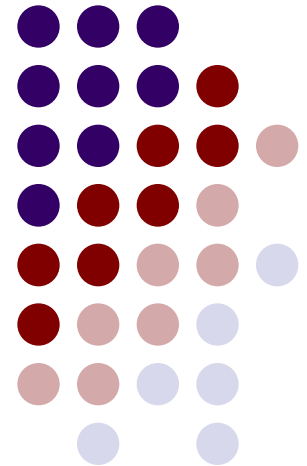




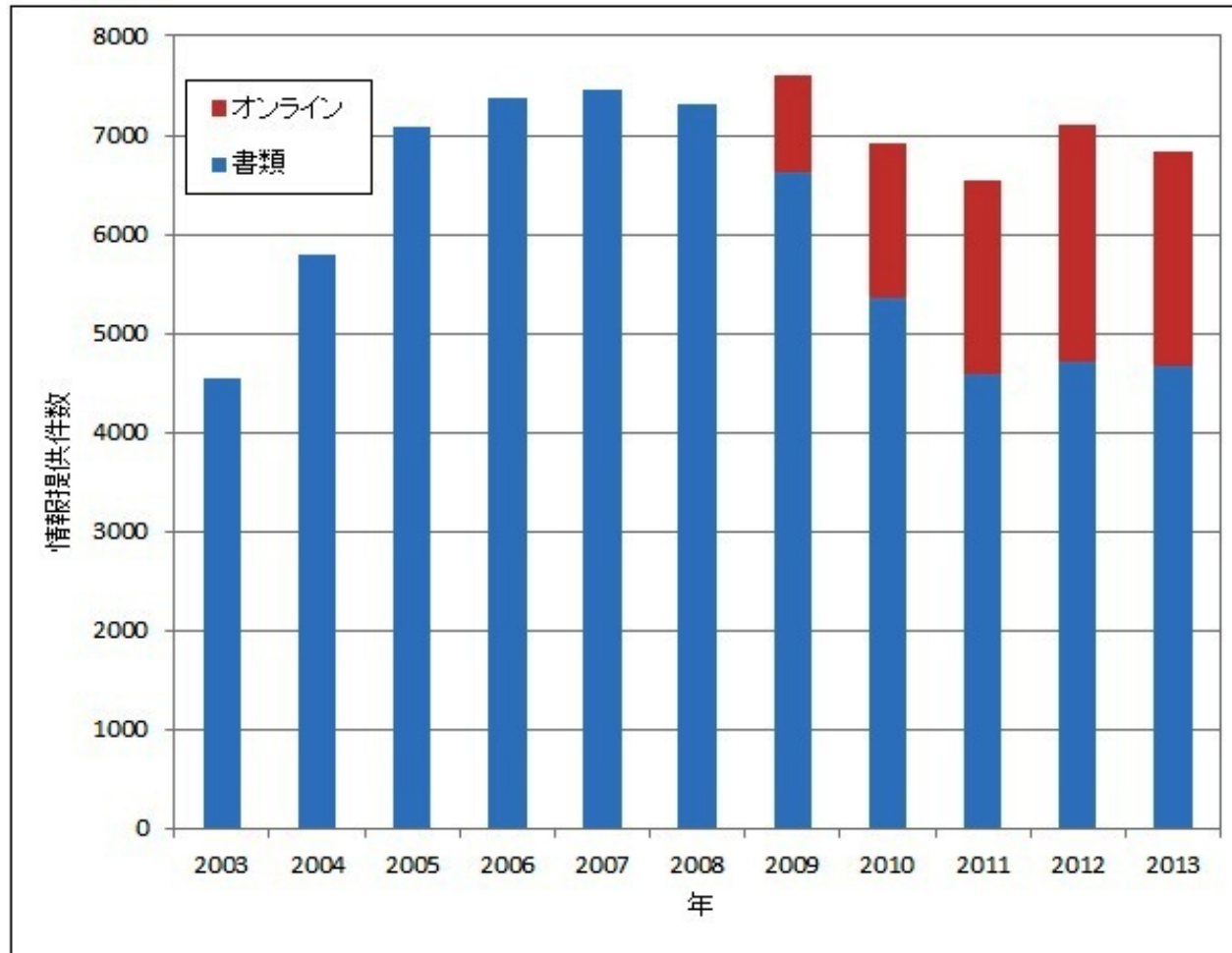
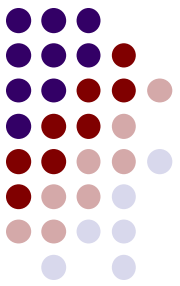
Birch
Stewart
Kolasch
Birch LLP

Preissuance Third Party Submission (TPS)

