

# Chapter 1100 Statutory Invention Registration (SIR); Pre-Grant Publication (PGPub) and Preissuance Submissions

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## 1101 Request for Statutory Invention Registration (SIR) [R-11.2013]

Only requests for a statutory invention registration filed prior to March 16, 2013 are timely. Requests for a statutory invention registration filed on or after March 16, 2013 will not be treated as the provisions of [pre-AIA 35 U.S.C. 157](#) were repealed on March 16, 2013, effective for any request filed on or after that date. See §3(e) of the America Invents Act. Guidance on requests filed before March 16, 2013 may be found in the ninth revision of the Eighth Edition of the MPEP published August 2012. The

material in former MPEP §§ 1103-1109 is not repeated in this edition of the MPEP.

- 1102
- 1110 [Reserved]

## 1111 SIR Publication and Effect [R-11.2013]

*(pre-2013-03-16) 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 [pre-AIA 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 [pre-AIA 35 U.S.C. 102\(g\)](#) and “prior art” under all applicable sections of [35 U.S.C. 102](#) including [35 U.S.C. 102\(a\)\(2\)](#) and [pre-AIA 35 U.S.C. 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 data bases, 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 ( [pre-AIA 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. 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.

**1112**  
**-1119 [Reserved]**

**1120 Eighteen-Month Publication of Patent Applications [R-07.2015]**

**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](#);

(iii) a provisional application filed under [section 111\(b\)](#); or

(iv) an application for a design patent filed under [chapter 16](#).

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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](#)), 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, international design applications under [35 U.S.C. chapter 38](#), 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\(c\)](#)) and any English translation required by [§ 1.52\(d\)](#). The Office may delay publishing any application until it includes any application size fee required by the Office under [§ 1.16\(s\)](#) or [§ 1.492\(j\)](#), a specification having papers in compliance with

[§ 1.52](#) and an abstract ([§ 1.72\(b\)](#)), drawings in compliance with [§ 1.84](#), a sequence listing in compliance with [§§ 1.821](#) through [1.825](#) (if applicable), and the inventor's oath or declaration or application data sheet containing the information specified in [§ 1.63\(b\)](#).

(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.

#### *Pre-AIA 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\(c\)](#)), 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 any application size fee required by the Office under [§ 1.16\(s\)](#) or [§ 1.492\(j\)](#), 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.

For applications filed on or after September 16, 2012, [37 CFR 1.211\(c\)](#) does not require an executed oath or declaration for publication of the application since applicants may postpone filing the inventor's oath or declaration until payment of the issue fee. The Office may delay publishing any application until it includes the inventor's oath or declaration or application data sheet containing the information specified in [37 CFR 1.63\(b\)](#).

## 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](#);

(C) International design applications filed under [35 U.S.C. 385](#); and

(D) 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 for which a benefit is sought 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 1.55 or 1.78](#) and the surcharge set forth in [37 CFR 1.17\(t\)](#). See [MPEP § 211.04 and 214.02](#). 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 website ([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; and
- (B) an English translation if the application is in a language other than English.

The Office may delay publication until the application includes:

(A) any application size fee required by the Office under [37 CFR 1.16\(s\)](#) or [37 CFR 1.492\(j\)](#);

(B) a specification in compliance with [37 CFR 1.52](#);

(C) an abstract in compliance with [37 CFR 1.72\(b\)](#);

(D) drawings (if any) in compliance with [37 CFR 1.84](#);

(E) a sequence listing in compliance with [37 CFR 1.821](#) through [1.825](#) (if applicable); and

(F) an executed oath or declaration under [37 CFR 1.63](#) and/or an application data sheet for application filed on or after September 16, 2012.

The Office may also delay publication until any petition under [37 CFR 1.47](#) is granted for applications filed prior to September 16, 2012.

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, and/or an application data sheet for applications filed on or after September 16, 2012) 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 promptly file a request for corrected filing receipt if the information on the filing receipt needs to be corrected. In addition, applicants should contact the Office of Data Management – Patent Publication Branch (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 or correct any priority or benefit claims if the filing receipt does not include the desired claims or includes incorrect claims. If the information is incorrect, Applicants should promptly file a request for corrected filing receipt to assist the Office in quickly processing the change prior to export of the application to the publisher. 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 § 211.04](#) and [214.02](#). Furthermore, if the corrections are not recognized by the Office of Data Management – Patent Publication Branch before the technical preparation for publication has begun, the Office

cannot change the projected publication date and include the corrections in the publication.

### 1121 Content of a Patent Application Publication [R-07.2015]

#### *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 specification and drawings deposited on the filing date of the application, as well as the application data sheet and/or the inventor's oath or declaration. The patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under [§ 1.125\(b\)](#), amendments to the abstract under [§ 1.121\(b\)](#), amendments to the claims that are reflected in a complete claim listing under [§ 1.121\(c\)](#), and amendments to the drawings under [§ 1.121\(d\)](#), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. 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. See paragraph (c) of this section for publication of an application based upon a copy of the application submitted via the Office electronic filing system.

(b) The patent application publication will include the name of the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter if that information is provided in the application data sheet in an application filed under [§ 1.46](#). Assignee information may be included on the patent application publication in other applications if the assignee information is provided in an application data sheet submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Providing assignee information in 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 the application data sheet and/or the inventor's oath or declaration) as amended, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the mailing date of the first Office communication that includes 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.

(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.

***Pre-AIA 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 specification and drawings deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application. The patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under [37 CFR 1.125\(b\)](#), amendments to the abstract under [37 CFR 1.121\(b\)](#), amendments to the claims that are reflected in a complete claim listing under [§ 1.121\(c\)](#), and amendments to the drawings under [37 CFR 1.121\(d\)](#), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. 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. See paragraph (c) of this section for publication of an application based upon a copy of the application submitted via the Office electronic filing system.

(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, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the mailing date of the first Office communication that includes 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.

(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 and/or application data sheet for applications filed on or after September 16, 2012; and

(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

## I. AMENDMENTS

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). While the Office will attempt to use the amendments submitted by applicants, applicants are not entitled to have the amendments used in the publication. For example, the patent application publication may also be based upon the following amendments because they are in formats useable for publication:

(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 the patent application publication be based upon a copy of the application (specification, drawings and oath or declaration) as amended, applicant must supply such a copy via the electronic filing system (EFS), e.g., set forth in the EFS-Web Legal Framework 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 electronic 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).

#### A. Avoid Filing Preliminary Amendments

Applicants should not file any preliminary amendment with the application. Submitting applications without any accompanying preliminary amendment reduces the processing required of the Office, and will help to ensure that patent application publications are printed correctly.

A preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application under [37 CFR 1.115\(a\)\(1\)](#). The Office will include such a preliminary amendment that is present on the filing date of the application in the patent application publication. If the preliminary amendment that is present on the filing date of the application is not in a format that is useable for publication, the Office will issue a notice requiring the applicant to submit the amendment in a format useable for publication. Generally, a substitute specification (excluding claims) is required for any preliminary amendments to the specification (other than the claims) that are present on the filing date of the application. Even though a substitute specification is a useable format for publication, applicant should not file a substitute specification with the application because the application size fee will be calculated based on the application papers including the clean version and marked-up version of the substitute specification.



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\(d\)\(1\)\(iii\)](#). The specific reference to the prior application required by [35 U.S.C. 119\(e\)](#) or [120](#) and [37 CFR 1.78\(a\)](#) in applications filed before September 16, 2012 can be submitted in an application data sheet (ADS) rather than in a preliminary amendment to the first sentence(s) of the specification. Such references in applications filed on or after September 16, 2012 may only be made in an ADS. If the specific reference is submitted in a preliminary amendment, however, a substitute specification will not be required if the preliminary amendment only adds or amends a benefit claim.

#### **B. *Requests for Republication to Correct Errors***

Applications with poor quality text, which may be acceptable for scanning and examination purposes, may lead to errors in the patent application publication. 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 [37 CFR 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 a copy of the application (specification, drawings and oath or declaration) as amended, provided that applicant supplies such a copy in compliance with the Office electronic filing system (EFS) requirements, e.g. set forth in the EFS-Web Legal Framework within one month of the mailing date of the first Office communication that includes 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. [37 CFR 1.215\(c\)](#). If the copy of the application submitted under [37 CFR 1.215\(c\)](#) does not comply with the Office EFS requirements, the Office will publish the application as provided in [37 CFR 1.215\(a\)](#). If the copy of the application submitted under [37 CFR 1.215\(c\)](#) was untimely, the Office may use the untimely filed copy of the application supplied by the applicant under [37 CFR 1.215\(c\)](#) in creating the patent application publication so long as the copy was received before the Office has started the publication process. For further information about EFS, see the Electronic Business Center on the USPTO website ([www.uspto.gov](http://www.uspto.gov)).

## **IV. APPLICANT INFORMATION**

If a patent application is filed pursuant to [37 CFR 1.46](#), the patent application publication will include the name of the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter. The information must be provided on the application data sheet (ADS) filed with the application. If the applicant information is corrected or updated in accordance with [37 CFR 1.46\(c\)](#) after filing the application, the corrected or updated information may be used, if the information is recognized by the Office of Data Management – Patent Publication Branch before the technical preparation for the publication has begun.

Errors in applicant information printed on the publication are not considered material mistakes by the Office under [37 CFR 1.211\(b\)](#) (e.g., errors in the assignee's name). See [MPEP § 1130](#). Thus, these errors may only be corrected if applicant files a request for republication under [37 CFR 1.211\(a\)](#).

## V. ASSIGNEE INFORMATION

For applications filed on or after September 16, 2012, if the applicant would like the assignee data to be published, the assignee data must be submitted on the application data sheet (ADS). For applications filed before September 16, 2012, if the applicant would like the assignee data to be published, the information must be provided on the application transmittal letter or the application data sheet (ADS) filed with the application. Providing this information on the application transmittal letter or the application data sheet does not substitute for compliance with any requirement of 37 CFR Part 3 to have an assignment recorded by the Office. 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\(a\)](#).

### 1122 Requests for Nonpublication [R-07.2015]

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

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(b) PUBLICATION.—

\*\*\*\*\*

(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 11.18\(b\)](#) 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

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 nonpublication is not conspicuous, and thus the Office's assignment of a publication date would be appropriate.

A nonpublication request must be filed upon the filing of the application. This is a statutory requirement and cannot be waived. For example, a nonpublication request filed with a request under [37 CFR 1.53\(c\)\(3\)](#) to convert a provisional application to a nonprovisional application will not be accepted as timely filed because the nonprovisional application would be accorded the original filing date of the provisional application if the request to convert is granted. The nonpublication request must also be included with the application papers. The nonpublication request cannot be filed separately on the same date as the filing date of the application (e.g., the nonpublication request is filed in a different Priority Mail Express<sup>®</sup> package than the package that contains the application). If the Office mistakenly accepts an improper nonpublication request, applicants should notify the Office of Data Management – Patent Publication Branch and rescind the request immediately. See [MPEP § 1730](#) for contact information.

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\(a\)\(f\)](#) 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\(a\)\(f\)](#) 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 11.18\(b\)](#). In addition, false statements by registered patent practitioners may also violate other Disciplinary Rules (see 37 CFR Part 11).

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.

### 1123 Rescission of a Nonpublication Request [R-07.2015]

#### 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.

(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 [37 CFR 1.111\(a\)](#) 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\(b\)\(2\)\(B\)\(i\)](#) 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\(b\)](#).

## 1124 Notice of Foreign Filing [R-07.2015]

### 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.

(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](#)).

### I. NOTICE OF FOREIGN FILING REQUIRED WITHIN 45 DAYS

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\(b\)\(2\)\(B\)\(iv\)](#).

