

**Leahy-Smith America Invents Act: Third Party Preissuance Submission
Comment on Proposed Regulation 37 C.F.R. § 1.290**

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Abstract

The United States Patent and Trademark Office has proposed 37 C.F.R. §1.290 to implement 35 U.S.C. § 122(e), the Third Party Preissuance Submission provision of the Leahy-Smith America Invents Act, which allows third parties to submit relevant documents along with concise statements explaining each document to the Office prior to patent issuance for examiner consideration. However, the proposed rule fails to clarify whether the statute precludes a third party from submitting concise statements for patents, patent applications, and printed publications already cited in the record by the applicant, examiner, or another third party. This comment urges the Office to permit third-party concise statement submissions for *any* patent, published patent application, or other printed publication of potential relevance, regardless of whether the document is already in the file record.

I. Introduction

On January 5, 2012, the United States Patent and Trademark Office (“the PTO”) published proposed 37 C.F.R. §1.290 to implement 35 U.S.C. § 122(e), the Third Party Preissuance Submission provision of the Leahy-Smith America Invents Act (“the Act”).² The statutory provision permits any third party to submit “any” potentially relevant patents, published patent applications, or printed publications and a concise description of relevance for each document for examiner consideration and inclusion in the record, within the time period set forth in 35 U.S.C. § 122(e)(1)(B) during the prosecution of a patent application. However, the provision does not expressly state whether a third party may submit documents and concise descriptions for documents already in the file record.

Proposed Section 1.290 merely mirrors the statutory language and fails to clarify whether third parties may submit comments on already-cited documents. The “Supplemental Information” portion of the Federal Register notice indicates that the PTO’s position is to discourage duplicate third-party submission of cited documents:

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² See *Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith American Invents Act*, 77 Fed. Reg. 448 (January 5, 2012) (Notice of proposed rulemaking).

“third parties [] should avoid submitting documents that are cumulative in nature” and “need not submit documents that are [] cumulative of information already under consideration by the Office.”³ Nevertheless, this comment urges the Office to define “cumulative” broadly to permit multiple submissions of the same reference bearing substantively different comments because: (i) the statute explicitly permits third parties to submit “any” potentially relevant patents, published applications, or printed publications; and (ii) such submission could assist examination process by drawing attention to critical portions of art that the examiner may not have considered, which ultimately improves patent quality. Submissions relating to an already-cited reference that make duplicative substantive comments should be considered “cumulative” and would not be appropriate for consideration by the examiner. Such an approach furthers the intent behind the Third Party Preissuance Submission statutory provisions, while simultaneously protecting against abuse.

II. Plain Meaning of the Statute

The plain language of Section 122(e)(1) speaks directly to the precise issue, whether third parties may submit any potentially relevant printed documents. In relevant part, Congress permits any third party to “submit for consideration and inclusion in the record...*any patent, published patent application or other printed publication* of potential relevance.”⁴ This language appears unambiguous, indicating that Congress intended to allow third parties to submit patents, published patent applications, and other printed publications when potentially relevant, regardless of whether those documents had already been submitted by the applicant, examiner, or another third party.

One may argue that the phrase, “submit for consideration and inclusion in the record”⁵ supports restricting third-party submissions only to documents not present in the record. Specifically, on this view, “for consideration and inclusion” would be superfluous when applied to the submission of already-cited documents, because the examiner must consider any documents already present in the record.

However, a more careful reading belies such a view. Particularly, the “submission” made to the PTO “for consideration and inclusion in the record” is not merely the patent, patent application, or printed publication. Specifically, paragraph (2) of Section 122(e)(2) requires the “submission” under paragraph (1) to include, *inter alia*, a “concise description of the asserted relevance of each submitted document,” which the examiner must consider and enter into the record.⁶ Accordingly, Congress directs the PTO to

³ 77 Fed. Reg. 450.

