## Legal and policy guidance

http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html

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<tr>
<th>TITLE*</th>
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<td>Updated Lists of Exceptions to the Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence (signed 19Sep2005) (PDF)</td>
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<td>Search and Examination of International Applications Filed Under the Patent Cooperation Treaty (signed 19Sep2005) (PDF)</td>
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Topics

• Peer Reviewed Prior Art Pilot
• Mechanisms for Third-Party Submissions (Current) and Correcting Patents
Peer Reviewed Prior Art

USPTO Perspective

• Public Criticism of Patents, Software
• Current Rules Permit Rule 1.99 Submission
• Proof of Concept Pilot
Peer Reviewed Prior Art

USPTO Goals

• Get the best art before the examiner
• Improve patent quality
• Address negative public perception
• Foster public involvement using Internet collaboration techniques
Pilot Short History

• Coordination with Community Patent Review Project (CPRP), Dec. 2005
• Public meetings in Feb and May 2006
Peer Reviewed Prior Art

Volunteer Applicants

• File waiver form with USPTO
• USPTO will notify applicants and Community Patent Review Project of acceptance
• USPTO will assist applicants with identifying possible applications for pilot
Peer Reviewed Prior Art

Pilot Overview

• For up to 250 applications in TC 2100
• USPTO to waive portions of 37 CFR 1.99 and 1.291 for volunteer pilot participants
• Participants consent to allow comments with submission
• USPTO to accept one submission
Related Requirements
(to be described in detail later)

• Existing § 1.99 permits third-party submissions that satisfy rule requirements including fees, service, timing and format requirements.

• Existing § 1.291 permits public protests that satisfy rule requirements including service, timing, written consent and format requirements.
Peer Reviewed Prior Art

Submission

• CPRP to submit to the USPTO up to 10 peer selected pieces of prior art with commentary within 4 months of pre-grant publication of volunteered U.S. patent application assigned to Technology Center 2100.
Peer Reviewed Prior Art

For every application submitted and accepted for the Pilot, the USPTO will:

• Accept **one** Rule 99 submission from CPRP

• Advance the application out-of-turn for initial examination on the merits so the results of the pilot can be reviewed in a short time frame

• Consider the prior art submitted by CPRP in the determination of patentability
Data to be collected by USPTO:

• Did the prior art submitted by CPRP materially effect the patentability determination for any claim?

• Was the prior art submitted available to the examiner during normal examination?

• Did the commentary have any effect on the examination process?

• What was the general perception of the examiners with the pilot and process?

• Etc.
End of Pilot

• Evaluation of the Results
• Expectations
• Next steps?
Mechanisms for Third-Party Submissions (Current) and Correcting Patents

• Rule 1.99 Submissions
• Protests Under Rule 1.291
• Rule 1.501 Submissions
• Reexamination
Mechanisms for Third-Party Submissions (Current) and Correcting Patents

Rule 1.99 Submissions

• A third party may submit up to ten patents and/or publications to the USPTO for consideration in examination of a patent application
  • The application must be pending when the submission and application file are brought to the examiner
  • The submission must include:
    • the fee set forth in 37 CFR 1.17(p) (currently $180)
    • A list of the patents and/or publications
    • A copy of each listed document
    • Any necessary English language translation
Mechanisms for Third-Party Submissions (Current) and Correcting Patents

Rule 1.99 Submissions (continued)

• The submission must be served on applicant.
• Any explanation of the relevance of the submission, or a defective submission, will be discarded.
• The submission must be filed by the earlier of:
  • the date of mailing of the Notice of Allowance; or
  • two months after the date of publication of the application.
Protests Under Rule 1.291

• In general, a protest may be filed by a member of the public if:
  • the protest has been served upon applicant;
  • the protest was either filed prior to the date the application was published or a notice of allowance was mailed, whichever occurs first; or applicant has consented to the protest and it is matched with application in time to permit review during prosecution
Mechanisms for Third-Party Submissions (Current) and Correcting Patents

**Protests Under Rule 1.291** (continued)

- The protest must include:
  - A listing of the patents, publications, or other information relied upon
  - A concise explanation of the relevance of each item listed
  - A copy of each listed patent, publication, or other item of information in written form, or at least the pertinent portions
  - An English language translation of all the necessary and pertinent parts of any non-English language patent, publication or other item of information relied upon
Submissions Under Rule 1.501

• Any person may cite (in writing) prior art consisting of patents or printed publications which that person states are pertinent and applicable to the patent and believes to have a bearing on patentability
  • “Any person” includes patent owner; the patent owner may include an explanation of how the claims differ from the prior art (see exceptions during reexamination)
• Can be submitted anonymously
• Person submitting can keep identification confidential by omitting identification
• Should serve on patent owner or file in duplicate
Mechanisms for Third-Party Submissions (Current) and Correcting Patents

Reexamination

• *Ex Parte* Reexamination
  • Any person may file a request containing certain elements and a fee ($2520)
  • Intent
    • To provide procedures for reexamination of patents
    • To provide procedures for prompt and timely determinations by the Office in accordance with the “special dispatch” requirement
Mechanisms for Third-Party Submissions (Current) and Correcting Patents

Reexamination (continued)

• *Inter Partes* Reexamination
  • Provides a third-party requester the opportunity to participate in the reexamination (fee of $8800); *Ex parte* reexamination allows very limited participation at the beginning stage only

• Characteristics common to both procedures
  • Prior art is limited to patents or printed publications
  • A substantial new question of patentability (SNQ) must be present
  • No broadening allowed; broadening subject to Reissue
Thank you.

Samuel Broda, Office of Patent Legal Administration
571/272-7711