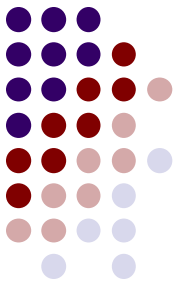
Toyohiko Konno
March 11, 2015



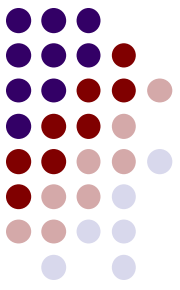
Number of 3rd Party Submission in Japan (JPO)



Third Party Submission (TPS) in Japan

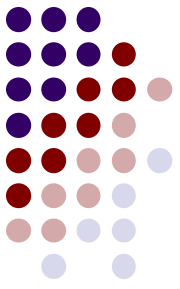


- In Japan, more than **6,000/year!!**
- Japanese companies like TPS (to JPO) because of legal and business reasons.
- e.g., Anonymously attaching before patented;
- inexpensive.



In USA, 35 USC § 122(e) (AIA)

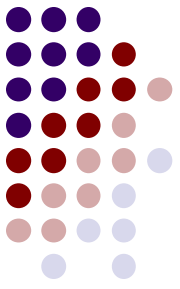
- **New § 122(e) PREISSUANCE SUBMISSIONS BY THIRD PARTIES.—**
 - (1) Any third party may submit: any patent, published patent application, or other printed publication
 - (A) Before the date a notice of allowance under section 151 is given or mailed in the application for patent; or
 - (B) the later of-(i) 6 months after the date of Publication or (ii) the date of the first rejection;
- a concise description of the asserted relevance of each submitted document.
- Fee: \$180 for every ten (10) documents.



When can you file TPS?

- (A) Before Notice of Allowance;
- (B) later of the later of (i) 6 months after the date of Publication or (ii) the date of the first rejection.

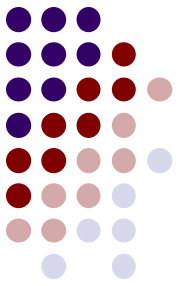
- → cannot file additional TPS after Applicant amends the claims in a response to the Office Action, unlike in Japan.



Who can file TPS?

- (1) Anyone (but applicant and ones having duty of disclosure).
- (2) Anonymous is OK. Real party is NOT necessary to identify.
- (3) But “/Anonymous/” or blank is not acceptable.
- (4) Need to identify person who actually file the 3rd party submission.

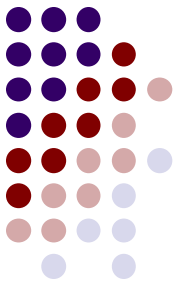
What can you submit? (evidence)



Printed Publication including:

- US/Non-US Patent, Published Patent Application,
- Non Patent Publication

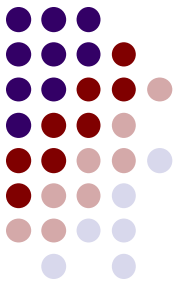
What can you submit? (evidence)



Non-Patent Publication includes:

- Office Actions;
 - Journal Articles;
 - Communications from foreign patent offices; court documents; and
 - Almost anything on Internet.
- (MPEP 1134.01 II 2 (c) and III)

What can you submit? (evidence)

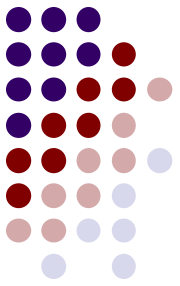


Non-Patent Publication DOES NOT include:

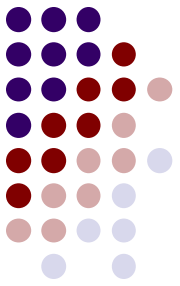
- materials that are subject to a court-imposed protective or secrecy order,
- trade secret information,
- unpublished internal documents of a corporation intended to be confidential,
- e-mail correspondence not widely disseminated to the public,

(MPEP 1134.01 III)

What can you submit? (evidence)

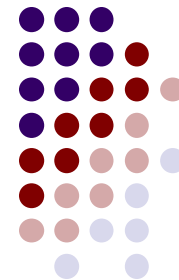


- Need Not be Prior Art (MPEP 1134.01 III B)
- You may submit a document published even after a filing date of a patent application, if it is relevant.



Items you must submit

- Document List (Form PTO/SB/429);
- Copy of Document;
- Concise description of the asserted relevance of each item identified in the document list.



