

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(2) EXCEPTIONS-- (A) An application shall not be published if that application is--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 of this title;
- (iii) a provisional application filed under section 111(b) of this title; or
- (iv) an application for a design patent filed under chapter 16 of this title.

(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international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).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, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(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.

(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.

(d) **NATIONAL SECURITY**-- No application for patent shall be published under subsection (b)(1) if the publication or disclosure of such invention would be detrimental to the national security. The Director shall establish appropriate procedures to ensure that such applications are promptly identified and the secrecy of such inventions is maintained in accordance with chapter 17 of this title.

37 CFR 1.138² provides that:

(a) An application may be expressly abandoned by filing a written declaration of abandonment identifying the application in the United States Patent and Trademark Office. Express abandonment of the application may not be recognized by the Office before the date of issue or publication unless it is actually received by appropriate officials in time to act.

(b) A written declaration of abandonment must be signed by a party authorized under § 1.33(b)(1), (b)(3), or (b)(4) to sign a paper in the application, except as otherwise provided in this paragraph. A registered attorney or agent, not of record, who acts in a representative capacity under the provisions of § 1.34(a) when filing a continuing application, may expressly abandon the prior application as of the filing date granted to the continuing application.

(c) An applicant seeking to abandon an application to avoid publication of the application (see § 1.211(a)(1)) must submit a declaration of express abandonment by way of a petition under this section 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. Applicant 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.

² See 37 CFR 1.138 (2001).

37 CFR 1.182³ provides that:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.211⁴ provides that:

(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(g)), 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 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

³ See 37 CFR 1.182 (2001).

⁴ See 37 CFR 1.211 (2001).

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.

DECISION

Petitioners assert that the letter of express abandonment filed October 5, 2001 should have prevented the publication of the above-identified application. Specifically, petitioners assert that the letter of express abandonment of October 5, 2001 expressly indicated that its purpose was to prevent the publication of the above-identified application. Petitioners argue that since this letter of express abandonment was filed more than five months prior to the publication of the above-identified application, the United States Patent and Trademark Office (Office) had adequate time to act upon the letter of express abandonment and thus prevent publication of the above-identified application. Petitioners request that the Office treat the above-identified application as expressly abandoned retroactively as of a date prior to the publication date of the above-identified application, and that the Office expunge the publication of the above-identified application from the Office's databases and other worldwide patent databases including, but not limited to, the European Patent Office's International Patent Documentation Center (INPADOC) patent database.

The American Inventors Protection Act of 1999 (AIPA) was enacted into law on November 29, 1999. See Pub. L. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999). The AIPA contained a number of changes to title 35, including provisions for the publication of pending applications for patent, with certain exceptions, promptly after the expiration of a period of eighteen-months from the earliest filing date for which a benefit is sought under title 35 ("eighteen-month publication"). The eighteen-month publication provisions of the AIPA became effective on November 29, 2000, and apply to all applications filed on or after November 29, 2000. See Pub. L. 106-113, 113 Stat. At 1501A-566 through 1501A-567. The Office implemented the eighteen-month publication provisions of the AIPA in a final rule published in September of 2000. See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. 57023 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office 63 (Oct. 10, 2000) (final rule).

The above-identified application was filed under 35 U.S.C. § 111(a) and 37 CFR 1.53(b) on May 21, 2001. The above-identified application claims priority to Japanese application 2000-150579 (filed May 22, 2000), Japanese application 2000-267037 (filed September 4, 2000), and Japanese application 2001-143198 (filed May 14, 2001). The Office mailed a filing receipt on October 16, 2001 notifying petitioners that the projected publication date of the

above-identified application was January 24, 2002.⁵ The above-identified application was published on February 7, 2002⁶ as Patent Application Publication US 20020016700A1.

One of the exceptions to the eighteen-month publication provisions of the AIPA is that an application shall not be published if the application is no longer pending. See 35 U.S.C. §122(b)(2)(A)(i). In implementing the eighteen-month publication provisions of the AIPA, the Office added 37 CFR 1.138(c) for the specific purpose of providing a petition for express abandonment to avoid publication for those applicants seeking to expressly abandon an application to avoid its publication under the eighteen-month publication provisions of the AIPA. See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. at 57034, 1239 Off. Gaz. Pat. Office at 73. The Office also indicated that:

Unless an applicant has received a notice of abandonment, 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. An applicant permitting an application to become abandoned (for failure to reply to an Office action) to avoid publication by passively waiting for the Office to recognize that the application has become abandoned must bear 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.

