

Preissuance Submissions

General

Question PS1100: What is the effective date for the preissuance submission provision in the AIA?

The effective date for the preissuance submission provision in the AIA is September 16, 2012.

Question PS1200: Who may file a preissuance submission?

Any member of the public may file a third-party submission, including private persons and corporate entities. However, the third party may not be the applicant or any individual who has a duty to disclose information with respect to the application under § 1.56.

Question PS1300: What can a third party file in a preissuance submission?

A third party may file any patents, published patent applications, or other printed publications of potential relevance to the examination of a patent application.

Question PS1310: Is an examiner reluctant to apply prior art from a third party submission as opposed to applying prior art identified from his/her own search?

No, an examiner is motivated to apply the best prior art available to make a rejection, regardless of whether the examiner or a third party found the prior art.

Filing a Preissuance Submission

Question PS2100: When can a third party make a preissuance submission in a patent application?

A third-party preissuance submission statutorily must be made in a patent application before the earlier of: (a) the date a notice of allowance under 35 U.S.C. 151 is given or mailed in the application; or (b) the later of (i) six months after the date on which the application is first published under 35 U.S.C. 122 by the Office, or (ii) the date of the first rejection under 35 U.S.C. 132 of any claim by the examiner during the examination of the application.

Question PS2200: How can a third party file a preissuance submission?

Third parties are encouraged to file third-party submissions electronically through the Office's dedicated web-based interface for third-party submissions, which can be accessed via EFS-Web. Submissions may also be submitted in paper through first-class mail, United States Postal Service (USPS) Express Mail service pursuant to 37 CFR 1.10, or by hand delivery. However, processing delays will be associated with paper submissions due to the scanning and indexing of these papers by the Office. Third-party submissions may not be filed by facsimile.

Question PS2300: In what types of applications may a third party file a preissuance submission?

A third party may file a submission in any non-provisional utility, design, or plant application, as well as in any continuing application, even if the application to which the submission is directed has been abandoned or has not been published. Third-party submissions may not be filed in any issued patent, reissue application, or reexamination proceeding.

Question PS2400: When filing a preissuance submission electronically via the dedicated third-party submission EFS-Web interface, how does a third party enter an older patent with a serial number earlier than 4,000,000?

The Office does not keep electronic records for older patents having a serial number earlier than 4,000,000. Therefore, older patents cannot be verified against the USPTO database and the First Named Inventor and Issue Date fields cannot be automatically populated. Accordingly, when entering a patent number less than 4,000,000, manually complete the Issue Date and First Named Inventor fields after clicking the "OK" button on the pop-up warning.

Content of a Preissuance Submission

Question PS3100: What items must be included in a preissuance submission?

There are several items that must be included for a compliant preissuance submission:

1. Form PTO/SB/429 (or equivalent document list), identifying the publications, or portions of publications, being submitted [NOTE: use form PTO/SB/429 for paper submissions only; a completed form PTO/SB/429 will be automatically generated for electronic submissions];
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;
4. An English language translation of any non-English language item identified in the document list;
5. Statements 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 § 1.56; and
 - ii. The submission complies with the requirements of 35 U.S.C. 122(e) and § 1.290; and
6. Any required fee, or the statement that the fee exemption applies to the submission.

Question PS3200: Is it an absolute requirement to include form PTO/SB/429 with a preissuance submission?

No, but it is highly recommended for paper submissions. Use of form PTO/SB/429 will help to ensure that important requirements are not overlooked, such as the document listing requirements and the required statements pursuant to § 1.290(d)(5). The form PTO/SB/429 will also enable the third party to indicate whether a fee is due or to select the “first and only” statement where the fee exemption applies.

Use of this form will not be necessary for preissuance submissions filed electronically via the Office’s dedicated Web-based interface for preissuance submissions, as this interface will prompt the third party to complete the fields that are provided on the form and will automatically format the entered information into an electronic version of the form PTO/SB/429 for electronic submission.

Question PS3300: How should a third party request that the Office provide notification if a preissuance submission is non-compliant?

If filing electronically via the dedicated Web-based interface in EFS-Web, the request must be made on the “Applicant Data” screen under the heading “REQUEST FOR NOTIFICATION REGARDING THIRD PARTY PREISSUANCE SUBMISSION.” Check the box requesting the notification and enter an email address in the box provided. The email address will not be made of record in the application should the submission be deemed compliant.

If filing in paper, the request must be made on a separate sheet of paper. The paper should be clearly titled “REQUEST FOR NOTIFICATION REGARDING THIRD PARTY PREISSUANCE SUBMISSION” and identify the email address to which the notification should be directed. This separate paper must be clearly labeled so the paper is not made of record in the application.

