Reminder that Rescission of a Nonpublication Request is Not Itself a Notice of Foreign Filing

Office of Patent Legal Administration << Pre-OG Notices << Reminder that Rescission of a Nonpublication Request is Not Itself a Notice of Foreign Filing

35 U.S.C. § 122(b)(2)(B)(iii) provides that an applicant who has made a nonpublication request under 35 U.S.C. § 122(b)(2)(B)(i) in an application filed in the United States Patent and Trademark Office (USPTO), but who subsequently files, in a foreign country or under a multilateral international agreement that requires eighteen-month publication (hereinafter "foreign filing" or "foreign country"), an application directed to the invention disclosed in the application filed in the USPTO (hereinafter "counterpart application"), must notify the USPTO of the foreign filing not later than forty-five days after the date of such foreign filing. 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-day period shall result in abandonment of the application.

Therefore, whenever a patent application is filed in the USPTO with a nonpublication request, and the applicant later files a counterpart application in a foreign country, the applicant must provide notice of the foreign filing within forty-five days to avoid abandonment of the application by operation of 35 U.S.C. § 122(b)(2)(B)(iii). The requirement in 35 U.S.C. § 122(b)(2)(B)(iii) for notice of the foreign filing is in addition to any rescission of the nonpublication request under 35 U.S.C. § 122(b)(2)(B)(ii). That is, if an applicant files a counterpart application in a foreign country after having filed an application in the USPTO with a nonpublication request, filing a rescission of the nonpublication request under 35 U.S.C. § 122(b)(2)(B)(ii) without also providing a notice of the foreign filing in a timely manner will result in abandonment of the United States application under 35 U.S.C. § 122(b)(2)(B)(iii).

The current 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 strongly encouraged to use the current USPTO form (PTO/SB/36) when rescinding a nonpublication request because of a subsequent foreign filing of a counterpart application. If an applicant merely rescinds a nonpublication request but does not also file a notice of foreign filing within forty-five days of the subsequent foreign filing of a counterpart applicant, applicant must file a petition under 37 CFR 1.137(b) to revive the abandoned United States application (37 CFR 1.137(f)).

Questions regarding petitions to revive should be directed to the Office of Petitions at (703) 305-9282. Questions regarding publication of patent applications (or rescissions of nonpublication requests) should be directed to the patent application publication hotline at (703) 605-4283 or by e-mail pgpub@uspto.gov.

Date: 04/11/2003  Signed: /s/  
STEPHEN G. KUNIN  
Deputy Commissioner for Patent Examination Policy