

# REPORT

## USPTO ISSUES FINAL RULES FOR THIRD-PARTY PREISSUANCE SUBMISSIONS IN PATENT APPLICATIONS

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On July 17 the U.S. Patent and Trademark Office (USPTO) issued final rules to implement the provision of the America Invents Act (AIA) relating to preissuance submissions by third parties.<sup>1</sup> The rules will go into effect on September 16, 2012 and will apply to patent applications filed before, on or after that date.

### **I. Preissuance Submissions by Third Parties Under 37 C.F.R. §1.290**

New USPTO Rule 290 (37 C.F.R. §1.290) implements 35 U.S.C. §122(e) which was added by the AIA to expand the ability of third parties to submit patents and printed publications in pending patent applications. Preissuance submissions by third parties may be filed in pending utility, design, and plant patent applications, including continuing applications, but may not be filed in reissue applications or in reexamination proceedings.

Rule 99, which dealt with third-party preissuance submissions of patents and printed publications, has been deleted and replaced by Rule 290. Rule 292, which dealt with preissuance submissions of "public use" prior art, has been deleted. Rule 291 protests may be used,

when time limits permit, to submit preissuance allegations of "public use" prior art.

The USPTO will prescreen each preissuance submission by a third party. If the formal requirements are not met, the submission will generally not be entered into the application file. If the formal requirements are met, the submission should be entered in the file of the subject application, and the examiner should consider the submitted information when he/she examines the application.

When the examiner considers the submitted information, the examiner may or may not base a rejection on it. The examiner should provide applicant(s) with an initialed form indicating that the information submitted by the third party has or has not been considered.

### **A. Parties That May Not Submit Information**

Third-party preissuance submissions cannot be filed in an application by the applicant(s) or any other person with a duty to disclose information in the application under Rule 56. Thus, third-party preissuance submissions should not be used to circumvent the timing requirements for filing an Information Disclosure Statement (IDS) under Rule 97. However, the USPTO has expressly not extended this prohibition to third parties in privity with such persons.

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<sup>1</sup> We previously reported on preissuance submissions by third parties in Section III.D of our November 22, 2011 Special Report entitled "Updated Analysis of America Invents Act (AIA)," available in the News and Events section of our website ([www.oliff.com](http://www.oliff.com)).

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**B. Information That May Be Submitted**

Preissuance submissions by third parties are limited to patents, published patent applications, other printed publications, and related explanatory material (e.g., a concise description, declaration, or affidavit, as discussed below).

The documents submitted by a third party need not be prior art. For example, publications that do not qualify as prior art under 35 U.S.C. §102, but provide the examiner with, for example, background information, the level of ordinary skill in the art, inherent properties, or other relevant information, may be submitted. As an example, the USPTO commentary indicates that litigation documents that are not subject to a protective or secrecy order may qualify as publications under the rules. However, trade secrets, unpublished internal documents, and litigation documents subject to a protective or secrecy order will not be considered publications by the USPTO.

The submitter has the burden of showing that a document is, in fact, a publication. A traditional publication (e.g., book, journal article, etc.) will be considered a publication *per se*. However, if it is not readily apparent that a document is a publication, the submitter has the burden of providing evidence that the document is a publication, such as a screen shot of a web page, or an affidavit or declaration attesting to the publication of a document.

Similarly, if the submitter would like a publication to be considered as prior art by the examiner, the submitter has the burden of showing that the document qualifies as prior art.

The publication date on the face of a document is sufficient evidence to show that a document *prima facie* qualifies as prior art. If the publication date is not apparent on the face of the document (such as a document published on the internet), the concise description may include evidence of the date of publication, such as an affidavit or declaration or other evidence. Such evidence may be a screen shot of a webpage or a statement verifying the retrieval date of a document.

Each substantive document that is to be considered by the examiner must be a patent, published patent application, or other printed publication. As discussed above, other documents (e.g., declarations and affidavits) may be submitted to support non-substantive issues regarding the publication, such as its publication date. However, the other documents should not include legal arguments. For example, a declaration by an expert stating that a submitted publication would have rendered various claims of an application obvious should not be submitted.

