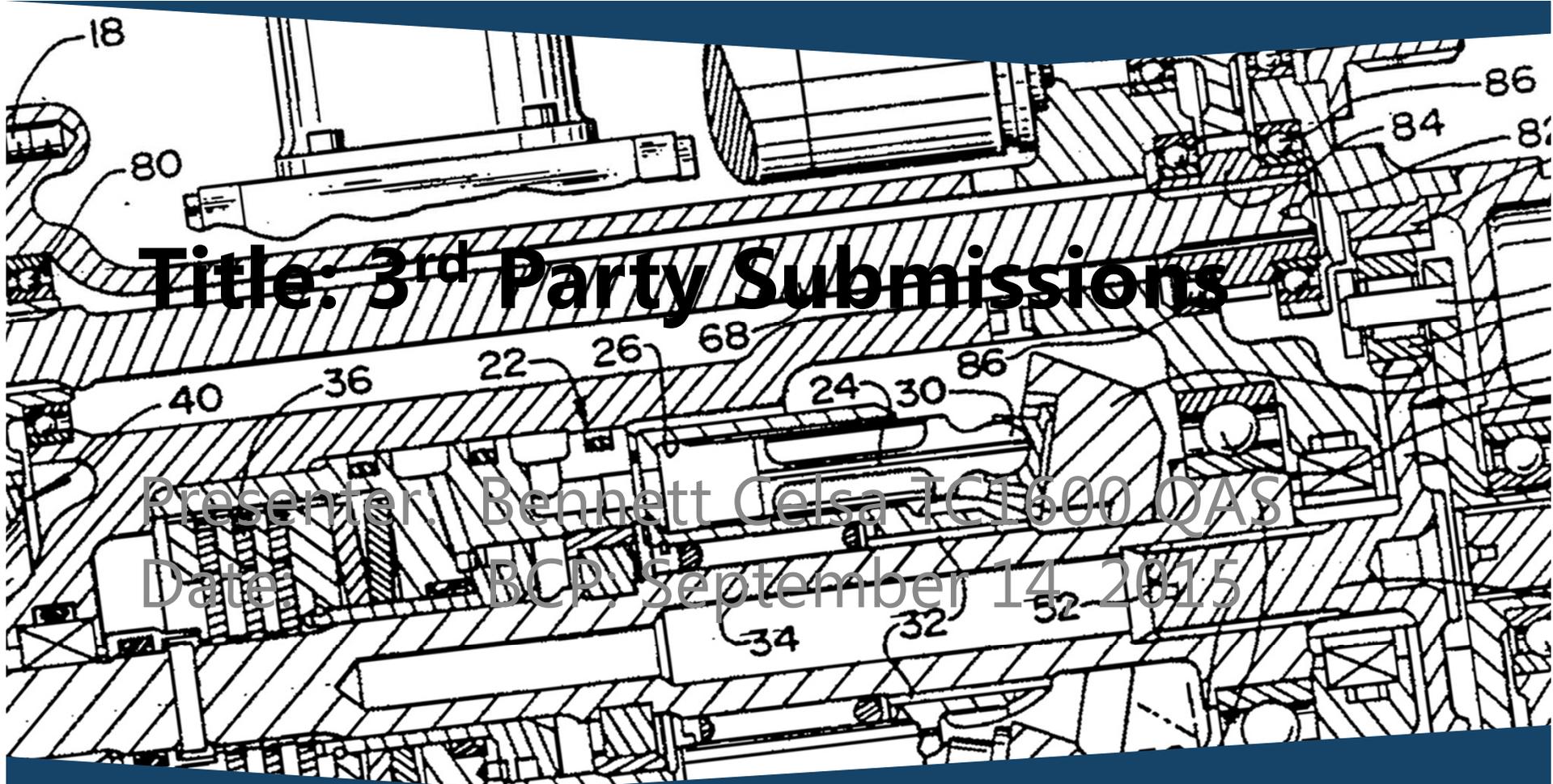


UNITED STATES
PATENT AND TRADEMARK OFFICE

uspto



Title: 3rd Party Submissions

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UNITED STATES
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- Pre-Issuance Submissions under 37 CFR § 1.290
(35 U.S.C. § 122(e) & MPEP § 1134.01);
- Protest under 37 CFR § 1.291
(35 U.S.C. § 122(c); MPEP §§ 1901-1907; Reissue: MPEP § 1441.01);
- Prior Art Submission under 37 CFR § 1.501
(35 U.S.C. § 301; MPEP § § 1920; 2202-2208);
- Rule 290 vs. Rule 291 and other 3rd Party Submissions
(MPEP §§ 1134 and 1901.07).