## II. ABANDONMENT FOR FAILURE TO PROVIDE TIMELY NOTICE

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

(a) *Revival on the basis of unintentional delay.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this section to revive an abandoned application or a reexamination prosecution terminated under § 1.550(d) or § 1.957(b) or limited under § 1.957(c).

(b) *Petition requirements.* A grantable petition pursuant to this section must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § [1.17\(m\)](#);
- (3) Any terminal disclaimer (and fee as set forth in § [1.20\(d\)](#)) required pursuant to paragraph (d) of this section; and
- (4) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) *Reply.* In an application abandoned under § 1.57(a), the reply must include a copy of the specification and any drawings of the previously filed application. In an application or patent abandoned 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. 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, abandoned after the close of prosecution as defined in § 1.114(b), the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114.

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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 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](#) to revive the abandoned application on the basis of unintentional 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](#) 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](#). 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.

## 1125 Express Abandonment to Avoid Publication [R-11.2013]

### *37 CFR 1.138 Express abandonment*

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(c) An applicant seeking to abandon an application to avoid publication of the application ([37 CFR 1.211\(a\)\(1\)](#)) must submit a declaration of express abandonment by way of a petition under this paragraph 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. Applicants 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.

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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 (Office of Data Management – Patent Publication Branch) to recognize the abandonment and remove the application from the publication process. Applicants may use form PTO/AIA/24A for applications filed on or after September 16, 2012 or form PTO/SB/24A for applications filed before September 16, 2012 for filing a petition for express abandonment to avoid publication under [37 CFR 1.138\(c\)](#). (see [MPEP § 1135](#)) and file the petition electronically using EFS-Web, or mail the petition to **Mail Stop Express Abandonment**, or transmit the petition via facsimile to the Office at (571) 273 8300 (see [MPEP § 1730](#)). Filing the petition via EFS-Web will 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 recognized as abandoned at least four weeks prior to the projected publication date, the Office will 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.

## 1126 Publication Fees [R-11.2013]

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

(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 (or scheduled

to be 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. Effective January 1, 2014, the publication fee set forth in [37 CFR 1.18\(d\)](#) is \$0.00.

Accordingly, applicant may file a request for a refund of the publication fee after 4 weeks from the issue date of the patent if the application did not publish. 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 Office of Data Management – Patent Publication Branch 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\(h\)](#).

### **1127 Notice of Publication [R-08.2012]**

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 website ([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 timely adds or deletes a benefit or priority claim and the Office recognizes the correction and changes the projected publication date before the technical preparations of the application have begun, the Office will mail a notice (e.g., a corrected filing receipt), informing applicant of the newly assigned projected publication date.

### **1128 Availability of Published Applications [R-07.2015]**

#### *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 and paragraph (j) for international design applications) may be available in the following situations:

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(ii) *Published abandoned applications.* The file of an abandoned published application is available to the public as set forth in § 1.11(a). A copy of the application-as-filed, the file contents of the published application, or a specific document in the file of the published application may be provided to any person upon request, and payment of the appropriate fee set forth in § 1.19(b).

(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 published application 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 (i) of this section.

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(b) Electronic access to an application. Where a copy of the application file or access to the application may be made available pursuant to this section, the Office may at its discretion provide access to only an electronic copy of the specification, drawings, and file contents of the application.

## I. ELECTRONIC ACCESS

Patent application publications are available electronically on the USPTO website ([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. See [37 CFR 1.14\(b\)](#). Note that if a published patent application is pending and it is not maintained in the IFW system, the paper application file itself will not be available to the public for inspection. Only copies of the application file may be obtained pursuant to [37 CFR 1.14\(a\)\(1\)\(iii\)](#). See [MPEP § 103](#) for additional information pertaining to access to patent application files.

## 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 website ([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. STATUS INFORMATION

Any member of the public may obtain status information concerning any published application via the Office's PAIR system or contact the File Information Unit (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, an international publication of an international application under [PCT Article 21\(2\)](#), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. 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](#).

### 1129 Request for Early Publication [R-11.2013]

#### *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 compliance 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.

## 1130 Republication and Correction of Patent Application Publications [R-07.2015]

### *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.

#### I. REQUEST FOR REPUBLICATION

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, e.g., set forth in the EFS-Web Legal Framework (for more information on EFS see [MPEP § 1730](#) and the USPTO website, [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.

#### II. REQUEST FOR CORRECTED PUBLICATION - 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 originally filed.

(D) For applications filed on or after September 16, 2012, the publication did not include the benefit claim to a prior-filed nonprovisional application where the specific reference was timely submitted in an application data sheet (ADS). For applications filed before September 16, 2012, the publication did not include the benefit claim to a prior-filed nonprovisional application where the specific

reference was timely submitted in the first sentences of the specification or 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. 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) (for applications filed on or after September 16, 2012) or the reference to the prior application under [37 CFR 1.78](#) was not properly submitted in the first sentences of the specification or in an application data sheet (ADS) (for applications filed before September 16, 2012). See [MPEP §§ 211 et seq.](#)

(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).

## 1131 [Reserved]

## 1132 Requests for Redacted Publication [R-08.2012]

### 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, e.g., set forth in the EFS-Web Legal Framework 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 multilateral international agreement, that corresponds to the application filed in the Office.

Items (B) – (E) above must be submitted in paper (which includes submitting via EFS-Web) 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 redactions, 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](#).

### 1133 Voluntary Publication [R-08.2012]

#### *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, e.g., set forth in the EFS-Web Legal Framework;

(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.

### 1134 Third Party Inquiries and Correspondence in a Published Application [R-11.2013]

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

\*\*\*\*\*

(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.

(e) PREISSUANCE SUBMISSIONS BY THIRD PARTIES.—

(1) IN GENERAL.—Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of—

(A) the date a notice of allowance under [section 151](#) is given or mailed in the application for patent; or

(B) the later of—

(i) 6 months after the date on which the application for patent is first published under [section 122](#) by the Office, or

(ii) the date of the first rejection under [section 132](#) of any claim by the examiner during the examination of the application for patent.

(2) OTHER REQUIREMENTS.—Any submission under paragraph (1) shall—

(A) set forth a concise description of the asserted relevance of each submitted document;

(B) be accompanied by such fee as the Director may prescribe; and

(C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.

\*\*\*\*\*



[35 U.S.C. 122](#) includes two provisions regarding submissions by third parties in patent applications. Pursuant to [35 U.S.C. 122\(c\)](#), no protest or other form or pre-issuance opposition may be initiated after publication of an application without the express written consent of the applicant. [35 U.S.C. 122\(c\)](#) is implemented by [37 CFR 1.291](#). For information on protests see [MPEP § 1901](#). [35 U.S.C. 122\(e\)](#), on the other hand, provides a mechanism for third parties to submit printed publications in another party's patent application. Under [35 U.S.C. 122\(e\)](#), any third party may submit printed publications of potential relevance to the examination of an application for consideration and inclusion in the record of the application. Such submissions must be timely made in writing and include a concise description of the asserted relevance of each publication submitted, any fee prescribed by the Director, and a statement of compliance with [35 U.S.C. 122\(e\)](#). [35 U.S.C. 122\(e\)](#) is implemented by [37 CFR 1.290](#), which replaces [37 CFR 1.99](#). See *Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act*, 77 Fed. Reg. 42150 (July 17, 2012) (final rule). Third-party submissions under [37 CFR 1.99](#) were eliminated as of September 16, 2012.

In contrast to protests under [37 CFR 1.291](#), third-party submissions under [37 CFR 1.290](#) may be made in published patent applications where the timing provisions set forth in [37 CFR 1.290\(b\)](#) are satisfied. Additionally, third-party submissions have different content requirements than protests. While [37 CFR 1.290](#) limits third-party submissions to printed publications, [37 CFR 1.291](#) provides for the submission of information in a protest other than publications, including any facts or information adverse to patentability, and arguments to that effect. See [MPEP §§ 1901](#), [1901.02](#) and [1901.06](#) subsection VII. Moreover, [37 CFR 1.291\(c\)\(2\)](#) requires a protest to include a "concise explanation of the relevance" of each item of information submitted. This is distinct from the concise description of relevance required by [37 CFR 1.290\(d\)\(3\)](#) for third-party submissions. Unlike the concise description of relevance for a third-party submission under [37 CFR 1.290](#), which is limited to a description of a document's relevance, the concise explanation for a protest under [37 CFR 1.291](#) allows for arguments against patentability.

Despite the provisions of [35 U.S.C. 122\(c\)](#) and [\(e\)](#), the Office occasionally receives third-party inquiries or submissions (other than under [37 CFR 1.290](#) and [37 CFR 1.291](#)) regarding patent applications. For example, third parties have inquired into the timing of future actions on an application, inventorship in 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 in an application that is not provided for in [37 CFR 1.290](#) or [37 CFR 1.291](#). Any submission filed by a third party in an application that does not comply with the requirements of [37 CFR 1.290](#) or [37 CFR 1.291](#) will not be entered into the application file and will be discarded.

Office personnel (including the Patent Examining Corps) are instructed to: (1) not reply to or act upon any third-party inquiry or other submission in an application, except those in compliance with [37 CFR 1.290](#) or [37 CFR 1.291](#); and (2) decline to accept oral or telephone comments or submissions about 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 1.290](#) or [37 CFR 1.291](#), by registered practitioners in applications to the Office of Enrollment and Discipline for appropriate action.

The provisions of [35 U.S.C. 122\(c\)](#) and [\(e\)](#) 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).

### 1134.01 Third Party Submissions Under 37 CFR 1.290 [R-07.2015]

#### 37 CFR 1.290 Submissions by third parties in applications.

(a) A third party may submit, for consideration and entry in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application if the submission is made in accordance with [35 U.S.C. 122\(e\)](#) and this section. A third-party submission may not be entered or considered by the Office if any part of the submission is not in compliance with [35 U.S.C. 122\(e\)](#) and this section.

(b) Any third-party submission under this section must be filed prior to the earlier of:

(1) The date a notice of allowance under [§ 1.311](#) is given or mailed in the application; or

(2) The later of:

(i) Six months after the date on which the application is first published by the Office under [35 U.S.C. 122\(b\)](#) and [§ 1.211](#), or

(ii) The date the first rejection under [§ 1.104](#) of any claim by the examiner is given or mailed during the examination of the application.

(c) Any third-party submission under this section must be made in writing.

(d) Any third-party submission under this section must include:

(1) A document list identifying the documents, or portions of documents, being submitted in accordance with paragraph (e) of this section;

(2) A concise description of the asserted relevance of each item identified in the document list;

(3) A legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications;

(4) An English language translation of any non-English language item identified in the document list; and

(5) A statement by the party making the submission that:

(i) The party is not an individual who has a duty to disclose information with respect to the application under [§ 1.56](#); and

(ii) The submission complies with the requirements of [35 U.S.C. 122\(e\)](#) and this section.

(e) The document list required by paragraph (d)(1) of this section must include a heading that identifies the list as a third-party submission under [§ 1.290](#), identify on each page of the list the application number of the application in which the submission is being filed, list U.S. patents and U.S. patent application publications in a separate section from other items, and identify each:

(1) U.S. patent by patent number, first named inventor, and issue date;

(2) U.S. patent application publication by patent application publication number, first named inventor, and publication date;

(3) Foreign patent or published foreign patent application by the country or patent office that issued the patent or published the application; the applicant, patentee, or first named inventor; an appropriate document number; and the publication date indicated on the patent or published application; and

(4) Non-patent publication by author (if any), title, pages being submitted, publication date, and, where available, publisher and place of publication. If no publication date is known, the third party must provide evidence of publication.

