


35 U.S.C. § 122(b)(2)(B)(i) provides that an application filed in the United States will not be published if the applicant includes a request upon filing that the application not be published (a "nonpublication request"). Such a request must contain the certification "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

35 U.S.C. § 122(b)(2)(B)(i)-(iv) provides that:

(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international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in [35 U.S.C. § 122(b)(1)].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 [35 U.S.C. § 122(b)(1)] on or as soon as is practical after the date that is specified in clause (i).

**In Summary**

(1) If an applicant makes a nonpublication request and then rescinds the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country, the application will be treated as if the nonpublication request were never made.

(2) If an applicant makes a nonpublication request, subsequently files a counterpart application in an eighteen-month publication country and also files a notice of this foreign filing within forty-five days of the date such counterpart application was filed, the applicant is not required to rescind the nonpublication request.

(3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, 35 U.S.C. § 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.

(4) When an application is abandoned by operation of 35 U.S.C. § 122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, 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.

(5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

(6) Applicants may use USPTO form PTO/SB/36 (revision April 2001 or later) to both rescind a nonpublication request and provide notice of foreign filing.

(1) **Rescinding a Nonpublication Request Before or on the Date a Counterpart Application is Filed**

Rescission generally has the effect of voiding, repealing, or annulling a previous action. See Black's Law Dictionary 1308 (7th ed. 1999) (second definition: to make void, to repeal, or annul). Thus, if an applicant makes a nonpublication request under 35 U.S.C. § 122(b)(2)(B)(i) and then rescinds (pursuant to 35 U.S.C. § 122(b)(2)(B)(ii)) the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country, 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 had never been made.

(2) **Filing a Counterpart Application and Providing Notice of Foreign Filing Without Also Rescinding the Nonpublication Request**

35 U.S.C. § 122(b)(2)(B)(iii) requires an applicant who has made a nonpublication request under 35 U.S.C. § 122(b)(2)(B)(i) but who subsequently files a counterpart application in an eighteen-month publication country to notify the USPTO of such filing not later than forty-five days after the date
such counterpart application was filed to avoid abandonment of the application. 35 U.S.C. § 122(b)(2)(B)(iii), however, does not require the applicant to also rescind (pursuant to 35 U.S.C. § 122(b)(2)(B)(ii)) the nonpublication request. In addition, 35 U.S.C. § 122(b)(2)(B)(ii) is permissive in that it provides that an applicant may rescind a nonpublication request at any time, but it does not set forth any situation under which an applicant is required to rescind a nonpublication request. Finally, 35 U.S.C. § 122(b)(2)(B)(iv) provides that notifying the USPTO of a foreign filing has the same effect on the application as rescinding the nonpublication request in the application, namely the application will be published in accordance with the provisions of 35 U.S.C. § 122(b)(1) at or as soon as is practical after eighteen months from the earliest filing date for which a benefit is sought under title 35, U.S.C. Thus, if an applicant makes a nonpublication request under 35 U.S.C. § 122(b)(2)(B)(i), files a counterpart application in an eighteen-month publication country and also files a notice of this foreign filing under 35 U.S.C. § 122(b)(2)(B)(iii) within forty-five days of the date such counterpart application was filed, the applicant is not also required to rescind the nonpublication request.

(3) Filing a Counterpart Application Before Rescinding a Nonpublication Request

As indicated above, a rescission under 35 U.S.C. § 122(b)(2)(B)(ii) of a nonpublication request under 35 U.S.C. § 122(b)(2)(B)(i) has the effect of annulling the nonpublication request, placing the application in the position as if the nonpublication request had never been made. However, a nonpublication request is operative unless and until the nonpublication request has been annulled through the filing of a rescission or the USPTO has been notified of a foreign filing under 35 U.S.C. § 122(b)(2)(B)(iii). An applicant who has filed an application with a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country at a time when nonpublication request is still operative falls squarely under the provisions of 35 U.S.C. § 122(b)(2)(B)(iii) and is required to notify the USPTO of this foreign filing not later than forty-five days after the date the counterpart application was filed to avoid abandonment. If the nonpublication request has not been rescinded before the filing of a counterpart application in an eighteen-month publication country, merely filing a rescission of the nonpublication request without also filing a notice of foreign filing within forty-five days after the date the counterpart application was filed is not sufficient to avoid abandonment of the application.

