

# Chapter 1100 Statutory Invention Registration (SIR) and Pre-Grant Publication (PG Pub)

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## 1101 Request for Statutory Invention - Registration (SIR) [R-2]

### 35 U.S.C. 157. Statutory invention registration.

(a) Notwithstanding any other provision of this title, the Director is authorized to publish a statutory invention registration containing the specification and drawings of a regularly filed application for a patent without examination if the applicant —

- (1) meets the requirements of section 112 of this title;
- (2) has complied with the requirements for printing, as set forth in regulations of the Director;
- (3) waives the right to receive a patent on the invention within such period as may be prescribed by the Director; and
- (4) pays application, publication, and other processing fees established by the Director.

If an interference is declared with respect to such an application, a statutory invention registration may not be published unless the issue of priority of invention is finally determined in favor of the applicant.

(b) The waiver under subsection (a)(3) of this section by an applicant shall take effect upon publication of the statutory invention registration.

(c) A statutory invention registration published pursuant to this section shall have all of the attributes specified for patents in this title except those specified in section 183 and sections 271 through 289 of this title. A statutory invention registration shall

not have any of the attributes specified for patents in any other provision of law other than this title. A statutory invention registration published pursuant to this section shall give appropriate notice to the public, pursuant to regulations which the Director shall issue, of the preceding provisions of this subsection. The invention with respect to which a statutory invention certificate is published is not a patented invention for purposes of section 292 of this title.

(d) The Director shall report to the Congress annually on the use of statutory invention registrations. Such report shall include an assessment of the degree to which agencies of the federal government are making use of the statutory invention registration system, the degree to which it aids the management of federally developed technology, and an assessment of the cost savings to the Federal Government of the uses of such procedures.

### 37 CFR 1.293. Statutory invention registration.

(a) An applicant for an original patent may request, at any time during the pendency of applicant's pending complete application, that the specification and drawings be published as a statutory invention registration. Any such request must be signed by (1) the applicant and any assignee of record or (2) an attorney or agent of record in the application.

(b) Any request for publication of a statutory invention registration must include the following parts:

- (1) A waiver of the applicant's right to receive a patent on the invention claimed effective upon the date of publication of the statutory invention registration;
- (2) The required fee for filing a request for publication of a statutory invention registration as provided for in § 1.17(n) or (o);

(3) A statement that, in the opinion of the requester, the application to which the request is directed meets the requirements of 35 U.S.C. 112; and

(4) A statement that, in the opinion of the requester, the application to which the request is directed complies with the formal requirements of this part for printing as a patent.

(c) A waiver filed with a request for a statutory invention registration will be effective, upon publication of the statutory invention registration, to waive the inventor's right to receive a patent on the invention claimed in the statutory invention registration, in any application for an original patent which is pending on, or filed after, the date of publication of the statutory invention registration. A waiver filed with a request for a statutory invention registration will not affect the rights of any other inventor even if the subject matter of the statutory invention registration and an application of another inventor are commonly owned. A waiver filed with a request for a statutory invention registration will not affect any rights in a patent to the inventor which issued prior to the date of publication of the statutory invention registration unless a reissue application is filed seeking to enlarge the scope of the claims of the patent. See also § 1.104(c)(5).

A request for a statutory invention registration (SIR) may be filed at the time of filing a nonprovisional application for patent, or may be filed later during pendency of a nonprovisional application. The fee

required (37 CFR 1.17(n) or (o)) depends on when the request is filed. The application to be published as a SIR must be complete as set forth in 37 CFR 1.51(b) including a specification with a claim or claims, an oath or declaration, and drawings when necessary. Applicants should use the format set forth in form PTO/SB/94, Request for Statutory Invention Registration. Form PTO/SB/94 is available from the USPTO website ([www.uspto.gov](http://www.uspto.gov)), and it is reproduced \*\*>at the end of< this section.

A provisional application cannot include a request for a SIR.

Requests for statutory invention registrations, including those submitted in utility, plant, and design applications, are handled in art units 3641 and 3662 of Technology Center (TC) 3600. Accordingly, incoming new applications which include a request for a SIR will be processed like other new applications in the Office of Initial Patent Examination (OIPE) and then forwarded to TC 3600. TC 3600 may be assisted by other Technology Centers when the subject matter of the application makes it necessary or desirable. For example, TC 1600 may handle issues under 35 U.S.C. 112 in applications involving biotechnology.

Applications not already assigned to art unit 3641 or 3662 which receive a request for a SIR (or any other indication that they are to be published as a SIR) should be forwarded with a brief explanation to one of these art units via the technical support staff of the TC to which the application is assigned. The forwarding TC should first determine whether an Office action

has been mailed in the application and issue proper SIR disposal credit to the examiner who prepared any such action where appropriate. Art unit 3662 handles applications including a request for a SIR that are electrical in nature and those that are related to computer science. Accordingly, applications from TCs 2100, 2600, and 2800 should be forwarded to art unit 3662. All other applications including a request for a SIR should be forwarded to art unit 3641. An examiner in art unit 3641 or 3662 will determine whether the request for a SIR is proper. An examiner who is not in one of these two art units should make no comment to the applicant regarding what effect the filing of a request for a SIR may have had on any outstanding rejection.

It should be noted that 37 CFR 1.211 requires the publication of most nonprovisional applications (other than for a design patent filed under 35 U.S.C. 171 and reissue applications filed under 35 U.S.C. 251) filed on or after November 29, 2000. Exceptions to publication are set forth in 35 U.S.C. 122(b)(2) and 37 CFR 1.211. Further, voluntary publication may be requested under 37 CFR 1.221(a) for applications filed before, but pending on, November 29, 2000. An applicant may find publication of an application to be a desirable alternative to requesting a SIR since publication of the application is achieved without any waiver of patent rights. >See MPEP § 1120 *et seq.* for more information pertaining to eighteen months publication of patent applications.<

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PTO/SB/94 (05-03)  
 Approved for use through 04/30/2006. OMB 0651-0036  
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## Request for Statutory Invention Registration

Application Number \_\_\_\_\_, or  attached hereto

Filed: \_\_\_\_\_

Titled: \_\_\_\_\_

Applicant(s): \_\_\_\_\_

A. In the above identified patent application, I hereby:

1. Request and authorize the Director of Patent and Trademark Office to publish the above identified regularly filed patent application as a Statutory Invention Registration. (35 U.S.C. 157)
2. Waive the right to receive a United States patent on the same invention claimed in the above identified patent application. These rights, which are waived, include those specified in 35 U.S.C. 183 and 271 through 289 as well as all attributes specified for patents in any other provisions of law other than title 35, United States Code. The waiver includes, but is not limited to, the remedies under 19 U.S.C. 1337 and 1337a, 22 U.S.C. 2356 and 28 U.S.C. 1498. (35 U.S.C. 157(c))
3. Understand that the above waiver will be effective pursuant to 37 CFR 1.293 upon publication of the Statutory Invention Registration to waive the inventor's right to receive a United States patent on the invention claimed in the Statutory Invention Registration. (37 CFR 1.293(b)(1))
4. State that, in my opinion, the disclosure and claims of the above identified patent application meet the requirements of 35 U.S.C. 112. (37 CFR 1.293(b)(3))
5. State that, in my opinion, the above identified patent application complies with the requirements for printing as set forth in the Rules of Practice for Patent Cases, 37 CFR Part 1. (37 CFR 1.293(b)(4))
6. Enclose the fee set forth in 37 CFR 1.17(n) or (o) for requesting publication of a Statutory Invention Registration:

A first Office Action has not been mailed in the above application, 37 CFR 1.17(n) \_\_\_\_\_ \$ \_\_\_\_\_

A first Office Action has been mailed in the above application, 37 CFR 1.17(o) \_\_\_\_\_ \$ \_\_\_\_\_

Request fee \$ \_\_\_\_\_

MINUS BASIC FILING FEE, IF PREVIOUSLY PAID

Basic filing fee for utility patent application set forth in 37 CFR 1.16(a);

Basic filing fee for design patent application set forth in 37 CFR 1.16(f); or

Basic filing fee for plant patent application set forth in 37 CFR 1.16(g)

Minus basic filing fee \$ \_\_\_\_\_

Amount due \$ \_\_\_\_\_

Payment charged to credit card \_\_\_\_\_ Form PTO-2038 is attached.

Amount enclosed by check or money order \_\_\_\_\_

Please charge Deposit Account No. \_\_\_\_\_ the amount of \$ \_\_\_\_\_

If payment of any additional fee is required for publication of the Statutory Invention Registration, charge such amount to Deposit Account No. \_\_\_\_\_

\* Where this request is submitted at the time the application is filed, the filing fee is included in the fee.

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This collection of information is required by 37 CFR 157. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 24 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

PTO/SB/94 (05-03)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

B. For printing of the Statutory Invention Registration front page, if desired, list below the name(s) of not more than 3 registered patent attorneys and agents OR alternatively, the name of a firm having as a member a registered patent attorney or agent. If no name is listed below, no name will be printed on the Statutory Invention Registration.

\_\_\_\_\_  
\_\_\_\_\_

C. Name of assignee, if any, for printing on the Statutory Invention Registration \_\_\_\_\_  
Address (City and State or Country) \_\_\_\_\_  
State of incorporation, if assignee is a corporation \_\_\_\_\_

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

\_\_\_\_\_  
Signature(s) (37 CFR 1.293(a))  
 attorney or agent of record  applicant(s) and any assignee

### 1103 Examination of a SIR [R-2]

*37 CFR 1.294. Examination of request for publication of a statutory invention registration and patent application to which the request is directed.*

(a) Any request for a statutory invention registration will be examined to determine if the requirements of § 1.293 have been met. The application to which the request is directed will be examined to determine (1) if the subject matter of the application is appropriate for publication, (2) if the requirements for publication are met, and (3) if the requirements of 35 U.S.C. 112 and § 1.293 of this part are met.

(b) Applicant will be notified of the results of the examination set forth in paragraph (a) of this section. If the requirements of § 1.293 and this section are not met by the request filed, the notification to applicant will set a period of time within which to comply with the requirements in order to avoid abandonment of the application. If the application does not meet the requirements of 35 U.S.C. 112, the notification to applicant will include a rejection under the appropriate provisions of 35 U.S.C. 112. The periods for reply established pursuant to this section are subject to the extension of time provisions of § 1.136. After reply by the applicant, the application will again be considered for publication of a statutory invention registration. If the requirements of § 1.293 and this section are not timely met, the refusal to publish will be made final. If the requirements of 35 U.S.C. 112 are not met, the rejection pursuant to 35 U.S.C. 112 will be made final.

(c) If the examination pursuant to this section results in approval of the request for a statutory invention registration the applicant will be notified of the intent to publish a statutory invention registration.

An examiner in Art Unit 3641 or 3662, where appropriate, will determine whether the application in which a request for a statutory invention registration has been filed is a pending nonprovisional application. If the application was abandoned at the time the request was filed, has been patented, or has been allowed and the issue fee paid, the examiner should return the SIR request to the requester accompanied by a Return of Statutory Invention Registration Request to Requester notice (form \*>SIR-C<).

If the application is pending, the examiner should ascertain whether an Office action with a rejection under 35 U.S.C. 112 has been issued and not replied to. If so, and if there remains any time to reply to the rejection, the examiner should send the applicant a courtesy notice requiring a timely reply. If no time for reply remains, the application is abandoned and the examiner should inform the applicant of this fact.

After the examiner handling the SIR has ascertained that all outstanding rejections under 35 U.S.C. 112 have been replied to, the examiner should verify

that the request for a SIR meets the requirements of 37 CFR 1.293. First, applicant should be notified of any defects in the signature on the SIR request or of any inadequacy of the SIR fee. A 1-month time period should be set for applicant to correct the signature or fee before any further consideration of the SIR request is given. \*\*>A Notice of Improper Request for a Statutory Invention Registration (form SIR-E)< may be used for this purpose. Next, applicant should be given 1 month to correct any other informalities in the SIR request under 37 CFR 1.293 and any informalities in the application under 37 CFR 1.294 using a Notice of Informal Statutory Invention Registration (SIR) Request, form \*>SIR-F<. The examiner should also determine whether the application complies with 35 U.S.C. 112. If not, a rejection with a 3-month shortened statutory period for reply should be made using a Notice of Noncompliance with 35 U.S.C. 112 of application having SIR Request, form \*>SIR-I<. Both form \*>SIR-F< and form \*>SIR-I< can be mailed at the same time. If they are, applicant should be given a 3-month shortened statutory period to reply to both forms.

If applicant's reply to form \*>SIR-F< does not correct the defects, the SIR request should be finally refused using a Notice of Final Refusal of Informal Statutory Invention Registration (SIR) Request, form \*>SIR-G<. If applicant's reply to the rejection set forth on form \*>SIR-I< does not bring the application into compliance with 35 U.S.C. 112, the rejection should be made final.