Question PS3400: If the publication date of a printed publication is not known, can a third party still include that document in the preissuance submission?

Yes, the third party may include a document for which the publication date is unknown in a preissuance submission. However, the third party must supply evidence of publication. At a minimum, the third party must provide a date of retrieval or a time frame when the document was available as a publication as well as include evidence that establishes the

document as a publication. Such evidence may be in the form of affidavits, declarations, or any other appropriate format.

Question PS3420: Are there any requirements for affidavits and declarations submitted as evidence of publication?

Yes, affidavits and declarations submitted as evidence of publication must comply with the Office's formal requirements set forth in MPEP § 715.04(II).

Question PS3440: What information can be included in an affidavit or declaration submitted as evidence of publication?

Affidavits and declarations submitted as evidence of publication must be limited to facts establishing why a submitted document qualifies as a publication and must not to be used as a mechanism to place information that is not pertinent to establishing the document as a publication before the examiner. Further, affidavits and declarations submitted as evidence of publication should explain how the affiant/declarant has personal knowledge of the facts described therein and must be specific to the document(s) submitted for consideration.

Question PS3460: Can a third-party submission be filed anonymously?

A real party in interest can remain anonymous by having someone else make the third-party submission for them, but the submitter cannot remain anonymous. The signature requirement of 37 CFR 1.4 for papers filed in a patent application, which require a person's signature, apply to third-party submissions. Third-party submissions must be signed due to statements that are required to be made under 37 CFR 1.290(d)(5) and 37 CFR 1.290(g) (if applicable) by the party making the submission. Thus, the identity of the submitter (*i.e.*, the party signing the submission) will be provided to the applicant upon entry of the compliant submission in the application file.

Question PS3500: Where should a third party list an Office action on the form PTO/SB/429?

All non-patent publications, such as Office actions, journal articles, communications from foreign patent offices, court documents, etc. that qualify as publications should be listed under the "Non-Patent Publications" section of the form PTO/SB/429 (or entered in the "Non-Patent Publications" section of the "Application Data" screen when filing electronically).

Question PS3600: If a third party is required to submit a translation for a non-English language document, can the third party submit a machine translation?

Yes, a reliable machine translation is acceptable. The translation need not be certified.

Question PS3700: Can a third party submit a compact disc (CD) containing a software program in a preissuance submission?

No, a preissuance submission is required to be made in writing and contain printed publications. A software program may be submitted only if reduced to writing, such as in the form of screen shots. Additionally, evidence of publication may be required.

Concise Description of Relevance

Question PS4100: May I use the concise description of relevance to propose how the claims should be rejected?

No, the concise description of relevance must not propose rejections of the claims. Instead, the concise description should only set forth facts, explaining how an item listed is of potential relevance to the examination of the application in which the third-party submission has been filed. This is done, most effectively, by pointing out relevant pages or lines of the respective document and providing a focused description to draw the examiner's attention to the relevant issues.

Unlike the concise explanation for a protest under §1.291, which allows for arguments against patentability, the concise description of relevance required by 35 U.S.C. 122(e) is limited to a factual description of a document's relevance. The concise description of relevance, therefore, does not permit third parties to submit arguments against patentability or set forth conclusions regarding whether one or more claims are patentable.

Question PS4200: Is a concise description of relevance required to be submitted in a particular format?

No, a concise description of relevance is not required to be presented in a particular format. As one option, it may be presented as a narrative. Alternatively as a second option, a concise description of relevance may be presented as a claim chart mapping various portions of a submitted printed publication to different claim elements.

Question PS4300: What are examples of compliant and non-compliant concise descriptions of relevance formatted as a narrative?

Example of a compliant concise description formatted as a narrative for a claim having only two elements:

"Publication X and publication Y both disclose machines that perform the same function as the machine recited in claim 1. The machine set forth in publication X includes many of the same parts discussed in the specification of this application. For example, in the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication

X. Publication Y teaches a machine having element B of claim 1. See lines 1-3 on page 6 of publication Y. Publication Y teaches the benefits of using element B in this type of a machine.”

Example of a non-compliant concise description formatted as a narrative for a claim having only two elements:

“Publication X and publication Y both disclose machines that perform the same function as the machine recited in claim 1. The machine set forth in publication X includes many of the same parts discussed in the specification of this application. For example, in the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication X. Publication Y teaches a machine having element B of claim 1. See lines 1-3 on page 6 of publication Y. Publication Y teaches the benefits of using element B in this type of a machine. Accordingly, claim 1 is obvious in view of publication X and publication Y.”