Specifically, if applicant makes a nonpublication request under 35 U.S.C. § 122(b)(2)(B)(i) and files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, the provisions of 35 U.S.C. § 122(b)(2)(B)(iii) require applicant to notify the USPTO of the foreign filing not later than forty-five days after the date the counterpart application was filed to avoid abandonment. If the nonpublication request has not been rescinded before the filing of a counterpart application in an eighteen-month publication country, merely filing a rescission of the nonpublication request without also filing a notice of foreign filing within forty-five days after the date the counterpart application was filed is not sufficient to avoid abandonment by operation of 35 U.S.C. § 122(b)(2)(B)(iii).

Similarly, if applicant makes a nonpublication request under 35 U.S.C. § 122(b)(2)(B)(i) and files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, and fails to notify the USPTO not later than forty-five days after the date the counterpart application was filed, the application is abandoned by operation of 35 U.S.C. § 122(b)(2)(B)(iii). Filing a rescission under 35 U.S.C. § 122(b)(2)(B)(ii) of this nonpublication request later than forty-five days after the date the counterpart application was filed would not have the effect of annulling the nonpublication request so as to retroactively restore the application to pending status.
Finally, if an applicant makes nonpublication request under 35 U.S.C. § 122(b)(2)(B)(i) that contains an improper certification because the applicant had already filed one or more applications in an eighteen-month publication country at the time of the nonpublication request, filing a rescission under 35 U.S.C. § 122(b)(2)(B)(ii) of this nonpublication request will not annul the fact that applicant made an improper certification to the USPTO. 35 U.S.C. 122(b)(2)(B)(iii) does not apply when an applicant has made an improper certification subsequent to the filing of a counterpart application in an eighteen-month publication country. Nevertheless, any applicant who has made such a mistake should promptly file a rescission of the nonpublication request and explain that the certification was improper.

(4) Petitions to Revive an Application Abandoned for Failure to Timely file a Notice of Foreign Filing


Therefore, when an application is abandoned by 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. 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 also that the delay in submitting the notice of foreign filing have been unintentional (35 U.S.C. § 122(b)(2)(B)(iii)). Form PTO/SB/64a may be used for such a petition to revive.

Questions regarding petitions to revive should be directed to the Office of Petitions at (703) 305-9282.

(5) No Benefit Given to a Certificate of Mailing or Transmission (37 CFR 1.8) on a Rescission of a Nonpublication Request

Applicants are strongly encouraged to also provide a notice of foreign filing whenever rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country. This is because no benefit can be given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of 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, of the rescission to determine whether the nonpublication request has been rescinded before or on the date of the filing of a counterpart application in an eighteen-month publication country such that the application may be considered an
application in which the nonpublication request under 35 U.S.C. § 122(b)(1)(B)(i) was never made.

However, in an application in which a nonpublication request under 35 U.S.C. § 122(b)(1)(B)(i) was made and was not rescinded before or on the date of the filing of a counterpart application in an eighteen-month publication country, a notice of foreign filing is required to be filed in the USPTO by 35 U.S.C. § 122(b)(2)(B)(iii) no later than forty-five days after the date the counterpart application was filed to avoid abandonment of the application (35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.215(c)). Accordingly, 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).

(6) USPTO 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 USPTO form PTO/SB/36 (revision April 2001 or later) to rescind a nonpublication request also contains the foreign filing notice required by 35 U.S.C. § 122(b)(2)(B)(iii). Applicants are reminded that the USPTO has no authority to waive a requirement of the patent statute. See, e.g., Baxter Int'l, Inc. v. McGaw, Inc, 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-35 (Fed. Cir. 1998). Thus, applicants are cautioned to familiarize themselves with the requirements of the patent statute to ensure that a submission, whether on a USPTO-provided form or an applicant-created form that is modeled after a USPTO-created form, meets the requirements of the patent statute that are applicable to the particular submission.

Inquiries

Inquiries concerning this notice may be directed to Joni Y. Chang and Mark O. Polutta, Legal Advisors, Office of Patent Legal Administration, by telephone at (703) 305-1622.

Inquiries concerning eighteen-month publication in general (including the rescission of a nonpublication request) should be directed to the patent application publication hotline at (703) 605-4283 or by e-mail pgpub@uspto.gov.

Date: 06/05/2003 Signed: /s/

STEPHEN G. KUNIN
Deputy Commissioner for Patent Examination Policy

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(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 [35 U.S.C. § 122(b)(1)] on or as soon as is practical after the date that is specified in clause (i).