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Mail Stop Comments - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By Email

Attention: Nicole D. Haines

Re: Request for Comments on Proposed Rules for Preissuance Submissions by Third Parties

Dear Ms. Haines:

Oliff & Berridge, PLC is a private intellectual property law firm that files and prosecutes thousands of patent applications each year on behalf of a wide range of U.S. and foreign applicants. Its practice before the U.S. Patent and Trademark Office (USPTO) provides a perspective and depth of experience necessary to provide the following comments regarding the proposed rules.

First, we would like to commend the USPTO on its efforts to enhance quality and efficiency in its operations. With the many impending changes brought by the America Invents Act (AIA), we appreciate that the USPTO has chosen to move forward in a spirit of communication and cooperation with the applicant community to produce rules that effectively and efficiently carry out the intent of the AIA and "promote the progress of science and the useful arts."

Our concerns, as well as our recommendations for addressing those concerns, are detailed below.

A. Relationship to Duty of Disclosure Under Rule 1.56

We recommend eliminating any suggestion from the USPTO's commentary that actions of the USPTO, such as eliminating the submitter's notice requirement, "underscor[es] that such third-party submissions will not create a duty on the part of applicant to independently file the submitted documents with the Office in an information disclosure statement (IDS)." 77 Fed. Reg. 450, col. 1. Such language is unnecessary, and could be interpreted as waiving applicants' duty under Rule 1.56 to disclose material references of which they are aware. The proposed rules take steps not to trigger applicants' duty under Rule 1.56, which we applaud. However, applicants' duty under Rule 1.56 cannot be waived by rule. We provide the following suggestions to help the USPTO further ensure that applicants' duty under Rule 1.56 is not triggered.

Applicants cannot be required to submit references of which they are not aware. Thus, references submitted by third parties that are not conveyed to applicants by the third party and not ultimately added to the file wrapper would not create a duty under Rule 1.56. In this regard, the proposed rules try to prevent third parties from directly triggering applicants' duty under Rule 1.56 by not requiring the third party to provide applicants with notice. However, third-party submissions that are added to the file wrapper and not ultimately considered, in whole or in part, by the Examiner will create a duty for applicants to disclose any material unconsidered references that they review. The USPTO attempts to address this situation by reviewing third-party submissions for compliance before they are added to the file wrapper, which is a good first step. However, more can be done.

The USPTO should ensure that all submissions that are placed in the file wrapper will be considered by Examiners. The proposed rules first require review of submissions for compliance with the rules before they are placed in the file wrapper, and then Examiners acknowledge consideration of third party submissions in the same manner that they currently acknowledge consideration of references submitted by applicants in Information Disclosure Statements. *See* 77 Fed. Reg. 450, col. 2. However, in this proposed system, there is still the possibility that third-party submissions could pass the initial review, be placed in the file wrapper, and the Examiner could then refuse to consider the references for failing to comply with some formality that was not caught by the initial review.

As stated above, such non-considered references could place a duty on applicants under Rule 1.56 to re-submit the non-considered references, thereby effectively requiring applicants to correct the third-party submitters' errors and the USPTO's faulty initial review. Such a situation places an undue burden on applicants, particularly small entity applicants with limited resources, to ensure that the references in the third-party submission are ultimately considered by the USPTO. The USPTO could ease applicants' burden by requiring a thorough initial review to ensure that the references can be considered by Examiners, and by requiring Examiners to consider all references that pass the initial review and are placed in the file wrapper. Such a requirement should not place much additional burden on the USPTO because it already plans to review all submissions before they are placed in the file wrapper. Thus, such a requirement will merely require the initial review to be thorough enough that it ensures Examiners will be able to consider the submitted references.

Finally, the proposed rules require the third-party submitter to provide a concise description that points out relevant portions of the submitted references. *See* 77 Fed. Reg. 452, col. 2. However, if only portions of the submitted documents are cited in the concise explanation, applicants may have a duty under Rule 1.56 to submit to the USPTO any other portions that may be material to patentability.