After the application complies with 37 CFR 1.293, 37 CFR 1.294, and 35 U.S.C. 112, the examiner should determine whether the application is involved in a pending interference. If so, applicant should be notified, using form \*>SIR-J<, that no decision will be made on the SIR request until the interference proceedings are concluded.

If the applicant has lost priority of any claims due to a concluded interference, applicant should be given 1 month, using form \*>SIR-K<, to cancel the lost claims (if a statutory invention registration is still desired with claims on which priority was not lost) or to request withdrawal of the request for statutory invention registration (if further prosecution as to patentability is desired). See MPEP § 1109. If none of the claims in the application was lost in interference, and if the application complies with 37 CFR 1.293,

37 CFR 1.294, and 35 U.S.C. 112, then the application is in condition to be prepared for publication. See MPEP § 1107.

An application under secrecy order will be withheld from publication during such period as the national interest requires, and the applicant should be informed of this fact by using a Notice of Statutory Invention Registration \* Acceptance (Form D-11), form \*>SIR-N (Form D-11)<.

## 1105 Review of Final Refusal to Publish SIR [R-2]

*37 CFR 1.295. Review of decision finally refusing to publish a statutory invention registration.*

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(a) Any requester who is dissatisfied with the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 may obtain review of the refusal to publish the statutory invention registration by filing a petition to the Director accompanied by the fee set forth in § 1.17(h) within one month or such other time as is set in the decision refusing publication. Any such petition should comply with the requirements of § 1.181(b). The petition may include a request that the petition fee be refunded if the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 is determined to result from an error by the Patent and Trademark Office.<

(b) Any requester who is dissatisfied with a decision finally rejecting claims pursuant to 35 U.S.C. 112 may obtain review of the decision by filing an appeal to the Board of Patent Appeals and Interferences pursuant to § 1.191. If the decision rejecting claims pursuant to 35 U.S.C. 112 is reversed, the request for a statutory invention registration will be approved and the registration published if all of the other provisions of § 1.293 and this section are met.

An applicant who is dissatisfied with a final refusal to publish a SIR for reasons other than compliance with 35 U.S.C. 112 may obtain review by filing a petition as set forth in 37 CFR 1.295(a). The petition should be directed to the TC Director responsible for the art unit handling the SIR.

An applicant who is dissatisfied with a decision finally rejecting claims under 35 U.S.C. 112 may obtain review by filing an appeal with the Board of Patent Appeals and Interferences as set forth in 37 CFR 1.295(b).

## 1107 Preparing a SIR for Publication [R-2]

>For Image File Wrapper (IFW) processing, see the IFW Manual.<

In preparing a nonprovisional application with a SIR request for publication, the examiner should fill out the face of the application file wrapper in the same manner as in a non-SIR application. Additionally, the examiner should add the notation “OK for SIR” in the space provided for the primary examiner’s signature and “SIR” should be indicated next to the space for the patent number. A form \*>PTO-SIR-M< is attached to the “LABEL AREA” on the face of the file wrapper to indicate that the application is for a statutory invention registration. An issue classification slip (form PTO-270 or PTO-328) is filled out and attached inside the file wrapper for series 08/ and earlier applications in the normal manner with the additional notation of “SIR” added to the left side of the space allocated for the patent number. The index of claims inside the left flap of the file wrapper is filled out, with the notation “\*” indicating the claims to be published in the SIR. The final official classification of the application and the figure to be published in the *Official Gazette* are indicated, as in non-SIR applications, on the front of the file wrapper.

A Notice of Intent to Publish Statutory Invention Registration, form \*>SIR-L<, is prepared and sent to the applicant. Requirements for corrected or formal drawings and examiner’s amendments may be attached to the Notice of Intent to Publish Statutory Invention Registration as needed. If corrected drawings are required, the examiner should set a 3 month shortened statutory period for submission of the drawings and indicate that the shortened statutory period is not extendable under 37 CFR 1.136(a) or 37 CFR 1.136(b). After the form \*>SIR-L< has been mailed, the application is forwarded to the Office of Patent Publication.

## 1109 Withdrawal of SIR Request [R-2]

*37 CFR 1.296. Withdrawal of request for publication of statutory invention registration.*

A request for a statutory invention registration, which has been filed, may be withdrawn prior to the date of the notice of the intent to publish a statutory invention registration issued pursuant to § 1.294(c) by filing a request to withdraw the request for publication of a statutory invention registration. The request to withdraw

may also include a request for a refund of any amount paid in excess of the application filing fee and a handling fee of \$130.00 which will be retained. Any request to withdraw the request for publication of a statutory invention registration filed on or after the date of the notice of intent to publish issued pursuant to § 1.294(c) must be in the form of a petition pursuant to § 1.183 accompanied by the fee set forth in § 1.17(h).

If a request to withdraw a SIR is filed in a nonprovisional application which contains a SIR request before a Notice of Intent to Publish Statutory Invention Registration has been mailed, the examiner handling the SIR should ascertain whether any outstanding rejection under 35 U.S.C. 112 is present in the application. If so, the examiner should require a timely reply to the rejection using a Response to Request to Withdraw Request for a Statutory Invention Registration, form \*>SIR-K<. After a timely reply to the rejection is received, the request to withdraw the SIR request will ordinarily be granted and the application forwarded for further examination to whichever art unit would ordinarily examine the art area in which the application is classifiable.

Any request to withdraw a SIR filed after the mailing date of the Notice of Intent to Publish Statutory Invention Registration must be in the form of a petition pursuant to 37 CFR 1.183 accompanied by the fee set forth in 37 CFR 1.17(h). The TC Director responsible for the art unit handling the SIR will inform the applicant of the decision on the petition via a form \*>SIR-K< or Response to Petition under 37 CFR 1.295(a), form \*>SIR-H<.

Note that an original SIR application can be abandoned in favor of a continuing application for a patent, claiming the filing date of the earlier filed application, by filing an express abandonment of the original application and a timely request or petition to withdraw the request for a SIR prior to publication of the SIR.

## 1111 SIR Publication and Effect

37 CFR 1.297. *Publication of statutory invention registration.*

(a) If the request for a statutory invention registration is approved the statutory invention registration will be published. The statutory invention registration will be mailed to the requester at the correspondence address as provided for in § 1.33(a). A notice of the publication of each statutory invention registration will be published in the *Official Gazette*.

(b) Each statutory invention registration published will include a statement relating to the attributes of a statutory invention registration. The statement will read as follows:

A statutory invention registration is not a patent. It has the defensive attributes of a patent but does not have the enforceable attributes of a patent. No article or advertisement or the like may use the term patent, or any term suggestive of a patent, when referring to a statutory invention registration. For more specific information on the rights associated with a statutory invention registration see 35 U.S.C. 157.

Published SIRs are sequentially numbered in a separate “H” series, starting with number “H1”. For a description of the “kind codes” used on other documents published by the U.S. Patent and Trademark Office, see MPEP § 901.04(a).

In accordance with 35 U.S.C. 157(c), a published SIR will be treated the same as a U.S. patent for all defensive purposes, usable as a reference as of its filing date in the same manner as a patent. A SIR is a “constructive reduction to practice” under 35 U.S.C. 102(g) and “prior art” under all applicable sections of 35 U.S.C. 102 including section 102(e). SIRs are classified, cross-referenced, and placed in the search files, disseminated to foreign patent offices, stored in U.S. Patent and Trademark Office computer tapes, made available in commercial data bases, and announced in the *Official Gazette*.

The waiver of patent rights to the subject matter claimed in a statutory invention registration takes effect on publication (37 CFR 1.293(c)) and may affect the patentability of claims in related applications without SIR requests, such as divisional or other continuing applications, since the waiver of patent rights is effective for all inventions claimed in the SIR and would effectively waive the right of the inventor to obtain a patent on the invention claimed in the same application or on the same invention claimed in any other application not issued before the publication date of the SIR. If an application containing generic claims is published as a SIR, the waiver in that application applies to any other related applications to the extent that the same invention claimed in the SIR is claimed in the other application. Examiners should apply standards similar to those applied in making “same invention” double patenting determinations to determine whether a waiver by an inventor to claims in a SIR precludes patenting by the same inventor to subject matter in any related application. If the same

subject matter is claimed in an application and in a published statutory invention registration naming a common inventor, the claims in the application should be rejected as being precluded by the waiver in the statutory invention registration. See 37 CFR 1.104(c)(5). A rejection as being precluded by a waiver in a SIR cannot be overcome by a terminal disclaimer.

The holder of a SIR will not be able to file a reissue application to recapture the rights, including the right to exclude others from making, using, selling, offering to sell, or importing the invention, that were waived by the initial publication of the SIR.

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## 1120 Eighteen-Month Publication of Patent Applications [R-2]

35 U.S.C. 122. *Confidential status of applications; publication of patent applications.*

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### (b) PUBLICATION.—

#### (1) IN GENERAL.—

(A) Subject to paragraph (2), each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title. At the request of the applicant, an application may be published earlier than the end of such 18-month period.

(B) No information concerning published patent applications shall be made available to the public except as the Director determines.

(C) Notwithstanding any other provision of law, a determination by the Director to release or not to release information concerning a published patent application shall be final and nonreviewable.

#### (2) EXCEPTIONS.—

(A) An application shall not be published if that application is—

- (i) no longer pending;
- (ii) subject to a secrecy order under section 181 of this title;
- (iii) a provisional application filed under section 111(b) of this title; or
- (iv) an application for a design patent filed under chapter 16 of this title.

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### 37 CFR 1.211. *Publication of applications.*

(a) Each U.S. national application for patent filed in the Office under 35 U.S.C. 111(a) and each international application in compliance with 35 U.S.C. 371 will be published promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code, unless:

(1) The application is recognized by the Office as no longer pending;

(2) The application is national security classified (see § 5.2(c)), subject to a secrecy order under 35 U.S.C. 181, or under national security review;

(3) The application has issued as a patent in sufficient time to be removed from the publication process; or

(4) The application was filed with a nonpublication request in compliance with § 1.213(a).

(b) Provisional applications under 35 U.S.C. 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16 and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section.

(c) An application filed under 35 U.S.C. 111(a) will not be published until it includes the basic filing fee (§ 1.16(a) or 1.16(g)), any English translation required by § 1.52(d), and an executed oath or declaration under § 1.63. The Office may delay publishing any application until it includes a specification having papers in compliance with § 1.52 and an abstract (§ 1.72(b)), drawings in compliance with § 1.84, and a sequence listing in compliance with §§ 1.821 through 1.825 (if applicable), and until any petition under § 1.47 is granted.

(d) The Office may refuse to publish an application, or to include a portion of an application in the patent application publication (§ 1.215), if publication of the application or portion thereof would violate Federal or state law, or if the application or portion thereof contains offensive or disparaging material.

(e) The publication fee set forth in § 1.18(d) must be paid in each application published under this section before the patent will be granted. If an application is subject to publication under this section, the sum specified in the notice of allowance under § 1.311 will also include the publication fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable. If the application is not published under this section, the publication fee (if paid) will be refunded. <

## I. IN GENERAL

With certain exceptions, nonprovisional utility and plant applications for patent filed on or after November 29, 2000 are published promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code (eighteen-month publication or pre-grant publication (PGPub)). See 35 U.S.C. 122(b). The Office will generally publish:



(A) utility and plant applications filed under 35 U.S.C. 111(a) on or after November 29, 2000; and

(B) nonprovisional applications which entered the national stage after compliance with 35 U.S.C. 371 from an international application under 35 U.S.C. 363 filed on or after November 29, 2000 (regardless of whether the international application has been published by the International Bureau (IB) under PCT Article 21 in English).

The Office will not publish the following applications under 35 U.S.C. 122(b):

(A) Provisional applications filed under 35 U.S.C. 111(b) (for more information see subsection II. EXCEPTIONS below);

(B) Design applications filed under 35 U.S.C. 171; and

(C) Reissue applications filed under 35 U.S.C. 251 (because reissue applications are not kept confidential under 35 U.S.C. 122(a)).

Applications will be published after the expiration of a period of eighteen months from the earliest of: (1) the U.S. filing date; (2) the international filing date; or (3) the filing date of an earlier application if the application claims benefit of the earlier application under 35 U.S.C. 119, 120, 121, or 365. Applicants are encouraged to timely submit any desired priority and benefit claims to ensure that their applications will be published on time and to avoid the need to file a petition to accept unintentionally delayed priority or benefit claims under 37 CFR 3651.55 or 1.78 and the surcharge set forth in 37 CFR 1.17(t). See MPEP § 201.11 and § 201.13. Applications are normally published based on the application as filed and certain amendments. See MPEP § 1121. A proper continued prosecution application (CPA) for utility or plant patent filed on or after November 29, 2000 will be published based upon the application papers deposited on the filing date of the first prior application. (Note: CPA practice has been eliminated as to utility and plant applications effective July 14, 2003. See MPEP § 201.06(d).) Since a request for continued examination (RCE) under 37 CFR 1.114 is not the filing of a new application, filing an RCE will not cause an application filed before November 29, 2000 to be published. The Office will not mail a paper copy of the patent application publication to the applicant, but will mail a notice to the applicant indicating that the

application has been published. See MPEP § 1127. Patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)).

