticized this theory as being a “latently subversive basis for withholding information.”<sup>63</sup> Scholars have accused this theory of both (1) limiting the ability for the general public to identify and respond to threats, and (2) being used excessively to “shield potentially controversial or embarrassing government operations from public view.”<sup>64</sup> To quote the findings in House Report No. 96-1540 on secrecy orders:

Invention secrecy as currently constituted is heavily weighted against private inventors who work outside the classified and defense community. Invention secrecy undergirds and aggrandizes the military-industrial complex, and ensnares the inventors who work outside of the classified information community. It gives these nonmember inventors the choice of presenting their discoveries to the public without ownership protection or of trying to obtain a patent and thereby risking Government confiscation of their ideas.<sup>65</sup>

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<sup>62</sup> David Pozen, *The Mosaic Theory, National Security, and the Freedom of Information Act*, 115 YALE L.J. 628, 630 (2005).

<sup>63</sup> *Id.* at 632.

<sup>64</sup> Michael Goodwin, *A National Security Puzzle: Mosaic Theory and the First Amendment Right of Access in the Federal Courts*, 32 HASTINGS COMM. & ENT. L.J. 179, 183–84 (2010).

<sup>65</sup> COMM. ON GOV'T OPERATIONS, *supra* note 4, at 2.

**III. POTENTIAL UNCONSTITUTIONALITY VIA PRIOR  
RESTRAINTS ON SPEECH AND THE ENSUING DUE  
PROCESS ISSUES FOR BRINGING THIS FIRST  
AMENDMENT CLAIM TO COURT<sup>66</sup>**

***A. Secrecy Orders are Potentially  
Unconstitutional Prior Restraints on  
Speech under the Pentagon Papers Scheme***

Freedom from government restriction of speech is an essential right in the United States.<sup>67</sup> Some restrictions of speech occur after the speech, but prior restraints are “administrative and judicial orders forbidding certain communications when issued in advance of the time that such communications are to occur.”<sup>68</sup> In cases such as *New York Times Co. v. United States* (hereinafter the Pentagon Papers Case), the Supreme Court has stated that “any system of prior restraints of expression comes to this Court bearing a heavy presumption against its constitutional

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<sup>66</sup> As mentioned earlier in this article, there are many criticisms of the mechanisms for patent applicants to receive compensation for damages ensuing from secrecy orders placed on their applications, as they have been found to be “more illusory than real.” This article will focus instead on the First Amendment constitutionality issues and the ensuing procedural due process challenges in getting that specific argument in front of the court. Cited herein for reference are a plurality of articles which are more focused on the procedural due process issues for the compensatory aspect. *See, e.g.*, COMM. ON GOV’T OPERATIONS, *supra* note 4; Scott Locke, *The Invention Secrecy Act: The USPTO as a Gatekeeper of National Security*, 8 IP THEORY 71 (2019); Lee, *supra* note 2; Lee Ann Gilbert, *Patent Secrecy Orders: The Unconstitutionality of Interference in Civilian Cryptography under Present Procedures*, 22 SANTA CLARA L. REV. 325 (1982).

<sup>67</sup> U.S. CONST. amend. I.

<sup>68</sup> *Alexander v. U.S.*, 509 U.S. 544, 550 (1993) (citing MELVILLE B. NIMMER, NIMMER ON FREEDOM OF SPEECH: A TREATISE ON THE THEORY OF THE FIRST AMENDMENT § 4.03 (1984)).

validity.”<sup>69</sup> This presumption against validity is rooted in the Court’s fear that, since the speech is suppressed before it can be spoken, there is a high chance that prior restraints will act as an impermissible chill on protected speech.<sup>70</sup> The Court emphasized a few accompanying concepts: (1) just because someone cannot be barred from saying something does not mean there are no consequences after saying it (e.g. defamation), and (2) times of war may require prior restraints on speech.<sup>71</sup> “No one would question but that a government might prevent actual obstruction to its recruiting service or the publication of the sailing dates of transports or the number and location of troops.”<sup>72</sup>

The burden for the imposition of a prior restraint has been somewhat reduced for certain forms of intellectual property, particularly for copyright infringement and unauthorized disclosure of trade secrets.<sup>73</sup> The First Amendment “‘securely protects the freedom to make—or decline to make—one’s own speech,’ but it ‘bears less heavily when speakers assert the right to make other people’s speeches.’”<sup>74</sup> Under this theory, the imposition of prior restraints on inventors who seek to disclose their *own* invention should not be affected by the reduction in protection for intellectual property cases. What remains is the question of national security.

