

March 5, 2012

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: preissuance_submissions@uspto.gov

**RE: Comments on Notice of Proposed Rulemaking
Changes to Implement the Preissuance Submissions by Third Parties Provision
of the Leahy-Smith America Invents Act, 77 Fed. Reg. 448 (January 5, 2012)**

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the Notice of Proposed Rulemaking entitled: “Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act” as published in the Federal Register (Vol. 77, No. 3, pp. 448-457) on January 5, 2012 (the “Notice”).

AIPLA is a U.S.-based national bar association whose approximately 15,000 members are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law affecting intellectual property. Our members practice or are otherwise involved in patent law and other intellectual property law in the United States and in jurisdictions throughout the world.

AIPLA supports the expanded opportunities afforded by changes introduced by the America Invents Act (AIA) (35 U.S.C. § 122(e)) for third parties to submit certain information of potential relevance to the examination of an identified application. We support the adoption of a separate regulation (proposed § 1.290) to implement the expanded provisions that will replace the existing regulation (§ 1.99) governing submissions by third parties in pending applications. We understand the proposed regulations will be applicable to any nonprovisional utility, design, plant, or reissue application filed before, on, or after September 16, 2012, when the final regulations are expected to go into effect.

The Notice proposes that the regulations pertaining to protests (§ 1.291) be changed for clarity and consistency with 35 U.S.C. § 122(e) and proposed § 1.290. We applaud the goals of clarity and consistency and suggest below other opportunities to achieve those goals with respect to the broader spectrum of patent practices before the United States Patent and Trademark Office (USPTO). The Notice also proposes to eliminate public use proceedings under § 1.292 because of the infrequency of these proceedings, the prohibition against such proceedings with respect to a published application (35 U.S.C. § 122(c)), and the availability of public use as an issue for supplemental examination and post-grant review proceedings. AIPLA supports the removal of § 1.292 upon implementation of these other proceedings in which public use may be addressed.

AIPLA generally approves of the overall clarity and direction of the proposed regulations implementing the preissuance submission procedures of the AIA. The USPTO should consider the following concerns and suggestions that could further improve the procedures.

Treatment of Non-Compliant Submissions

An important purpose served by proposed § 1.290 and revised § 1.291 is to permit third parties to assist the examiner in identifying relevant prior art and issues during the examination process, typically before any substantive examination has begun or at least early in the examination process. To encourage third parties to make these efforts, the policies and practices adopted by the USPTO should facilitate submissions in accordance with these regulations and minimize the barriers that may frustrate these efforts.

Specifically, whatever requirements are ultimately adopted for §§ 1.290 and 1.291, the USPTO should provide some latitude for a minor deviation from the requirements by waiving the requirement or permitting the submitter to correct a minor omission or mistake in accordance with the policies and practices followed under § 1.135(c). If there is a good faith attempt made to comply with the requirements and the submission does not appear to have been made for harassment purposes, but some element is missing (e.g., a foreign patent is identified by the applicant assignee rather than the first named inventor), the omission should be waived or the submitter given a non-extendable one-month period to correct the citation and bring it into compliance with the adopted regulations, rather than not entering the non-compliant third-party submission and discarding it. As it does under the provisions of § 1.135(c), the USPTO has authority to consider the statutory period to be tolled by an initial non-compliant submission, and should reconsider its statement and change its proposed policy that non-compliant submissions would not toll the statutory time period under any circumstance. 77 Fed. Reg. at 444.

As we understand the proposal, the USPTO would not enter non-compliant third-party submissions into the image file wrapper (IFW) with the result that they would not be considered by an examiner and would be discarded; we also understand that there would be no refund of the required fees in this circumstance. 77 Fed. Reg. at 449. This is perhaps a justifiable fate for a submission by someone trying to improperly interfere with the examination process, but it is hardly appropriate for those trying to assist the USPTO in one of its most important functions.