The above duty is compounded when the document submitted by the third party is not in the English language. The proposed rules only require a translation of any relevant portion of non-English language documents. *See* 77 Fed. Reg. 452, col. 2. If the third party submits a non-English language document but translates only a portion of it, applicants may have a duty under Rule 1.56 not only to submit other portions of the documents that may be material to patentability, but also an English-language translation or explanation of relevance of those other portions. Requiring the submitter to provide a translation of all the portions of a document that are submitted, with a translator's certification that the translation is accurate and complete, would reduce applicants' burden and avoid triggering of the duty of disclosure for applicants. If the third party does not want to translate the entire document, it can redact the non-translated portions of the submission.

B. Interpretation of "First Published"

The commentary states, "where the Office republishes an application due to material mistake of the Office pursuant to 37 C.F.R. 1.221(b), the date on which the application is republished will be considered the date the application is 'first published by the Office.'" 77 Fed. Reg. 451, col. 3. This portion of the commentary is in direct conflict with both reality and the express language of the AIA.

The AIA states that third-party submissions may be made, "6 months after the date on which the application for patent is first published under section 122 by the Office." The commentary recognizes a distinction between §122(c) that recites "publication of the application" and §122(e) that recites "first published." However, the interpretation that "first published" includes applications republished under 37 C.F.R. §1.221(b) gives no meaning to "first." More particularly, if second or subsequent republications under §1.221(b) can qualify as "first published," the "first" modifier in 35 U.S.C. §122(e) would have no meaning under the proposed definition.

In addition, third-party submitters will likely not be aware that a republication is forthcoming, and thus they will submit or withhold references based on the date of the initial publication. Allowing third-party submitters additional time if a patent application is republished under §1.221(b) will give a windfall of time for third-party submitters to file references and possibly delay submissions from receiving timely consideration before a first Office Action is mailed. Further, once an application is published, the public has access to the file wrapper through the Patent Office's PAIR system. Thus, the public can review the application as filed whether or not the application was published in error. Accordingly, we do not believe that third-party submitters will be negatively effected by considering that applications that are republished under §1.221(b) are not "first published under section 122." Therefore, we recommend amending the rules to indicate that applications that are republished under §1.221(b) do not qualify as "first published under section 122," at least because this is consistent with the wording of the AIA and will more timely provide the USPTO with preissuance third-party

submissions. Thus, we believe that the rules should not consider republished applications as "first published under section 122."

The proposed rules further state that the time period will not be initiated by a publication by the World Intellectual Property Organization (WIPO). *See* 77 Fed. Reg. 451, col. 3. This is in direct conflict with statutory mandates. For example, 35 U.S.C. §363 and §374 require that international patent applications and patent publications designating the United States are to be treated as applications filed in the USPTO and as publications under §122(b). Accordingly, any rule that does not consider international publications as initiating the time period for making third party submissions violates 35 U.S.C. §363 and §374. While we understand and appreciate that permitting publications by WIPO to initiate the period for third-party submissions will result in the lapse of the six-month period from publication to submit references in most PCT applications before they enter the National Stage, only Congress can change the requirements of 35 U.S.C. §363 and §374, which it did not do in pertinent part when enacting the AIA. The USPTO should encourage Congress to provide exceptions for §122(e) in 35 U.S.C. §363 and §374 if it believes that international publications should not initiate the six-month period for filing third-party submissions. Thus, we believe that the rules or associated commentary should make clear that international patent publications by WIPO do initiate the six month period for filing a third party submissions to comply with 35 U.S.C. §363 and §374.

C. Notification of Submissions by the USPTO

The proposed rules do not have a mechanism in place for notifying applicants when a third-party submission is placed in the file wrapper. Rather, according to the proposed rules, applicants will only be notified that a third-party submission has been made when the first office action is received that indicates whether the Examiner considered the submitted references. This proposal places an undue burden on applicants to monitor their applications for third-party submissions before an office action is received, and will prolong prosecution by not providing applicants with notice that will better allow applicants the opportunity to review the references submitted by a third party and make any necessary amendments.

