

# AIA Pre Issuance Submissions

Final Rule Implementing Sec. 8 of the AIA on July 17, 2012

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# Overall Facts

- \* Effective Date – Sep. 16, 2012 –
  - \* APPLIES TO ALL FILINGS – NOT JUST AFTER
- \* Patents, published patent applications, other printed publications of potential relevance
- \* Must include a concise description of asserted relevance of each document submitted
- \* Must be submitted within a statutory time period
- \* Must submit a fee
- \* Must submit a statement that the submission complies with the statute
- \* Eliminating public use proceedings

# Contents of Submission

- \* Must be in writing
- \* Must contain a list identifying items submitted
- \* Must have concise description of relevance of each item
- \* Must have legible copy of each non-U.S. patent document listed
- \* Must have statement that it complies with statute
- \* Required fee

# 35 USC 122(e) added and implemented as 37 CFR 1.290

- \* Submission must be before the earlier of
  - \* A) A Notice of Allowance is given or mailed OR
  - \* B) the later of
    - \* 6 months after publication under 35 USC 122 OR
    - \* Date of first rejection under 35 USC 132 of any claim
- \* NO REQUIREMENT TO SERVE APPLICANT WITH COPY OF SUBMISSION
  - \* Applicant will get notification if participating in e-Office Action program

# This new rule eliminates prior art submissions without comment under 37 CFR 1.99

- \* 37 CFR 1.99 was a weak opportunity relatively speaking
  - \* Did not allow for comment on relevance

# New rule eliminates public use proceedings under 37 CFR 1.292

- \* Really this was made obsolete by PGR, so 1.292 no longer necessary
- \* Third parties **can still submit a protest under 37 CFR 1.291**

# How to File and How Not to File

- \* YES

- \* New web portal created for submissions to be filed electronically (must select proper option in EFS-Web)

- \* Encouraged

- \* Can also use first class mail and 37 CFR 1.10

- \* Use post card

- \* Can also hand deliver

- \* NOTE: Filing receipt is not entry – filings must be screened before entry into IFW

- \* NO

- \* 37 CFR 1.8 amended to indicate that no benefit of certificate of mailing or transmission will be given

- \* 37 CFR 1.6 amended to indicate no fax transmissions are permitted

# If your filing is defective . . .

- \* No refunds
  - \* Filing discarded
  - \* No opportunity to amend/correct
  - \* No tacking of time periods based on improper filing
  - \* Just have to file again (if possible)
- 
- \* If third party includes email address then Office will attempt to notify given email address



# Reissues

- \* No protests of reissue applications will be allowed
  - \* Reissue application is a post-issuance proceeding
  - \* Therefore 35 USC 1.22(e) is directed to “preissuance” proceedings only, and will not apply to reissue
  - \* In reissue, third parties can use protest proceedings of 37 CFR 1.291 and MPEP 1441.01
    - \* MPEP 1441.01 provides that 35 USC 122© protests can be filed after publication when it relates to a reissue

# Reexaminations

- \* Preissuance Submissions do not apply to reexams because they too are post-issuance proceedings
  - \* 35 USC 302 and 35 USC 311

# Preissuance Submissions Summary

- \* OK in non-provisional utility applications
- \* OK in design applications
- \* OK in plant applications
- \* OK in any continuing application
- \* Not OK in reissues or reexams

# Differences

## Protest

- \* 37 CFR 1.291 under 35 USC 122©
- \* Can include things that preissuance submission cannot
  - \* Info other than printed patents
  - \* Facts, arguments, other info ok without having to be printed
  - \* Allows for arguments against patentability
- \* “concise explanation of relevance” as opposed to “concise description of asserted relevance”
- \* Must be before US publication
  - \* WIPO publication does not prevent a protest from being filed

## Preissuance Submission

- \* 37 CFR 1.290 under 35 USC 122(e)
- \* Can be made after publication
- \* Can provide statement of reasons why references are relevant, but no new facts or information are permitted

# Miscellaneous

- \* Preissuance Submissions can be made on applications that go abandoned (i.e., need not be pending)
- \* Fee exemption if
  - \* Listing 3 or fewer documents
  - \* First submission by the third party
  - \* Can be made by different third parties if not in privity

# Office Recommends

- \* File early
- \* File most relevant and don't load down submission with miscellany
- \* Avoid cumulative references
- \* May want to resubmit document of record with new comment

# If you are the Applicant of the subject Patent Application

- \* No need to IDS documents submitted by third party

# Caveats

- \* That which you do not kill, you only make stronger
  - \* Presumption of Validity
  - \* Failed postissuance reviews can make it more difficult to challenge the patent in the future
- \* Even if you manage to force amendments in the patent application, that can result in better rights for the Patent Owner
  - \* Is that good or bad???



# Disclaimer

- \* This presentation is not intended to be legal advice, but instead it is a general discussion of patent topics. Legal situations will vary greatly with facts and the state of the law. Since no presentation can contemplate the facts of a particular action, this discussion is intended only to provide some information and cannot be considered legal advice. Therefore, attempts to apply the discussions presented herein without ample consideration of facts and the law is inherently prone to error, and must be done by legal counsel. The reader is advised to seek competent legal counsel for any actions contemplated or ongoing.

# End

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