For some, adoption of strict compliance regulations is an invitation to revisit the non-compliance nightmares that once affected the USPTO's review of appeal briefs and reexamination requests. Whomever is selected to review these submissions for compliance with the adopted regulations should have an understanding, or be supervised by a person with an understanding, of the purpose and use of these submissions. It is in the USPTO's best interests to avoid inflexibility and implement the practices proposed under §§ 1.290 and 1.291 in a manner that encourages third parties to provide the type of assistance to the USPTO that these regulations are designed to promote.

Service on Applicant

The USPTO has proposed, contrary to the provisions in § 1.99 and § 1.291 (protests), that submissions under proposed § 1.290 need not be served on the applicant, to underscore that third-party submissions will not create a duty on the part of the applicant to independently file the submitted documents with the USPTO in an information disclosure statement (IDS). While it is appropriate to protect applicants from harassment by third parties, on balance, patent applicants may wish to be informed of submissions made to one of their applications, just as in the case of protests under § 1.291, rather than having to periodically monitor the IFW for each of their applications to see if a submission has been entered. It is our understanding that any such duty on the part of the applicant would be extinguished if the submission was entered and considered by the examiner.

However, the duty could arise if the person making the submission served a copy on the applicant even though not required by the regulations, and could also arise if a compliant submission was entered into an abandoned application but not considered by the examiner. In the latter case, any duty on the applicant would persist in a continuing application because an examiner in a continuing application is not expected to consider information of record in a parent application unless it was considered by the examiner in the parent application. MPEP 609.02(A)(2).

On balance, AIPLA supports a requirement for service on the patent applicant under proposed § 1.290. Alternatively, the USPTO should consider providing a notice to the applicant when a § 1.290 submission is entered into the IFW. Applicants should not have the burden of periodically checking the IFW to determine whether a § 1.290 submission has been added to an application. An applicant may elect to consider the information cited and file an amendment where warranted by that information, thereby advancing prosecution.

Consideration of Third-Party Submissions

The Notice indicates that compliant third-party preissuance submissions will be considered "in the same manner that the examiner considers information and concise statements of relevance submitted as part of an IDS." However, USPTO guidance on such "consideration" is arguably less than clear or consistent and should be improved.

For example, MPEP 609.05(b) states that consideration by the examiner of information cited in an IDS means that the examiner will consider the documents in the same manner as other documents in the USPTO search files when conducting a search of the prior art in a proper field of search. MPEP 904.03 elaborates a little further by stating that when selecting references to be cited during a search, the examiner should carefully compare the references with one another and with the applicant's disclosure to avoid the citation of an unnecessary number of references. The obligations of an examiner in considering references cited, but not described, in an IDS have been stated to be that the examiner is only responsible for cursorily reviewing the references. Notice on Guidelines for Reexamination, 64 Fed. Reg. 15346, 15347, response to comment 6 (March 31, 1999).

Further, in MPEP 2256 and 2656, examiners in reexamination proceedings are advised that consideration of documents cited in an IDS is normally limited by the degree to which the party filing the citation has explained the content and relevance of the information. Thus, further clarification is needed as to how examiners will be expected to consider information and concise explanations of relevance provided in a § 1.290 submission.

The Notice also describes the USPTO plans for having examiners acknowledge either consideration or non-consideration of the documents submitted. 77 Fed. Reg. at 450, 2d column. It states that striking through a document will mean that the examiner did not consider the document or its accompanying concise description (e.g., because the document was listed improperly, a copy of the document was not submitted or a concise description was omitted). However, the Notice earlier states (at 449, 3rd column) that third-party submissions would be reviewed for compliance prior to entry into the IFW, so the examiner should never see a non-compliant submission or citation. These are examples of minor informalities for which the USPTO should allow corrections. The USPTO should consider all citations to the extent possible, once the submission is reviewed for compliance and entered into the IFW.

The following additional comments are offered on the provisions in the proposed regulations:

Proposed § 1.290(a) – “Other Printed Publications”

A third party is permitted to submit any patent, published patent application, or “other printed publications” of potential relevance to the examination of an application. 35 U.S.C. § 122(e) and proposed § 1.290(a). The USPTO has not provided sufficient guidance on what it intends to permit or exclude in this latter category, stating only that it “could not include unpublished internal documents or other non-patent documents which do not qualify as printed publications. *See* MPEP § 2128.” That section of the MPEP is devoted to “Printed Publications as Prior Art,” but neither 35 U.S.C. § 122(e) nor proposed § 1.290(a) is limited to printed publications that must also qualify as prior art.

