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## 9 Tips For 3rd-Party Prior Art Submissions

Law360, New York (August 20, 2012, 1:04 PM ET) -- The U.S. Patent & Trademark Office recently issued the final rules on third-party prior art submissions at 77 F.R. 42150 (2012). Previously, third-party submissions of prior art in a patent application were limited to a two-month window after a patent application was published. But the final rules, enacted as part of the recent America Invents Act legislation, expand this time window.

### Timing

For most patent applications, a third-party prior art submission can now be filed before the first Office Action is mailed. In cases where the USPTO examines a patent application quickly, such submissions can be filed within six months of publication. The USPTO will not consider any submissions after the notice of allowance.

Effective Date: These submissions can be filed starting Sept. 16, 2012. The submissions may be filed in any pending application.

### Requirements

These submissions may be done anonymously and can be submitted electronically. The submissions must include: (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 translation of any non-English language item listed; (5) a statement that the submission complies with the statutory provision; and (6) the required fee (\$0 if fewer than three-documents submitted for a first submission, \$180 otherwise).

The submissions will be screened for these requirements and if not compliant, the submission will not be entered in the application. The third party is not required to serve the applicant with a copy of the submission.

### Results

The examiner is required to consider compliant third-party submissions in preparation for the next Office Action. The documents in the submission will be listed on the face of the issued patent, if considered by the examiner.

### Strategies

When preparing third-party prior art submissions, keep the following practice tips in mind.

#### *Quality Art*

The best submissions will contain on-point, relevant prior art. Examiners will likely not review submissions containing nonrelevant or cumulative prior art. So, unlike the typical practice of citing prior art in an Information Disclosure Statement, it is helpful to review the prior art and make a judgment call on the relevance before submitting it.

### *Be Concise*

The explanation of the relevance of each item should contain only enough information to point the examiner to the pertinent disclosure in the prior art. Additional explanations will not only waste time and costs, but will most likely be ignored by the examiner.

### *Submit Electronically*

The EFS-WEB system will be modified to allow submissions to be filed electronically. Indeed, the EFS-WEB system will be modified to contain a specific category under which these submissions must be submitted, else they will be deemed non compliant. In the event any submission is deemed non-compliant by the USPTO division created to screen them, the third party will be notified electronically if an email address is provided.

### *Limited Submissions*

Each submission is limited to 10 items of prior art. Multiple submissions (each of up to 10 items) can be made, as long as a fee is paid for each submission. So cumulative prior art is best avoided for cost reasons. It also makes for a less concise submission.

### *Explaining Known Art*

Rather than submitting new prior art, a third party may re-submit existing prior art of record in the file, along with an explanation of additional information in that prior art. In most instances, that additional information might explain a point of view not considered by the examiner. As well, this additional information might point to parts of the prior art not discussed in any rejection and reply.

### *Scope*

The submission can be especially useful for limiting and defining the scope of the claims. If properly presented, the submission can explain the prior art in such a manner that regardless of whether that prior art reference is relied on by the examiner, the disclosure in the prior art can be used when construing the claims.

### *Other Questions of Patentability*

The submission can include any published document relevant to the examination of the application. In other words, the submission need not be restricted to merely issues of novelty and obviousness. Accordingly, if a published document (which would arguably include a court decision) has bearing on issues that can be raised under 35 U.S.C. § 101 or 35 U.S.C. § 112, it can — and should be — submitted to bring such issues to the attention of the examiner.

### *Applicant Submissions*

If third-party submissions containing prior art are deemed non-compliant, they are not supposed to be entered into the record. But if an applicant is somehow made aware of non-compliant submissions, that applicant should submit that prior art via an Information Disclosure Statement

to avoid any claim of inequitable conduct during litigation.

### *Competitive Monitoring*

These third-party prior art submissions will require increased monitoring programs of competitors' published applications so that they can be submitted timely and effectively. So factor the additional resources needed for this competitive monitoring into your management programs.

--By Kenneth E. Horton, Kirton McConkie PC

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