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August 15, 2012

USPTO Issues Final Rules: Preissuance Submissions by Third Parties

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On September 16, 2012, final rules issued by the U.S. Patent and Trademark Office (USPTO) (the rules) that implement provisions of the Leahy-Smith America Invents Act related to preissuance submissions by third parties become effective. The rules modify existing practice by allowing third parties to submit documents with a concise description of relevance of each document submitted with the same or greater time than previously allowed. The rules, once effective, apply to any application filed before, on, or after September 16, 2012.

A preissuance submission must be filed timely and contain a list identifying the items being submitted, a concise description of each item listed, a legible copy of each non-U.S. patent document listed, an English language translation of any non-English language item listed, a statement by the party making the submission that the submission complies with the statute and the rule, and the required fee.

In order to be filed timely, a preissuance submission must be filed prior to the earlier of one of two time periods. The first is the date a notice of allowance is mailed. The second is the later of six months after the date on which the application is first published by the USPTO or the date the first rejection of any claim by the examiner is given or mailed during the examination of the application.

A concise description for an item is a statement of facts regarding the submitted evidence and will not, itself, be treated as evidence. The concise description should set forth facts explaining how an item listed is of potential relevance to the examination of the application in which the third-party submission has been filed. The concise description may take the form of a narrative or claim chart. However, the USPTO cautions that the concise description should not be interpreted as permitting a third party to participate in the prosecution of an application, because the initiation of a protest or other form of preissuance opposition for published applications without the consent of the applicant is not permitted by U.S. patent law.

The rules limit the type of information that may be submitted to patents, published patent applications, and other printed publications of potential relevance to the examination of a patent application. However, there is no requirement that the information submitted be prior art documents, that the information submitted not already be of record in the application, or that the information submitted not be cumulative of other documents or of information already under consideration by the USPTO. In these cases, the concise description may provide additional information such that the submitted information, along with the concise description, are not cumulative of information already of record.

Compliant third-party submissions will be made of record and considered by the examiner when the examiner next takes up the application for action following the entry of the submission into patent file. The examiner will consider the submitted documents and concise descriptions in the same manner that the examiner would consider information and concise explanations of relevance submitted in an IDS.

The rules include several other important aspects. For example, preissuance submissions are not permitted to be filed in reissue applications or reexamination proceedings, because they are post-issuance proceedings. A third party may not be required to pay fees if the third-party submission lists three or fewer documents and is the first third-party submission filed by a third party or a party in privity with a third party in a given application. Any member of the public may file a third-party, and it may also be filed by an attorney or other representative on behalf of an unnamed real party in interest to impart some degree of anonymity.