Standing to this day as one of the most influential cases on prior restraints, the Pentagon Papers Case brought a high-profile national security problem to the Supreme Court. The Government tried to prevent multiple

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<sup>69</sup> *New York Times Co. v. U.S.*, 403 U.S. 713, 714 (1971).

<sup>70</sup> *Spolar v. Discovery Communs.*, 2020 U.S. Dist. LEXIS 247006, at \*7–8 (C.D. Cal., Oct. 2, 2020).

<sup>71</sup> *Near v. Minnesota*, 283 U.S. 697, 715–16 (1931).

<sup>72</sup> *Id.* at 716.

<sup>73</sup> *Spolar*, 2020 U.S. Dist. LEXIS 247006, at \*10.

<sup>74</sup> *Green v. U.S. Dep’t of Just.*, 111 F.4th 81, 87 (2024).

newspapers, such as the Washington Post and the New York Times, from publishing classified information about the Vietnam War.<sup>75</sup> Justice Black (joined by Justice Douglas) in his concurrence stated that, “the word ‘security’ is a broad, vague generality whose contours should not be invoked to abrogate the fundamental law embodied in the First Amendment.”<sup>76</sup> It is granted that the Pentagon Papers case was directed towards the press and a topic of very intense political debate in the country, but the Court emphasized the great burden of showing enough justification for the prior restraint that the government has to bear in order to overcome the presumption against its validity.<sup>77</sup> The Supreme Court affirmed the lower courts’ findings that the government did not meet this burden, and the Pentagon Papers were released to the public.<sup>78</sup> After this release of the documents to the public, “the government’s asserted national security interests in restraining publication turned out to be ‘a mirage.’”<sup>79</sup>

Secrecy orders on private inventors interact with this governmental burden in a strange way. Consider the following scenario: a private inventor who is not working under any auspices of the government has created an invention that they seek to share with the world through the patent system. They are then told that they (and anyone who knew of it) cannot disclose any information without applying for exceptions that they may or may not get, and are still, at the end of the day, a restriction on speech. Critically, the information that is being kept secret *did not originate with the government*.

In cases such as *Farag v. DTRA* (examined in Section III(C)(ii)), the courts have made statements such

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<sup>75</sup> *New York Times Co. v. U.S.*, 403 U.S. 713, 714 (1971).

<sup>76</sup> *Id.* at 719.

<sup>77</sup> *Id.* at 714.

<sup>78</sup> *Id.*

<sup>79</sup> Goodwin, *supra* note 64, at 184.

as: “[t]he potential threat to the nation and world from terrorist activity or nuclear annihilation caused by someone seeing plaintiff’s patent application is too remote and generalized to support standing for plaintiff.”<sup>80</sup> If the Supreme Court did not stop the publication of classified materials that originated *from* the government and were inherently flagged as something that posed a national security risk at the time, how is a prior restraint supposed to be upheld on information that originated *from a private party* and is buried as one of about a half a million patent applications that the U.S. receives a year?<sup>81</sup>

But then again, there are legitimate national security threats that would likely meet the justification burden that the government needs in order to impose this restriction on speech, and because of this, the Invention Secrecy Act as a whole may be constitutional under a First Amendment basis. That being said, there may exist an inventor who could have a strong argument for it being unconstitutional *as applied*.

The problem is, now, how to get that argument in front of the court.

### ***B. The Process of Bringing Secrecy Order Claims to Court: Waiver of Sovereign Immunity and the State Secrets Privilege***

There is a specific judicial process for claimants under a secrecy order that has been laid out in 35 U.S.C. §

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<sup>80</sup> Farag v. DTRA, No. 07 C 1688, 2007 U.S. Dist. LEXIS 60448, at \*8 (N.D. Ill., Aug. 15, 2007).