The USPTO should allow the submission of documents that are accessible to the public and of potential relevance to the examination of an application if the submission otherwise complies with 35 U.S.C. § 122(e) and proposed § 1.290. This would include, for example, litigation papers of all types that were not subject to a Protective Order and are otherwise available to the public. Further clarification and exemplification of the type of documents that will be admitted or excluded under this provision is requested.

Proposed § 1.290(b) – “Before”

This proposed subsection, along with proposed § 1.291(b)(1), states that a submission/protest must be filed “before” a certain date or event. While it is recognized that the term “before” appears in 35 U.S.C. § 122(e), the meaning of this term often varies depending on the context and how the USPTO elects to interpret it. As it relates to proposed § 1.290(b), the USPTO has explained in the Discussion of Specific Rules that preissuance submissions “must be filed before, not on, the dates identified.”

Consider, however, the use of the term “before” in the context of 35 U.S.C. § 120 where a subsequent application must be filed “before the patenting or abandonment of or termination of proceedings on the first application” to obtain benefit of the earlier application. As the USPTO explains in MPEP 201.11(II)(B), a continuing application is filed “before” the patenting, abandonment, etc., if it is filed on the same date or before the date the patent issues. This is because, as explained in MPEP 711.02(c), the term “before” in this § 120 context has been consistently interpreted to mean “not later than.”

Potential confusion can be avoided by deleting use of the term “before” and adopting language similar to that recited in § 1.291(b), that the filing must be made “prior to” the specified date or event if that is what is intended. The Notice as a whole makes clear that filing “prior to” a particular date or event is the intended meaning in both proposed § 1.290(b) and § 1.291(b)(1).

Proposed § 1.290(c) – Application Number on Each Page

This proposed section would require that a third-party submission contain on each page of the submission, except for the documents submitted, the application number of the application to which the submission is directed. The USPTO has not provided any justification for this requirement, which is apparently different from the requirements for any other paper submitted to the USPTO by any party in any application or reexamination proceeding. Certainly the application number should appear on at least the first page of the submission, and it may be a best practice to place the number on each page, to facilitate the timely association of the submission with the correct application file. However, in the absence of a compelling reason to deviate from standard USPTO practice, this unnecessary requirement should not be adopted.

Proposed § 1.290(g) – Fee Exemption

This proposed section would provide an exemption from the proposed § 1.290(f) fee where the preissuance submission listing identifies three or fewer total documents and is the first preissuance submission made by a third party. The USPTO should reconsider the number of documents that could be submitted without a fee to encourage submissions that would assist the USPTO in the examination process. The requirement to provide a concise explanation of the relevance of each document submitted is sufficiently burdensome that the USPTO should not impose any additional burden to those who wish to assist the USPTO. AIPLA believes that the number of fee-exempt documents should be raised to ten. The USPTO will be able to revisit this issue as experience dictates.

Proposed § 1.290(i) – § 1.8 Does Not Apply

New section 1.290(i) provides an exception to the use of certificate of mailing procedures for the procedures under § 1.290. Exceptions to certificate of mailing provisions are typically set out in § 1.8(a)(2)(i), and many practitioners refer to § 1.8 for guidance on when those procedures may not be used. We therefore recommend that the exception to certificate of mailing provisions with respect to § 1.290 be also set out in § 1.8(a)(2)(i). While there is no harm in listing the exception in proposed § 1.290(i), the limitations on § 1.8 practice are typically not recited in the regulations to which the exception applies.

AIPLA appreciates the opportunity to provide these comments on the subject Notice of Proposed Rulemaking. We would be pleased to answer any questions these comments may raise and look forward to participation in the continuing development of rules appropriate for patent practice and for implementation of the AIA.

Sincerely,

A handwritten signature in black ink, appearing to read "William G. Barber", with a long horizontal flourish extending to the right.

William G. Barber
AIPLA President