(f) Any third-party submission under this section must be accompanied by the fee set forth in [§ 1.17\(o\)](#) for every ten items or fraction thereof identified in the document list.

(g) The fee otherwise required by paragraph (f) of this section is not required for a submission listing three or fewer total items that is accompanied by a statement by the party making the submission that, to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only submission under [35 U.S.C. 122\(e\)](#) filed in the application by the party or a party in privity with the party.

(h) In the absence of a request by the Office, an applicant need not reply to a submission under this section.

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

Section 8 of the America Invents Act (AIA) amends [35 U.S.C. 122](#) by adding [35 U.S.C. 122\(e\)](#), which provides a mechanism for third parties to submit printed publications in another party's patent application. [35 U.S.C. 122\(e\)](#) is implemented by [37 CFR 1.290](#), which replaces [37 CFR 1.99](#). See *Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act*, 77 Fed. Reg. 42150 (July 17, 2012) (final rule). Third-party submissions under [37 CFR 1.99](#) were eliminated as of September 16, 2012.

## I. TIMELINESS REQUIREMENT

[37 CFR 1.290\(b\)](#) sets forth the time periods in which a third party may file a third-party submission. While there is no limit on the number of submissions that one third party may make in an application, a third-party submission must be filed prior to the earlier of:

- (1) The date a notice of allowance under [37 CFR 1.311](#) is given or mailed in the application; or
- (2) The later of:
  - (i) Six months after the date on which the application is first published by the Office under [35 U.S.C. 122\(b\)](#) and [37 CFR 1.211](#), or
  - (ii) The date the first rejection under [37 CFR 1.104](#) of any claim by the examiner is given or mailed during the examination of the application.

Thus, a third-party submission cannot be filed in an application where a notice of allowance has been issued in the application, regardless of whether that notice of allowance is subsequently withdrawn. If a notice of allowance has not been issued in an application, a third-party submission may be filed prior to the date that is six months after the date of publication by the Office or prior to the date of the first rejection of any claim by the examiner, whichever is later.

The [37 CFR 1.290\(b\)\(2\)\(i\)](#) time period will be initiated only by publications “by the Office” under [35 U.S.C. 122](#) and [37 CFR 1.211](#), and will not be initiated by a publication by the World Intellectual Property Organization (WIPO). Thus, an earlier publication by WIPO of an international application designating the United States will not be considered a publication that will initiate the [37 CFR 1.290\(b\)\(2\)\(i\)](#) time period for an application which entered the national stage from the international application after compliance with [35 U.S.C. 371](#). Additionally, the first publication of the application by the Office will trigger the [37 CFR 1.290\(b\)\(2\)\(i\)](#) time period where appropriate. The republication of an application under [37 CFR 1.221\(b\)](#) is not the “first” publication by the Office under [35 U.S.C. 122\(b\)](#) for purposes of [35 U.S.C. 122\(e\)](#). Where the Office does not publish an application, the date that is six months after the publication date would not occur and, therefore, by default would be

considered later than both the date of a first rejection of any claim and the date the notice of allowance is given or mailed in the application. Accordingly, the date that a notice of allowance is given or mailed in the application would control the timing of a third-party submission in an application which has not been published, not the date of the first rejection of any claim.

The [37 CFR 1.290\(b\)\(2\)\(ii\)](#) time period will be initiated by the date the first rejection under [37 CFR 1.104](#) of any claim by the examiner is given or mailed during the examination of the application. “Given” refers to the electronic notification of an Office action that replaces postal mailing of an Office action for applicants participating in the Electronic Office Action Notification (e-Office Action) program. The [37 CFR 1.290\(b\)\(2\)\(ii\)](#) time period will not be initiated, for example, by a first Office action that only contains a restriction requirement or where the first Office action is an action under *Ex parte Quayle*, 1935 Dec. Comm’r Pat. 11 (1935).

The filing of an RCE does not reset the [37 CFR \(b\)\(2\)\(ii\)](#) time period for filing a third-party submission. Additionally, the filing of an RCE in an application does not preclude a third party from making a third-party submission in the application, if the third-party submission is made within the time periods set forth in [37 CFR 1.290\(b\)\(2\)](#).

All third-party submissions must be filed prior to, not on, the dates identified in [37 CFR 1.290\(b\)\(1\)](#) and [\(b\)\(2\)](#). For example, assuming no notice of allowance has been issued in an application, if a third-party submission is filed on the same date the first rejection is mailed and the application has been published for more than six months, the submission would not be timely and would not be entered. In another example, assuming no notice of allowance has been issued in an application, if a third-party submission is filed on the date that is six months after the date the Office published the application and a first rejection has already been mailed, the submission would not be timely and would not be entered (i.e., if the Office published the application on May 21, a third-party submission filed on November 21, which is the date that is six months after the date the Office published the application,

would not be timely as, according to the rule, the submission would need to have been made on November 20 or earlier).

#### A. *Time Periods Are Statutory and Cannot Be Waived*

The time periods provided for in [37 CFR 1.290\(b\)](#) are statutory and cannot be waived. See [35 U.S.C. 122\(e\)\(1\)](#). Thus, the Office cannot grant any request for extension of the [37 CFR 1.290\(b\)](#) time periods. Third-party submissions that are not timely filed will not be entered or considered and will be discarded.

The statutory time period for making a third-party submission will not be tolled by a non-compliant submission. Accordingly, making a third-party submission at the earliest opportunity increases the likelihood there will be sufficient time to make a resubmission should the initial submission be found non-compliant. A third party who previously filed a non-compliant submission may file another complete submission, provided the statutory time period for filing a third-party submission has not closed.

The abandonment of an application will not toll the statutory time period for making a third-party submission. For example, if prior to publication an application goes abandoned because the applicant fails to timely respond to a first rejection of any claim, and the application is later revived, a third-party submission would be timely if made prior to the earlier of: the date a notice of allowance is given or mailed or the date that is six months after the date the application is published by the Office.

#### B. *A Third-Party Submission Is Filed On Its Date of Receipt in the Office*

A third-party submission under [37 CFR 1.290](#) is filed on its date of receipt in the Office as set forth in [37 CFR 1.6](#). The holiday/weekend rule set forth in [37 CFR 1.7\(a\)](#) applies to a third-party submission under [37 CFR 1.290](#). For example, if the day prior to the date that is six months after publication of an application which has not been allowed but which application was subject to a first Office action including a rejection of at least one claim more than six months previously is a Saturday, the submission may be timely filed on the next business day, e.g.,

the following Monday via Priority Mail Express<sup>®</sup> service pursuant to [37 CFR 1.10](#), hand delivery or preferably via the Office's dedicated Web-based interface for preissuance submissions. *See also* Subsection IV.D. below (providing that the certificate of mailing and transmission provisions of [37 CFR 1.8](#) do not apply, but the United States Postal Service (USPS) Priority Mail Express<sup>®</sup> service provisions of [37 CFR 1.10](#) do apply to a third-party submission under [37 CFR 1.290](#)).

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

[37 CFR 1.290\(d\)](#) identifies the required content of a third-party submission as follows:

(A) a document list, identifying the publications, or portions of publications, submitted (form PTO/SB/429 or an equivalent document list for paper submissions only; a completed form PTO/SB/429 is automatically generated for electronic submissions);

(B) a concise description of the asserted relevance of each item identified in the document list;

(C) a legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications;

(D) an English language translation of any non-English language item identified in the document list;

(E) statements by the party making the submission that:

a) the party is not an individual who has a duty to disclose information with respect to the application under [37 CFR 1.56](#); and

b) the submission complies with the requirements of [35 U.S.C. 122\(e\)](#) and [37 CFR 1.290](#); and

(F) any required fee or the [37 CFR 1.290\(g\)](#) statement that the fee exemption applies to the submission.

### A. *Document List*

[37 CFR 1.290\(d\)\(1\)](#) provides that any third-party submission under [37 CFR 1.290](#) must include a document list identifying the documents, or portions of documents, being submitted in accordance with [37 CFR 1.290\(e\)](#). [37 CFR 1.290\(e\)](#) sets forth the requirements for identifying the items in the [37 CFR 1.290\(d\)\(1\)](#) document list. Because [37 CFR 1.290\(d\)\(1\)](#) provides for an item identified in the document list to be either an entire document or a portion of a document, in the case where a lengthy document contains both information of potential relevance to the examination of the application and other information that is not of potential relevance, a third party may choose to identify only the relevant portion of the document (e.g., one chapter of a textbook) in lieu of the entire document where it is practical to do so. Otherwise, the third party should identify the entire document.

#### 1. **Form PTO/SB/429**

When filing in paper, third parties may use form PTO/SB/429 (or equivalent) to prepare the document

list in accordance with [37 CFR 1.290\(d\)\(1\)](#) and [37 CFR 1.290\(e\)](#). Electronic filing via the Office's dedicated Web-based interface for preissuance submissions in EFS-Web is an alternative to paper filing using form PTO/SB/429 (or equivalent). Use of this form will not be necessary for third-party submissions filed electronically via the Office's dedicated Web-based interface for preissuance submissions, as this interface will prompt the third party to complete the fields that are provided on the form and will automatically format the entered information into an electronic version of the form PTO/SB/429 for electronic submission. While use of form PTO/SB/429 is not required for paper submissions, form PTO/SB/429 is designed to help ensure that important requirements are not overlooked, such as the document listing requirements pursuant to [37 CFR 1.290\(e\)](#) and the required statements pursuant to [37 CFR 1.290\(d\)\(5\)](#). The form PTO/SB/429 also enables the third party to indicate whether a fee is due or to select the "first and only" statement pursuant to [37 CFR 1.290\(g\)](#) where the fee exemption applies. Form PTO/SB/429 and instructions for completion are available on the USPTO website at [www.uspto.gov/forms](http://www.uspto.gov/forms).



Doc Code: IDS.3P  
 Document Description: Information Disclosure Statement Filed

PTO/SB/429 (06-15)  
 Approved for use through 07/31/2018. OMB 0651-0062  
 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><b>THIRD-PARTY SUBMISSION<br/>                 UNDER 37 CFR 1.290</b></p> <p>(Page 2 of 2)</p> | Application Number (required): |
|---|--------------------------------|

| NON-PATENT PUBLICATIONS (e.g., journal article, Office action) |   |                          |                                  |
|--|---|--------------------------|----------------------------------|
| Cite No.   | Author (if any), title of the publication, page(s) being submitted, publication date, publisher (where available), and place of publication (where available) | Translation Attached     | Evidence of Publication Attached |
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| STATEMENTS   |                         |                 |  |
|--|-------------------------|-----------------|--|
| The party making the submission is not an individual who has a duty to disclose information with respect to the above-identified application under 37 CFR 1.56.<br>This submission complies with the requirements of 35 U.S.C. 122(e) and 37 CFR 1.290.  |                         |                 |  |
| <input type="checkbox"/> The following fee set forth in 37 CFR 1.290(f) is submitted herewith: <input type="checkbox"/> regular undiscounted <input type="checkbox"/> small entity*  |                         |                 |  |
| <input type="checkbox"/> The fee set forth in 37 CFR 1.290(f) is not required because this submission lists three or fewer total items and, to the knowledge of the person signing the statement after making reasonable inquiry, this submission is the first and only submission under 35 U.S.C. 122(e) filed in the above-identified application by the party making the submission or by a party in privity with the party.  |                         |                 |  |
| <input type="checkbox"/> This resubmission is being made responsive to a notification of non-compliance issued for an earlier filed third-party submission. The corrections in this resubmission are limited to addressing the non-compliance. As such, the party making this resubmission: (1) requests that the Office apply the previously-paid fee set forth in 37 CFR 1.290(f), or (2) states that no fee is required to accompany this resubmission as the undersigned is again making the fee exemption statement set forth in 37 CFR 1.290(g). |                         |                 |  |
| Signature  |                         | Date            |  |
| Name (Printed/Typed)   | Reg. No., if applicable |                 |  |
| Examiner Signature**   |                         | Date Considered |  |

\*SUBMITTER: By selecting the "small entity" box and paying the applicable small entity fee, the party making the submission asserts that the party qualifies as a small entity. A third party is not eligible for the micro entity discount.

