THIRD PARTY PRIOR ART SUBMISSIONS

July 17, 2012

The Patent and Trademark Office on July 17, 2012, announced final rules to implement the provisions of the America Invents Act (AIA) on preissuance submissions by third parties in pending patent applications. These rules, which go into effect on September 16, 2012, apply to any application filed before, on or after that date.
Section 8 of the AIA amends the patent laws to provide a mechanism for third parties to submit to the Office, for consideration and inclusion 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.

A third-party submission under 37 CFR 1.290 may be made in any non-provisional utility, design, or plant application, as well as in any continuing application. These submissions may not be made in reissue applications or reexamination proceedings.

The Office has developed a dedicated Web-based interface to permit third-party submissions under new 37 CFR 1.290 to be filed electronically. Third parties can access the preissuance submissions Web-based interface by selecting the preissuance submissions filing option in the Office's electronic filing system—Web (EFS-Web).
A preissuance submission must be timely filed, in writing, and contain:

1. a list identifying the items being submitted;
2. a concise description of the relevance of each item listed;
3. a legible copy of each non-U.S. patent document listed;
4. an English language translation of any non-English language item listed;
5. a statement by the party making the submission that the submission complies with the statute and the rule; and
6. the required fee.

The Office has determined that the fee set forth in 37 CFR 1.17(p) (currently $180) will be applicable to third-party submissions under 37 CFR 1.290 such that the fee set forth in 37 CFR 1.17(p) will be required for every ten documents, or fraction thereof, listed in each third-party submission.

The Office is providing an exemption from this fee requirement where a third-party submission lists three or fewer total documents and is the first third-party submission by a third-party or a party in privity with the third-party, in a given application.

The Office is providing this fee exemption for the first third-party submission in an application by a third party containing three or fewer total documents because the submission of a limited number of documents is more likely to assist in the examination process and thus offset the cost of processing the submission.

Moreover, keeping the size of the fee exempted submission to three or fewer total documents will help to focus the attention of third parties on finding and submitting only the most relevant art to the claims at hand.

Where one third-party takes advantage of the fee exemption in an application, another third party is not precluded from also taking advantage of the fee exemption in the same application provided that the third parties are not in privity with each other.

Note – 35 U.S.C. 122(e) does not limit third-party preissuance submissions to pending patent applications. A third-party submission made within the statutory time period, and otherwise compliant, will be entered even if the application to which the submission is directed has been abandoned. Such submissions will only be reviewed if the abandoned application is revived.

Posted: July 17, 2012