35 U.S.C. § 122:

- **35 U.S.C. § 122 Confidential status of applications; publication of patent applications.**

(c) PROTEST AND PRE-ISSUANCE OPPOSITION.—

(e) PREISSUANCE SUBMISSIONS BY THIRD PARTIES.—

AIA-effect on 3rd Party Submissions

- As a result of the AIA, the USPTO eliminated third-party submissions under §1.99 and implemented 35 USC 122(e) in new §1.290
- See: Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act: Final Rule: Federal Register / Vol. 77, No. 137 / Tuesday, July 17, 2012 at 42150 at www.uspto.gov/sites/default/files/aia_implementation/120707-preissuance_submission_fr.pdf

35 U.S.C. §122 (e)(2): Applicability

- Non-provisional utility, design, and plant applications (includes Cons, Divs & CIPs)
 - pending or abandoned
 - need not be published
- Not filed in provisional applications, issued patents, reissues, or reexams
- Where a submission under §1.290 is filed in a reissue, the office will process the submission as a protest under §1.291 because protests are permitted in a reissue
 - If it is compliant under §1.290, it should be compliant under §1.291

Filing of Submission

- Submitted electronically (via dedicated EFS-Web interface) or in paper (not by facsimile)

See: link to “File a Third-Party Preissuance Submission” at <http://www.uspto.gov/patent/initiatives/third-party-preissuance-submissions.html>

- No service on applicant required;
- Must be signed by submitter
 - real party in interest need not be identified.



Timeliness: § 122(e)(1) and Rule 290 (b)

Submission *must be* timely:

❖ Filed before: allowance and the later of:

-6 month post-publication; or

-date of first claim rejection.

§1.290: Timeliness

- A third-party submission is filed on its date of receipt in the Office (§ 1.6)
 - The certificate of mailing or transmission provisions of § 1.8 do not apply
 - The USPS Express Mail service provisions of § 1.10 do apply
 - Must be filed prior to, not on, the dates identified in §§ 1.290(b)(1) and (b)(2)
 - For example, a third-party submission filed on the same date the first rejection is mailed would be untimely where the application has been published for more than six months
- Other timing considerations:
 - An earlier WIPO publication will not initiate the § 1.290(b)(2)(i) time period
 - A first Office action that only contains a restriction requirement or a first Office action that is a *Quayle* action will not initiate the § 1.290(b)(2)(ii) time period
 - Filing an RCE does not reset the time period for filing a submission nor does the filing of an RCE preclude a third-party submission from being filed after the RCE, if otherwise timely

35 U.S.C. §122 (e)(2): Filer/Content

- Any Third Party (35 U.S.C. § 122(e)(1));
- A 3rd Party submission may include patents, published patent applications, or other printed publications of potential relevance to the examination of the application
 - need not be prior art.

35 U.S.C. § 122(e)(2): Filing

Submission: must be in writing and include:

- Concise description of relevance;
- Fee (if required); and
- State compliance with 35 U.S.C. 122(e)
 - these are the statutory requirements;
 - §1.290 requires additional content

§1.290: Filing Checklist

- a. Document list;
- b. Concise description of relevance;
- c. Copies and translations;
- d. Statements:
 - (i) compliance with statute and rule;
 - (ii) submitting party does not have a duty of disclosure;
 - (iii) “first and only” submission (if fee exemption applies); and
- e. Fee
 - Every 10 documents listed or fraction thereof : \$180 fee
 - First submission of 3 or fewer total documents;
 - No fee (with “first and only” statement)

§1.290: Document Listing

- Document List: identify the documents being submitted (§ 1.290(d)(1))

- Automatically generated when filing electronically at:

- <http://www.uspto.gov/patent/initiatives/third-party-preissuance-submissions.html>

- When filing in paper can use PTO/SB/429 at:

- <http://www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012>

which includes the required statements to make compliance easier

Submission: Examiner Treatment

- The listed publications and accompanying concise descriptions are considered in the same manner as documents cited on an IDS
- Copy of the document list, indicating examiner consideration, will be provided to the applicant
 - Considered documents will be printed on the patent
 - Consideration does not equate to agreement with third party
- Third party: cannot respond to examiner's treatment of submission
- Applicant: need not reply to submission unless requested by USPTO



Submission: Office Treatment

- An applicant will be notified upon entry of a compliant submission in an application
- Upon request, a 3rd Party will be notified regarding whether their submission is compliant or non-compliant

§ 1.291 Public Protests

- § 1.291 (a): filed by a member of the public against a pending application
 - Must adequately identify the patent application.
 - Any information that would make the grant of a patent improper (not limited to prior art: see MPEP 1901.02);
- Protest not matched in a timely manner to permit review by the examiner during prosecution, due to inadequate identification:
 - May not be entered and
 - May be returned to the protestor where practical, or, if return is not practical, discarded: § 1.291 (g).

