

THIRD PARTY SUBMISSIONS: THE FINAL RULE*

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EXECUTIVE SUMMARY

In its preferred usage, a “Third Party Submission” is a simple, electronically filed attack document submitted prior to the first Office Action. It (a) cites one or two relevant “printed publications”; and (b) includes a “*concise description* of the relevance” of that publication.

Anonymous Submissions: The identity of the real party in interest may be masked. Anyone – even someone not registered to practice – may make a Third Party Submission with no duty to disclose the true party in interest.

Explaining Already Cited Prior Art: The prior art *already cited by the applicant* may be explained in a manner that will lead to a rejection.

Internet Prior Art: An internet disclosure may constitute a “printed publication”; its prior art status can be explained by affidavits or declarations.

Intervening Prior Art before a Continuing Application Filing Date: Denial of priority for a continuing application may be explained to show why a foreign counterpart of the original application is a statutory bar.

Great Utility to Pin Down the Applicant to Specifically Defined Claims: Where a company is not *presently* marketing a product but wants to know the precise boundaries of the patentee’s claims, the Third Party Submission is a good way to pin the applicant down to specific boundaries. For example, the Third Party Submission may focus upon the unpatentability of one specific area within or near the claims: To maintain patentability, the applicant may either narrow his effective scope through arguments, creating an estoppel, or may even narrow the scope of claims to provide a clear blueprint how a competitor can design around a patent.

Uncertified machine translations of Relevant Portions: Translations into English must be provided, but only of the *specific pages or passages relied upon*. Translations need not be certified; a “reliable machine translation” is permitted.

Introduction

The *Third Party Submission Law* of the Leahy Smith Act offers an excellent vehicle for third parties to participate in certain situations with great advantage and minimal risk. Effective from September 16, 2012, the new law will be applicable *retroactively* for *any* pending patent application where the first action has not been issued.

The final regulations are published as *Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act; Final Rule*, 77 Federal Register 42150 (July 17, 2012). The new law is 35 USC § 122(e) in *Leahy Smith America Invents Act*, Public Law 112-29 (September 16, 2011), SEC. 8, *Preissuance Submissions by Third Parties*.

Optimum Use of the New System

In a preferred method, third parties will electronically submit from one to three “publications” for consideration by the Examiner. This can include both publications *already cited* by the applicant in the specification. Also possible are internet, e-mail and other tangible information disseminated to the public; hence, such a disclosure is a “printed publication” under the case law. The critical feature of the new law which makes it particularly attractive is requirement for a *concise description* of the relevance of the publication

Among the many valid uses of the Prior Art Submission Law, third parties will be able to –

- explain why the *applicant's cited* prior art (seemingly distinguished in the *Background of the Invention*) actually *is* highly pertinent; this can be done, for example, by demonstrating the broadest reasonable interpretation of claim 1 and then showing precisely how “claim 1” reads on that prior art (and is hence anticipated) or reads on subject matter very close to outer boundaries of the claim (which is hence rendered obvious);
- explain in a continuing application under 35 USC § 120 (including continuation, continuation-in-part or divisional) why a claim not supported verbatim in the parent application is *not* supported within the meaning of 35 USC § 112, ¶ 1, so that the published parent patent application constitutes a patent defeating anticipation under 35 USC § 102(b);
- cite an e-mail with an enabling disclosure of the invention addressed to a group of workers skilled in the art, without restriction, and explain why that e-mail *is* prior art under 35 USC § 102(b) because of the open circulation of the prior art without secrecy restrictions; and
- cite prior art that shows *KSR* factors such as “design need” which, taken together with prior art cited in the Background of the Invention, render the claimed invention obvious.

Helping the Examiner with his First Office Action

Perhaps the most important time to cite prior art and provide a concise description of that prior art is *just before* the Examiner issues his first Office Action. At this time, the Examiner has an open mind as he starts his examination. It is extremely helpful if one provides, say, one highly pertinent prior art reference and, say, one to three pages of discussion to explain why the claims should be construed to either read directly on that prior art or read directly on an embodiment that is obvious over that prior art.

The concise description should be entirely factual and not judgmental.

The concise description should simply lay out the facts to explain the scope of the claims and how the claims read on an unpatentable embodiment.

If there is any teaching reference needed to link the prior art to the claimed invention, then a second or third reference should be cited to provide any missing link.

The ideal concise statement will thus present a neutral exposition of the facts. If convincing, the Examiner may draft his entire Office Action based upon this concise description. His task in writing the first Office Action is over.

