

Post-AIA Preissuance Prior Art Submissions at the USPTO

Best Practices for Third-Party Challenges to Patent Applications and for Monitoring Competition

TUESDAY, DECEMBER 3, 2013

1pm Eastern | 12pm Central | 11am Mountain | 10am Pacific

Today's faculty features:

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Preissuance Submissions Under the America Invents Act

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N.B.: The views expressed in this presentation are those of the authors and do not reflect the views of Thompson Hine LLP or Landon IP.

Preissuance Submissions Before the AIA

- A third party had a limited ability to submit prior art
- Provisions of old 35 U.S.C. § 122(c), 37 CFR 1.99:
 - ▣ Required third party submission within **two months** of publication, and
 - ▣ **Prohibited third party from explaining** prior art's relevance
- Result?
 - ▣ Examiners missed the point
 - ▣ Examiners issued patent over the cited prior art
 - ▣ Issued patent became less susceptible to attack

Preissuance Submissions After the AIA

- Section 8 of the 2011 America Invents Act
- Amended 35 U.S.C. §122 by adding subsection (e)
- Implemented by PTO Rule 290 (37 CFR § 1.290)
- The new statute became effective September 16, 2012
- Intended to satisfy two goals of the AIA:
 - ▣ Increase integrity of U.S. patents
 - ▣ Reduce or eliminate costs of patent disputes