## II. EXCEPTIONS

An application will not be published if one of the following exceptions as set forth in 37 CFR 1.211 applies:

(A) The application is recognized by the Office as no longer pending; for information on express abandonment to avoid publication see 37 CFR 1.138(c) and MPEP § 1125;

(B) The application is national security classified (see 37 CFR 5.2(c)), subject to a secrecy order under 35 U.S.C. 181, or under national security review;

(C) The application has issued as a patent in sufficient time to be removed from the publication process; or

(D) The application was filed with a nonpublication request in compliance with 37 CFR 1.213(a). See MPEP §§ 1122-1124.

The Office will not publish applications that are recognized as no longer pending. See 37 CFR 1.211(a)(1). An application is not “recognized by the Office as no longer pending” when the period for reply (either the shortened statutory period for reply or the maximum extendable period for reply) to an Office action has expired, but the Office has not yet entered the change of status (to abandoned) of the application in the Office’s Patent Application Locating and Monitoring (PALM) system and mailed a notice of abandonment. An application will remain in the publication process until the PALM system indicates that the application is abandoned. Once the PALM system indicates that an application is abandoned, the Office will attempt to remove the application from the publication process and avoid dissemination of the application information.

Unless an applicant has received a notice of abandonment at least 4 weeks prior to the projected publication date, an applicant who wants to abandon the application to avoid publication must file a petition under 37 CFR 1.138(c) to expressly abandon the application and avoid publication. See MPEP § 1125. An applicant who seeks to avoid publication by permitting an application to become abandoned (for failure to reply to an Office action) and passively waiting

for the Office to recognize that the application has become abandoned bears the risk that the Office will not recognize that the application has become abandoned and change the status of the application in the PALM system in sufficient time to avoid publication.

The Office will not publish applications that have issued as patents in sufficient time to be removed from the publication process. See 37 CFR 1.211(a)(3). If the pre-grant publication process coincides with the patent issue process, the Office will continue with the pre-grant publication process until a patent actually issues. This is because there are many instances in which the Office mails a notice of allowance in an application but the application does not issue as a patent in regular course (e.g., abandonment due to failure to pay the issue fee, or withdrawal from issue). Therefore, the Office will not discontinue the pre-grant publication process until a patent has actually issued. Since the Office cannot discontinue the pre-grant publication process during the last two to four weeks of the publication process, this will result in a few applications being issued as patents and subsequently being published as patent application publications.

The Office may refuse to publish an application, or to include a portion of an application in the publication, if publication of the application or portion thereof would violate Federal or state law, or if the application or portion thereof contains offensive or disparaging material. See 37 CFR 1.211(d). The Office may require a substitute specification to delete the portion of the application that would violate Federal or state law, or that contains offensive or disparaging material.

Converting a nonprovisional application to a provisional application will not avoid the publication of the nonprovisional application unless the request to convert is recognized in sufficient time to permit the appropriate officials to remove the nonprovisional application from the publication process. The Office cannot ensure that it can remove an application from the publication process or avoid publication of application information any time after the publication process for the application has been initiated. Technical preparations for publication of an application generally begin four months prior to the projected publication date. The projected publication date is indicated on the filing receipt for the patent application.

### III. APPLICATION MUST BE COMPLETE

In accordance with 37 CFR 1.211(c), publication will not occur or will be delayed in certain circumstances. The Office will not publish an application until the application includes:

- (A) the basic filing fee;
- (B) an English translation if the application is in a language other than English; and
- (C) an executed oath or declaration under 37 CFR 1.63.

The Office may delay publication until the application includes:

- (A) a specification in compliance with 37 CFR 1.52;
- (B) an abstract in compliance with 37 CFR 1.72(b);
- (C) drawings (if any) in compliance with 37 CFR 1.84; and
- (D) a sequence listing in compliance with 37 CFR 1.821 through 1.825 (if applicable).

The Office may also delay publication until any petition under 37 CFR 1.47 is granted.

If an application does not contain the content specified in 37 CFR 1.211(c) and papers or drawings of sufficient quality to create a patent application publication by eighteen months from the earliest filing date for which benefit is claimed, the Office will publish the application as soon as practical after these deficiencies are corrected. For example, publication of the patent application publication may be delayed if the application papers submitted on the filing date of the application do not include the content needed (e.g., an abstract or an executed oath or declaration) or the specification (including claims) or drawings are not of sufficient quality to be used to create a patent application publication. In such a situation, the Office will issue a preexamination notice requiring a substitute specification or replacement drawings. The applicant's reply (e.g., substitute specification or replacement drawings) to the notice will be used for creating the patent application publication. If the application on filing includes papers that are of sufficient quality to create the publication, the Office will publish the application using the originally filed application papers.

Applicants who attempt to delay publication by intentionally delaying the submission of the application content necessary for publication may encounter a reduction in any patent term adjustment under 35 U.S.C. 154(b). See 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

**IV. PROJECTED PUBLICATION DATE**

Once the application is complete, the Office will provide applicants the projected publication date of the application on a filing receipt. The projected publication date normally will be the later of: (1) eighteen months from the earliest filing date claimed; or (2) fourteen weeks from the mailing date of the filing receipt. The publication process takes about fourteen weeks. Publication occurs on Thursday of each week.

Applicants should carefully and promptly review their filing receipts. Applicants should contact the Pre-Grant Publication Division (see MPEP § 1730) if the projected publication date is incorrect or if a projected publication date has been assigned to an application that should not be published. Applicants should also promptly check any priority or benefit claims provided on the filing receipt and timely file any desired priority or benefit claims if the filing receipt does not include the desired claims. This will avoid the need to file a petition under 37 CFR 1.55 or 1.78 to accept unintentionally delayed claims and the surcharge under 37 CFR 1.17(t). See MPEP §§ 201.11 and 201.13. <

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**1121 Content of a Patent Application Publication [R-2]**

*37 CFR 1.215. Patent application publication*

(a) The publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The date of publication shall be indicated on the patent application publication. The patent application publication will be based upon the application papers deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application, and any application papers or drawings submitted in reply to a preexamination notice requiring a title and abstract in compliance with § 1.72, application papers in compliance with § 1.52, drawings in compliance with § 1.84, or a sequence listing in compliance with §§ 1.821 through 1.825, except as otherwise provided in this section. The patent application publication will not include any amendments, including preliminary amendments, unless applicant supplies a copy of the application containing the amendment pursuant to paragraph (c) of this section.

(b) If applicant wants the patent application publication to include assignee information, the applicant must include the assignee information on the application transmittal sheet or the application data sheet (§ 1.76). Assignee information may not be included on the patent application publication unless this information is provided on the application transmittal sheet or application data sheet included with the application on filing. Providing this information on the application transmittal sheet or the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) At applicant’s option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or declaration) as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

(d) If the copy of the application submitted pursuant to paragraph (c) of this section does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in paragraph (a) of this section. If, however, the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.

A patent application publication includes a front page containing information similar to that contained on the front page of a patent, the drawings (if any), and the specification (including claims). The patent application publication will generally be based upon the following:

(A) The patent application papers and drawings deposited on the filing date of the application;

(B) The executed oath or declaration submitted to complete the application;

(C) Any subsequently filed application papers and drawings submitted in reply to a preexamination notice requiring a title and abstract in compliance with 37 CFR 1.72, application papers in compliance with 37 CFR 1.52, drawings in compliance with 37 CFR 1.84, or a sequence listing in compliance with 37 CFR 1.821 through 1.825; and

(D) The correspondence address for the application according to Office records at the time the publication process was initiated.

The patent application publication may also be based upon amendments that expedite the publication process, provided that such amendments are submitted in sufficient time to be entered into the application

file before technical preparations for publication of the application have begun (generally four months prior to the projected publication date). For example, the patent application publication may also be based upon:

(A) Amendments to the specification that are reflected in a substitute specification under 37 CFR 1.125(b);

(B) An amendment to the abstract under 37 CFR 1.121(b);

(C) Amendments to the claims that are reflected in a complete claim listing under 37 CFR 1.121(c); and

(D) Amendments to drawings under 37 CFR 1.121(d).

The patent application publication of an application that has entered the national stage under 35 U.S.C. 371 may also include amendments made during the international stage, such as: amendments under Article 34 and 19; rectifications; corrections of physical defects under PCT Rule 26; and an abstract rewritten by the International Searching Authority.

If an applicant wants the publication to include drawings other than those submitted with the application as filed (e.g., better quality or amended drawings), applicant may file the replacement drawings in sufficient time to be entered into the application file before four months prior to the projected publication date. The Office cannot guarantee that the latest amendment or any particular amendment will be included in the patent application publication. If applicant wishes to have a particular amended specification (including claims) and drawings to be included in the publication, applicants must submit the amended specification (including claims) and drawings via the electronic filing system (EFS) within one month of the mailing date of the first Office correspondence (e.g., filing receipt) including a confirmation number for the application or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later (see 37 CFR 1.215(c) and *Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes*, 1241 *Off. Gaz. Pat. Office* 97 (December 12, 2000)). See also III. AMENDED APPLICATION FILED VIA EFS, below. The Office will use the elec-

tronic copy provided by the applicant to create the publication. A proper continued prosecution application (CPA) filed on or after November 29, 2000 (but before July 14, 2003) will be published based upon the application papers deposited on the filing date of the first prior application.

Applicants may review the bibliographic information contained in the Office's database, and application papers that have been scanned into the Image File Wrapper system, via the Office's Patent Application Information Retrieval (PAIR) system. Applicants should bring any errors to the Office's attention before technical preparations for publication of the application have begun (generally four months prior to the projected publication date).

Long nucleotide and/or amino acid sequences or large numbers of such sequences are very difficult for the Office to publish as part of patent application publications. Therefore, long sequence listings will only be published in electronic form on the USPTO sequence homepage (<http://seqdata.uspto.gov>) as an ASCII text file. The patent application publication will include a statement that the application contains a lengthy sequence listing section and a hyperlink to the web page containing the sequence listing. See *Notice of Change in Publishing of Patents and Patent Application Publications With Sequence Listings*, 1250 *Off. Gaz. Pat. Office* 70 (September 11, 2001).

## I. AMENDMENTS

The patent application publication will be based on certain amendments, including preliminary amendments as discussed above (e.g., amended application filed via EFS). To avoid submitting preliminary amendments, applicants should incorporate any desired amendments into the text of the specification including a new set of claims, even where the application is a continuation or divisional application of a previously-filed patent application. In such a continuation or divisional application, a new specification (e.g., reflecting amendments made in the parent application) may be submitted together with a copy of the oath or declaration from the previously filed application so long as no new matter is included in the specification. See 37 CFR 1.63(d)(1)(iii). Additionally, applications with poor quality text, which may be acceptable for scanning and examination purposes, may lead to errors in the patent application publica-

tion. Correction of these errors and inclusion of any desired amendments into the text of the originally-filed specification and drawings will only occur if applicant files a request for republication under 37 CFR 1.221(a). They will not be corrected by the Office in a corrected publication under 37 CFR 1.221(b). See MPEP § 1130.

**II. APPENDICES**

Appendices, other than those containing sequence listings or certain tables, are not printed if they are contained on pages located after the claims. If the application includes multiple claim sets in the specification, the Office may treat pages located after the first set of claims as appendices. Note that computer program listings may be printed if they are included in the specification before the claims, but that computer program listings that are provided on compact disc in accordance with 37 CFR 1.96(c) and 1.52(e) are not printed as part of the patent or patent application publication.

**III. AMENDED APPLICATION FILED VIA EFS**

At applicant’s option, a patent application publication may be based upon an amended specification (including claims) and drawings filed via the Electronic Filing System (EFS). See 37 CFR 1.215(c). If applicant files a replacement copy of the specification (including claims) and drawings through EFS within one month of the filing date of the application or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later, the replacement copy will be used in printing the patent application publication. Since a confirmation number must be used when submitting an EFS copy of the application for publication, the Office will accept an EFS copy of the application submitted within one month of the mailing date of the first Office correspondence containing a confirmation number (e.g., filing receipt). See *Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes*, 1241 *Off. Gaz. Pat. Office* 97 (December 12, 2000). If the replacement copy is submitted outside the time period, it may still be used to create the patent application publication so long as it is received before the Office has started the publica-

tion process. For further information about EFS, see the Electronic Business Center on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)).