Prior Art Status of the Document need not be Identified

Publications may be cited which do not constitute “prior art”; furthermore, the citation does not need to indicate whether the publication is or is not prior art:

“Pursuant to 35 U.S.C. 122(e), “[a]ny 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.” The statute does not limit the publications that can be submitted to prior art publications. Accordingly, [37 CFR §] 1.290(a) does not require that publications be prior art in order to be considered by an examiner. Additionally, *the Office is not requiring a third party to indicate whether a listed document is or is not asserted to be prior art* because a mistake in complying with such a requirement could cause a submission to be found not in compliance with Sec. 1.290. The Office believes the benefit of such a statement is outweighed by the potential that the submission will be found not to comply should the Office disagree with the third party.”

Changes..., 77 Fed. Reg. at 42161, *Response to Comment 7* (emphasis added).

Limited Translations

The final rules provide a loophole to permit filing short translations of foreign language documents. If the third party submission is made *only* as to, say, page 213 of a 2000 word foreign language treatise, then only page 213 must be translated into English. Or, if, say, page 1121, lines 7-22, are cited within the treatise, then only such lines 7-22 would need to be translated.

The rule for limited translations is explained as follows:

Section 1.290(d)(1) provides for the listing of either entire documents or portions of documents, and Sec. Sec. 1.290(d)(3) and (4) require a copy and translation, respectively, of each item listed pursuant to Sec. 1.290(d)(1). Thus, *where only a portion of a non-English language document is listed, a third party must not submit a copy of the entire non-English language document. Rather, the third party must submit a copy of the listed portion of the non-English language document and a translation of only this portion.*” *Changes...*, 77 Fed. Reg. at 42158 (emphasis added).

Uncertified, even *Machine* Translations are Permitted

The final regulations are quite loose as to translation accuracy. An English translation need not be certified and even a “*reliable* machine translation” is acceptable. Thus, “Section 1.290(d)(4) requires an English language translation of any non-English language item identified in the document list. A translation submitted pursuant to Sec. 1.290(d)(4) may be a reliable machine translation and need not be certified.” *Changes...*, 77 Fed. Reg. at 42160

Avoid Lengthy “Concise description[s]” and Multiple Prior Art Citations

In theory, an unlimited number of prior art references may be cited. (A modest fee is charged with more than three citations of references.) To file a large number of references is only to accentuate the apparent *weakness* of the third party’s position. If anything, this will discourage the Examiner from adopting the position taken in the third party submission.

Even worse are lengthy “concise description[s]” of the prior art. This will also discourage Examiner usage of the results of the third party submission.

Anonymous Citations, Good or Bad?

Optimum third party submissions will be signed by persons *known to the particular Technology Center* as reliable, particularly if the true party in interest wishes to remain anonymous. Here, it is extremely important that a registered practitioner be employed, one known for his candor and fair statement of issues.

The reason for the need for an optimum spokesman for the third party submission is due to the complete failure of the final regulations to provide any constraints as to who may submit anonymous (or other) third party submissions.

There is no requirement of any kind that the submission is by a registered practitioner.

There is no requirement that the person making the submission is a resident of either the United States or a country with diplomatic relations with the United States such that a person making a false statement could be made subject of an extradition proceeding. Thus, for example, the third party submission could be written by “Mr. X” in Havana or Teheran or elsewhere, in a place where the party issuing the third party submission is under no control of the American authorities.

SPECIFIC ADVICE FROM THE PATENT OFFICE

e-mails, Internet Postings and other Non-“Publication” Prior Art

An e-mail, poster, microfilm or other forms of public dissemination are not “publications” in the sense of a printing press or Xerox copy, but such forms of public dissemination may qualify as a “printed publication” within the meaning of the patent law. Such non-“publication” publications *are* permitted to be cited under the new procedure:

“Section 1.290(a) does not limit the type of printed publications that can be filed as part of a compliant submission. Litigation papers and court documents not subject to a court-imposed protective or secrecy order can be submitted for consideration and entry under Sec. 1.290(a) if they qualify as publications. See MPEP Sec. 2128. Documents that are subject to a court-imposed protective or secrecy order, documents that include trade secret information, unpublished internal documents, or other non-patent documents that do not qualify as publications should not be submitted for consideration and entry under Sec. 1.290(a).” *Changes...*, 77 Fed. Reg. at 42162, *Response to Comment 8*.