\*\*EXAMINER: Signature indicates all items listed have been considered, except for citations through which a line is drawn. Draw line through citation if not considered. Include a copy of this form with next communication to applicant.

### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



## 2. Listing Requirements

[37 CFR 1.290\(e\)](#) sets forth the requirements for identifying the items in the document list pursuant to [37 CFR 1.290\(d\)\(1\)](#). [Section 1.290\(e\)](#) requires the document list include a heading that identifies the list as a third-party submission under [37 CFR 1.290](#). [37 CFR 1.290\(e\)](#) also requires that the document list identify on each page of the list, the application number (i.e., the series code and serial number) of the application in which the submission is being filed. This requirement is consistent with the requirement set forth in [37 CFR 1.98\(a\)\(1\)\(i\)](#) for applicant information disclosure statement listings. [37 CFR 1.290\(e\)](#) further requires that U.S. patents and U.S. patent application publications be listed in a separate section from other items in the document list. Separating the listing of U.S. patents and U.S. patent application publications from the listing of other items in the document list will facilitate printing the U.S. patents and U.S. patent application publications considered by the examiner in a third-party submission on the face of the patent. The dedicated Web-based interface for electronically filing preissuance submissions will automatically generate a document list in accordance with these requirements of [37 CFR 1.290\(e\)](#).

[Sections 1.290\(e\)\(1\)](#) through [\(e\)\(4\)](#) set forth the requirements for identifying the items in the [37 CFR 1.290\(d\)\(1\)](#) document list.

### (a) U.S. Patents and U.S. Patent Application Publications

[37 CFR 1.290\(e\)\(1\)](#) requires that each U.S. patent be identified by patent number, first named inventor, and issue date. [37 CFR 1.290\(e\)\(2\)](#) requires that each U.S. patent application publication be identified by patent application publication number, first named inventor, and publication date.

### (b) Foreign Patents and Published Foreign Patent Applications

[37 CFR 1.290\(e\)\(3\)](#) requires that each foreign patent or published foreign patent application be identified by the country or patent office that issued the patent or published the application; the applicant, patentee, or first named inventor; an appropriate document

number; and the publication date indicated on the patent or published application. The requirement for U.S. patents and patent application publications to be identified by first named inventor, and for foreign patents and published patent applications to be identified by the applicant, patentee, or first named inventor, is intended to aid in identifying the items in the document list in the event the application number, publication number, or other appropriate document number data is in error, for example, inadvertently transposed. Further, [37 CFR 1.290\(e\)\(3\)](#) offers flexibility in permitting identification of foreign patents and published foreign patent applications by expanding the identification to also include the applicant or patentee, in addition to the first named inventor.

### (c) Non-Patent Publications

All non-patent publications, such as Office actions, journal articles, communications from foreign patent offices, court documents, etc. that qualify as publications should be listed under the “Non-Patent Publications” section of the form PTO/SB/429 (or equivalent) or entered in the “Non-Patent Publications” section of the Office’s dedicated Web-based interface for preissuance submissions when filing electronically.

[37 CFR 1.290\(e\)\(4\)](#) requires that each non-patent publication be identified by author (if any), title, pages being submitted, publication date, and where available, publisher and place of publication. However, [37 CFR 1.290\(e\)\(4\)](#) does not preclude a third party from providing additional information not specified in [37 CFR 1.290\(e\)\(4\)](#) (e.g., journal title and volume/issue information for a journal article). Because publisher and place of publication information may not be available in some instances, [37 CFR 1.290\(e\)\(4\)](#) emphasizes that such information need only be provided where it is available. For publications obtained from the Internet, the uniform resource locator (URL) of the Web page that is the source of the publication must be provided for the place of publication ( e.g., “www.uspto.gov”). Further, for an Internet publication obtained from a website that archives Web pages, both the URL of the archived Web page submitted for consideration and the URL of the website from which the archived copy of the Web

page was obtained should be provided on the document listing (e.g., “Hand Tools,” Web page <<http://www.farmshopstore.com/handtools.html>>, 1 page, August 18, 2009, retrieved from Internet Archive Wayback Machine <<http://web.archive.org/web/20090818144217/http://www.farmshopstore.com/handtools.html>> on December 20, 2012).

[37 CFR 1.290\(e\)\(4\)](#) further requires that, if no publication date is known, the third party must provide evidence of publication. This requirement recognizes that some documents may not indicate a date of publication. Where the actual publication date of a non-patent document is not known, a third party must, at a minimum, provide a date of retrieval (e.g., the date a Web page was retrieved) or a time frame (e.g., a year, a month and year, a certain period of time) when the document was available as a publication for purposes of identifying the document by publication date pursuant to [37 CFR 1.290\(e\)\(4\)](#), in addition to including evidence that establishes the document as a publication. See Subsection III.A. below for additional discussion regarding evidence of publication.

#### B. *Concise description of relevance*

[37 CFR 1.290\(d\)\(2\)](#) requires a concise description of the asserted relevance of each item identified in the document list in view of the statutory requirement of [35 U.S.C. 122\(e\)\(2\)\(A\)](#) that each third-party preissuance submission be accompanied by a “concise description of the asserted relevance of each submitted document.” A concise description of relevance for an item is a statement of facts regarding the submitted evidence (*i.e.*, the patent, published patent application, or other publication) and will not, itself, be treated as evidence. The concise description should set forth facts, explaining how an item listed is of potential relevance to the examination of the application in which the third-party submission has been filed.

##### 1. **Format**

The concise description of relevance for a listed publication can be presented in any format that would best explain to the examiner the relevance of the accompanying document, such as in a narrative

description or a claim chart. A concise description of relevance is most effective when it draws the examiner’s attention to the potential relevance of a submitted document to the examination of an application. A concise description that points out the relevant pages or lines of the respective document may be an effective way to draw the examiner’s attention to the potential relevance of the document, particularly where the document is lengthy and complex and the third party can identify a highly relevant section, such as a particular figure or paragraph.

A third party using the Office’s dedicated Web-based interface to electronically file a third-party submission may fill in the concise description of relevance field for an item or upload a separate paper with the concise description for the item in lieu of entering the concise description in the field. See Subsection IV.E. below for more information regarding electronic filing. When filing in paper, a third party should provide the concise description of relevance for an item as a separate paper (as opposed to combining the concise descriptions of relevance for all items into a single paper). Providing, for each concise description of relevance, a separate paper that prominently identifies the item in the document list to which the concise description pertains will help ensure that the screener and the examiner can readily identify it. See Subsection IV.F below for more information regarding paper filing.

##### 2. **Content**

At a minimum, a concise description of relevance must be more than a bare statement that the document is relevant because such a statement does not amount to a meaningful concise description. For example, the following statements, presented alone, would not be considered anything more than bare statements of relevance that do not rise to the level of meaningful concise descriptions: “Document 1 is relevant,” “See Document 1,” “Document 1 discloses/may disclose the invention,” and “Document 1 teaches the invention in Claim 1.” Additionally, a copy of the listed document that is merely annotated or highlighted will not be deemed a proper concise description of relevance. Further, concise descriptions of relevance that appear to be

mere form paragraphs/letters in opposition to a general class of invention or technology will not be deemed proper concise descriptions of relevance.

While there is no page limit on a concise description of relevance, third parties should refrain from submitting a verbose description of relevance, not only because the statute calls for a “concise” description, but also because a focused description is more effective in drawing the examiner’s attention to the relevant issues. For example, a description that includes an introductory paragraph describing the field of technology of a document and a claim chart that maps portions of the document to different claim elements would likely be considered “concise.” On the other hand, descriptions that merely repeat in narrative format the same information that is also depicted in a claim chart or that approach the length of the documents themselves will not likely be considered “concise.”

Third-party submissions that include unpublished materials as attachments to or inserted into the text of a concise description of relevance of a listed publication will be found to be non-compliant. For example, where a third party submits a publication for consideration, describes how a feature shown in an image from the publication is relevant, and inserts an image from a different source into the concise description to show details that are not visible or otherwise apparent in the published image, such submission would be deemed non-compliant unless the image from the different source was also published and separately listed for consideration.

### **3. Not an invitation to participate in the prosecution of the application**

The statutory requirement for a concise description of relevance should not be interpreted as permitting a third party to participate in the prosecution of an application, as [35 U.S.C. 122\(c\)](#) prohibits the initiation of a protest or other form of pre-issuance opposition for published applications without the consent of the applicant. Therefore, while a concise description of relevance may include claim charts (i.e., mapping various portions of a submitted document to different claim elements), the concise description of relevance is not an invitation to a third party to propose rejections of the claims or set forth

arguments relating to an Office action in the application or to an applicant’s reply to an Office action in the application. Unlike the concise explanation for a protest under [37 CFR 1.291](#), which allows for arguments against patentability, the concise description of relevance required by [35 U.S.C. 122\(e\)](#) is limited to a factual description of a document’s relevance. The concise description of relevance, therefore, does not permit third parties to submit arguments against patentability or set forth conclusions regarding whether one or more claims are patentable. In other words, the concise description of relevance must not rise to the level of a protest under [37 CFR 1.291](#).

Examples of compliant concise descriptions formatted as a narrative:

“Claim 1 recites a refrigeration system comprising elements A, B, and C. Publication X discloses the refrigeration system recited in claim 1, except that the refrigeration system disclosed in publication X uses element D instead of element C. See Figure 1 on page 2 of publication X. Publication Y discloses the specific element C recited in claim 1, but not in the context of refrigeration systems. See pages 1-3 of publication Y. Publication Z teaches that element C is frequently used in refrigeration systems. See lines 2-10 on page 6 of publication Z.”

“Claim 1 recites a chemical composition comprising chemicals A, B, C, and D. Patent publication X teaches a chemical composition comprising chemicals A, B, C, and E. See claim 4 of patent publication X. Publication Y teaches chemical D and discusses why chemical D is an art-recognized equivalent of chemical E. See page 4 of publication Y.”

