

UNITED STATES PATENT AND TRADEMARK OFFICE

Testimony of

Harold C. Wegner

responsive to

*Changes to Implement the Preissuance Submissions by Third Parties Provision of
the Leahy-Smith America Invents Act*

(Notice of Proposed Rulemaking),

77 Federal Register 448

(January 5, 2012)

electronically filed: preissuance_submissions@uspto.gov

Sir:

Kindly make of record the attached paper, *Third Party Submission Law of the Leahy Smith Act* (February 1, 2012), which represents my testimony responsive to the captioned Notice of Proposed Rulemaking.

The author is a partner in Foley & Lardner LLP. This paper represents the personal views of the author and does not necessarily represent the views of any colleague, organization or client thereof.

Respectfully submitted,

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THIRD PARTY SUBMISSION LAW OF THE LEAHY SMITH ACT*

Harold C. Wegner**

The *Third Party Submission Law* of the Leahy Smith Act offers the promise of greatly facilitating the examination process by providing examiners with a *useful citation and analysis* of prior art by third parties. The new law will encourage patent applicants to draft cleaner and more forthright patent applications, given that inaccurate or incomplete statements in a patent application may well be challenged through the Third Party Submission Law. *See* 35 USC § 122(e) in *Leahy Smith America Invents Act*, Public Law 112-29 (September 16, 2011), SEC. 8, *Preissuance Submissions by Third Parties*.

The proposed regulations will authorize any third party to submit extremely useful information to the Examiner *before* his examination commences. Such information goes beyond the mere submission of prior art documents but also *requires* the third party to provide a *concise* explanation of the *relevance* of the documents to the examination process. *See Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act* (Notice of proposed rulemaking), 77 Federal Register 448 (January 5, 2012).

* This paper may be cited as Wegner, Harold C., Third Party Submission Law of the Leahy Smith Act (February 1, 2012), available at www.GrayOnClaims.com/hal. This paper represents the personal views of the author and does not represent the views of any colleague, organization or client thereof.

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The promise of the new rules will be fully realized, however, only if the Patent Office amends the proposed rules to tighten up the procedure to stop wasteful “document dumping” and less than forthright submissions.

Among the many valid uses of the Prior Art Submission Law, third parties will be able to –

- explain why prior art seemingly distinguished in the background of the invention actually *is* highly pertinent, such as by demonstrating the broadest reasonable interpretation of claim 1 and then showing precisely how “claim 1” reads on that prior art (and is hence anticipated) or reads on subject matter very close to outer boundaries of the claim (which is hence rendered obvious);
- explain in a continuing application under 35 USC § 120 (including continuation, continuation-in-part or divisional) why a claim not supported verbatim in the parent application is *not* supported within the meaning of 35 USC § 112, ¶ 1, so that the published parent patent application constitutes a patent defeating anticipation under 35 USC § 102(b);
- cite an e-mail with an enabling disclosure of the invention addressed to a group of workers skilled in the art, without restriction, and explain why that e-mail *is* prior art under 35 USC § 102(b) because of the open circulation of the prior art without secrecy restrictions; and
- cite prior art that shows *KSR* factors such as “design need” which, taken together with prior art cited in the Background of the Invention, render the claimed invention obvious.

For the good points of the proposed rulemaking, it is sufficient to say that the proposed rules are excellent in providing pathways for bona fide third party submissions.

Yet, there are loopholes which are found in the rulemaking that will make it possible for unscrupulous parties to anonymously harass patent applicants by

- citing untold thousands of pages of documents to electronically “flood” the file with documents that a diligent applicant will feel compelled to review;
- hiring a person without any degree of knowledge of patent law to conduct a search who would provide, say, 50 documents with his statement of “relevance” which would be completely uninformed by the necessary knowledge of patent law; or
- presenting a seemingly plausible attack with seemingly relevant prior art which is fabricated.

