

CERTAIN PROPOSED U.S. PTO RULES IN COMPLIANCE WITH THE AMERICA INVENTS ACT

By Mel R. Quintos

This Newsletter will summarize three subject areas in which rules have been proposed in compliance with the new America Invents Act signed into law on September 16, 2011. The three subject areas discussed here are as follows: (i) third party submission of prior art in a patent application (Federal Register 448, Vol. 77, No. 3, January 5, 2012); (ii) citation of prior art in a patent file (Federal Register 442, Vol. 77, No. 3, January 5, 2012); and (iii) supplemental examination (Federal Register 3666, Vol. 77, No 16, January 25, 2012).

Third Party Submission of Prior Art in a Patent Application:

A third party may submit prior art in a patent application for consideration and entry in the record of the patent application. The prior art may be any patents, published patent applications, or other printed publications of potential relevance to the examination of the application. The filing of the submission must be made before the earlier of: (1) the date of a notice of allowance, or (2) the later of: (i) six months after the date on which the application is first published by the U.S. PTO or (ii) the date of the first rejection of any claim.

The third party submission must include: (1) a list of the documents being submitted; (2) a concise description of the asserted relevance of each listed document; and (3) a legible copy of each listed document (other than U.S. patents and U.S. patent application publications, unless required by the U.S. PTO).

It is important to note that the party making the submission include a statement that: (1) the party is not an individual who has a duty to disclose information with respect to the patent application under 37 C.F.R. '1.56; and (2) the submission complies with the 35 U.S.C. '1.22(e) (entitled, Preissuance Submissions by Third Parties).

The submission must be accompanied by the \$180.00 fee (37 C.F.R. '1.17(p)) for every ten documents (or fraction thereof). There is no fee if the submission lists three or fewer documents and accompanied by a statement that, for the party making the submission, it is the first and only submission being made under 35 U.S.C. '1.22(e).

Citation of Prior Art in a Patent File:

The scope of information that a third party may submit in a patent file is expanded to include a patent owner's written statements filed before a Federal court or the U.S. PTO regarding the scope of any claim of the patent. The U.S. PTO may use such written statements to determine the meaning of a patent claim in an

ex parte proceeding already ordered and *inter partes* review and post grant review proceedings already instituted.

In certain instances where a third party requester has filed a petition for *inter partes* review or post grant review and a final written decision has been issued, the third party requester is estopped from filing a request for *ex parte* reexamination.

To assist the U.S. PTO in identifying the proceeding where the patent owner claim scope statement was made, the submitter should also consider providing the following information: (1) the forum in which the statement was made (i.e., the specific Federal court or the Office); (2) the Federal court or Office proceeding designation (i.e., case citation or numerical designation); (3) the status of the proceeding; (4) the relationship of the proceeding to the patent in which the submission is being made; (5) an identification of the specific papers of the proceeding containing the statement of the patent owner; and (6) an identification of the portion(s) of the papers relevant to the written statement being asserted to constitute the patent owner's statement. The submission may be anonymous.

Supplemental Examination:

A supplemental examination may be requested by the patent owner to Aconsider, reconsider or correct information believed to be relevant to the patent.@ The information that may be presented by the patent owner is not limited to patents and printed publications, and may include, e.g., issues concerning patentability under 35 U.S.C. ' ' 101 and 112. The U.S. PTO conducts the supplemental examination to determine whether there is a Asubstantial new question of patentability@ by the issuance of a supplemental examination certificate, which indicates that an *ex parte* reexamination has been ordered by the U.S. PTO.

The basis of the *ex parte* reexamination is not limited to patents and printed publications; and the patent owner does not have the right to file a statement in the *ex parte* reexamination.

Information that is considered, reconsidered or corrected during the supplemental examination cannot be used for finding the patent unenforceable, as long as the supplemental examination and subsequent *ex parte* reexamination so ordered are finished prior to a civil action being brought.

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