**IV. ASSIGNEE INFORMATION**

If the applicant would like the assignee data to be published, the information should be provided on the application transmittal letter or the application data sheet (ADS) filed with the application. The applicant may also submit the information via PAIR using the “Bib-Data Review Prior to Publication” screens or submit a letter to the Office requesting that the assignee’s name be included on the patent application publication, and request a corrected filing receipt acknowledging the request. Requests to include assignment data that are submitted after the filing date of the application will only result in the patent application publication including the assignment data if it is received and entered before the publication process has begun. If the assignee data is recorded with the Assignment Division only, the information will not be published as part of the patent application publication.

Errors in assignee information printed on the publication are not considered material mistakes by the Office under 37 CFR 1.221(b) (e.g., errors in the assignee’s name). See MPEP § 1130. Thus, these assignment errors and applicant’s failure to include assignment data may only be corrected if applicant files a request for republication under 37 CFR 1.221(a).<

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**1122 Requests for Nonpublication [R-2]**

35 U.S.C. 122. *Confidential status of applications; publication of patent applications.*

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(b) PUBLICATION.—

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(2) EXCEPTIONS.—

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(B)(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

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*37 CFR 1.213. Nonpublication request.*

(a) If the invention disclosed in an application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the application will not be published under 35 U.S.C. 122(b) and § 1.211 provided:

(1) A request (nonpublication request) is submitted with the application upon filing;

(2) The request states in a conspicuous manner that the application is not to be published under 35 U.S.C. 122(b);

(3) The request contains a certification that the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing; and

(4) The request is signed in compliance with § 1.33(b).

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If the invention disclosed in an application filed under 35 U.S.C. 111(a) has not been and will not be the subject of a foreign or international application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing (e.g., a counterpart PCT application), applicants may request that the application filed under 35 U.S.C. 111(a) not be published by filing a nonpublication request under 37 CFR 1.213(a). The Office will not publish an application filed under 35 U.S.C. 111(a) with a nonpublication request in compliance with the following:

(A) The request for nonpublication under 37 CFR 1.213(a) must be submitted with the application **upon filing** (this is a statutory requirement and cannot be waived);

(B) The request for nonpublication must state in a **conspicuous** manner that the application is not to be published under 35 U.S.C. 122(b) (see Form PTO/SB/35 in MPEP § 1135);

(C) The request must contain a certification that the invention disclosed in the application **has not been and will not** be the subject of an application filed in another country, or under a multilateral international agreement, that requires eighteen-month publication. Before making the certification, the person who signs the certification must make an **actual inquiry** to determine whether the certification under 35 U.S.C. 122(b)(2)(B)(i) and 37 CFR 1.213(a)(3) can be appropriately made (see I. REQUIREMENTS PRIOR TO FILING A NONPUBLICATION REQUEST, below); and

(D) The request is signed in compliance with 37 CFR 1.33(b).

If applicant filed a nonpublication request and later decides to file a counterpart foreign or international application in another country, or under a multilateral agreement, that requires eighteen-month publication, applicant must either: (1) rescind the nonpublication request before filing such foreign or international application; or (2) notify the Office of such filing no later than 45 days after the filing date of the counterpart foreign or international application. See MPEP §§ 1123 and 1124.

## I. REQUIREMENTS PRIOR TO FILING A NONPUBLICATION REQUEST

A nonpublication request is not appropriate unless the person who is signing the nonpublication request has made an actual inquiry consistent with the requirements of 37 CFR 10.18(b) to determine that:

(A) The application under 35 U.S.C. 111(a) has not been the subject of a foreign or international application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing (e.g., a counterpart PCT application); and

(B) The applicant's intent at the time the nonpublication request is being filed is that the application under 35 U.S.C. 111(a) will not be the subject of a foreign or international application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing.

Only when both conditions are satisfied, can applicants file a nonpublication request under 37 CFR 1.213(a). A nonpublication request is not appropriate if applicants have already filed a counterpart foreign or international application in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing. A nonpublication request is not proper even if the foreign or international application is abandoned before the foreign or international application is published.

A nonpublication request also is not appropriate if the applicant has not yet made a decision whether to file a counterpart application in a foreign country, or under a multilateral international agreement, that

requires publication of applications at eighteen months after filing. A certification under 37 CFR 1.213(a)(3) cannot be made based on a lack of knowledge of the applicant's plans concerning the filing of any counterpart application that would be subject to eighteen-month publication or the applicant's past practices or tendencies with respect to the filing of foreign counterpart applications. The fact that a particular applicant has a tendency to file counterpart applications for fewer than fifty percent of its U.S. applications is not alone an adequate basis for filing all or any of the U.S. applications with a nonpublication request. The applicant must have an affirmative intent not to file a counterpart application, and not just the absence of any intent or plan concerning the filing of any counterpart application that would be subject to eighteen-month publication. A nonpublication request is only appropriate if the applicant's intent at the time the nonpublication request is being filed is not to file a counterpart foreign or international application that would be subject to eighteen-month publication.

## II. FILING A NONPUBLICATION REQUEST

Applicants should use the format set forth in form PTO/SB/35, Nonpublication Request under 35 U.S.C. 122(b)(2)(B)(i), to ensure that the certification includes the proper language required by the statute and the request is stated in a conspicuous manner. Form PTO/SB/35 is available from the USPTO website ([www.uspto.gov](http://www.uspto.gov)), and is reproduced in MPEP § 1135. A nonpublication request that does not include the language required by 35 U.S.C. 122(b)(2)(B)(i) (i.e., certifying that the "invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing") will not be accepted. A nonpublication request must be included with the application on filing. This is a statutory requirement and cannot be waived. If the Office mistakenly accepts an improper nonpublication request, applicants should notify the Pre-Grant Publication Division and rescind the request immediately. See MPEP § 1730 for contact information.

A request for nonpublication may not be recognized unless it is conspicuous. See 37 CFR 1.213(a)(2). Providing text as one paragraph among

numerous other paragraphs with no highlighting of the request for non-publication is not conspicuous, and thus the Office's assignment of a publication date would be appropriate.

When the Office recognizes the nonpublication request, the filing receipt will not include a projected publication date. If applicant includes a nonpublication request as specified by 35 U.S.C. 122(b)(2)(B)(i) and the filing receipt reflects a projected publication date, applicant should promptly contact the Office and determine whether the nonpublication request was overlooked.

## III. INAPPROPRIATE NONPUBLICATION REQUEST

If prior to filing a U.S. application under 35 U.S.C. 111(a), applicants have filed a counterpart foreign or international application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, a nonpublication request would not be appropriate in the U.S. application. If applicants filed a nonpublication request in a U.S. application that claims the benefit to an earlier foreign or international application, the Office will not accept the nonpublication request and will assign a projected publication date. The applicant will be notified that the certification is inconsistent with the priority claim. The notice will provide a non-extendable time period of 30 days from the mail date of the notice for applicant to provide a satisfactory explanation as to how the certification submitted is valid in light of the priority claim. If applicants fail to provide a satisfactory explanation, the Office will publish the U.S. application.

If an applicant files a PCT application, abandons the PCT application before the International Bureau publishes the PCT application, and thereafter files a corresponding U.S. application under 35 U.S.C. 111(a) with a non-publication request under 37 CFR 1.213, the nonpublication request is improper. The mere filing of the PCT application precludes the proper use of a nonpublication request, since the invention disclosed in the U.S. application was the subject of an application that was filed under an international agreement requiring publication at 18 months (the PCT application). 35 U.S.C. 122(b)(2)(B)(i) states that an application will not be published "[i]f an applicant makes a request upon filing, certifying that

the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, . . . .” The trigger in the statute is not whether the other application will be published, but rather the trigger is the act of filing where eighteen-month publication of patent applications is required. Abandonment of the foreign application, or the application under a multilateral international agreement, prior to foreign publication at 18-months has no bearing on the propriety of requesting nonpublication of the U.S. application.

Where a foreign or PCT application is filed first, and a U.S. application is filed thereafter with an (improper) nonpublication request, the Office will not consider the U.S. application as abandoned for having made the nonpublication request. This is because the statute only provides for an application to be regarded as abandoned when the applicant fails to notify the Office within 45 days of a subsequently filed application that is directed to the same subject as the invention of the U.S. application in another country, or under a multilateral international agreement, that requires eighteen-month publication of applications. 35 U.S.C. 122(b)(2)(B)(iii) does not apply to the situation where the applicant has made an improper certification subsequent to the foreign filing. A petition to revive under 37 CFR 1.137(b)/(f) is inappropriate and not necessary in the above-noted situation because the U.S. application is pending (unless the application is abandoned for other reasons). If a petition to revive under 37 CFR 1.137(b)/(f) is filed, the Office will dismiss the petition as inappropriate but retain the petition fee because the Office was required to evaluate the merits of the petition before being able to determine that the petition was not appropriate.

Applicants and their representatives should make sure that the certification is proper before signing and filing it with the Office. While applicants should rescind any improper nonpublication request as soon as possible, 35 U.S.C. 122(b)(2)(B)(i)-(iv) does not include any provision for “correction” of an improper certification. Any applicant or applicant’s representative who makes a false statement (e.g., an improper certification) may be in violation of 37 CFR 10.18(b). In addition, false statements by registered patent prac-

tioners may also violate other Disciplinary Rules (see 37 CFR Part 10).

While applicant cannot undo the fact that an improper certification was made, any applicant who has made such a mistake should promptly file a rescission of the nonpublication request and note that the original certification was improper.<

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## 1123 Rescission of a Nonpublication Request [R-2]

35 U.S.C. 122. *Confidential status of applications; publication of patent applications*

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(b) PUBLICATION.—

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(2) EXCEPTIONS.—

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(B)(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) An applicant may rescind a request made under clause (i) at any time.

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(iv) If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

(v) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign filed applications corresponding to an application filed in the Patent and Trademark Office or the description of the invention in such foreign filed applications is less extensive than the application or description of the invention in the application filed in the Patent and Trademark Office, the applicant may submit a redacted copy of the application filed in



the Patent and Trademark Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. The Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title. The provisions of section 154(d) shall not apply to a claim if the description of the invention published in the redacted application filed under this clause with respect to the claim does not enable a person skilled in the art to make and use the subject matter of the claim.

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*37 CFR 1.213. Nonpublication request.*

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(b) The applicant may rescind a nonpublication request at any time. A request to rescind a nonpublication request under paragraph (a) of this section must:

- (1) Identify the application to which it is directed;
- (2) State in a conspicuous manner that the request that the application is not to be published under 35 U.S.C. 122(b) is rescinded; and
- (3) Be signed in compliance with § 1.33(b).

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An applicant may rescind a previously-filed nonpublication request at any time. See 35 U.S.C. 122(b)(2)(B)(ii). Form PTO/SB/36 (revision April 2001 or later) may be used to both rescind a nonpublication request and provide notice of foreign filing. The form is reproduced in MPEP § 1135. If applicant makes a nonpublication request under 35 U.S.C. 122(b)(2)(B)(i) and then rescinds the nonpublication request before or on the date a foreign or international application (hereinafter “foreign filing” or “counterpart application”) directed to the invention disclosed in the U.S. application filed under 35 U.S.C. 111(a) in the USPTO is filed in a foreign country, or under a multilateral international agreement, that requires eighteen-month publication, the nonpublication request under 35 U.S.C. 122(b)(2)(B)(i) will be treated as annulled and the application will be treated as if the nonpublication request was never made. Thus, if applicant filed a nonpublication request and then decided to file a counterpart application, applicant must file either: (1) a request to rescind the nonpublication request before filing the counterpart application; or (2) a notice of foreign filing no later than 45 days after the filing date of the counterpart

application, to avoid abandonment of the application (35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c)).

The mere filing of a request under 37 CFR 1.213(b) to rescind the previously filed nonpublication request does not comply with the notice of foreign filing requirement of 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) (for applicants who submitted a nonpublication request but before filing the request to rescind, also filed a counterpart application in another country, or under a multilateral international agreement, that requires eighteen-month publication of applications). Applicants are strongly encouraged to provide a notice of foreign filing whenever rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country. Form PTO/SB/36 (revision April 2001 or later) provides both a rescission and notice of foreign filing. See MPEP § 1135. No benefit can be given to a certificate of mailing or transmission under 37 CFR 1.8 on a request to rescind a nonpublication request in determining whether there has been a rescission of a nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country. A rescission of a nonpublication request is not a paper required to be filed in the USPTO as provided for in 37 CFR 1.8(a). Thus, the provisions of 37 CFR 1.8 by their terms do not apply in this situation, and the USPTO must use the actual date of receipt in the USPTO as defined in 37 CFR 1.6 as the date of the rescission to determine whether the nonpublication request has been rescinded before or on the date of the filing of a counterpart application such that the application may be considered an application in which no nonpublication request under 35 U.S.C. 122(b)(1)(B)(i) was made. Since a notice of foreign filing is required by the statute and 37 CFR 1.215(c), the benefit of a certificate of mailing or transmission under 37 CFR 1.8 will be given to a notice of foreign filing.