§ 1.291 (b): Service and Timeliness

Protest must be:

- Served upon the applicant (see § 1.248), or
 - filed in duplicate (if service is not possible);
 - Filed the earlier of:
 - prior to the date of publication of the application; or
 - prior to the mailing of a notice of allowance;
- Note: if a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is filed prior to the date a notice of allowance under §1.311 is given or mailed in the application



§ 1.291 (c) : List + Relevance

3. Content: must include.

(a) Listing of patents, publication, or other information;

(b) Concise *explanation* of the relevance of each item listed;

(c) A legible copy of each item, other than U.S. patents and U.S. patent application publications; and

(d) An English language translation of any non-English language item



§ 1.291 (b)(2) & (c)(5) Statement

- No statement is required for the first protest filed in an application
- If a protest has already been filed in an application by a different real party in interest, then the 1st protest by “real party in interest” statement under (b)(2) applies
 - A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest
- For a 2nd or subsequent protest by the same “real party in interest” the explanation under (c)(5) applies
 - An explanation as to why the issue(s) raised in the second or subsequent protest are significantly different than those raised earlier and why the issue(s) were not presented earlier, and
 - A processing fee under § 1.17(i) must be submitted

§ 1.291 (d): 3rd Party Participation

- No office communication to 3rd party except acknowledgment of postcard receipt
 - MPEP 1907 “Unauthorized Participation by Protestor” (Office personnel must exercise care to ensure that substantive matters relating to the application are not discussed ex parte with protestor or communicated in writing ex parte to protestor)
- The limited involvement of the public protester ends with the filing of the protest.

§ 1.291 (e) & (f): Inequitable Conduct & Applicant Comment

- (e) Where a protest raising inequitable conduct issues satisfies the provisions of this section for entry, it will be entered into the application file, generally without comment on the inequitable conduct issues raised in it.
- (f) In the absence of a request by the Office, an applicant need not reply to a protest

§ 1.291 Protest in Reissue

- May be filed during pendency and before date of notice of allowance.
 - Preferably filed within two month of O.G. notice (e.g. prior to examination).
 - 35 USC § 122 (c) requirement of express written consent not applicable to a reissue which is a post-issuance proceeding. See MPEP § 1441.01.

Pre-Issuance Submission vs. Protest

Submission	Pre-issuance	Protest
Statute/Rule	35 U.S.C. § 122(e); 37 CFR § 1.290	35 U.S.C. § 122 (c); 37 CFR § 1.291
Content	Printed Publications	Publications and adverse information/arguments and public use
Concise	Description of relevance	Explanation of relevance
Timing	Pre- & Post- Publication	Pre-Publication; Post-Publication with consent
Time-Range Application	Prior to Allowance and Prior to Later of: 6mth Post-Pub or 1 st rejected claim	Prior to Allowance and Prior to Pub; OR Prior to Allowance and Post-Pub with consent
Time-Range Reissue	N.A.	Up to Allowance

Patent :“Prior Art” Submission: 37 CFR § 1.501(a)(1)

- 37 CFR § 1.501 Submission:
 - by anyone (patentee or third party)
 - anytime during patent enforceability
 - can be submitted either electronically via EFS-Web or paper via USPS or drop off window
 - dedicated EFS-Web interface; Forms PTO/SB/08A or 08B, or PTO/SB/42 may be used
- **(a)(1) submission** of prior art patents or printed publications
 - must explain pertinence & applicability to any patent claim;
 - patentee filer can distinguish claims from the prior art

See: 35 U.S.C. § 301; MPEP §§ 1920 and 2202-2208



Patent: “Claim Scope” Submission: 37 CFR § 1.501(a)(2)

- **(a)(2) submission:** patent owner statement of claim scope in PTO or Federal proceeding.

must identify:

- (i) The forum and proceeding in which patent owner filed each statement;
- (ii) The specific papers and portions of the papers submitted that contain the statements; and
- (iii) How each statement submitted is a statement in which patent owner took a position on the scope of any claim in the patent

§ 1.501(d): Confidential

(d) If the person making the citation wishes his or her identity to be excluded from the patent file and kept confidential, the citation papers must be submitted without any identification of the person making the submission.