Third parties may submit documents previously submitted in the application. For example, if an applicant submitted a document in an IDS, a third party may submit that same document in a third-party submission and point out the portions of the document that are relevant to patentability in the third party's concise description, discussed below.

There is no *per se* limit on the number of documents that may be submitted. However, as discussed below, the required fee is tied directly to the number of documents submitted.

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### C. Time Limits for Submissions

A preissuance submission must be filed before the earlier of:

(A) the date a notice of allowance under section 151 is given or mailed in the application;<sup>2</sup> or

(B) the later of (i) 6 months after the date on which the application is first published under section 122 by the Office, or (ii) the date of the first rejection of any claim by the examiner during the examination of the application.

To summarize, a preissuance submission by a third party will not be considered if filed on or after the date a notice of allowance is mailed. If a notice of allowance has not been mailed, a preissuance submission may be filed before six months from the date the application was published, whether or not the USPTO has mailed any Office Action. A preissuance submission may also be filed on or after six months from the date the application was published, but only if no rejection on the merits or notice of allowance has been mailed.

Preissuance submissions are not timely if they are filed on one of the above date limits. For example, if a preissuance submission by a third party is filed on the same date that a notice of allowance is mailed, the preissuance submission is not timely. If a rejection on the merits has been mailed, a preissuance submission would not be timely if filed on the sixth-month anniversary of publication of the application.

Further, if a notice of allowance is mailed and subsequently withdrawn, a third party may not thereafter make a preissuance submission. The initially mailed notice of allowance ends the

period for submission. Similarly, filing an RCE in an application does not re-set any of the time limits.

The time limits for filing a preissuance submission are not extendible. Further, a timely but non-compliant submission does not toll the time limit for filing a preissuance submission. For example, if a submission is timely filed but non-compliant, the submission will not be considered. If a subsequent compliant submission correcting the non-compliant submission is filed outside of the above time limits, it will not be considered because it was not timely filed.

The publication that triggers the six-month time limit for a preissuance submission by a third party is defined in §122(e), which states, "... the application for patent first published under section 122 by the Office." The USPTO considers this phrase only to include first publications made by the USPTO itself. Thus, a publication by WIPO of an international application is not considered a triggering publication, even if it was published in English and designated the United States.

A rejection that triggers the time limit for a preissuance submission by a third party must be a rejection of one or more claims on the merits. Thus, a restriction requirement, election of species requirement, or *Ex Parte Quayle* action will not trigger the time limit.

Abandonment of an application also does not toll the time limits. However, if an application is abandoned before it is published (such as for failure to respond to an office action), and the application is later revived, a third-party submission may still be made before six months after the application is published.

The application in which a third-party submission is made does not need to be published, or even pending. A third-party

<sup>2</sup> "Given" covers electronic communications from the Patent Office that are not sent through the mail. Hereinafter we use the term "mailed" to mean both electronic communications and communications sent by mail.

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submission may be made in an application that is subject to a non-publication request, pre-publication in a continuing application, or in an abandoned application, so long as the third-party submission is timely filed and in compliance with the rules. Further, the examiner should consider a third-party submission that was entered in a parent application when examining the child application.

#### **D. Items That Must Be Included in a Third-Party Submission**

The following items must be provided with a preissuance third-party submission: (1) a document list; (2) a concise description of each document; (3) a legible copy of each submitted document; (4) an English-language translation of each submitted non-English language document; (5) the appropriate fee; and (6) a statement of compliance.

##### **1. Document List**

The document list submitted with a preissuance third-party submission will be very similar to the document list (Form 1449) that we currently submit with an IDS. The document list should identify only the relevant portion(s) of a publication. For example, if only one chapter of a lengthy book is relevant, the document list should list only the chapter that is relevant and not the entire book. Similarly, if only two pages of an article are relevant, the document list should include only those two pages.

Unlike the current rules for listing non-U.S. patents and patent publications in an IDS, the document list in a preissuance submission must include the name of one of the applicant, the patentee, or the first-named inventor.

##### **2. Concise Description**

A preissuance submission must be accompanied by a concise description of the

relevance of each document being submitted. The concise description should explain why the corresponding document has been submitted and its potential relevance to the examination and patentability of the application. The concise description should point to specific paragraphs and figures of a document that are believed to be particularly relevant to the subject application.

