

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:

(i) 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

(ii) 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.

(b) *Rescission of a nonpublication request.* The applicant may rescind a previously filed nonpublication request at any time. The mere filing of a request under 35 U.S.C. 122(b)(2)(B)(ii) and this paragraph 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 paragraph (c) of this section. The provisions of § 1.8 do not apply in determining whether such an application has been filed before filing a request under this paragraph to rescind a previously filed nonpublication request. 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(2) State in a conspicuous manner that the request that the application is not to be published under 35 U.S.C. 122(b) is rescinded; and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). A request under paragraph (b) of this section 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 paragraph (a) of this section was previously filed in the application in which the request to rescind a nonpublication request is directed.

(c) *Notification of subsequent foreign filing.* An applicant who has submitted a nonpublication request under 35 U.S.C. 122(b)(2)(B)(i) and paragraph (a) of this section, but before filing a request under 35 U.S.C. 122(b)(2)(B)(ii) and paragraph (b) of this section 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. The provisions of § 1.8 do not apply in determining whether such an application has been filed before filing a request under paragraph (b) of this section to rescind a previously filed nonpublication request. The mere filing of a request under 35 U.S.C. 122(b)(2)(B)(ii) and paragraph (b) of this section 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 this paragraph. The failure to timely notify the Office of the filing in another country, or under a multilateral international agreement, shall result in abandonment of the application in which the nonpublication request was submitted (35 U.S.C. 122(b)(2)(B)(iii)).

(d) *Publication after rescission or notice of foreign filing.* If an applicant who has submitted a nonpublication request under 35 U.S.C. 122(b)(2)(B)(i) and paragraph (a) of this section, subsequently files a request under 35 U.S.C. 122(b)(2)(B)(ii) and paragraph (b) of this section to rescind the nonpublication request or files a notice of a filing in another country, or under a multilateral international agreement, under 35 U.S.C. 122(b)(2)(B)(iii) and paragraph (c) of this section, 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)).

42. Section 1.215 is amended by revising paragraphs (a) and (c) to read as follows:

**§ 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 application papers deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application, any application papers or drawings submitted in reply to a preexamination notice requiring a title and abstract in compliance with § 1.72, application papers in compliance with § 1.52, drawings in compliance with § 1.84, or a sequence listing in compliance with §§ 1.821 through 1.825, and any replacement drawings

received with the processing fee set forth in § 1.17(i) within the period set forth in paragraph (c) of this section, except as otherwise provided in this section. The patent application publication will not include any amendments, including preliminary amendments, unless applicant supplies a copy of the application containing the amendment pursuant to paragraph (c) of this section.

\* \* \* \* \*

(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 during examination, 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 within fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

\* \* \* \* \*

43. Section 1.291 is revised to read as follows:

**§ 1.291 Protests by the public against pending applications.**

(a) A protest may be filed by a member of the public against a pending application, and will be matched with the application file if it adequately identifies the patent application to the extent that the Office can timely match it. A protest which does not adequately identify a pending patent application will not be considered by the Office other than to return it to the protestor.

(b) Where the protest adequately identifies the patent application to the extent that the Office can timely match it with an application, the protest will be entered into the record of the application if it:

(1) Is submitted:

(i) Prior to the date the application was published under § 1.211, or the notice of allowance under § 1.311 was mailed, whichever occurs first; or

(ii) At any time if it is accompanied by the written consent of the applicant to the filing of the protest being submitted;

(2) Is served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and

(3) Includes a statement identifying the real party in interest on whose behalf the protest is being filed to the extent necessary for determination of whether a party who may file a subsequent protest is in privity with the