Examples of non-compliant concise descriptions formatted as a narrative (the non-compliant portion is shown in bold):

“Claim 1 recites a refrigeration system comprising elements A, B, and C. Publication X discloses the refrigeration system recited in claim 1, except that the refrigeration system disclosed in publication X uses element D instead of element C. See Figure 1 on page 2 of publication X. Publication Y discloses the specific element C recited in claim 1, but not in

the context of refrigeration systems. See pages 1-3 of publication Y. Publication Z teaches that element C is frequently used in refrigeration systems. See lines 2-10 on page 6 of publication Z. **It would have been obvious to one of ordinary skill in the art to combine the teachings of publication X and publication Y to obtain the refrigeration system recited in claim 1.**”

chemicals A, B, C, and E. See claim 4 of patent publication X. Publication Y teaches chemical D and discusses why chemical D is an art-recognized equivalent of chemical E. See pages 3-4 of publication Y. **The composition of claim 1 is unpatentable in view of publication X and publication Y.”**

“Claim 1 recites a chemical composition comprising chemicals A, B, C, and D. Patent publication X teaches a chemical composition comprising

Examples of compliant concise descriptions formatted as a claim chart for a claim having only two elements:

| <b>Claim 1</b> | <b>Publication X</b>  |
|----------------|---|
| Preamble       | As discussed on page 1, publication X discloses a machine that performs the same function as the machine recited in claim 1. The machine set forth in publication X includes many of the same parts discussed in the specification of this application. |
| Element A      | For example, in the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication X.   |
| Element B      | The first embodiment also includes element B of claim 1. See lines 1-3 on page 6 of publication X.  |

| <b>Claim 1</b> | <b>Publication X</b>  | <b>Publication Y</b>  |
|----------------|---|---|
| Preamble       | Publication X discloses a machine that performs the same function as the machine recited in claim 1. The machine set forth in publication X includes many of the same parts discussed in the specification of this application. | Publication Y discloses a machine that performs the same function as the machine recited in claim 1.  |
| Element A      | For example, in the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication X.                             |   |
| Element B      |   | Publication Y teaches a machine having element B of claim 1. See lines 1-3 on page 6 of publication Y. Publication Y teaches the benefits of using element B in this type of a machine. |

Examples of non-compliant concise descriptions formatted as a claim chart for a claim having only two elements (the non-compliant portion is shown in bold):

| <b>Claim 1</b> | <b>Publication X</b>  |
|----------------|---|
| Preamble       | As discussed on page 1, publication X discloses a machine that performs the same function as the machine recited in claim 1. The machine set forth in publication X includes many of the same parts discussed in the specification of this application. |
| Element A      | For example, in the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication X.   |
| Element B      | The first embodiment also includes element B of claim 1. See lines 1-3 on page 6 of publication X. <b>Thus, publication X anticipates claim 1 because it teaches all of the elements of claim 1.</b>  |

| <b>Claim 1</b> | <b>Publication X</b>   | <b>Publication Y</b>   |
|----------------|--|--|
| Preamble       | Publication X discloses a machine that performs the same function as the machine recited in claim 1. The machine set forth in publication X includes many of the same parts discussed in the specification of this application.  | Publication Y discloses a machine that performs the same function as the machine recited in claim 1. |
| Element A      | For example, in the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication X.  |  |
| Element B      | Publication Y teaches a machine having element B of claim 1. See lines 1-3 on page 6 of publication Y. Publication Y teaches the benefits of using element B in this type of a machine. <b>Accordingly, claim 1 is unpatentable in view of the combination of publication X and publication Y.</b> |  |

A concise description of relevance for a submitted document is not considered evidence but, rather, a statement of facts regarding the submitted evidence. Accordingly, the Office will not consider a declaration as evidence, where such declaration is submitted as a concise description of relevance for

a document. Where a third party submits a declaration for the concise description of relevance, the concise description of relevance must not amount to an attempt at third-party participation in the examination of the application.

### C. *Copies*

[37 CFR 1.290\(d\)\(3\)](#) requires submission of a legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications. *See* [37 CFR 1.98\(a\)\(2\)\(ii\)](#) and [MPEP § 609.04\(a\)](#). Any copies of documents that are submitted in color will be scanned into black and white prior to entry of a compliant submission in the record of an application. There is no provision for the submission of copies of documents via compact disc or other electronic data storage medium. However, a third party may upload electronic copies of documents when using the Office's dedicated Web-based interface to electronically file a third-party submission. *See* Subsection IV.E. below.

[37 CFR 1.290\(d\)\(1\)](#) provides for the listing of either entire documents or portions of documents. Thus, where only a portion of a document is listed as an item in the document list, a copy of that portion and not a copy of the entire document (e.g., where a particular chapter of a book is listed and not the entire book) must be submitted. Further, when a copy of only a portion of a document is submitted, copies of pages of the document that provide identifying information (e.g., a copy of the cover, the title page, the copyright information page, etc.) should also be submitted. Under [37 CFR 1.290\(d\)\(3\)](#), copies of U.S. patents and U.S. patent application publications need not be submitted because such documents are readily accessible to examiners.

Whether filing a third-party submission under [37 CFR 1.290](#) in paper or electronically, it would be a best practice for third parties to include an identifying label for each item in the document list and place the identifying label on the accompanying concise description of relevance for the item, on the copy of the item (if submitted), and on the translation of the item (if submitted) so that screeners and examiners can more quickly identify the descriptions of relevance, copies, and translations that correspond to each item in the document list.

Images of non-patent literature (NPL) cited in a compliant third-party submission will not be available for either viewing or downloading through Public PAIR. However, when entering a compliant third-party submission into an application file, the

Office will separate the document list from the copies of the documents so that the identifying bibliographical information for the documents cited in the third-party submission will be visible in Public PAIR. The Office currently employs such a practice when entering IDS submissions under [37 CFR 1.98](#).

### D. *Translations*

[37 CFR 1.290\(d\)\(4\)](#) requires an English language translation of any non-English language item identified in the document list. A translation submitted pursuant to [37 CFR 1.290\(d\)\(4\)](#) may be a reliable machine translation and need not be certified. [37 CFR 1.290\(d\)\(1\)](#) provides for the listing of either entire documents or portions of documents. Thus, where only a portion of a non-English language document is listed, a translation of the entire non-English language document must not be submitted. Rather, a copy of the listed portion of the non-English language document and a translation of only this portion must be submitted.

### E. *Statements*

[37 CFR 1.290\(d\)\(5\)\(i\)](#) requires a statement by the party making the submission that the party is not an individual who has a duty to disclose information with respect to the application (i.e., each individual associated with the filing and prosecution of the patent application) under [37 CFR 1.56](#). Such statement is intended to avoid potential misuse of third-party submissions by applicants (e.g., by employing a third-party "straw man") to attempt to circumvent the IDS rules. [37 CFR 1.290\(d\)\(5\)\(ii\)](#) requires a statement by the party making the submission that the submission complies with the requirements of [35 U.S.C. 122\(e\)](#) and [37 CFR 1.290](#). Additionally, to take advantage of the fee exemption, a third-party submission must be accompanied by the statement under [37 CFR 1.290\(g\)](#). *See* Subsection IV.F. below for more information regarding the fee exemption.

To facilitate compliance by third parties, form PTO/SB/429 and the dedicated Web-based interface for preissuance submissions include the statements required by [37 CFR 1.290\(d\)\(5\)\(i\)](#) and [\(ii\)](#), as well as the statement under [37 CFR 1.290\(g\)](#) (which can be selected if applicable). The Office will not

entertain challenges to the accuracy of such statements because, pursuant to [37 CFR 11.18\(b\)](#), whoever knowingly and willfully makes any false, fictitious, or fraudulent statements or representations to the Office shall be subject to the penalties set forth under [18 U.S.C. 1001](#). [37 CFR 11.18\(b\)](#) applies to any paper presented to the Office, whether by a practitioner or non-practitioner.

The Office cannot permit a third-party submission to be presented unsigned by the submitter in view of the signature requirement set forth in [37 CFR 1.4](#) for papers filed in a patent application, which require a person's signature. Third-party submissions are required to be signed because [37 CFR 1.290\(d\)\(5\)](#) and [37 CFR 1.290\(g\)](#) (if applicable) require statements by the party making the submission. Thus, a third-party submission must be signed by the submitter, but there is no requirement to identify a real party in interest. A real party in interest can remain anonymous by having someone else make the third-party submission for them, but the submitter cannot remain anonymous.

#### F. *Fee (if necessary)*

[37 CFR 1.290\(f\)](#) requires payment of the fee set forth in [37 CFR 1.17\(o\)](#) for every ten items or fraction thereof listed in the document list, except where the submission is accompanied by the statement set forth in [37 CFR 1.290\(g\)](#). The Office will determine the item count based on the [37 CFR 1.290\(d\)\(1\)](#) document list. Thus, if a U.S. patent or a U.S. patent application publication is identified in the document list, but a copy of the item is not submitted (i.e., because a copy is not required), the listed U.S. patent or U.S. patent application publication will be counted toward the document count. If a copy of an item is submitted but the item is not identified in the document list, the item will not be counted or considered and will be discarded. Additionally, if a third party identifies an item in the [37 CFR 1.290\(d\)\(1\)](#) document list that is only a portion of a publication, the portion of the publication will be counted as one item. Further, while a third party is permitted to cite different publications that are all available from the same electronic source, such as a website, each such publication listed will be counted as a separate item. See *Changes To Implement the Preissuance Submissions by Third*

*Parties Provision of the Leahy-Smith America Invents Act*, 77 Fed. Reg. 42150, 42163 (July 17, 2012) (final rule) for guidance on what constitutes a separate document on a website.

When filing electronically, payment may be made by credit card, USPTO deposit account, or electronic funds transfer and the fee must accompany the submission at the time of filing. Credit card information for electronic credit card payments should be entered exclusively on the USPTO website providing electronic payment capability. When filing in paper, payment may be made by check, money order, credit card, or deposit account. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. Credit Card Payment Form (PTO-2038) is available for making payment by credit card for paper submission. See [www.uspto.gov/forms](http://www.uspto.gov/forms). To protect credit card information, form PTO-2038 must not be submitted electronically through EFS-Web.

#### 1. **Fee exemption**

[37 CFR 1.290\(g\)](#) provides an exemption from the [37 CFR 1.290\(f\)](#) fee requirement where a third-party submission listing three or fewer total items is the first third-party submission by a third party, or a party in privity with the third party, in a given application. Where one third party takes advantage of the fee exemption in an application, another third party is not precluded from also taking advantage of the fee exemption in the same application as long as the third parties are not in privity with each other.

Third parties are not required to avail themselves of the fee exemption. Thus, a third party can make a first submission of three or fewer documents in an application and choose to pay the fee instead of making the statement under [37 CFR 1.290\(g\)](#) (e.g., where a third party is uncertain whether it is appropriate to make the "privity" statement pursuant to [37 CFR 1.290\(g\)](#).)

To implement the fee exemption in [37 CFR 1.290\(g\)](#) and avoid potential misuse of such exemption, exemption-eligible third-party submissions must be accompanied by a statement of the third party (i.e., "the party making the submission") that, to the knowledge of the person signing the statement after

making reasonable inquiry, the submission is the first and only third-party submission in the application by the third party or a party in privity with the third party. To preclude a third party from making multiple third-party submissions in the same application on the same day and asserting that each such submission is the first third-party submission in the application by the third party, the [37 CFR 1.290\(g\)](#) statement requires that the submission be the “first and only” third-party submission. This statement will not, however, preclude the third party from making more than one third-party submission in an application, where the need for the subsequent submissions was not known at the time the third party filed the earlier submission that included the [37 CFR 1.290\(g\)](#) statement. The third party would not be required to state in any such subsequent submission that the need for the subsequent submission was not known at the time the third party filed the earlier submission that included the [37 CFR 1.290\(g\)](#) statement. Any such subsequent submission, however, would not be exempt from the [37 CFR 1.290\(f\)](#) fee requirement.

## 2. Fee is required for a resubmission after a finding of non-compliance

Where a third party receives a notification of non-compliance for a third-party submission, the third party may make necessary revisions to its submission, limited to addressing the non-compliance, and resubmit the now corrected submission provided the statutory time period for filing a third-party submission has not closed. The resubmission must be another complete submission, as the Office will not accept amendments to the non-compliant submission. See Subsection II. for content requirements for a third-party submission. To be complete, the appropriate fee for the number of documents being submitted (e.g., \$180 for 1-10 documents) must accompany any resubmission made in response to a notification of non-compliance. However, to satisfy the fee requirement for a resubmission after a finding of non-compliance where the proper fee set forth in [37 CFR 1.290\(f\)](#) accompanied the non-compliant submission, the third party may request that the Office apply the previously-paid fee to the resubmission. Similarly, to satisfy the fee requirement for a resubmission after a finding of non-compliance where the third

party’s non-compliant submission of three or fewer documents was accompanied by the fee exemption statement set forth in [37 CFR 1.290\(g\)](#), the third party may state that the fee exemption applies to the resubmission. The determination of whether the fee requirement for a resubmission is satisfied will be made at the sole discretion of the Office.

