DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Parts 1 and 41

[Docket No.: PTO–P–2011–0073]

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

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The United States Patent and Trademark Office (Office) is revising the rules of patent practice to implement the preissuance submissions by third parties provision of the Leahy-Smith America Invents Act (AIA). This provision provides a mechanism for third parties to contribute to the quality of issued patents by submitting to the Office, for consideration and inclusion in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application. A preissuance submission may be made in any non-provisional utility, design, and plant application, as well as in any continuing application. A third-party preissuance submission must include a concise description of the asserted relevance of each document submitted, and must be submitted within a certain statutorily specified time period. The third party must submit a fee as prescribed by the Director, and a statement that the submission complies with the statutory provision. The Office has also revised the rules of patent practice to make related aspects of the existing protest rule more consistent with the new rule implementing the preissuance submissions by third parties provision. Further, the Office is eliminating the provision providing for public use proceedings.

DATES: *Effective Date:* The changes in this final rule take effect on September 16, 2012.

Applicability Date: The changes in this final rule apply to any application filed before, on, or after September 16, 2012.

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SUPPLEMENTARY INFORMATION:

Executive Summary: Purpose: Section 8 of the AIA amends the patent laws to provide a mechanism for third parties to submit to the Office, for consideration and inclusion in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application. The changes in section 8 of the AIA take effect on September 16, 2012. This final rule revises the rules of practice to implement the provision of section 8 of the AIA.

Summary of Major Provisions: This final rule specifies the requirements for third parties to file a preissuance submission of patents, published patent applications, or other printed publications of potential relevance to the examination of an application. A preissuance submission must be timely filed, in writing, and contain: (1) A list identifying the items being submitted; (2) a concise description of the relevance of each item listed; (3) a legible copy of each non-U.S. patent document listed; (4) an English language translation of any non-English language item listed; (5) a statement by the party making the submission that the submission complies with the statute and the rule; and (6) the required fee.

The Office is revising the rules of practice to harmonize, where appropriate, the practice regarding protests with the practice regarding preissuance submissions. The Office is also revising the rules of practice to eliminate the former practice for making third-party submissions in published patent applications and to eliminate the practice regarding public use proceedings.

Costs and Benefits: This rulemaking is not economically significant as that term is defined in Executive Order 12866 (Sept. 30, 1993).

Background: The AIA was enacted into law on September 16, 2011. *See* Public Law 112–29, 125 Stat. 284 (2011). This final rule changes the rules of practice to implement section 8 of the AIA, which provides a mechanism for third parties to submit to the Office, for consideration and inclusion in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application.

Section 8 of the AIA amends 35 U.S.C. 122 by adding 35 U.S.C. 122(e), which enumerates certain conditions that apply to a third-party preissuance submission to the Office in a patent application. Pursuant to 35 U.S.C. 122(e), preissuance submissions of patents, published patent applications, or other printed publications must be made in patent applications before the earlier of: (a) The date a notice of allowance under 35 U.S.C. 151 is given or mailed in the application; or (b) the later of (i) six months after the date on which the application is first published under 35 U.S.C. 122 by the Office, or (ii) the date of the first rejection under 35 U.S.C. 132 of any claim by the examiner during the examination of the application. 35 U.S.C. 122(e) also requires a concise description of the asserted relevance of each document submitted, a fee as prescribed by the Director, and a statement by the person making the third-party preissuance submission that the submission was made in compliance with 35 U.S.C. 122(e).

The preissuance submissions by third parties provision of the AIA takes effect on September 16, 2012. This provision applies to any patent application filed before, on, or after September 16, 2012.

This final rule implements 35 U.S.C. 122(e) in a new rule, 37 CFR 1.290, and revises the rules of practice in title 37 of the Code of Federal Regulations (CFR) concerning other related third-party practices. This final rule eliminates 37 CFR 1.99, which provided for third-party submissions of patents, published patent applications, or printed publications in published patent applications, but did not permit an accompanying concise description of the relevance of each submitted document and limited the time period for such submissions to up to two months after the date of the patent application publication or the mailing of a notice of allowance, whichever is earlier. By contrast, new 35 U.S.C. 122(e) and 37 CFR 1.290 permit third parties to submit the same types of documents, but with an accompanying concise description of relevance of each document submitted, and provide third parties with the same or more time to file preissuance submissions with the Office when compared with former 37 CFR 1.99. Third-party submissions under 37 CFR 1.290 provide an enhanced opportunity for third parties to identify and describe potentially relevant publications to the Office.

This final rule also eliminates the public use proceeding provisions of 37 CFR 1.292. Because section 6 of the AIA makes available a post-grant review proceeding in which prior public use may be raised, the pre-grant public use proceeding previously set forth in 37 CFR 1.292 is no longer necessary.

Additionally, information on prior public use may continue to be submitted by third parties via a protest in a pending application when the requirements of 37 CFR 1.291 have been met, and utilization of 37 CFR 1.291 will promote Office efficiency with respect to treatment of these issues. Such requests for a public use proceeding under 37 CFR 1.292 were very rare, and the few public use proceedings conducted each year were a source of considerable delay in the involved applications and seldom led to the rejection of claims on the basis of public use.

In view of the elimination of 37 CFR 1.99 and 37 CFR 1.292, this final rule amends 37 CFR 1.17 to eliminate the document submission fees pertaining to 37 CFR 1.292 and to add the document submission fee pertaining to new 37 CFR 1.290. This final rule also amends 37 CFR 41.202 to remove a reference to 37 CFR 1.99.

Additionally, this final rule amends 37 CFR 1.8 to add, among other items, third-party submissions filed under 37 CFR 1.290 to the list of items to which no benefit of a certificate of mailing or transmission will be given, and amends 37 CFR 1.6 to provide that facsimile transmissions are not permitted for third-party submissions, to which no benefit of a certificate of mailing or transmission will be given pursuant to 37 CFR 1.8.

In the notice of proposed rulemaking, the Office proposed to permit third-party submissions directed to reissue applications. *See Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 448, 449 and 451 (Jan. 5, 2012). After reviewing the public comments received and revisiting this proposal, the Office has decided not to adopt its previously proposed position. Instead, the Office will continue to maintain its position that a reissue application is a post-issuance proceeding, as set forth in the *Manual of Patent Examining Procedure* (MPEP) § 1441.01 (8th ed. 2001) (Rev. 8, July 2010) (''a reissue application is a post-issuance proceeding''). Accordingly, a preissuance submission under 35 U.S.C. 122(e) is not permitted to be filed in a reissue application since 35 U.S.C. 122(e) is limited to *preissuance* submissions by third parties in patent applications. Third parties who have a need to submit information in a reissue application are advised to avail themselves of the protest provisions of 37 CFR 1.291. *See* MPEP § 1441.01 (providing that ''the prohibition against the filing of a protest after publication of an application under 35 U.S.C. 122(c) is not applicable to a reissue application'').

Third-party submissions also are not permitted in reexamination proceedings because reexamination proceedings are post-issuance proceedings. *See* 35 U.S.C. 302 and 35 U.S.C. 311.

In the notice of proposed rulemaking, the Office proposed amendments to 37 CFR 1.291 to make the requirements for submitting protests against pending patent applications clearer and, where appropriate, more consistent with the requirements of new 37 CFR 1.290. *See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 451. While this final rule amends some aspects of 37 CFR 1.291 to streamline the requirements for submitting protests, as proposed, this final rule retains some of the original language of 37 CFR 1.291 because, in view of comments submitted by the public, the Office recognizes that its proposed attempt to harmonize the language of 37 CFR 1.291 with new 37 CFR 1.290 may have resulted in some confusion.

Comments questioned the necessity for maintaining 37 CFR 1.291 in view of new 37 CFR 1.290 if both provided for the same type of third-party submissions. For example, if the concise explanation requirement of 37 CFR 1.291(c)(2) is no different than the concise description of relevance required by 35 U.S.C. 122(e)(2)(A), then a question is raised as to whether it is necessary to maintain 37 CFR 1.291. *See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 454.

Protests pursuant to 37 CFR 1.291 are supported by a separate statutory provision, 35 U.S.C. 122(c), which implies the availability of submitting a protest in an application prior to publication, absent the applicant's consent. Further, 37 CFR 1.291 is not deemed duplicative or unnecessary because it permits the submission of information that is not permitted in a third-party submission under 37 CFR 1.290. Specifically, 37 CFR 1.291 provides for the submission of information other than publications, including any facts or information adverse to patentability, and arguments to that effect. *See* MPEP §§ 1901, 1901.02 and 1901.06(VII). That Congress provided for 35 U.S.C. 122(e), which permits concise descriptions of relevance to be submitted after publication, without rescinding 35 U.S.C. 122(c) evidences Congressional intent to supplement, not eviscerate, protests under 35 U.S.C. 122(c).

To eliminate any confusion, this final rule retains the language of 37 CFR 1.291(c)(2) requiring a protest to include a ''concise explanation of the relevance'' of each item of information submitted as opposed to the proposed ''concise description of the asserted relevance'' and highlights a distinction between the concise explanation required under 37 CFR 1.291 for protests and the concise description required by 35 U.S.C. 122(e) for preissuance submissions. Unlike the concise description of relevance required by 35 U.S.C. 122(e) for a preissuance submission, which is limited to a description of a document's relevance, the concise explanation for a protest under 37 CFR 1.291 allows for arguments against patentability.

Additionally, the proposed addition of a reference to 35 U.S.C. 122(b) in the 37 CFR 1.291(b) requirement that a protest be filed prior to the date the application was published under 37 CFR 1.211 has not been retained in this final rule in view of comments regarding whether the inclusion of 35 U.S.C. 122(b) suggested that an earlier publication by the World Intellectual Property Organization (WIPO) of an international application designating the U.S. could trigger the end of the 37 CFR 1.291(b) time period for an application which entered the national stage from the international application after compliance with 35 U.S.C. 371. Because there has been no change in Office policy that a publication by the Office under 37 CFR 1.211 triggers the end of the time period under 37 CFR 1.291(b) for filing a protest, absent an earlier notice of allowance, the proposed reference to 35 U.S.C. 122(b) has not been retained, thereby confirming and clarifying current Office practice that an earlier publication of the application by WIPO would not prevent a protest from being filed in accordance with 37 CFR 1.291(b).

General Discussion of Implementation: A third-party submission under 37 CFR 1.290 may be made in any non-provisional utility, design, or plant application, as well as in any continuing application. These submissions may not be made in reissue applications or reexamination proceedings.

The Office has developed a dedicated Web-based interface to permit third-party submissions under new 37 CFR 1.290 to be filed electronically. Third parties can access the preissuance submissions Web-based interface by selecting the preissuance submissions filing option in the Office's electronic filing system—Web (EFS-Web). Additionally, third-party submissions may be filed in paper via first-class

mail, United States Postal Service (USPS) Express Mail service pursuant to 37 CFR 1.10, or delivery by hand. Facsimile transmission of third-party submissions is not permitted. *See* 37 CFR 1.6(d)(3).

When filing a third-party submission electronically, a third party will receive immediate, electronic acknowledgment of the Office's receipt of the submission. When filing a third-party submission in paper, a third party may include a self-addressed postcard with the submission to receive an acknowledgment by return receipt postcard that a third-party submission has been received. In either case, the electronic acknowledgment or return receipt postcard is not an indication that the third-party submission is compliant or has been entered; rather, it merely shows Office receipt of the submission.

Third-party submissions, whether submitted in paper or electronically via the dedicated Web-based interface, will not be automatically entered into the electronic image file wrapper (IFW) of an application, *i.e.,* will not be made of record in the application. Instead, third-party submissions submitted by third parties will be reviewed by the Office to determine compliance with 35 U.S.C. 122(e) and 37 CFR 1.290 before being entered into the IFW. Third parties are encouraged to file third-party submissions electronically via the dedicated Web-based interface because the Office plans to automatically verify the timeliness of a submission, as well as some of the content of a submission (*e.g.,* U.S. patent and published patent application data). Electronic filing via the dedicated Web-based interface will be the most efficient means of making compliant third-party submissions available to an examiner for consideration, as compliant third-party submissions filed in paper will experience a delay in entry due to the additional processing required for scanning and indexing of paper submissions into electronic form. Additionally, third parties filing third-party submissions electronically via the dedicated Web-based interface will receive immediate, electronic acknowledgment of the Office's receipt of the submission, instead of waiting for the Office to mail a return receipt postcard when provided with a paper submission.

The EFS-Web Legal Framework previously prohibited third-party submissions under 37 CFR 1.99 from being filed electronically in patent applications because documents filed electronically via EFS-Web were instantly loaded into the IFW. *See Legal Framework for Electronic Filing System—Web (EFS-Web),* 74 FR 55200, 55202, 55206-7 (October 27, 2009). Because third-party submissions filed electronically in EFS&-Web via the dedicated Web-based interface for preissuance submissions will be screened for compliance with the requirements of 35 U.S.C. 122(e) and 37 CFR 1.290 before being entered into the IFW of an application, the EFS-Web Legal Framework will be revised to permit such submissions. Third parties are cautioned that electronically filing a third-party submission other than via the dedicated Web-based interface for preissuance submissions is prohibited (*i.e.,* a third party must select the ''Third-Party Preissuance Submission under 37 CFR 1.290'' option in EFS-Web). Additionally, the EFS-Web Legal Framework continues to prohibit protests under 37 CFR 1.291 from being filed electronically in patent applications.

The Office has established procedures to complete its compliance determination, for both paper and electronic submissions, promptly following receipt of the submission so that compliant third-party submissions will be quickly entered into the IFW and made available to the examiner for consideration. Third-party submissions filed in paper, however, will incur more processing delay than submissions filed electronically via the dedicated Web-based interface for preissuance submissions due to the scanning and indexing process.

Third-party submissions that are not compliant with the statute will not be entered into the IFW of an application or considered, and will be discarded. Also, the Office will not refund the required fees in the event a third-party submission is determined to be non-compliant. The statutory time period for making a third-party submission will not be tolled by an initial non-compliant submission. The Office will not set a time period for a third party to file a corrected third-party submission. Additionally, the Office will not accept amendments to a non-compliant submission that was previously filed. Instead, a third party who previously filed a non-compliant submission may file another complete submission, provided the statutory time period for filing a submission has not closed.

If the third party provides an electronic mail message (email) address with a third-party submission, whether filed electronically or in paper, the Office intends to notify the third-party submitter of such non-compliance at the email address provided and to include the reason(s) for non-compliance (*e.g.,* a document was listed improperly, a copy of a document was not submitted, a concise description was not provided for a document, etc.). No notification will be issued where a third party does not provide an email address with the submission. Neither the notification nor the non-compliant third-party submission will be made of record in the application. The Office intends to provide such notification as a result of numerous comments the Office received regarding the Office's proposal to not notify a third party of a non-compliant third-party submission.

Third parties are not required to serve the applicant with a copy of the third party submission. However, the Office intends to notify the applicant upon entry of a compliant third-party submission in their application file where the applicant participates in the Office's e-Office Action program. Such notification is being provided as a result of numerous comments the Office received regarding the Office's proposal to not directly notify applicants of the entry of a third-party submission in an application. In order to receive such notification, the applicant must participate in the Office's e-Office Action program, as such notification will only be provided via email to program participants. The contents of a compliant third-party submission will be made available to the applicant via its entry in the IFW of the application. An applicant may view non-patent documents identified in a third-party submission document list via the Office's private Patent Application Information Retrieval (PAIR) system. By not requiring service of third-party submissions on the applicant, the Office is underscoring that such third-party submissions will not create a requirement on the part of the applicant to independently file the submitted documents with the Office in an information disclosure statement (IDS). Additionally, the Office is seeking to prevent challenges regarding whether service of a third-party submission was proper from negatively impacting the pendency of the application.