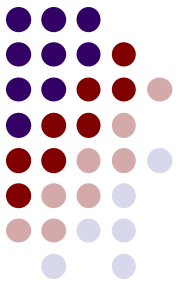
Document List (PTO/SB/429)

Doc Code: IDS.3P PTO/SB/429 (03-13)
 Document Description: Information Disclosure Statement Filed Approved for use through 07/31/2015. OMB 0651-0062
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
 Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number

THIRD-PARTY SUBMISSION UNDER 37 CFR 1.290 (Do not submit this form electronically via EFS-Web)	Application Number (required):
--	--------------------------------

U.S. PATENTS AND U.S. PATENT APPLICATION PUBLICATIONS			
Cite No.	Document Number	Issue Date or Publication Date	First Named Inventor
	Number-Kind Code ¹	MM/DD/YYYY	
	US-		
	US-		
	US-		
	US-		
	US-		
	US-		
	US-		
	US-		
	US-		
	US-		

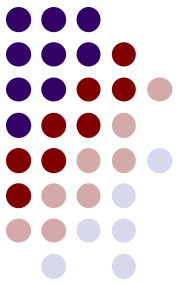
FOREIGN PATENTS AND PUBLISHED FOREIGN PATENT APPLICATIONS				
Cite No.	Country or Patent Office and Document Number	Publication Date	Applicant, Patentee or First Named Inventor	Translation Attached
	Country Code ² -Number ³ -Kind Code ⁴	MM/DD/YYYY		<input type="checkbox"/>
				<input type="checkbox"/>
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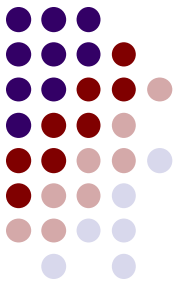
Copy of Document

- Copy (+ English Translation)
- Copy of US Patent and US Publication is not necessary to submit.

Copy of Document



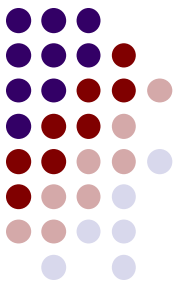
- If publication data is not clear from document, evidence (e.g., declaration) must be attached.
- E.g., a third party might submit a company's undated marketing brochure for consideration with a declaration from an employee of the company stating that the employee attended a trade show on a particular date and distributed copies of the brochure being submitted for consideration to trade show attendees. (MPEP 1134.01 III A)



Copy of Document

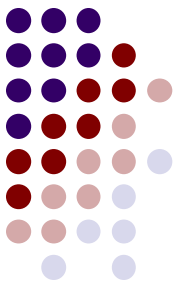
- When “publication” of document is not clear from the document,
- If the third party had e-mailed the company’s undated marketing brochure to the members of a trade organization without restriction, a copy of the e-mail might be submitted as evidence of publication.
- A third party might submit as evidence of publication a printout from a Web site showing that the content of the Web site was publicly available at least as of the date retrieved shown on the printout, or screenshots from a Web site that establish the content of the Web site on a particular date.

(MPEP 1134.01 III A)



Concise Description

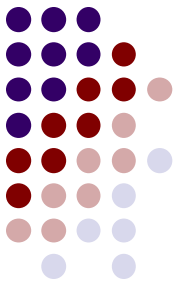
- **“*MUST*”** submit
- Bad Examples (too general) (MPEP 1134.01 II B 2):
 - “Document 1 is relevant;”
 - “Document 1 discloses/may disclose the invention;”
 - “Document 1 teaches the invention in Claim 1.”



Concise Description

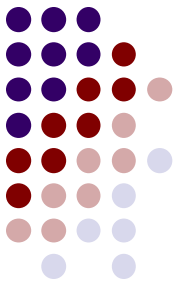
- Format: narrative or chart
- Concise description of relevance is limited to a factual description of a document's relevance. The concise description of relevance does not permit third parties to submit arguments against patentability or set forth conclusions regarding whether one or more claims are patentable.

Good Concise Description



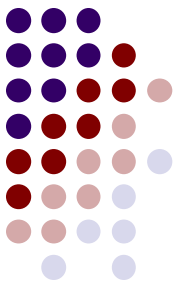
- “Claim 1 recites a refrigeration system comprising elements A, B, and C. Publication X discloses the refrigeration system recited in claim 1, except that the refrigeration system disclosed in publication X uses element D instead of element C. See Figure 1 on page 2 of publication X. Publication Y discloses the specific element C recited in claim 1, but not in the context of refrigeration systems. See pages 1-3 of publication Y. Publication Z teaches that element C is frequently used in refrigeration systems. See lines 2-10 on page 6 of publication Z.”

Bad Concise Description



- “Claim 1 recites a chemical composition comprising chemicals A, B, C, and D. Patent publication X teaches a chemical composition comprising chemicals A, B, C, and E. See claim 4 of patent publication X. Publication Y teaches chemical D and discusses why chemical D is an art-recognized equivalent of chemical E. See pages 3-4 of publication Y. **The composition of claim 1 is unpatentable in view of publication X and publication Y.**”

Good Concise Description



Claim 1

Publication X

Preamble

As discussed on page 1, publication X discloses a machine that performs the same function as the machine recited in claim 1. The machine set forth in publication X includes many of the same parts discussed in the specification of this application.

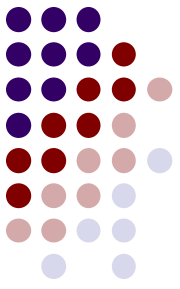
Element A

For example, in the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication X.

