



IP: Third party pre-issuance submissions

A THIRD PARTY TRYING TO REDUCE THE CLAIM BREADTH IN A COMPETITOR'S PENDING PATENT APPLICATION MAY WIND UP DOING MORE HARM THAN GOOD

The Leahy-Smith America Invents Act (AIA), enacted on Sept. 16, 2011, with various effective dates, introduced several new proceedings applicable to *issued patents* (e.g., post-grant review, *inter partes* review, derivation proceedings and supplemental examination), modified some old proceedings (e.g., reissue patents and *ex parte* reexamination), and got rid entirely of other proceedings (e.g., *inter partes* reexamination and interferences).

With respect to opportunities during the *pendency* of applications, the AIA also modified rules concerning third party submissions such that third parties are now given more opportunity to submit documents during the pendency of a patent application. Changes to this latter procedure include an extended time period in which submissions will be accepted as well as the third party's ability

to comment on each document submitted. The main objective of this preissuance submissions program is to provide relevant information to patent examiners early in the examination process and, as a result, to improve the quality of granted patents. Notable requirements are:

- Any person may anonymously submit printed publications with comments explaining their relevance in any non-provisional patent application pending on or after Sept. 16, 2012, regardless of when the application was filed. Documents must be of potential relevance to the examination of the application and can pertain to novelty, obviousness, enablement and written description. Documents may include, for example, patents, published patent applications, printed

publications, as well as court documents that are not under a court-imposed protective or secrecy order. The submission may only provide printed publications, but they need not qualify as prior art.

- The submissions require a minimal filing fee and must be filed within a certain time period: before the earlier of (a) the date a notice of allowance; or (b) the later of six months after the date on which the application is first published or the date of the first rejection by the examiner during the examination of the application.
- The submission may include a concise description of the relevance of each publication, but cannot include proposed rejections or arguments relating to the applicant's

reply to an Office Action.

- Parties are encouraged to file preissuance submissions electronically through the U.S. Patent Office's (USPTO) dedicated web-based interface for third party submissions. Once submitted, the submissions will be reviewed for compliance with 35 U.S.C. 122(e) and 37 CFR 1.290 before being entered into the application record. A common reason for non-compliant preissuance submissions relates to an improper concise description of relevance. Third parties are therefore encouraged to point out specific pages or lines of the printed publications and provide a focused description of the cited text to draw the examiner's attention to the issues. However, submissions that are made with the third party's conclusions regarding patentability of claims (*e.g.*, "Claims 1-10 are anticipated by reference X") will be deemed non-compliant under the USPTO rules, and will not be entered into the application record nor considered by the examiner.

Third party mindset — "Should I file a preissuance submission?"

It should first be understood that

preissuance submissions are not an opportunity for third parties to *participate* in prosecution of a patent application or comment on rejections by the examiner and statements by the applicant. If the examiner raises a rejection having considered the preissuance submission, only the applicant, not the third party, can respond. Third parties should carefully consider whether documents should be filed in a preissuance submission or might be better filed later, such as in one of the new proceedings applicable to issued patents mentioned above, or in a civil proceeding that challenges a resulting patent.

Considerations for third parties include the following:

- Third parties may want to monitor patent application prosecution in foreign jurisdictions. Potentially relevant art-based rejections or arguments made in foreign applications may be relevant to the claims pending in the corresponding U.S. patent application.
- Keep in mind the restrictions on the explanations that can be provided.
- Preissuance submissions that are received and considered by a patent

examiner yet nonetheless fail to limit the claim scope or prevent the application from issuing is a reality third parties need to appreciate before filing a preissuance submission. An issued patent may be harder to invalidate in the situation where, for example, a publication provided in a preissuance submission is not relied upon by an examiner (*e.g.*, not cited in an Office Action). Likewise, an issued patent may be harder to invalidate in the situation where, for example, a publication provided in a preissuance submission is cited in a rejection, but the applicant either amended the claims or successfully argued around the rejection.

- Preissuance submissions may be submitted anonymously (*e.g.*, by using a straw man) so the real party in interest does not expose itself as a potential infringer or as an adverse party.

Applicant mindset — "Bring it on!"

The ability of third parties to submit publications during the pendency of an application should not concern an applicant. To the contrary, applicants often welcome third party submissions

in patent applications. Why? To the extent the examiner relies on the third party submission to support a claim rejection, applicants have the opportunity to address the documents on the record by arguments or by claim amendments. Dealing with references *during* prosecution is far more advantageous than after issuance of a patent.

Applicants should keep in mind the duty of candor implications of preissuance submissions across entire families of applications. Applicants may want to consider filing the references listed in the preissuance submission in an Information Disclosure Statement (IDS) in any related pending case in order to satisfy the duty to disclose information material to patentability if the submitted documents are relevant. If a preissuance submission was filed in an application that is later abandoned, or if an applicant becomes aware of a submission that was not entered in a case (*e.g.*, because the submission was deemed non-compliant), the applicant could likewise consider filing the submitted references in an IDS in any related pending case.

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