



3rd Party Participation During Examination



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- 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
- AIA Proposed Changes to Third Party Submission



§ 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 the 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 Requirements

- **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
- **Submissions outside the time period: 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, in protester's opinion, 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(a).**



§ 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) Statements

- **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 return of a self-addressed postcard that was included with the protest**
 - **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 protester 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**



AIA – Proposed Rule

- **77 FR (January 5, 2012) 448**
- **Notice of Proposed Rulemaking**
- **Comments Due on or before March 5, 2012**
- **Addresses amendments to 35 USC 122(e)**



AIA – Proposed Rule

- **Proposes addition of new rule 37 CFR § 1.290**
- **Proposes amendment to 37 CFR § 1.291 to implement new 35 USC § 122(e) pertaining to third-party preissuance submissions**
- **Proposes elimination of current rules 37 CFR § 1.99 and § 1.292**
- **Effective Date September 16, 2012**



AIA – 35 USC § 122(e) 3rd Party Submissions

■ Impact on 3rd Party

Timing of compliant submission

- Earlier of:
 - notice of allowance or
- Later of:
 - six (6) months after date of publication or
 - first rejection



AIA – 35 USC § 122(e) 3rd Party Submissions

■ Impact on 3rd Party

➤ Content

- List of documents of potential relevance to examination of an application
- Concise description of the asserted relevance of each document submitted



AIA – 35 USC § 122(e) 3rd Party Submissions

- **Impact on 3rd Party**
 - **Proposed fees to be set to recover estimated average cost to Office**
 - **Fee required for every 10 documents, or fraction thereof, submitted**
 - **Fee waived for a first submission of 3 or fewer total documents (if accompanied by required statement)**



AIA – 35 USC § 122(e) 3rd Party Submissions

- **Impact on Applicants**
 - **No duty for applicants to independently disclose documents submitted by 3rd party**



AIA – 35 USC § 122(e) 3rd Party Submissions

- **Impact on Examiners**
 - **Examiner considers 3rd party submission in the same manner as with IDSs**
 - **Documents considered will be printed on the patent**



Thank You

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