Applicants should be notified when a third-party submission has been placed in the file wrapper. Applicants should be given every opportunity to review the references challenging the patentability of their application as early as possible without having the undue burden of continuously monitoring their applications' file wrappers for submissions by third parties. For large entities with many applications, the extensive monitoring that would be required could unnecessarily occupy entire departments and place further financial burdens on already struggling organizations. For small entities with limited resources, monitoring their application(s) will impose an unnecessary investment in both time and money that they can little afford.

Further, notifying applicants that a third-party submission has been placed in the file wrapper of their application will place little or no additional burden on the USPTO. The USPTO is already working on the file and must make, and document, a decision to enter a third-party submission. Sending that documentation to applicants, especially by email, would involve little or no additional burden. The USPTO already has a notification system in place that notifies applicants, or their representatives, when a communication has been placed in an application file wrapper. The USPTO need only make a decision to use this system for third-party submissions.

The President has issued an Executive Order directing each organization under the executive branch to "tailor its regulations to impose the least burden on society, consistent with obtaining regulatory objectives, taking into account, among other things, and to the extent practicable, the costs of cumulative regulations." Executive Order 13563 of January 18, 2011, "Improving Regulations and Regulatory Review," 76 Fed. Reg. 3821. Relieving applicants of the burden of constantly monitoring their applications until a first Office Action issues or six months after publication, whichever is later, falls squarely into the President's Executive Order, particularly when the USPTO already has the technology available to provide applicants with notification.

Such notification would also not trigger applicants' duty under Rule 1.56 because the third-party submission has already been reviewed and should be compliant with the rules. Thus, the references in the third-party submission should be considered by the Examiner and should not need to be re-submitted by applicants. Particularly, if the USPTO institutes a requirement that Examiners consider all third-party submissions that pass the initial review and are placed in the file wrapper, applicants would be assured that such notification would not trigger their duty under Rule 1.56.

Last, but certainly not least, providing applicants with notification that a third party submission has been made in their application will help shorten prosecution. If applicants are timely notified of a third-party submission, they will have the opportunity to review the references and file claim amendments or arguments, if necessary, before the Examiner issues a first office action, thus eliminating a possible rejection and furthering prosecution before the first office action is even issued. If applicants are not provided with timely notification of third-party submissions, the likelihood that claim amendments or arguments will be timely filed before a first office action will be decreased, and prosecution will be prolonged.

For at least the above reasons, providing applicants with notification when a third-party submission is placed in the file wrapper benefits both applicants and the USPTO. Accordingly, we suggest that the USPTO send applicant a notification when a third-party submission is entered in the file wrapper.

D. Fee Exemption

We believe that waiving the fee for first submissions by a third-party may lead to abuse that overburdens the USPTO. Requiring a fee could deter such abuse. The proposed rule allows third-party submissions to be made without paying the corresponding fee if three or fewer references are submitted and the individual(s) signing the submission includes a statement that, after reasonable inquiry, the submission is the "first and only" submission made by the third party or a party in privity with the third party. 77 Fed. Reg. 453, col. 2. However, we believe that a fee is necessary to deter abuse.

The reasoning for including the "first and only" language is to prevent third parties, or parties in privity with the third parties, from submitting multiple submissions claiming benefit to the fee exemption on the same day. Fed. Reg. 453, col. 2. However, there is no mechanism for enforcement regarding the statement. *Id.* Although the proposed rules assert that 18 U.S.C. 1001 and Rule 11.18(b) are applicable for practitioners and non-practitioners and would cover statements under §1.290(g), without some mechanism for challenging the validity of the statements under those provisions there is no practical way of policing the validity of statements under §1.290(g). Thus, a fee is a simple and effective way to deter multiple submissions and gamesmanship.