Multiple concise descriptions should not be combined on a single paper. The concise description for each submitted document should be provided on a separate paper and accompany the corresponding document.

There is no prescribed format for a concise description. Thus, the format that will best explain the relevance of the document(s) should be used, such as a narrative description and a claim chart. While there is no specific limitation on the length of the concise description, the effectiveness of a submission may be adversely affected if the concise description is too long or complex to be readily absorbed by the examiner. On the other hand, the concise description must be more than a statement that the document is relevant, or a generalization regarding the area of technology as a whole. Further, the concise description should not be repetitive (e.g., a claim chart and a narrative that is essentially a copy of the claim chart would likely not be considered "concise").

The USPTO provides as an example of a concise description, "a description that includes an introductory paragraph describing the field of technology of a document and a claim chart that maps portions of the document to different claim elements." It provides as an example of a description that is not concise, "a description that merely repeats in narrative format the same information that is also depicted in a claim chart or that approaches the length of the documents themselves."

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The concise description should be fact-based and should not make legal assertions. Put differently, the concise description should lead the examiner to relevant portions of a publication and explain their relevance. The USPTO's commentary states that the concise description should not constitute "involvement by the submitter in the prosecution of the application" by making legal assertions of anticipation or obviousness.

The USPTO does not prohibit the use of a substantive declaration as a concise description. However, it will not treat the declaration as evidence.

In the initial review to determine whether a preissuance submission will be entered into the application, the concise description will not be challenged by the USPTO unless it is not present, or it is a bare statement that the document is relevant. However, the examiner will have discretion not to consider a document, even if it passes the initial review and is placed in the application file, if the concise description is so deficient that the relevance of the submitted publication cannot be determined by the examiner.

### **3. Copies of Submitted Documents**

Like the current IDS practice, copies of U.S. patents and U.S. patent application publications do not need to be submitted. Copies of all other documents must be submitted, and must be legible. In general, a copy of only the portion of a document listed on the document list may be submitted. Thus, if the document list includes two pages of an article, copies of only the two listed pages may be submitted. However, where additional, non-substantive, pages are required to identify a publication (e.g., a title page or copyright page), the identifying pages may be

submitted even if they do not appear on the document list.

The requirement to submit only the relevant portion(s) of a document listed on the document list is instituted in an attempt not to trigger the duty of disclosure under Rule 56. Under Rule 56 there is a duty to submit to the USPTO any information that is material to patentability of which an applicant, or another person associated with an application, is aware. Thus, if a third-party submitter includes only pages 7-12 of a book on the document list, the examiner will only consider pages 7-12. However, if the third-party submitter submits the entire book, applicant(s) might review other portions of the book and thus trigger a duty to disclose some such other portions. By allowing third-party submitters only to submit the pages of a document included on the document list, the examiner will consider those pages and applicant(s) will not be put at risk under Rule 56 as to any non-submitted pages of the document.

### **4. English-Language Translations**

An English-language translation of each non-English language patent, patent application publication, or other publication included on the document list must be submitted. The translation may be a computer-generated translation and need not be certified. An English-language translation should only be provided for the portions of a document included on the document list. For example, if only two pages of a seven page non-English language document are listed on the document list, a translation of only the two listed pages may be submitted. Concomitantly, if an entire article is submitted, a translation of the entire article must be submitted.

As with submitted publications, the requirement to submit a translation of the entire portion of a document included on the document

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list and submitted to the USPTO is instituted in an attempt not to trigger the duty to disclose under Rule 56. Thus, for example, a third party may not submit an entire Japanese-language document in a Japanese inventor's application, yet only translate a portion of it, to try to trigger a duty of disclosure of untranslated portions that may be reviewed by the Japanese inventor.

## **5. Fee**

Third-party preissuance submissions must be accompanied by a fee of \$180 per 10 documents submitted, or fraction thereof. Thus, submitting 1-10 documents requires a \$180 fee, submitting 11-20 documents requires a \$360 fee, submitting 21-30 documents requires a \$540 fee, etc. The fee will be based on the number of patents, patent application publications, and other publications on the document list. There is no refund available, even in the case of a non-compliant submission.