After either a rescission of a nonpublication request or a notice of foreign filing is received by the Office, the Office will enter the rescission or notice of foreign filing into the Office Pre-Examination System to schedule the application for publication. A notice (e.g., a “Notice Regarding Rescission Of Nonpublication Request and Notice of Foreign Filing”) should be sent to inform the applicant of the projected publication date. The application will be published promptly

after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under title 35, United States Code, or as soon as practicable after mailing this notice. See 35 U.S.C. 122(b)(2)(B)(iv).

An applicant should not rescind a nonpublication request or provide a notice of foreign filing unless a nonpublication request was actually made, because filing a rescission when one is not needed leads to a waste of Office resources and may delay prosecution in the application. Furthermore, filing a rescission of a nonpublication request where a nonpublication request was not originally made may result in a reduction to any patent term adjustment under 35 U.S.C. 154(b).<

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## 1124 Notice of Foreign Filing [R-2]

35 U.S.C. 122. *Confidential status of applications; publication of patent applications.*

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(b) PUBLICATION.—

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(2) EXCEPTIONS.—

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(B)(iii)An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(iv) If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

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37 CFR 1.213. *Nonpublication request.*

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(c) If an applicant who has submitted a nonpublication request under paragraph (a) of this section subsequently files an application directed to the invention disclosed in the application in

which the nonpublication request was submitted in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. The failure to timely notify the Office of the filing of such foreign or international application shall result in abandonment of the application in which the nonpublication request was submitted (35 U.S.C. 122(b)(2)(B)(iii)).

Applicants must timely file a notice of foreign filing to avoid abandonment of a U.S. application if:

(A) applicant filed a nonpublication request in the U.S. application filed under 35 U.S.C. 111(a) (see MPEP § 1122);

(B) applicant subsequently filed a foreign or international application directed to the invention disclosed in the U.S. application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing (foreign filing or counterpart application); and

(C) applicant did not rescind the nonpublication request before filing the foreign or international application (see MPEP § 1123).

The notice of foreign filing must be filed not later than 45 days after the filing date of the counterpart application. The requirement for notice of foreign filing is set forth in 35 U.S.C. 122(b)(2)(B)(iii) which provides that an applicant who has made a nonpublication request under 35 U.S.C. 122(b)(2)(B)(i) in a U.S. application filed under 35 U.S.C. 111(a), but who subsequently files an application in a foreign country or under a multilateral international agreement that requires eighteen-month publication, must notify the USPTO of the foreign filing not later than forty-five days after the date of such foreign filing. Form PTO/SB/36 (revision April 2001 or later) may be used to both rescind a nonpublication request and provide notice of foreign filing. The form is reproduced in MPEP § 1135. 35 U.S.C. 122(b)(2)(B)(iii) further provides that failure of the applicant to provide the required notice within this forty-five (45) day period shall result in abandonment of the application. Accordingly, if at the time the foreign filing is made, the applicant still has an operative nonpublication request (i.e., the applicant has not rescinded the nonpublication request), a notice of foreign filing must be made within 45 days of the foreign filing or the U.S.

application with the nonpublication request will become abandoned.

Since the notice of foreign filing is required by the statute, the benefit of a certificate of mailing or transmission under 37 CFR 1.8 will be given to a notice of foreign filing. See 37 CFR 1.8(a). Form PTO/SB/36 includes a certificate of mailing. If the end of the 45 day period falls on a Saturday, Sunday or Federal holiday within the District of Columbia, a notice of foreign filing filed on the next succeeding secular or business day is timely. See 35 U.S.C. 21(b).

After either a rescission of a nonpublication request or a notice of foreign filing is received by the Office, the Office will enter the rescission or notice of foreign filing into the Office Pre-Examination System to schedule the application for publication. A notice (e.g., a “Notice Regarding Rescission Of Nonpublication Request and Notice of Foreign Filing”) should be sent to inform the applicant of the projected publication date. The application will be published promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under title 35, United States Code, or as soon as practicable after mailing this notice. See 35 U.S.C. 122(b)(2)(B)(iv).

**ABANDONMENT FOR FAILURE TO PROVIDE TIMELY NOTICE**

*37 CFR 1.137. Revival of abandoned application, terminated reexamination proceeding, or lapsed patent*

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(b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(c) *Reply.* In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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(f) *Abandonment for failure to notify the Office of a foreign filing:* A nonprovisional application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing, may be revived only pursuant to paragraph (b) of this section. The reply requirement of paragraph (c) of this section is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under this section will not operate to stay any period for reply that may be running against the application.

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35 U.S.C. 122(b)(2)(B)(iii) provides that failure of the applicant to provide the required notice of foreign filing within 45 days of the subsequent filing of a counterpart application shall result in abandonment of the application. When an application is abandoned by the operation of 35 U.S.C. 122(b)(2)(B)(iii), applicant’s sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application on the basis of unintentional delay, and not on the basis of unavoidable delay. See 37 CFR 1.137(f). By statute, such a petition to revive requires payment of the petition fee specified in 37 CFR 1.17(m) (35 U.S.C. 41(a)(7)), and that the delay in submitting the notice of foreign filing was unintentional. Form PTO/SB/64a may be used for such a petition to revive. See also MPEP § 711.03(c). In addition, if, after filing a counterpart application, an applicant merely rescinds a nonpublication request but does not file a notice of foreign filing within forty-five days of the subsequent filing of a counterpart application, applicant must file a petition under 37 CFR 1.137(b) to revive the abandoned U.S. application (37 CFR 1.137(f)).

Abandonment occurs by operation of the statute, and the Office is unlikely to recognize when applicant has filed a counterpart application in a foreign country or under a multilateral agreement contrary to their certification to the Office. The Office would not be able to change the status of the application from pending to abandoned in the PALM system and send applicant a notice of abandonment. As a result, if applicant failed to file a notice of foreign filing when it was required, prosecution of the application will continue and the application may issue as a patent, even though the application has become abandoned by operation of the statute. Applicants who determine that a required notice of foreign filing was not timely provided

should promptly file a petition to revive under 37 CFR 1.137(b). See 37 CFR 1.137(f). The reply requirement of 37 CFR 1.137(c) is met by the notification of the filing in a foreign country or under a multinational treaty, but the filing of a petition to revive will not operate to stay any period for reply that may be running against the application.<

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## 1125 Express Abandonment to Avoid Publication [R-2]

37 CFR 1.138. *Express abandonment*

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(c) An applicant seeking to abandon an application to avoid publication of the application (see § 1.211(a)(1)) must submit a declaration of express abandonment by way of a petition under this section including the fee set forth in § 1.17(h) in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process. Applicant should expect that the petition will not be granted and the application will be published in regular course unless such declaration of express abandonment and petition are received by the appropriate officials more than four weeks prior to the projected date of publication.

Applicants seeking to abandon an application to avoid publication of the application are urged to do so by filing a petition under 37 CFR 1.138(c) and submitting a declaration of express abandonment and the fee set forth in 37 CFR 1.17(h) in sufficient time to permit the appropriate officials (Pre-Grant Publication Division) to recognize the abandonment and remove the application from the publication process. Applicants may use form PTO/SB/24A (see MPEP § 1135) and mail the petition to **Mail Stop Express Abandonment**, or transmit the petition via facsimile to Pre-Grant Publication Division at **(703) 305-8568** (see MPEP § 1730) to increase the chances of such petition being received by the appropriate officials in sufficient time to avoid publication of an application.

Any applicant seeking to abandon the application for the purpose of avoiding publication must take appropriate action well prior to the projected publication date. If the application is not expressly abandoned at least four weeks prior to the projected publication date, the Office will probably not be able to avoid publication of the application. This does not imply that a request to expressly abandon an application to avoid publication filed prior to this four-week

time frame will ensure that the Office will be able to remove an application from publication. The Office simply cannot ensure that it can remove an application from publication or avoid publication of application information any time after the publication process for the application is initiated (about 4 months prior to the projected publication date).

The petition for express abandonment to avoid publication will be granted when it is recognized in sufficient time to avoid publication and will be denied when it is not recognized in sufficient time to avoid publication of the application. This will avert the situation in which an applicant files a letter of express abandonment to avoid publication, the letter of express abandonment is not recognized in sufficient time to avoid publication, upon publication the applicant wishes to rescind the letter of express abandonment, and the Office cannot revive the application (once the letter of express abandonment is recognized) because the application was expressly and intentionally abandoned by the applicant.<

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## 1126 Publication Fees [R-2]

37 CFR 1.211. *Publication of applications.*

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(e) The publication fee set forth in § 1.18(d) must be paid in each application published under this section before the patent will be granted. If an application is subject to publication under this section, the sum specified in the notice of allowance under § 1.311 will also include the publication fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable. If the application is not published under this section, the publication fee (if paid) will be refunded.

The publication fee set forth in 37 CFR 1.18(d) must be paid in each application published under 35 U.S.C. 122(b) before a patent will be granted on the application. The publication fee will be required with the Notice of Allowance and Fee(s) Due, unless the publication fee was previously paid. If an application becomes abandoned without being allowed, no publication fee is required. The small entity discount is not available for the publication fee. The sum specified in the Notice of Allowance and Fee(s) Due will also include the publication fee which must be paid within three months from the date of mailing of the Notice of Allowance and Fee(s) Due to avoid abandonment of

the application. This three-month period is not extendable.

Applicant is required to pay the publication fee to avoid abandonment of the application even if the application has not yet been published at the time when the publication fee is due. The Office will continue with the pre-grant publication process until a patent actually issues. This is because there are many instances in which the Office mails a notice of allowance in an application but the application does not issue as a patent in regular course. Therefore, the Office will not discontinue the pre-grant publication process until a patent has actually issued. Since the Office cannot discontinue the pre-grant publication process during the last two to four weeks of the publication process, this will result in a few applications being issued as patents and subsequently being published as patent application publications. The Office will refund the publication fee (if paid) if the application is not published as a patent application publication, but will not refund the publication fee if the application is published as a patent application publication, even if it is published after the patent issues.

Accordingly, applicant may file a request for a refund of the publication fee after 4 weeks from the issue date of the patent. A request for refund filed before 4 weeks from the issue date is premature and will be disregarded. Requests for a refund of the publication fee should be directed to the Pre-Grant Publication Division of the Office of Publications at Mail Stop PGPUB.

If applicant files a request for continued examination (RCE) under 37 CFR 1.114 after a Notice of Allowance and Fee(s) Due is mailed (but before the expiration of the three-month time period set forth in the Notice of Allowance and Fee(s) Due), the Office will suspend the due date for the publication fee until three months from the mail date of the new Notice of Allowance and Fee(s) Due for the application (if and when a new Notice is mailed). See *Time Period for Paying Publication Fee if a Request for Continued Examination is Filed After a Notice of Allowance is Mailed*, 1249 *Off. Gaz. Pat. Office* 81 (Aug. 21, 2001). For more information on RCE practice, see MPEP § 706.07(h).<

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## 1127 Notice of Publication [R-2]

Applicants will be informed of the projected publication date assigned to the application on the filing receipt. The Office will not mail a paper copy of the patent application publication to the applicant, but will mail a “Notice of Publication” to the applicant indicating that the application has been published when the application is published. Copies of patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)).

A “Notice of New or Revised Publication Date” may be mailed if the publication date changes by more than six weeks due to processing delays, if a secrecy order is removed, or subsequent to the revival of an abandoned application. If applicant adds or deletes a benefit or priority claim so that the 18-month publication date is changed, applicant will be mailed a notice (e.g., a corrected filing receipt), informing applicant of the newly assigned publication date.<

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## 1128 Availability of Published Applications [R-2]

*37 CFR 1.14. Patent applications preserved in confidence.*

(a) Confidentiality of patent application information. Patent applications that have not been published under 35 U.S.C. 122(b) are generally preserved in confidence pursuant to 35 U.S.C. 122(a). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § 1.11 or in this section.

(1) Records associated with patent applications (see paragraph (g) for international applications) may be available in the following situations:

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(iii) Published pending applications. A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending application that has been published as a patent application publication may be provided to any person upon request, and payment of the appropriate fee set forth in § 1.19(b). If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy. The Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (h) of this section.

(iv) Unpublished abandoned applications (including provisional applications) that are identified or relied upon.

The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publication of an international application that was published in accordance with PCT Article 21(2). An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under 35 U.S.C. 119(e), 120, 121, or 365 in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, or an international patent application that was published in accordance with PCT Article 21(2). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b)).

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## I. ELECTRONIC ACCESS

Patent application publications are available electronically on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)). Any member of the public may obtain status information concerning any published application via the Office's Patent Application Information Retrieval (PAIR) system. See MPEP § 1730. Published applications that have been scanned into the Image File Wrapper (IFW) system may be available electronically via PAIR.

## II. COPIES OF PUBLISHED APPLICATIONS

Any member of the public may submit a request under 37 CFR 1.14(a)(1)(ii) or (iii) and the fee set forth in 37 CFR 1.19(b) to the Office of Public Records or electronically on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)) for:

(A) a copy of the complete file wrapper and contents of, or a copy of a specific paper in, any published application, provided that no redacted copy was timely submitted for publication; or

(B) an appropriately redacted copy of the file wrapper and contents of, or a copy of a specific paper in, any published application for which a redacted copy was timely submitted for publication.

## III. PHYSICAL ACCESS TO PUBLISHED APPLICATIONS

Any member of the public cannot obtain physical access to any **pending** published application because permitting physical inspection of pending published applications would interfere with the Office's ability to act on the applications. Any member of the public may, however, physically inspect (subject to the same conditions that apply to inspection of patented files) the file of any **abandoned** published application, provided that no redacted copy was timely submitted for publication, through the File Information Unit (FIU). See MPEP § 1730.

## IV. STATUS INFORMATION

Any member of the public may obtain status information concerning any published application via the Office's PAIR system or contact the FIU. See MPEP § 1730. Status information is defined to include identification of whether the application has been published under 35 U.S.C. 122(b), as well as whether the application is pending, abandoned, or patented, and the application number. Status information may also be provided when the application is referred to by its application number in a U.S. patent application publication as well as a U.S. patent or a published international application. The public may obtain continuity data for applications that have been published as a U.S. patent application publication or as a U.S. patent. See also MPEP § 102.<

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## 1129 Request for Early Publication [R-2]

*37 CFR 1.219. Early publication.*

Applications that will be published under § 1.211 may be published earlier than as set forth in § 1.211(a) at the request of the applicant. Any request for early publication must be accompanied by the publication fee set forth in § 1.18(d). If the applicant does not submit a copy of the application in compliance with the Office electronic filing system requirements pursuant to § 1.215(c), the Office will publish the application as provided in § 1.215(a). No consideration will be given to requests for publication on a certain date, and such requests will be treated as a request for publication as soon as possible.

If an applicant wishes to have an application published earlier than the date that is eighteen months after the earliest filing date for which benefit is claimed, applicant may submit a request in compli-

ance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d). The Office will publish the application as soon as possible if the application is otherwise ready for publication. The publication process takes approximately 14 weeks and does not begin until the application is complete and ready for publication (e.g., an executed oath or declaration has been filed and the filing fee has been paid). See MPEP § 1120. The Office will not give any consideration to requests for publication on a certain date. Note that if early publication is requested, and the publication fee paid, applicant will not be required to pay the publication fee at allowance.<

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## 1130 Republication and Correction of Patent Application Publications [R-2]

*37 CFR 1.221. Voluntary publication or republication of patent application publication*

(a) Any request for publication of an application filed before, but pending on, November 29, 2000, and any request for republication of an application previously published under § 1.211, must include a copy of the application in compliance with the Office electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). If the request does not comply with the requirements of this paragraph or the copy of the application does not comply with the Office electronic filing system requirements, the Office will not publish the application and will refund the publication fee.

(b) The Office will grant a request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section only when the Office makes a material mistake which is apparent from Office records. Any request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable.

If an applicant wishes to correct errors in a patent application publication, or republish the application with an amended specification (including amended claims) and/or replacement drawings, applicant may file a request for republication pursuant to 37 CFR 1.221(a). The request for republication must include:

(A) a copy of the application in compliance with the Office Electronic Filing System (EFS) requirements (for more information on EFS see MPEP § 1730 and the USPTO web site, [www.uspto.gov](http://www.uspto.gov));

(B) the publication fee set forth in 37 CFR 1.18(d); and

(C) the processing fee set forth in 37 CFR 1.17(i).

If the applicant submits a request that does not meet the EFS requirements, the request will be dismissed. If the fees are not paid, the USPTO will send the applicant a letter requiring the fees and republication of the application will be delayed. While there is no set time limit for requesting republication, the application must still be pending.

If the application is **recognized** by the Office as abandoned, or has issued as a patent, the application may be removed from the publication process and not republished, even if the Office accepted the request.

## CORRECTION OF MATERIAL MISTAKE MADE BY THE OFFICE

If the Office made a material mistake in a patent application publication that is apparent from the Office records and applicant wishes to correct the material mistake, applicant may file a request for corrected publication pursuant to 37 CFR 1.221(b). Prior to submitting a request for a corrected publication under 37 CFR 1.221(b), applicant must check applicant's records (or PAIR) to determine that the application papers submitted to the Office did not contain the alleged material error made by the Office. If applicant submitted a specification that includes illegible text, the Office will not grant a request for corrected publication under 37 CFR 1.221(b) based on errors arising from misinterpretation of such text.

The request for a corrected publication under 37 CFR 1.221(b) must:

(A) be filed within two months from the date of the patent application publication; and

(B) identify the Office's material mistake in the publication.

The two-month time period is not extendable. A request for corrected publication should include a listing of the alleged material errors made by the Office, marked up copies of the relevant pages of the publication and an indication of where in the specification as filed the relevant text appears. If the period has expired or the mistake is caused by the applicants, applicants may correct the mistakes by filing a request for republication under 37 CFR 1.221(a), and should

not file a request for corrected publication under 37 CFR 1.221(b).

#### A. *Material Mistake*

The Office will grant a request for a corrected publication under 37 CFR 1.221(b) only when the Office makes a material mistake which is apparent from Office records. A material mistake means a mistake that affects the public's ability to appreciate the technical disclosure of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. An error in the claims, the (effective) filing date of the application, or a serious error in the written description or drawings that is necessary to support the claims may be a material error. The following are examples of material mistake:

(A) The publication did not include claims that were included in the originally-filed specification and not canceled by a preliminary amendment.

(B) The publication did not include a part of the specification that provides support for the published claims.

(C) The publication did not include any of the drawings submitted.

(D) The publication did not include the benefit claim to a prior-filed nonprovisional application where the specific reference was timely submitted in the first sentence of the specification or application data sheet (ADS).

#### B. *Non-Material Mistake*

Applicants should not file requests for corrected publication that include no material error made by the Office. Errors in the correspondence address, the assignment information or missing assignment information, minor typographical errors or missing section headings are not material mistakes. A failure to include an amendment is not an Office error, because amendments are not reflected in the patent application publication. See MPEP § 1121. For example, applicants should not file a request for a corrected publication under 37 CFR 1.221(b) for the following situations:

(A) The publication did not include assignment information.

(B) The publication shows the wrong assignee or the name of the assignee is misspelled.

(C) The publication did not include a benefit or priority claim to a prior application. For example, where either the claim was not timely filed or the reference to the prior application under 37 CFR 1.78 was not properly submitted in the first sentence of the specification or in an application data sheet (ADS). See MPEP § 201.11.

(D) The publication did not include claims or changes submitted in an amendment.

(E) The publication includes typographical errors that do not affect the interpretation of the published claims.

A request for corrected publication under 37 CFR 1.221(b) may result in a patent term adjustment reduction where the Office made only non-material errors (especially those listed above).<

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### 1132 Requests for Redacted Publication [R-2]

35 U.S.C. 122. *Confidential status of applications; publication of patent applications.*

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(b) PUBLICATION.—

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(2) EXCEPTIONS.—

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(B)(v)If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign filed applications corresponding to an application filed in the Patent and Trademark Office or the description of the invention in such foreign filed applications is less extensive than the application or description of the invention in the application filed in the Patent and Trademark Office, the applicant may submit a redacted copy of the application filed in the Patent and Trademark Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. The Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title. The provisions of section 154(d) shall not apply to a claim if the description of the invention published in the redacted application filed under this clause with respect to the claim does not enable a person skilled in the art to make and use the subject matter of the claim.



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*37 CFR 1.217. Publication of a redacted copy of an application*

(a) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the Office, the applicant may submit a redacted copy of the application filed in the Office for publication, eliminating any part or description of the invention that is not also contained in any of the corresponding applications filed in a foreign country. The Office will publish the application as provided in § 1.215(a) unless the applicant files a redacted copy of the application in compliance with this section within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code.

(b) The redacted copy of the application must be submitted in compliance with the Office electronic filing system requirements. The title of the invention in the redacted copy of the application must correspond to the title of the application at the time the redacted copy of the application is submitted to the Office. If the redacted copy of the application does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in § 1.215(a).

(c) The applicant must also concurrently submit in paper (§ 1.52(a)) to be filed in the application:

(1) A certified copy of each foreign-filed application that corresponds to the application for which a redacted copy is submitted;

(2) A translation of each such foreign-filed application that is in a language other than English, and a statement that the translation is accurate;

(3) A marked-up copy of the application showing the redactions in brackets; and

(4) A certification that the redacted copy of the application eliminates only the part or description of the invention that is not contained in any application filed in a foreign country, directly or through a multilateral international agreement, that corresponds to the application filed in the Office.

(d) The Office will provide a copy of the complete file wrapper and contents of an application for which a redacted copy was submitted under this section to any person upon written request pursuant to § 1.14(c)(2), unless applicant complies with the requirements of paragraphs (d)(1), (d)(2), and (d)(3) of this section.

(1) Applicant must accompany the submission required by paragraph (c) of this section with the following:

(i) A copy of any Office correspondence previously received by applicant including any desired redactions, and a second copy of all Office correspondence previously received by applicant showing the redacted material in brackets; and

(ii) A copy of each submission previously filed by the applicant including any desired redactions, and a second copy of each submission previously filed by the applicant showing the redacted material in brackets.

(2) In addition to providing the submission required by paragraphs (c) and (d)(1) of this section, applicant must:

(i) Within one month of the date of mailing of any correspondence from the Office, file a copy of such Office correspondence including any desired redactions, and a second copy of such Office correspondence showing the redacted material in brackets; and

(ii) With each submission by the applicant, include a copy of such submission including any desired redactions, and a second copy of such submission showing the redacted material in brackets.

(3) Each submission under paragraph (d)(1) or (d)(2) of this paragraph must also be accompanied by the processing fee set forth in § 1.17(i) and a certification that the redactions are limited to the elimination of material that is relevant only to the part or description of the invention that was not contained in the redacted copy of the application submitted for publication.

(e) The provisions of § 1.8 do not apply to the time periods set forth in this section.

If an application filed in the USPTO and subject to publication under 35 U.S.C. 122 (b) includes description that is more extensive than any previously filed corresponding foreign applications, applicant may request for redacted publication under 37 CFR 1.217, eliminating any part or description of the invention that is not also contained in any of the corresponding applications filed in a foreign country. The Office will publish the redacted (less extensive) copy of the application instead of the full description of the invention disclosed in the U.S. application (as provided in 37 CFR 1.215(a)) if applicant timely files a request for redacted publication in compliance with 37 CFR 1.217 which requires the following:

(A) A redacted copy of the application in compliance with the Office electronic filing system (EFS) requirements within sixteen (16) months after the earliest filing date for which a benefit is sought under title 35, United States Code;

(B) A certified copy of each foreign-filed application that corresponds to the U.S. application for which a redacted copy is submitted;

(C) A translation of each such foreign-filed application that is in a language other than English, and a statement that the translation is accurate;

(D) A marked-up copy of the application showing the redactions in brackets; and

(E) A certification that the redacted copy of the application eliminates only the part or description of the invention that is not contained in any application filed in a foreign country, directly or through a multi-lateral international agreement, that corresponds to the application filed in the Office.

Items (B)– (E) above must be submitted in paper concurrently with the EFS submission of the redacted copy of the application.

The 16-month period is provided by statute (35 U.S.C. 122(b)(2)(B)(v)), and as such, requests for waiver of this 16-month period will be denied. The title of the invention in the redacted copy of the application must correspond to the title of the application at the time the redacted copy of the application is submitted to the Office. If the redacted copy of the application does not comply with the Office electronic filing system requirements, the Office will publish the full description of the invention disclosed in the U.S. application as provided in 37 CFR 1.215(a).

Once an application has been published, a member of the public may request a copy of the complete file wrapper and contents of, or a copy of a specific paper in, the published application, provided that no redacted copy was timely submitted for publication. If a redacted copy of the application was used for publication, the copy of the specification, drawings, and papers may be limited to a redacted copy, provided that the applicant submits the following:

(A) A copy of any Office correspondence previously received by applicant including any desired redactions, and a second copy of all Office correspondence previously received by applicant showing the redacted material in brackets, at the time of filing the request for redacted publication;

(B) A copy of each submission previously filed by the applicant including any desired redactions, and a second copy of each submission previously filed by the applicant showing the redacted material in brackets, at the time of filing the request for redacted publication;

(C) Within one month of the date of mailing of any correspondence from the Office, a copy of such Office correspondence including any desired redac-

tions, and a second copy of such Office correspondence showing the redacted material in brackets;

(D) With each submission by the applicant, a copy of such submission including any desired redactions, and a second copy of such submission showing the redacted material in brackets; and

(E) The processing fee set forth in 37 CFR 1.17(i), and a certification that the redactions are limited to the elimination of material that is relevant only to the part or description of the invention that was not contained in the redacted copy of the application submitted for publication for each submission in (A)-(D).

