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Nonpublication Requests For Patent Applications Part 1: Benefits

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This 3-part series of posts examines the benefits, disadvantages, and pitfalls concerning nonpublication requests for patent applications. Part 1 of this series focuses on the general procedure and benefits of not publishing a patent application.

Filing a patent application is critical for many companies to protect their intellectual property. By default, most patent applications are published around eighteen months from the earliest filing date for which a priority benefit is sought.¹ However, there are a number of exceptions under which a patent application will not be published, including: (i) if the patent application is no longer pending (e.g., expressly abandoned or issued as a patent), (ii) the patent application is national security classified, subject to a secrecy order, or under nation security review, (iii) the patent application is a provisional patent application, (iv) the patent application is a design patent application, or (v) the patent application was filed with a nonpublication request.² The nonpublication request is an important exception for companies to understand because this is an option that can be deliberately elected to delay the date of publication of a patent application up until publication of an issued patent.

General Procedure Concerning Nonpublication Requests

- **Timing of filing a nonpublication request:** The nonpublication request must be filed at the time of filing the patent application with the application papers. This is a statutory requirement that cannot be waived.³
- **How to file the nonpublication request:** At the time of filing the application, an applicant can either file a nonpublication request stating, in a conspicuous manner, that the application is not to be published using the format provided in USPTO form PTO/SB/35 or select the check-box for a request not to publish provided in USPTO form PTO/AIA/14 (Application Data Sheet).⁴ In either instance, to make the nonpublication request, a certification must be made to the USPTO 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.⁵
- **How to rescind the nonpublication request and/or provide notice of foreign filing:** If an applicant later decides to publish the application, the applicant may file a request to rescind the nonpublication request at any time.⁶ Applicant can file a request to rescind the nonpublication using the format provided in USPTO form PTO/SB/36.⁷ Additionally, if an applicant later decides to file a counterpart foreign or international application that would be subject to eighteen-month publication, the applicant must provide notice of the

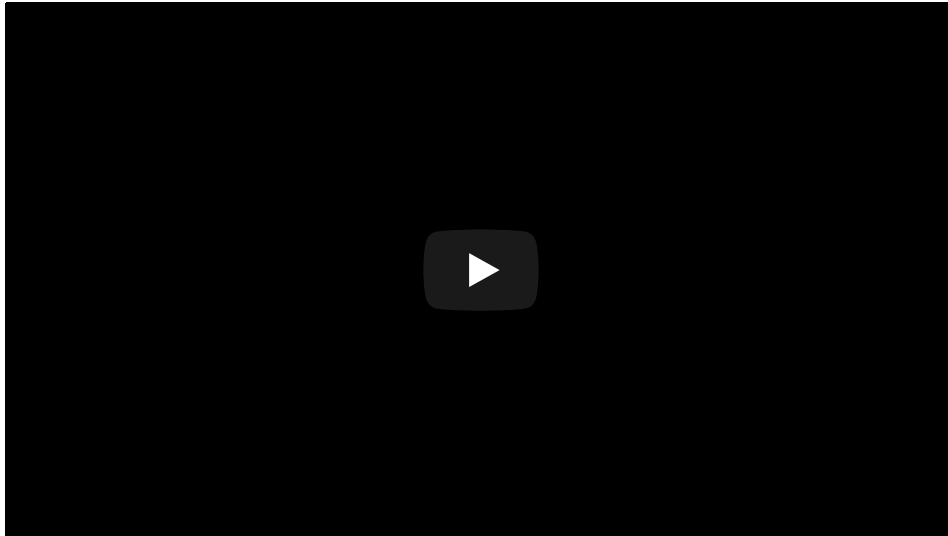
foreign filing to the USPTO no later than 45 days after the date of the filing of the foreign or international application.⁸ Applicant can provide notice of foreign filing using the format provided in USPTO form PTO/SB/36.⁹

Benefits of Not Publishing a Patent Application

There are a number of benefits available to companies that elect not to publish a patent application, including:

- **Secrecy and competitive advantage:** The existence of the invention and any documents filed along with the patent application stay confidential until a patent is issued. If a patent is not issued, the contents of the application are never published, and the subject matter remains confidential. Thus, competitors cannot view the contents of the application prior to issuance of the patent (if ever - in the instance a patent never grants) and applicants may maintain a competitive advantage by keeping areas of research and development or potential business goals confidential for an extended period of time. For example, the extra period of nondisclosure may be years and invaluable to applicants in a highly competitive market such as biotechnology, as the early years of research and development of a new product or service are critical, and the nondisclosure of the patent application in those years could give the applicant enough lead time to evaluate innovation viability, market trends, and/or scope of protection prior to disclosure.
- **Option to maintain content of an application as a trade secret:** Since nonpublished patent applications are not available to the public until an issued patent is published, requesting nonpublication allows a company to retain the option to abandon the application and to keep the technology a trade secret and out of the public domain. For example, in the technology space of bioinformatics, U.S. patent law concerning subject matter eligibility is fairly volatile or unsettled. Thus, by filing with a nonpublication request, the contents of the application can be maintained as a trade secret if the prosecution of the application does not proceed as planned.
- **Avoiding the creation of prior art:** Not publishing the patent application means that the publication itself will not become prior art. This can be helpful if an applicant intends to file a future patent application for technology that is similar to or builds upon the prior application.
- **Competitors cannot review the status of prosecution and the application will not be subject to third party submissions of prior art:** Because a nonpublication request prevents a competitor from being aware of a patent application, the competitor cannot provide prior art that might have an effect on anticipation or obviousness analysis of claims of the application through a Third Party Preissuance Submission. A Third Party Preissuance Submission (any patent, published patent application, or other printed publication of potential relevance to the examination of the application) may be submitted for consideration and inclusion in the record of a patent application, if the submission is made before (1) the later of (i) 6 months after the date of publication or (ii) the date of a first Office action on the merits rejecting any claims, or (2) before the date of a notice of allowance, if earlier.¹⁰ Thus, if the application is under a

nonpublication request, competitors will be kept from knowing about the patent application and have no idea when to submit a reference under Third Party Preissuance Submission.



Please contact the author with any questions and stay tuned for Part 2 of this series, in which the author will identify the disadvantages associated with nonpublication requests.

Footnotes

¹ 35 U.S.C. § 122(b)(1); 37 C.F.R. § 1.211(a) (2015).

² 35 U.S.C. § 122(b)(2); 37 C.F.R. § 1.211(a)-(e).

³ 37 C.F.R. § 1.213(a) (2000).

⁴ MPEP § 1122 (requests for nonpublication); 37 C.F.R. § 1.213(a)(1) and (2).

⁵ 35 U.S.C. § 122(b)(2)(B)(i); 37 C.F.R. § 1.213(a)(3).

⁶ 35 U.S.C. § 122(b)(2)(B)(ii); 37 C.F.R. § 1.213(b).

⁷ MPEP § 1123 (rescission of a nonpublication request).

⁸ 35 U.S.C. § 122(b)(2)(B)(iii).

⁹ MPEP § 1123.

¹⁰ 35 U.S.C. § 122(e).