### **a. Publications that Count Toward the Fee**

Each patent, patent application publication, and other publication on the document list will count toward the fee total. Any document submitted but not included on the document list will not count toward the fee total, but also will not be considered by the examiner.<sup>3</sup> Affidavits to show, for example, the relevant date of publication and translations do not count toward the fee total.

The USPTO gives limited guidance regarding how internet-based documents will be counted, requiring that they be considered on a case-by-case basis. Thus, internet-based publications will need to be considered individually to determine how they affect the count of submitted documents. Each electronic

publication structured like a traditional publication, such as an electronic journal article, will count as a document. If the subject matter of an internet-based publication appears to be related and could reasonably be included in a single publication (e.g., separate "pages" of a single website), that internet-based publication should count as one publication. However, publications on the same website that do not have subject matter that is related (e.g., separate articles available on one website) should be treated as separate publications. Any pages submitted to show how to navigate to the internet-based publication should not be treated as separate documents.

### **b. Fee Exemption**

There is a fee exemption if the preissuance submission by a third party meets the following requirements: (1) the submission includes three or fewer documents; and (2) the party making the submission certifies that the submission is the first and only submission by that third party, or any party in privity with that third party, in the subject application. Subsequent submissions by a third party, or party in privity with the third party, that previously took advantage of the fee exemption may be filed with the fee for the subsequent filing. A different third party may take advantage of the fee exemption even if another third party also took advantage of the exemption so long as the two third parties are not in privity with one another.

The individual making the submission will have to make a statement that, to his or her knowledge and after reasonable inquiry, the submission is the first and only submission by the third party or a party in privity with the third party in the subject application. However, the USPTO will not challenge the certification, and it will not require that the real party in interest be identified.

<sup>3</sup> In this instance, the entire submission may be discarded in the initial review as being non-compliant with the rules.

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## 6. Statement of Compliance

A third-party submission may be made by an attorney on behalf of a third party without identifying the real party in interest. However, each preissuance submission by a third party must be accompanied by a statement of compliance. The statement of compliance must be signed by the person (e.g., the attorney) making the submission and must state that: (1) the third party is not an individual who has a duty to disclose information with respect to the application under Rule 56, and (2) the submission complies with the requirements of 35 U.S.C. §122(e) and Rule 290.

### E. USPTO Treatment of Third-Party Submissions

Each preissuance third-party submission will be reviewed for formal compliance with Rule 290 before it is entered into the file of an application. For example, in the initial review, the USPTO will determine whether the submission is timely, whether the appropriate fee has been paid, whether a compliant document list has been submitted, whether copies of all the documents and translations have been submitted, whether a concise description of each document has been submitted, and whether a statement of compliance has been submitted. This initial review may not consider the accuracy of the statements made (e.g., the initial review will not determine whether the concise description is accurate).

If a third-party submission does not meet a requirement under the statute (35 U.S.C. §122(e)), it will be discarded and not entered into the file. However, if one or more of the formal requirements under Rule 290 is not met, the submission may be discarded and not entered into the file of the application at the discretion of the Patent Office. The USPTO will not discard a submission if it believes that the unmet formal requirement under Rule 290 "does not raise an

ambiguity as to the content of the submission." If any portion of the submission is discarded, the entire submission will be discarded. In that case, any corrected submission must completely replace the previous submission.

If the third-party submitter provides the USPTO with an email address when the submission is filed, the USPTO will notify the submitter via the provided email address if it determines that the submission is non-compliant. Notification of a non-compliant submission will not be provided by any other means. Neither the notification of a non-compliant submission nor the non-compliant submission will be placed in the file. Third-party submitters will not be notified when their submission is entered into the file, and will not be provided access to the application file that is not also available to the public.

The USPTO will not revert to the third-party submitter with any inquiries about issues or facts raised in a submission. However, the USPTO may request information from the affected applicant(s) under Rule 105.

