

Submitting Publications In U.S. Patent Applications

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As of September 16, 2012, third parties have been able to make "Preissuance Submissions" of printed publications in pending U.S. patent applications. To date, the USPTO has received just over 100 Preissuance Submissions. This article looks at important timing and disclosure requirements that parties considering making such submissions should keep in mind when deciding whether to take advantage of this new program.

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The Statutory And Regulatory Framework

Section 8 of the America Invents Act amended 35 USC § 122 to provide for Preissuance Submissions. The USPTO's implementing regulations are found in new 37 CFR § 1.290 and revised 37 CFR § 1.291. Key requirements and related strategies are outlined below.

The Timing Requirements

Preissuance Submissions can be made in applications that were pending before September 16, 2012, but certain timing requirements must be satisfied. By statute, a Preissuance Submission must be filed by

the **earlier** of—

(A) the date a **notice of allowance** or

(B) the **later** of—

(i) 6 months after the application is first published under 35 USC § 122 or

(ii) the date of the first rejection of any claim by the examiner under 35 USC § 132

This means that a Preissuance Submission can be filed within 6 months of publication of the application unless a Notice of Allowance has been issued (even if an Office Action has been issued), and can be filed beyond 6 months after publication of the application as long as an Office Action on the merits or Notice of Allowance has not been issued.

Third parties who want to be able to make Preissuance Submissions may want to consider instituting watches for published applications in certain technologies or by certain applicants, and could include PCT and non-U.S. applications in their searches in order to identify potential target applications (e.g., priority applications) as early as possible.

Applicants who want to shield their patent applications from Preissuance Submissions may want to consider making non-publication requests (if ex-U.S. patent protection is not being sought) or pursuing expedited examination (such as under Track 1 or the Patent Prosecution Highway), to increase the likelihood that a Notice of Allowance will be issued before any Preissuance Submission is made.

The Formal Requirements

The USPTO's implementing regulations set forth a number of formal requirements for Preissuance Submissions. Notably, Preissuance Submissions can be made via a dedicated interface in the USPTO's EFS-Web system. The USPTO encourages the use of the EFS-Web system because it walks users through the formal requirements and also confirms that the timing requirements are satisfied for the patent application at issue.

The Substantive Requirements

By statute, a Preissuance Submission can cite "any patent, published patent application, or other printed publication of potential relevance to the examination of the application." The USPTO has interpreted this provision as permitting the submission of references that are **not prior art** to the application at issue, of references that are **identical** to or **cumulative** of references that already are of record, and as including documents issued or filed in connection with **ex-U.S. patent prosecution**, as long as such documents qualify as printed publications.

Third parties considering making Preissuance Submissions may want to determine whether any relevant rejections or arguments have been made in corresponding foreign applications. On the other hand, applicants with ex-U.S. applications undergoing active prosecution may want to be mindful of the possibility that any arguments or claim amendments they make could be provided to the U.S. examiner under the Preissuance Submissions program.

The Description Of Relevance

The statute requires the third party to provide "a concise description of the asserted relevance of each submitted document." The USPTO has cautioned that this provision "does **not** permit third parties to submit arguments against patentability or set forth conclusions regarding whether one or more claims are patentable," and "is not an invitation for a third party to propose rejections of the claims or set forth arguments relating to an Office action ... or to an applicant's reply to an Office action." Indeed, the USPTO may **reject** a Preissuance Submission if it cites 35 USC § 102 or 35 USC § 103, or discusses anticipation or obviousness. The USPTO has provides the following guidance on its [AIA Implementation webpage](#) :

A concise description of relevance should set forth facts explaining how a particular printed publication is of potential relevance to the examination of the application in which the submission has been filed. This is done, most effectively, by (i) pointing out relevant pages or lines of the respective printed publication where the relevant issues raised by the text are located; and (ii) providing a focused description of the import of the cited text to draw the examiner's attention to the issues. Also, a concise description may be presented in narrative or claim chart form.

Strategic Considerations

The main goal of the Preissuance Submissions program is to provide relevant information to Examiners early in the examination process, to improve the quality of granted patents. Before making a Preissuance Submission in a specific patent application, third parties may want to consider their objectives and the possible outcomes, keeping in mind the restrictions on the explanations that can be provided.

- If a cited publication is not cited in an Office Action (but is deemed to have been "considered" by the Examiner via the Preissuance submission process), will it be harder to invalidate the resulting patent?
- If a cited publication is cited in an Office Action, and the applicant argues around it, will it be harder to invalidate the resulting patent?
- If a cited publication is cited in an Office Action, and the applicant amends around it, will the amended claims be harder to invalidate? Will the amended claims provide the desired freedom to operate?

The Impact On Examination

It will take some time before there is enough data to assess whether Preissuance Submissions have a meaningful impact on U.S. patent prosecution, and even more time before we can determine whether they improve patent quality. Until then, it will be interesting to see how frequently Examiners apply submitted publications in rejections.