



ARE Patent Law Alert: USPTO Issues Final Rules Easing Requirements For And Expanding Use Of Third-Party Preissuance Submissions

July 19, 2012

Author(s): Charles R. Macedo, Michael J. Kasdan and Addie A. Bendory

(July 19, 2012) On July 17, 2012, the USPTO issued final rules on Third-Party Preissuance Submissions. See [Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 42150 \(July 17, 2012\)](#). The final rules go into effect on September 16, 2012 and apply to any application filed **before, on, or after** that date.

Section 8 of the AIA amends 35 U.S.C. § 122 by adding new 35 U.S.C. § 122(e), which states that any third party may submit any patents, published patent applications, or other printed publications of potential relevance to the examination of the application to the USPTO for consideration. See Appendix for full text of new 35 U.S.C. § 122(e).

The previous rules regarding third party submissions, (see 37 C.F.R. § 1.99), limited third-party submissions to a time period of two months from the date of publication of the patent application and a maximum of 10 printed documents and, and prohibited comments regarding the relevance of the documents submitted. By contrast, new 35 U.S.C. § 122(e) and new 37 C.F.R. § 1.290 grant longer time periods for submission, allow for an unlimited number of documents to be submitted and, contrary to 37 C.F.R. § 1.99, *require* comments regarding relevance regardless of the publication status of the application.

The newly issued rules specify the procedural requirements for a third party to follow when making a preissuance written submission to the USPTO. As to timing, the written submission must be made before the earlier of:

- (1) a notice of allowance; or
- (2) the later of
 - (a) six months after first publication, or
 - (b) rejection of any claim.

new 37 C.F.R. § 1.290(b); see also new 35 U.S.C. § 122(e)(1).



The written submission must contain a concise description of relevance of the prior art and be accompanied by a fee of \$180 for every 10 documents. Written submissions may be made via the electronic filing system of the USPTO.

To implement the above changes, the final rule creates new 37 C.F.R. § 1.290, entitled “Submissions by third parties in applications,” and deletes existing Section 1.99 entitled “Third-party submission in published application.” (see Appendix for full text of new 37 C.F.R. § 1.290).

New 37 C.F.R. § 1.290 expands on the express statutory requirements of new 35 U.S.C. § 122(e) by:

1. Detailing how to submit printed documents to the USPTO (see new 37 C.F.R. §1.290(e)); and
2. Providing that in the absence of a request by the USPTO, an applicant has no duty to, and need not, reply to a third party submission, (see new 37 C.F.R. § 1.290(h)).

We will continue to monitor the America Invents Act as new rules are issued, and encourage you to review the publications and events page of our firm website (www.arelaw.com) for more information. Please feel free to contact one of our firm’s attorneys to learn more.

*[Charles Macedo](#) is a partner, Michael J. Kasdan is a former partner and Addie A. Bendory is a former associate at Amster, Rothstein & Ebenstein LLP. Their practice specializes in intellectual property issues. Charles may be reached at cmacedo@arelaw.com.

Mr. Macedo is also the author of *The Corporate Insider’s Guide to U.S. Patent Practice*, published by Oxford University Press in 2009.

APPENDIX

New 35 U.S.C. 122 (e):

§ 122(e) PREISSUANCE SUBMISSIONS BY THIRD PARTIES.—



(1) IN GENERAL.—Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of—

(A) the date a notice of allowance under section 151 is given or mailed in the application for patent; or

(B) the later of—

(i) 6 months after the date on which the application for patent is first published under section 122 by the Office, or

(ii) the date of the first rejection under section 132 of any claim by the examiner during the examination of the application for patent.

(2) OTHER REQUIREMENTS.—Any submission under paragraph (1) shall—

(A) set forth a concise description of the asserted relevance of each submitted document;

(B) be accompanied by such fee as the Director may prescribe; and

(C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.



New 37 CFR 1.290:

§ 1.290 Submissions by third parties in applications.

(a) A third party may submit, for consideration and entry in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application if the submission is made in accordance with 35 U.S.C. 122(e) and this section. A third-party submission may not be entered or considered by the Office if any part of the submission is not in compliance with 35 U.S.C. 122(e) and this section.

(b) Any third-party submission under this section must be filed prior to the earlier of:

(1) The date a notice of allowance under § 1.311 is given or mailed in the application; or

(2) The later of:

(i) Six months after the date on which the application is first published by the Office under 35 U.S.C. 122(b) and § 1.211, or

(ii) The date the first rejection under § 1.104 of any claim by the examiner is given or mailed during the examination of the application.

(c) Any third-party submission under this section must be made in writing.

(d) Any third-party submission under this section must include:

(1) A document list identifying the documents, or portions of documents, being submitted in accordance with paragraph (e) of this section;



- (2) A concise description of the asserted relevance of each item identified in the document list;
- (3) A legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications;
- (4) An English language translation of any non-English language item identified in the document list; and
- (5) A statement by the party making the submission that:
 - (i) The party is not an individual who has a duty to disclose information with respect to the application under § 1.56;and
 - (ii) The submission complies with the requirements of 35 U.S.C. 122(e) and this section.
- (e) The document list required by paragraph (d)(1) of this section must include a heading that identifies the list as a third-party submission under § 1.290, identify on each page of the list the application number of the application in which the submission is being filed, list U.S. patents and U.S. patent application publications in a separate section from other items, and identify each:
 - (1) U.S. patent by patent number, first named inventor, and issue date;
 - (2) U.S. patent application publication by patent application publication number, first named inventor, and publication date;
 - (3) Foreign patent or published foreign patent application by the country or patent office that issued the patent or published the application; the applicant, patentee, or first named inventor; an appropriate document number; and the publication date indicated on the patent or published application; and
 - (4) Non-patent publication by author (if any), title, pages being submitted, publication date, and, where available, publisher and place of publication. If no publication date is known, the third party must provide evidence of publication.
- (f) Any third-party submission under this section must be accompanied by the fee set forth in § 1.17(p) for every ten items or fraction thereof identified in the document list.



(g) The fee otherwise required by paragraph (f) of this section is not required for a submission listing three or fewer total items that is accompanied by a statement by the party making the submission that, to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only submission under 35 U.S.C. 122(e) filed in the application by the party or a party in privity with the party.

(h) In the absence of a request by the Office, an applicant need not reply to a submission under this section.

(i) The provisions of § 1.8 do not apply to the time periods set forth in this section.