35 U.S.C. 122(e) does not limit third-party preissuance submissions to pending applications. A third-party submission made within the statutory time period, and otherwise compliant, will be entered even if the application to which the submission is directed has been abandoned. An examiner will not consider such third-party submission unless the application resumes a pending status (*e.g.,* the application is revived, the notice of abandonment is withdrawn, etc.). The abandonment of an application will not, however, toll the statutory time period for making a

third-party submission. For example, if prior to publication an application goes abandoned because the applicant fails to timely respond to a first rejection of any claim, and the application is later revived, the time period for making a third-party submission will run until the earlier of the date of a notice of allowance or the date that is six months after the application's publication date. Additionally, a third-party submission made within the statutory time period, and otherwise compliant, will be entered even if the application to which the submission is directed has not been published, for example, due to a non-publication request filed under 35 U.S.C. 122(b)(2)(B)(i) and § 1.213.

Compliant third-party submissions will be considered by the examiner when the examiner next takes up the application for action following the entry of the third-party submission into the IFW. An examiner will consider the documents and concise descriptions submitted in a compliant third-party submission in the same manner that the examiner considers information and concise explanations of relevance submitted as part of an IDS. Similarly, examiner consideration of a document and its accompanying concise description of relevance in a third-party submission does not mean that the examiner agrees with the third party's position regarding the document, only that the examiner considered the publication and its accompanying description. Generally with the next Office action, a copy of the third party's listing of documents with an indication of the examiner's consideration (*e.g.,* an initialed form PTO/SB/429) will be provided to the applicant. Documents from a third-party submission that were considered by the examiner will be printed on the patent, similar to the way documents from an IDS that were considered by the examiner are printed on the patent. Accordingly, an applicant need not file an IDS to have the same documents that were previously submitted by a third party as part of a compliant third-party submission considered by the examiner in the application. The Office is updating its existing information technology (IT) systems to distinguish considered third-party submission documents on an issued patent from documents cited by the applicant and by the examiner.

Examiners will acknowledge in the record of the patent application the examiner's consideration of the documents submitted. This acknowledgment will be made in a manner similar to that of the examiner's consideration of applicant-submitted documents filed as part of an IDS. For example, the examiner may indicate at the bottom of each page of a third-party submission ''All documents considered except where lined through,'' along with the examiner's electronic initials and the examiner's electronic signature on the final page of the submission. *See, e.g.,* MPEP § 609.05(b). Such indication by the examiner placed at the bottom of each page of a third-party submission will mean that the examiner has considered the listed documents and their accompanying concise descriptions. While every effort will be made to ensure that only compliant third-party submissions are entered for an examiner's consideration, in the unlikely event an examiner cannot consider a listed document, the examiner will strike through the document to indicate that the examiner did not consider either the document or its accompanying concise description. If the examiner does not cite the stricken document on a form PTO–892, the applicant may file an IDS to have the document considered, if deemed necessary. Because the prosecution of a patent application is an *ex parte* proceeding, no response from a third party with respect to an examiner's treatment of the third-party submission will be permitted or considered.

Since it would be advantageous for examiners to have the best art before them prior to issuing the first Office action on the merits, and because a first action allowance in the application could close the time period for making a preissuance submission under 35 U.S.C. 122(e), third parties should consider providing any third-party submission at the earliest opportunity. Additionally, because highly relevant documents can be obfuscated by voluminous submissions, third parties should limit any third-party submission to the most relevant documents and should avoid submitting documents that are cumulative in nature. Third parties need not submit documents that are cumulative of each other or that are cumulative of information already under consideration by the Office. Nonetheless, in some instances, third parties may deem it necessary to submit a document in an application that was previously made of record in the application, where the third party has additional information regarding a document that was not previously considered. Third parties are reminded that 35 U.S.C. 122(e) requires that the documents submitted be ''of potential relevance to the examination of the application'' and that the relevance of each document submitted must be provided in an accompanying concise description.

The Director has set the fees for third-party submissions to recover costs to the Office for third-party submissions to the Office. 35 U.S.C. 122(e) expressly provides for ''such fee as the Director may prescribe.'' The Office is setting fees for third-party submissions in this final rule pursuant to its authority under 35 U.S.C. 41(d)(2), which provides that fees for all processing, services, or materials relating to patents not specified in 35 U.S.C. 41 are to be set at amounts to recover the estimated average cost to the Office of such processing, services, or materials. *See* 35 U.S.C. 41(d)(2). The prior practice (37 CFR 1.99) provided for a third-party submission of up to ten documents for the fee set forth in 37 CFR 1.17(p) (currently $180.00). The Office expects the processing costs to the Office for third-party submissions under new 37 CFR 1.290 to be equivalent to the processing costs to the Office for submissions under former 37 CFR 1.99. Accordingly, the Office has determined that the fee set forth in 37 CFR 1.17(p) will also be applicable to third-party submissions under 37 CFR 1.290 such that the fee set forth in 37 CFR 1.17(p) will be required for every ten documents, or fraction thereof, listed in each third-party submission.

The Office is providing an exemption from this fee requirement where a third-party submission lists three or fewer total documents and is the first third-party submission by a third party or a party in privity with the third party, in a given application. The Office is providing this fee exemption for the first third-party submission in an application by a third party containing three or fewer total documents because the submission of a limited number of documents is more likely to assist in the examination process and thus offset the cost of processing the submission. Moreover, keeping the size of the fee exempted submission to three or fewer total documents will help to focus the attention of third parties on finding and submitting only the most relevant art to the claims at hand. Where one third party takes advantage of the fee exemption in an application, another third party is not precluded from also taking advantage of the fee exemption in the same application provided that the third parties are not in privity with each other.

The fees set or adjusted in this notice will subsequently be revisited and may be proposed to be set or adjusted in a notice of proposed rulemaking under section 10 of the AIA.

Discussion of Specific Rules

The following is a discussion of the amendments to Title 37 of the Code of Federal Regulations, part 1, that are implemented in this final rule:

Section 1.6: Section 1.6(d)(3) is amended to provide that facsimile transmissions are not permitted for third-party submissions under § 1.290, to which no benefit of a certificate of mailing or transmission will be given pursuant to § 1.8(a)(2)(i)(I).

Section 1.8: Section 1.8(a)(2)(i)(C) is amended to replace the reference to the ''Board of Patent Appeals and Interferences'' with ''Patent Trial and Appeal Board.'' Sections 1.8(a)(2)(i)(B) and §§ 1.8(a)(2)(i)(G) through 1.8(a)(2)(i)(J) are added to identify additional situations where the procedure of § 1.8(a) does not apply. For instance, the procedure of § 1.8(a) does not apply to papers filed in trials before the Patent Trial and Appeal Board governed by § 42.6(b); the filing of a written declaration of abandonment under § 1.138; the filing of any of the papers required for a submission under § 1.217 for publication of a redacted copy of an application; the filing of the papers required for making a third-party submission under § 1.290; and the calculation of any period of adjustment, as specified in § 1.703(f).

Section 1.17: Section 1.17(j) is removed to eliminate the document submission fee pertaining to § 1.292 and is reserved. Section 1.17(p) is amended to replace the reference in the document submission fee to former § 1.99 with a reference to new § 1.290.

Section 1.99: Section 1.99 is removed and reserved. Section 1.99 is unnecessary because § 1.290 provides for third-party submissions of patents, published patent applications, and other printed publications to the Office for consideration and inclusion in the record of a patent application, with a concise description of the relevance of each document being submitted and within time periods that are the same or greater than those permitted under former § 1.99.

Section 1.290: Section 1.290(a) provides that a third party may submit, for consideration and entry in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application if the submission is made in accordance with 35 U.S.C. 122(e) and § 1.290. Any member of the public, including private persons, corporate entities, and government agencies, may file a third-party submission under § 1.290. A third-party submission may also be filed by an attorney or other representative on behalf of an unnamed real party in interest, because § 1.290 does not require that the real party in interest be identified as such identification might discourage some third parties from making a third-party submission or invite challenges based on allegations of misidentification that could delay the prosecution of an application. The submitter of a third-party submission, however, will be identified in view of the signature requirement in § 1.4 for papers filed in a patent application, which require a person's signature. Third-party submissions are required to be signed because §§ 1.290(d)(5) and (g) require statements by the party making the submission.

Because § 1.290(a) requires that third-party submissions be directed to patent applications, the Office will not accept third-party submissions directed to issued patents. Such submissions should be filed in accordance with § 1.501. Third-party submissions under § 1.290 may be directed to non-provisional utility, design, and plant applications, as well as to continuing applications. Because 35 U.S.C. 122(e) is limited to preissuance submissions, a third party may not file a submission under § 1.290 in post-issuance proceedings, such as reexamination proceedings and reissue applications. Where a submission is filed under § 1.290 in a reissue application, the Office will process the submission as a protest under § 1.291 because, while a concise explanation of relevance under § 1.291 allows for arguments against patentability, such as proposed rejections of the claims, it does not require that such arguments be raised. Therefore, a third-party submission that would otherwise be compliant under § 1.290 will be entered into the record of a reissue application as a protest under § 1.291.

35 U.S.C. 122(e) provides for preissuance submissions to be made for consideration and inclusion ''in the record of a patent application'' and does not preclude third parties from making preissuance submissions in unpublished applications. Therefore, § 1.290(a) does not require that the application to which a submission is directed be published. For example, the Office will enter a compliant third-party submission directed to an application in which a nonpublication request has been filed pursuant to 35 U.S.C. 122(b)(2)(B)(i) and § 1.213. Further, because 35 U.S.C. 122(e) does not preclude third parties from making submissions in abandoned applications, § 1.290(a) does not require that the application be pending and, therefore, permits third-party submissions to be filed in an abandoned application.

Section 1.290(a) limits the type of information that may be submitted to patents, published patent applications, and other printed publications of potential relevance to the examination of a patent application. For example, a submission under § 1.290 could include litigation papers and court documents not subject to a court-imposed protective or secrecy order, if they qualify as publications, but must not include documents that are subject to a court-imposed protective or secrecy order or include trade secret information, unpublished internal documents, or other non-patent documents which do not qualify as ''printed publications.'' *See* MPEP § 2128.

Because 35 U.S.C. 122(e) does not limit the type of information that may be submitted to only that which is prior art, there is no requirement in § 1.290(a) that the information submitted be prior art documents in order to be considered by the examiner. Further, § 1.290(a) does not require a third party to indicate whether a listed document is or is not asserted to be prior art. For those documents where the date of publication is not apparent from a review of the document, the third party may provide information regarding the publication date of the document in its accompanying concise description of relevance.

Similarly, 35 U.S.C. 122(e) does not limit submissions to publications that are not already of record in a patent application. As a result, § 1.290(a) does not prohibit third-party submissions including patents, published patent applications, or other printed publications that are already of record in an application where the submission is otherwise compliant.

Further, while it would be a best practice for third parties not to submit documents that are cumulative of each other or that are cumulative of information already under consideration by the Office, § 1.290(a) does not explicitly prohibit cumulative submissions because it has been the Office's experience that identifying purely cumulative submissions is difficult where a submission includes both a publication and a description of the publication's relevance. For example, a document submitted may appear on its face to be cumulative of information already of record, but the description of relevance may provide additional information with respect to the document such that the submission of the document, together with the

concise description of relevance, is not cumulative of information already of record.

The standard under § 1.290(a) for the documents submitted to be of ''potential relevance to the examination of the application'' is imposed by 35 U.S.C. 122(e)(1). This standard requires the submitter to believe the documents being submitted are relevant to the extent that the submitter can provide the concise description of the asserted relevance of each document submitted as required by 35 U.S.C. 122(e).

Section 1.290(a) also provides that a third-party submission may not be entered or considered by the Office if any part of the submission is not in compliance with 35 U.S.C. 122(e) and § 1.290. The Office will enter a third-party submission that is compliant with both 35 U.S.C. 122(e) and § 1.290; however, any part of a third-party submission that is non-compliant with respect to the requirements of 35 U.S.C. 122(e), whether or not the third-party submission is otherwise compliant with § 1.290, will prevent entry of the entire third-party submission into the record. By contrast, a third-party submission that is compliant with 35 U.S.C. 122(e), but non-compliant with some requirement of § 1.290, may be entered into the record if the error is of such a minor character that, in the opinion of the Office, it does not raise an ambiguity as to the content of the submission. In any event, the Office will either enter or not enter the entire submission and will not attempt to enter portions of partially compliant submissions. The determination of whether to enter or not to enter a submission that partially complies with respect to a requirement of § 1.290 will be at the sole discretion of the Office. The Office will not set a time period for a third party to file a corrected third-party submission. Additionally, the Office will not accept amendments to non-compliant submissions that were previously filed. Instead, a third party who previously filed a non-compliant submission may file another complete submission, provided the statutory time period for filing a submission has not closed.

Section 1.290(b) sets forth the time periods in which a third party may file a third-party submission. Under § 1.290(b), any third-party submission must be filed prior to the earlier of: (1) The date a notice of allowance under § 1.311 is given or mailed in the application; or (2) the later of: (i) Six months after the date on which the application is first published by the Office under 35 U.S.C. 122(b) and § 1.211, or (ii) the date the first rejection under § 1.104 of any claim by the examiner is given or mailed during the examination of the application.

The time periods provided for in § 1.290(b) are statutory and cannot be waived. Thus, the Office cannot grant any request for extension of the § 1.290(b) time periods. Also, third-party submissions must be filed prior to, not on, the dates identified in §§ 1.290(b)(1) and (b)(2). A third-party submission under § 1.290 is filed on its date of receipt in the Office as set forth in § 1.6. Pursuant to § 1.290(i), the certificate of mailing or transmission provisions of § 1.8 do *not* apply to a third-party submission under § 1.290; however, the USPS Express Mail service provisions of § 1.10 do apply to a third-party submission under § 1.290. Additionally, facsimile transmission of third-party submissions is not permitted. *See* § 1.6(d)(3). Third-party submissions that are not timely filed will not be entered or considered and will be discarded.

The § 1.290(b)(2)(i) time period will be initiated only by publications ''by the Office'' under 35 U.S.C. 122(b) and § 1.211, and will not be initiated by a publication by WIPO. Thus, an earlier publication by WIPO of an international application designating the U.S. will not be considered a publication that will initiate the § 1.290(b)(2)(i) time period for an application which entered the national stage from the international application after compliance with 35 U.S.C. 371.

The § 1.290(b)(2)(ii) time period will be initiated by the date the first rejection under § 1.104 of any claim by the examiner is given or mailed during the examination of the application. ''Given'' refers to the electronic notification of an Office action that replaces postal mailing of an Office action for applicants participating in the Electronic Office Action Notification (e-Office Action) program. The § 1.290(b)(2)(ii) time period will not be initiated, for example, by a first Office action that only contains a restriction requirement or where the first Office action is an action under *Ex parte Quayle,* 1935 Dec. Comm'r Pat. 11 (1935). The filing of a request for continued examination (RCE) does not preclude a third-party submission from being filed, if the filing of the third-party submission would otherwise be within the time periods set forth in § 1.290(b)(2). Nor does the filing of an RCE reset the § 1.290(b)(2)(ii) time period for filing a third-party submission.

