



March 5, 2012

Hon. David J. Kappos  
Under Secretary of Commerce for Intellectual Property  
and Director of the U.S. Patent and Trademark Office  
600 Dulany Street  
P.O. Box 1450  
Alexandria, VA 22313-1450

Submitted via: [preissuance\\_submissions@uspto.gov](mailto:preissuance_submissions@uspto.gov)

**Re: Comments on Proposed Rules: “Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act” 77 Fed. Reg. 448 (January 5, 2012)**

Dear Under Secretary Kappos:

Intellectual Property Owners Association (IPO) appreciates the opportunity to provide comments to the U.S. Patent and Trademark Office in response to the proposed Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act published in the Federal Register on January 5, 2012 (Notice).

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO’s membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members.

The Leahy-Smith America Invents Act (AIA) amended 35 U.S.C. §122 to provide for third party submissions of patents, published patent applications, or other printed publications into the record of a patent application. The proposed rules implementing the changes to section 122 should take into account and balance the interests of applicants, third parties, examiners, and the public. IPO’s comments are provided with these goals in mind.

**A. Applicant Interests**

**1. Purging Non-compliant Submissions**

The Notice indicates that the USPTO will discard non-compliant submissions, but also indicates that compliance may be considered on a document-by-document basis, similar to the treatment of an information disclosure statement (IDS). For example, the Notice indicates that the examiner will strike through documents that were not considered because,

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for example, “the document was listed improperly, a copy of the document was not submitted, or a concise description was not provided for that document.”

IPO is concerned that this procedure could shift the disclosure burden to applicants, requiring applicants to submit in an IDS any documents that are struck through as not considered. Indeed, the Notice indicates that “applicants would not need to file an IDS to have [the examiner consider] the same documents that were previously submitted by a third party as part of a *compliant* preissuance submission,” leaving open the question of documents cited in a non-compliant submission.

IPO suggests that the USPTO consider an alternative way of processing partially compliant third party submissions, such as preparing a clean or redacted list of only the documents that were considered, and discarding any paper that mentions any documents that were not considered.

## 2. EFS-Web

The Notice indicates that the USPTO will be updating its EFS-Web system to permit third party submissions in connection with an application without automatically entering the submissions into the Image File Wrapper (IFW) for the application. The USPTO should proceed with the utmost care and caution to protect applications from un-authorized third party submissions of every kind. For example, the USPTO should employ strict safeguards that not only prevent the entry of non-compliant preissuance submissions, but that also prevent spam submissions in patent applications.

## 3. Notification of Applicants

The Notice indicates that the USPTO will not notify applicants when a preissuance submission has been made until the examiner provides a copy with the first Office Action. IPO urges the USPTO to reconsider its position on this point.

While IPO agrees that applicants should not be required to respond to any preissuance submission, IPO believes that applicants should be given prompt notice of any preissuance submissions. For example, such notice would give applicants an opportunity to respond before the first Office Action is issued, in order to expedite prosecution.

Additionally, providing applicants with early notice of compliant third party submissions will facilitate applicant compliance with the duty of disclosure in co-pending applications. For example, it would be in the interests of applicants, examiners and the public for potentially relevant new documents identified in a third party submission in one application to be promptly cited in a co-pending application.

## 4. Applicant Response

The Notice makes clear that an applicant need only reply to issues raised by an examiner in an Office Action.<sup>1</sup> Proposed Rule 1.290(h), however, implies that applicants may be required to reply to a third party submission under some circumstances. The rule should reflect that applicants

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<sup>1</sup> Applicants already are obligated to reply to Office Actions pursuant to 35 U.S.C. §132 and 37 C.F.R. §1.111.

are not required to reply to a third party submission. IPO proposes the following amendment:

Rule 1.290(h) ~~In the absence of a request by the Office, an~~ An applicant has no duty to, and need not, reply to a submission under this section.

## **B. Third Party Interests**

### **1. Party in Privity**

The proposed rules do not define a “party in privity,” and IPO believes that the USPTO should provide guidance on this point. If the USPTO intends to draw on guidance from reexamination proceedings (e.g., Reexam Control No. 95/000,120, Petition Decision dated July 19, 2006; Reexam Control No. 95/000,155, Petition Decision dated March 8, 2008), or some other source, it should make that clear.

### **2. Notification of Third Party Submitter**

The Notice indicates that the USPTO will not notify the third party submitter when a preissuance submission is accepted or rejected, although it “may attempt to notify the third party submitter” by e-mail if the preissuance submission is deemed to be non-compliant.

IPO believes that the USPTO should notify the third party submitter when a preissuance submission is deemed to be non-compliant (and why), so that the third party submitter has an opportunity to submit a compliant submission if the statutory time period has not yet expired. If the USPTO adopts this suggestion, it should ensure that any notice to the third party submitter is *not* made a part of the IFW for the application at issue.

## **C. Examiner/Public Interests**

### **1. Listed Documents**

The revised statute provides that a third party may submit “any patent, published patent application, or other printed publication of potential relevance to the examination of the application,” and the proposed rules mirror that language. The Notice provides that third parties “need not submit documents that are cumulative of each other or that are cumulative of information already under consideration by the Office” while reminding third parties that any submitted documents must be “of potential relevance to the examination of the application.” The proposed rules do not expressly require the listed documents to be new to the record. IPO believes that the proposed rules should be clarified to specify that documents already of record could be “of potential relevance to the examination.”

### **2. Foreign Language Documents**

The rules require the third party submitter to provide an English translation of “all relevant portions” of any cited foreign-language documents. IPO believes that that the third party submitter should be required to provide a full translation of any foreign language document, to represent that the document as a whole stands for the proposition for which it is cited. At the very least, the third

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party submitter should be subject to the same requirements pertaining to foreign language documents that applicants are subject to in the IDS context, e.g., 37 CFR §1.98(a)(3)(ii), which requires that “if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR §1.56(c), a copy of the translation shall accompany the statement.” That is, the third party submitter should be required to submit any translation that is in its possession.

IPO thanks the USPTO for consideration of these comments and would welcome any further dialogue or opportunity to support the USPTO in implementing these and any other provisions of the AIA.

Sincerely,

A handwritten signature in black ink, appearing to read 'R. F. Phillips', written in a cursive style.

Richard F. Phillips  
President