<sup>81</sup> *U.S. Patent Statistics Chart Calendar Years 1963-2020*, USPTO (May 2021), [https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us\\_stat.htm](https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm) [<https://perma.cc/6QWU-NN9Z>].

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183, but it has been highly criticized for its insufficiencies and possible violations of due process.<sup>82</sup>

As with all suits against the government, sovereign immunity is the first issue to be contended with. A relic from the monarchical system, this is essentially the idea that the U.S. Government cannot “be sued without its consent.”<sup>83</sup> This consent can come through the form of statutory waivers by Congress or an accusation of “unconstitutional conduct.”<sup>84</sup> Sovereign immunity is a particularly large issue for intellectual property matters when the U.S. Government is the accused infringer, and Congress has passed statutes that allow for suits, albeit with conditions on the manner of doing so and the viable outcomes.<sup>85</sup>

As the Congressional waiver of sovereign immunity for secrecy order cases, 35 U.S.C. § 183, gives two routes for inventors to seek compensation: the “administrative route” and the “judicial route.”<sup>86</sup> The administrative route requires an applicant to first submit a petition for compensation to the department or agency that placed the order on them, and upon the failure of that petition, they can sue in the U.S. Court of Federal Claims or their District Court.<sup>87</sup> Under the administrative route, the subsequent

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<sup>82</sup> 35 U.S.C. § 183; *see, e.g.*, COMM. ON GOV'T OPERATIONS, *supra* note 4; Scott Locke, *supra* note 66, Lee, *supra* note 2; Gilbert, *supra* note 66.

<sup>83</sup> Gregory Sisk, *A Primer on the Doctrine of Federal Sovereign Immunity*, 58 OKLA. L. REV. 439, 443, 456 (2005).

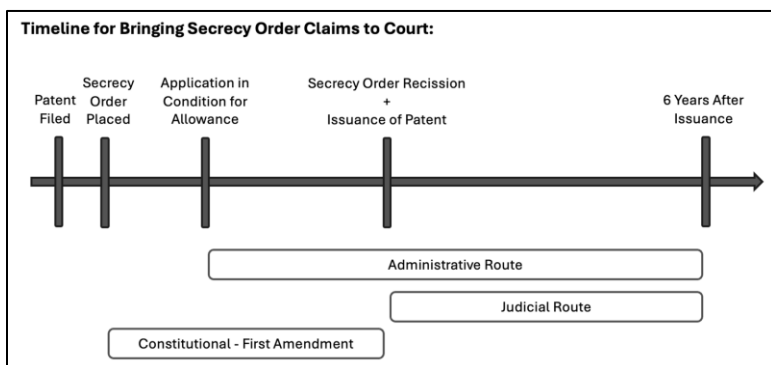
<sup>84</sup> *Id.* at 456–57.

<sup>85</sup> *See generally* Mitchell Feller, *IP and Sovereign Immunity: Why You Can't Always Sue for IP Infringement*, IP WATCHDOG (Feb. 1, 2018), <https://ipwatchdog.com/2018/02/01/ip-infringement-sovereign-immunity/id=93050/#:~:text=Under%20the%20Eleventh%20Amendment%2C%20states,exclusively%20governed%20by%20Federal%20law> [https://perma.cc/U37J-68LN]; Eugene Volokh, *Sovereign Immunity and Intellectual Property*, 73 S. CAL. L. REV. 1161 (2000).

<sup>86</sup> *Weiss v. U.S.*, 146 F. Supp. 2d 113, 118 (D. Mass. 2001).

<sup>87</sup> 35 U.S.C. § 183.

suit *can* be made while the secrecy order is still active.<sup>88</sup> The timing for this procedure begins upon the application being in condition for allowance and ends six years after issuance.<sup>89</sup> The judicial route, however, requires the applicant to wait until the patent has been issued, something that can only happen after the lifting of the secrecy order.<sup>90</sup> See Figure 6 for a visual of this timeline, which includes the constitutional aspect discussed in Section III(C)(ii).



*Figure 6: A timeline of when administrative route, judicial route, and First Amendment cases (as discussed herein) can be brought to court.*

While these sovereign immunity waivers allow for cases to be brought to court, there remain issues about the classified nature of the content under the secrecy order. While courts do have mechanisms to deal with such problems such as filing under seal, in-camera review of content, and judges with active security clearances,<sup>91</sup> the

<sup>88</sup> *Weiss*, 146 F. Supp. 2d at 123.