Section 1.290(c) requires a third-party submission to be made in writing. In the notice of proposed rulemaking, the Office proposed to require under § 1.290(c) that each page of a third-party submission identify the application to which the third-party submission is directed by application number, except for the copies of the documents being submitted. *See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 452. In view of comments submitted by the public expressing concern that such a requirement would be overly burdensome, § 1.290(e) of this final rule relaxes the requirement for identifying the application number of the application to which the submission is directed by only requiring the identification on each page of the document list, as opposed to every page of the submission.

Section 1.290(d) identifies the required content of a third-party submission. Section 1.290(d)(1) provides that any third-party submission under § 1.290 must include a document list identifying the documents, or portions of documents, being submitted in accordance with § 1.290(e). Section 1.290(e) sets forth the requirements on how to identify the items in the § 1.290(d)(1) document list. Because § 1.290(d)(1) provides for an item identified in the document list to be either an entire document or a portion of a document, in the case where a lengthy document contains both information of potential relevance to the examination of the application and other information that is not of potential relevance, a third party may choose to identify only the relevant portion of the document (*e.g.,* one chapter of a textbook) in lieu of the entire document where it is practical to do so. Otherwise, the third party should identify the entire document.

The Office is providing a form PTO/SB/429 that is similar to forms PTO/SB/08A and 08B to assist third parties in preparing the document list in accordance with §§ 1.290(d)(1) and (e). Use of this form is recommended for paper submissions. Use of this form will not be necessary for third-party submissions filed electronically via the Office's dedicated Web-based interface for preissuance submissions, as this interface will prompt the third party to complete the fields that are provided on the form and will automatically format the entered information into an electronic version of the form PTO/SB/429.

Section 1.290(d)(2) requires a concise description of the asserted relevance of each item identified in the document list in view of the statutory requirement of 35 U.S.C. 122(e)(2)(A) that each third-party preissuance submission be

accompanied by a ''concise description of the asserted relevance of each submitted document.'' A concise description of relevance for an item is a statement of facts regarding the submitted evidence (*i.e.,* the patent, published patent application, or other publication) and will not, itself, be treated as evidence. The concise description should set forth facts, explaining how an item listed is of potential relevance to the examination of the application in which the third-party submission has been filed.

The third party should present the concise description in a format that would best explain to the examiner the relevance of the accompanying document, such as in a narrative description or a claim chart. The statutory requirement for a concise description of relevance should not be interpreted as permitting a third party to participate in the prosecution of an application, as 35 U.S.C. 122(c) prohibits the initiation of a protest or other form of pre-issuance opposition for published applications without the consent of the applicant. Therefore, while a concise description of relevance may include claim charts (*i.e.,* mapping various portions of a submitted document to different claim elements), the concise description of relevance is not an invitation to a third party to propose rejections of the claims or set forth arguments relating to an Office action in the application or to an applicant's reply to an Office action in the application.

The Office is interpreting the requirement for a concise description of relevance liberally because the Office anticipates that third parties will be motivated to provide complete concise descriptions of relevance so as to effectively draw the examiner's attention to the potential relevance of a submitted document to the examination of an application. At a minimum, a concise description of relevance must be more than a bare statement that the document is relevant as such a statement does not amount to a meaningful concise description. As a best practice, each concise description should point out the relevant pages or lines of the respective document, particularly where the document is lengthy and complex and the third party can identify a highly relevant section, such as a particular figure or paragraph. Third parties should refrain from submitting a verbose description of relevance, not only because the statute calls for a ''concise'' description, but also because a focused description is more effective in drawing the examiner's attention to the relevant issues.

For example, a description that includes an introductory paragraph describing the field of technology of a document and a claim chart that maps portions of the document to different claim elements would likely be considered ''concise.'' On the other hand, descriptions that merely repeat in narrative format the same information that is also depicted in a claim chart or that approach the length of the documents themselves will not likely be considered ''concise.

A third party using the Office's dedicated Web-based interface to electronically file a third-party submission may fill in the concise description of relevance field for an item or upload a separate paper with the concise description for the item in lieu of entering the concise description in the field. When filing in paper, a third party should provide the concise description of relevance for an item as a separate paper (as opposed to combining the concise descriptions of relevance for all items into a single paper). Providing, for each concise description of relevance, a separate paper that prominently identifies the item in the document list to which the concise description pertains will help ensure that the screener and the examiner can readily identify it.

Section 1.290(d)(3) requires submission of a legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications. *See* § 1.98(a)(2) and MPEP § 609.04(a). Where only a portion of a document is listed as an item in the document list, the third party must only submit a copy of that portion and not a copy of the entire document (*e.g.,* where a particular chapter of a book is listed and not the entire book). Further, when a copy of only a portion of a document is submitted, the third party should also submit copies of pages of the document that provide identifying information (*e.g.,* a copy of the cover, the title page, the copyright information page, etc.). Under § 1.290(d)(3), a third party need not submit copies of U.S. patents and U.S. patent application publications because such documents are readily accessible to examiners. The proposed language ''unless required by the Office'' has not been retained in this final rule as the Office will not be communicating with third parties other than where a return receipt self-addressed postcard is mailed, acknowledging receipt of a third-party submission, and/or an email notification is given to a third party indicating that a third-party submission was found to be non-compliant.

Section 1.290(d)(4) requires an English language translation of any non-English language item identified in the document list. A translation submitted pursuant to § 1.290(d)(4) may be a reliable machine translation and need not be certified. Section 1.290(d)(4) has been clarified in this final rule in view of comments submitted by the public expressing concern regarding a situation where a third party cites and provides a translation for only a portion of a non-English language document but submits a copy of the entire non-English language document. The comments questioned whether an applicant would have a duty to cite and translate the remaining portions of the non-English language document in this situation. Section 1.290(d)(1) provides for the listing of either entire documents or portions of documents, and §§ 1.290(d)(3) and (4) require a copy and translation, respectively, of each item listed pursuant to § 1.290(d)(1). Thus, where only a portion of a non-English language document is listed, a third party must not submit a copy of the entire non-English language document. Rather, the third party must submit a copy of the listed portion of the non-English language document and a translation of only this portion.

Whether filing a third-party submission under § 1.290 in paper or electronically, it would be a best practice for third parties to include an identifying label for each item in the document list and place the identifying label on the accompanying concise description of relevance for the item, on the copy of the item (if submitted), and on the translation of the item (if submitted) so that screeners and examiners can more quickly identify the descriptions of relevance, copies, and translations that correspond to each item in the document list.

Section 1.290(d)(5)(i) requires a statement by the party making the submission that the party is not an individual who has a duty to disclose information with respect to the application (*i.e.,* each individual associated with the filing and prosecution of the patent application) under § 1.56. Such statement is intended to avoid potential misuse of third-party submissions by applicants (*e.g.,* by employing a third-party ''straw man'') to attempt to circumvent the IDS rules.

Section 1.290(d)(5)(ii) requires a statement by the party making the submission that the submission complies with the requirements of 35 U.S.C. 122(e) and § 1.290. To facilitate

compliance by third parties, the form PTO/SB/429 and the dedicated Web-based interface for preissuance submissions include the statements required by §§ 1.290(d)(5)(i) and (ii).

Section 1.290(e) sets forth the requirements for identifying the items in the document list pursuant to § 1.290(d)(1). Section 1.290(e) requires the document list include a heading that identifies the list as a third-party submission under § 1.290. The dedicated Web-based interface for electronically filing preissuance submissions will automatically generate a document list that complies with these two requirements of § 1.290(e).

Section 1.290(e) also requires that the document list required by § 1.290(d)(1) identify on each page of the list, the application number (*i.e.,* the series code and serial number) of the application in which the submission is being filed. This requirement is consistent with the requirement set forth in § 1.98(a)(1)(i) for applicant IDS listings. In view of public comments received, this requirement modifies the previously proposed requirement of § 1.290(c) to be less burdensome to the submitter, while achieving the same goals. *See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 452.

Section 1.290(e) further requires that U.S. patents and U.S. patent application publications be listed in a separate section from other items in the document list. Separating the listing of U.S. patents and U.S. patent application publications from the listing of other items in the document list will facilitate printing the U.S. patents and U.S. patent application publications considered by the examiner in a third-party submission on the face of the patent.

Sections 1.290(e)(1) through (e)(4) set forth the requirements for identifying the items in the § 1.290(d)(1) document list. Section 1.290(e)(1) requires that each U.S. patent be identified by patent number, first named inventor, and issue date. Section 1.290(e)(2) requires that each U.S. patent application publication be identified by patent application publication number, first named inventor, and publication date. Section 1.290(e)(3) requires that each foreign patent or published foreign patent application be identified by the country or patent office that issued the patent or published the application; the applicant, patentee, or first named inventor; an appropriate document number; and the publication date indicated on the patent or published application. The requirement for U.S. patents and patent application publications to be identified by first named inventor, and for foreign patents and published patent applications to be identified by the applicant, patentee, or first named inventor, is intended to aid in identifying the items in the document list in the event the application number, publication number, or other appropriate document number data is in error, for example, inadvertently transposed. In view of comments submitted by the public expressing concern that the identity of the first named inventor of a foreign patent/published patent application may not be known in some instances, § 1.290(e)(3) of this final rule offers more flexibility in permitting identification of foreign patents and published patent applications by expanding the identification to also include the applicant or patentee, in addition to the first named inventor. *See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 452.

Section 1.290(e)(4) requires that each non-patent publication be identified by author (if any), title, pages being submitted, publication date, and where available, publisher and place of publication. Section 1.290(e)(4) does not preclude a third party from providing additional information not specified in § 1.290(e)(4) (*e.g.,* journal title and volume/issue information for a journal article). In view of comments submitted by the public expressing concern that publisher and place of publication information may not be available in some instances, § 1.290(e)(4) of this final rule emphasizes that such information need only be provided where it is available.

Further, in view of comments submitted by the public that the Office should be more critical as to whether a document submitted is actually a publication, the qualifier ''where available'' no longer applies to each item of information specified in § 1.290(e)(4) in this final rule. *See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 452–53. In order for a submission to be compliant under 35 U.S.C. 122(e) and § 1.290, each item submitted for consideration and inclusion into the file of a patent application must be a publication. Thus, § 1.290(e)(4) requires that, if no publication date is known, the third party must provide evidence of publication. As a result, a third-party submission must either include items that are *prima facie* publications, or evidence that establishes that they are publications.

Where the actual publication date of a non-patent document is not known, a third party must, at a minimum, provide a date of retrieval or a time frame (*e.g.,* a year, a month and year, a certain period of time) when the document was available as a publication for purposes of identifying the document by publication date pursuant to § 1.290(e)(4), in addition to including evidence that establishes the document as a publication. In such situations, the third party may submit evidence in the form of affidavits, declarations, or any other appropriate format. For example, a third party might submit as evidence of publication a printout from a Web site showing that the content of the Web site was publicly available at least as of the date retrieved shown on the printout, or screenshots from a Web site that establish the content of the Web site on a particular date. In another example, a third party might submit a company's undated marketing brochure with a declaration from an employee of the company stating that the brochure was publicly distributed at a trade show on a particular date. Such evidence will not be counted toward the item count for fee purposes, unless the evidence is in the form of a patent document or other printed publication and the evidence, itself, is listed and submitted for consideration by the examiner. In some instances, the copy of the document provided pursuant to § 1.290(d)(3) may itself be the evidence, such as where a printout from the Web site showing the date the document was retrieved is provided to satisfy the copy requirement. Further, if the patent applicant has evidence that a document filed by a third party is, in fact, not a publication, the applicant can challenge the determination by the Office that a document is a publication in a response to a rejection applying the document in question.

Section 1.290(f) requires payment of the fee set forth in § 1.17(p) for every ten items or fraction thereof listed in the document list, except where the submission is accompanied by the statement set forth in proposed § 1.290(g). The Office will determine the item count based on the § 1.290(d)(1) document list. Thus, if a U.S. patent or a U.S. patent application publication is identified in the document list, but a copy of the item is not submitted (*i.e.,* because a copy is not required), the listed U.S. patent or U.S. patent application publication will be counted toward the document count. If a copy of an item is submitted but the item is not identified in the document list, the item will not be counted or considered and

will be discarded. Additionally, if a third party identifies an item in the § 1.290(d)(1) document list that is only a portion of a publication, the portion of the publication will be counted as one item. Further, while a third party is permitted to cite different publications that are all available from the same electronic source, such as a Web site, each such publication listed will be counted as a separate item.

Section 1.290(g) provides an exemption from the § 1.290(f) fee requirement where a third-party submission listing three or fewer total items is the first third-party submission by a third party, or a party in privity with the third party, in a given application. Where one third party takes advantage of the fee exemption in an application, another third party is not precluded from also taking advantage of the fee exemption in the same application as long as the third parties are not in privity with each other. For example, applying the current 37 CFR 1.17(p) fee of $180.00 in accordance with §§ 1.290(f) and (g): (1) No fee would be required for the first third-party submission by a third party containing three or fewer total items; (2) a $180.00 fee would be required for the first third-party submission by a third party containing more than three, but ten or fewer total items; and (3) a $360.00 fee would be required for the first third-party submission by a third party containing more than ten, but twenty or fewer total items. For a second or subsequent third-party submission by the same third party: (1) A $180.00 fee would be required where the second or subsequent third-party submission by the third party contains ten or fewer total items; and (2) a $360.00 fee would be required where the second or subsequent third-party submission by the same third party contains more than ten, but twenty or fewer total items. Note that fees set or adjusted in this notice will subsequently be revisited and may be proposed to be set or adjusted in a notice of proposed rulemaking under section 10 of the AIA.

To implement the fee exemption in § 1.290(g) and avoid potential misuse of such exemption, exemption-eligible third-party submissions must be accompanied by a statement of the third party that, to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only third-party submission in the application by the third party or a party in privity with the third party. To preclude a third party from making multiple third-party submissions in the same application on the same day and asserting that each such submission is the first third-party submission in the application by the third party, the § 1.290(g) statement requires that the submission be the ''first and only'' third-party submission. This statement will not, however, preclude the third party from making more than one third-party submission in an application, where the need for the subsequent submissions was not known at the time the earlier submission, including the § 1.290(g) statement, was filed with the Office. Such additional submissions would not be exempt from the § 1.290(f) fee requirement.

The Office will not entertain challenges to the accuracy of such third-party statements because, pursuant to § 11.18(b), whoever knowingly and willfully makes any false, fictitious, or fraudulent statements or representations to the Office shall be subject to the penalties set forth under 18 U.S.C. 1001. Section 11.18(b) applies to any paper presented to the Office, whether by a practitioner or non-practitioner.

Section 1.290(h) provides that in the absence of a request by the Office, an applicant need not reply to a third-party submission under § 1.290. Where the Office believes information from applicant is needed, the Office may issue a requirement for information pursuant to § 1.105. In view of public comments received regarding misinterpretations of the Office's use of the term ''duty'' in the proposed requirement, § 1.290(h) has been revised in this final rule to delete its use. While the comments interpreted the use of the term ''duty'' in the proposed requirement as an intent to incorporate a statement relative to the duty of disclosure under § 1.56, the use of the term ''duty'' was in keeping with the general concept that applicants need not comment on third-party submissions based solely on the presence of such submissions.