If a third-party submission meets the formal criteria set forth in the statute and Rule 290, the submission will be entered into the file for the examiner's consideration. When the examiner takes up the application for examination on the merits, the examiner will consider the references listed in the third-party submission in the same way that examiners consider documents submitted by applicants in an IDS. The examiner will confirm that he/she has considered the submitted documents by providing applicant(s) with an initialed list of those documents (the initialed form is similar to the initialed Form 1449 that applicants receive from the USPTO when they submit documents in an IDS). The publications submitted by a third party and considered by the Examiner will be listed on the face of the issued patent.

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The contents of a compliant submission will be available in the application file. Any non-patent documents submitted in a third-party submission will be available to applicant(s) through the USPTO's private PAIR system.

#### **F. Notification to Applicants**

The rules do not require the third-party submitter to notify applicant(s) of the submission. However, the USPTO will notify applicant(s) when a preissuance third-party submission has met the requirements of the initial review and has been entered into the file, but only if they participate in the USPTO's e-Office Action program. Our firm participates in the USPTO's e-Office Action program on behalf of all of our clients. Thus, we will receive notifications when preissuance third-party submissions are filed in our clients' applications, and will promptly forward them to our clients.

#### **G. Applicant Response to Third-Party Submissions**

There is no requirement that an applicant respond to a third-party submission. However, applicants may respond to third-party submissions, for example in a timely-filed preliminary amendment or supplemental response.

Alternatively, an applicant could wait until an office action is mailed to determine whether the examiner applies the submitted documents in a rejection. This option may be desirable if, once reviewed, the submitted documents do not appear to be relevant or anticipate the claims.

If an applicant believes that a document provided by a third party and applied in a rejection by the examiner is not a publication or is not prior art, the applicant can challenge these facts. The applicant may, for example, provide evidence that the document is not a publication or prior art.

#### **H. Analysis**

In most cases, due to the extremely limited participation of the third party, the patent applicant will have an opportunity to present un rebutted arguments and/or amend the claims to address submitted information (including conducting personal interviews with the Examiner), while still trying to cover the third party's product or method. Further, information submitted during prosecution with a description of its relevance will usually not subsequently be effective in an *ex parte* reexamination, post-grant review, *inter partes* review, or subsequent litigation, because it will have already been considered by the examiner for the reasons identified by the third party.

When considering whether to make a third-party submission, the advantages and disadvantages should be compared to other methods of challenging a patent or application. Generally, a third-party submission will be less expensive than other forms of challenge, but will limit the amount of participation by the third party. A brief comparison of third-party submissions to *ex parte* reexamination, post-grant review, and *inter partes* review is given below, but all avenues should be thoroughly explored with counsel to ensure that the third party's objectives may best be achieved:

- *Ex parte* reexamination (EPRE) - EPRE may be requested any time the patent is enforceable. The information submitted in EPRE is limited to patents, patent application publications, and other publications that qualify as prior art. A substantial new question as to the patentability of a claim in the patent must be raised for an EPRE to be ordered by the USPTO. Third parties generally are not involved in the EPRE once the documents and initial papers have been submitted. However, amendments that a



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patentee can make in a patent undergoing EPRE are limited, which is not the case after a preissuance third-party submission has been filed.

- Post-grant review (PGR) - PGR may be requested up to nine months after a patent has issued that is subject to post AIA §102 and §103 (or as of September 16, 2012 for certain business method patents). The patentability of patent claims may be challenged on substantially any basis, and limited discovery will be available. Third parties will be deeply involved in the PGR process.<sup>4</sup>
- *Inter partes* review (IPR) - IPR will be available as of September 16, 2012, and may be requested after a patent has been issued for nine or more months. Issues considered in IPR are limited to unpatentability over patents, patent application publications, and other publications that qualify as prior art. Third parties will be deeply involved in the IPR process, and limited discovery will be available.<sup>5</sup>

Unlike in PGR and IPR, a third-party submitter will have no interaction with the examiner after the submission has been made. Thus care must be taken to craft the concise description of the submitted documents. The concise description must be detailed and persuasive enough to convince the examiner that the submitted documents anticipate, or would have rendered obvious, the pending claims,

without bogging the examiner down in details and unnecessary information. The submission may also address other aspects of the claims and/or specification. Because the concise description must be carefully crafted, substantial attorney time may be required.<sup>6</sup>