Papers submitted for redaction are not entitled to the benefit of the certificate of mailing practice under 37 CFR 1.8. If applicant fails to provide the required redacted and marked up copies of the correspondence in compliance with 37 CFR 1.217(d), the Office will provide a copy of the complete file wrapper and contents of the application to any person upon written request pursuant to 37 CFR 1.14.<

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### 1133 Voluntary Publication [R-2]

*37 CFR 1.221. Voluntary publication or republication of patent application publication.*

(a) Any request for publication of an application filed before, but pending on, November 29, 2000, and any request for republication of an application previously published under § 1.211, must include a copy of the application in compliance with the Office electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). If the request does not comply with the requirements of this paragraph or the copy of the application does not comply with the Office electronic filing system requirements, the Office will not publish the application and will refund the publication fee.

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Utility and plant applications filed before November 29, 2000 will not be published under 35 U.S.C. 122(b). If an applicant wishes the Office to publish a utility or plant application filed before November 29, 2000 under 35 U.S.C. 122(b), applicant may file a request for voluntary publication under 37 CFR 1.221. The application must be pending and the request for voluntary publication must include:

(A) a copy of the application in compliance with the Office Electronic Filing System (EFS) requirements;

(B) the publication fee set forth in 37 CFR 1.18(d); and

(C) the processing fee set forth in 37 CFR 1.17(i).

If the applicant submits a request that does not meet the EFS requirements, the request will be dismissed. Since the Office does not intend to publish abandoned applications, applications that **are recognized** by the Office as abandoned will not be published. Thus, if applicant submits a request for a voluntary publication of an application, but the application is later abandoned before the application publishes, the application may not be published even if the Office has accepted the request.<

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### 1134 Third Party Inquiries and Correspondence in a Published Application [R-2]

35 U.S.C. 122. *Confidential status of applications; publication of patent applications.*

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(c) PROTEST AND PRE-ISSUANCE OPPOSITION.—

The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

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35 U.S.C. 122(c) provides that the Office “shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.” Accordingly, the Office prohibits third parties from submitting any protests under 37 CFR 1.291 or initiating any public use proceedings under 37 CFR 1.292 (without the express written consent of the applicant) after publication of an application. These are the only forms of third party protest or pre-issuance opposition to a pending application permitted by the rules of practice. For more information on protest see MPEP § 1901; for public use proceedings see MPEP § 720. Third parties may submit patents or publications for consideration in a pending published application, with no further comment or explanation, pursuant to 37 CFR 1.99. See MPEP § 1134.01.

Despite the provisions of 35 U.S.C. 122(c), the Office occasionally receives third-party inquiries or submissions (other than under 37 CFR 1.99) regarding applications that have been published under the eighteen-month publication provisions of 35 U.S.C. 122(b). For example, third parties have inquired into the timing of future actions on an application, and some third parties have insisted that the Office withdraw an application from issue under 37 CFR 1.313 on the basis of unpatentability of a claim. The Office considers inappropriate any third-party inquiry, or submission that is not provided for in 37 CFR 1.99, in a published application in which the applicant has not provided an express written consent to protest or pre-issuance opposition. Any submission filed by a third party (e.g., a protest) in an application published under 35 U.S.C. 122(b) (without the express written consent of the applicant) that does not comply with the requirements of 37 CFR 1.99 will be disregarded and not entered into the application file. For example: a protest under 37 CFR 1.291 filed after publication of the application under 35 U.S.C. 122(b) (without the express written consent of the applicant) will be reviewed to determine if it is in compliance with 37 CFR 1.99 and, if it is not in compliance with 37 CFR 1.99, it will be discarded before the application is forwarded to the examiner. Petitions to institute public use proceedings under 37 CFR 1.292, including those that are filed after publication of an application under 35 U.S.C. 122(b), should be forwarded to the Office of Patent Legal Administration. See MPEP § 720.

Office personnel (including the Patent Examining Corps) are instructed to: (1) not reply to any third-party inquiry or other submission in a published pending application; (2) not act upon any third-party inquiry or other submission in a published application, except for written submissions that are provided for in 37 CFR 1.99 and written submissions in applications in which the applicant has provided an express written consent to protest or pre-issuance opposition; and (3) decline to accept oral or telephone comments or submissions about published applications from third parties. When refusing third-party telephone or oral discussions, examiners may call the party’s attention to the statutory prohibition on initiating protests, or 37 CFR 1.2 (all Office business should be transacted in writing), as appropriate. See *Third Party Attempts to Protest or Otherwise Oppose the Grant of*

a *Published Application*, 1269 *Off. Gaz. Pat. Office* 179 (April 22, 2003). The Office may also refer third-party inquiries, or submissions not provided for in 37 CFR 1.99, by registered practitioners in published applications in which the applicant has not provided an express written consent to protest, or pre-issuance opposition, to the Office of Enrollment and Discipline for appropriate action.

The provisions of 35 U.S.C. 122(c) and 37 CFR 1.99, 1.291, and 1.292 limit a third party's ability to protest, oppose the grant of, or have information entered and considered in an application pending before the Office. However, these provisions do not limit the Office's authority to independently re-open the prosecution of a pending application on the Office's own initiative and consider information deemed relevant to the patentability of any claim in the application. See *Blacklight Power, Inc. v. Rogan*, 295 F.3d 1269, 63 USPQ2d 1534 (Fed. Cir. 2002).<

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### 1134.01 Third Party Submissions Under 37 CFR 1.99 [R-2]

37 CFR 1.99. *Third-party submission in published application.*

(a) A submission by a member of the public of patents or publications relevant to a pending published application may be entered in the application file if the submission complies with the requirements of this section and the application is still pending when the submission and application file are brought before the examiner.

(b) A submission under this section must identify the application to which it is directed by application number and include:

- (1) The fee set forth in § 1.17(p);
- (2) A list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication;
- (3) A copy of each listed patent or publication in written form or at least the pertinent portions; and
- (4) An English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.

(c) The submission under this section must be served upon the applicant in accordance with § 1.248.

(d) A submission under this section shall not include any explanation of the patents or publications, or any other information. The Office will not enter such explanation or information if included in a submission under this section. A submission under this section is also limited to ten total patents or publications.

(e) A submission under this section must be filed within two months from the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Any submission under this section not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth in § 1.17(i). A submission by a member of the public to a pending published application that does not comply with the requirements of this section will not be entered.

(f) A member of the public may include a self-addressed postcard with a submission to receive an acknowledgment by the Office that the submission has been received. A member of the public filing a submission under this section will not receive any communications from the Office relating to the submission other than the return of a self-addressed postcard. In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a submission under this section.

To balance the mandate of 35 U.S.C. 122(c) and the Office's authority and responsibility under 35 U.S.C. 131 and 151 to issue a patent only if "it appears that the applicant is entitled to a patent under the law," the Office permits third parties to submit patents and publications (i.e., prior art documents that are public information and which the Office would discover on its own with an ideal prior art search) during a limited (2 month) period after publication of an application in compliance with 37 CFR 1.99. However, 37 CFR 1.99 prohibits third parties from submitting any explanation of the patents or publications, or submitting any other information.

Third parties may submit patents and publications relevant to the published application, with no further comment or explanation, pursuant to 37 CFR 1.99. The patents and publications may be entered in the application file if the submission complies with the requirements of 37 CFR 1.99 and the application is still pending when the submission and application file are brought before the examiner. For Image File Wrapper (IFW) processing, see IFW Manual, Section 2.1. The submission must be served upon the applicant in accordance with 37 CFR 1.248 prior to the filing of the submission in the Office.

To ensure that a third-party submission under 37 CFR 1.99 does not amount to a protest or pre-grant opposition without express consent of the applicant, the third party does not have the right to insist that the examiner consider any of the patents or publications submitted.

If the submission is not in compliance with 37 CFR 1.99, information filed in the submission may be

removed prior to the examiner receiving the submission and application file. The Office will screen third-party submissions to determine whether they are limited to patents and publications, and to remove any explanations or information (other than patents and publications) from the submission before the submission is placed in the application file and forwarded to the examiner. For IFW processing, see IFW Manual, Section 2.1. If the explanations cannot be separated from the patents or publications, such patents or publications will be discarded. By the time the examiner receives the application file and submission, some or all patents or publications in the submission may have been discarded.

If the applicant wants to ensure that the information in a third-party submission is considered by the examiner, the applicant should submit such information in an IDS in compliance with 37 CFR 1.97 and 1.98. Since the third party is required to serve the applicant a copy of the submission, applicant may file the IDS prior to the Office receiving or acting on the submission. Furthermore, an individual who has a duty to disclose under 37 CFR 1.56 should submit any material information contained in a third-party submission to the Office in an IDS in compliance with 37 CFR 1.97 and 1.98 to ensure such material information is properly disclosed to the examiner, if the examiner has not indicated that the reference has been considered.

## I. TIMELINESS REQUIREMENT

37 CFR 1.99(e) specifies that a submission under 37 CFR 1.99 must be filed within two months from the date of publication of the application (37 CFR 1.215(a)), or prior to the mailing of a notice of allowance (37 CFR 1.311), whichever is earlier. Republication of an application under 37 CFR 1.221 does not restart the two-month period specified in 37 CFR 1.99(e).

In determining the timeliness of a third-party submission, the publication date of an application filed under 35 U.S.C. 111(a) is the date that the application published under 35 U.S.C. 122(b). However, the publication date of an application which entered the national stage of an international application after compliance with 35 U.S.C. 371 is the publication date of the World Intellectual Property Organization (WIPO) publication, if the international application is

filed on or after November 29, 2000. The WIPO publication of an international application designating the United States filed on or after November 29, 2000 under PCT Article 21(2) is deemed a publication under 35 U.S.C. 122(b) except as provided in 35 U.S.C. 102(e) and 154(d). See 35 U.S.C. 374.

Any submission not filed within the time period specified in 37 CFR 1.99(e) is permitted only when the patents or publications could not have been submitted to the Office earlier (e.g., an amendment submitted in the application after publication changes the scope of the claims to an extent that could not reasonably have been anticipated by a person reviewing the published application during the period specified in 37 CFR 1.99(e)). Submissions after the time period specified in 37 CFR 1.99(e) must be accompanied by (1) a statement that the patents or publications being submitted in the submission could not have been submitted to the Office earlier, and (2) the processing fee as set forth in 37 CFR 1.17(i).

## II. CONTENTS REQUIREMENTS FOR A THIRD-PARTY SUBMISSION

The submission should be clearly labeled as a third-party submission under 37 CFR 1.99 and not as a protest, an IDS or a pre-issuance opposition. Prior to filing a submission under 37 CFR 1.99, the patents or publications being submitted must be served upon the applicant pursuant to 37 CFR 1.248. A submission under 37 CFR 1.99 must identify the application to which it is directed by the application number and must include:

- (A) the fee set forth in 37 CFR 1.17(p);
- (B) a listing of the patents or publications submitted for consideration by the Office (including the date of publication of each patent or publication);
- (C) a copy of each listed patent or publication in written form or at least the pertinent portions thereof;
- (D) an English language translation of all pertinent parts of any non-English language patent or publication in written form; and
- (E) a certification that the third party has served the information being submitted upon the applicant in compliance with 37 CFR 1.248(b).

Pursuant to 37 CFR 1.99(d), a submission **cannot** include any of the following:

- (A) more than ten total references (patents or publications);
- (B) explanations of the patents or publications;
- (C) documents other than patents or publications (e.g., the submission cannot include any affidavits or declarations); or
- (D) markings or highlights on the patents or publications.

The third party may, however, submit redacted versions of a patent or publication containing only the most relevant portions of the patent or publication. The Office will review submissions to determine whether they are limited to patents and publications and remove any explanations or documents other than patents and publications from the submission before the submission is placed in the file of the application and forwarded to the examiner. The Office will dispose of such explanations or documents if included in a submission. Furthermore, if the explanation cannot be readily removed from the patents or publications (e.g., highlights), the patents or publications will be discarded.

### III. NO THIRD-PARTY PARTICIPATION

The involvement of a third party in filing a submission under 37 CFR 1.99 ends with the filing of the submission. A third party may include a self-addressed postcard with a submission filed under 37 CFR 1.99 to receive an acknowledgment by the Office that the submission has been received. The third party filing the submission will not receive any communications from the Office relating to the submission other than the return of the self-addressed postcard. The third party should not contact the Office or submit any other inquiries. See MPEP § 1134.

