

Submission of Information by Third Parties

United States of America

(i) Third party submission in published application

According to 35 U.S.C. §301, any person may at any time cite to the USPTO, in writing, prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. It is possible to submit such prior art information anonymously (upon request, the identity of the submitter will be excluded from the official file and kept confidential).

In accordance with 37 C.F.R. §122(e) a third party is permitted to submit patents, published patent applications or printed publications along with a concise description of the relevance of each document to the USPTO for consideration during the examination of a patent application. This provision applies to any patent application filed before, on, or after September 16, 2012. The third party submission must be made before the earlier of:

- (a) the mailing of a notice of allowance; or
- (b) the later of
 - (i) six months from the date of publication of the application; or
 - (ii) the date of the first rejection by the examiner.

Section 122(e) also provides for such fees as the Director may prescribe. The third-party preissuance submissions can be filed on paper or via the Office electronic filing system (EFS) with an immediate electronic acknowledgement. Compliant preissuance submissions are entered into the electronic image file wrapper (IFW).

There is no fee required if the first submission by a third party in an application lists three or fewer items, and is accompanied by the statement set forth in 37 C.F.R. §1.290(g).¹

(ii) Protest under 37 C.F.R §1.291

In addition to the third party submission in respect of published applications, a protest under 37 C.F.R §1.291 may be filed by a member of the public against a pending application, to challenge the issuance of a patent from the application. In this case, the protester is entitled to provide written comments describing the relevance of publications or other information being submitted as prior art to the claims of the pending application of the patents. However, under 37 C.F.R. 1.291, the protest must be filed before the challenged pending application is published, or if the application is not published, before a Notice of Allowance is issued. Thus, a protest can only take place when the challenger has personal knowledge of the application being filed.

¹ For further information see http://www.uspto.gov/sites/default/files/documents/3prsubmission_instructions.pdf (instructions for paper filing) and http://www.uspto.gov/sites/default/files/OSG_Third_Party_Preissuance.pdf (instructions for electronic filing).