<sup>89</sup> 35 U.S.C. § 183.

<sup>90</sup> *Id.*

<sup>91</sup> *Guidelines for Cases Involving Classified Information*, U.S. COURT OF FEDERAL CLAIMS (Apr. 2021), <https://www.usfc.uscourts.gov>

state secrets privilege presents a problem, particularly for litigants with still active secrecy orders. This privilege can be invoked to restrict access to specific pieces of evidence or make it such that “if the underlying subject matter of a lawsuit is a state secret, then the courts must dismiss the action for lack of jurisdiction.”<sup>92</sup> The court has confirmed that cases under active secrecy orders can hold in-camera proceedings if “such a proceeding can be held without running any serious risk of divulgence of military secrets.”<sup>93</sup> However, if the plaintiff’s claims require disclosure of new classified information to the parties, the government is likely to succeed in invoking state secrets privilege.<sup>94</sup>

To summarize, the administrative route cases can be split into pre-issuance and post-issuance status based on the existence of an active secrecy order. Judicial route and post-issuance administrative route cases are after the secrecy order has been rescinded, but pre-issuance administrative route cases are still under the secrecy order and attempts to bring it to court will likely be limited by the availability or not of an in-camera proceeding.

### ***C. The Lack of Standing Problem When Placing a Prior Restraint Argument in Front of the Court***

While the Congressional waivers of sovereign immunity are mostly in place to allow for compensation of

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/sites/cfc/files/classified\_information\_guidelines.pdf  
[<https://perma.cc/7FWV-NPXQ>].

<sup>92</sup> Jennifer Elsea & Edward Liu, *The State Secrets Privilege: National Security Information in Civil Litigation*, CONG. RSCH. SERV. (Apr. 28, 2022), <https://www.congress.gov/crs-product/R47081> [<https://perma.cc/JG6J-SMCQ>].

<sup>93</sup> *Halpern v. U.S.*, 258 F.2d 36, 43 (2d Cir. 1958).

<sup>94</sup> *Id.*; see also *Barlow v. U.S.*, No. 98-887X, 2000 U.S. Claims LEXIS 156, at \*29 (Fed. Cl., July 18, 2000).

the inventor (as the suppression of an invention set up for patenting inherently leads to a question of economic damages), there remains a question about the constitutionality of the Invention Secrecy Act under the First Amendment, as analyzed above, and some cases have attempted to bring this to the court's attention. The keyword for that, is, of course, *attempted*.

### **1. First Amendment Arguments by Plaintiffs Operating Under the 35 U.S.C. § 183 Mechanisms**

There are a very limited number of cases under the framework of 35 U.S.C. § 183 which have brought forth a First Amendment argument.<sup>95</sup> Of the *two* cases that are actually relevant to that question, one is a post-issuance administrative route case and the other cannot be described as falling cleanly under either of the 35 U.S.C. § 183 mechanisms since the *pro se* plaintiff was never able to actually identify any secrecy order, and his patent application was never issued.<sup>96</sup> That being said, given the secret nature of the inventions involved in such cases, there is a chance that a plaintiff under the pre-issuance administrative route *has* made the argument, but the case is simply still under seal.

*Damjanovic v. United States Department of the Air Force* (the post-issuance administrative route case) is

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<sup>95</sup> For example, a LEXIS search of “secrecy order” and “patent” and (“prior restraint” or “first amendment”) only found 10 cases, 4 of which were relevant to secrecy orders and only 2 of which alleged a first amendment violation, *Damjanovic* and *Clark*. LEXIS, “secrecy order” and “patent” and (“prior restraint” or “first amendment”), (Mar. 22, 2025) (on file with author). A search on Westlaw produced similar results. WESTLAW, “secrecy order” and “patent” and (“prior restraint” or “first amendment”), (Mar. 22, 2025) (on file with author).