§ 1.501(e) Certificate of Service on patent owner

- A submission by a person other than the patent owner must include a certification that a copy of the submission was served on the patent owner at the address as provided for in § 1.33(c)
- A submission by a person other than the patent owner that fails to include proper proof of service as required by § 1.248(b) will not be entered into the patent file

§ 1.501 (c) : Submission Entry

- A conforming submission will be entered in the patent file except if a Reexamination is pending in which entry will be delayed until the Reexam has been terminated.

See: 37 C.F.R. § 1.501 (c) and 37 C.F.R. §§ 1.502 (*ex parte* reexam) and § 1.902(*inter partes* reexam)

Limitations on Office Usage of Written Statements

- USPTO can only use written statements (or accompanying information) submitted under 37 CFR § 1.501 to determine the proper meaning of a patent claim in an Office proceeding that has already been ordered (*ex parte* reexamination) or instituted (*inter partes* review or post grant review)
- USPTO may use prior art and printed publications submitted under 37 CFR § 1.501 in a reexamination proceeding unless the submission is made while the proceeding has been requested and is pending for the patent in which the submission is filed

§ 1.501: benefits (MPEP § 2202)

1. Prior art (patents or printed publications) or patent owner claim scope statements may be cited to the Office for placement into the patent files without payment of a fee;
2. Citations may be made separate from and without a request for reexamination
 - Purpose:
 - ❖ Informs patent owner and the public that relevant patents or printed publications exist that should be considered when evaluating patent claims;
 - ❖ Promotes the consideration of relevant patents or printed publications in post-grant proceedings;
 - ❖ Promotes consistent claim interpretation across different proceedings and forums

MPEP § 1134: 3rd Party Inquiries

- Pursuant to [35 U.S.C. 122\(c\)](#), no protest or other form or pre-issuance opposition may be initiated after publication of an application without the express written consent of the applicant (implemented by 37 CFR 1.291)
- Under [35 U.S.C. 122\(e\)](#), any third party may submit printed publications of potential relevance to the examination of an application for consideration and inclusion in the record of the application. Such submissions must be timely made ... (implemented by 37 CFR 1.290)

MPEP § 1134: 3rd Party Inquiries

- The provisions of [35 U.S.C. 122\(c\)](#) and [\(e\)](#) thus limit a third party's ability to protest, oppose the grant of, or have information entered and considered in an application pending before the Office
- However, these provisions do not limit the Office's authority to independently re-open the prosecution of a pending application on the Office's own initiative and consider information deemed relevant to the patentability of any claim in the application

MPEP § 1134: 3rd Party Inquiries

- Despite the provisions of [35 U.S.C. 122\(c\)](#) and [\(e\)](#), the Office occasionally receives third-party inquiries or submissions (other than under [37 CFR 1.290](#) and [37 CFR 1.291](#)) regarding patent applications;
 - For example, third parties have inquired into the timing of future actions on an application, inventorship in an application, and insisted that the Office withdraw an application from issue under [37 CFR 1.313](#) on the basis of unpatentability of a claim
- The Office considers inappropriate any third-party inquiry, or submission in an application that is not provided for in [37 CFR 1.290](#) or [37 CFR 1.291](#)
- Any submission filed by a third party in an application that does not comply with the requirements of [37 CFR 1.290](#) or [37 CFR 1.291](#) will not be entered into the application file and will be discarded

MPEP § 1134: Improper 3rd Party Inquiries

- Office personnel are instructed to: (1) not reply to or act upon any third-party inquiry or other submission in an application, except those in compliance with [37 CFR 1.290](#) or [37 CFR 1.291](#); and (2) decline to accept oral or telephone comments or submissions about applications from third parties
 - When refusing third-party telephone or oral discussions, examiners may call the party's attention to the statutory prohibition on initiating protests, or [37 CFR 1.2](#) (all Office business should be transacted in writing), as appropriate
 - The Office may also refer third-party inquiries, or submissions not provided for in [37 CFR 1.290](#) or [37 CFR 1.291](#), by registered practitioners in applications to the Office of Enrollment and Discipline for appropriate action
- See *Third Party Attempts to Protest or Otherwise Oppose the Grant of a Published Application*, 1269 Off. Gaz. Pat. Office 179 (April 22, 2003) at <http://www.uspto.gov/web/offices/com/sol/og/2003/week16/patoppo.htm>



Questions ????

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