Helpful Hints Regarding
Publication of Patent Applications

The United States Patent and Trademark Office (USPTO) is now publishing pending utility and plant applications, other than reissue applications, under the eighteen-month publication provisions (eighteen-month publication) of the American Inventors Protection Act of 1999 (AIPA) (P.L. 106-113). The USPTO has received numerous telephone and e-mail inquiries concerning publication of patent applications. This "Helpful Hints" notice highlights questions and answers that are posted on the USPTO web site at www.uspto.gov/web/offices/dcom/olia/aipa/infoexch.htm#C and provides information about the Patent Application Information Retrieval System. In addition, this notice describes how the projected or revised publication date of an application is communicated to applicant, how applicants are informed of the publication of an application, and provides other information regarding publication of patent applications.

Questions and Answers

The USPTO posts questions and answers addressing repeatedly asked questions on the USPTO web site. Applicants are encouraged to check these questions and answers to see if their inquiries are addressed before calling the USPTO. Examples of such questions and answers are:

Q. I received a filing receipt with a projected publication date, and I don’t think that the application should be published, what should I do?

A. If you do not think that you should have received a projected publication date because you filed a request for continued examination or because the filing date of the application is before November 29, 2000, contact the Technology Center where your application is assigned and ask for the Customer Service Representative. The Representative can have the problem corrected.

Patent Application Information Retrieval System

The Patent Application Information Retrieval (PAIR) system is a system which enables applicants and the public to obtain access to the USPTO’s electronic records for a patent application or patent. PAIR has a public side, which displays information for published U.S. patent applications and U.S. patents, as well as a private side, which is only available to certain applicants and displays information for the applicants applications. Private PAIR is available to applicants who have a customer number associated with the correspondence address for an application and who have acquired the access software (Entrust Direct Software and a PKI certificate). PAIR can be accessed over the Internet at http://pair.uspto.gov.

If a projected publication date has been assigned to a patent application, applicants may submit corrections to the bibliographic information through the private side of PAIR, instead of mailing in a request for a corrected filing receipt. The correction will be reflected
in the patent application publication so long as the correction is submitted more than twelve weeks before the projected publication date. In the private side of PAIR, applicant should choose the Publication Review button, and then the Request Data Change button on the screen. The instructions will then appear with a data entry box in which the changes can be inserted. For instance "An inventor has been omitted. John Doe should be added with a residence of Arlington, VA." Once the change has been confirmed, the Transmit Request button should be selected, and the information will be electronically sent to the USPTO. A copy of the request will not be placed in the patent application file. Applicant may only submit a request through PAIR to request correction of inventor information consistent with the inventor information reflected in the patent application file. For example, if the USPTO entered four of the five inventors shown in the executed oath or declaration, applicant may submit a request through PAIR to add the missing inventor. If the originally filed executed declaration named an inventor who should not have been named as an inventor, or did not include someone who should have been included as an inventor, then applicant must file the change under 37 CFR 1.48.

Requests filed through PAIR will arrive in the Customer Support Center of the Electronic Business Center (EBC), where the data will be entered in the USPTO’s computer database, and, once the data is entered, the changes will be displayed in PAIR. A corrected filing receipt will be mailed to applicant once the EBC has made the correction. This new means of requesting a change to the bibliographic data should greatly assist the applicant and the Office, and should significantly reduce the need for submitting correspondence by mail requesting corrected filing receipts. The Customer Support Center of the EBC can be reached by telephone at (703) 305-3028. If applicant requests a change that cannot be made through PAIR (e.g., a change to the order of inventor names, or the addition of an inventor not named in the executed oath or declaration), then the EBC will send a communication to applicant indicating that the request cannot be made through PAIR.

**Notice of Projected Publication Date**

The filing receipt of an application filed on or after November 29, 2000, including a Continued Prosecution Application (CPA) filed on or after November 29, 2000 in an application filed before May 29, 2000, includes the projected publication date (PPD) that has been assigned to a patent application, or if a nonpublication request was filed, that the request is acknowledged and confirming that there is no PPD. The projected publication date of an application is the Thursday after the date that is eighteen months after the earliest filing date claimed by the applicant. Accordingly, if the application does not claim priority under 35 U.S.C. §§ 119, 120 or 365, then the projected publication date is eighteen months after the filing date of the application. If the application claims priority, such as priority under 35 U.S.C. § 119(e) to a provisional application, then the projected publication date is the Thursday after the date that is eighteen months after the filing date of the provisional application. If the earliest priority claim was more than 15 months before the filing date of the application, then the projected publication date will be about fourteen weeks after the mailing date of the filing receipt. If the projected publication date is changed by more than six weeks, a "Notice of New or Revised Publication Date" will be mailed, informing applicant of the new projected publication date.
Notice of Publication Prior to Publication and Publication of Patent Application