<sup>96</sup> *Clark v. U.S.*, No. 11-10C, 2014 U.S. Claims LEXIS 728 (Fed. Cl., July 18, 2014); *Damjanovic v. U.S. Dep’t of the Air Force*, 135 F. Supp. 3d 601, 606 (E.D. Mich. 2015).

essentially the only example of a First Amendment argument being legitimately made on this topic. Plaintiffs sought compensation for damages that followed from a secrecy order placed on their patent for an “improved countermeasure process for both military and civil commercial aircraft under an attack by an infrared heat seeking missile” and, in the alternative, alleged constitutional violations under the First Amendment and the Fifth Amendment.<sup>97</sup> The Plaintiffs argued:

The Secrecy Order prohibits the Inventors from disclosing the subject matter of the Invention. One who willfully violates the secrecy order will likely have his patent application held abandoned, lose his right to compensation, be barred from receiving a patent and may be subject to a substantial fine and up to two years in prison under 35 U.S.C. §§ 182, 184, 185, 186. The First Amendment states “Congress shall make no law ... abridging the freedom of speech, or of the press ....” Because the Patent Secrecy Act prohibits Plaintiffs from speaking of their Invention to third parties, including potential customers, it violates the First Amendment of the Constitution.<sup>98</sup>

During this litigation, the Plaintiffs found themselves in a Catch-22 situation. The Air Force successfully argued that, because the secrecy order had been lifted, the restriction of their speech was now a past injury, and the Court did not have jurisdiction to hear the First Amendment argument under the declaratory judgment action since the Plaintiffs would no longer have standing.<sup>99</sup>

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<sup>97</sup> *Damnjanovic*, 135 F. Supp. 3d at 603, 606; U.S. Patent No. 8,925,438 (filed July 28, 2007).

<sup>98</sup> Complaint and Jury Demand at 8, *Damnjanovic v. United States Dep’t of the Air Force*, 135 F. Supp. 3d 601 (E.D. Mich. 2015) (No. 4:14-cv-11920-LVP-MKM).

<sup>99</sup> *Damnjanovic*, 135 F. Supp. 3d at 606; *see also* Defendants’ Motion to Dismiss at 23, *Damnjanovic v. United States Dep’t of the Air Force*,

The problem with this, though, is that inventors under a secrecy order are largely prohibited from disclosure until the order is lifted.<sup>100</sup>

This is a frustrating result for a plaintiff to be faced with. To be told that they cannot bring a First Amendment claim to court because they followed a statutory mechanism and did not reveal anything about their invention until the government told them they could is a result that is hard to swallow.

## 2. First Amendment Arguments by Plaintiffs Under a Purely Constitutional Mechanism

Since constitutional-based claims are inherently a waiver of sovereign immunity, a claim purely of such nature could theoretically be seen outside of the mechanisms provided for by Congress. The standing requirements to bring such a claim to court are that the plaintiff: (1) has suffered an actual or imminent “injury in fact,” (2) can allege that their injury is traceable to the conduct of the Defendant, and (3) that a court’s decision would provide redress for the injury.<sup>101</sup>

As shown in *Damnjanovic*, the first prong for the actual or imminent injury is inherently negated the minute that the secrecy order is lifted.<sup>102</sup> This would require a plaintiff asking for a declaratory judgment to attempt to argue a First Amendment violation either (1) while the

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135 F. Supp. 3d 601 (E.D. Mich. 2015) (No. 4:14-cv-11920-LVP-MKM) (“[B]ecause the Damnjanovics are only seeking declarative relief, not money damages, for the alleged infringement of their right to free speech, there exists no ‘backward-looking right to challenge’ the secrecy order, preserving a live free speech controversy over the restrictions imposed by that order.”).

<sup>100</sup> MPEP § 120 (9th ed., Rev 01.2024, Nov. 2024).

<sup>101</sup> *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560–61 (1992).

<sup>102</sup> *Damnjanovic*, 135 F. Supp. 3d at 606.

secrecy order is still in place or (2) right before one *will* be placed.

