

requirement for even a statement of surrender (e.g., reexamination certificate, certificate of correction).

Section 1.179: Section 1.179 would be removed and reserved as no longer being necessary. The information provided by this rule, i.e., notification to the public in the patent file that a reissue application has been filed for a particular patent, is now available through other means, such as public PAIR on the Office's Internet home page. This source of information can be entered through the Office's Internet Web site at <http://pair.uspto.gov/cgi-bin/final/home.pl> wherein the user can enter the original patent number, click on "Search," and then click on "Continuity Data." Any post-issuance filings (e.g., reissues, reexamination proceedings) will be identified by scrolling to "Child Continuity Data." To identify an application under "Child Continuity Data" as a reissue, the user simply clicks on the desired application number and searches through the file contents screen for "Notice of Reissue Published in Official Gazette." The Patent Assistance Center (PAC) Helpdesk (telephone number: 800-786-9199) can also provide information to the public on reissue filings. Removal of the provision that the Office place a separate paper in the patent file stating that a reissue has been filed would therefore eliminate several processing steps within the Office and contribute to overall efficiency. Similarly, public PAIR will indicate termination of the reissue examination, and placing a second separate paper notice to that effect in the patent file would be unnecessary.

The Office, through recent rule changes, has removed other language directed solely to internal instructions or directions to itself, and which do not directly impact patent applicants or the public. See, e.g., *Changes to Implement the Patent Business Goals*, 65 FR 54603, 54644, 54676 (Sept. 8, 2000), 1238 *Off. Gaz. Pat. Office* 77 (Sept. 19, 2000) (revised § 1.176 to eliminate instructions providing for a two-month delay of examination following the notice of reissue filing in the *Official Gazette*). Additionally, Office personnel can internally through the PALM database access information regarding reissue filings and do not rely on the presence or absence of the notice in the patent file as determinative of reissue status.

Section 1.182: Section 1.182 is proposed to be amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.

Section 1.183: Section 1.183 is proposed to be amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.

Section 1.213: Section 1.213(a) is proposed to be amended to add a provision that the certification under § 1.213(a)(3) is not appropriate unless the person signing the request has made an actual inquiry consistent with the requirements of § 10.18(b) of this chapter with respect to the application to which the request and certification pertains to determine that: (1) The application has not been the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing; and (2) the applicant's intent at the time the nonpublication request is being filed is that the application will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing. The Office has received inquiries which make it apparent that a number of practitioners consider a certification under 35 U.S.C. 122(b)(2)(B)(i) and § 1.213(a) appropriate so long as the applicant has not filed, and 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 counterpart application subject to eighteen-month publication"). Thus, § 1.213(a) is proposed to be amended to more clearly place persons signing nonpublication requests under § 1.213(a) on notice as to what a certification under 35 U.S.C. 122(b)(2)(B)(i) and § 1.213(a) entails.

A nonpublication request must contain a certification that "the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing" (emphasis added). See 35 U.S.C. 122(b)(2)(B)(i). A certification under 35 U.S.C. 122(b)(2)(B)(i) and § 1.213(a) is not appropriate unless the applicant's intent at the time the nonpublication request is being filed is not to file a counterpart application that would be subject to eighteen-month publication for the particular application with which the nonpublication request is filed. That is, the applicant must have an affirmative intent not to file a counterpart application that would be subject to eighteen-month publication,

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. In addition, a certification on the basis of 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 would not meet the requirement that the person signing the request make an "actual inquiry" "with respect to the application to which the request and certification pertains." Obviously, 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 under § 1.213(a).

Section 1.213(b) (and § 1.213(c)) is proposed to be amended to incorporate into the rules of practice the Office's interpretation of the interplay between the provision in 35 U.S.C.

122(b)(2)(B)(ii) for rescission of a previously filed nonpublication request and the notice requirement of 35 U.S.C. 122(b)(2)(B)(iii). The Office published a notice advising practitioners that the requirement in 35 U.S.C.

122(b)(2)(B)(iii) (and § 1.213(c)) for a notice of the foreign filing is in addition to any rescission of the nonpublication request under 35 U.S.C. 122(b)(2)(B)(ii) (and § 1.213(b)). See *Reminder that Rescission of a Nonpublication Request is Not Itself a Notice of Foreign Filing*, 1270 *Off. Gaz. Pat. Office* 20 (May 6, 2003). The inquiries in response to that notice revealed that many practitioners were unaware of this information. These inquiries also revealed that many practitioners who filed a counterpart application subject to eighteen-month publication after filing a nonpublication request in a U.S. application rescinded the nonpublication request by filing a nonpublication request rescission form that did not also contain a foreign filing notice (in many situations because the foreign filing notice included on the Office pre-printed form was removed). In view of these inquiries, the Office published a notice further clarifying the Office's interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv). See *Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C.*

122(b)(2)(B)(ii)-(iv), 1272 *Off. Gaz. Pat. Office* 22 (July 1, 2003). Section 1.213(b) is specifically proposed to be amended to indicate that the mere filing of a