Element B

The first embodiment also includes element B of claim 1. See lines 1-3 on page 6 of publication X.

Bad Concise Description



Claim 1

Publication X

Preamble

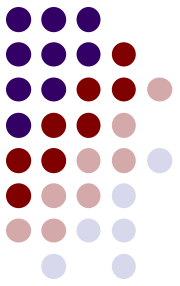
As discussed on page 1, publication X discloses a machine that performs the same function as the machine recited in claim 1. The machine set forth in publication X includes many of the same parts discussed in the specification of this application.

Element A

For example, in the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication X.

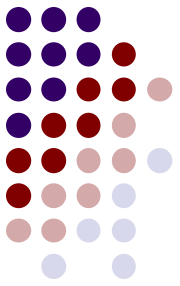
Element B

The first embodiment also includes element B of claim 1. See lines 1-3 on page 6 of publication X. **Thus, publication X anticipates claim 1 because it teaches all of the elements of claim 1.**



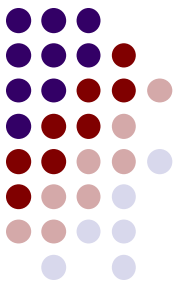
Fee

- \$ 180/10 documents
- First Submission with 3 or less Documents: Free.
- Small Entity Discount: Yes.
- Micro Entity Discount: NO.



Treatment of TPS

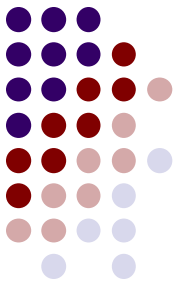
- Not automatically entered in a electronic file wrapper (IFW)
- Subjected to screening.
- Non-compliant TPS: discard
- Compliant TPS: entered to IFW.



Treatment of TPS

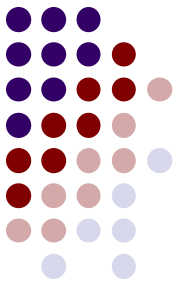
MPEP 1134.01 VI B sets forth:

- The examiner should consider the listed publications and accompanying concise descriptions in the third-party submission in the same manner as information in an information disclosure statement (IDS), ...
- During examination, the examiner should sign form PTO/SB/429 (or equivalent) in the same manner as an IDS to indicate all the items and their concise descriptions have been considered. ...



Treatment of TPS

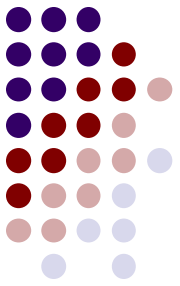
- Applicant need not respond to the third-party submission in the absence of a request by the Office (e.g. Examiner) to do so.



Miscellaneous

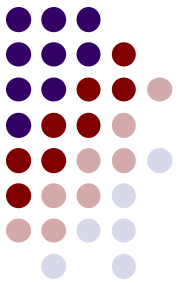
- Not required to serve the applicant with a copy of the third-party submission.

Statistics (as of Sep 26, 2014)