Section 1.290(i) provides that the provisions of § 1.8 do not apply to the time periods set forth in § 1.290. Third parties may not use a certificate of mailing or transmission in filing a third-party submission under § 1.290. By not according a third-party submission filed by first class mail the benefit of its date of deposit with the USPS pursuant to a § 1.8 certificate of mailing, the Office reduces the potential for papers crossing in the mail. That is, the requirement of § 1.290(h) reduces the risk that a third-party submission, if it was permitted to rely on a certificate of mailing to be timely, would not be identified and entered until after an Office action is mailed. The requirement of § 1.290(h) also encourages third parties to file third-party submissions at their earliest opportunity. Additionally, because facsimile transmission of third-party submissions under § 1.290 is not permitted, the use of a certificate of transmission pursuant to § 1.8 is not applicable. Facsimile transmissions, although not subject to the delay associated with first class mail, are often received in poor quality, which may result in illegible content and cause the submission to be found non-compliant. The use of USPS Express Mail service pursuant to § 1.10 is permitted for third-party submissions under § 1.290 as it carries with it the risk of little, if any, delay. Nonetheless, the fastest and most legible means for transmitting a third-party submission is electronically via the dedicated Web-based interface the Office has developed for these submissions.

Section 1.291: This final rule amends portions of § 1.291 for clarity and also for consistency with new 35 U.S.C. 122(e) and § 1.290, where appropriate.

The proposed addition of a reference to 35 U.S.C. 122(b) in the § 1.291(b) requirement that a protest be filed prior to the date the application was published under § 1.211 has not been retained in this final rule in view of public comments received. *See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 451. The comments questioned whether the inclusion of 35 U.S.C. 122(b) suggested that an earlier publication by WIPO of an international application designating the U.S. could trigger the end of the § 1.291(b) time period for an application which entered the national stage from the international application after compliance with 35 U.S.C. 371. Because there has been no change in Office policy that a publication by the Office under § 1.211 triggers the end of the time period under § 1.291(b) for filing a protest, absent an earlier notice of allowance, the proposed reference to 35 U.S.C. 122(b) has not been retained, thereby clarifying that an earlier publication of the application by WIPO would not prevent a protest from being filed in accordance with § 1.291(b).

Section 1.291(b) is amended by including ''given or'' before ''mailed'' to provide for electronic notification of the notice of allowance (*i.e.,* via the e-Office action program).

Section 1.291(b)(1) is amended to more clearly define the time period for submitting protests under § 1.291 that are accompanied by applicant consent. Specifically, § 1.291(b)(1) is amended to provide that, if a protest is accompanied by the written consent of the applicant, the protest will be considered if the

protest is filed prior to the date a notice of allowance under § 1.311 is being given or mailed in the application. This amendment provides a definite standard for both the Office and third parties and gives more certainty as to when a protest under § 1.291 that is accompanied by applicant consent would or would not be accepted by the Office. Moreover, it is reasonable that the time period for submission ends when a notice of allowance is given or mailed in the application in view of the current publication process. Under the current publication process, final electronic capture of information to be printed in a patent will begin as soon as an allowed application is received in the Office of Data Management, which occurs immediately after the notice of allowance has been given or mailed. *See* MPEP § 1309.

Section 1.291(c) identifies required content of a protest. Section 1.291(c)(1) is amended to provide that any protest under § 1.291 must include an information list identifying the documents, portions of documents, or other information being submitted. Unlike § 1.290(d)(1), which refers to a ''document list'' because a third-party submission under § 1.290 is limited to publications, § 1.291(c)(1) now refers to an ''information list'' because § 1.291 provides for the submission of information other than publications, including any facts or information adverse to patentability. *See* MPEP §§ 1901 and 1901.02. Like § 1.290(d)(1), § 1.291(c)(1) provides for the listing of either entire documents or portions of documents, as deemed appropriate by the protestor. Additionally, § 1.291(c)(1) also provides for the listing of other information.

Sections 1.291(c)(1)(i) through (c)(1)(v) are added to set forth the requirements on how to identify the items in the § 1.291(c)(1) information list, consistent with the requirements set forth in §§ 1.290(e)(1) through (e)(4), where appropriate. Section 1.291(c)(1)(i) requires that each U.S. patent be identified by patent number, first named inventor, and issue date. Section 1.291(c)(1)(ii) requires that each U.S. patent application publication be identified by patent application publication number, first named inventor, and publication date. Section 1.291(c)(1)(iii) requires that each foreign patent or published foreign patent application be identified by the country or patent office that issued the patent or published the application; the applicant, patentee, or first named inventor; an appropriate document number; and the publication date indicated on the patent or published application. The requirement for U.S. patents and patent application publications to be identified by first named inventor, and for foreign patents and published patent applications to be identified by the applicant, patentee, or first named inventor, is intended to aid in identifying the items in the information list in the event the application number, publication number, or other appropriate document number data is, for example, inadvertently transposed.

In view of comments submitted by the public expressing concern that the identity of the first named inventor of a foreign patent/published patent application may not be known in some instances, § 1.291(c)(1)(iii) of this final rule offers more flexibility in permitting identification of foreign patents and published patent applications by the applicant, patentee, or first named inventor. *See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 454.

Section 1.291(c)(1)(iv) requires that each non-patent publication be identified by author (if any), title, pages being submitted, publication date, and where available, publisher and place of publication. Section 1.291(c)(1)(iv) does not preclude a protestor from providing additional information not specified in § 1.291(c)(1)(iv) (*e.g.,* journal title and volume/issue information for a journal article). In view of comments submitted by the public expressing concern that publisher and place of publication information may not be available in some instances, § 1.291(c)(1)(iv) of this final rule emphasizes that such information need only be provided where it is available. The qualifier ''where such information is available'' no longer applies to each item of information specified in § 1.291(c)(1)(iv), as proposed, because at least a minimum amount of identifying information must be provided to establish the listed item as a non-patent publication.

Section 1.291(c)(1)(v) requires that each item of ''other information'' be identified by date, if known. This requirement accounts for the submission of information other than patents and publications, including any facts or information adverse to patentability. *See* MPEP §§ 1901 and 1901.02. For example, if a publication date for a document is not known and the document is not being relied upon as a publication, the protestor may list such document as ''other information'' pursuant to 1.291(c)(1)(v).

Section 1.291(c)(2) requires a concise explanation of the relevance of each item identified in the information list. Comments questioned the necessity for maintaining § 1.291 in view of new § 1.290 if both require the third party to comment on the relevance of the items being submitted. For example, if the concise explanation requirement of § 1.291(c)(2) is no different than the concise description of relevance required by 35 U.S.C. 122(e)(2)(A) and § 1.290(d)(2), then a question is raised as to whether it is necessary to maintain § 1.291. *See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 454. Unlike the concise description of relevance required by 35 U.S.C. 122(e)(2)(A) and § 1.290(d)(2) for a preissuance submission, the concise explanation for a protest under § 1.291(c)(2) allows for arguments against patentability. To eliminate any confusion, this final rule retains the language of § 1.291(c)(2) in requiring that a protest must include a ''concise explanation of the relevance'' of each item of information submitted as opposed to the proposed ''concise description of the asserted relevance,'' and highlights a distinction between the concise explanation required under § 1.291(c)(2) for protests and the concise description required by 35 U.S.C. 122(e)(2)(A) and § 1.290(d)(2) for preissuance submissions.

Section 1.291(c)(3) requires a legible copy of each item identified in the information list, other than U.S. patents and U.S. patent application publications. Section 1.291(c)(3) is amended to clarify that copies of information submitted must be legible. *See* § 1.98(a)(2) and MPEP § 609.04(a). Section 1.291(c)(3) is also amended to provide that copies of U.S. patents and U.S. patent application publications need not be submitted because such documents are readily accessible to examiners. The proposed language ''unless required by the Office'' has not been retained in this final rule as the Office will not be communicating with protestors other than where a return receipt self-addressed postcard acknowledging receipt of a protest is mailed. Where only a portion of a document is listed as an item in the information list, the protestor must only submit a copy of that portion and not a copy of the entire document (*e.g.,* where a particular chapter of a book is listed and not the entire book). Further, when a copy of only a portion of a document is submitted, the protestor should also submit copies of pages of the document that provide identifying information (*e.g.,* a copy of the cover, the title page, the copyright information page, etc.).

Section 1.291(c)(4) requires an English language translation of any non-English language item identified in the information list. A translation submitted pursuant to § 1.291(c)(4) may be a reliable machine translation and need not be certified. Section 1.291(c)(4) has been clarified in this final rule in view of comments submitted by the public expressing concern regarding a situation where a protestor cites and provides a translation for only a portion of a non-English language document but submits a copy of the entire non-English language document. The comments questioned whether an applicant would have a duty to cite and translate the remaining portions of the non-English language document in this situation. Section 1.291(c)(1) provides for the listing of entire documents or portions of documents, and §§ 1.291(c)(3) and (4) require a copy and translation, respectively, of each item listed pursuant to § 1.291(c)(1). Thus, where only a portion of a non-English language document is listed, a protestor must not submit a copy of the entire non-English language document. Rather, the protestor must submit a copy of the listed portion of the non-English language document and a translation of only this portion.

Section 1.291(f) is amended to provide that in the absence of a request by the Office, an applicant need not reply to a protest under § 1.291. In view of public comments received regarding misinterpretations of the Office's use of the term ''duty'' in the proposed requirement for § 1.290(h), both § 1.290(h) and § 1.291(f) have been revised in this final rule to delete its use. While the comments interpreted the use of the term ''duty'' in the proposed requirement for § 1.290(h) as an intent to incorporate a statement relative to the duty of disclosure under § 1.56, the use of the term ''duty'' in § 1.291(f) was in keeping with the general concept that applicants need not comment on a protest solely because one has been entered into the application.

Section 1.292: Section 1.292 is removed and reserved. The practice of providing a pre-grant public use proceeding as set forth in § 1.292 is no longer considered necessary, and is inefficient as compared to alternative mechanisms available to third parties for raising prior public use, for example, as provided for by § 1.291 protests, where appropriate, and also by section 6 of the AIA which makes available a post-grant review proceeding. Petitions to institute public use proceedings filed under former § 1.292 on or after the effective date of this final rule will not be entered or otherwise treated by the Office. Instead, they will be discarded.

Section 41.202: Section 41.202 is amended to remove a reference to § 1.99 for consistency in view of the removal of § 1.99.

Comments and Response to Comments: As discussed previously, the Office published a notice on January 6, 2012, proposing to change the rules of practice to implement the preissuance submissions by third parties provisions of section 8 of the AIA. *See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 448–457. The Office received thirty-six written comments (from intellectual property organizations, academia, industry, law firms, individual patent practitioners, and the general public) in response to this notice. The comments and the Office's responses to the comments follow:

A. Submission Requirements

1. Identification of Documents

Comment 1: A number of comments suggested revising some of the requirements for identifying documents set forth in proposed §§ 1.290(e) and 1.291(c)(1). These suggestions are detailed with the Office's response to this comment.

Response: In response to the comments, the proposed requirements for identifying foreign patents or published foreign patent applications pursuant to §§ 1.290(e)(3) and 1.291(c)(1)(iii) and for identifying non-patent publications pursuant to §§ 1.290(e)(4) and 1.291(c)(1)(iv) have been modified in this final rule. For example, when identifying foreign patents or published foreign patent applications pursuant to §§ 1.290(e)(3) and 1.291(c)(1)(iii), at least one of the applicant, patentee, or first named inventor must be identified. This requirement offers flexibility in identification, such as where a foreign jurisdiction does not require inventors be named or allows inventors to remain anonymous.

Additionally, § 1.290(e)(4) and 1.291(c)(1)(iv) require identification of non-patent publications by publisher and place of publication only where such information is available. With the increasing use of the Internet for publication, many non-patent publications do not identify a publisher or place of publication, so such information need only be provided where it is available. Sections 1.290(e)(4) and 1.291(c)(1)(iv) do not, however, preclude additional identifying information, not specified in the rules, from being provided (*e.g.,* journal title and volume/issue information for a journal article). Section 1.290(e)(4) also requires evidence establishing publication if the date of publication is not available. For example, such evidence might establish a date the document was publicly available.

2. *English language translation of listed non-English language documents:*

Comment 2: A number of comments suggested revising the requirements set forth in proposed §§ 1.290(d)(4) and 1.291(c)(4) requiring a translation of ''all relevant portions'' and ''all the necessary and pertinent parts,'' respectively, of any non-English language document. One comment suggested a third party be required to provide a translation of all portions, or to redact any non-translated portions. The comment stated that if a third party submits a copy of an entire non-English language document and only translates and cites a portion of the document, the applicant may have a duty to translate and cite the remaining portions. Other comments suggested that a full translation of any non-English language document be required so the examiner can determine if the document as a whole stands for the proposition for which it is cited. Alternatively, it was suggested a third party be required to submit any translation in its possession.

Response: Sections 1.290(d)(4) and 1.291(c)(4) have been modified from the proposed rule to clarify that an English language translation of any non-English language item identified in the document or information list, respectively, is required. Sections 1.290(d)(1) and 1.291(c)(1) provide for the listing of entire documents or portions of documents. Sections 1.290(d)(3) and (4) require a copy and translation, respectively, of each item listed pursuant to § 1.290(d)(1), and §§ 1.291(c)(3) and (4) require a copy and translation, respectively, of each item listed pursuant to § 1.291(c)(1). Thus, where only a portion of a non-English language document is listed, a third party or protestor must not submit a copy of the entire non-English language document. Rather, the third party or protestor must submit only a copy of the listed portion of the non-English language document and only a translation of this portion. Where an entire non-English language document is listed, a third party or protestor should submit a copy and a translation of the entire non-English language document.

Any translations submitted pursuant to §§ 1.290(d)(4) and 1.291(c)(4) may be a reliable machine translation and need

not be certified. The requirements of §§ 1.290(d)(4) and 1.291(c)(4) are different from the requirement of § 1.98(a)(3)(ii), which requires a copy of any translation of a non-English language document cited in an IDS that is ''within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).''

3. Application Number

Comment 3: A number of comments asserted that the requirement of proposed § 1.290(c) to identify the application number on each page of the submission (except for the copies of documents) is unnecessary and burdensome. Several comments stated that the application number should appear on at least the first page of the submission and that, while it may be a best practice to include the application number on each page of the submission, it should not be required.

Response: Based on the comments, the Office understands that the requirement in proposed § 1.290(c) that the application number of the application to which the submission is directed be identified on every page of the submission was overly burdensome. Accordingly, the final rule does not include this requirement. Instead, § 1.290(e) only requires that the document list set forth in § 1.290(d)(1) identify on each page of the list, the application number of the application in which the submission is being filed. This requirement is consistent with the requirement set forth in § 1.98(a)(1)(i) for applicant IDS listings.

B. Documents

1. Corroboration of Documents

Comment 4: One comment suggested the examiner should objectively corroborate submitted documents and be permitted to ignore any documents that cannot be corroborated (*e.g.,* as a publication). The comment suggested the Office should not blindly accept submissions as true and accurate and should entertain challenges to the accuracy of third-party statements that are not objectively verifiable (*e.g.,* a journal article might be verifiable, whereas a marketing pamphlet might be less so).

Response: Submissions filed pursuant to § 1.290 will be reviewed before being forwarded to an examiner for consideration. During this review, the Office will determine if the documents submitted for consideration appear on their faces to be publications. If any of the submitted documents are found not to be a publication, the entire submission will be found not to comply. In such a situation, the submission will not be entered into the patent application file or considered by the examiner and will be discarded. If the submission is determined to be compliant, the publications will be considered by the examiner and entered into the file, as required by 35 U.S.C. 122(e). If the patent applicant, however, has evidence that a document filed by a third party is, in fact, not a publication, then the applicant can challenge the determination by the Office that the document is a publication in response to a rejection applying the document in question.

Comment 5: One comment questioned whether an examiner can request additional information from a third party under § 1.105. The comment suggested it should be at the option of the third party to respond to any such request and that there should be no effect on the original submission if the third party does not comply with the request.

