

Patent Office Professional Association

Box 25287, Alexandria, VA 22313

March 5, 2012

David J. Kappos
Under Secretary of Commerce for Intellectual Property
And Director,
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act. RIN 0651-AC67.

Dear Mr. Kappos,

This letter sets forth the formal Comments of the Patent Office Professional Association (POPA) in response to Notice of Proposed Rulemaking RIN 0651-AC67 regarding the preissuance submission of prior art by third parties. Comments are due on or before March 5, 2012. Therefore, these Comments are timely filed.

POPA is the exclusive representative of the more than 7,000 patent examiners and other patent professionals at the U.S. Patent and Trademark Office (USPTO). Patent examiners examine patent applications within the constraints of a very rigorous performance appraisal system that measures examiners' production in six-minute increments. Because of these rigorous constraints, examiners have a vested interest in any changes that would result in additional work for examiners, such as the preissuance submission of prior art by third parties.

POPA has serious concerns with this proposed rule package. The proposed rule package does not put substantial limitation(s) on how many "free" third party submissions may be filed in a particular patent application, so long as no two third party submitters are in "privity" with one another. Therefore, it is possible that an examiner could be faced with considering multiple third party submissions, each containing up to three references. Additional references could be submitted with the payment of additional fees.

The emphasis of third party submissions of prior art should be with respect to getting the very best art in front of the examiner. A third party submission providing background art, for example, will just become a frustrating waste of time for the examiner and a significant administrative burden on the agency. Such art will presumably be found during the examiner's prior art search and not need to be repeatedly submitted by third parties.

The amount of prior art that a third party may submit increases the likelihood of the examiner having to spend his/her time wading through third party art submissions of which the examiner is most likely already aware. This, coupled with the fact that there is no currently contemplated limit on the number of third party submissions of prior art, could well leave an examiner buried under a pile of third party submissions and could actually result in the examiner missing a piece of highly relevant art as the examiner digs his/her way through the pile of submissions.

Keeping the amount of third party prior art submissions limited to no more than three references will help to focus the attention of third parties on finding and submitting only the most relevant art to the claims at hand. Only then, would the administrative burden on the examiner (time spent examining) and the agency (cost of additional time for examination) be reasonably offset by an increase in the quality of issued U.S. patents.

POPA cannot support any increase in the number of references in “free” prior art submissions beyond the proposed three (3) documents or any even more open-ended proposals for third party submissions of prior art in the absence of specific assurances that the collected fees for such proposals are directly translated into additional time for the examiner’s consideration of each submission. We realize that this is an implementation issue between POPA and the agency but we want to make clear that the fees charged for cost recovery must be actually applied to the cost of the activity, i.e., more time for the examiner to consider the third party submission of prior art.

If you have further questions or wish to discuss our position further, please contact me and I will be happy to talk with you.

Sincerely,

[Robert D. Budens]

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