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NASA Goddard Space Flight Center Information Science  
and Technology Colloquium

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# Office of Patent Legal Administration

Legal and policy guidance

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

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<a href="#">Patents</a> > <a href="#">Office of the Deputy Commissioner for Patent Examination Policy</a> > <a href="#">Office of Patent Legal Administration</a> > <a href="#">Recent Patent-Related Notices</a>				
TITLE*	OG CITE	OG DATE	FR CITE	FR DATE
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<a href="#">United States Postal Service Interruption and Emergency under 35 U.S.C. 21(a)</a> [PDF]				
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<a href="#">Updated Lists of Exceptions to the Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence (signed 19Sept2005)</a> [PDF]				
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<a href="#">Office Actions and Notice of Allowances Previously Mailed to Areas of Alabama, Louisiana,</a>				



# Topics

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



# Peer Reviewed Prior Art

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## **USPTO** Perspective

- Public Criticism of Patents, Software
- Current Rules Permit Rule 1.99 Submission
- Proof of Concept Pilot



# Peer Reviewed Prior Art

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## USPTO Goals

- Get the best art before the examiner
- Improve patent quality
- Address negative public perception
- Foster public involvement using Internet collaboration techniques



# Peer Reviewed Prior Art

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## **Pilot Short History**

- Coordination with Community Patent Review Project (CPRP), Dec. 2005
- Public meetings in Feb and May 2006



# Peer Reviewed Prior Art

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## **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

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## 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



# Peer Reviewed Prior Art

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## 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

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## **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

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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



# Peer Reviewed Prior Art

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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.



# Peer Reviewed Prior Art

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## End of Pilot

- Evaluation of the Results
- Expectations
- Next steps?



## Mechanisms for Third-Party Submissions (Current) and Correcting Patents

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- Rule 1.99 Submissions
- Protests Under Rule 1.291
- Rule 1.501 Submissions
- Reexamination



## Mechanisms for Third-Party Submissions (Current) and Correcting Patents

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### **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

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### **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



## Mechanisms for Third-Party Submissions (Current) and Correcting Patents

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### **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

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### **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



## Mechanisms for Third-Party Submissions (Current) and Correcting Patents

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### **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

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## **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

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### **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



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**Thank you.**

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