In *City of Los Angeles v. Lyons*, the plaintiff tried to get an injunction on the use of chokeholds by the Los Angeles police after being placed in one during a traffic stop.<sup>103</sup> The court found that the plaintiff did not have standing to bring this claim since he would need to show that he was likely to “suffer future injury from the use of the chokeholds by police officers.”<sup>104</sup> The dissent by Justice Marshall (joined by Justices Brennan, Blackmun, and Stevens) summarized the problem with this: “[s]ince no one can show that he will be choked in the future, no one -- not even a person who, like Lyons, has almost been choked to death -- has standing to challenge the continuation of the policy. The city is free to continue the policy indefinitely as long as it is willing to pay damages for the injuries and deaths that result.”<sup>105</sup>

Given this precedent of difficulties in establishing imminence, an inventor who attempts to have standing under the “imminent” possibility will likely run into issues, no matter how strong their argument about their status as a scientist working in a possibly national security threatening field is. Consider the case of *Farag v. DTRA*. The plaintiff applied for a patent on a process to “separate U235 isotope from natural Uranium—at very low cost and high speed—for peaceful uses or to make nuclear bombs.”<sup>106</sup> The plaintiff actually *requested* that a secrecy order be placed on the invention. Upon the DOD and DOE’s refusal to do so, he brought the issue to court *pro se* to try and force the restriction of publication.<sup>107</sup> The plaintiff later amended

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<sup>103</sup> *City of Los Angeles v. Lyons*, 461 U.S. 95, 97–98 (1983).

<sup>104</sup> *Id.* at 105.

<sup>105</sup> *Id.* at 113.

<sup>106</sup> *Farag v. DTRA*, No. 07 C 1688, 2007 U.S. Dist. LEXIS 60448, at \*1 (N.D. Ill., Aug. 15, 2007).

<sup>107</sup> *Id.* at \*2.

the original filing to include a request for \$500,000,000 in damages that he believed he would be owed if a secrecy order had been placed and he had been restricted from foreign filings.<sup>108</sup> While the circumstances for this case were rather unique, it goes to show that even a strong belief by the inventor of the threat that their creation poses is not enough to predict whether a secrecy order will be imposed or not. Not only that, but coming out of this case was a statement by the court which brings all secrecy orders into question: “[t]he potential threat to the nation and world from terrorist activity or nuclear annihilation caused by someone seeing plaintiff’s patent application is too remote and generalized to support standing for plaintiff.”<sup>109</sup>

The secretive nature of this process makes it difficult to predict with certainty if a secrecy order is going to be placed, but even if an inventor brings this to court with a bulletproof argument that a secrecy order is imminent, they might be shooting themselves in the foot anyway. Secrecy orders are unlikely to be placed on anything that has already been disclosed,<sup>110</sup> so the act of bringing it to the court (and thus increasing the amount of people who know about the invention) may affect the possibility of the order being placed and thus the imminence.<sup>111</sup> So, essentially, we are left with a plaintiff whose secrecy order is still active.

The second prong for standing requires that the injury is traceable to the defendant.<sup>112</sup> Since the secrecy order is what prevents the inventor from disclosing their

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<sup>108</sup> *Id.* at \*3.

<sup>109</sup> *Id.* at \*8.

<sup>110</sup> COMM. ON GOV’T OPERATIONS, *supra* note 4, at 21 (“If the individual had elected to publish in academic journals,” said the director of NSA, “there would have been no question of a secrecy order.”).

<sup>111</sup> Note that this may depend on what measures are taken by plaintiffs to ensure security, i.e. filing under seal, in-camera review, etc.

<sup>112</sup> *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560–61 (1992).

invention and thus limiting their free speech,<sup>113</sup> the second prong is easily achieved.

The third prong for standing requires that the court's decision would actually provide redress for the injury.<sup>114</sup> On one hand, it seems straightforward. If the secrecy order is found to be a violation of the inventor's free speech, the court can order it to be lifted, and they will have free speech once more. But what if the inventor wants their redress in the form of damages or further injunctions on the use of secrecy orders? That is where it gets more difficult. For the monetary damages, even though they may be able to surpass some of the issues arising from a purely declaratory judgment status, they would have to contend with the same problems as inventors suing through the 35 U.S.C. § 183 mechanisms to acquire compensation; it is incredibly difficult to prove that they would have made any profit from the patent, and, if they cannot show that, they would not be able to show possible redress.<sup>115</sup> In regard to further injunctions, the problems from *City of Los Angeles v. Lyons* will arise once more with the issue of showing that the specific inventor from the suit would be in danger of another secrecy order. The best chance for redress is to base it primarily on the rescission of the order.

