



3rd Party Participation
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3rd Party Participation: Outline

Pre-Grant:

- Third Party Submission under 37 CFR § 1.99; MPEP §§ 1134.01
- Protest under 37 CFR § 1.291; MPEP §§ 1901-1907
- Public Use Proceeding under 37 CFR § 1.292; MPEP §§ 720; 720.01-720.05

Post-Grant:

- Prior Art Submission under 35 U.S.C. § 301; 37 CFR § 1.501; MPEP §§ 1920; 2202 - 2208
- *Ex Parte* Reexam under 37 CFR § 1.502 et seq.; MPEP §§ 2200-2296
- *Inter Partes* Reexam under 37 CFR § 1.902; MPEP §§ 2601-2696



§ 1.99: 3rd Party submission

- **§ 1.99 Third-party submission in published application.**
 - (a) **A public submission of patents or publications relevant to a pending published application may be entered if:**
 - **the submission complies with the requirements of this section and**
 - **the application is still pending when the submission and application file are brought before the examiner.**



§ 1.99 (b) and (c) submission requirements

- **Must identify an application number and include:**
 - (1) **Fee in § 1.17(p);**
 - (2) **A list of patents or publications (with publication date);**
 - (3) **A written copy of each listed patent or publication or at least the pertinent portions; and**
 - (4) **An English translation of all the necessary and pertinent parts of any non-English language patent or publication**
- **Must be served upon applicant pursuant to § 1.248.**



§ 1.99 (d) : submission cont.

- **Submission shall not include:**

- an explanation of the patents or publications, or any other information.**

- **The Office will not enter such explanation or information if included in a submission under this section.**
- **A submission is limited to ten total patents or publications**



§ 1.99(e): timely submission

- **Must be filed the earlier of:**
 - within two months from the date of publication of the application; or
 - prior to the mailing of a notice of allowance
- **Untimely submissions: only permitted when the patents or publications could not have been submitted earlier, and when accompanied by the § 1.17(i) processing fee**
- **Non-compliant submissions will not be entered.**



§ 1.99(f): receipt & applicant duty

- **3rd Party Tip:**
 - include a self-addressed postcard to receive an acknowledgment by the Office that the submission has been received

- **Applicant Tip:**
 - an applicant has no duty to, and need not, reply to a submission under this section



§ 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 requirement

- The protest must be:
 1. served upon the applicant (see § 1.248), or filed with the Office in duplicate in the event service is not possible;
 2. filed the earlier of:
 - prior to the date of publication of the application; or
 - prior to the mailing of a notice of allowance
 - UNLESS:
 - accompanied by written consent of the applicant (b)(1).



§ 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) Written copy of each listed item, or at least the pertinent portions thereof;**
- (d) An English translation of all the necessary and pertinent parts of any non-English language item relied upon.**



§ 1.291 (b)(2) & (c)(5) statement

- **1st protest by “real party in interest” (b)(2)**
 - 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; or
- **2nd or subsequent protest by “real party in interest” (c)(5)**
 - 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 protestor 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 has no duty to, and need not, reply to a protest



§ 1.292 Public Use Proceeding

- § 1.292 (a) 3rd Party petitions to the examiner for the institution of public use proceedings with supporting affidavits/declarations
- Prima facie showing that the claimed invention had been in public use or on sale >1year before the filing of the application
 - a hearing may be had before the Director to determine whether a public use proceeding should be instituted.
 - If instituted, the Director may designate an appropriate official to conduct the public use proceeding, including setting of times for taking testimony, as provided by part 41, subpart D, of this title.
- Petitioner will be heard in the proceedings
- Post-decision: petitioner will not be heard further in the prosecution of the application for patent.



§ 1.292(b): Public Use Proceeding

- (b) The petition and accompanying papers, or a notice that such a petition has been filed, shall be entered if:
 - (1) accompanied by the fee set forth in § 1.17(j);
 - (2) served (see §1.248) on applicant, or filed with the Office in duplicate in the event service is not possible; and
 - (3) submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first.



§ 1.292(c): Interference 3rd party

- A petition for public use proceedings shall not be filed by a party to an interference as to an application involved in the interference
- Public use and on sale issues in an interference shall be raised by a motion under § 41.121(a)(1) of this title
- However, if the interference is stayed upon termination of a public use proceeding, a notice should be sent to the Board notifying them of the disposition of the public use proceeding. MPEP § 706.03(v).
- ❖ The outcome of public use proceedings may also be the basis of a rejection. See MPEP § 706.03(v) citing *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).



Post-Grant: 3rd Party Participation

Post-Grant: submission of prior art during patent pendency

- Prior Art Submission under 35 U.S.C. § 301; 37 CFR § 1.501; MPEP §§ 1920; 2202 - 2208
- *Ex Parte* Reexamination under 37 CFR § 1.502 et seq.; MPEP §§ 2200-2296
- *Inter Partes* Reexamination under 37 CFR § 1.902; MPEP §§ 2601-2696



Prior Art Submission under 37 CFR § 1.501(a)

- **Submission of a written citation of prior art patents or printed publications:**
 - **at any time during the period of enforceability of patent**
 - **by anyone including patent owner**
 - **Confidential submission under § 1.501 (b)**
 - **explanation of pertinence and applicability to any claim of the patent**
- **Patent Owner can distinguish claims from the prior art**
- **See: 35 U.S.C. 301; MPEP 1920 and 2202-2208.**



§ 1.501(b): confidential

- (b) 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(c) Prior Art Submission

- Citation of patents or printed publications by the public in patent files should either:
 - (1) reflect that a copy of the same has been mailed to the patent owner at the address as provided for in § 1.33(c);
 - or
 - (2) in the event service is not possible
 - be filed with the Office in duplicate.