Care should be taken to submit only relevant portions of a document so that the examiner's attention will not be diluted by non-relevant subject matter. Although the USPTO cautions that third-party submissions should not make legal arguments, a claim chart showing where each feature of a claim is disclosed in a document is permitted. Such a claim chart can essentially lay out a rejection for an examiner without making a legal conclusion. Further, third-party submissions are not limited to subject matter in the pending claims, but may address any subject matter that is relevant to patentability. Thus, if a submitter determines that certain subject matter in the specification might be added to the claims through amendment, that subject matter could be addressed by pointing out where the submitted document discloses that subject matter. For example, unclaimed embodiments could be addressed. Similarly, issues of enablement, written description, lack of utility or indefiniteness could be addressed if the submitter's position is supported by appropriate documents.

Publications that may be submitted in a third-party submission are not limited to prior art documents. Therefore, documents that are published after the application was filed may be brought to the examiner's attention. Further, although the USPTO cautions that the concise

<sup>4</sup> The minimum USPTO fee for PGR is currently proposed to be \$35,800. We will provide more details regarding forthcoming PGR rules in a subsequent Special Report.

<sup>5</sup> The minimum USPTO fee for IPR is currently proposed to be \$27,200. We will provide more details regarding forthcoming IPR rules in a subsequent Special Report.

<sup>6</sup> The USPTO estimates approximately 10 hours of attorney time and a cost of \$3,710 per submission. We believe that this is a very conservative estimate for an attack on an important patent application, as it only takes into account time spent preparing the required materials, but not finding and analyzing relevant documents or developing an associated strategy.

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description should not be used to make arguments of anticipation and obviousness, there is no such limitation on the listed documents themselves. Thus, a document that, for example, concludes that an invention described in an application was merely an obvious variation on a pre-existing product could be submitted in a third-party submission even if this document was written and published after the application was filed. However, the USPTO may refuse to consider such a publication if it considers it an attempt to become involved in prosecution of the application.

Although the USPTO takes steps to prevent triggering applicants' duty to disclose under Rule 56 by third-party submissions, the rules cannot account for every possibility. Accordingly, there may be times when the duty to disclose under Rule 56 is triggered.

For example, the examiner may refuse to consider a document in a third-party submission that was entered in the file, if the translation was incorrect, or the concise description was inaccurate. In this instance, because applicant(s) would be aware of the document and aware that the examiner did not consider it, it may be desirable for the applicant to correctly submit the non-considered document in an IDS to make clear that the applicant has complied with the duty to disclose under Rule 56. Because in most instances such a determination will be made by an examiner in a first office action, any non-considered documents could be submitted in an IDS, with the appropriate certification fee. However, if a third-party submission is made just before an office action is mailed, the examiner may not address the submission in the first office action. In this instance, the applicant should consider contacting the examiner to request that he/she consider the third-party submission because it may not be cost-effective to submit any non-considered documents after a final rejection is issued.

Although the USPTO rules do not require a third party to provide notification of its submission to an applicant, notification provided to the applicant may trigger the applicant's duty to disclose under Rule 56 even as to a non-compliant submission. Thus, when making a third-party submission, one should consider serving notification of the submission on the applicant to intentionally trigger a duty to disclose under Rule 56. This process could provide a safeguard against the USPTO finding the submission non-compliant or the examiner possibly not considering a document, by triggering applicant's duty to disclose the documents.

## II. Rule 291 Third Party Protests

Protests under Rule 291 allow third parties to submit any information in an application file that the third party deems relevant to the patentability of an application. The examiner should consider any information timely submitted in a protest. Differences and similarities between protests under Rule 291 and third-party submissions under Rule 290 are discussed below.

The time limits for submitting a protest are different from the time limits for a preissuance submission. A protest may be considered without the applicant's written consent if it is filed before the earlier of: (1) the date the application is published; or (2) the date that a notice of allowance is mailed. A protest will be considered with the applicant's written consent if it is filed before a notice of allowance is mailed. Publication by WIPO of an international application designating the United States does not trigger the time limit to file a protest in a resulting U.S. national phase application.

