

Topic Submission for Patent Quality Case Study

Subject: Consistency in the Grant of Non-Publication Requests under 35 U.S.C. §122

Proposed Case Study:

35 U.S.C. §122 provides that, upon filing an application, an applicant may certify 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”

The Office should study how “the subject of an application” is being understood by examiners. In particular, are examiners considering a difference in claims between a pending US application and those of a foreign counterpart sufficient to prevent publication?

More particularly, is it possible that a continuation or divisional of a parent with a foreign counterpart ever warrant non-publication in its entirety, or would some publication necessarily be required, albeit possibly redacted to remove subject matter not considered to be the subject of the counterpart foreign application?

Consistent application of an enunciated standard would be very valuable to practitioners.

Study Paradigm: The proposed study is readily implemented by performing a computer search for continuations of US applications that serve as priority documents for PCT applications, and, if the file indicates that the USPTO honored a certification for non-publication of any continuation, identifying on what grounds that was allowed to happen.

Thank you.

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