## 3. Small entity discount

A small entity discount is available for third-party submissions where applicable. To assert small entity status when filing in paper, a third party should select the “small entity” box on form PTO/SB/429 and pay the applicable small entity fee. By selecting the “small entity” box on form PTO/SB/429 (or equivalent) or the “small entity” link on the EFS-Web payment screen and paying the applicable small entity fee, the party making the submission asserts that the party qualifies as a small entity. A **micro entity discount is not available for third-party submissions** because a third party is not eligible for the micro entity discount.

## 4. Fee Examples

The following are examples of when a fee may or may not be required for a third-party submission.

If the regular undiscounted and small entity fees are \$180.00 and \$90.00, respectively, then for the first third-party submission in an application by a third party:

- (1) no fee would be required where the first submission contains three or fewer total items and is accompanied by the [37 CFR 1.290\(g\)](#) fee exemption statement;
- (2) a \$180/\$90 fee would be required where the first submission contains three or fewer total items and is not accompanied by the [37 CFR 1.290\(g\)](#) fee exemption statement;
- (3) a \$180/\$90 fee would be required where the first submission contains more than three, but ten or fewer total items; and
- (4) a \$360/\$180 fee would be required where the first submission contains more than ten, but twenty or fewer total items, and so on (e.g., where the first submission contains twelve documents and



the third party does not qualify for the small entity discount, a fee of \$180 would be required for the first ten documents and a fee of \$180 would be required for the remaining two documents, for a total fee of \$360).

For a second or subsequent third-party submission by the same third party:

(1) a \$180/\$90 fee would be required where the second or subsequent submission contains ten or fewer total items; and

(2) a \$360/\$180 fee would be required where the second or subsequent submission contains more than ten, but twenty or fewer total items, and so on.

### III. “PRINTED PUBLICATIONS”

[35 U.S.C. 122\(e\)\(1\)](#) and [37 CFR 1.290\(a\)](#) limit the type of information that may be submitted in a third-party submission to patents, published patent applications, and other printed publications of potential relevance to the examination of a patent application. See [MPEP § 2128](#) for guidance regarding printed publications. For example, a third-party submission may include U.S. patents and patent application publications, foreign patents and published foreign patent applications, as well as non-patent documents that qualify as publications, such as published articles, Office actions issued in published U.S. patent applications, and communications from foreign patent offices issued in published foreign patent applications. Documents that do not qualify as publications, such as materials that are subject to a court-imposed protective or secrecy order, trade secret information, unpublished internal documents of a corporation intended to be confidential, email correspondence not widely disseminated to the public, etc., must not be submitted for consideration under [37 CFR 1.290](#). Accordingly, third-party submissions cannot be submitted under [MPEP § 724.02](#).

Pursuant to [35 USC 122\(e\)\(1\)](#) and [37 CFR 1.290\(c\)](#), a third-party submission is required to be made in writing. Thus, published information, such as the visual output of a software program or a video, may be submitted only if reduced to writing, such as in the form of screen shots, and evidence of publication provided if the date of publication is not known. Additionally, physical samples must not be submitted

for consideration. Any physical samples submitted with a third-party submission will not be entered and will be discarded.

Submissions filed pursuant to [37 CFR 1.290](#) will be reviewed for compliance before being forwarded to an examiner for consideration. During this review, the Office will determine if the documents submitted for consideration appear on their faces to be publications. If any of the submitted documents are found not to be a publication, the entire submission will be found non-compliant. In such a situation, the submission will not be entered into the patent application file or considered by the examiner and will be discarded. If a submission is determined to be compliant, the publications will be considered by the examiner and entered into the file as required by [35 U.S.C. 122\(e\)](#). If the patent applicant, however, has evidence that a document filed by a third party is, in fact, not a publication, then the applicant can challenge the determination by the Office that the document is a publication, for example, in response to a rejection applying the document in question.

#### A. *Evidence of Publication*

In order for a submission to be compliant under [35 U.S.C. 122\(e\)](#) and [37 CFR 1.290](#), each item submitted for consideration and inclusion into the file of a patent application must be a publication. Thus, [37 CFR 1.290\(e\)\(4\)](#) requires that, if no publication date is known, the third party must provide evidence of publication. As a result, a third-party submission must either include items that are *prima facie* publications, or evidence that establishes that they are publications. In such situations, the third party may submit evidence in the form of affidavits, declarations, or any other appropriate format. Each item of evidence submitted will be evaluated with respect to both its authenticity and its persuasiveness. Evidence of publication must be specific to the document(s) submitted for consideration.

Any affidavits or declarations submitted as evidence of publication must comply with the Office’s formal requirements. See [MPEP § 715.04\(II\)](#) (providing that “[a]n affidavit is a statement in writing made under oath before a notary public, magistrate, or officer authorized to administer oaths” and that a

declaration “must include an acknowledgment by the declarant that willful false statements and the like are punishable by fine or imprisonment, or both ([18 U.S.C. 1001](#)) and must also “set forth in the body of the declaration that all statements made of the declarant’s own knowledge are true and that all statements made on information and belief are believed to be true.” [Note that a third party need not state “may jeopardize the validity of the application or any patent issuing therefrom.”)]. Affidavits and declarations submitted as evidence of publication should explain how the affiant/declarant has personal knowledge of the facts described therein. Further, affidavits and declarations submitted as evidence of publication must be limited to facts establishing why a submitted document qualifies as a publication and must not to be used as a mechanism to place information that is not pertinent to establishing the document as a publication before the examiner.

For example, a third party might submit a company’s undated marketing brochure for consideration with a declaration from an employee of the company stating that the employee attended a trade show on a particular date and distributed copies of the brochure being submitted for consideration to trade show attendees. In another example, if the third party had emailed the company’s undated marketing brochure to the members of a trade organization without restriction, a copy of the email might be submitted as evidence of publication. In a further example, a third party might submit as evidence of publication a printout from a website showing that the content of the website was publicly available at least as of the date retrieved shown on the printout, or screenshots from a website that establish the content of the website on a particular date. See Subsection II.A.2.c. for information on listing a document obtained from a website that archives Web pages.

Such evidence will not be counted toward the item count for fee purposes, unless the evidence is in the form of a patent document or other printed publication and the evidence, itself, is listed and submitted for consideration by the examiner. In some instances, the copy of the document provided pursuant to [37 CFR 1.290\(d\)\(3\)](#) may itself be the evidence, such as where a printout from the website

showing the date the document was retrieved is provided to satisfy the copy requirement. See Subsection II.A.2.c. for information on listing a document where the actual publication date of the submitted document is not known.

#### **B. *Need Not Be Prior Art***

There is no requirement in [37 CFR 1.290\(a\)](#) that the information submitted be prior art documents in order to be considered by the examiner. Further, [37 CFR 1.290\(a\)](#) does not require a third party to indicate whether a listed document is or is not asserted to be prior art. For those documents where the date of publication is not apparent from a review of the document, the third party may provide information regarding the publication date of the document in its accompanying concise description of relevance.

#### **C. *Cumulative Information/Information Already of Record***

[37 CFR 1.290\(a\)](#) does not prohibit third-party submissions that include patents, published patent applications, or other printed publications that are already of record in an application, where the submission is otherwise compliant. While it would be a best practice for third parties not to submit documents that are cumulative of each other or that are cumulative of information already under consideration by the Office, [37 CFR 1.290\(a\)](#) does not explicitly prohibit cumulative submissions because it has been the Office’s experience that identifying purely cumulative submissions is difficult where a submission includes both a publication and a description of the publication’s relevance.

A document submitted may appear on its face to be cumulative of information already of record, but its accompanying concise description of relevance may provide additional information with respect to the document, such that the submission of the document, together with the concise description of relevance of the document, is not cumulative of information already of record. For example, a submission would not be considered cumulative where it includes a document previously submitted by the applicant in an information disclosure statement and describes the document’s relevance to the examination of the

application. In another example, a submission that includes documents cited in the background section of an application would not be considered cumulative if accompanied by concise descriptions of relevance that provide additional information regarding the documents.

#### **D. Of “Potential Relevance to the Examination of the Application”**

The standard under [37 CFR 1.290\(a\)](#) for the documents submitted to be of “potential relevance to the examination of the application” is imposed by [35 U.S.C. 122\(e\)\(1\)](#). This standard requires the submitter to believe the documents being submitted are relevant to the extent that the submitter can provide the concise description of the asserted relevance of each document submitted as required by [35 U.S.C. 122\(e\)](#) and [37 CFR 1.290\(d\)\(2\)](#).

### **IV. FILING A THIRD-PARTY SUBMISSION**

#### **A. For Consideration and Inclusion in a “Patent Application”**

[35 U.S.C. 122\(e\)](#) provides that any third party may submit for consideration and inclusion in the record of a *patent application*, any patent, published patent application, or other printed publication of potential relevance to the examination of the application. A third-party submission may be directed to any non-provisional utility application, design application, or plant application filed before, on, or after September 16, 2012. Any continuations, divisionals, and continuations-in-part of such applications (as applicable) are also eligible to receive third-party submissions.

##### **1. Applies to Abandoned and Unpublished Applications**

[35 U.S.C. 122\(e\)](#) and [37 CFR 1.290](#) do not require that the application to which a third-party submission is directed be pending or published. A third-party submission made within the statutory time period, and otherwise compliant, will be entered even if the application to which the submission is directed has been abandoned. An examiner will not consider such third-party submission unless the application resumes

a pending status (*e.g.*, the application is revived, the notice of abandonment is withdrawn, etc.). Additionally, a third-party submission made within the statutory time period, and otherwise compliant, will be entered even if the application to which the submission is directed has not been published, for example, due to a nonpublication request filed under [35 U.S.C. 122\(b\)\(2\)\(B\)\(i\)](#) and [37 CFR 1.213](#).

##### **2. Cannot Be Filed In Provisional Applications or Post-Issuance Proceedings**

[35 U.S.C. 122\(e\)](#) provides for consideration and inclusion of third-party submissions in the record of a patent application, and limits such submissions to publications that are of potential relevance to the examination of the application. Thus, third-party submissions may not be directed to: (1) provisional applications, (2) issued patents, (3) reissue applications, and (4) reexamination proceedings. The Office will not accept third-party submissions in provisional applications as provisional applications are not examined by the Office. Additionally, the Office will not accept third-party submissions in issued patents. The provisions of [35 U.S.C. 301](#) and [37 CFR 1.501](#) provide an avenue for third parties who have a need to submit information in an issued patent.

Further, third-party submissions are not permitted in post-issuance proceedings, including reexamination proceedings and reissue applications. See [35 U.S.C. 302](#) and [35 U.S.C. 311](#) and [MPEP § 1441.01](#) (“a reissue application is a post-issuance proceeding”). The protest provisions of [37 CFR 1.291](#) provide an avenue for third parties who have a need to submit information in a reissue application. See [MPEP § 1441.01](#) (“the prohibition against the filing of a protest after publication of an application under [35 U.S.C. 122\(c\)](#) is not applicable to a reissue application”). Further, where a third-party submission is directed to a reissue application and would otherwise be compliant under [37 CFR 1.290](#), the Office will enter the submission into the record of a reissue application as a protest under [37 CFR 1.291](#).

## B. “Any Third Party”

[35 U.S.C. 122\(e\)\(1\)](#) provides for “[a]ny third party” to file a preissuance submission. Thus, a third-party submission may be filed by any member of the public, including, for example, private persons and corporate entities. However, the third party must not be the applicant or any individual who has a duty to disclose information with respect to the application under [37 CFR 1.56](#). See [37 CFR 1.290\(d\)\(5\)\(i\)](#).