Response: Section 1.105 provides an examiner or other Office employee with the authority to require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat a matter. Section 1.290(d)(5)(i) does not permit a third party to be a § 1.56(c) party. An examiner cannot therefore request additional information from a party who makes a third-party submission. The Office does not believe there is a need for a similar mechanism to require further information from third-party submitters as the third parties will be motivated to provide complete submissions that would not likely require further information.

Comment 6: A number of comments suggested evidence should be required to establish the relevant date of documents not in print, such as documents only published electronically on the Internet. One comment suggested the rules explicitly provide for the submission of screenshots from Web sites, such as ''*www.archive.org,*'' that evidence the content of Web pages at specified dates in the past because such screenshots are relevant to novelty considerations under 35 U.S.C. 102 and can be readily verified.

Response: Section 1.290(e)(4) requires non-patent publications be identified by author (if any), title, pages being submitted, publication date, and where available, publisher and place of publication. Section 1.290(e)(4) further requires that, if no publication date is known, the third party must provide evidence of publication. This requirement recognizes that some documents, such as the content of a Web site, may not indicate a date of publication. *See* MPEP 2128. Section 1.290(e)(4) does not require the evidence of publication be submitted in a particular format. For example, the third party might submit as evidence of publication a printout from the Web site showing that the content of the Web site was publicly available at least as of the date retrieved shown on the printout, or screenshots from a Web site that establish the content of the Web site on a particular date (like www.archive.org). In some instances, the copy of the document provided pursuant to § 1.290(d)(3) may itself be the evidence, such as where a printout from the Web site showing the date the document was retrieved is provided to satisfy the copy requirement. Each item of evidence submitted will be evaluated with respect to both its authenticity and its persuasiveness.

2. Prior Art Documents

Comment 7: A number of comments requested clarification as to whether the proposed rules allow submissions of documents that are not prior art to the patent application. These comments also suggested the rules not permit submission of non-prior art documents. A number of comments also proposed adding a requirement that the third party indicate whether the documents submitted are prior art or are not prior art.

Response: Pursuant to 35 U.S.C. 122(e), ''[a]ny third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application.'' The statute does not limit the publications that can be submitted to prior art publications. Accordingly, § 1.290(a) does not require that publications be prior art in order to be considered by an examiner. Additionally, the Office is not requiring a third party to indicate whether a listed document is or is not asserted to be prior art because a mistake in complying with such a requirement could cause a submission to be found not in compliance with § 1.290. The Office believes the benefit of such a statement is outweighed by the potential that the submission will be found not to comply should the Office disagree with the third party.

Comment 8: A number of comments requested further clarification on what documents would be admitted or excluded as ''other printed publications'' under proposed

§ 1.290(a). These comments also requested that publicly accessible documents of potential relevance to the examination of the application be permitted, such as litigation papers not subject to a protective order and otherwise available to the public.

Response: Section 1.290(a) does not limit the type of printed publications that can be filed as part of a compliant submission. Litigation papers and court documents not subject to a court-imposed protective or secrecy order can be submitted for consideration and entry under § 1.290(a) if they qualify as publications. *See* MPEP § 2128. Documents that are subject to a court-imposed protective or secrecy order, documents that include trade secret information, unpublished internal documents, or other non-patent documents that do not qualify as publications should *not* be submitted for consideration and entry under § 1.290(a).

Comment 9: A number of comments suggested amending proposed § 1.290(e)(4) to clarify what is required to establish the date of a non-patent publication asserted to be prior art if the date is ''not apparent from the document.''

Response: This final rule revises the requirement of proposed § 1.290(e)(4) that the third party bears the burden of establishing the date of a non-patent publication asserted to be prior art if the date is not apparent from the document. A compliant submission pursuant to § 1.290 requires that all documents for consideration and inclusion into the file of an application be publications. Thus, § 1.290(e)(4) requires a third party to provide evidence of publication where the publication date of a document is not known, regardless of whether the document is asserted to be prior art. As a result, third parties making such a submission must either submit documents that are *prima facie* publications or evidence that establishes that they are publications. The Office is not requiring specific types of evidence to prove publication, but where the actual publication date of a non-patent document is not known, a third party should, at a minimum, provide a date of retrieval or a timeframe (*e.g.,* a year, a month and year, a certain period of time) when the document was available as a publication for purposes of identifying the document by publication date pursuant to § 1.290(e)(4), in addition to including evidence that establishes the document as a publication. In such situations, the evidence that may be submitted by a third party includes affidavits or declarations, or may be present on the copy of the document itself submitted pursuant to § 1.290(d)(3).

3. Submissions Related to Documents Already of Record

Comment 10: A number of comments requested clarification as to whether the proposed rules allow submissions and descriptions of relevance in connection with patents, published patent applications, or other printed publications that are already of record in a patent application.

Response: 35 U.S.C. 122(e) states: ''Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application.'' The statute does not limit submissions to publications that are not already of record in a patent application. Accordingly, new § 1.290 does not place this limitation on the publications that can be submitted. As a result, third-party submissions pursuant to § 1.290 can include patents, published patent applications, or other printed publications that are already of record in an application where the submission is otherwise compliant.

Comment 11: Some comments suggested amending proposed § 1.290 to prohibit cumulative submissions. One comment suggested that where more than three documents are submitted, the third party should be required to explain which documents, up to three, are most relevant and why any other submitted documents are not merely cumulative.

Response: While it would be a best practice for third parties not to submit documents that are cumulative of each other or that are cumulative of information already under consideration by the Office, § 1.290 does not explicitly prohibit cumulative submissions because it has been the Office's experience that identifying purely cumulative submissions is difficult, such as where the submission includes both a publication and a description of the publication's relevance. Where a concise description of relevance is not identical to another party's concise description of relevance, and the submission is otherwise compliant, the submission will be entered into the file of the application. Thus, while a document submitted may appear on its face to be cumulative of information already of record, its accompanying concise description of relevance may provide additional information with respect to the document, such that the submission of the document, together with the concise description of relevance of the document, is not cumulative of information already of record. For example, a submission including documents cited in the background section of an application would not be considered cumulative if accompanied by concise descriptions of relevance that provide additional information regarding the documents.

4. Limits on Submissions

Comment 12: Several comments raised concerns regarding the potential for third parties to ''flood'' an application with third-party submissions. One comment suggested that, with no contemplated limit on the number of third-party submissions that may be made in an application, an examiner could become ''buried'' and, as a result, potentially miss highly relevant art. Another comment asserted that the fee structure alone may not go far enough to prevent harassment where the third party is allowed to remain anonymous.

Response: Third-party submitters are subject to § 11.18(b)(2), which provides that a party presenting a paper to the Office, whether a practitioner or non-practitioner, is certifying that ''to the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, [t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office.'' Accordingly, Office rules already prohibit third parties from purposely ''flooding'' an application with third-party submissions in order to cause unnecessary delay in the prosecution of the application. Moreover, the statute does not impose any limit on the number of third-party submissions that may be filed in an application. The Office, in turn, has not imposed any limit on the number of third-party submissions that may be filed in applications so as not to preclude examiners from having all relevant information before them when examining applications. To limit the number of third-party submissions in an application might preclude some third parties from filing potentially relevant information. Further, because highly relevant documents can be obfuscated by voluminous submissions, third parties should be motivated to limit any third-party submission to only the most relevant documents and should not be motivated to ''flood'' the Office with irrelevant submissions.

Comment 13: Some comments suggested the Office limit the number of pages in a third-party submission that

will be considered by an examiner. For example, one comment suggested amending § 1.290(f) to require a third party to identify up to 50 of the most relevant pages of the submitted documents where the cumulative number of pages of the submitted documents, other than patents or published patent applications, exceeds 50 pages.

Response: The Office has not imposed any limit on the total number of pages that may be submitted in a third-party submission because, to do so, could prevent an examiner from considering all of the relevant information submitted. Further, if a third party deems more than 50 pages in a submission to be relevant to the examination of an application, an examiner should not be precluded from reviewing all of the pages of information deemed to be relevant. Nevertheless, a third party should avoid making a submission unnecessarily voluminous as voluminous submissions tend to obfuscate the most relevant information.

5. Electronic Sources

Comment 14: One comment requested clarification regarding what is considered a separate document on a Web site. The comment questioned whether each page of a single Web site would constitute a separate document.

Response: What constitutes a separate document on a Web site will vary case-by-case. For example, if a single article posted on a Web site spans multiple Web pages, each such Web page would not constitute a separate document. On the other hand, if a Web site includes different articles and each appears on a different Web page, then each such Web page would constitute a separate document, even though each article is available from the same Web site.

6. Third Party Participation

Comment 15: One comment suggested the Office not permit third-party submissions of documents that were prepared by the third party solely to address patentability issues in an application. The comment suggested the Office require a statement that the third party or its privies did not draft the cited documents after the application was filed to contest patentability.

Response: Third parties are cautioned that submission of documents drafted after the application was filed solely to contest patentability may result in non-entry of an entire third-party submission. A concise description of relevance under § 1.290 is not an invitation for third-party participation in the examination of an application. Thus, the concise description of relevance of a document, which was prepared by a third party after an application was filed solely to contest the patentability of the application, would likely be deemed an improper attempt by the third party to impermissibly participate in the examination of the application because the relevance of the document being described is its discussion of the patentability of the application. As a result of the improper concise description, the entire third-party submission that includes such document would not be entered.

C. Consideration of Documents

1. Consideration by an Examiner

Comment 16: A number of comments requested clarification as to how examiners will consider documents and concise descriptions of relevance submitted in third-party submissions pursuant to the guidance set forth in the MPEP at §§ 609.05(b), 904.03, 2256, and 2656.

Response: Examiners will consider documents and concise descriptions of relevance submitted in compliant third-party submissions in the same manner that examiners consider information and concise explanations of relevance submitted as part of IDSs in patent applications. Generally with the next Office action following the entry of third-party submission, a copy of the third party's listing of documents, with an indication of which documents were considered by the examiner, will be provided to the applicant. The indication that a document has been considered by the examiner will mean that the examiner has considered both the listed document and its accompanying concise description. The examiner will apply the information in a compliant third-party submission as the examiner deems necessary, but will not be expected to comment on each submitted document and concise description of relevance.

Parties should keep in mind that examiner consideration of a document and its accompanying concise description of relevance does not mean that the examiner agrees with the third party's position regarding the document, only that the examiner considered the publication and its accompanying description. For example, a third party might assert that a particular document is prior art but the examiner might determine that the assertion is incorrect in view of the application's earliest effective filing date. In such a situation, the examiner will still consider the document and the concise description of relevance even though the examiner determined that the document is not prior art.

2. Distinguish Third-Party Submitted Documents

Comment 17: Several comments suggested the Office print considered third-party submitted documents on the patent with a font or symbol that distinguishes them from applicant-submitted documents and examiner-cited documents. One comment also suggested the Office similarly distinguish references entered into the image file wrapper (IFW) of an application.

Response: The Office is updating its existing information technology (IT) systems to permit considered third-party submission documents to be distinguished on an issued patent from documents cited by the applicant and by the examiner, and also to distinguish third-party submission papers from other papers in the IFW of an application. The Office intends to have these updates completed prior to or shortly after the effective date of this final rule.

D. Concise Description of Relevance

Comment 18: One comment suggested that the Office indicate that the standard set forth in proposed § 1.290(a) for documents to be of ''potential relevance to the examination of the application'' is intended to be a low threshold so that third parties are encouraged to submit potentially relevant documents.

Response: The standard under § 1.290(a) for the documents submitted to be of ''potential relevance to the examination of the application'' is specified by 35 U.S.C. 122(e)(1). This standard requires the submitter to believe the documents being submitted are relevant to the extent that the submitter can provide the statutorily required concise description of the asserted relevance of each document submitted. *See* 35 U.S.C. 122(e)(2)(A).

Comment 19: Some comments requested the Office clarify the threshold for non-compliance for concise descriptions of relevance. One comment suggested the Office make the concise description requirement a low threshold that can be easily satisfied so that third parties are encouraged to participate. A number of comments requested more guidance and examples on concise descriptions. Several comments requested further guidance regarding what would be considered non-compliant (*e.g.,* bare statements) and what would be considered ''concise.'' One comment further recommended the Office publish samples of third-party submission filing

documents and Office communications concerning third-party submissions.

Response: The Office is interpreting the requirement for a concise description of relevance liberally because the Office anticipates third parties will be motivated to provide complete concise descriptions of relevance to draw the examiner's attention to the potential relevance of a submitted document to the examination of an application. At a minimum, a concise description of relevance must be more than a bare statement that the document is relevant. For example, the statements ''Document 1 is relevant,'' ''See Document 1,'' and ''Document 1 discloses/may disclose the invention'' would not be considered anything more than bare statements of relevance that do not rise to the level of meaningful concise descriptions. Additionally, merely highlighting or otherwise annotating the copy of the submitted document itself will not be deemed a proper concise description of relevance. Further, concise descriptions of relevance that appear to be mere form paragraphs/letters in opposition to a general class of invention or technology will not be deemed proper concise descriptions of relevance.

The statutory requirement for a concise description of relevance should not be interpreted as permitting a third party to participate in the prosecution of an application. 35 U.S.C. 122(c) prohibits the initiation of a protest or other form of pre-issuance opposition for published applications without the consent of the applicant. Therefore, while a concise description of relevance may include claim charts (*i.e.,* mapping various portions of a submitted document to different claim elements), the concise description of relevance is not an invitation to a third party to propose rejections of the claims, or set forth arguments relating to an Office action in the application or to an applicant's reply to an Office action in the application. Further, while third parties should refrain from submitting verbose descriptions of relevance, not only because the statute calls for a ''concise'' description but also because a focused description is more effective in drawing the examiner's attention to the relevant issues, the Office has not established an upper limit on the size of a concise description at this time.

Any sample third-party submission filing documents that the Office provides may not be appropriate in all situations; however, the Office intends to provide additional guidance on filing third-party submissions on its Web site, *www.uspto.gov.*

Comment 20: One comment suggested a third party need only explain ''how'' a document is of potential relevance, and suggested that it is unnecessary to explain both ''how and why'' a document is relevant, as discussed in the proposed rule package. *See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 452 (stating that ''[t]he concise description should explain why the document has been submitted and how it is of potential relevance to the examination of the application * * *.'').

Response: The Office did not intend to suggest that two separate statements are required in order to comply with § 1.290(d)(2) as the statute only requires one statement of the asserted relevance of each submitted document. Accordingly, the third party need only provide for each document submitted one concise description setting forth the asserted relevance of the document.

Comment 21: One comment recommended the Office amend the rules to explicitly exclude declarations, such as expert declarations, as concise descriptions of relevance because applicants would not be able to readily contest such testimonial evidence during prosecution.

Response: 35 U.S.C. 122(e) provides for the submission of evidence in the form of patents, published patent applications, and other printed publications. A concise description of relevance for a submitted document is not considered evidence but, rather, a statement of facts regarding the submitted evidence. Accordingly, the Office will not consider a declaration as evidence, where such declaration is submitted as a concise description of relevance for a document. Third parties relying on declarations as concise descriptions of relevance should ensure the concise description of relevance does not amount to an attempt at third-party participation in the examination of the application.

E. Third Party

1. Anonymity

Comment 22: One comment expressed concern that preserving the anonymity of the third party could negatively impact small entities where large competitors seek out third parties to file excessive third-party submissions against small start-up companies, which might not have the funds, or be able to acquire the funds from their financial backers, to address such submissions.

Response: Section 1.290(h) makes clear, and its related preamble further explains, that the Office believes there is no need for applicants in general to address third-party submissions. The examiner will review the submissions, and should an issue arise where information from the applicant is desired, the Office will frame the issue and request information from the applicant under § 1.105. Such requests are envisioned to be rare and limited in scope and therefore well within the ability of any applicant to reply, including small start-up companies.