To summarize, to have standing for a purely First Amendment argument, the plaintiff must have an active secrecy order and a good argument for redress.

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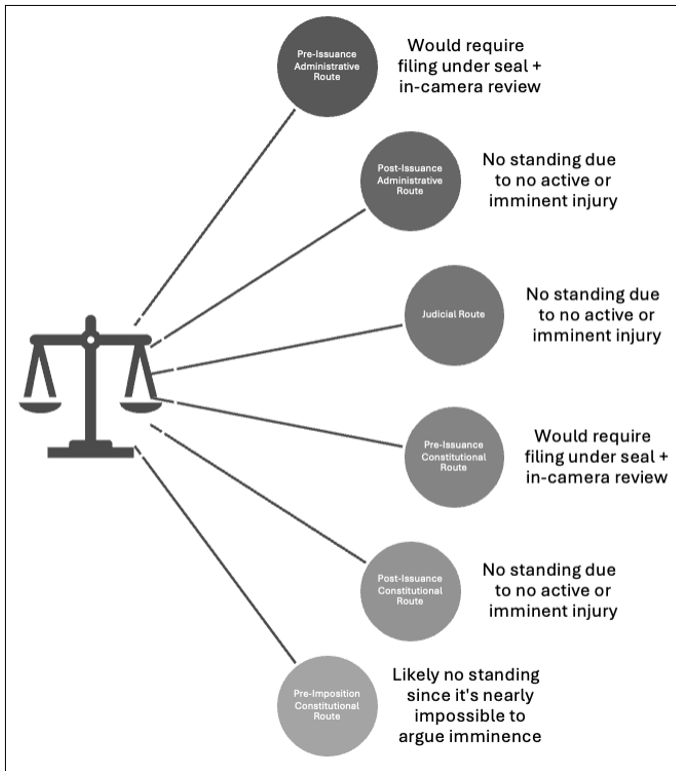
<sup>113</sup> James W. Parrett, Jr., *A Proactive Solution to the Inherent Dangers of Biotechnology: Using the Invention Secrecy Act to Restrict Disclosure of Threatening Biotechnology Patents*, 26 WM. & MARY ENV'T. L. & POL'Y REV. 145, 146 (2001) ("a secrecy order is an obvious prior restraint on the dissemination of information").

<sup>114</sup> *Lujan*, 504 U.S. 555 at 560–61.

<sup>115</sup> See 35 U.S.C. § 183; see, e.g., COMM. ON GOV'T OPERATIONS, *supra* note 4; Scott Locke, *supra* note 66, Lee, *supra* note 2; Gilbert, *supra* note 66.

### 3. The Specter of Due Process

To succinctly state the status of bringing an accusation of a First Amendment violation via secrecy order imposition to court (with a declaratory judgment action) as shown in Figure 7 below: help me pre-issuance plaintiffs (with the possibility of an in-camera review and keeping everything under seal until disclosure is allowed), you're my only hope.<sup>116</sup>



*Figure 7: Visualization of the 6 routes a Plaintiff could take to try and bring a First Amendment argument to court*

<sup>116</sup> Paraphrased from STAR WARS: EPISODE IV - A NEW HOPE, at 21:14–21:19 (1977) (“Help me Obi-Wan Kenobi, you’re my only hope.”).

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*(either as the main argument or one in the alternative) and  
how they would be affected particularly if going for a  
declaratory judgment.*

First, post-issuance plaintiffs are out of luck since they will not have standing. Second, a purely constitutional based argument is going to have to find the rare plaintiff who has the necessary requisites of (1) an active secrecy order and (2) willingness to risk possible prison time, fines, or the loss of patentability (as outlined in 35 U.S.C. § 186 on penalties for disclosure) that may result from unauthorized disclosure outside of any authorization, requested seals, or in-camera review.<sup>117</sup> Third, pre-issuance plaintiffs need to somehow overcome the state secrets privilege to get a First Amendment argument in front of the court before the order is rescinded and they no longer have standing.

