

request under § 1.213(b) to rescind a previously filed nonpublication request does not comply with the notice requirement of 35 U.S.C.

122(b)(2)(B)(iii) and § 1.213(c) (for applicants who submitted a nonpublication request under § 1.213(a), but before filing the request under § 1.213(b) to rescind the previously filed nonpublication request, also filed 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). *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* at 23. Section 1.213(b) is also proposed to be amended to indicate that the provisions of § 1.8 do not apply in determining whether such an application has been filed before filing a request under § 1.213(b) to rescind a previously filed nonpublication request. *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* at 23–24.

Section 1.213(b) is also proposed to be amended to provide that a request under § 1.213(b) to rescind a nonpublication request is not appropriate unless the person signing the request has made an inquiry consistent with the requirements of § 10.18(b) of this chapter and determined that a nonpublication request under § 1.213(a) was previously filed in the application in which the request to rescind a nonpublication request is directed. A number of practitioners have developed the practice of filing a request under § 1.213(b) to rescind a nonpublication request in all applications for which a counterpart application subject to eighteen-month publication is filed, regardless of whether a nonpublication request was filed in the application. Processing a request under § 1.213(b) to rescind a nonpublication request in an application in which a nonpublication request was not previously filed in the application is burdensome on the Office. This is because the filing of a nonpublication request in an application for which a nonpublication request is not entered in the Office's computer system generally results in a search of the application file to determine whether the Office failed to record a nonpublication request in the Office's computer system. The filing of a request under § 1.213(b) to rescind a

nonpublication request in an application in which a nonpublication request was not previously filed is unwarranted and results in an unnecessary delay and a needless increase in the cost of processing the application. Thus, the Office considers this course of conduct to be in violation of § 10.18(b). Therefore, the Office is proposing to amend § 1.213(b) to place persons signing a request under § 1.213(b) to rescind a nonpublication request on notice that such a request is not appropriate unless the person signing the request has made an inquiry consistent with the requirements of § 10.18(b) of this chapter and determined that a nonpublication request under § 1.213(a) was previously filed in the application in which the request to rescind a nonpublication request is directed. Practitioners who continue to engage in the practice of filing a request under § 1.213(b) to rescind a nonpublication request in applications for which a nonpublication request was never filed may be subject to sanctions, disciplinary action, or both (*see* §§ 10.18(c) and (d)).

Section 1.213(c) is (as discussed above with respect to § 1.213(b)) 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). Section 1.213(c) is specifically proposed to be amended to provide that an applicant who has submitted a nonpublication request under § 1.213(a), but before filing a request under § 1.213(b) to rescind the previously filed nonpublication request, 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, must notify the Office of such filing within forty-five days after the date of the filing in another country, or under a multilateral international agreement. Section 1.213(c) is also proposed to be amended to provide that the provisions of § 1.8 do not apply in determining whether such an application has been filed before filing a request under § 1.213(b) to rescind a previously filed nonpublication request. Section 1.213(c) is also proposed to be amended to provide that the mere filing of a request under § 1.213(b) to rescind a previously filed nonpublication request does not comply with the notice

requirement of 35 U.S.C.

122(b)(2)(B)(iii) and § 1.213(c). Section 1.213(c) is also proposed to be amended to recite "of the filing in another country, or under a multilateral international agreement," rather than "of the filing of such foreign or international application" to more accurately track the language of 35 U.S.C. 122(b)(2)(B)(iii).

Section 1.213(d) is proposed to be added to provide that if an applicant who has submitted a nonpublication request under § 1.213(a), subsequently files a request under § 1.213(b) to rescind a nonpublication request or files a notice of a filing in another country, or under a multilateral international agreement, under § 1.213(c), the application shall be published as soon as is practical 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. 35 U.S.C. 122(b)(2)(B)(iv) provides that if an applicant rescinds a request made under 35 U.S.C. 122(b)(2)(B)(i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in 35 U.S.C. 122(b)(2)(B)(i), the application shall be published in accordance with the provisions of 35 U.S.C. 122(b)(1) on or as soon as is practical after the date that is specified in 35 U.S.C. 122(b)(2)(B)(i). Notwithstanding this provision in 35 U.S.C. 122(b)(2)(B), the Office has also received inquiries as to whether an application will be published if a request under § 1.213(b) to rescind a nonpublication request or a notice of foreign or international filing under § 1.213(c) is filed.

*Section 1.215:* Section 1.215(a) is proposed to be amended to permit submission of paper replacement drawings with a processing fee pursuant to § 1.17(i) (to replace the requirement for a petition) within the same time frame as is being proposed in § 1.215(c). Additionally, § 1.215(c) is proposed to be amended to provide a time frame of one month from the mailing date of the first Office communication that includes a confirmation number for the application for the submission of an amended version of an application through EFS (as well as providing the same time frame for replacement drawings submitted pursuant to § 1.215(a)).

Section 1.215(a) is proposed to be amended to refer to the processing fee set forth in § 1.17(i), and to provide that paper replacement drawings received before the Office has begun to process the patent application publication will be included in any patent application