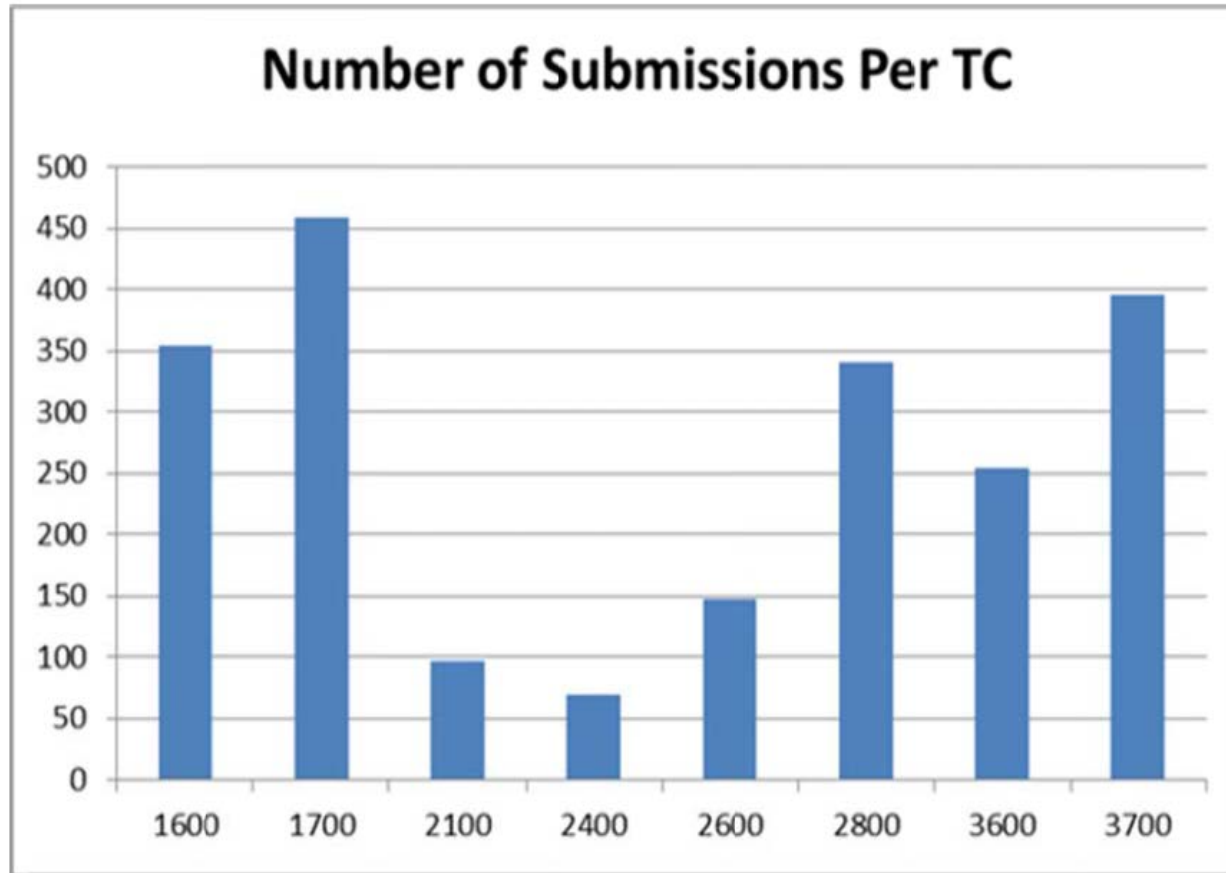


- Total Number: **2,116**

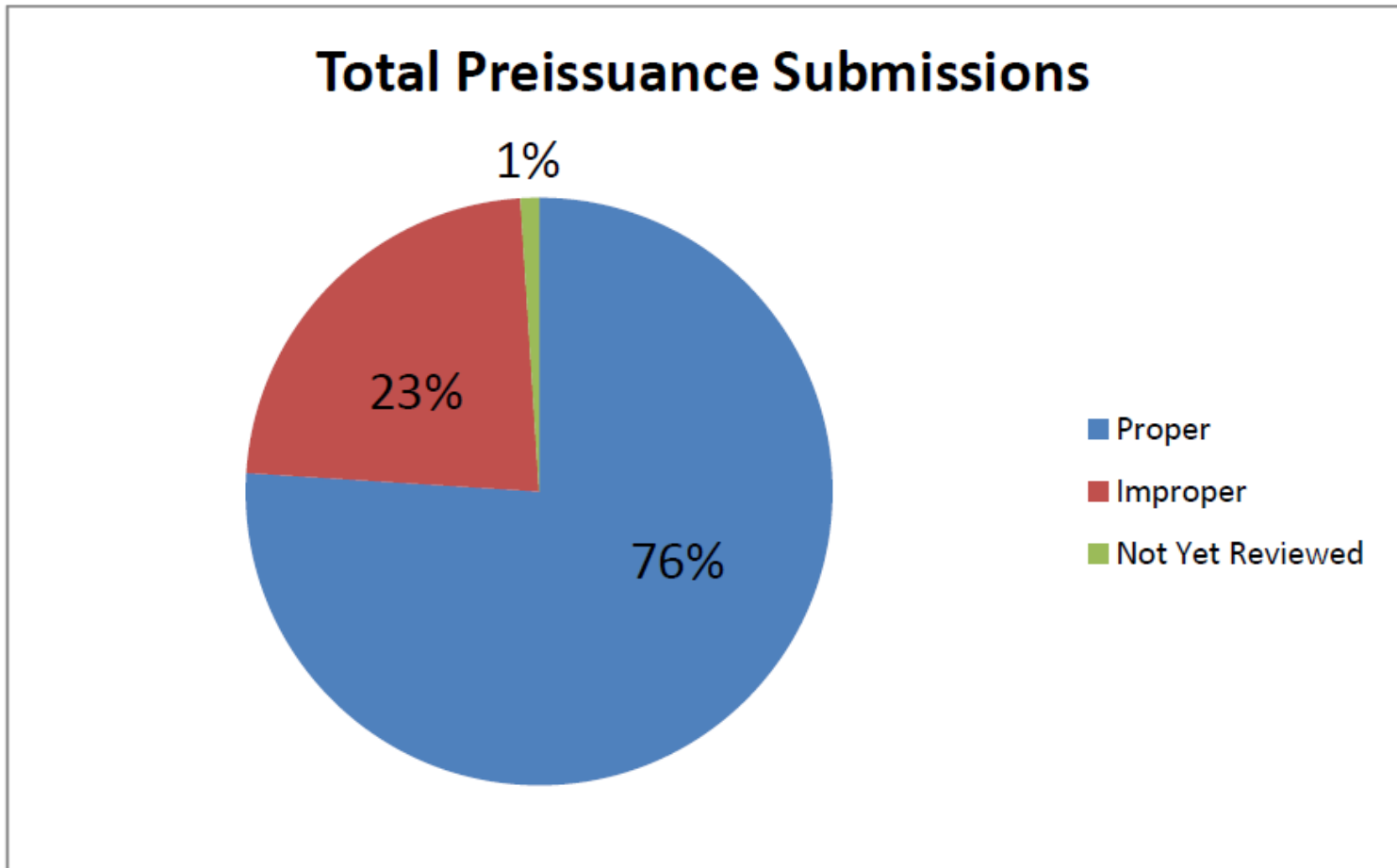
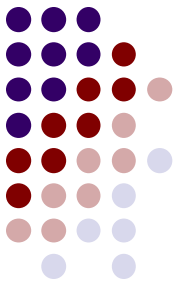
Statistics