Aside from the slim chance of finding a court that will not defer so much to the state secrets privilege such that the case is either (1) thrown out entirely or (2) lacks the ability to get enough quality evidence to even have a chance, the likelihood of getting this First Amendment argument heard is low. If these allegations cannot be heard in the court because it happened in the past, but the inventor could not disclose it in the past because of (1) risk of imprisonment or (2) security restrictions on judicial options, we have a situation that is seemingly unsolvable. It is also another instance of these private inventors being unable to have a fair fight in front of the court, and this inability to get a First Amendment claim sufficiently argued is, at the end of the day, simply a furtherance of their right to compensation being “more illusory than real.”<sup>118</sup>

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<sup>117</sup> 35 U.S.C. § 186.

<sup>118</sup> COMM. ON GOV'T OPERATIONS, *supra* note 4, at 2.

The requirement of active or imminent harm for standing does not necessarily create a procedural due process issue for most types of cases, but these secrecy orders put plaintiffs under unique conditions which have created a questionable regime. The opportunity for a meaningful hearing over the First Amendment rights of plaintiffs (particularly via declaratory judgment) is dubious and statistically unlikely. Should Congress or the Judiciary ever seek to amend/fix the Invention Secrecy Act and/or its corresponding litigation mechanisms to address the various problems within that have been identified over the years, it would behoove them to add some sort procedural mechanism to better allow for such arguments to be brought to the court, whether that be (1) improved capabilities for judicial review whilst still classified or (2) a way to preserve standing, alike tolling on a statute of limitations, so that a First Amendment as applied challenge in declaratory judgment form can be argued in court.

### **A SUMMARY OF THE POTENTIAL SOLUTIONS**

The intent behind the Invention Secrecy Act of 1951 was to use the patent system and its incentives for disclosure of inventions to catch and classify potential national security threats before they could fall into the public domain and the hands of foreign adversaries.<sup>119</sup> Over seventy years later, the efficacy of this Act has been affected by the ability of inventors to use the grace periods of the America Invents Act (all the while foreign filing rates increase), and there are legitimate questions of whether these orders are even constitutional under the First Amendment and due process.

Regarding the issue of efficacy, since the applications that these orders are placed on are only

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<sup>119</sup> *Id.*

0.003% of all patent applications filed each year in the United States, it would be devastating for the first-to-file world to change the AIA grace periods for the entire system simply to increase the efficacy of one Act. Instead, one solution is to place restrictions on disclosure exceptions for inventions that the applicant is *on notice* for being considered as a potential national security threat. Versions of the Patent Security Category Review Lists from the United States and other countries have been released by FOIA requests, and this shows that it *is* possible to relay at least some information so that inventors can be aware of the possibility.

Regarding the due process issue, there must be (1) improved capabilities for judicial review while a patent application is still classified and (2) a way to preserve standing, alike tolling a statute of limitations, so that a First Amendment as applied challenge in declaratory judgment form can be argued in court. It is already nearly impossible for an inventor to acquire compensation for damages inflicted by these orders, it should not be even harder for an inventor to try and defend their First Amendment rights.

Inventors put their heart and soul into their creations, and their whole livelihoods can sometimes hinge on one patent. While national security threats are a legitimate concern, the out-of-date nature of the Invention Secrecy Act since the AIA was enacted, in combination with the potential constitutional violations that it creates, places it in a questionable status that should be clarified by legislation that will *actually* protect inventors after seventy years of “illusory” rights.<sup>120</sup> This article cannot resolve the intricate balance of national security and disclosure, but the statements of Frank Cassell, then Assistant Chancellor of UW-Milwaukee, in a Congressional hearing on the topic ring strongly:

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<sup>120</sup> *Id.*

Should the executive branch of Government be able to prevent a citizen from speaking or publishing without some involvement by the courts? Should the executive branch of Government be able to invoke the claim of “national security” without demonstrating that our national security was genuinely threatened? Should defense or intelligence agencies be able to interfere with or inhibit academic research through the patent process? Is censorship an appropriate function of the Patent and Trademark Office? Who will prevent abuses of the secrecy order concept that could frighten professors and stifle research in areas someone in a defense or intelligence agency opposes?<sup>121</sup>

The system of checks and balances exists for a reason, and any restriction of the speech of private inventors needs to have its day in court.

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<sup>121</sup> *Id.* at 22.