

Comment on Proposed Rules for Third Party Preissuance Submissions

The *Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act* provides a means for third parties to contribute to the quality of issued patents by submitting relevant publications to the Patent Office prior to issuance of a patent. The apparent policy reasoning behind the provision is that third parties will be able to help improve the quality of patent examination by providing insight and information that may otherwise go unnoticed by the examiner. Ideally, the result will be issuance of higher quality patents.

The Concise Description Requirement Should be Easily Satisfied and the Number of Submissions by a Single Party Should be Limited

Under the *Preissuance Submissions by Third Parties Provision*, third parties will be allowed to submit relevant prior art publications that must be accompanied by a “concise description of the asserted relevance of each submitted document.” *See* 35 USC § 122(e) as amended in accordance with the *Leahy Smith America Invents Act*. The United States Patent and Trademark Office (“the Office”) has indicated that “unless there is no concise description provided for a document that is listed, or the concise description is merely a bare statement that the document is relevant and thus does not amount to a meaningful concise description, the Office does not propose to otherwise evaluate the sufficiency of the concise description.” *See Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act* (Notice of proposed rule making), 77 Federal Register 448, at 452 (January 5, 2012). Although a quick review process is necessary to avoid long delays in making valid submissions available to the examiner, the review process must also be sufficient to avoid an inundation of documents from a single third party where the concise description requirement is easily satisfied. It is necessary for the concise description requirement to be easily satisfied to encourage third parties to participate. Thus, rather than attempt to implement a more thorough review process that would increase costs, result in delays, and may discourage third parties from submitting references altogether, the USPTO should amend the proposed rules to limit the number of submissions that a single party (or parties in privity) may submit. Such a policy

would allow submissions to be quickly reviewed and entered into examination without enabling malicious users to overwhelm the process with excessive submissions. The fee structure as proposed that would charge an additional fee for every ten documents submitted is satisfactory, and may mitigate malicious submissions. However, the fee structure alone may not go far enough to dissuade an unfriendly third party from making extensive submissions, where the third party is allowed to remain anonymous.

Applicants Should Be Immediately Notified of a Third Party Submission

The Office states that it does not “intend to directly notify the applicant upon entry of a third party preissuance submission. However, the contents of a compliant third-party preissuance submission will be made available to the applicant via its entry in the [image file wrapper] of the patent application.” *Id.* At 450. The Office goes on to state, “Generally with the next office action, a copy of the third party’s listing of documents, with an indication of which documents were considered by the examiner would be provided to the applicant.” *Id.* Therefore, it appears that an applicant will not be notified of a third party submission until the next office action, and absent scrutiny of the examiner’s prior art listing documents, the applicant may remain unaware of the third party submission altogether.

Instead of delaying notification of the applicant, the Office should adopt a policy of immediately notifying the applicant upon submission of prior art by a third party. Such a policy would serve several purposes. First, upon notification of a third party submission, the applicant could choose to take immediate action such as filing a preliminary amendment. Such an immediate action would improve the efficiency of examination. Second, the concise statement submitted by the third party and available in the file wrapper would assist the applicant in crafting higher quality claims and may explain the prior art reference in a manner not clearly articulated by the examiner during examination. Third, at the time of entry of the third party submission, the applicant may have filed, or may plan to file, a continuation application or other related application. Therefore, the applicant may be required or may desire to immediately file an information disclosure statement (IDS) in the related cases to include the prior art submitted by the third party. Such IDS submissions would improve the efficiency and quality of, not only the present application, but the entire family of applications. Thus, the overall policy benefits of

allowing third party submissions would be amplified by immediately notifying an applicant of third party preissuance submissions.

Anonymity

The Office states that it “does not propose to require an explicit identification of a real party in interest because such identification might discourage some third parties from making a preissuance submission or invite challenges based on allegations of misidentification.” *Id.* at 453. It’s clear that anonymity is critical to success of the *Preissuance Submissions by Third Parties Provision*. Therefore, the Office should state explicitly in the language of the rules that identification of the real party in interest is not required.

Two policies are served by guaranteeing that the anonymity of third party submitters is protected. First, third parties will be more likely to submit relevant art if they do not fear retaliation. If an applicant were to become aware that a third party had submitted prior art against an application, the applicant may attempt punitive action against the third party such as suing them based on already issued patents or attempting to harm them economically. Second, it follows that a third party concerned enough to submit prior art against a patent application may also be a potential infringer of the patent should it issue. Thus, identification of a third party would likely cause the applicant to later aggressively target the third party for patent infringement should the identity of the submitter be made known to the applicant. A failure to protect anonymity may result in a cooling affect on third party submissions to the patent Office, because submitters may fear becoming a target of the applicant. Therefore, the rules should be amended to expressly state that the real party in interest need not be identified.

Additionally, the Office should adopt a policy of protecting the identity, not only of the real party in interest, but of a submitter who is a representative of a real party in interest. For example, if an applicant became aware the name of the law firm that made a preissuance submission, the applicant may be able to deduce the identity of a client known to be represented by the law firm. For the same policy reasons described above with regard to protecting the identity of the real party in interest, the identity of representatives should also be kept hidden, at least from the applicant.

Sample Documents

It is unclear exactly how much and what information about a third party submitter would be provided to an applicant, or in what form that information would be published. Therefore, it is recommended that the Office publish sample submission documents, sample image file wrapper documents, and sample listing documents (as would be provided with an office action). This would help third parties and applicants better understand and gain confidence in the process. Preferably, the sample documents would be made available well before the *Preissuance Submissions by Third Parties Provision* takes effect on September 16, 2012.

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