Further, the statement under 1.290(g) requires the submission to be the first by a third party or a party in privity with the third party. However, determining whether privity exists between submitters and third parties will be difficult. Individuals could also act in concert without being in privity. For example, if a blogger wants to prevent patenting of some politically sensitive technology (e.g., contraceptive technology, stem cell technology, or many others), and encourages like-minded individuals to file references, there would be no privity between the submitters, and the USPTO could be flooded with thousands of submissions in any given application or even art unit. A fee would deter such activities.

E. Unnecessarily Burdensome Requirements

At least two provisions of the proposed rules make requirements that will provide the USPTO with little benefit while creating an administrative burden for the submitters.

First, the proposed rules require that each page of the third-party submission include the application number to which the filing is being directed. *See* 77 Fed. Reg. 452, col. 1. For electronic filings, this requirement is completely unnecessary because the electronic documents are submitted as a single file. Even with paper submissions, the pages of each document should be bound together. Thus, identifying to which application a submission is directed should not be an issue regardless of this requirement. This proposed requirement places an administrative burden on the submitter without providing the USPTO with much, if any, benefit. Also, this requirement could result in submissions being found non-compliant for not having the

application number on one page. Therefore, we recommend changing the language of the proposed rule to state that each submission must include on its cover the application number of the application to which the filing is directed.

Second, the proposed rules require the submitter to identify the first named inventor for foreign patents and published foreign patent applications. *See* 77 Fed. Reg. 452, col. 3. Not all foreign references have this information listed, and transliterations of names often vary. Thus, this requirement places a burden on the submitter to uncover the identity of the first-named inventor. In addition, applicant-submitted information disclosure statements do not currently require the first-named inventor for foreign applications. Thus, we do not believe that identification of the first-named inventor should be required, and the proposed rules should be modified to remove this requirement.

F. Submissions by Individuals with Duty to Disclose

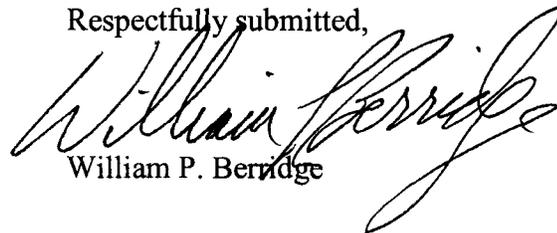
The proposed rules state that the submitter must make a statement that the party making the submission is not an individual with a duty to disclose information. *See* 77 Fed. Reg. 452, cols. 2-3. However, we believe that this statement is incomplete. For example, it appears as though someone in privity with an individual with a duty to disclose could make that statement and submit references as a third-party submission. Thus, we believe that the statement should be amended to include an individual who has a duty to disclose or is in privity with an individual who has a duty to disclose.

G. Clarification

The proposed rules state, "Further, while a third party would be permitted to cite different publications that are all available from the same electronic source, such as a Web site, each such publication would be counted as a separate document." *See* 77 Fed. Reg. 453, col. 1. While it is clear that an electronic journal article would be a separate document from a different electronic journal article posted by the same web site (for example the journal's website), this language is unclear as to whether each page of a single web site would necessarily constitute a separate document. For example, if a single website has two pages linked together for the same topic, would these two related pages be considered two documents? We request that the USPTO provide more explicit commentary on what is considered a separate document on a web site.

The proposed rules also allow applicants to submit affidavits and declarations as evidence of the date a document was published. *See* 77 Fed. Reg. 451, col. 3. However, it is unclear whether declarations, such as expert declarations, are permissible as the concise description of a document. Only patents, published patent applications, and other printed publications may be submitted under §122(e). Thus, we do not believe that declarations, such as expert declarations, should be permitted because it would provide testimonial evidence on the record regarding a document that applicants could not readily contest during prosecution. Applicants cannot easily challenge the declarant, or even the party that submitted the declaration, during prosecution. Thus, we recommend that the rules explicitly exclude declarations as concise explanations.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William P. Berridge", written in a cursive style.

William P. Berridge

WPB:NAB/hs