A third party does not need to be a registered practitioner to file a third-party submission. However, a registered practitioner may file a third-party submission on behalf of an unnamed real party in interest. If a third party wishes to remain anonymous, an attorney or other representative may submit a third-party submission on the third party’s behalf, but the submitter will need to be identified. See Subsection II.E above.

## C. No Service on Applicant Required

Third parties are not required to serve the applicant with a copy of the third-party submission. By not requiring service of third-party submissions on the applicant, the Office is underscoring that such third-party submissions will not create a requirement on the part of the applicant to independently file the submitted documents with the Office in an information disclosure statement (IDS). Additionally, not requiring service of third-party submissions on the applicants will prevent challenges regarding whether service of a third-party submission was proper from negatively impacting the pendency of an application.

## D. Certificate of Mailing/Transmission Does Not Apply

[37 CFR 1.290\(i\)](#) provides that the provisions of [37 CFR 1.8](#) do not apply to the time periods set forth in [37 CFR 1.290](#). See also [37 CFR 1.8\(a\)\(2\)\(i\)\(A\)](#). Thus, third parties may not use a certificate of mailing or transmission in filing a third-party submission under [37 CFR 1.290](#). By not according a third-party submission filed by first class mail the benefit of its date of deposit with the USPS pursuant to a [37 CFR 1.8](#) certificate of mailing, the Office reduces the potential for papers crossing in the mail. That is, the requirement of [37 CFR 1.290\(i\)](#) reduces

the risk that a third-party submission, if it was permitted to rely on a certificate of mailing to be timely, would not be identified and entered until after an Office action is mailed. The requirement of [37 CFR 1.290\(i\)](#) also encourages third parties to file third-party submissions at their earliest opportunity.

The United States Postal Service (USPS) Priority Mail Express<sup>®</sup> service provisions of [37 CFR 1.10](#) do apply to a third-party submission under [37 CFR 1.290](#). See [MPEP § 513](#) for guidance on the Priority Mail Express<sup>®</sup> service provisions of [37 CFR 1.10](#).

## E. Electronic Filing

The Office has developed a dedicated Web-based interface to permit third-party submissions under [37 CFR 1.290](#) to be filed electronically. Third parties can access the Web-based interface by using the Office's electronic filing system (EFS-Web) available at [www.uspto.gov/learning-and-resources/portal-applications](http://www.uspto.gov/learning-and-resources/portal-applications). Registered and unregistered eFilers are able to select the “Third-Party Preissuance Submission under 37 CFR 1.290” option upon clicking the “Existing application/patent” radio button. See also the EFS-Web quick start guide for third party preissuance submissions (available at [www.uspto.gov/sites/default/files/QSG\\_Third\\_Party\\_Preissuance.pdf](http://www.uspto.gov/sites/default/files/QSG_Third_Party_Preissuance.pdf)) for detailed instructions on filing third-party submissions electronically. Filing via EFS-Web is an electronic alternative to paper filing using form PTO/SB/429 (or equivalent). Instead of uploading the form, EFS-Web will automatically generate and complete the form after a third party enters all of the necessary information.

Filing via the dedicated Web-based interface is the most efficient means of making compliant third-party submissions available to an examiner for consideration. Additionally, the Web-based interface will warn a third party if a submission appears to be untimely, as well as verify some of the content of a submission (e.g., U.S. patent data). Also, when filing a third-party submission electronically, a third party will receive immediate, electronic acknowledgment of the Office’s receipt of the submission. The electronic acknowledgment is not an indication that

the third-party submission is compliant or has been entered; rather, it merely shows Office receipt of the submission. Note that a third party cannot electronically file a third-party submission without a Confirmation Number for the application, which can be obtained by looking up the application number in the Public Patent Application Information Retrieval (PAIR) System located at <http://portal.uspto.gov/pair/PublicPair> and viewing the Bibliographic Data. If the Confirmation Number is not available or not known, the third-party submission cannot be filed electronically and instead must be filed in paper.

The EFS-Web Legal Framework prohibited third-party submissions under [former 37 CFR 1.99](#) from being filed electronically in patent applications because documents filed electronically via EFS-Web were instantly loaded into the Image File Wrapper (IFW). *See Legal Framework for Electronic Filing System—Web (EFS-Web)*, 74 FR 55200, 55202, 55206-7 (October 27, 2009). Third-party submissions under [37 CFR 1.290](#) that are filed electronically via the dedicated Web-based interface for preissuance submissions in EFS-Web, however, will not be instantly loaded into the IFW. Thus, third-party submissions under [37 CFR 1.290](#) are permitted to be filed electronically via the dedicated Web-based interface for preissuance submissions because such submissions will be screened for compliance with the requirements of [35 U.S.C. 122\(e\)](#) and [37 CFR 1.290](#) before being entered into the IFW of an application. Note that protests under [37 CFR 1.291](#) are still prohibited from being filed electronically in patent applications.

Electronically-filed third-party submissions not made via the dedicated Web-based interface for preissuance submissions are prohibited and will be discarded ( *i.e.*, a third party must select the “Third-Party Preissuance Submission under 37 CFR 1.290” option in EFS-Web when filing electronically and not the “Document/Fees for an existing application/proceeding” option, which is only available for the applicant or applicant’s representative). Further, applicants must not file follow-on papers in their applications via the dedicated option for third-party submissions.

#### F. *Paper Filing*

Additionally, third-party submissions may be filed in paper via first-class mail, United States Postal Service (USPS) Priority Mail Express<sup>®</sup> service pursuant to [37 CFR 1.10](#), or delivery by hand. Instructions for filing a third-party submission in paper using form PTO/SB/429 (or equivalent) are located at [www.uspto.gov/sites/default/files/documents/3prsubmission\\_instructions.pdf](http://www.uspto.gov/sites/default/files/documents/3prsubmission_instructions.pdf).

Pursuant to [37 CFR 1.6\(d\)\(3\)](#), third-party submissions may not be filed by facsimile. Facsimile transmissions, although not subject to the delay associated with first class mail, are often received in poor quality, which may result in illegible content and cause the submission to be found non-compliant. Because facsimile transmission of third-party submissions under [37 CFR 1.290](#) is not permitted, the use of a certificate of transmission pursuant to [37 CFR 1.8](#) is not applicable to third-party submissions.

When filing a third-party submission in paper, a third party may include a self-addressed postcard with the submission to receive an acknowledgment by return receipt postcard that a third-party submission has been received. The return receipt postcard is not an indication that the third-party submission is compliant or has been entered; rather, it merely shows Office receipt of the submission. Where a third-party submission is filed in an unpublished application, a returned postcard acknowledging receipt will not indicate whether such application in fact exists or the status of any such application because, pursuant to [35 U.S.C. 122](#), original applications are kept in confidence unless published under [35 U.S.C. 122\(b\)](#) or available to the public pursuant to [37 CFR 1.14\(a\)\(1\)\(iv\)](#), [\(v\)](#), or [\(vi\)](#). Thus, unless a third party has been granted access to an original application, the third party is not entitled to obtain from the Office any information concerning the same, including the mere fact that such an application exists.

Electronic filing via the dedicated Web-based interface is the most efficient means of making compliant third-party submissions available to an examiner for consideration, as compliant third-party submissions filed in paper will experience a delay

in entry due to the additional processing required for scanning and indexing of paper submissions into electronic form. Additionally, third parties filing third-party submissions electronically via the dedicated Web-based interface will receive immediate, electronic acknowledgment of the Office's receipt of the submission, instead of waiting for the Office to mail a return receipt postcard when provided with a paper submission.

## V. NO THIRD-PARTY PARTICIPATION

The involvement of a third party in filing a submission under [37 CFR 1.290](#) ends with the filing of the submission. The third party filing the submission will not receive any communications from the Office relating to the submission other than the electronic acknowledgement receipt ( *see* Subsection IV.E.), the return of the self-addressed postcard ( *see* Subsection IV.F.), or a notification to the third party regarding its third-party submission ( *see* Subsection VI.A.1.). A third party is not permitted to contact the examiner. Questions regarding a third-party submission may be directed to the AIA help telephone (1-855-HELPAIA) or AIA email (HelpAIA@uspto.gov), or to the point of contact listed on a notification to the third party regarding its third-party submission. Further, because the prosecution of a patent application is an *ex parte* proceeding, a third party is not permitted to respond to an examiner's treatment of the third-party submission in the application ( *see* Subsection VI.B.).

## VI. TREATMENT OF A THIRD-PARTY SUBMISSION

### A. Submissions Screened for Compliance Prior to Entry in an Application

Third-party submissions, whether submitted in paper or electronically via the dedicated Web-based interface, will not be automatically entered into the electronic image file wrapper (IFW) of an application, *i.e.*, will not be made of record in the application. Instead, third-party submissions submitted by third parties will be reviewed by the Office to determine compliance with [35 U.S.C. 122\(e\)](#) and [37 CFR 1.290](#) before being entered into

the IFW. The Office has established procedures to complete its compliance determination, for both paper and electronic submissions, promptly following receipt of the submission so that compliant third-party submissions will be quickly entered into the IFW and made available to the examiner for consideration. Third-party submissions filed in paper, however, will incur more processing delay than submissions filed electronically via the dedicated Web-based interface for preissuance submissions due to the scanning and indexing process. Each Technology Center (TC) has designated points of contact for screening third-party submissions made in applications docketed to the respective TCs.

[37 CFR 1.290\(a\)](#) provides that a third-party submission may not be entered or considered by the Office if any part of the submission is not in compliance with [35 U.S.C. 122\(e\)](#) and [37 CFR 1.290](#). The Office will enter a third-party submission that is compliant with both [35 U.S.C. 122\(e\)](#) and [37 CFR 1.290](#); however, any part of a third-party submission that is non-compliant with respect to the requirements of [35 U.S.C. 122\(e\)](#), whether or not the third-party submission is otherwise compliant with [37 CFR 1.290](#), will prevent entry of the entire third-party submission into the record. By contrast, a third-party submission that is compliant with [35 U.S.C. 122\(e\)](#), but non-compliant with some requirement of [37 CFR 1.290](#), may be entered into the record if the error is of such a minor character that, in the opinion of the Office, it does not raise an ambiguity as to the content of the submission. For example, if an error with respect to a requirement of [37 CFR 1.290](#) is of such a nature that the content of the third-party submission can still be readily ascertained (*e.g.*, a U.S. patent is identified by the correct patent number and issue date but the name of the first named inventor is clearly misspelled), the Office may have enough information to be able to enter the third-party submission into the record despite the error. However, the determination of whether to enter or not to enter a submission that partially complies with a requirement of [37 CFR 1.290](#) will be made on a case-by-case basis and at the sole discretion of the Office ( *e.g.*, the Office may decline to enter a third-party submission listing a U.S. patent whose patent number does not match Office records with respect to that patent number's issue date and/or first named inventor). In any event,

the Office will either enter or not enter the entire submission and will not attempt to enter portions of partially compliant submissions.

Non-compliant third-party submissions, except those submissions having a non-compliance of minor character noted above, will not be entered into the IFW of an application or considered, and will be discarded. Also, the Office will not refund the required fees in the event a third-party submission is determined to be non-compliant. The statutory time period for making a third-party submission will not be tolled by an initial non-compliant submission. The Office will not set a time period for a third party to file a corrected third-party submission. Additionally, the Office will not accept amendments to a non-compliant submission that was previously filed. Instead, a third party who previously filed a non-compliant submission may file another complete submission, provided the statutory time period for filing a submission has not closed. See also Subsection II.F.2. (fee is required for a resubmission after a finding of non-compliance).