Additionally, the Office believes that providing anonymity would encourage small entity third parties to submit prior art. Without such anonymity, there are situations where potential third-party small start-ups would be hesitant to make a third-party submission, such as where the third party would be concerned with damaging a valuable relationship with the larger applicant. Anonymity helps small start-ups in supplying prior art against applications submitted by large entities (not necessarily competitors) with whom they may have a relationship.

Comment 23: A number of comments suggested making explicit in the rules that the real party in interest need not be identified and that the submitter may also remain anonymous where the submitter is not the real party in interest. Several comments asserted that the identity of the party making the submission for the real party in interest should also be protected because the identity of the submitter (*e.g.,* a particular attorney or law firm) could, in some instances, implicitly give away the identity of the real party in interest and that such protection would likely encourage more third-party submissions. Some comments have suggested ways for the Office to protect the identity of a party making a third-party submission for a real party in interest.

Response: The absence of an identification requirement in § 1.290 makes clear that there is no requirement to identify a real party in interest. The absence of such requirement is reinforced by the explanation of such in the preamble.

The Office cannot permit a third-party submission to be presented unsigned by the submitter in view of the signature requirement in § 1.4 for papers filed in a patent application, which require a person's signature. Third-party submissions are required to be signed because §§ 1.290(d)(5) and (g) require statements by the party making the submission. Therefore, to permit anonymity of the submitter, the Office would need a special procedure to hide the submitter's identity, which would impose an unjustifiable burden in view

of the ease with which the real party in interest can be shielded notwithstanding identification of a submitter.

Comment 24: To the extent the Office collects identifying information regarding the submitter, some comments have suggested ways of collecting the information and means of keeping such identifying information confidential and preventing its entry into the IFW.

Response: The Office, at this time, does not intend to collect identifying information from submitters who utilize § 1.290. In view of the signature requirement in § 1.4 for all papers filed in a patent application, which require a person's signature, only the name of the submitter will be identified upon entry of a compliant third-party submission into the IFW of an application.

2. Registered Practitioners

Comment 25: Some comments suggested that only registered patent practitioners should be able to file third-party submissions. One comment suggested that registered practitioners are presumed qualified to have sufficient knowledge of patent law necessary to make the concise descriptions of relevance, and distinguished *ex parte* reexamination which may be filed by ''[a]ny person at any time.'' Another comment stated that the independent inventor community is concerned that potential harassment could result if any third party can file a third-party submission under proposed § 1.290.

Response: New 35 U.S.C. 122(e)(1) provides for ''[a]ny third party'' to file a preissuance submission. Any member of the public, including private persons, corporate entities, and government agencies, may file a third-party submission under § 1.290. An attorney or other representative on behalf of an unnamed real party in interest likewise may file a third-party submission since § 1.290 does not require that the real party in interest be identified. To limit the filing of third-party submissions to registered practitioners would be contrary to the express language of the statute and potentially exclude parties that may not have the resources to hire registered practitioners to file third-party submissions for them. Further, the Office's experience with pilot programs, such as the Peer Review Pilot 2011, has demonstrated the capabilities of non-practitioners to make appropriate submissions to the Office. To describe the relevance of a submitted document to an application, submitters need not be as well-versed in the patent laws as they should be in the field or technology described in the application and the document being submitted.

Regardless of who files a third-party submission, the Office will screen the third-party submission for compliance before entering it into the record so as to limit the potential for patent applicants to be harassed by third parties filing non-compliant third-party submissions. Moreover, third-party submitters are subject to § 11.18(b)(2), which provides that a party presenting a paper to the Office, whether a practitioner or non-practitioner, is certifying that ''to the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, [t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office.'' Accordingly, Office rules already prohibit third parties from purposely filing a third-party submission to harass the applicant.

3. Compliance

Comment 26: One comment asserted that given the requirements of 35 U.S.C. 122(e)(2)(C) for making a statement affirming that a submission was made in compliance with the statute, and the requirements of § 11.18(b), for presenting a paper to the Office after making reasonable inquiry that the paper is not being presented for any improper purpose, the Office should provide explicit guidance regarding what is a ''reasonable inquiry'' so far as ascertaining whether a first rejection or notice of allowance has been issued and how a third party would be able to demonstrate such reasonable inquiry.

Response: What is reasonable will vary on a case-by-case basis. However, at a minimum, third parties wishing to determine whether an Office action rejecting any claim or a notice of allowance has been issued in a published application should avail themselves of the Office's public Patent Application Information Retrieval (PAIR) system to obtain the application's status prior to making a third-party submission.

F. Proposed Fees

1. Proposed Fee Schedule

Comment 27: A number of comments suggested that proposed § 1.290(f) be amended to charge a fee on a per-document basis as opposed to in increments of ten documents.

Response: Because the Office expects the processing costs to the Office for third-party submissions under § 1.290 to be equivalent to the processing costs to the Office for submissions under prior § 1.99, the Office has determined that the fee set forth in § 1.17(p) for submissions under prior § 1.99 is also applicable to third-party submissions under § 1.290. Thus, § 1.290(f) provides that any third-party submission filed under § 1.290 must be accompanied by the fee set forth in § 1.17(p) for every ten documents or fraction thereof being submitted.

2. Fee Exemption

Comment 28: Several comments suggested the fee exemption provided for in proposed § 1.290(g) could encourage abuse, which will result in the Office being overburdened by documents for consideration by an examiner. These comments also favored the $180 fee and suggested that the $180 fee set forth in proposed § 1.290(f) would not discourage a third party from filing documents that will enhance the quality of the application's examination. Another comment proposed an alternate fee schedule intended to balance the needs of the Office and third parties.

Response: Because the fee exemption provided under § 1.290(g) only applies to a third party's first submission of three or fewer documents in an application, the Office does not anticipate it will become overburdened by submissions in any one application. While the $180 fee set forth under § 1.290(f) may not be burdensome to some third parties, the Office believes it may discourage or prevent some third parties from making a third-party submission if even the first document submitted incurred the $180 fee. The Office believes the fee structure implemented in this final rule strikes a balance between encouraging submissions so that examiners have the best documents before them when examining applications and, at the same time, discouraging third parties from making excessive submissions.

Comment 29: A number of comments suggested the Office not rely on the concept of ''privity'' to administer the fee exemption. One comment suggested it will be difficult for third parties with limited legal experience and large entities, such as corporations and universities, to determine if privity exists. This comment also suggested that a ''privity test'' in the fee exemption is not necessary to avoid abuse because the Office's experience with the Peer-to-Patent pilot program shows that third parties did not flood applications with documents even though the submissions were free and could be made anonymously. This comment further asserted that the required statement regarding privity is likely to ''chill

collaboration'' among third-party submitters which might be necessary for third parties to avoid making cumulative submissions.

Response: The Office believes that the concept of ''privity'' is well established since it is already employed in other contexts before the Office, such as *inter partes* reexamination. *See, e.g.,* § 1.907 (providing that ''[o]nce an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.''). Additionally, third parties who are concerned about not being able to make the ''privity'' statement under § 1.290(g) to take advantage of the fee exemption when making a submission in an application are not precluded from making the submission because such parties have the option of simply paying the required fee under § 1.290(f) instead of evaluating whether it is appropriate to make the ''privity'' statement pursuant to § 1.290(g).

Comment 30: One comment questioned whether a third party who made a first third-party submission that included the statement set forth in proposed § 1.290(g) would need to make a similar statement in each subsequent submission (*e.g.,* that it was previously unaware of the documents at the time of the first submission).

Response: Where a third party takes advantage of the fee exemption pursuant to § 1.290(g) in a first submission, the third party is not required to make any statement in each subsequent submission indicating that the third party was previously unaware of the need to file the subsequent submission at the time the third party made the first submission.

Comment 31: Several comments suggested that the number of fee-exempt documents under proposed § 1.290(g) should be changed. Some comments suggested that the number be reduced, while others suggested it be increased.

Response: The Office is providing a fee exemption for the first third-party submission in an application by that third party containing three or fewer total documents because the submission of three or fewer documents is more likely to assist the examiner in the examination process than no third-party submissions. Moreover, keeping the size of the fee exempted submission to three or fewer total documents will help to focus the attention of third parties on finding and submitting only the most relevant art to the claims at hand. Submission of voluminous documents costs the Office more in processing the submission and that cost outweighs the benefit to the examiner in having access to third-party submissions. Thus, the provision of § 1.290(g) strikes a balance between encouraging third parties to make focused third-party submissions of perhaps highly relevant documents to the examination of an application and discouraging third parties from making unnecessarily voluminous submissions.

G. Time Periods for Submission

1. Statutory Time Periods

Comment 32: One comment questioned whether the filing of a request for continued examination (RCE) resets the time period for filing a third-party submission under proposed § 1.290(b)(2)(ii).

Response: The filing of an RCE does not reset the time period for filing a third-party submission under § 1.290(b)(2)(ii). However, the filing of an RCE does not preclude a third-party submission from being filed after the RCE, if the filing of the third-party submission would otherwise be within the time periods set forth in § 1.290(b)(2).

Comment 33: One comment asserted that the only deadline for making a third-party submission should be the issuance date of a notice of allowance because, among other reasons, third parties may not immediately be aware of their competitors' patent applications.

Response: The time period for making a third-party submission is set by statute in 35 U.S.C. 122(e) and cannot be modified by the Office, as the Office regulations must conform to the requirements of the statute.

Comment 34: A number of comments recommended amending proposed §§ 1.290(b) and 1.291(b)(1) to state that the third-party submission/protest must be filed ''prior to'' the specified date or event instead of ''before'' because the meaning of the term ''before'' can vary depending on the context.

Response: Sections 1.290(b) and 1.291(b)(1) have been modified relative to the proposed rule to require that any third-party submission/protest must be filed ''prior to'' the specified date or event.

Comment 35: One comment requested clarification regarding whether a third-party submission could be timely submitted after prosecution is reopened in an application subsequent to a notice of allowance where the publication of the application or the mailing of a first rejection of any claim has not occurred.

Response: The time period for making a third-party submission is set by statute in new 35 U.S.C. 122(e), which states that a third-party submission must be made before ''a notice of allowance * * * is given or mailed in the application.'' Thus, the statute does not permit a third-party submission to be filed after a notice of allowance has been given or mailed in an application, regardless of whether that notice of allowance is subsequently withdrawn.

2. ''First Published''

Comment 36: One comment suggested that the republication of an application under § 1.221(b) should not be considered the first publication under 35 U.S.C. 122(b) for purposes of proposed § 1.290(b) as third parties will be given a windfall of time to file documents. This comment also suggested that this additional time could result in submissions not receiving timely consideration before a first Office action is mailed.

Response: The republication of an application under § 1.221(b) is not the first publication by the Office under 35 U.S.C. 122(b) for purposes of 35 U.S.C. 122(e). Accordingly, the first publication of the application will trigger the § 1.221(b)(2)(i) time period where appropriate.

Comment 37: One comment suggested that publication of an application by the World Intellectual Property Organization (WIPO) should be considered a publication of the application for purposes of proposed § 1.290(b).

Response: The third-party submission timing requirement based on the publication of the application is set forth in new 35 U.S.C. 122(e)(1)(B), which is expressly limited to the publication of the application for patent ''by the Office.'' This statutory provision does not account for the publication of the application by organizations other than the Office, such as WIPO. The timing requirement of § 1.290(b)(2)(i) conforms to that of the statute and, likewise, is not triggered by the publication of the application by WIPO.

Comment 38: One comment questioned how a third party could make a third-party submission before a date of first rejection that is earlier than the date the application publishes, where the existence of the application, and its contents, is only available to that third party after the publication date.

Response: A third-party submission could be made before a first rejection that is earlier than the date the application publishes where a third party otherwise knows of the application. The time periods for submission are set forth in new 35 U.S.C. 122(e) and cannot be modified by

the Office. The AIA included provisions for prioritization of examination, as well as for preissuance submissions by third parties, and the details of any individual provision, such as for preissuance submissions, can be understood to represent a balance among the benefits of the individual provisions of the Act.

Comment 39: Several comments requested that the Office consider amending the provisions of 35 U.S.C. 122(b)(2)(B)(i), which permit applicants to make non-publication requests in their applications, to ensure that all applications publish without condition so examiners will have the benefit of third-party submissions during examination.

Response: The statutory provisions of 35 U.S.C. 122(b)(2)(B)(i) are not subject to amendment by the Office. Where the Office does not publish an application, the date that is six months after the publication date would not occur and, therefore, by default would be considered later than both the date of a first rejection of any claim and the date the notice of allowance is given or mailed in the application. Accordingly, the date that a notice of allowance is given or mailed in the application would control the timing of a third-party submission in an application which has not been published, not the date of the first rejection of any claim.

3. Certificate of Mailing/Transmission

Comment 40: Several comments suggested amending § 1.8 to include the exception listed in proposed § 1.290(i). One comment suggested the Office permit use of the certificate of mailing or transmission under § 1.8. The comment further suggested that the problem of papers crossing in the mail can also occur with use of ''Express Mail'' service under § 1.10.

Response: Section 1.8(a)(2)(i) has been amended to include the exception listed in § 1.290(i). Not according a third-party submission filed by first class mail the benefit of its date of deposit with the USPS pursuant to a § 1.8 certificate of mailing reduces the potential for papers crossing in the mail. This requirement reduces the risk that a third-party submission, if it was permitted to rely on a certificate of mailing to be timely, would not be identified and entered until after an Office action is mailed, and encourages third parties to file a third-party submission at their earliest opportunity. It is desirable for papers filed under § 1.290 to be included in the record of the patent application, and considered by the Office, at the earliest possible point in prosecution.

Additionally, the use of a certificate of transmission pursuant to § 1.8 is not applicable to third-party submissions under § 1.290 because facsimile transmission of third-party submissions is not permitted. Facsimile transmissions, although not subject to delay, are often received in poor quality. Errors in optical character recognition, or lack of clarity of symbols or figures, present potential issues with providing a ''legible copy'' as required by § 1.290(d)(3), and could cause a submission to be found non-compliant. Further, because a submission under § 1.290 is made by a third party, the Office will not have an opportunity to contact the third party for clarification of any illegible content.

The use of United States Postal Service (USPS) Express Mail service pursuant to § 1.10 carries with it the risk of little, if any, delay. This risk is minimal as compared to the possible delay that could be experienced with first class mail for which a certificate of mailing is used. The fastest and most legible means for transmitting a third-party submission is electronically via the dedicated Web-based interface the Office has developed for these submissions. As a practical matter, any third-party submission should be submitted as soon as possible after the third party becomes aware of the existence of the application to which the submission is to be directed. By submitting a third-party submission early in the examination process, *i.e.,* before the Office acts on the application if possible, the third party ensures that the submission will be of the most benefit to the Office in its examination of the application and increases the likelihood that the submission will meet the statutory timing requirements.

H. Entry of Third-Party Submissions

1. Notification to Applicant of Entry

Comment 41: A number of comments recommended the Office directly notify applicants of third-party submissions directed to their applications, either when the third-party submissions are filed or when compliant third-party submissions are entered into the applications.

Response: The Office plans to electronically message applicants upon entry of compliant third-party submissions directed to their applications. In order to receive notification, however, applicants must participate in the e-Office Action program, as such notification will only be provided via electronic mail message (email) to program participants.

2. Service on Applicant

Comment 42: As an alternative to the Office directly notifying applicants, several comments recommended requiring third parties to serve third-party submissions on applicants. These comments suggested that service would alleviate the burden on applicants to monitor their application files for third-party submissions.