Question PS4400: What are examples of compliant and non-compliant concise descriptions of relevance formatted as a claim chart?

Example of a compliant concise description formatted as a claim chart for a claim having only two elements:

Claim 1	Publication X
Element A	As discussed on page 1, publication X discloses a machine that performs the same function as the machine recited in claim 1. The machine set forth in publication X includes many of the same parts discussed in the specification of this application. For example, in the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication X.
Element B	The first embodiment also includes element B of claim 1. See lines 1-3 on page 6 of publication X.

Example of a non-compliant concise description formatted as a claim chart for a claim having only two elements:

Claim 1	Publication X
Element A	As discussed on page 1, publication X discloses a machine that performs the same function as the machine recited in claim 1. The machine set forth in publication X includes many of the same parts discussed in the specification of this application. For example, in the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication X.
Element B	The first embodiment also includes element B of claim 1. See lines 1-3 on page 6

of publication X. Thus, publication X anticipates claim 1 because it teaches all of the elements of claim 1.
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Question PS4500: Can a third party file an annotated copy of a listed document as the concise description of relevance for that listed document?

No, merely annotating or highlighting the copy of the listed document itself will not be deemed a proper concise description of relevance.

Question PS4600: How do I include the concise description of relevance when filing electronically?

Concise descriptions may be entered as text in the provided text box on the “Application Data” screen. Alternatively, the concise description may be uploaded as a separate document on the “Attach Documents” screen. When entering a concise description of relevance in the provided text box, up to 1000 characters may be entered. A concise description of relevance that exceeds 1000 characters must be uploaded as a separate document on the “Attach Documents” screen. When filed as a separate paper, the concise description of relevance should clearly identify the document to which it pertains.

Question PS4700: Should I provide the concise description for each listed item as a separate paper?

While there is no requirement that each concise description of relevance be provided as a separate paper, the Office highly recommends this practice. Providing a separate paper for each concise description of relevance that prominently identifies printed publication to which the concise description pertains will help ensure that the screener and the examiner readily identify and consider it.

Timing of a Preissuance Submission

Question PS5100: How can a third party determine if a planned preissuance submission will be timely given the limited statutory time window for such submissions to be made?

First, check Public PAIR to determine if a Notice of Allowance (NOA) has been issued in the application. If the NOA has been issued, you may not file a third-party submission. If the NOA has not been issued, determine if a first rejection has been issued by the examiner or if the application has been published for six months or longer. You may file as long as the first rejection has not been issued or the application has not been published for six months.

Question PS5200: What happens if a third party files a preissuance submission on the same date the first rejection is mailed and the application has been published for more than six months?

If a third party files a preissuance submission on the same date the first rejection is mailed and the application has been published for more than six months, the submission would not be timely and would not be entered. All third-party submissions must be filed prior to, not on, the critical date. Where the application has been published for more than six months and no notice of allowance has been mailed, the critical date is the mailing date of the first rejection such that the third-party submission would need to be filed prior to the mailing date of the first rejection.

Question PS5300: Does the holiday/weekend rule set forth in 37 CFR 1.7(a) apply to a preissuance submission?

Yes, the holiday/weekend rule set forth in 37 CFR 1.7(a) applies to a preissuance submission.

Question PS5220: Assuming no notice of allowance has been issued in an application, can a third-party submission be filed on the date that is six months after the date the Office published the application if a first rejection has already been mailed in the application?

No, all third-party submissions must be filed prior to, not on, the dates identified in 37 CFR 1.290(b). Assuming no notice of allowance has been issued in an application, if a third-party submission is filed on the date that is six months after the date the Office published the application and a first rejection has already been mailed, the submission would not be timely and would not be entered (*i.e.*, if the Office published the application on May 21, a third-party submission filed on November 21, which is the date that is six months after the date the Office published the application, would not be timely as, according to the rule, the submission would need to have been made on November 20 or earlier).

Question PS5240: Does the filing of a request for continued examination (RCE) in an application reset the time period for filing a third-party submission?

No, the filing of an RCE does not reset the time period for filing a third-party submission. However, the filing of an RCE does not preclude a third-party submission from being filed after the RCE, if the filing of the third-party submission would otherwise be filed within the time periods set forth in 37 CFR 1.290(b).

Question PS5260: Does the issuance of a notice of allowance prevent filing a third party submission?

Yes, a third party submission must be filed prior to the date a notice of allowance is given or mailed. Where a notice of allowance has not been issued, a third party submission must be filed prior to the later of: (i) the date that is six months after the date on which the application is first published by the Office or (ii) the date of the first rejection of any claim by the examiner.