### **1. Notification to Third Party Regarding Third-Party Submission**

A third-party may request a courtesy electronic mail message (email) notification in the event their third-party submission is found to be compliant or non-compliant. Such request may be made when filing electronically by selecting the appropriate check box and entering an email address to which the notification should be directed in the “Request for Notification Regarding Third-Party Preissuance Submission” section of the Office’s dedicated Web-based interface for preissuance submissions. Such request may be made when filing in paper by including a separate paper with the third-party submission clearly titled “REQUEST FOR NOTIFICATION REGARDING THIRD-PARTY PREISSUANCE SUBMISSION” and clearly indicating the email address to which the notification should be directed.

A notification of non-compliance will include the reason(s) for non-compliance ( *e.g.*, no concise description of relevance was provided for a listed document, the concise description of relevance for a listed document was improper, the submission was

not timely, *etc.*). The non-compliant third-party submission will not be made of record in the application.

No notification will be issued where a third party does not provide an email address with the submission. Further, no notification will be issued where the third-party submission is directed to an unpublished application. *See* Subsection IV.F. (unpublished patent applications preserved in confidence).

The notification to the third party will not be made of record in the application. Further, the Office does not intend to enter the email address provided for notification into the record of the patent application.

### **2. Notification to Applicant of Compliant Third-Party Submission**

An applicant will be notified upon entry of a compliant third-party submission in their application file where the applicant participates in the Office’s e-Office Action program, and the contents of a compliant third-party submission will be made available to the applicant after it has been entered in the IFW of the application. An applicant may view non-patent documents identified in a third-party submission document list via the Office’s private Patent Application Information Retrieval (PAIR) system. The applicant will not be notified of a non-compliant submission.

### **3. Applicant Need Not Reply To a Third-Party Submission**

[37 CFR 1.290\(h\)](#) provides that in the absence of a request by the Office, an applicant need not reply to a third-party submission under [37 CFR 1.290](#). Where the Office believes information from applicant is needed, the Office may issue a requirement for information pursuant to [37 CFR 1.105](#).

### **B. Examiner Consideration of Third-Party Submissions**

Once a third-party submission has been screened and found compliant, the submission will be entered into the IFW for examiner consideration. The examiner should consider the listed publications and accompanying concise descriptions in the third-party

submission in the same manner as information in an information disclosure statement (IDS), generally before issuing the next Office action. Entry of a third-party submission does not expedite the application.

During examination, the examiner should sign form PTO/SB/429 (or equivalent) in the same manner as an IDS to indicate all the items and their concise descriptions have been considered. The examiner's signature does not indicate the examiner agrees with the third party's position regarding the publication, but only that the examiner considered the submission. Further, the examiner should clear the submission's IDS flag in PALM and provide a signed copy of the PTO/SB/429 with the next Office action. There is no need for the examiner to comment on the submitted documents or the concise descriptions of relevance in the Office action. However, the examiner should apply the information as deemed necessary (*i.e.*, in a rejection of a claim). Also, the applicant need not respond to the third-party submission in the absence of a request by the Office to do so. See [37 CFR 1.290\(h\)](#). Where the examiner believes information from the applicant is needed, the examiner may issue a requirement for information pursuant to [37 CFR 1.105](#). In no circumstance may an examiner direct a requirement for information to the third party that submitted the paper under [37 CFR 1.290](#). Further, because the prosecution of a patent application is an *ex parte* proceeding, no response from a third party with respect to an examiner's treatment of the third-party submission will be permitted or considered.

Documents from a third-party submission that were considered by the examiner will be printed on the patent, similar to the way documents from an IDS that were considered by the examiner are printed on the patent. Documents cited by third-parties under [37 CFR 1.290](#) will be distinguished on an issued patent from documents cited by the applicant and by the examiner.

In the unlikely event an examiner believes a submission is non-compliant (*e.g.*, the examiner believes a submitted document is not a publication), the examiner should immediately consult the

screner or other appropriate TC point of contact. If as a result of such consultation it is determined that the examiner should not consider a listed document, the examiner should strike through the document to indicate that the examiner did not consider either the document or its accompanying concise description. In some instances, the stricken document may be cited by the examiner on a form PTO-892

### 1135 PGPub Forms [R-11.2013]

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

Form PTO/AIA/24A, "Petition for Express Abandonment to Avoid Publication Under [37 CFR 1.138\(c\)](#)," may be used by applicant in an application filed on or after September 16, 2012 for filing a petition for express abandonment to avoid publication under [37 CFR 1.138\(c\)](#). Form PTO/SB/24A, "Petition for Express Abandonment to Avoid Publication Under [37 CFR 1.138\(c\)](#)," may be used by applicant in an application filed before September 16, 2012 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](#).



Doc Code: PGEA

Document Description: Request for Exp Aband for refund or to avoid pub

PTO/AIA/24A (07-12)

Approved for use through 07/31/2014. OMB 0651-0059

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><b>PETITION FOR EXPRESS ABANDONMENT TO AVOID PUBLICATION UNDER 37 CFR 1.138(c)</b></p> <p>File the petition electronically using EFS-Web<br/>Or Mail the petition to:<br/><b>Mail Stop Express Abandonment</b><br/>Commissioner for Patents<br/>P.O. Box 1450, Alexandria, VA 22313-1450</p> | Application Number     |  |
|   | Filing Date            |  |
|   | First Named Inventor   |  |
|   | Art Unit               |  |
|   | Examiner Name          |  |
|   | Attorney Docket Number |  |

**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).

**TO REQUEST A REFUND OF SEARCH FEE AND EXCESS CLAIMS FEE (IF ELIGIBLE), PLEASE ALSO INCLUDE FORM PTO/SB/24B WITH THIS FORM.**

I am the:

- applicant.
- attorney or agent of record. Attorney or agent registration number is \_\_\_\_\_
- attorney or agent acting under 37 CFR 1.34, who is authorized under 37 CFR 1.138(b) because the application is expressly abandoned in favor of a continuing application. Attorney or agent registration number is \_\_\_\_\_.

|                       |                  |
|-----------------------|------------------|
| Signature             | Date             |
| Typed or printed name | Telephone Number |

Note: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. 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 1.11 and 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.*

### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Doc Code: PGEA

Document Description: Request for Exp Aband for refund or to avoid pub

PTO/SB/24A (07-09)

Approved for use through 07/31/2012. 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><b>PETITION FOR EXPRESS ABANDONMENT TO AVOID PUBLICATION UNDER 37 CFR 1.138(c)</b></p> <p>File the petition electronically using EFS-Web<br/>Or Mail the petition to:<br/><b>Mail Stop Express Abandonment</b><br/>Commissioner for Patents<br/>P.O. Box 1450, Alexandria, VA 22313-1450</p> | Application Number     |  |
|   | Filing Date            |  |
|   | First Named Inventor   |  |
|   | Art Unit               |  |
|   | Examiner Name          |  |
|   | Attorney Docket Number |  |

**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).

**TO REQUEST A REFUND OF SEARCH FEE AND EXCESS CLAIMS FEE (IF ELIGIBLE), PLEASE ALSO INCLUDE FORM PTO/SB/24B WITH THIS FORM.**

- 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. Attorney or agent registration number is \_\_\_\_\_
  - attorney or agent acting under 37 CFR 1.34, who is authorized under 37 CFR 1.138(b) because the application is expressly abandoned in favor of a continuing application.  
Attorney or agent registration number is \_\_\_\_\_

\_\_\_\_\_  
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 1.11 and 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.

### Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
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8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

PTO/SB/35 (07-09)

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

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|   |                        |  |
|---|------------------------|--|
| <b>NONPUBLICATION REQUEST<br/>UNDER<br/>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 international 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).

\_\_\_\_\_

Signature

\_\_\_\_\_

Date

\_\_\_\_\_

Typed or printed name

\_\_\_\_\_

Registration Number, if applicable

\_\_\_\_\_

Telephone Number

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 1.11 and 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.

### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
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3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

PTO/SB/36 (07-09)

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| <p><b>RESCISSION OF PREVIOUS NONPUBLICATION REQUEST</b><br/>                 (35 U.S.C. 122(b)(2)(B)(ii))<br/> <b>AND, IF APPLICABLE,</b><br/> <b>NOTICE OF FOREIGN FILING</b><br/>                 (35 U.S.C. 122(b)(2)(B)(iii))</p> <p>Send completed form to:<br/> <b>Mail Stop PG Pub</b><br/>                 Commissioner for Patents<br/>                 P.O. Box 1450<br/>                 Alexandria, VA 22313-1450<br/>                 FAX: (571) 273-8300</p> | Application Number   |  |
|  | Filing Date          |  |
|  | First Named Inventor |  |
|  | Title                |  |
|  | Atty Docket Number   |  |
|  | 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).*

|                                |   |
|--------------------------------|---|
| _____<br>Signature             | _____<br>Date                               |
| _____<br>Typed or printed name | _____<br>Registration Number, if applicable |
| _____<br>Telephone Number      |   |

**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.

**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 transmitted to the U.S. Patent and Trademark Office on the date shown below.

|                            |               |
|----------------------------|---------------|
| _____<br>Signature         |               |
| _____<br>Name (Print/Type) | _____<br>Date |

This collection of information is required by 37 CFR 1.213(b). 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 1.11 and 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: Mail Stop PG Pub, 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.*

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



Doc Code: PET.OP

Document Description: Petition for Review by the Office of Petitions

PTO/SB/64a (12-13)  
 Approved for use through 07/31/2016. 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><b>PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT<br/>                 ABANDONED FOR FAILURE TO NOTIFY THE OFFICE OF A<br/>                 FOREIGN OR INTERNATIONAL FILING (37 CFR 1.137(f))</b></p> <p>Page 1 of 2</p>   | <p>Docket Number (Optional)</p> |
| <p>First named inventor: _____</p> <p>Application No.: _____ Art Unit: _____</p> <p>Filed: _____ Examiner: _____</p> <p>Title: <span style="border: 1px solid black; display: inline-block; width: 500px; height: 20px; vertical-align: middle;"></span></p> <p>Attention: Office of Petitions<br/> <b>Mail Stop Petition</b><br/>                 Commissioner for Patents<br/>                 P.O. Box 1450<br/>                 Alexandria, VA 22313-1450<br/>                 FAX (571) 273-8300</p> <p>NOTE: If information or assistance is needed in completing this form, please contact the Office of Petitions at (571) 272-3282.</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><b>PURSUANT TO 37 CFR 1.137(f), APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION UNDER 37 CFR 1.137(b).</b></p> <p><b>1. Petition fee</b></p> <p><input checked="" type="checkbox"/> Small entity fee \$ _____ (37 CFR 1.17(m)). Applicant asserts small entity status. See 37 CFR 1.27.</p> <p><input type="checkbox"/> Undiscounted fee \$ _____ (37 CFR 1.17(m)).</p> <p><b>2. Notice of Foreign or International Filing (35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c))</b></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 the filing. The filing date of the subsequently filed foreign or international application is _____.</p> |                                 |

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 1.11, 1.14 and 41.6. This collection is estimated to take 1 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. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, 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.*

Doc Code: PET.OP

Document Description: Petition for Review by the Office of Petitions

PTO/SB/64a (12-13)  
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 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**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))**

Page 2 of 2

3. **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(a) 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(a) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

**WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

|                       |                                    |
|-----------------------|------------------------------------|
| Signature             | Date                               |
| Typed or Printed Name | Registration Number, if applicable |
| Address               | Telephone Number                   |
| Address               |                                    |

Enclosures:

Fee Payment

Additional sheet(s) 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 EFS-Web or facsimile on the date shown to the United States Patent and Trademark Office at (571) 273-8300.

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| Date  | Signature |
| Typed or printed name of person signing certificate |           |

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The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.