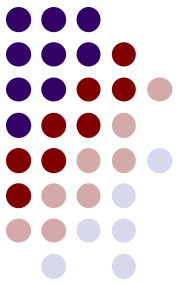
- 1600: bio, pharma
- 1700: chemical
- 2100-2800: electrical, computers
- 3600-3700: mechanical



Statistics



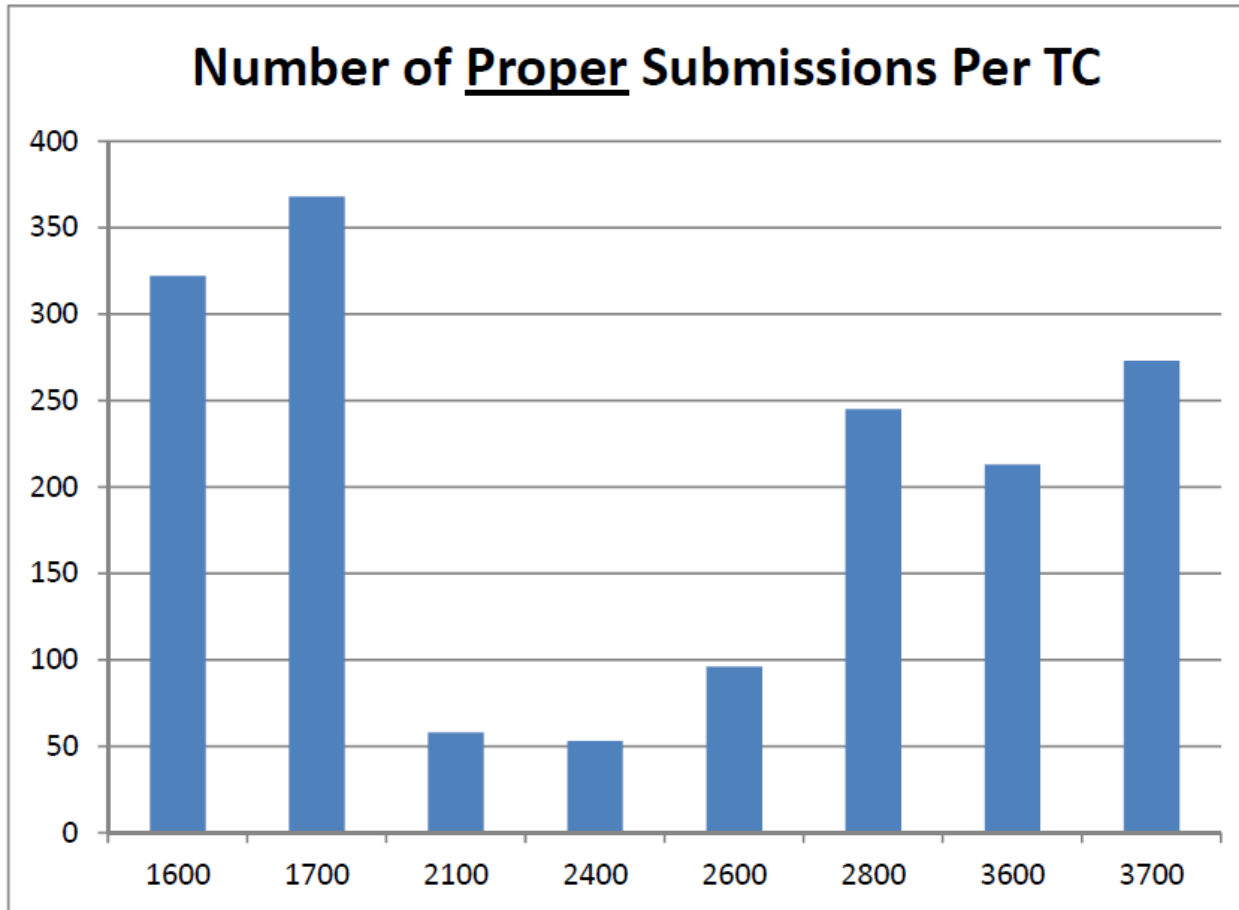
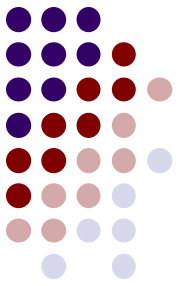