Fees

Question PS6100: Is there a fee to file a preissuance submission?

Yes, a third party must submit the required fee for every ten documents listed or fraction thereof, unless the fee exemption applies to the submission. A third party is exempt from paying a fee for a submission of three or fewer documents, provided it is the party's first such submission and the party files a "first and only" statement.

Question PS6200: If another third party has already taken advantage of the fee exemption in the application, may a second third party also benefit from the fee exemption in the same application?

Yes, a second third party may take advantage of the fee exemption in the same application as long as the submission includes three or fewer items and is accompanied by the "first and only" statement. However, such statement could not be made where the third parties are in privity with each other.

Question PS6300: If a third party took advantage of the fee exemption when he/she/it filed the first preissuance submission in an application, can the third party file a subsequent preissuance submission in the same application?

Yes, a third party may file a subsequent preissuance submission if the need for the subsequent submission was not known at the time of the earlier submission. Any such subsequent submission would not be exempt from the fee requirement.

Question PS6400: Can a third party electronically file a preissuance submission and pay the required fee at a later time?

No, the fee must accompany a preissuance submission at the time of filing. Registered e-Filers who authenticate can save "in-progress" submissions and return to edit them prior to completing filing. Payment, in this instance, will be due when the filing is complete. Unregistered users, by contrast, must complete the filing and pay the fee at the time the submission is initiated.

Question PS6500: If a third party wishes to file a third-party submission of twelve documents, what is the required fee?

A fee is required for every ten items or fraction thereof identified in the document list. If the third party does not qualify for the small entity discount, the third party would have to pay a fee of \$360 for twelve listed documents (i.e., \$180 for the first ten documents and \$180 for the remaining two documents). If filing electronically, the third party in this example would need to split the twelve documents into two separate submissions, paying \$180 for each submission.

Question PS6600: How can a third party pay the required fee for a preissuance submission?

When filing electronically, payment may be made on the “Pay Fees” screen by credit card, USPTO deposit account, or electronic funds transfer.

When filing in paper, payment may be made by check, money order, credit card, or deposit account. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. Credit Card Payment Form (PTO-2038) should be used when paying by credit card. Form PTO-2038 may be downloaded at <http://www.uspto.gov/forms/index.jsp>. To protect your credit card information, do not submit this form electronically through EFS-Web. Credit card information for electronic credit card payments should be entered exclusively on the USPTO Web site providing electronic payment capability.

Question PS6700: A third party took advantage of the fee exemption when he/she/it made a first submission of three or fewer documents in an application but received notification that the submission was non-compliant. If the third party makes a re-submission of three or fewer documents in the application, will he/she/it have to pay the required fee?

Yes, to be complete, the appropriate fee for the number of documents being submitted (e.g., \$180 for 1-10 documents) must accompany any resubmission made in response to a notification of non-compliance. However, to satisfy the fee requirement for a resubmission after a finding of non-compliance where the non-compliant submission of three or fewer documents was accompanied by the fee exemption statement set forth in 37 CFR 1.290(g), the third party may state that the fee exemption applies to the resubmission. When filing electronically, the statement may be made by selecting the third fee radio button in the “Statements” section at the bottom of the “Application Data” screen. When filing in paper, the statement may be made by selecting the third fee checkbox in the “Statements” section of the form PTO/SB/429. The corrections in the resubmission must be limited to addressing the non-compliance, and the resubmission must be another complete submission, as the Office will not accept amendments to the non-compliant submission. The determination of whether the fee requirement for a resubmission is satisfied will be made at the sole discretion of the Office. Note that the resubmission must be made before the statutory time period for filing a third-party submission has closed.

Question PS6800: A third party paid the required fee for a submission of five documents in an application. The submission was found to be non-compliant. If the third party makes a re-submission of the same five documents in the application, will he/she/it need to pay the required fee again?

Yes, to be complete, the appropriate fee for the number of documents being submitted (e.g., \$180 for 1-10 documents) must accompany any resubmission made in response to a notification of non-compliance. However, to satisfy the fee requirement for a resubmission after a finding of non-compliance where the proper fee set forth in 37 CFR 1.290(f) accompanied the non-compliant submission, the third party may request that the Office apply the previously-paid fee to the resubmission. When filing electronically, the request

may be made by selecting the third fee radio button in the “Statements” section at the bottom of the “Application Data” screen. When filing in paper, the request may be made by selecting the third fee checkbox in the “Statements” section of the form PTO/SB/429. The corrections in the resubmission must be limited to addressing the non-compliance, and the resubmission must be another complete submission, as the Office will not accept amendments to the non-compliant submission. The determination of whether the fee requirement for a resubmission is satisfied will be made at the sole discretion of the Office. Note that the resubmission must be made before the statutory time period for filing a third-party submission has closed.