Response: Service on applicants will not be necessary in view of the opportunity for applicants to receive electronic notification of the entry of a third-party submission from the Office by participating in the e-Office action program. Further, not requiring service of third-party submissions should reduce the possibility that applicants will gain knowledge of non-compliant third-party submissions and, as a result, deem it necessary to independently file the submitted documents with the Office in an IDS. Additionally, the Office is seeking to prevent challenges regarding whether service of a third-party submission was proper from negatively impacting the pendency of the application.

3. Notification to Third Party of Non-Compliance

Comment 43: A number of comments urged the Office to notify third parties of non-compliant third-party submissions to provide those parties an opportunity to make a resubmission if the statutory time period has not yet expired. Several comments suggested that such notice include the reason(s) for non-compliance. Other comments suggested the notice of non-compliance provide procedures for curing the defect(s) and not be made of record in the application. One comment suggested that such notice be provided where the third party includes a correspondence address with the submission, while another comment suggested the Office also notify third parties when third-party submissions are accepted.

Response: As a courtesy, the Office intends to notify third parties of non-compliant third-party submissions via electronic mail message (email) where the third-party submitter includes an email address in the third-party submission, whether the submission is filed electronically or in paper. An issued notice of non-compliance will indicate why the third-party submission was found to be non-compliant. Neither the notification nor the non-compliant third-party submission will be made of record in the application. Further, if the submission is deemed compliant, the Office does not intend to enter the email address provided for notification of non-

compliance into the record of the patent application.

The Office will not notify the third-party submitter of entry of a compliant third-party submission into the record. However, for an electronic filing, the third party will receive immediate, electronic acknowledgment of the Office's receipt of the submission. For a paper filing, the third party may include a self-addressed postcard with the third-party submission to receive an acknowledgment by the Office that a third-party submission has been received. In either case, the electronic acknowledgment or return receipt postcard is not an indication that the third-party submission is compliant or has been entered. In a published application, third parties may access public PAIR to confirm that their submission has been entered.

Where a third-party submission is filed in an unpublished application, a returned postcard acknowledging receipt will not indicate whether such application in fact exists or the status of any such application because original applications are required by 35 U.S.C. 122 to be kept in confidence unless published pursuant to 35 U.S.C. 122(b) or available to the public pursuant to § 1.14(a)(1)(iv), (v), or (vi). Thus, unless a third party has been granted access to an original application, the third party is not entitled to obtain from the Office any information concerning the same, including the mere fact that such an application exists.

4. Non-Compliant Submissions

Comment 44: Some comments raised the issue of applicant's duty to disclose any documents cited in a third-party submission that make it through an initial review but are not considered by the examiner for failure to comply with some formality. One of these comments urged the Office to conduct a thorough initial review to ensure submitted documents can be considered by examiners. Several comments suggested the Office consider alternative ways of processing partially compliant third-party submissions, such as by redacting the non-compliant parts of the submission so that the other documents and their concise descriptions may be entered and considered by the examiner, or by preparing a clean or redacted list of only the documents that were considered, and discarding any paper that references any documents that were not considered by the examiner.

Response: The Office has established procedures to screen third-party submissions for compliance with the requirements of 35 U.S.C. 122(e) and § 1.290 before entering the submissions into the IFW of an application for consideration. Non-compliant and partially compliant submissions will not be entered into the record, as the Office's intent is that only compliant third-party submissions will be entered for consideration by examiners. The Office does not intend to redact or correct non-compliant portions of a third-party submission as the third-party submitter is in the best position to make any necessary revisions to its submission and make a resubmission if the statutory time period has not yet expired.

Comment 45: A number of comments questioned whether minor defects in a third-party submission would result in the entire submission not being entered, and requested guidance regarding what types of informalities, if any, in a third-party submission would not cause the Office to deem the entire submission non-compliant.

Response: Section 1.290(a) provides that a third-party submission may not be entered or considered by the Office if any part of the submission is not in compliance with 35 U.S.C. 122(e) and § 1.290. The Office will enter a third-party submission that is compliant with both 35 U.S.C. 122(e) and § 1.290; however, any non-compliance in a third-party submission with respect to the requirements of 35 U.S.C. 122(e), whether or not the third-party submission is otherwise compliant with § 1.290, will prevent entry of the entire third-party submission into the record. A third-party submission that is compliant with 35 U.S.C. 122(e) but non-compliant with some requirement of § 1.290 may be entered if the error is of such a minor character that, in the opinion of the Office, it does not raise an ambiguity as to the content of the submission. In any event, the Office will either enter or not enter the entire submission and will not attempt to enter portions of partially compliant submissions.

Ideally, only compliant third-party submissions will come before an examiner for consideration. Nonetheless, the Office, in certain circumstances, may be able to exercise some latitude in its screening of third-party submissions for non-compliance with the requirements of § 1.290 so that errors of only a minor character that, in the opinion of the Office, do not raise an ambiguity as to the content of the submission do not prevent entry of the entire submission. For example, if an error with respect to a requirement of § 1.290 is of such a nature that the content of the third-party submission can still be readily ascertained (*e.g.,* a U.S. patent is identified by the correct patent number and issue date but the name of the first named inventor is clearly misspelled), the Office may have enough information to be able to enter the third-party submission into the record despite the error. However, the determination of whether to enter or not to enter a partially compliant submission with respect to a requirement of § 1.290 will be on a case-by-case basis and at the sole discretion of the Office (*e.g.,* the Office may decline to enter a third-party submission listing a U.S. patent whose patent number does not match Office records with respect to that patent number's issue date and/or first named inventor). The Office's dedicated Web-based interface for filing third-party submissions electronically permits third parties to verify the accuracy of some of the information in the submission prior to its filing. Thus, third parties are strongly encouraged to avail themselves of this feature to better ensure compliance with 35 U.S.C. 122(e) and § 1.290.

Comment 46: Several comments suggested the Office waive any informality in a third-party submission, or give the submitter an opportunity, such as a non-extendable one-month period, to either explain why the submission was not defective or to correct the submission. One comment stated that the Office has authority to consider the statutory period to be tolled by an initial non-compliant submission, as it does under the provisions of § 1.135(c).

Response: Where a third-party submitter is notified of a non-compliant third-party submission, the party will have an opportunity to make a resubmission if the statutory time period for making a third-party submission has not yet expired. The Office will not provide the third-party submitter a non-extendable time period in which to make a correction as such a practice would delay the prosecution of the application and could potentially be used by third parties as a mechanism for delaying prosecution. Similarly, the filing of a non-compliant third-party submission will not toll the statutory time period for making submissions. The Office cannot toll the statutory time period for third-party submissions that fail to comply with statutory requirements. Further, the Office will not toll the time period for making a third-party submission where a submission complies with the statute but does not comply with a requirement of § 1.290 because the Office does not want to introduce a delay in the prosecution of an application to wait for

a third party who may, or may not, make the necessary correction. Accordingly, third parties are advised not to delay in making third-party submissions to increase the likelihood of having sufficient time to make a resubmission should the original submission be found non-compliant. The Office intends to notify third parties of non-compliant submissions as soon as reasonably practicable.

Comment 47: Several comments favored eliminating the Office's proposed ''gatekeeper function'' (*i.e.,* screening third-party submissions for compliance) and instead relying upon ''self-policing'' pursuant to the statement of compliance under proposed § 1.290(d)(5)(ii), as being subject to § 11.18(b), to discourage unauthorized filings. These comments also asserted that overly strict screening may prevent an examiner from considering relevant documents, and that screening will not fully protect applicants from obtaining knowledge of non-compliant submissions. Instead of a costly review process, one comment suggested limiting the number of third-party submissions that a single party (or parties in privity with the third party) may submit to promote prompt entry of third-party submissions while preventing individual third parties from making excessive submissions.

Response: By screening third-party submissions for compliance before entry into the record of an application, the Office is affording some protection to applicants against entry of non-compliant submissions that might trigger a duty of disclosure on the part of the applicant to independently file such information in an IDS. Such screening is merely an extension of the screening the Office already performs for submissions under § 1.291 (and previously performed for submissions under § 1.99). Further, such screening should encourage third parties to file better quality third-party submissions, with fewer errors, than under the proposed ''self-policing'' approach.

5. Submissions in Abandoned Applications

Comment 48: One comment suggested the Office should give more consideration to requests to revive applications that were abandoned during the time period when third parties could make third-party submissions because some applicants might abandon their applications to discourage third-party submissions.

Response: The statute does not preclude third parties from making submissions in abandoned applications. Third parties having documents relevant to an abandoned application, therefore, should cite these documents to the Office via a compliant third-party submission since the application eventually may be revived and the submission considered.

Comment 49: One comment suggested the Office not permit entry of third-party submissions into the record of abandoned applications because it wastes Office resources to screen such submissions for compliance and places too much burden on applicants to monitor abandoned application records if the Office does not notify them when compliant submissions are entered. Another comment suggested the Office only enter third-party submissions into the record of abandoned applications under certain circumstances, such as when the Office's Patent Application Information Retrieval (PAIR) system indicates that a continuing application or a petition to revive has been filed, thereby shifting the burden to third parties to monitor the application in that regard.

Response: 35 U.S.C. 122(e) permits preissuance submissions to be filed in an application, whether the application is pending or abandoned. Because the Office intends to notify applicants participating in the e-Office action program of the entry of compliant third-party submissions into an application, whether pending or abandoned, these applicants should not need to monitor their abandoned application files for entry of such submissions.

Comment 50: One comment requested clarification regarding examiner consideration of third-party submissions made in abandoned applications. While the notice of proposed rulemaking states that an examiner would not consider such submission until the abandoned application resumes a pending status, the comment questioned whether, in reviewing an abandoned parent application for pertinent prior art with respect to a pending child application pursuant to MPEP § 707.05, an examiner would be required to consider any third-party submission that was entered into the parent application after it was abandoned.

Response: In reviewing an abandoned parent application for pertinent prior art with respect to a pending child application pursuant to MPEP § 707.05, an examiner should consider any third-party submission that was entered into the parent application after it was abandoned.

I. Duty on Applicant

1. Duty of Disclosure

Comment 51: Several comments suggested deleting any references in proposed § 1.290(h) to an applicant's duty under § 1.56 because such references could be interpreted as waiving the duty of disclosure or, alternatively, revising proposed § 1.290(h) to make it clear that applicants are not relieved of their duty under § 1.56. Several of these comments gave examples of where non-compliant third-party submissions may trigger an applicant's duty under § 1.56. Another comment suggested the rule explicitly provide that a third-party submission imposes no duty on an applicant (*e.g.,* to correct or otherwise review its contents). Further, to the extent proposed § 1.290(h) implies that applicants may be required to reply to a third-party submission under some circumstances, several comments suggested amending proposed § 1.290(h) to reflect that applicants are not required to reply to a third-party submission.

Response: Section 1.290(h), as proposed, states that in the absence of any request by the Office, an applicant has no duty to, and need not, reply to a third-party submission under § 1.290 by a third party. The Office's intent in utilizing the term ''duty'' in proposed § 1.290(h) was not to incorporate a statement relative to the duty of disclosure under § 1.56. Rather, the Office's use of the term ''duty'' was in keeping with the general concept that applicants need not comment on third-party submissions based solely on the presence of such submissions. This concept was articulated in the rule by providing that there is no general requirement that applicants reply to third-party submissions. In view of the controversy generated by the use of the term ''duty'' in the proposed rule, the section has been revised in this final rule to delete its use.

Comment 52: One comment suggested amending the statement under proposed § 1.290(d)(5)(i) to include individuals who are in privity with an individual who has a duty to disclose information with respect to the application under § 1.56. Another comment recommended providing instructions to the general public regarding the statement under proposed § 1.290(d)(5)(i) because non-practitioners may be unfamiliar with the duty of disclosure.

Response: Section 1.290(d)(5)(i) requires a statement by the third-party submitter that the submitter is not a § 1.56(c) party with a duty to disclose information with respect to the

application for which the third-party submission is intended. The requirement is present to exclude applicants and other § 1.56(c) parties from filing information in the application via § 1.290 rather than using the required means of an information disclosure statement under §§ 1.97 and 1.98. The Office declines the invitation to extend the prohibition beyond those parties who already have a duty to disclose material information to the Office under § 1.56.

Guidance regarding who has a duty to disclose, *i.e.,* a § 1.56(c) party, can be found in MPEP § 2001.01, and the use of the rule section is itself self-defining.

J. Information Technology (IT) Issues

1. Electronic Filing

Comment 53: One comment suggested requiring that all third-party submissions be filed electronically.

Response: While it would be most efficient for third parties to file third-party submissions electronically, the Office is not requiring all third-party submissions be filed electronically, as doing so would be contrary to Article 8 of the Patent Law Treaty (PLT), which requires an Office to accept a filing in paper for purposes of complying with a time limit.

Comment 54: One comment suggested the Office separate the listing of documents from the copies of submitted documents so that identifying bibliographical information in the listing of documents is visible in the IFW even when the copies of submitted non-patent literature (NPL) documents are not visible in the IFW.

Response: The Office will separate the § 1.290(d)(1) document list from the copies of the documents in the IFW when entering compliant third-party submissions under § 1.290. The Office currently employs such a practice when entering IDS submissions under § 1.98.

2. Protect Applicants From Unauthorized Submissions

Comment 55: Several comments urged the Office to exercise precautions to protect applications from unauthorized third-party submissions in applications. Another comment asserted that third parties should be encouraged to use EFS-Web to make third-party submissions, but the Office should alter the EFS software to prevent third-party submissions from being directly entered into the IFW without first being reviewed for compliance.

Response: The Office has developed a dedicated Web-based interface for third parties to submit third-party submissions electronically. This dedicated electronic interface is available as an option in EFS-Web and is designed so that third-party submissions under § 1.290 are first screened for compliance with the statute and the rule before being entered into an application file. While this interface will identify submissions for screening before the submissions are sent to the examiner, the Office cannot guarantee that such a system will entirely prevent parties from making unauthorized submissions. Further, while the Office could limit third-party submissions to paper and perform manual screening of each incoming paper to determine whether it is a proper paper, such a system would require intensive resources, and lack the efficiencies and benefits of electronic filing using the Office's dedicated interface. Additionally, limiting submissions to paper only would not entirely eliminate the risk of an unauthorized submission being entered into an application due to inadvertent human error in a manual screening process.

3. Reduce Untimely Third-Party Submissions

Comment 56: A number of comments suggested IT enhancements to prevent or drastically reduce the possibility of untimely third-party submissions. Several of these comments suggested the Office include a feature in EFS-Web or the Office's Patent Application Information Retrieval (PAIR) system that automatically notifies third parties when an application is no longer eligible to receive third-party submissions. One comment suggested providing notice to the examiner when a third-party submission is made in the time period between the posting of an Office action to be mailed and the actual mailing date of the Office action.

Response: As a feature of its dedicated Web-based interface for electronically filing preissuance submissions, the Office plans to automatically prevent a third party from making a third-party submission in an application after the time periods for submission have expired for that application. With respect to providing notice to examiners, examiners will be notified upon entry of a compliant third-party submission in an application that they are examining. On the rare occasion of a third-party submission being filed after preparation of an Office action but before the mailing of the Office action, notification of the entry of a compliant third-party submission in the application will not necessarily delay the mailing of the Office action. Such submissions will be handled the same way IDS submissions are handled under similar circumstances.

4. Other Proposed System Enhancements

Comment 57: One comment suggested making available in the Office's Patent Application Information Retrieval (PAIR) system a ''first action prediction'' estimate of when the first Office action is expected to be issued, and that such estimate might be provided only after the six-month window from publication has elapsed.