§ 1.501: citation entry

- Such citations shall be entered in the patent file except as set forth in
- § 1.502 Processing of prior art citations during an *ex parte* reexamination proceeding **and**
- §1.902 Processing of prior art citations during an *inter partes* reexamination proceeding
- See 37 C.F.R. § 1.501 (a)



§ 1.501: benefits (MPEP 2202)

- **Prior art in the form of patents or printed publications may be cited to the Office for placement into the patent files without payment of a fee**
- **Citations of prior art may be made separate from and without a request for reexamination**
- **Purpose:**
 - **informs the patent owner and the public that such patents or printed publications are in existence and should be considered when evaluating the validity of the patent claims**
 - **ensures consideration thereof during any subsequent reissue or reexamination proceeding.**



§ 1.510: Ex parte Reexam

- **§ 1.510 Request for ex parte reexamination.**
 - (a) **Any person may, at any time during the period of enforceability of a patent, file a request for an ex parte reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501**
 - (b) **The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1) (\$2,520.00: as of 7/10).**



§ 1.510(b): Ex Parte filing requirements: statements

- (1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.**
- (2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested.**
 - A patent owner requesting reexamination may also point out how claims distinguish over cited prior art and may include a proposed amendment. § 1.510(e).**



§ 1.510(b): Ex Parte filing requirements: documents

- (3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.
- (4) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent.
 - All copies must have each page plainly written on only one side of a sheet of paper.



§ 1.510(b): Ex Parte filing requirements: service

- (5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c).
 - The name and address of the party served must be indicated.
- If service was not possible, a duplicate copy must be supplied to the Office.



§ 1.502: Ex Parte Reexam prior art citations (Pre-Ordered)

- **37 CFR § 1.502 citations:**
 - **by the patent owner under § 1.555 (Information material to patentability in ex parte and inter partes reexams)**
- and
- **by an ex parte reexam requester under either § 1.510 (in the request) or § 1.535 (in response to a patent owner statement)**
- **will be entered in the reexam proceeding**



§ 1.502: Ex Parte Reexam prior art citations (Post-Ordered)

- **37 CFR § 1.502:** The entry in the patent file of citations submitted after the date of an order to reexamine under § 1.525 by persons other than the patent owner, or an ex parte reexamination requester under either § 1.510 (request for ex parte reexamination) or § 1.535 (reply by third party requester to patent owner statement) will be delayed until the reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate.



Handling of “Post-Order” Prior Art Citations

- **MPEP 2206: Proper citations filed after the date of an order for reexamination that are not entitled to entry pursuant to the reexamination rules:**
 - **will not be considered by the examiner during the reexamination; and**
 - **are retained until the reexamination is concluded for placement in the patent file.**



§ 1.913: Inter Parte Reexam

- **§ 1.913** Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for inter partes reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501
- **§ 1.915 (a)** The request must be accompanied by the fee for requesting inter partes reexamination set forth in § 1.20(c)(2) (\$8,800.00- July 2010).



§ 1.907 3rd Party filing estoppel

- (a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for inter partes reexam of the patent until an inter partes reexamination certificate is issued under § 1.997, unless authorized by the Director.
- (b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request inter partes reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an inter partes reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.
- (c) If a final decision in an inter partes reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request inter partes reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such inter partes reexamination proceeding.



§ 1.915(b): Inter-Parte filing requirements

A request for inter partes reexamination must include:

- (1) An identification of the patent by patent number and every claim for which reexamination is requested;**
- (2) A citation of the patents and printed publications which are presented to provide a substantial new question of patentability**
- (3) A statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.**



§ 1.915(b): Inter-Parte filing requirements (documents)

- 4) A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1) through (3) of this section, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document.**

- (5) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.**



§ 1.915(b): Inter-Parte filing requirements (certifications)

- (6) A certification by the third party requester that a copy of the request has been served in its entirety on the patent owner at the address provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy of the request must be supplied to the Office.
- (7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
- (8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an inter partes reexamination request to determine whether that person is a privy.



§ 1.902: Inter parte prior art citations

- § 37 CFR 1.902

Citations by the patent owner in accordance with § 1.933 (patent owner duty to disclose) and by an inter partes reexamination third party requester under § 1.915 (in the request) or § 1.948 will be entered in the inter partes reexamination file.

The entry in the patent file of other citations submitted after the date of an order for reexamination pursuant to § 1.931 by persons other than the patent owner, or the third party requester under either § 1.913 (filing of request) or § 1.948 (post-order 3rd party submission), will be delayed until the inter partes reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate.



§ 1.948: Inter parte: post-order 3rd party prior art citations

- (a) 3rd party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947(request owner statement) or § 1.951(b) (ACP owner statement) and is limited to prior art:
 - (1) which is necessary to rebut a finding of fact by the examiner;
 - (2) which is necessary to rebut a response of the patent owner; or
 - (3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding.
- (a)(3) submission must:
 - state when the prior art first became known or available to the third party requester and
 - include a discussion of the pertinency of each reference to the patentability of at least one claim.



Questions ?????

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