

# The Limited Monopoly™

## Preissuance Submissions by Third Parties Under the AIA - “Getting the Wheels to Fall Off”

by Robert Gunderman, PE and John Hammond, PE

### Patent Reform- The America Invents Act – A Refresher

Patent reform in the United States, known as the America Invents Act (AIA), was enacted on September 16, 2011, creating the most substantial changes to our patent laws in more than a century. The changes continue, and will culminate with the “first inventor to file” section taking effect March 16, 2013. In this article, we will discuss Section 15 of H.R. 1249, “Preissuance Submissions by Third Parties,” effective September 16, 2012<sup>1</sup>.

### Influencing a Patent Application of Another

In years past, there has been very little opportunity for a third party to influence the patent application of another. For example, suppose a competitor filed a patent application on an invention that you were certain existed before their filing. Under the old law, there would be little you could do about it, except perhaps asking your patent practitioner to inform the applicant’s practitioner of this knowledge. By law (both past and current), the practitioner (and the applicant) must disclose items that are material to patentability to the USPTO<sup>2</sup>. But that’s it. However, new provisions for third party submissions now in effect under the AIA provide you with an opportunity to submit directly to the USPTO the information that you believe is relevant, and even provide a concise description of its relevance, essentially giving you an opportunity to try and get the wheels to fall off of your competitor’s patent application.

### Making a Third party submission

A third party submission under 37 CFR 1.290 may be made in any non-provisional utility, design, or plant patent application, as well as any continuing application. A third party submission may not, however, be made in reissue applications or reexamination proceedings, because these are not considered patent applications. It is interesting to note that third party submissions are not limited to pending applications. A third party submission that is made within the specified time interval and is otherwise compliant will

*“Preissuance submissions...an opportunity to try and get the wheels to fall off of your competitor’s patent application.”*



be entered even if the application to which the submission is directed has been abandoned. An examiner will not consider this third party submission unless the application resumes a pending status. The abandonment of the application does not, however, toll or otherwise stop or delay the statutory time period for making the third party submission.

### Timing- When You Can Submit

A preissuance submission must be made before the earlier of either the date a notice of allowance is given or mailed in the application, or the later of either six months after the date on which the application is first published or the date of the first rejection of any claim by the examiner during examination of the application. These time periods must be observed or your submission will be discarded by the USPTO, and your submission fee will not be refunded.

### Elimination of 37 C.F.R. 1.99

This new final rule for preissuance submissions eliminates the old 37 C.F.R. 1.99 that provided for a limited two month time following the date of the patent application publication or the mailing of a notice of allowance, whichever was earlier, to submit patents, published patent applications, or printed publications in published patent

applications, but did not permit an accompanying concise description of the relevance of each submitted document.

### Submission Requirements

To submit a preissuance submission under this new rule, you must do so in writing and it must be filed within the time period described above. The submission must 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<sup>1</sup>; and of course (6) the required fee. The fee is currently set at \$180 and provides for the submission of up to ten documents. But with surprising generosity, the fee will be waived entirely for a third party submission that lists three or fewer documents and is the first third party submission by the third party or a party in privity with the third party, in a given application.

### Anonymity

A third party submission does not need to indicate the true identity of the third party, and hence, can be filed through a patent practitioner. The submitter must be identified through a signature, but the true third party of interest does not need to be identified. This could prevent, for example, a small company from being harassed or otherwise subject to undesirable business practices by a larger entity that the small company is competing against. This does not, however, allow an anonymous third party to attempt to “flood” an examiner with useless information in an attempt to bog down prosecution, because one of the submission requirements is a statement of why the submitted items are in fact relevant.

### What Happens Next?

Once you have filed your third party submission, the Office will review it for compliance. If it is found to not be compliant with the submission requirements, it is not entered into the file, not considered, and will be discarded. A non-compliant submission does not receive a refund of the fees paid, and the clock continues to tick with regard to the deadline to file a third party submission (the non-compliant submission does not “toll” the statutory time period for submission). The Office will only notify the submitter of the non-compliant submission if an email address has been provided with the submission. Neither the notification nor the non-compliant third party submission will be made of record in the application.

Third parties are not required to serve the applicant with a copy of the third party submission. The USPTO will

notify the applicant upon entry of a compliant third party submission if the applicant participates in the e-Office Action program. Otherwise the compliant submission will be available in PAIR for the applicant or the applicant’s representative to retrieve. Also, a third party submission does not create a requirement for the applicant to independently file an Information Disclosure Statement (IDS).

When the application is in turn examined during prosecution, the examiner will consider the documents and concise descriptions submitted in a compliant third party submission in the same manner as an IDS submission. Because the prosecution of a patent application is an *ex parte* proceeding, no response from a third party with regards to the examiner’s treatment of the third party submission will be permitted or considered.

So third party preissuance submissions may have an evolving role in the prosecution of patent applications for years to come. For a nominal fee and the cost to prepare the submission, a third party is given a limited opportunity to attempt to get the wheels to fall off of a competitor’s patent application. The decision making is still, however, done by the examiner. Only now, however, you have an opportunity to be heard.

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1. New Sections 35 U.S.C. §122(e) and 37 C.F.R. 1.290
  2. See also [“The Limited Monopoly”](#) December 2006

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*PHOTO CREDIT: Robert D. Gunderman, Jr.- “I hate it when the wheels fall off”. 1970 SAAB Sonett III. The SAAB Sonett III was a two seat fiberglass sports car built between 1970 and 1974 by SAAB Automobile AB of Sweden. It was powered by a Ford V-4 Taunus (not Taurus) engine, was front wheel drive, and had a curb weight of 1900 lbs. Only 8,368 of these cars were built in total, making them rare and tired old sports cars.*