⁴ 35 U.S.C. § 122(e)(1) (emphasis added).

⁵ *Id.*

⁶ See § 122(e)(2) (“[a]ny submission under paragraph (1) shall [] set forth a concise description of the asserted relevance of each submitted document”).

“consider[] and inclu[de] in the record” third-party submitted documents *plus* its comments.⁷ As such, when read in context, “for consideration and inclusion” is not superfluous because it refers to material not necessarily present in the record—namely, the comments in the submission. Thus, the plain language of Section 122(e) should be read to permit third parties to submit relevant documents with explanations, even if the applicant already cited such art.

III. The PTO’s Proposed Regulation

One may also argue that Congress failed to explicitly address whether third parties can submit documents already existing in the record. In such a case, any interpretation by the agency will receive *Chevron* deference.⁸

However, the PTO’s proposed regulation offers no additional clarity because the PTO adopted a language that mirrors the statute: “[a]ny third party may submit for consideration and entry in the record... *any patents, published patent applications, or other printed publications* of potential relevance.”⁹ Nevertheless, the PTO cautions third parties against submitting documents “cumulative of information already under consideration by the Office.”¹⁰ The PTO should analyze the submission *as a whole*—both the document and its accompanying comment—to determine whether the submission is cumulative of information already under consideration because, otherwise, the PTO could only accept one explanation per document. Such a practice would restrict the PTO to the first submitted explanation per document, thus excluding entry in the record potentially more valuable subsequently submitted comments. Such a limitation would also preclude multiple third parties from presenting alternative explanations on the same art or correcting misrepresentation by the applicant or another third party. Moreover, any cumulateness determination based on submitted documents alone would be inconsistent with the Congressional intent behind Section 122(e).

IV. Legislative Intent: To Strengthen Patent Quality

The PTO would severely diminish Congress’s goal to improve examination efficacy through third-party comments if the PTO limits third-party submissions to patents, patent applications, and other printed publications not already in the record. Such a restrictive practice could preclude third parties from providing meaningful comments that can

⁷ *See id.*

⁸ *See Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837, 843 (1984).

⁹ 77 Fed. Reg. 457.

¹⁰ *See id.* at 450.

greatly benefit examiners in assessing whether an applicant's claims are novel and nonobvious under Sections 102 and 103.

In fact, the House Report explains that the Act improves on the current practice, which precludes comment submission, because “[s]uch restrictions decrease the value of the information to the examiner.”¹¹ Further, Senator Leahy emphasized that third-party comments will assist examiners with not just “more” information, but “*more and better* information readily available.”¹² Senator Hatch expressed similar views during a floor debate; he stated that allowing third parties to submit “relevant information during the patent examination process provides the PTO with better information about the technology and claimed invention by leveraging the knowledge of the public.”¹³ Finally, Representative Goodlatte commented that third-party prior submission practice helps ensure “a *full record* before [examiners] when making decisions.”¹⁴

Thus, congressional intent would be thwarted by restricting third-party submissions to documents not present in the record—such a limitation precludes examiners from access to a “full record” during examination and prevents benefit of the public’s knowledge, especially when the applicant has mischaracterized the art. For instance, under such a restrictive view, a third party would be precluded from using the procedure to correct a mischaracterized prior art reference in the *Background of the Invention*.¹⁵ Further, if the PTO allows third-party submission of documents already cited in the record, the third party could explain through a claim chart how the broadest reasonable interpretation of a claim reads on the prior art, which would be of substantial value to examiners, who have limited time to perform a detailed review of all submitted references.

Particularly, the PTO would increase examination efficiency by permitting third-party submission of documents in the record along with comments because the submitter can point the examiner to relevant portions of a lengthy and complex art and its importance in a concise claim chart.¹⁶ As Senator Klobuchar explained, “it is unrealistic to believe a[n] examiner would know all the places to look [] or ha[s] the time to search in all the nooks and crannies.”¹⁷ If Congress and the PTO intend to require a precise relevance statement to point out the art’s importance, boundaries, and relevance, it fails to logically follow that Congress or the PTO would prevent a third party from submitting

¹¹ H.R. REP. No. 112-98, at 48-49.