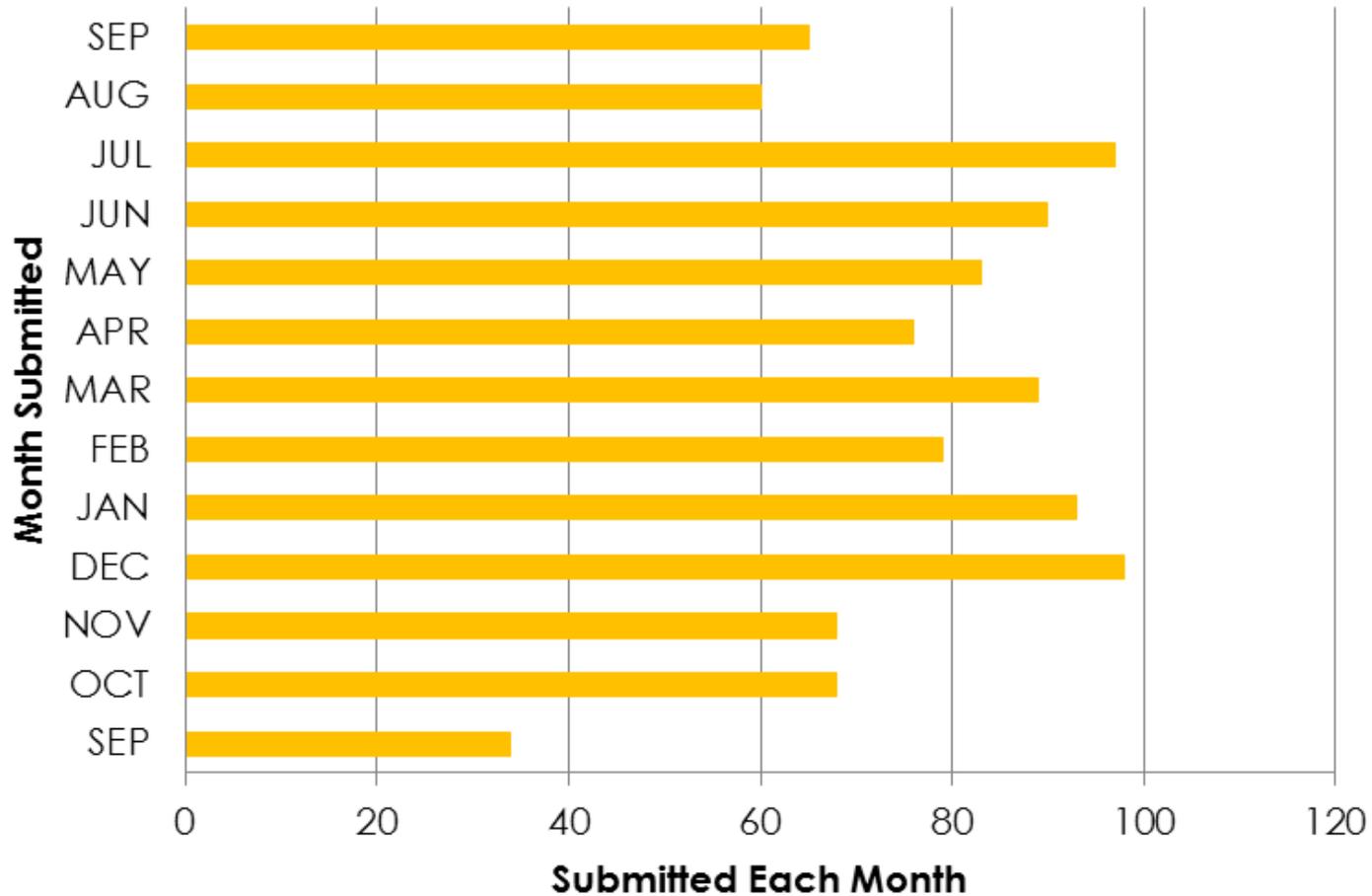
§122(e) Enjoyed Bipartisan Support

- Congress recognized that bar on prior art explanations in §122(c) “decrease[d] the value of the prior art to the examiner” and could “deter [prior art] submissions”
- Congress predicted that AIA’s new §122(e) will:
 - ▣ “help the PTO correct its mistakes”
 - ▣ stop patenting of “inventions already available to the public”
 - ▣ “leverage the knowledge of the public” and
 - ▣ “increase the efficiency of examination and the quality of patents”

Source: H. Rep. No. 112-98, at 48-49 (2011); 157 Cong. Rec. S1097 & S1326 March 2 & 7, 2011

Preissuance Submission

Cumulative as of 9/27/2013 = 1000



■ Source: http://www.uspto.gov/aia_implementation/statistics.jsp

Preissuance v. Post-Issuance AIA Filings

(Totals Sept. 16, 2012 to Sept. 27, 2013)

■ Preissuance Submissions	1000
■ Post-issuance AIA filings	620
▣ Supplemental Examinations	42
▣ Inter Partes Review	522
▣ Covered Business Methods	56

■ Source: www.uspto.gov/aia_implementation/statistics.jsp

USPTO Poll of 100 Examiners (August 2013)

- Overall, to what extent were the submissions by the third party useful during the examination of your application?
 - ▣ 52% rated great to moderately useful
 - ▣ 48% rated limited to not useful
- Overall, to what extent were the concise explanations helpful in identifying pertinent parts of the submissions?
 - ▣ 63% rated great to moderately useful
 - ▣ 36% rated limited to not useful

Source: USPTO's Second Anniversary AIA Forum, Sept. 16, 2013

Text of 35 U.S.C. § 122(e)

(1) In general – Any third party may submit ... any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of:

(A) the date a notice of allowance under § 151 is given or mailed in the application for patent; or

(B) the later of:

(i) 6 months after the date on which the application for patent is first published under § 122 by the Office, or

(ii) the date of the first rejection under § 132 of any claim by the examiner during the examination of the application for patent. ...

Text of 35 U.S.C. § 122(e) (Cont'd)

- (2) Other requirements – Any submission under paragraph (1) shall:
- (A) set forth a concise description of the asserted relevance of each submitted document;
 - (B) be accompanied by such fee as the Director may prescribe; and
 - (C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.

Provisions Added By PTO Rule

- Rule 290 provided more detailed requirements re:
 - ▣ Form of the submission
 - ▣ Content of the submission
 - ▣ Statement by the submitter
 - ▣ The government fee
 - ▣ Free for first submission of up to three documents
 - ▣ \$180 for every 10 documents (large entity)
 - ▣ \$90 for every 10 documents (small entity)

§ 122(e) Submission Can Be Applied Broadly

- § 122(e) is NOT limited to:
 - ▣ Prior art under 102/103
 - ▣ Prior art dated before application's priority date
- Prior art can address:
 - ▣ Eligibility under § 101
 - ▣ Anticipation under § 102
 - ▣ Obviousness under § 103
 - ▣ Indefiniteness under § 112
 - ▣ Other issues "relevant to examination"

“Printed Publication” Is Expansive in Scope

■ Examples:

- ▣ Patents, online journals
- ▣ Competitors’ webpages
- ▣ Blog-posts, emails with wide circulation
- ▣ Public court and PTAB filings

■ Submission of duplicative publication okay

- ▣ Point out a passage the examiner missed
- ▣ Make connection examiner may have overlooked

■ Publication’s date can be after invention priority date

■ Missing dates can be provided via documents or declarations



See USPTO'S Pre-Issuance Final Rules (July 2012), and USPTO's related responses to comments on the rules

“Concise Description” Construed Broadly

- PTO encourages "best format" for explaining relevance
 - ▣ Narrative descriptions acceptable
 - ▣ Claim charts acceptable
- However, explanations should *not*:
 - ▣ Propose rejections, e.g., "103 based on combination of ..."
 - ▣ Address positions taken in an Office action
 - ▣ Address arguments made by applicant in response to OA, or
 - ▣ Otherwise argue against patentability

See USPTO'S Pre-Issuance Final Rules (July 2012), and USPTO's related responses to comments on the rules

Timing of Preissuance Submissions

Submission must be made *before* the earlier of —

- (A) the date a notice of allowance under § 151 is given or mailed in the application for patent; or
- (B) the later of —
 - (i) 6 months after the date on which the application for patent is first published under § 122 by the Office, or
 - (ii) the date of the first rejection under §132 of any claim by the examiner during the examination of the application for patent.

Preissuance Submission Timing - Example 1

Must submit before the earliest of:

- (1) notice of allowance mailing date, **OR**
- (2) the later of (i) 6 months after date of publication or (ii) the date of the 1st substantive Office Action

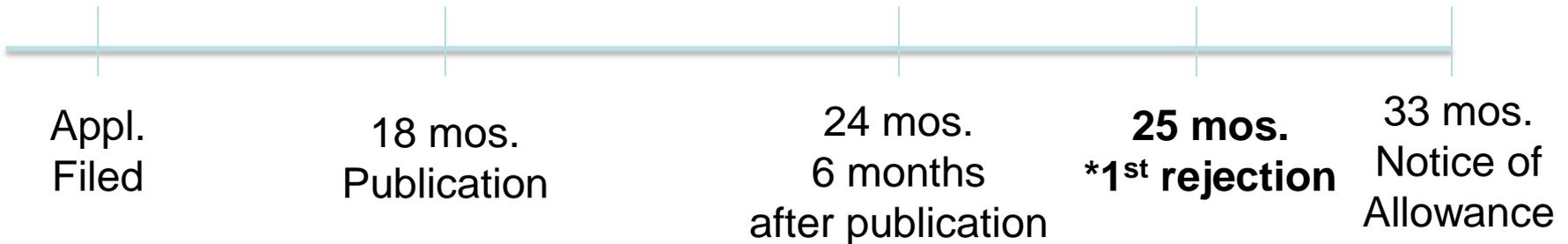


* Preissuance submission must be filed before this date

Preissuance Submission Timing - Example 2

Must submit before the earliest of:

- (1) notice of allowance mailing date, **OR**
- (2) the later of (i) 6 months after date of publication or (ii) the date of the 1st substantive Office Action

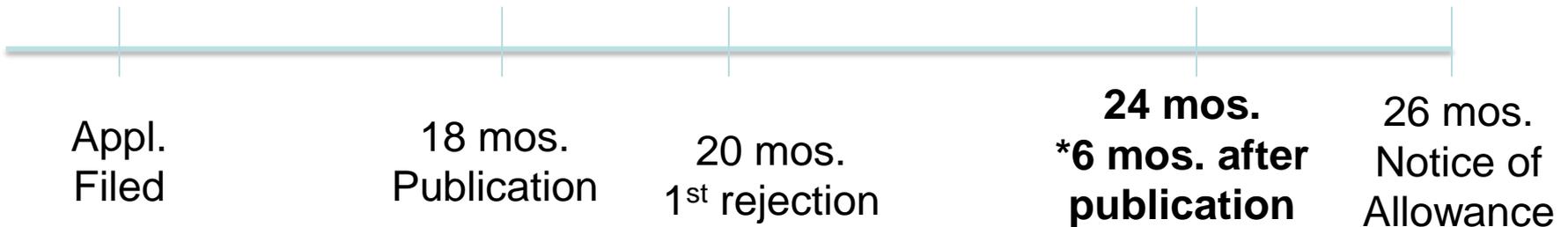


* Preissuance submission must be filed before this date

Preissuance Submission Timing - Example 3

Must submit before the earliest of:

- (1) notice of allowance mailing date, **OR**
- (2) the later of (i) 6 months after date of publication or (ii) the date of the 1st substantive Office Action



* Preissuance submission must be filed before this date

Other Post-AIA Third-Party Submission Options

- NEW: Claim Scope Statements under revised 35 U.S.C. § 301
 - ▣ Permits third party to anonymously file a patentee's prior statement in an ongoing litigation proceeding in USPTO
 - ▣ The patentee's prior statement must be one in which the patentee took a position on the scope of a patent claim at issue
 - ▣ The patentee must have taken the position in an earlier proceeding before the USPTO or a federal court
 - ▣ The third party's filing must include an explanation of the relevance of the patentee's prior statement to each claim
- ELIMINATED: Preissuance submissions under 35 U.S.C. § 122(c) and PTO Rule 99
- CONTINUED: Protests under 35 U.S.C. § 122(c) and PTO Rule 291

Preissuance Submission Pros and Cons

Advantages:



- ▣ Submission is not limited to prior art or 102/103
- ▣ "Concise description" with claim charts is allowed
- ▣ "Printed publication" is broadly construed; can include prior art of record
- ▣ Anonymous — no estoppel v. later making arguments in court
- ▣ PTO's patentability standard is lower than courts' invalidity standard
- ▣ Can destroy or at least trim patent protection to avoid conflict
- ▣ Very inexpensive way to challenge patent rights

Disadvantages:



- ▣ Risk of strengthened patent if examiner issues patent anyway
- ▣ Possible flag to applicant that prospective patent is important
- ▣ Diligence required; no guarantee submission can be made

Preissuance Submissions: Eligibility

- Not restricted to applications filed under AIA
- Not for use in reissues or re-examinations
- Not for use with your own applications
- Not for use in provisionals

Preissuance Submissions: Eligibility (Cont'd)

- Can use in non-provisional utility, design, and plant applications
- Can use in RCEs
- Can use in Continuations
- Can be submitted in unpublished application
- Can be submitted in abandoned applications

Traps for the Unwary

- Time periods are unextendable
- No opportunity to cure a denied Preissuance Submission – must re-file
- May provide an email address for USPTO to notify you of deficiency
- Don't wait until the last minute
- Consider tracking first Office Action predictor

Traps for the Unwary (Cont'd)

- Submissions must be received before, not on, triggering dates
- Cannot use 37 C.F.R. § 1.8 – Certificate of Mailing or Transmission
- Can use 37 C.F.R. § 1.10 – Express Mail
- File Electronically

Traps for the Unwary (Cont'd)

- Timing issue: publication by WIPO of an application designating US does not trigger 1.290(b)(2)(i)
- Check all references you are submitting against your own pending applications – trigger the need for an IDS?

Non-Compliant Submissions

- Not entered
- No ability to amend/correct
- Not forwarded to the Examiner
- No refund
- Not forwarded to the Applicant
- What if the Office wrongly denies entry?

Partially Compliant Submissions

- Submissions not in compliance with 35 U.S.C. § 122 - not entered
- Submissions not in compliance with 37 C.F.R. § 1.290 - may be entered
- Standard: If the error is of such a minor character that it does not raise an ambiguity as to the content of the submission
- Standard applies to Preissuance Submission as a whole

Compliant Submission

- Applicant is notified (if Applicant participates in E-Office Action program)
- Considered by the Examiner
- Examiner will provide a copy of the listing of documents that were considered by Examiner
- Listing of considered documents will be listed on front page of patent

Comparison To Protests

- Protests: 35 U.S.C. §122(c) and 37 C.F.R. §1.291
- Quite Similar Overall
- Comments Questioned Need for Both
- USPTO: Separate Statutory Provision
- Major difference: Protests require applicant consent, if filed after publication

Miscellaneous Provisions

- Third Party Submissions Eliminated
- Public Use Proceedings Eliminated
- Anonymity is permitted to encourage submissions and avoid challenges that party is improperly identified
- Name of attorney or representative is disclosed

Miscellaneous Provisions (Cont'd)

- Filer need not be a registered attorney or agent
- Foreign language translation – machine translation OK
- Art already cited by Examiner
 - ▣ Can be considered
 - ▣ Timing Issues
 - ▣ Cumulative?

Strategic Considerations

- Cannot suggest a rejection – can you suggest a Requirement for Information?
- Submit Foreign Office Actions
- Compare to placing Applicant on notice

Strategic Considerations (Cont'd)

- Consider implementing a Preissuance Submission strategy
- Continue monitoring applications of interest even if the deadline is passed – watch for relating filings
- Consider requesting Prioritized (accelerated) Examination to avoid Preissuance Submissions for your applications

Preissuance Submission v. PGR/IPR: Differences

Preissuance Submissions:

- Are inexpensive
- Are quicker; expected resolution of a few months
- Allow for anonymity; PGR/IPR does not
- Creates no estoppel; PGR/IPR does

Preissuance Submission v. PGR/IPR: Differences (Cont'd)

- No threshold to be met
- Involves no discovery or hearing, PGR does, as does IPR to lesser extent
- Applies to all patents; PGR restricted to “first to file” applications

Preissuance Submission v. PGR/IPR: Similarities

- Limited to patentability challenges – no possibility for infringement or unenforceability
- Preissuance Submissions and PGR allow challenges under 35 U.S.C. §101, §102, §103 and §112
- Involve reduced burden of proof of unpatentability - clear and convincing evidence not required
- Tech-savvy decision makers

Preissuance Submission v. Civil Action

- Differences are generally the same as in case of Preissuance Submission v. PGR/IPR
- Similarities are generally the same as in case of Preissuance Submission v PGR/IPR, except:
 - ▣ Challenger in civil action can raise issues of infringement, damages, unenforceability, willfulness, and attorneys' fees
 - ▣ Burden of proving invalidity in civil action is higher: clear and convincing evidence
 - ▣ Decision-maker at civil action is typically not tech-savvy

Preissuance Submission v. Ex Parte Reexamination

- Similarities and differences are generally the same as in case of Preissuance Submission v. PGR/IPR, except:
 - ▣ Both Preissuance Submission and Reexams allow for anonymity
 - ▣ The challenger's involvement in both Preissuance Submission and reexamination is very limited
 - ▣ Reexamination is limited to patentability challenges based on prior art, Preissuance Submission patentability challenges are as not limited

Preissuance Submissions – Sweet Spot

- Use against nuisance patents
- Keep track of dates
- Easy to monitor competitors

Monitoring – Timing

- Pre-issuance submissions must be received within a time window for the patent application you are challenging (as previously discussed)
 - ▣ Before the Notice of Allowance
 - or the later of:
 - ▣ 6 months after the published patent application (PGPub) publication date
 - ▣ Before the first office action

Monitoring – Timing

- The best course of action is to monitor for recently published PGPubs and to submit the pre-issuance submission within the 6 month publication time window
 - ▣ You can not anticipate when a notice of allowance will be sent by the examiner
 - ▣ First action allowances and other early allowances are rare
 - ▣ Rely on the 6 month publication time window
 - ▣ You can not anticipate when the first office action will be sent out by the examiner

Monitoring – Search Parameters

- The search parameters for any type of monitoring should be customized to fit the end goals
- Standalone search systems allow you to search / filter your results by many different parameters
- Standalone search systems may or may not rely on patent families to group their results
 - ▣ Different strategies are needed depending on if you are or are not using a family-based search system
 - ▣ There are advantages and disadvantages to relying or not relying on family-based search results

Monitoring – Search Parameters

- The first goal is to locate recently published PGPubs on a regular basis (the examples going forward assume we are looking for US PGPubs)
 - ▣ The monitoring search will need to be conducted on a regular basis, it is recommended to update the monitoring search once a month
 - ▣ Filter the results for PGPubs which have published in the past 1¼ months
 - ▣ There is a lag between when the documents publish and when they are added to the search system
 - ▣ When using a family-based search system you will need to also filter your results by country code (US) and kind code (A1)

Monitoring – Search Parameters

- The second goal is to locate recently published PGPubs in the correct technological area
 - ▣ If these patent applications are granted, they may be potential threats to your company or client
- Search parameters such as assignee, inventor, keyword terms, or classification codes can be used alone or in combination to filter your results and locate potentially threatening patent applications
 - ▣ The parameters will be chosen based on the monitoring project's end goals

Monitoring – Search Parameters – Assignee

- Filter your results by assignee to locate and challenge your competitor's patent applications (example 3M)
 - ▣ Company divisions can vary in the assignee field from application to application
 - ▣ The company “3M” may also be represented as “3M Inc”, “3M Corp”, etc...
 - ▣ Companies may have multiple names
 - ▣ “3M” may also be represented as “Minnesota Mining and Manufacturing”
 - ▣ Many times company names are misspelled in the assignee field

Monitoring – Search Parameters – Assignee

continued...

- Filter your results by assignee to locate and challenge your competitor's patent applications (example 3M)
 - ▣ Companies may have subsidiaries to take into consideration
 - ▣ You may be concerned about joint research agreements between companies or between a company and a research institution
 - ▣ Note that the assignee does not need to be reported until a patent application is granted
 - ▣ Other bibliographic data can be used to guess who the assignee is

Monitoring – Search Parameters – Inventor

- Inventor name searching is useful to monitor for patent applications filed by industry leaders or by employees of a particular company
 - ▣ This is a useful technique when you can't search by assignee
 - ▣ Take name variations into account
 - ▣ An individual named Robert may be represented as: Bert, Bob, Bobby, or Rob
 - ▣ Some standalone search systems allow you to search by inventor country or inventor state
 - ▣ This is useful for common names

Monitoring – Search Parameters – Text

- Text searching can be used to monitor for published patent applications involving a particular technology or industry
- Keywords can be searched in either the full text to find documents which mention the technology, or in the claims to find documents which may have threatening claim language
 - ▣ Patent publications are known to use vague language to broaden the scope and hide the invention
 - ▣ Claim searching is particularly tricky due to the even broader and imprecise nature of the language used in claims

Monitoring – Search Parameters – Classification

- Classification codes can be used to represent particular technologies or concepts
 - ▣ Many technologies use common words to represent components, making keyword searching ineffective
- Use as many classification systems as you can to your advantage
 - ▣ Patent applications may be misclassified in one system but not in another
 - ▣ If you use a family-based search system, note that the other family members may be correctly classified
 - ▣ Different classification systems use different rationales or viewpoints
 - ▣ Make sure you use at least USPC & the new Cooperative Patent Classification (CPC)

Monitoring – Search Parameters – Example

- You are interested in challenging patent applications filed by 3M for systems which optically monitor an individual's blood sugar
 - ▣ US PGPubs published in the past 1¼ month
 - ▣ Assignee: “3M” or “Minnesota Mining”
 - ▣ Inventor: Anderson or Johnson living in MN or WI
 - ▣ Text: “Blood sugar” or “Glucose” or “Analyte”
 - ▣ Classification:
 - ▣ USPC 356/39 OPTICS:MEASURING AND TESTING; BLOOD ANALYSIS
 - ▣ USPC 600/316 SURGERY; ...; Measuring or detecting nonradioactive constituent of body liquid...; Infrared, visible light...; Glucose
 - ▣ CPC A61B5/14555 ...; Measuring characteristics of blood; using optical sensors

Monitoring – Reporting

- Reporting can be done in different ways and should reflect the monitoring project goals
 - ▣ Feature Matrix – a spreadsheet which links inventive features or product features to the published patent applications found
 - ▣ This is similar to a claim chart
 - ▣ Summary – a summary of the published patent application and how it appears to be similar to or different from the inventive features or product features

Monitoring – Next Steps

- Once a threatening published patent application is found you can conduct a prior art search for your pre-issuance submission
- A prior art search will have the same parameters and strategy as a validity or invalidity search
 - ▣ Establish which claims to search and their interpretation, and establish a critical date
 - ▣ Search for prior art anywhere in the world
 - ▣ Granted patents and published patent applications
 - ▣ Use native language searchers or English machine translations to search for non-English publications
 - ▣ Non-patent literature
 - ▣ Journal publications, theses and dissertations, conference proceedings, standards, blogs, videos (TED talks), etc...

Thank You

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