



America Invents Act

Third Party Submission of Prior Art Pending Applications

The purpose of third-party submissions of prior art is to improve patent quality by allowing third parties to submit patents, published patent applications, or other printed publications that may be relevant to an examiner when determining the patentability of claims in a patent application.

Scope and Conduct:

A third-party submission may include patents, published patent applications, or other printed publications, including litigation and court documents, that are potentially relevant to the examination of the patent application.

Each third-party submission may include up to ten references, for a fee of \$180. If it is the first submission by the third party, and fewer than four documents are cited, the fee is waived.

The identity of the interested party making the submission may be confidential.

Requirements:

A third-party submission must include:

- a document list identifying up to ten documents,
- a concise description of the relevance of each document,
- a legible copy of any non-U.S. patent publications,
- an English translation of non-English documents,
- a statement that the submission applies with the rules, and
- the prescribed fee.

If the date of publication is not apparent, evidence of publication is required.

A third-party submission must be submitted by the later of (1) six months after the date of publication of the application, and (2) the date of the first substantive Office Action. A third-party submission will not be allowed after a notice of allowance has issued.

Considerations:

A third-party submission may help narrow or prevent allowance of competitors' patent.

A third-party submission may prompt a more thorough examination.

The concise description of relevance is an unusual opportunity to influence examination by directing the examiner's attention to particular issues.

During prosecution, the applicant will have an opportunity to argue for patentability and/or amend the claims to distinguish over the cited art, which could strengthen the patent and/or negate the value of the cited references in any future dispute.

Unlike post-grant review, in any subsequent proceedings, the third party retains the right to challenge any issued patent based on the documents submitted.

Filing new applications with a request for non-publication, if no plans to file any corresponding foreign or international application exist, will usually prevent others from filing third-party submissions against an application.