Response: The Office already provides a tool that permits third parties and applicants to check current estimates on how long it will take for a first Office action to issue in a patent application according to the Group Art Unit in which the application has been docketed or by class and subclass associated with the application. This ''First Office Action Estimator'' tool is available on the Office's Web site at *http://www.uspto.gov/patents/stats/first_office_action_estimator.jsp.* Accordingly, the Office does not plan to implement an additional feature in PAIR at this time to specifically address third-party submissions under § 1.290. Additionally, third parties are encouraged to file third-party submissions as early as possible rather than delay a submission based upon a predicted first Office action date. Any first Office action prediction for an application would merely operate as an estimate and would not be a binding date or otherwise provide assurance to a third party that a submission would be accepted if an Office action was mailed before the estimated date.

Comment 58: One comment suggested EFS-Web identify the earliest-claimed priority date of an application so an interested third party can identify whether a document is prior art.

Response: In general, the Office does not make a determination regarding earliest effective filing date until such determination is necessary to evaluate the patentability of the claims. Additionally, the determination of the earliest-claimed priority date of an application is a highly fact-specific inquiry that is not fully amenable to performance by an automated algorithm. Furthermore, it would not be desirable for third parties to delay submissions until the Office would provide such a date, which is subject to change if, for instance, applicant introduces new priority or benefit claims or amends the claims in such a manner as to affect whether the claims are supported by the disclosures of the claimed priority or benefit documents. Also, determination of the earliest-claimed priority date of

an application would not be necessary where a third-party is submitting a document that is not prior art. For these reasons, the Office has no plans at this time to modify EFS-Web to identify the earliest-claimed priority or benefit date of an application for third-party submission purposes.

Comment 59: One comment suggested the Office provide an automated means for third parties to check whether a document has been made of record in an application, making it convenient for the third party to review any associated descriptions of relevance so the third party can avoid making a cumulative submission. The comment also suggested the Office automatically flag documents in the IFW that have been submitted more than once in an application and make the associated descriptions of relevance for these documents easily accessible to examiners.

Response: Since an interested third party can review a published application's file history using the Office's public Patent Application Information Retrieval (PAIR) system (*e.g.,* to view a document list previously submitted in a third-party submission by another third party), the Office does not deem an automated system that would identify whether a particular document was previously made of record in the application to be necessary at this time. Further, third parties may use the concise description of relevance to bring to the examiner's attention whether a particular document being submitted was previously made of record in the application.

L. Other Rules

1. 37 CFR 1.99

Comment 60: Some comments suggested the Office retain § 1.99 because some third parties might still want to make a submission without providing a concise description of relevance as required by proposed §§ 1.290(d)(2) and 1.291(c)(2). In this regard, one of these comments recommended the time for making a submission under § 1.99 be amended to be the same as that for proposed § 1.290.

Response: In implementing new 35 U.S.C. 122(e), Congress provided that preissuance submissions by third parties must set forth a concise description of relevance of each document submitted. Thus, to maintain § 1.99, which does not require concise descriptions of relevance, would be in conflict with the statute.

2. 37 CFR 1.291

Comment 61: One comment proposed removing § 1.291 along with §§ 1.99 and 1.292 on the basis that § 1.291 is unnecessary and contrary to Congressional intent. The comment asserted that § 1.291 is ultra vires because it permits submission of evidence concerning inequitable conduct that is not statutorily authorized under 35 U.S.C. 122(e), which refers solely to submission of printed publications. The comment further asserted that § 1.291 imposes obligations that conflict with those under § 1.290 because 35 U.S.C. 122(e) will require a concise description of relevance regardless of whether the application has been published, yet 35 U.S.C. 122(c) still does not allow post-publication protests without the applicant's consent.

Response: Protests pursuant to § 1.291 are supported by a separate statutory provision, 35 U.S.C. 122(c), which implies the availability of submitting a protest in an application prior to publication, absent the applicant's consent. Further, § 1.291 is not deemed duplicative or unnecessary because it permits the submission of information that is not permitted in a third-party submission under § 1.290. For example, in addition to printed publications, under § 1.291, a third party can submit information other than printed publications, as well as present arguments regarding the patentability of the claims of the application.

Rulemaking Considerations

A. *Administrative Procedure Act:* This final rule changes the rules of practice concerning the procedure for filing third-party submissions. The changes in this final rule concern the patent application process and do not change the substantive criteria of patentability. Therefore, the changes in this final rule are merely procedural and/or interpretive. *See Bachow Communs., Inc.* v. *FCC,* 237 F.3d 683, 690 (DC Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp.* v. *Shalala,* 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims); *Nat'l Org. of Veterans' Advocates* v. *Sec'y of Veterans Affairs,* 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive).

Accordingly, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law) and are not required pursuant to 5 U.S.C. 553(d) (or any other law). *See Cooper Techs. Co.* v. *Dudas,* 536 F.3d 1330, 1336–37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for ''interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice.'') (quoting 5 U.S.C. 553(b)(A)). The Office, however, published proposed changes and a Regulatory Flexibility Act certification for comment as it sought the benefit of the public's views on the Office's proposed implementation of this provision of the AIA. The Office received no comments on the Regulatory Flexibility Act certification.

B. *Regulatory Flexibility Act:* For the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes in this final rule will not have a significant economic impact on a substantial number of small entities. *See* 5 U.S.C. 605(b). This final rule changes the rules of practice to implement section 8 of the AIA, which provides a mechanism for third parties to submit to the Office, for consideration and inclusion in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application.

The changes in this final rule concern requirements for third parties submitting patents, published patent applications, or other printed publications in a patent application. The burden to all entities, including small entities, imposed by these rules is a minor addition to that of the current regulations for third-party submissions under § 1.99. Consistent with the current regulations, the Office will continue to require third parties filing submissions to, for example, file a listing of the documents submitted along with a copy of each document, with minor additional formatting requirements. Additional requirements in this final rule are requirements of statute (*e.g.,* the concise explanation) and thus the sole means of accomplishing the purpose of the statute. Because of the expanded scope of submissions under this rulemaking and additional requirements by statute, the Office believes this will take a total of 10 hours at a cost of $3710 per submission. Furthermore, the Office estimates that no more than 730 small entity third parties will make third-party submissions per year. Therefore,

the changes in this final rule will not have a significant economic impact on a substantial number of small entities.

C. *Executive Order 12866 (Regulatory Planning and Review):* This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. *Executive Order 13563 (Improving Regulation and Regulatory Review):* The Office has complied with Executive Order 13563. Specifically, the Office has, to the extent feasible and applicable: (1) Made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector, and the public as a whole, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. *Executive Order 13132 (Federalism):* This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

F. *Executive Order 13175 (Tribal Consultation):* This rulemaking will not: (1) Have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

G. *Executive Order 13211 (Energy Effects):* This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

H. *Executive Order 12988 (Civil Justice Reform):* This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

I. *Executive Order 13045 (Protection of Children):* This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

J. *Executive Order 12630 (Taking of Private Property):* This rulemaking will not effect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

K. *Congressional Review Act:* Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq.*), the United States Patent and Trademark Office will submit a report containing this final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this final rule are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this final rule is not a ''major rule'' as defined in 5 U.S.C. 804(2).

L. *Unfunded Mandates Reform Act of 1995:* The changes in this final rule do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. *See* 2 U.S.C. 1501 *et seq.*

M. *National Environmental Policy Act:* This rulemaking will not have any effect on the quality of environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. *See* 42 U.S.C. 4321 *et seq.*

N. *National Technology Transfer and Advancement Act:* The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions which involve the use of technical standards.

O. *Paperwork Reduction Act:* The Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This final rule makes changes to the rules of practice that impact existing information collection requirements previously approved by the Office of Management and Budget (OMB) under OMB Control Number 0651–0062. Accordingly, the Office submitted a proposed revision to the information collection requirements under 0651–0062 to OMB for its review and approval when the notice of proposed rulemaking was published. The Office also published the title, description, and respondent description of the information collection, with an estimate of the annual reporting burdens, in the notice of proposed rulemaking (*See Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act,* 77 FR 455–56). The Office did not receive any comments on the proposed revision to the information collection requirements under 0651–0062. The changes adopted in this final rule do not require any further change to the proposed revision to the information collection requirements under 0651–0062. Accordingly, the Office has resubmitted the proposed revision to the information collection requirements under 0651–0062 to OMB. The proposed revision to the information collection requirements under 0651–0062 is available at OMB's Information Collection Review Web site (*www.reginfo.gov/public/do/PRAMain*).

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act, unless that collection of information displays a currently valid OMB control number.

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses, and Biologics.

37 CFR Part 41

Administrative practice and procedure, Inventions and patents, Lawyers.

For the reasons set forth in the preamble, 37 CFR parts 1 and 41 are amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

■ 1. The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

■ 2. Section 1.6 is amended by revising paragraph (d)(3) to read as follows:

§ 1.6 Receipt of correspondence.

* * * * *

(d) * * *

(3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in § 1.8(a)(2)(i)(A) through (D), (F), and (I), and § 1.8(a)(2)(iii)(A), except that a continued prosecution application under § 1.53(d) may be transmitted to the Office by facsimile;

* * * * *

■ 3. Section 1.8 is amended by revising paragraph (a)(2)(i)(C), and by adding new paragraphs (a)(2)(i)(B) and (a)(2)(i)(G) through (a)(2)(i)(J), to read as follows:

§ 1.8 Certificate of mailing or transmission.

(a) * * *

(2) * * *

(i) * * *

(B) Papers filed in trials before the Patent Trial and Appeal Board, which are governed by § 42.6(b) of this title;

(C) Papers filed in contested cases before the Patent Trial and Appeal Board, which are governed by § 41.106 (f) of this title;

* * * * *

(G) The filing of a written declaration of abandonment under § 1.138;

(H) The filing of a submission under § 1.217 for publication of a redacted copy of an application;

(I) The filing of a third-party submission under § 1.290; and

(J) The calculation of any period of adjustment, as specified in § 1.703(f).

* * * * *

■ 4. Section 1.17 is amended by removing and reserving paragraph (j) and revising paragraph (p) to read as follows:

§ 1.17 Patent application and reexamination processing fees.

* * * * *

(j) [Reserved]

* * * * *

(p) For an information disclosure statement under § 1.97(c) or (d) or for the document fee for a submission under § 1.290—$180.00

* * * * *

§ 1.99 [Removed and reserved]

■ 5. Section 1.99 is removed and reserved.

■ 6. An undesignated center heading before § 1.290 is added to read as follows:

PREISSUANCE SUBMISSIONS AND PROTESTS BY THIRD PARTIES

■ 7. Section 1.290 is added to read as follows:

§ 1.290 Submissions by third parties in applications.

(a) A third party may submit, for consideration and entry in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application if the submission is made in accordance with 35 U.S.C. 122(e) and this section. A third-party submission may not be entered or considered by the Office if any part of the submission is not in compliance with 35 U.S.C. 122(e) and this section.

(b) Any third-party submission under this section must be filed prior to the earlier of:

(1) The date a notice of allowance under § 1.311 is given or mailed in the application; or

(2) The later of:

(i) Six months after the date on which the application is first published by the Office under 35 U.S.C. 122(b) and § 1.211, or

(ii) The date the first rejection under § 1.104 of any claim by the examiner is given or mailed during the examination of the application.

(c) Any third-party submission under this section must be made in writing.

(d) Any third-party submission under this section must include:

(1) A document list identifying the documents, or portions of documents, being submitted in accordance with paragraph (e) of this section;

(2) A concise description of the asserted relevance of each item identified in the document list;

(3) A legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications;

(4) An English language translation of any non-English language item identified in the document list; and

(5) A statement by the party making the submission that:

(i) The party is not an individual who has a duty to disclose information with respect to the application under § 1.56; and

(ii) The submission complies with the requirements of 35 U.S.C. 122(e) and this section.

(e) The document list required by paragraph (d)(1) of this section must include a heading that identifies the list as a third-party submission under § 1.290, identify on each page of the list the application number of the application in which the submission is being filed, list U.S. patents and U.S. patent application publications in a separate section from other items, and identify each:

(1) U.S. patent by patent number, first named inventor, and issue date;

(2) U.S. patent application publication by patent application publication number, first named inventor, and publication date;

(3) Foreign patent or published foreign patent application by the country or patent office that issued the patent or published the application; the applicant, patentee, or first named inventor; an appropriate document number; and the publication date indicated on the patent or published application; and

(4) Non-patent publication by author (if any), title, pages being submitted, publication date, and, where available, publisher and place of publication. If no publication date is known, the third party must provide evidence of publication.

(f) Any third-party submission under this section must be accompanied by the fee set forth in § 1.17(p) for every ten items or fraction thereof identified in the document list.

(g) The fee otherwise required by paragraph (f) of this section is not required for a submission listing three or fewer total items that is accompanied by a statement by the party making the submission that, to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only submission under 35 U.S.C. 122(e) filed in the application by the party or a party in privity with the party.

(h) In the absence of a request by the Office, an applicant need not reply to a submission under this section.

(i) The provisions of § 1.8 do not apply to the time periods set forth in this section.

■ 8. The undesignated center heading before § 1.291 is removed.

■ 9. Section 1.291 is amended by revising paragraphs (b) introductory text, (b)(1), (c)(1) through (c)(4), and (f) to read as follows:

§ 1.291 Protests by the public against pending applications.

* * * * *

(b) The protest will be entered into the record of the application if, in addition to complying with paragraph (c) of this section, the protest has been served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and, except for paragraph (b)(1) of this section, the protest was filed prior to the date the application was published under § 1.211, or the date a notice of allowance under § 1.311 was given or mailed, whichever occurs first:

(1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is filed prior to the date a notice of allowance under § 1.311 is given or mailed in the application.

* * * * *

(c) * * *

(1) An information list of the documents, portions of documents, or other information being submitted, where each:

(i) U.S. patent is identified by patent number, first named inventor, and issue date;

(ii) U.S. patent application publication is identified by patent application publication number, first named inventor, and publication date;

(iii) Foreign patent or published foreign patent application is identified by the country or patent office that issued the patent or published the application; an appropriate document number; the applicant, patentee, or first named inventor; and the publication date indicated on the patent or published application;

(iv) Non-patent publication is identified by author (if any), title, pages being submitted, publication date, and, where available, publisher and place of publication; and

(v) Item of other information is identified by date, if known.

(2) A concise explanation of the relevance of each item identified in the information list pursuant to paragraph (c)(1) of this section;

(3) A legible copy of each item identified in the information list, other than U.S. patents and U.S. patent application publications;

(4) An English language translation of any non-English language item identified in the information list; and

* * * * *

(f) In the absence of a request by the Office, an applicant need not reply to a protest.

* * * * *

§ 1.292 [Removed and reserved]

■ 10. Section 1.292 is removed and reserved.

PART 41—PRACTICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

■ 11. The authority citation for 37 CFR Part 41 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), 3(a)(2)(A), 21, 23, 32, 41, 132, 133, 134, 135, 306, and 315.

■ 12. Section 41.202 is amended by revising paragraph (b) to read as follows:

§ 41.202 Suggesting an interference.

* * * * *

(b) *Patentee.* A patentee cannot suggest an interference under this section but may, to the extent permitted under § 1.291 of this title, alert the examiner of an application claiming interfering subject matter to the possibility of an interference.

* * * * *

Dated: June 21, 2012.

David J. Kappos,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

[FR Doc. 2012–16710 Filed 7–16–12; 8:45 am]

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