As of September 16, 2012, third parties have been able to make “Preissuance Submissions” of printed applications in pending U.S. patent applications. To date, the USPTO has received over 350 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 the new program.

The Statutory and Regulatory Framework
Section 8 of the America Invents Act amended 35 USC § 122 and revised 37 CFR § 1.291. Key requirements and restrictions are as follows:

The Timing Requirements
Preissuance Submissions can be made in applications that are 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 of issuance of a Notice of Allowance or
  (b) 6 months after the application was filed.

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, and can be filed before 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 make Preissuance Submissions may want to consider instituting watch lists 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., prior art 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 I or the Patent Prosecution Highway), to increase the likelihood that a Notice of Allowance will be issued before any Preissuance Submission is made.

The Substantive Requirements
By statute, a Preissuance Submission can cite “any patent, published patent application, or other printed publication.” The USPTO has interpreted this provision to permit the submission of references that are not prior art to the application at issue of relevance (i.e., that are not identified as an evaluation of whether any claims are patentable, and are not part of a Preissuance Submission if it cites 35 USC § 102 or 35 USC § 103, or discusses anticipation or obviousness). The USPTO has also cautioned that this provision (i) permits third parties 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 has provided the following guidance on its AIA Implementation webpage:

A concise description of relevance should set forth facts explaining how a particular printed publication is relevant. The description should be presented in narrative or claim chart form. Also, a concise description may be presented in narrative or claim chart form.

The Formal Requirements
Preissuance Submissions must be filed by 37 CFR § 1.291. The USPTO's implementing regulations set forth a number of formal requirements for Preissuance Submissions. Namely, 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 allows third parties to review other Preissuance Submissions. Notably, Preissuance Submissions can be made via a dedicated interface in the USPTO's EFS-Web system. By statute, a Preissuance Submission must be filed by:

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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 published a Notice setting forth the regulations for Preissuance Submissions. These regulations require the following information:

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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, and to reduce the cost of granting a patent. Third parties may want to consider their objectives and the possible outcomes, keeping in mind the restrictions on the explanations that can be provided:

- It is important for third parties to be aware that their Preissuance Submissions may be used by Examiners to make a decision on the merits.

The Impact On Examination
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?

Examiner via the Preissuance submission process), will it be harder to invalidate the resulting patent?

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), and it is harder to invalidate the resulting patent?

If a citation to a prior art publication is made in an Office Action, and the applicant amends around it, will it be harder to invalidate the resulting patent?

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