



Greenblum & Bernstein, P.L.C.  
**CLIENT ADVISORY**  
Recent Changes in Rules and Procedures

July 23, 2012

## **USPTO Final Rule for Third-Party Preissuance Submissions**

Dear Clients:

The America Invents Act provides for preissuance submissions by third parties as a mechanism for third parties to contribute to the quality of issued patents by submitting, to the United States Patent and Trademark Office (USPTO), 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. In furtherance of this provision, the USPTO has recently issued a final rule to implement procedures for such submissions. Relevant provisions of the final rule are as follows:

A preissuance submission may be filed in any application filed before, on, or after September 16, 2012, including abandoned applications. In particular, a preissuance submission may be filed in any non-provisional utility, design, and plant application as well as in any continuing application. However, a preissuance submission may not be filed in a reissue application or in a reexamination proceeding.

A preissuance submission must be in writing and must include (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-US 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 (35 USC 122) and the rule (37 CFR 1.290); and (6) the required fee.

A preissuance submission must be filed before (not on) the earliest of (a) the date that a notice of allowance is issued; or (b) the later of six months after the date on which the application is first published by the US PTO or the date of the first rejection of a claim on the merits. These time periods are statutory and cannot be waived or extended.

A preissuance submission must be filed either electronically or by mail. No facsimile transmissions are permitted

A preissuance submission will not be automatically entered into the electronic image file wrapper of an application but instead will be reviewed to determine compliance with 35 USC 122(e) and 37 CFR 1.290 before being entered into the application file. Submissions that are not compliant with the statute or rule will not be entered or considered but will be discarded. The PTO will not attempt to enter portions of partially compliant submissions but will either enter or not enter the entire submission. Any fees paid for a non-compliant submission will not be refunded. A party who previously filed a noncompliant submission may refile a complete compliant submission, provided that the statutory period for such filing has not closed.

The "concise description of the asserted relevance" of each item identified in the submission is a statement of facts regarding the submitted evidence. The concise description should set forth facts explaining how each item listed is of potential relevance to the examination of the application in which the third-party preissuance submission has been filed. The concise description can be a narrative description or a claim chart but must be more than a mere statement that the document is relevant. At the other extreme, the concise description of relevance is not an invitation to a third party to propose rejections of the claims or to set forth arguments relating to an office action in an application. A response by the third-party submitter with respect to an examiner's treatment of the third-party submission will not be permitted or considered.

Compliant third-party preissuance 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 file wrapper in the same manner that the Examiner considers information submitted as part of an IDS.

A fee (currently \$180), is required for every 10 documents, or fraction thereof, listed in each third-party preissuance submission. However an exemption from this requirement is provided where the third-party submission lists three or fewer total documents and is the first third-party submission by the third party or by a party in privity with the third-party, in a given application.

Third-party preissuance submissions must be signed but may be filed by an attorney or other representative on the behalf of an unnamed real party in interest. The party making the preissuance submission must be a party that does not have a duty to disclose information with respect to the application (i.e. is not subject to 37 CFR 1.56).

Should you have any questions or comments regarding this matter, please do not hesitate to contact us.

Best regards,

GREENBLUM & BERNSTEIN, P.L.C.

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Contact Us:  
[www.gbpatent.com](http://www.gbpatent.com)  
[gbpatent@gbpatent.com](mailto:gbpatent@gbpatent.com)  
703-716-1191 (phone)  
703-716-1180 (fax)

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Greenblum & Bernstein, P.L.C | 1950 Roland Clarke Place | Reston | VA | 20191



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