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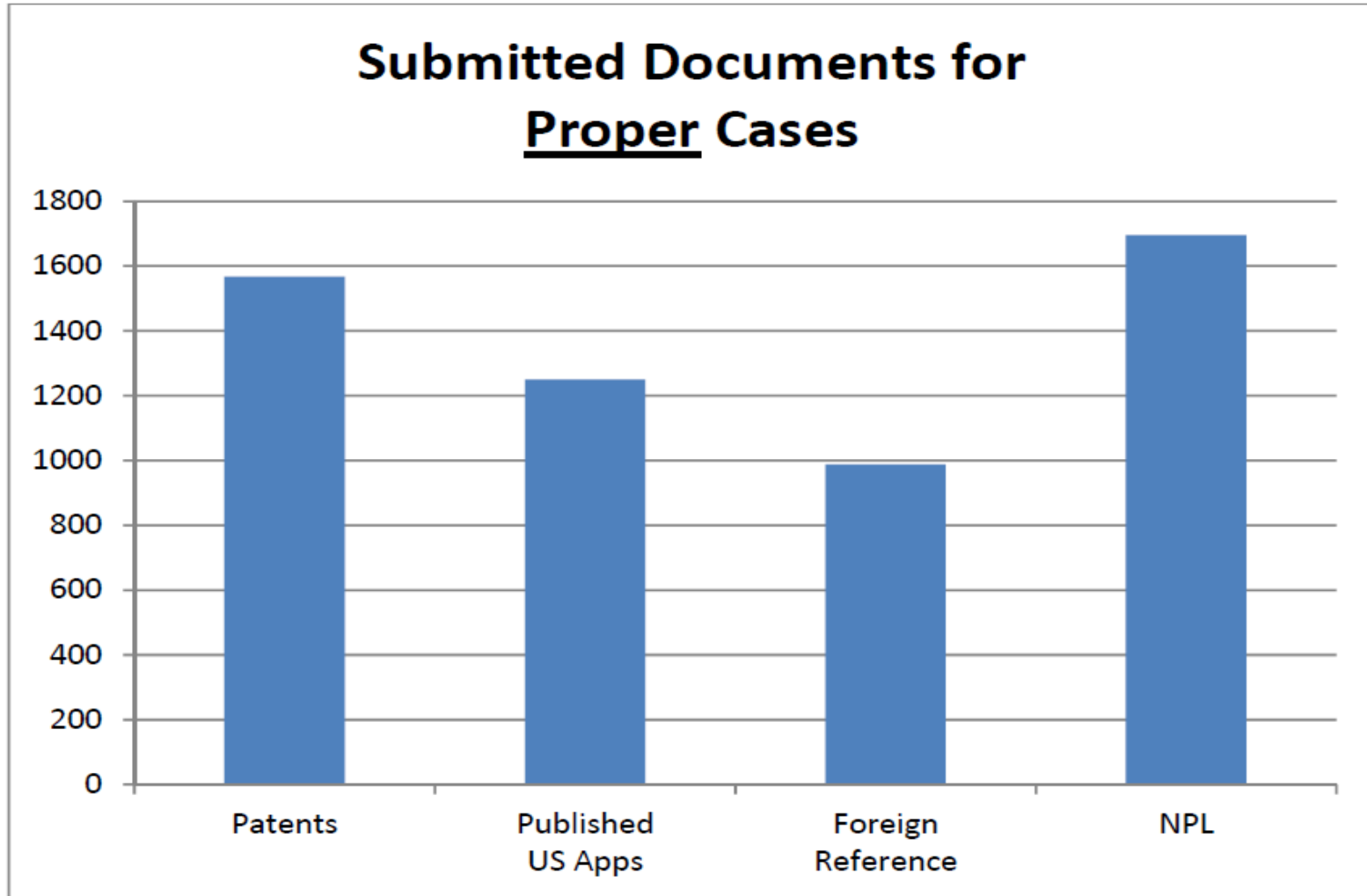
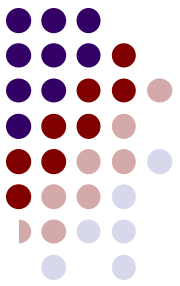
Top 3 of Reasons for Incompliance of TPS:

- Untimely;
- Improper Concise Description;
- Improper signature of submitter.

