

**From:** sarah smith [e-mail address redacted]

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**To:** preissuance\_submissions

**Subject:** Third Party Submission of Prior Art in a Patent Application (Response to Proposed Rules)

With respect to the proposed rules for submission of prior art in a patent application, I have the following comments:

1. The deadline for submission of prior art should be the issuance date of a notice of allowance. Third parties should not be artificially stopped from submitting prior art that they have just discovered (or against a patent application that they have just discovered), just because examination has commenced or six months has elapsed from publication. Examiners cite new art during examination frequently, and applicants cite new art frequently, especially when the results of foreign patent office searches and/or examinations are coming in. Examiners are thus already able to review newly cited prior art and issue another office action if it proves to be especially relevant. The need to issue valid patents, and the reality that third parties are not always immediately aware of their competitor's patent applications in my view should outweigh the desire to provide a deadline any earlier than the notice of allowance date.
2. Providing a fee exemption for submitting less than 3 documents could conceivably encourage certain people to maliciously submit documents to third party files that are not necessarily any more relevant to patentability than other documents already cited/provided. The fee of \$180 is moderate, and should not deter a serious person from submitting a document that is felt to be very relevant. The requirement to make a statement that the submission is the first and only submission in order to get the fee exemption does not make sense because of the chance that relevant documents could be discovered later. The commentary states that such subsequent submissions will be allowed to be filed, but is silent on whether a statement will have to be made that the documents were not known about previously. It would simplify things to remove the convoluted fee exemption completely. If a fee exemption is felt to be necessary, I would limit it to the first document only, and only to small entities.
3. With respect to EFS filing of such third party submissions, while the commentary notes that the EFS legal framework prohibits third parties from currently filing documents to a patent application, with the current software there is no technical means of preventing such submissions (and nor should there be, in case an attorney takes over prosecution and needs to quickly act in a representative capacity to meet a deadline in order to preserve an applicant's rights). Thus, at the moment there is nothing to stop a third party filing documents, and if they do so, it can be quite difficult to have those documents removed from the file wrapper (for example, if documents were submitted to the wrong application in error). Reliance on a legal prohibition, and assumption that the Office will follow up with some sort of disciplinary action if a third party files a document, will be difficult in practice, especially once third party filings become commonplace, as it will be onerous for the office to review every submission by a party who is not of record in an application. If it CAN be done, it will be done, and damage can be difficult to reverse. I do feel that EFS submission of prior art should be allowed and even encouraged, however, thought should be given to altering the EFS software so that the third party submissions do not go directly into the electronic file wrapper, but are reviewed for compliance with the rules first.
4. As a third party has no way of knowing when an office action on the merits is about to be issued, there is a chance that a submission could be made between the date on which the examiner completes the review of the application and the mailing of the office action. If changes to the EFS system are made to allow for proper electronic filing, thought should be given to providing a warning to the examiner if

the submission is made in the window between submission of an office action by the examiner, and the actual mailing date of the Office Action and/or warning the third party that the submission may be too late to be considered. Alternatively, or in addition, it would be helpful to make the "first action prediction" estimate of when the first office action is expected to be issued available in public PAIR, perhaps only after the 6 month window from publication has elapsed. However, if my point 1 above is taken (extending the deadline to the issuance of the notice of allowance), the likelihood of this happening would be greatly reduced.

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