

AMERICAN BAR ASSOCIATION

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March 5, 2012

Via Electronic Mail
preissuance_submissions@uspto.govThe Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Mail Stop Comments - Patents
P.O. Box 1450
Alexandria, VA 22313-1450Attn: Nicole D. Haines, Legal Advisor
Office of Patent Legal Administration, Office of the Associate
Commissioner for Patent Examination PolicyRe: Changes To Implement the Preissuance Submissions by Third Parties
Provision of the Leahy-Smith America Invents Act, USPTO Docket
No. PTO-P-2011-0073

Dear Under Secretary Kappos:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the "Section") to provide comments in response to the request of the United States Patent and Trademark Office ("the Office") published in the Federal Register on January 5, 2012 (PTO-P-2011-0073). In particular, the Section submits the following comments on the *Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act*, 77 Fed. Reg. 448 (the "Notice"). These comments have not been approved by the American Bar Association's House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

As the Office recognizes, the purpose of this provision of the Leahy-Smith America Invents Act is to "provide[] a mechanism for third parties to contribute to the quality of issued patents..." The Section fully agrees that the quality of examination benefits, and potentially erroneous grants may be avoided, when the examiner assigned to an application considers all relevant, non-cumulative prior art. This serves the public interest by potentially avoiding erroneous grants of patent

rights and reducing the need for more burdensome proceedings challenging such grant after a patent has issued.

The Office has proposed a gatekeeper function so that third party submissions that do not meet certain requirements are not entered into the file history and not presented to the examiner for consideration. This mechanism is “intend[ed] to protect applicants” from obtaining knowledge of non-compliant submissions so that such applicants will not then have a separate duty of disclosure for references contained in such non-compliant submissions. The Section is concerned, however, that at least some of the conditions required for entering a third party submission are unnecessary and overly strict application of the requirements may prevent an examiner from considering relevant, non-cumulative prior art.

Moreover, the proposed gatekeeper function will not fully “protect applicants” from obtaining knowledge of non-compliant submissions. As the Notice contemplates, even where a submission is entered, the examiner may elect not to consider some of the references “because the document was listed improperly, a copy of the document was not submitted, or a concise description was not provided for that document.” Similarly, a third party submitter may voluntarily elect to serve a copy on the applicant.

In the interest of getting relevant prior art before the examiner, the Section favors eliminating the proposed gatekeeper function and instead suggests that the Office rely upon self-policing until such time as the Office observes significant abuses of the procedures permitting third party submissions. Because the proposed rules require a statement that a third party “submission complies with the requirements of 35 U.S.C. §122(e) and [37 C.F.R. §1.290]” and because such statements are subject to 37 C.F.R. §11.18(b), the Section believes this self-policing mechanism is sufficient to discourage filings for any purpose other than to improve the quality of examination.

The Section looks forward to working with the Office as it continues to implement provisions of the Leahy-Smith America Invents Act. If you should have any questions or we can be of further assistance, please do not hesitate to contact us.

Sincerely,



Robert A. Armitage
Section Chairperson
American Bar Association
Section of Intellectual Property Law