### IV. TREATMENT OF A THIRD-PARTY SUBMISSION

#### A. *Procedures for Technical Support Staff*

Technical support staff in the Technology Center (TC) will initially process third party submissions under 37 CFR 1.99. Once the technical support personnel recognizes a prior art submission as a third party submission under 37 CFR 1.99, he or she will enter the third party submission into PALM and into the application file. For Image File Wrapper (IFW) processing, see IFW Manual, Section 2.1. The techni-

cal support personnel will verify that the fee for a submission under 37 CFR 1.99 (i.e., the fee set forth in 37 CFR 1.17(p)) has been paid and, if appropriate, collect the fee(s) that may have been authorized in the third party submission. If the fee has not been paid (and there is no authorization to charge the fee contained in the third party submission), technical support personnel are **not** to charge applicant's deposit account for the requisite fee since the submission is being submitted by a third party and not the applicant. The technical support personnel will review the listing of patents and publications to verify that it is clearly identified as a submission under 37 CFR 1.99. If the listing is not identified as a submission under 37 CFR 1.99, the technical support personnel will write on the listing "Submission under 37 CFR 1.99" followed by his or her initials and the date of entry. The technical support personnel will then forward the submission and the application file to the Supervisory Patent Examiner (SPE) or Special Program Examiner (SPRE) responsible for screening submissions under 37 CFR 1.99. Occasionally, a third party may file a correspondence that is not properly labeled as a third party submission under 37 CFR 1.99 in a published application (e.g., the paper may be labeled as an IDS or a protest). Such paper should be processed as a third-party submission under 37 CFR 1.99 and the designated screener should review the paper as a submission under 37 CFR 1.99.

#### B. *Procedures for Screeners*

Once the third party submission and application file have been forwarded to the SPE or SPRE who is responsible for screening submissions under 37 CFR 1.99, the SPE or SPRE will screen the third party submission to determine whether the submission is in compliance with the timeliness requirements noted in subsection I. above and the content requirements noted in subsection II. above. Submissions under 37 CFR 1.99 that do not comply with the timeliness or content requirements will be discarded. Only those submissions that comply with 37 CFR 1.99 will be forwarded to the examiner along with the application file for consideration. For IFW processing, see IFW Manual, Section 2.1.

If the entire submission or parts of the submission need to be discarded, the screener should place the cover letter or the first page of the submission (trans-

mittal) and parts of the submission that are in compliance with the requirements of 37 CFR 1.99 in the application file and discard the rest of the submission. The screener should write on the transmittal that 'the third party submission (or the list of items) has been discarded,' and include the reason(s) why the submission or the items have been discarded (e.g., the submission was not timely filed or copies of items 1, 2, & 3 are not provided). The screener should also include his or her initials, and the date of entry.

If a patent or publication has been discarded (e.g., because it contained highlighted portions), there is nothing to preclude the screener from separately obtaining a clean copy of the patent or publication. After the submission has been reviewed for compliance with all the requirements of 37 CFR 1.99, the submission and the application file will be forwarded to the examiner for consideration.

### **C. Procedures for Examiners**

Once the third-party submission and the application file have been forwarded to the examiner, the examiner should act on the submission immediately. If an Office action is outstanding, the examiner may treat the submission when preparing the Office action. If an Office action is not outstanding, the examiner should treat the submission immediately on a separate Office communication (i.e., a PTOL-90).

The examiner should not initial any patents or publications on the listing of patents or publications submitted in a third-party submission. The examiner may request applicant's comments on any patent or publication in the submission.

The examiner should notify applicant of the Office treatment of the third-party submission using form paragraph 6.56. If any patent or publication in the submission under 37 CFR 1.99 has been determined by the examiner to be relevant to the patentability of the claims in the published application, the examiner should list the patent or publication on form PTO-892 and provide an explanation of its relevance unless the patent or publication has been used in a rejection. If

the examiner considers it desirable, or necessary, to obtain applicant's comments on the patents or publications submitted before further action, the examiner will offer applicant an opportunity to file comments. If the examiner has specific questions or requests for information from the applicant regarding any of the patents or publications, the examiner may make a requirement for information under 37 CFR 1.105. See MPEP § 704.<

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### **1135 PGPub Forms [R-2]**

The following PGPub forms are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)) and are reproduced at the end of this section:

Form PTO/SB/24A, "Petition for Express Abandonment to Avoid Publication Under 37 CFR 1.138(c)," may be used by applicant for filing a petition for express abandonment to avoid publication under 37 CFR 1.138(c). See MPEP § 1125. Form PTO/SB/35, "Nonpublication Request Under 35 U.S.C. 122(b)(2)(B)(i)," may be used by applicant for filing a request for nonpublication and the certification under 35 U.S.C. 122(b)(2)(B)(i) upon the filing of an application. See MPEP § 1122. Form PTO/SB/36 (revision April 2001 or later), "Rescission of Previous Nonpublication Request (35 U.S.C. 122(b)(2)(B)(ii)) and, if Applicable, Notice of Foreign Filing (35 U.S.C. 122(b)(2)(B)(iii))," may be used by applicant for filing a request for rescinding a previously filed nonpublication request and/or for filing a notice of foreign filing. The certificate of mailing or transmission only applies when applicant is filing a notice of foreign filing. See MPEP §§ 1123 and 1124. Form PTO/SB/64a, "Petition for Revival of an Application for Patent Abandoned for Failure to Notify the Office of a Foreign or International Filing (37 CFR 1.137(f))," may be used by applicant for filing a petition to revive an application abandoned for failure to notify the Office of a foreign filing. See MPEP § 1124.

PTO/SB/24A (04-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<p align="center"><b>PETITION FOR EXPRESS ABANDONMENT TO AVOID PUBLICATION UNDER 37 CFR 1.138(c)</b></p> <hr/> <p>Fax the petition directly to the Pre-Grant Publication Division at (703) 305-8568 Or Mail the petition to: <b>Mail Stop Express Abandonment</b> Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450</p>	<b>Application Number</b>	
	<b>Filing Date</b>	
	<b>First Named Inventor</b>	
	<b>Art Unit</b>	
	<b>Examiner Name</b>	
	<b>Attorney Docket Number</b>	

**Petition for Express Abandonment to Avoid Publication under 37 CFR 1.138(c)**

I hereby petition to expressly abandon the above-identified application to avoid publication.

**Petition Fee** – must be filed with petition to avoid delays in recognizing the petition.

- a.  The Director is hereby authorized to charge the petition fee under 37 CFR 1.17(h) to Deposit Account No. \_\_\_\_\_.
- b.  Check in the amount of \$ \_\_\_\_\_ is enclosed.
- c.  Payment by credit card (Form PTO-2038 is enclosed).

**NOTE:** A paper requesting express abandonment of an application is not effective unless and until an appropriate USPTO official recognizes and acts on the paper. See the Manual of Patent Examining Procedure (MPEP), section 711.01. In addition, the paper will not stop publication of the application unless a petition under 37 CFR 1.138(c) is recognized and acted on by the Pre-Grant Publication Division in sufficient time to avoid publication (e.g., more than four (4) weeks prior to the projected publication date).

- I am the:  applicant.
- assignee of record of the entire interest. See 37 CFR 3.71.  
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- attorney or agent of record. Registration Number \_\_\_\_\_

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Date

\_\_\_\_\_  
Typed or printed name

\_\_\_\_\_  
Telephone Number

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 37 CFR 1.138(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Express Abandonment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*



PTO/SB/35 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

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<b>NONPUBLICATION REQUEST UNDER 35 U.S.C. 122(b)(2)(B)(i)</b>	First Named Inventor	
	Title	
	Attorney Docket Number	

I hereby certify that the invention disclosed in the attached application **has not and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

I hereby request that the attached application not be published under 35 U.S.C. 122(b).

\_\_\_\_\_

Date

\_\_\_\_\_

Signature

\_\_\_\_\_

Telephone number

\_\_\_\_\_

Typed or printed name

This request must be signed in compliance with 37 CFR 1.33(b) and submitted with the application **upon filing**.

Applicant may rescind this nonpublication request at any time. If applicant rescinds a request that an application not be published under 35 U.S.C. 122(b), the application will be scheduled for publication at eighteen months from the earliest claimed filing date for which a benefit is claimed.

If applicant subsequently files an application directed to the invention disclosed in the attached application in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant **must** notify the United States Patent and Trademark Office of such filing within forty-five (45) days after the date of the filing of such foreign or international application. **Failure to do so will result in abandonment of this application (35 U.S.C. 122(b)(2)(B)(iii)).**

This collection of information is required by 37 CFR 1.213(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

PTO/SB/36 (08-03)  
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<p style="text-align: center;"><b>RESCISSION OF PREVIOUS NONPUBLICATION REQUEST</b>                  (35 U.S.C. 122(b)(2)(B)(ii))  <b>AND, IF APPLICABLE, NOTICE OF FOREIGN FILING</b>                  (35 U.S.C. 122(b)(2)(B)(iii))</p> <p>Send completed form to:  <b>Mail Stop PG Pub</b>                  Commissioner for Patents                  P.O. Box 1450                  Alexandria, VA 22313-1450                  FAX: (703) 305-8568</p>	Application Number	
	Filing Date	
	First Named Inventor	
	Title	
	Atty Docket Number	
	Group Art Unit	
	Examiner	

A request that the above-identified application not be published under 35 U.S.C. 122(b) (nonpublication request) was included with the above-identified application on filing pursuant to 35 U.S.C. 122(b)(2)(B)(i). I hereby **rescind** the previous nonpublication request.

If a notice of foreign or international filing is or will be required by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c), I hereby provide such notice. This notice is being provided no later than forty-five (45) days after the date of such foreign or international filing.

*If a notice of subsequent foreign or international filing required by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) was not filed within forty-five (45) days after the date of filing of the foreign or international application, the application is ABANDONED, and a petition to revive under 37 CFR 1.137(b) is required. See 37 CFR 1.137(f).*

_____	_____
Date	Signature
_____	_____
Telephone Number	Typed or printed name

**This request must be signed in compliance with 37 CFR 1.33(b).**

If information or assistance is needed in completing this form, please contact the Pre-Grant Publication Division at (703) 605-4283 or by e-mail at [PGPub@USPTO.gov](mailto:PGPub@USPTO.gov).

**CERTIFICATE OF MAILING OR TRANSMISSION**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop PG Pub, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile ((703) 305-8568) transmitted to the U.S. Patent and Trademark Office on the date shown below.

Name (Print/Type)		Date	
Signature			

Burden Hour Statement: This collection of information is required by 37 CFR 1.213(b). The information is used by the public to rescind a previously filed request that an application not be published under 35 U.S.C. 122(b) (and the PTO to process that rescission). Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This form is estimated to take 6 minutes to complete. This time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop PG Pub, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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PTO/SB/64a (11-03)  
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<b>PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED FOR FAILURE TO NOTIFY THE OFFICE OF A FOREIGN OR INTERNATIONAL FILING (37 CFR 1.137(f))</b>	Docket Number (Optional)
<p>First named inventor:</p> <p>Application No.: _____ Art Unit: _____</p> <p>Filed: _____ Examiner: _____</p> <p>Title: _____</p> <p>Attention: Office of Petitions  <b>Mail Stop Petition</b>                  Commissioner for Patents                  P.O. Box 1450                  Alexandria, VA 22313-1450                  FAX: (703) 872-9306</p> <p style="text-align: center;">NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.</p> <p>The above-identified application became abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational international treaty that requires publication of applications eighteen months after filing. The date of abandonment is the day after the expiration date of the forty-five (45) day period set in 35 U.S.C. 122(b)(2)(B)(iii).</p> <p style="text-align: center;">PURSUANT TO 37 CFR 1.137(f), APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION UNDER 37 CFR 1.137(b)</p> <p>1. Petition fee</p> <p><input type="checkbox"/> Small entity-fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.</p> <p><input type="checkbox"/> Other than small entity - fee \$ _____ (37 CFR 1.17(m))</p> <p>2. Notice of Foreign or International Filing (35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c))</p> <p>Subsequent to the filing of the above-identified application, an application was filed in another country, or under a multinational international treaty (e.g., filed under the Patent Cooperation Treaty), that requires publication of applications eighteen months after filing. The filing date of the subsequently-filed foreign or international application is _____.</p>	

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This collection of information is required by 37 CFR 1.137. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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MANUAL OF PATENT EXAMINING PROCEDURE

PTO/SB/64a (11-03)

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STATEMENT: The entire delay in filing the required notice of a foreign or international filing from the due date for the required notice until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

[NOTE. The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D))].

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

\_\_\_\_\_ Date

\_\_\_\_\_ Signature

Telephone  
Number: \_\_\_\_\_

\_\_\_\_\_ Typed or printed name

\_\_\_\_\_ Address

\_\_\_\_\_

Enclosures:  Fee Payment

Additional sheets containing statements establishing unintentional delay

Other: \_\_\_\_\_

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 872-9306.

\_\_\_\_\_ Date

\_\_\_\_\_ Signature

\_\_\_\_\_ Typed or printed name of person signing certificate