¹² See 157 Cong. Rec. S5322-03, at 12 (emphasis added).

¹³ 157 Cong. Rec. S5402-02, at 25.

¹⁴ 157 Cong. Rec. H4420-06, at 14 (emphasis added).

¹⁵ See Harold C. Wegner, Third Party Prior Art Submissions During Prosecution: Proposed 27 CFR § 1.290 to Implement New 35 USC § 122(e) (January 5, 2012), available at http://www.ipfrontline.com/downloads/Third_Party.pdf (last visited March 1, 2012).

¹⁶ See 77 Fed. Reg. 452.

¹⁷ Cong. Rec. S5356-01, at 2.

such valuable comments or claim charts simply because the underlying art is present in the record.

Furthermore, while the examiners have the final say on how they interpret each prior art reference with respect to the claims, third-party comments on applicant-cited art particularly presents examiners with more views to consider when analyzing the bounds of the prior art and assists the examiners achieve a more proper characterization of the art. When examiners review claims against properly characterized art, the outcome leads to higher quality patents that can better withstand later challenges.

Therefore, the PTO should amend its existing rule to make clear that third parties may provide submissions that address already-cited art. However, this practice—along with other practices under the proposed rule—should be subject to limitations to prevent abuse.

V. Potential Drawbacks

Rather than strengthening patent quality and improving the examination process, the PTO's proposed rule could negatively impact prosecution if left unrefined. First, without any limitation on the number of allowed submissions or guidance on what is "concise," an applicant's competitor could unduly burden the examiner and badger the applicant by submitting lengthy comments for nearly limitless documents not in the record (and, if the approach advocated here is adopted, documents in the record).

Second, different third parties could submit countless conflicting or even misleading explanations on the same art, leaving examiners more perplexed. The proposed rule fails to deter a hostile opponent from submitting fabricated interpretations, because there is no identity disclosure requirement. This problem applies regardless of whether comments can be submitted on previously-cited art.

Third, the PTO's proposed rule fails to explicitly prevent a third party from publishing information on the Internet and submitting such printed publication with a plausible relevance explanation because submissions are not limited to art published prior to filing of the subject patent application.¹⁸ Therefore, seemingly any third party may publish online lengthy arguments that presumably address any patentability issues for third party submission.

To address these concerns, the PTO should amend the rules to prevent cumulateness by requiring that submissions either (i) concern a patent or printed publication not previously cited, or (ii) raise or address arguments that are materially different from those already raised by the examiner, applicant, or by another third party

¹⁸ See *id.*

if the submission pertains to a printed publication published after the date of filing or pertains to already-cited art. Additionally, the PTO may wish to consider restricting the number of pages submitted, requiring a statement that the submitting party or its privies have not drafted the printed publication following applicant's patent application filing to contest the patentability of one of more claims and requiring a statement that the third party has not falsified its submission in any manner.

VI. Conclusion

While preissuance third party participation provides a powerful tool to shape patent prosecution, the PTO can greatly hinder its full benefit if it prevents third parties from submitting documents already cited in the record. The plain language of the statute undoubtedly permits third parties to submit *any* potentially relevant patent, published application, or other printed material and a concise relevance explanation for each submission. Further, the PTO seeks third parties to explain the documents' relevance to patentability and pinpoint the precise location with every submitted document; no sound reason exists as to why a third party should be precluded from providing the same guidance merely because the document is already in the record. Lastly, allowing such a submission helps the PTO grant quality patents, which ultimately reduces litigation. For the above reasons, I urge the PTO to adopt a procedure that permits preissuance third-party submission of documents already present in the record, subject to several potential limitations to prevent abuse.