

Third Party Art Submissions Under the AIA

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The America Invents Act (“AIA”) has created a process for third parties to submit relevant documents (or “art”) to the Patent Office for review during the examination of a patent application, or to add art to the record of an abandoned application. While a similar procedure was available to third parties prior to passage of the AIA, it was not used extensively for two reasons: the submissions were not anonymous and the submitting party was not permitted to comment on the art submitted. These two deficiencies of the pre-AIA process have been remedied. As a result, expectations are high that the new third party submission process will improve the quality of patent examination and provide a useful tool for third parties to comment on the patent applications of others.

Lack of anonymity, in particular, prevented the pre-AIA third party submission process from being used. Many parties having an interest in the patent application of another feared retaliatory submissions in their own pending applications. The fear of tit-for-tat submissions between parties was compounded by the risk that such an interaction could escalate into costly patent litigation. However, this deficiency of the pre-AIA process has been addressed.

Unlike the prior process, the AIA process enables anonymous third party submissions. Anonymity is preserved in the new process because, while the submission filing must be signed (e.g., by a patent attorney or other registered practitioner) there is no requirement to identify the real party in interest. This releases the third party from balancing the advantage of submitting relevant art with the significant disadvantage of alienating the patent applicant.

Additionally, this new process is expected to improve the quality of the patent examination process by presenting to a patent examiner art that may be relevant to patentability of the invention. This is both helpful to the examiner and beneficial for the quality of examination. Examiners have limited time to search for prior art that is relevant to a patent application. And, with hundreds of thousands issued patents and patent applications published every year, the amount of art that is in published patent applications and issued patents alone is vast. When non-patent literature (e.g., peer-reviewed scientific publications, conference proceedings, publicly available

presentations) is also considered, the challenge of finding relevant art to use in the examination of a patent application can be daunting. By permitting third parties to submit art, the hope is that an examiner is more likely to review relevant art and therefore have better, or at least more, information for the examination

A written comment on the relevance of the art to the application must be provided by the submitting party. This comment (referred to as a “concise description of relevance” in the statute), submitted with the art, is another reason to expect that this reformed process will improve the quality of patent examination. By providing a factual explanation of the relevance of the art, the patent examiner is spared some of the labor required to fully consider a reference. Using the comment of the third party, the examiner can identify the portions of the art most relevant, and then proceed with an independent, but informed, analysis of the application.

Even though the comment must be factual, one incentive to use this process for third parties is that it can be a subtle way to influence the examination of the patent. The regulations specifically state that the concise description of relevance is not an invitation for the submitting party to comment on the examination of the pending application. Rather, the concise description must be limited to facts, such as a chart comparing elements of the claimed invention to those found in the submitted documents.

While this comment is limited to facts, the facts alone can be persuasive. For example, a chart citing art otherwise not considered by the examiner and comparing language in the art to the language of the application can be extremely persuasive even though attorney argument is absent. Similarly, the submission can provide an interpretation of the pending application that may have been unconsidered by the examiner. This can inform the examiner’s analysis. In fact, while submissions should not include multiple documents repetitively promoting a single idea, parties are permitted to submit art that has already been considered by an examiner. The comment can identify an interpretation of the art not previously considered by the examiner.

For this reformed process to benefit the patent examination process, the submitted art must be received at an appropriate time. To ensure that submitted art is received on a timely basis, there are a number of deadlines dictating when a third party may submit art.

To be timely, the pre-issuance submission must be filed before the earlier of 1) a Notice of Allowance or 2) the later of either a) six months after publication of the application or b) the first rejection of the application. The deadline is absolute: it cannot be tolled by filing a Request for Continued Examination or by a timely, but otherwise defective, submission that is intended to be cured after the deadline.

In conclusion, patent practitioners and patent owners expect that the process will help patent examiners with their analysis of patent applications. Art, and alternative interpretations of the art, from third parties will inform examiners during the analysis of an application. This has the potential to improve the quality of patent examination. Furthermore, because the process permits anonymous submissions, interested parties are more likely to use this process.

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