Unlike preissuance submissions, the type of information that may be submitted in a protest under Rule 291 is not limited to patents, patent application publications, or other publications.

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Thus, any information, as well as arguments directly addressing patentability, may be submitted in a protest.

Regarding the mechanics of submitting information in a protest, Rule 291 has been amended in view of the new rules for preissuance submissions. Documents submitted in a protest under Rule 291 must be listed in an information list in the same manner as documents in the document list under Rule 290. The protester must only submit the information that is listed on the information list. For example, the protester may not list two pages of a seven-page document on the information list and submit the entire document.

Other differences between a protest under Rule 291 and a preissuance submission under Rule 290 include: in a protest, the real party in interest must be named, and the submitter must attempt to notify the applicant(s) of the protest.

In addition, Rule 291 requires that, in a protest, a "concise explanation" of each document be provided. The concise explanation is not the same as the concise description required in preissuance submissions under Rule 290. The concise explanation required in a protest merely needs to describe the document that is being submitted; Rule 291 does not require that the protester point out how the reference affects the patentability of the application. However, unlike the concise description for preissuance submissions, unpatentability arguments may be made in the concise explanation in a protest.

Protests are a better vehicle for provoking an interference than third-party preissuance submissions, because the information submitted in a protest may directly state why an interference should be declared. In contrast, the USPTO rules admonish against including such legal conclusions in third-party preissuance submissions.

Also, unlike preissuance submissions by third parties, protests may be used in reissue applications, because the prohibition against the filing of a protest after publication of an application is not applicable to reissue applications. Any submission filed in a reissue application that complies with preissuance submissions Rule 290 will be treated in the reissue application as a protest under Rule 291.

### III. Recommendations

As recommended in our November 22, 2011 Special Report, we generally do not recommend filing third-party submissions during the pendency of a competitor's patent application, because there is limited involvement by the third party and the applicant(s) will have exclusive and substantially unlimited opportunities to rebut the relevance of any applied documents. However, a third-party submission might be useful if a prior publication of the complete invention was made, or if a prior art reference is available that will force an applicant to amend the claims so that they do not cover the third party's product. A third-party submission (or a protest) might also be useful to provoke an interference with an issued patent or published patent application.

We provide the following recommendations for anyone considering making a third-party submission:

1. Carefully consider the pros and cons of the third-party submission in relation to other available processes to challenge an application or patent;
2. Thoroughly review the documents to be submitted and the subject application to determine all relevant subject matter in the submitted documents;
3. Work closely with counsel to draft persuasive concise descriptions for each submitted document, taking into account

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the submitted documents, the subject application, the applicant's products, and the third party's products;

4. Work closely with counsel to prepare evidentiary documents, such as affidavits and declarations to show publication dates;
5. Consider whether the third party may take advantage of the fee exemption;
6. File the third-party submission in the USPTO as early as possible to avoid an untimely filing, and do not rely on potentially inaccurate USPTO predictions of publication or first office action dates;
7. Serve a copy of the submission on the applicant(s) to trigger their duty to disclose under Rule 56;
8. Include an email address for notification of non-compliance, and monitor the subject application file to make sure that the submission is found to be compliant and that all submitted documents are ultimately considered by the examiner; and
9. Consider making submissions, as necessary, in abandoned applications in the event they are revived.

We provide the following recommendations for applicants that receive a third-party submission in an application:

1. Review the cited documents to determine whether they qualify as prior art;
2. Review the submission and cited documents to determine whether the claims should be amended before the

first office action is mailed (e.g., if the documents destroy novelty or expose fatal §112 issues) to expedite prosecution;

3. File any necessary preliminary amendment as soon as possible so it will be present when the examiner considers the application, but consider timing that might make a further third-party submission more likely to be untimely;
4. Carefully review the first office action on the merits to determine whether the examiner has considered all of the submitted documents;
5. If the examiner does not consider a submitted document, determine whether it should be re-submitted in an IDS; and
6. If the examiner makes a rejection over a submitted document that is not a publication or does not qualify as prior art, include appropriate arguments in the response to the office action.

\* \* \* \* \*

*Oloff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.*

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