See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. at 57035, 1239 Off. Gaz. Pat. Office at 73.

37 CFR 1.138(c) provides, in part, that “[a]n applicant seeking to abandon an application to avoid publication of the application (see [37 CFR] 1.211(a)(1)) must submit a declaration of express abandonment by way of a petition under this section including the fee set forth in [37 CFR] 1.17(h) in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process.” The final rule also indicates that petitions under 37 CFR 1.138 should be addressed to Box PGPUB-ABN to increase the chances of such petition being received by the appropriate officials in sufficient time to avoid publication of an application. See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. at 57045, 1239 Off. Gaz. Pat. Office at 82 (response to comment 44).

Petitioners filed a letter of express abandonment on October 5, 2001. The letter of express abandonment on October 5, 2001 was acknowledged in a notice of abandonment mailed July

⁵ The projected publication date of the above-identified application was January 4, 2002, rather than November 22, 2001 (eighteen months after May 22, 2000) because the eighteen-month publication process went into effect on November 29, 2000 and the Office is in the initial stages of this publication process.

⁶ The Office does not mail a new filing receipt indicating a revised publication date unless the publication date is changed by more than two weeks. See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. at 57028, 1239 Off. Gaz. Pat. Office at 67.

19, 2002. Since the letter of express abandonment of October 5, 2001 did not request that the above-identified application be considered abandoned as of any specified date, the date of abandonment of the above-identified application is July 19, 2002. See Manual of Patent Examining Procedure § 711.01 (8th ed. 2001) (MPEP).

Contrary to petitioners' assertion that the purpose of avoiding publication was expressly indicated in the letter of express abandonment, the letter of express abandonment only states that "[a]pplicants hereby expressly abandon the above-identified application (but not the invention recited therein) in view of the fact that a Continuation-in-part application was filed on October 2, 2001."⁷ The letter of express abandonment filed on October 5, 2001 was not in compliance with 37 CFR 1.138(c) because: (1) the letter of express abandonment was not designated as a petition under 37 CFR 1.138(c) or otherwise indicate that it was submitted for the purpose of avoiding publication; and (2) the letter of express abandonment did not include the petition fee set forth in 37 CFR 1.17(h). In addition, petitioners did not address the letter of express abandonment to Box PGPUB-ABN. Therefore, the letter of express abandonment filed on October 5, 2001 is properly considered as a letter of express abandonment under 37 CFR 1.138(a), rather than a petition under 37 CFR 1.138(c) to expressly abandon an application to avoid publication.

37 CFR 1.138(a) provides that express abandonment of the application may not be recognized by the Office before the date of issue or publication unless it is actually received by appropriate officials in time to act. See 37 CFR 1.138(a). Furthermore, MPEP 711.01 provides that a letter of abandonment properly signed becomes effective when an appropriate official of the Office takes action thereon. Since petitioners did not follow the procedure set forth in 37 CFR 1.138(c), petitioners must accept the consequences of the letter of express abandonment under 37 CFR 1.138(a) not being recognized in sufficient time to avoid publication of the above-identified application.

Since the letter of express abandonment of October 5, 2001 was not recognized by the appropriate Office official by February 7, 2002 (the date the above-identified application was published), the above-identified application was still pending on the date it was published as Patent Application Publication US 20020016700A1. Therefore, the above-identified application was properly published under 35 U.S.C. § 122(b) on February 7, 2002 as Patent Application Publication US 20020016700A1. There is no basis or authority for expunging the publication of an application that has been properly published as required by 35 U.S.C. § 122(b) from the Office's database or any other patent databases.

CONCLUSION

For the above-stated reasons, the petition under 37 CFR 1.182 to retroactively accept the above-identified application as expressly abandoned as of a date prior to the publication date of

⁷ A continuation-in-part application was filed on October 2, 2001. This application was assigned application No. 09/968,547, and was published on April 11, 2002 as Patent Application Publication US 20020042703A1.

the above-identified application and to expunge the publication of the above-identified application is **denied**. Therefore, the Office will not expunge the publication of the above-identified application from the Office's or any other patent database.

This decision may be viewed as final agency action. See MPEP 1002.02(b).

The above-identified application is being forwarded to Files Repository.



Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy