



Patent Reform 2011:

Third Party Submission of Prior Art During Examination

Purpose:

- To provide a more effective way for third parties to submit patents, published patent applications, or other printed publications that are potentially relevant to the examination of a patent application. Existing practice does not permit parties to explain the relevance of the prior art, it limits the number to 10 total patents or publications, and it must be done within 2 months (unless an exception applies) of publication of the application, so long as there is no notice of allowance.

Scope and Conduct:

- A third party may submit patents, published patent applications, or other printed publications that are potentially relevant to the examination of the patent application, but qualification as “prior art” is not necessary.
- The submission must take place not later than 6 months after publication of the patent application or before the date of the first rejection of the patent application, so long as a notice of allowance has not issued.
- Unlike present practice, the submitting party is allowed (indeed, is required), to include a concise description of the asserted relevance of each reference submitted.
- **Fee and Statement:** Must include a fee and state that it is in compliance with law
 - **Anonymity:** There is no requirement to identify the real party in interest.

Effective Date

- Effective one year after enactment, i.e. September 16, 2012.
- Applies to all applications then pending or filed on or after that date.

Practice Tips/Considerations:

- Consider monitoring your competitors' applications and submitting documents for review by the examiner, perhaps anonymously
 - A submission may help narrow or prevent allowance of your competitors' patent
 - A submission may cause an Examiner to examine the application more thoroughly, knowing it may be subject to future dispute, including a post-grant review

- Providing argument regarding a document's relevance will help direct the Examiner's attention to the issue, and counter what is otherwise the applicant's natural advantage in being able to prosecute applications without opposition from an adversary
- Unlike post-grant review, a third party is not later estopped from bringing a claim with respect to a document submitted, though the patentee will be able to argue that the PTO has already considered the art in question.