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AIA new submissions  
Nicolas E. Seckel

Intellectual Property Law

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## New submissions

- Supplemental examination (by patent owner)
- Preissuance submission (by third party)
- Citations of patent owner prior statements
  
- Effective date: September 16, 2012 for all patents and applications

## Supplemental examination

## Supplemental examination

- Cost: \$5140 + \$16,120 (refundable if no reexamination)
- Goal: immunize patent owner from potential inequitable conduct
- Applies to all enforceable patents issued before, on or after September 16, 2012

## Content of request

- Identify patent and each claim for which supplemental examination is requested
- Identify submitted information
  - 12 items maximum
  - Not limited to patents and printed publications
- Explanation of relevance and manner of applying to each claim
  - Similar to ex parte reexamination request

## Processing

- Decision on Ex parte Reexamination
  - Substantial new question of patentability (SNQ)
    - Substantial evidence of unpatentability
  - If no SNQ, refund
- Electronic supplemental examination certificate
  - Within 3 months (statutory)

### Note: material fraud

- USPTO disciplinary sanctions
- USPTO may refer issue to U.S. Attorney General
- Material fraud is narrower than inequitable conduct

### Preissuance submission

### Preissuance submission

- Cost: \$180 (per 10 docs) or \$0 (if first and only submission of 3 docs max)
- Goal: improve quality of examination by having relevant information considered by Examiner early in prosecution
- Applies to all pending or abandoned applications on or after September 16, 2012

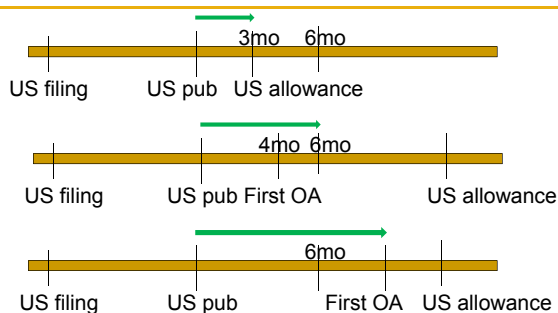
### Content of submission

- Identification of information
  - Limited to printed publications
  - Not necessarily prior art
  - With translations
- Concise description of asserted relevance
  - Not proposed rejection
- Identification of real party-of-interest not required
  - Signed
  - Declaration that no duty of disclosure
    - Excludes Applicant
- No service on applicant

### Time limit

- Before earliest of
- 1) Notice of allowance
- and
- 2) Latest of
    - a) 6 months after US publication
    - b) first Office Action

### Timelines



## Processing

- If compliant:
  - Made of record and considered by Examiner
  - Submitter cannot intervene or respond
- If non-compliant:
  - Submitter notified by email

## Note: protests under 37 C.F.R. 1.291

- Must be filed in pending application
  - Before earliest of notice of allowance and US publication
  - Except if applicant agrees
- Any facts or information adverse to patentability
- Concise explanation of relevance may include how to apply to the claims
- Identification of real party-of-interest not required

## Citation of patent owner written statements on claim scope

## Citation of patent owner claim scope statements

- Goal: point out different patent owner positions on claim scope in different proceedings
- Applies to all patents before, on or after September 16, 2012

## Statements subject to citation

- Written statements on claim scope:
  - Made by patent owner
  - Filed by patent owner
  - In Federal court or USPTO

## Content of citation

- Identification of patent owner claim scope statement
  - Content of patent owner statement
  - Forum where patent owner made or filed the statement
- Concise explanation of pertinence and manner of applying to at least one claim
- Identification of real party-of-interest not required
- If filed by other than patent owner, service on patent owner required

## Processing

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- Not used to order ex parte reexamination or contested proceeding
- BUT
- May be considered if one is instituted
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## Note: citation of prior art

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- Unchanged: citation of prior art in issued patents
    - prior art patents and printed publications
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## Conclusion: low-cost measures

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- Supplemental examination:
    - improve or correct prosecution history file (by patent owner)
  - Protests/preissuance submission:
    - influence examination against application (by third party)
  - Citations of prior art/patent owner prior statements:
    - influence prosecution history file (by patentee or third parties)
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## Questions, comments?

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This presentation is not legal advice