Third Party Evidence of Publication

For an internet posting or other non-traditional “publication” where the date of publication is not apparent, the third party should (a) submit evidence that the document is a “publication” under the law; (b) provide a date certain when the document became a “publication” through public availability; and (c) may use affidavit evidence to establish (a) and/or (b). Thus:

“A [proper] submission pursuant to Sec. 1.290 requires that all documents for consideration and inclusion into the file of an application be publications. Thus, Sec. 1.290(e)(4) requires a third party to provide evidence of publication where the publication date of a document is not known, regardless of whether the document is asserted to be prior art. As a result, ***third parties making such a submission must either submit documents that are prima facie publications or evidence that establishes that they are publications.*** The Office is not requiring specific types of evidence to prove publication, but where the actual publication date of a non-patent document is not known, ***a third party should, at a minimum, provide a date of retrieval or a timeframe (e.g., a year, a month and year, a certain period of time) when the document was available as a publication*** for purposes of identifying the document by publication date pursuant to Sec. 1.290(e)(4), in addition to including evidence that establishes the document as a publication. In such situations, ***the evidence that may be submitted by a third party includes affidavits or declarations, or may be present on the copy of the document itself submitted pursuant to Sec. 1.290(d)(3).***”
Response to Comment 9, Changes..., 77 Fed. Reg. at 42162

Publications to Establish Relevance of Already Cited Prior Art

“[Public] comments requested clarification as to whether the proposed rules allow submissions and descriptions of relevance in connection with patents, published patent applications, or other printed publications that are already of record in a patent application.” *Comment 10, , Changes...*, 77 Fed. Reg. at 42162

The Office *will* accept such publications:

“The statute does not limit submissions to publications that are not already of record in a patent application. Accordingly, new Sec. 1.290 does not place this limitation on the publications that can be submitted. As a result, third-party submissions pursuant to Sec. 1.290 can include patents, published patent applications, or other printed publications that are ***already of record in an application*** where the submission is otherwise compliant.” *Response to Comment 10, , Changes...*, 77 Fed. Reg. at 42162 (emphasis added).

“Argument” Documents Prepared After the Filing Date

A third party who submits a document that was prepared to attack patentability will be *denied* entry:

“[S]ubmission of documents drafted after the application was filed solely to contest patentability may result in non-entry of an entire third-party submission. *** [T]he concise description of relevance of a document, which was prepared by a third party after an application was filed solely to contest the patentability of the application, would likely be deemed an improper attempt by the third party to impermissibly participate in the examination of the application because the relevance of the document being described is its discussion of the patentability of the application. As a result of the improper concise description, *the entire third-party submission that includes such document would not be entered.*” Response to Comment 15, *Changes...*, 77 Fed. Reg. at 42163 (emphasis added).

Concise Statements, How Long Can that Be?

The ideal third party submission will be *very short* and easy for an Examiner to digest and understand. Nevertheless, in theory, longer submissions will be entered into the file:

“Examiners will consider documents and concise descriptions of relevance submitted in compliant third-party submissions in the same manner that examiners consider information and concise explanations of relevance submitted as part of IDSs in patent applications. Generally with the next Office action following the entry of third-party submission, a copy of the third party's listing of documents, with an indication of which documents were considered by the examiner, will be provided to the applicant.

The indication that a document has been considered by the examiner will mean that the examiner has considered both the listed document and its accompanying concise description. The examiner will apply the information in a compliant third-party submission as the examiner deems necessary, but will not be expected to comment on each submitted document and concise description of relevance.

“Parties should keep in mind that examiner consideration of a document and its accompanying concise description of relevance does not mean that the examiner agrees with the third party's position regarding the document, only that the examiner considered the publication and its accompanying description.

For example, a third party might assert that a particular document is prior art but the examiner might determine that the assertion is incorrect in view of the application's earliest effective filing date. In such a situation, the examiner will still consider the document and the concise description of relevance even though the examiner determined that the document is not prior art .”

Response to Comment 16 Changes..., 77 Fed. Reg. at 42163 (emphasis added).

Standard for Submission: “Potential Relevance”

A document may be submitted if it meets the standard of “potential relevance to the examination of the application”. Thus:

“The standard under Sec. 1.290(a) for the documents submitted to be of “potential relevance to the examination of the application” is specified by 35 U.S.C. 122(e)(1). This standard requires the submitter to believe the documents being submitted are relevant to the extent that the submitter can provide the statutorily required concise description of the asserted relevance of each document submitted.”