Applicant will be mailed a notice which will indicate the publication number and publication date about two weeks before the publication date of the application. Upon publication, the publication will be available on the USPTO websites’ Searchable Patent Databases section at www.uspto.gov/patft and information about the application will be available on the public, as well as on the private, side of PAIR.

Nonpublication Requests

Applicants are reminded that for plant and utility applications filed on or after November 29, 2000, a request for nonpublication must be made at the time of filing and be conspicuous. See 37 CFR 1.213(a)(2). A non-conspicuous request such as a request included on an application transmittal letter will generally not be noticed, and the application will be assigned a publication date. Applicants are encouraged to use USPTO Form PTO/SB/35, if a nonpublication request is to be made and applicants do not want the application published and the benefits of 35 U.S.C. § 154(d). If a nonpublication request is filed, it is recommended that the nonpublication request be itemized on a post card receipt. A request for nonpublication is appropriate only if the application has not been and will not be the subject of an application filed in another country, or under a multilateral agreement, that requires publication of applications eighteen months after filing.

If applicant did not submit a nonpublication request on filing, the request cannot be filed later and be effective. See 35 U.S.C. 122(b)(2)(B)(i). Instead, applicant may expressly abandon the application by filing a petition under 37 CFR 1.138(c), and file a continuation application under 37 CFR 1.53(b) by including a nonpublication request upon filing of the continuation application. The continuation application may claim benefit under 35 U.S.C. § 120 to the prior application. Alternatively, if the application does not claim priority to another application (see 35 U.S.C. § 111(b)(7)), applicant may file a petition to convert the application into a provisional application (see 37 CFR 1.53(c)). Thereafter, applicant may file a non-provisional application with a nonpublication request and claim the benefit of the prior provisional application in the non-provisional application under 35 U.S.C. § 119(e). Applicant cannot avoid publication of the application where a nonpublication request complying with 37 CFR 1.213(a) has not been submitted at the time of filing by subsequently submitting a request for continued examination (RCE), since an RCE is not a new application. In addition, a CPA cannot be filed because the prior application will have been filed on or after May 29, 2000. See 37 CFR 1.53(d)(1)(i)(A).

Avoid Preliminary Amendments

Applicants are also reminded that when a continuation or divisional application (other than a CPA) is filed, applicant should file a clean copy of the specification, including any required amendments. See 37 CFR 1.215(a). A copy of a previously-executed oath or declaration may still be filed with the clean copy of the specification. See 37 CFR 1.63(d) and Changes to Patent Practice and Procedure; Final Rule, 62 Fed. Reg. 53131, 53148
If preliminary amendments are filed, the preliminary amendments (new claims, etc.) will not be reflected in the patent application publication, unless they are submitted as part of a submission through the Electronic Filing System (EFS). See 37 CFR 1.215(c). For a CPA, the application that is published is the application as originally filed, i.e., the prior application, and a substitute specification will only be used for creating the patent application publication if it is submitted through EFS.

Voluntary Publication of Applications filed Before November 29, 2000

The Office has received several requests for voluntary publication of an application filed prior to November 29, 2000, where the request was not submitted in accordance with the EFS requirements. Such requests will be dismissed, and any processing fee paid (including those authorized to be charged, e.g., to a deposit account) will be retained. See 37 CFR 1.221(a). If applicant meets the EFS requirements, but does not include the publication and processing fees as set forth in 37 CFR 1.18(d) and 1.17(i), respectively, the Office will send applicant a letter requiring the fees, and publication of the application will be delayed.

For Further Information

General questions regarding publication of patent applications should be directed to the Customer Service Center, Office of Patent Publication, by telephone at (703) 305-8283. Questions regarding the Electronic Filing System should be directed to (703) 305-3028. Questions of a legal nature should be directed to the Office of Patent Legal Administration at (703) 308-6906.

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STEPHEN G. KUNIN
Deputy Commissioner for Patent Examination Policy