The loopholes permitting these examples include the following:

First, there is no explicit requirement that the third party be *identified* in the Prior Art Submission. Thus, a strawman giving an address in Tehran, Caracas or Havana could electronically submit a Prior Art Submission where there would be no way for the Office to meaningfully sanction such an offshore miscreant outside the effective reach of the law.

The safeguard under the proposed rules to guard against improper submissions is for the Patent Office to *review* submissions to screen out those that are improper. But, this is not a satisfactory solution for two reasons: There will be an inherent delay of days – or weeks or months, depending upon the success of this program – whereas if filings were by a registered practitioner this screening would not be necessary. Additionally, without limitation to filings by registered

practitioners, there will be *apparently* proper submissions which include fabrications of the truth which will pass screening and get into the electronic file wrapper.

Second, there is no limit on the number of pages of a document that may be submitted. For example, an entire specialty chemical treatise having the thickness of *War and Peace* could be submitted without any charge.

Third, there is no effective limitation on the number of citations that may be included in a Prior Art Submission: For a couple thousand dollars *dozens* of prior art references may be submitted.

Fourth, written (non-electronic) submissions are permitted which will unnecessarily slow down transformation of the filing into electronic form for the electronic file wrapper.

These loopholes *must* be plugged or an unscrupulous small minority of the public *will* harass legitimate patent applicants. This will cause great discredit to this important new aspect of the patent system under the Leahy Smith Act.

It is suggested that the amendments be made to the proposed regulations as outlined in the Appendix to this paper.

Proposed Amendments to the **Preissuance Submission Proposed Rule 290**

Additions are in bold, underlined and turquoise highlighted
[Deletions in gray shaded bracketing]
Comments are highlighted in yellow
[Blue Bracketed titles added for emphasis, not part of the rules]

37 CFR § 1.290 Submissions by third parties in applications.

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(c) **[Manner of Submission]** Any third-party submission under this section must be **filed electronically as a pdf document with the submission being in whole text readable form** *[made in writing]*, and identify on each page of the submission, except for copies required by paragraph (d)(3) of this section, the application to which the submission is directed by application number.

Comment: The proposed rules do not require electronic submission: “The Office plans to *permit* third-party preissuance submissions to be filed via the Office electronic filing system (EFS-Web).” 77 Federal Register 449 (emphasis added). With the tight time deadlines for submission the impact of early submissions should not be diluted by permitting filings other than in electronic form as to do otherwise would unduly delay inclusion in the electronic file wrapper.

(d) [[Contents of Submission](#)] Any third-party submission under this section **must be made by a registered practitioner who identifies the third party and** must include:

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Comment: Only a registered practitioner is presumed qualified to have sufficient knowledge of patent law necessary to make the mandatory “concise description of the asserted relevance” as to patentability under 35 USC § 122(e)(2)(A). Unlike *ex parte* reexamination which may be filed blind, i.e., by “[a]ny person at any time”, here, the *statute itself* limits the law to submissions to “[a]ny third party”; 35 USC § 122(e)(1).

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(f) [[Fees for Document submission](#)] Any third-party submission under this section must be accompanied by the fee set forth in § 1.17(p) for every ten documents or fraction thereof being submitted, **provided also that where the cumulative number of pages of submitted documents other than patents or published patent applications exceeds 50 pages, the submitter shall identify up to fifty pages which are considered most pertinent and limit the actual submission to such pages.**

Comment: There *must* be a strict limit on the number of pages of documents which are submitted to avoid “flooding” the file. The 50 page limit would not preclude a submission of documents with a greater number of pages but would compel the submitter to *identify* the relevant pages to fall under the 50 page limit.

(2) Cumulative prior art references shall not be included in any Preissuance Submission. Where more than three documents are submitted, the third party shall explain which documents up to three are most relevant and why any other submitted documents are not merely cumulative.

Comment: The statute *requires* that the submission include a “concise description of the asserted relevance” under 35 USC § 122(e)(2)(A). There is thus no additional burden in a requirement to segregate the references which are merely cumulative. There is no place for the mischief that would be created by flooding a file with cumulative citations.

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