Response to Comment 18, Changes..., 77 Fed. Reg. at 42163 (citing 35 U.S.C. 122(e)(2)(A)).

Affidavits and Declarations

Affidavit evidence may be used to establish facts such as evidence to establish a date of publication. But, affidavits may not be used as the “concise statement”. The distinction is seen from two different parts of the rulemaking notice:

First, the *proper* use of an affidavit or declaration involves establishing a publication date:

“[T]hird parties making [] a submission must either submit documents that are prima facie publications or evidence that establishes that they are publications. ...[A] third party should, at a minimum, provide a date of retrieval or a timeframe (e.g., a year, a month and year, a certain period of time) when the document was available as a publication for purposes of identifying the document by publication date pursuant to Sec. 1.290(e)(4)... [T]he evidence that may be submitted by a third party includes affidavits or declarations....” *Response to Comment 9, Changes...*, 77 Fed. Reg. at 42162.

The improper use of an affidavit or declaration as part of a “concise statement” is explained in the commentary:

“35 U.S.C. 122(e) provides for the submission of evidence in the form of patents, published patent applications, and other printed publications. A concise description of relevance for a submitted document is not considered evidence but, rather, a statement of facts regarding the submitted evidence. Accordingly, the Office will not consider a declaration as evidence, where such declaration is submitted as a concise description of relevance for a document. Third parties relying on declarations as concise descriptions of relevance should ensure the concise description of relevance does not amount to an attempt at third-party

participation in the examination of the application.” *Response to Comment 21, Changes...*, 77 Fed. Reg. at 42164

Anonymous Third Party Submissions

One of the most controversial provisions of the proposed rules was that submissions can be made anonymously. This provision is *maintained* in the final rulemaking with the following explanation:

“[T]he Office believes there is no need for applicants in general to address third-party submissions. The examiner will review the submissions, and should an issue arise where information from the applicant is desired, the Office will frame the issue and request information from the applicant under Sec. 1.105. Such requests are envisioned to be rare and limited in scope and therefore well within the ability of any applicant to reply, including small start-up companies.

“Additionally, the Office believes that providing anonymity would encourage small entity third parties to submit prior art. Without such anonymity, there are situations where potential third-party small start-ups would be hesitant to make a third-party submission, such as where the third party would be concerned with damaging a valuable relationship with the larger applicant. Anonymity helps small start-ups in supplying prior art against applications submitted by large entities (not necessarily competitors) with whom they may have a relationship.”

Electronic Filing is the Best Practice (but Optional)

“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).” *Changes...*, 77 Fed. Reg. at 42151. “When filing a third-party submission electronically, a third party will receive immediate, electronic acknowledgment of the Office's receipt of the submission.” *Changes...*, 77 Fed. Reg. at 42152. Electronic filing is encouraged by the Office: “Electronic filing via the dedicated Web-based interface will be the most efficient means of making

compliant third-party submissions available to an examiner for consideration, as compliant third-party submissions filed in paper will experience a delay in entry due to the additional processing required for scanning and indexing of paper submissions into electronic form. Additionally, third parties filing third-party submissions electronically via the dedicated Web-based interface will receive immediate, electronic acknowledgment of the Office's receipt of the submission, instead of waiting for the Office to mail a return receipt postcard when provided with a paper submission.” *Id.*

First Class Mail Submission: Permitted but Clearly *not* Preferred

First class mail submission is also permitted. *Changes...*, 77 Fed. Reg. at 42151-52.

Fax Submission is *NOT* Permitted

Fax filing is prohibited. *Changes...*, 77 Fed. Reg. at 42152 (“Facsimile transmission of third-party submissions is not permitted. See 37 CFR 1.6(d)(3).”)

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37 CFR § 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 [37 CFR §] 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 [37 CFR §] 1.211, or

(ii) *The date the first rejection* under [37 CFR §] 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;

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(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 [37 CFR §] 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 [37 CFR §] 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 [\$ 180.00] fee set forth in [37 CFR §] 1.17(p) for every ten items or fraction thereof identified in the document list.^[*]

^[*]37 CFR § 1.17(p): “Patent application and reexamination processing fees. *** ...[F]or the document fee for a submission under [37 CFR §] 1.290 –\$ 180.00.”

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(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 [37 CFR §] 1.8 do not apply to the time periods set forth in this section.