Question PS6820: Can a third party pay the micro entity fee for a third-party submission?

No, a third party is not eligible for the micro entity discount.

Question PS6840: Is there a small entity discount for third-party submissions?

Yes, a third party that qualifies as a small entity may take advantage of the small entity discount when making a third-party submission.

Question PS6860: How does a third party determine whether the third party qualifies as a small entity?

A third party may refer to 37 CFR 1.27(a) for guidance in determining whether a party qualifies as a small entity.

Question PS6870: How does a third party indicate that he/she/it is eligible for the small entity discount when filing a third-party submission?

When filing electronically, the submitter should select the “Small Entity” link on the “Calculate Fees” screen of the dedicated third-party submission EFS-Web interface and pay the applicable small entity fee. When filing in paper, the submitter should select the “small entity” box on the form PTO/SB/429 and pay the applicable small entity fee.

Processing of Preissuance Submissions

Question PS7100: What happens if a preissuance submission is found non-compliant?

Third-party submissions that are not compliant with the statute will not be entered into the image file wrapper (IFW) record of an application or considered by the examiner. Instead, non-compliant preissuance submissions will be discarded. The Office will not refund the required fees or toll the statutory time period for making a third-party submission. Additionally, the Office will not accept amendments to a non-compliant submission, but the party may file another complete submission, provided the statutory time period for filing a submission has not closed.

Question PS7200: Will a third party be notified if his/her/its preissuance submission is found non-compliant?

Yes, if a third party provides an electronic mail message (email) address with a preissuance submission, whether filed electronically or in paper, the Office will notify the third party of such non-compliance at the email address provided and will include the reason(s) for non-compliance. No notification will be issued where a third party does not provide an email address with the submission. See Question PS3300 for additional information.

Question PS7300: Does the applicant have any duty to respond to a preissuance submission?

No, absent a request by the Office, an applicant has no duty to, and need not, reply to a preissuance submission.

Question PS7400: Will the applicant be notified when a preissuance submission is entered into his/her/its application?

Yes, the Office will notify the applicant upon entry of a compliant preissuance submission in an application file if the applicant participates in the Office's e-Office Action program. The contents of a compliant third-party submission will be made available to the applicant via its entry in the IFW of the application.

Question PS7500: Can a third party file a preissuance submission electronically if the third party does not know the Confirmation Number for the application?

No, a third party cannot electronically file a preissuance submission without a Confirmation Number for the application. The Confirmation Number can be obtained by looking up the application number in the Public Patent Application Information Retrieval (PAIR) System located at <http://portal.uspto.gov/external/portal/pair> and viewing the Bibliographic Data. If the Confirmation Number is not available or not known, the preissuance submission cannot be filed electronically and instead must be filed in paper.

Question PS7600: As a Registered eFiler, how should a third party access the preissuance submission interface of EFS-Web?

After user authentication, a third party must select "Existing application/patent" under the "Main Functions" heading and then select the radio button for "Third-Party Preissuance Submission under 37 CFR 1.290." Do not file a third-party submission by selecting "Documents/Fees for an existing application" because only an applicant and/or an applicant's representative may file follow-on papers in an application's file.

Question PS7700: Can a third party file a protest using the preissuance submission interface of EFS-Web?

No, a protest under § 1.291 must not be filed via EFS-Web. Instead, all protests must continue to be filed in paper.

Question PS7800: Can a third party file a preissuance submission via USPS Express Mail service?

Yes, the USPS Express Mail service provisions of § 1.10 apply to a preissuance submission under § 1.290.

Question PS7900: How should a third party upload the form PTO/SB/429 using the preissuance submission interface of EFS-Web?

Form PTO/SB/429 cannot be uploaded to EFS-Web. Filing through EFS-Web is an electronic alternative to paper filing using form PTO/SB/429. Instead of uploading the form, EFS-Web will automatically generate and complete the form after a third party provides all of the necessary information on the “Application Data” screen. A third party may click on the “Third-party-preissuance-submission.pdf” hyperlink to preview the generated form on the “Attach Documents” screen, and may make any necessary corrections by going back to the “Application Data” screen. Instructions for filing electronically are located at http://www.uspto.gov/patents/process/file/efs/guidance/QSG_Third_Party_Preissuance.pdf. Instructions for filing in paper using form PTO/SB/429 are located at http://www.uspto.gov/forms/3prsubmission_instructions.pdf.

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