

From: Brad Pedersen [e-mail address redacted]

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To: preissuance_submissions

Subject: Comments on Changes to Implement the Preissuance Submissions by Third Parties Provision

March 5, 2012

MAIL STOP – Comments Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

ATTENTION - Nicole D. Haines

Legal Advisor, OPLA

Re: Comments on Preissuance Submissions by Third Parties Proposed Rules

The Minnesota Intellectual Property Law Association (MIPLA) is grateful for the opportunity to provide input with respect to the Notice of Proposed Rulemaking (NPR) entitled “Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act,” Fed. Reg. Vol. 77, No. 3, pp. 448-457, January 5, 2012.

MIPLA is an independent organization of nearly 500 members in and around the Minnesota area representing all aspects of private and corporate intellectual property practice, as well as the academic community. MIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent law before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of the Board of MIPLA after consultation and input from the IP Law, Patent Practice and Patent Litigation Committees, and do not necessarily reflect the view of opinions of any individual members or firms of the committees or MIPLA, or any of their clients. MIPLA understands that the USPTO will not directly respond to these suggestions, and MIPLA reserves the right to formulate specific comments pursuant to formal rule promulgation with respect to fee setting.

In general, MIPLA supports the opportunity for third parties to submit relevant prior art references during patent prosecution so long as the submissions are legitimate and the rules for the submission process protect patent applicants from frivolous or harassing uses of the process.

MIPLA has the following overall comments/suggestions.

1. *Support for USPTO Process for Considering Third Party Submissions* – MIPLA approves of the process outlined in the NPR that effectively has an Examiner treat the submission as if it were submitted by an applicant as part of an IDS. Specifically, MIPLA supports the rules that

no duty is imposed on the applicant by the submission and that the submission will be printed on the cover sheet of any patent that issues.

2. *Definition/Examples of Concise Description of Relevance* - MIPLA suggests that the USPTO provide a definition and/or examples of what the Office considers good and bad examples of concise definitions of relevance of a cited reference. The examples of good and bad obviousness rejections have been received as very useful by patent applicants and practitioners, and a similar set of examples for what the Office considers good and bad examples of concise definitions of relevance will be helpful.
3. *Scope of Submission for Already Considered Art* - It is not clear whether the proposed rules allow submissions and descriptions of relevance in connection with patents, published patent applications or other printed publications that are already of record in the patent application. Although MIPLA is not expressing an opinion on whether the rules should or should not allow submissions in connection with documents already of record, many members of MIPLA have expressed the opinion that the rules should not allow submissions of documents that are already of record. Accordingly, MIPLA suggests that the Office revise the rules for enhanced clarity on this issue. In connection with this issue, the Office may want to consider possible implications such as the administrative and substantive examination process demands resulting from the promulgation of rules effectively allowing serial submissions in connection with documents already of record in the patent application.
4. *Scope of Submission for Non-Prior Art* - It is also not clear whether the proposed rules allow submissions of documents that are not prior art to the patent application. For example, a published document in the form of a non-prior art article commenting on a document already of record may provide information of potential relevance to the examination of the application. Although MIPLA is not expressing an opinion on whether the rules should or should not allow submission of non-prior art documents, many members of MIPLA have expressed the opinion that the rules should not allow submission of non-prior art documents. Accordingly, MIPLA suggests that the Office revise the rules for enhanced clarity on this issue. In connection with this issue, the Office may want to consider possible implications such as the administrative and substantive examination process demands resulting from the promulgation of rules effectively allowing serial submissions in connection with documents already of record in the patent application.
5. *Requirement to Establish Submitted Reference as Prior Art* - MIPLA encourages the USPTO to require some indication by the Third Party Submitter as to whether the materials are or are not assumed to be prior art based on the date of the reference and the presumptive priority date of the application for which they are being submitted. The burden should not be on the Office or an applicant to try and establish a relevant date of a reference submitted by a Third Party Submitter. In addition, if the Office determines that either or both documents that are already part of the record or documents that are not prior art cannot be submitted under the rules for third party pre-issuance submission, then the rules

should require the Third Party Submitter to certify that the submission complies with those provisions.

MIPLA has the following specific comments/suggestions.

- A. Rule 1.290(e)(4) – MIPLA suggests that non-patent literature (NPL) documents be submitted by author, not by publisher. With the increasing use of the Internet, it is no longer common practice for an NPL to identify either a publisher or place of publication. To address this issue and the issue noted above in the general Comments above, MIPLA suggests the following language for Proposed Rule 1.290(e)(4):

(4) Non-patent publication by author, title, pages being submitted, publication date and, if available, publisher and place of publication. The third party bears the burden of establishing both the publication date of a non-patent publication, if not apparent from the document, and that the publication date qualifies the non-patent publication as prior art to the application based on the claimed priority date of the application.

- B. Rule 1.290(e)(4) - MIPLA suggests that this rule clarify the burden of establishing a relevant date based on the type of document being considered as to what qualifies "apparent from the document." To address this issue, MIPLA suggests the following additional language for Proposed Rule 1.290(e)(4):

(4) . . . Whether a publication date is apparent from the document can be satisfied by reference to the printed publication date of a document published in print; however, additional proof is required for a Third Party Submitter to establish the relevant date of publication of any document not published in print, including documents that have only been published on the Internet.

- C. Rule 1.290(f) – MIPLA suggests that the fees be set based on a per item charge, rather than a block incremental level of ten documents. The use of a block incremental level framework for these kinds of fees can result in arbitrary and capricious fees being charged.
- D. Rule 1.291(c)(1) (iv) – MIPLA suggests that non-patent literature (NPL) documents be submitted by author, not by publisher. With the increasing use of the Internet, it is no longer common practice for an NPL to identify either a publisher or place of publication. To address this issue and the issue noted above in Comment (2), MIPLA suggests the following language for Proposed Rule 1.291(c)(1)(iv):

(iv) Each non-patent publication by author, title, pages being submitted, publication date and, if available, publisher and place of publication. The protest bears the burden of establishing both the publication date of a non-patent publication, if not apparent from the document, and that the publication date qualifies the non-patent

publication as prior art to the application based on the claimed priority date of the application.

Submitted on behalf of MIPLA by:

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