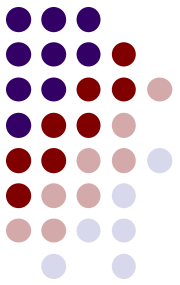
Statistics



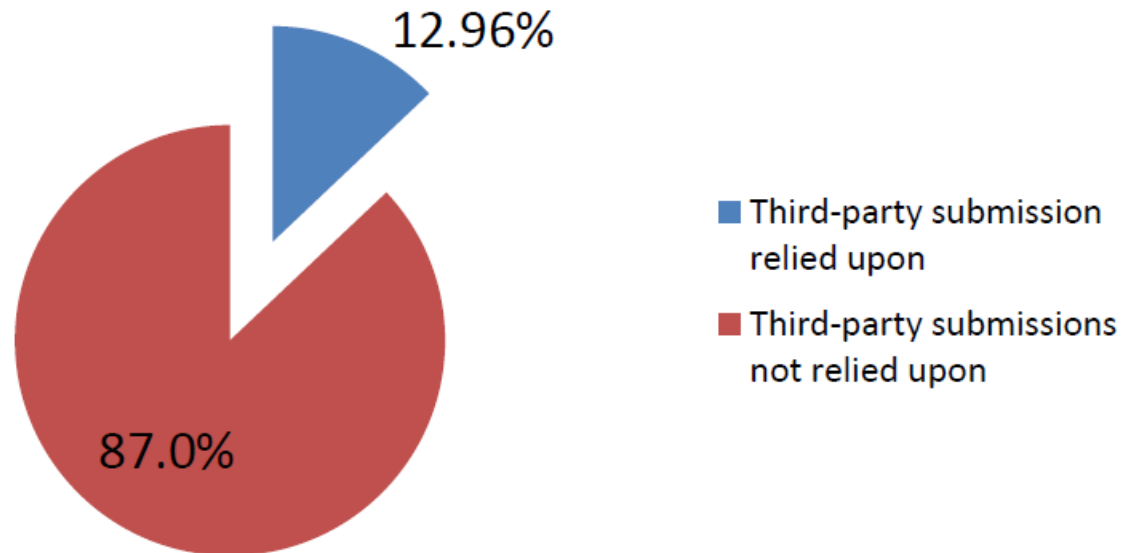
Statistics



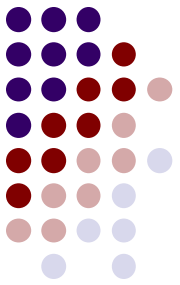
Statistics



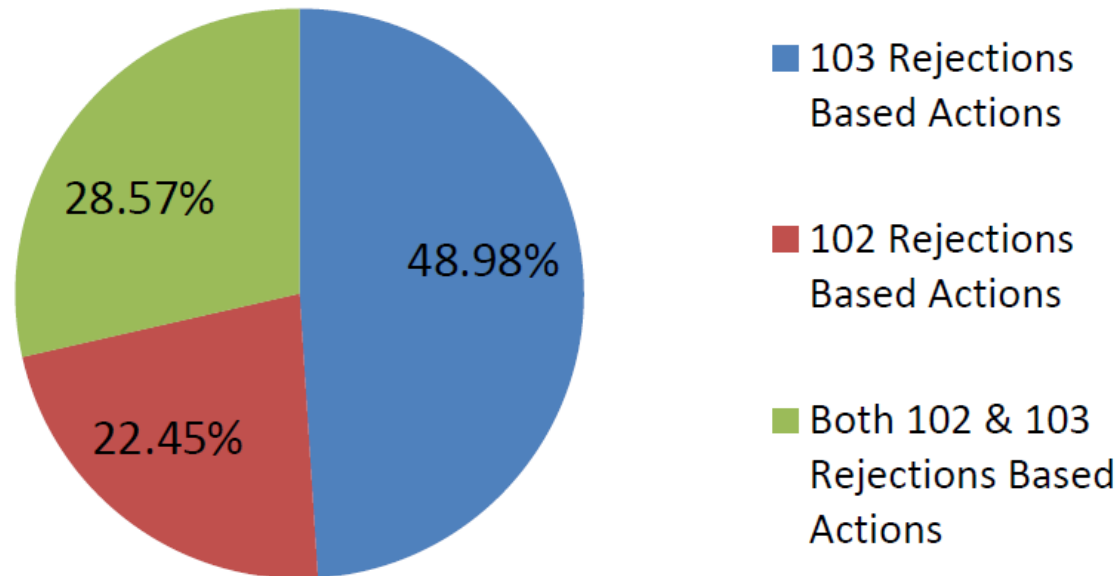
Applications w/ Office Actions after receipt of Proper Third-Party Submission



Statistics



**Applications having Rejections (by Statute)
& Using Third-Party Submissions**



Statistics

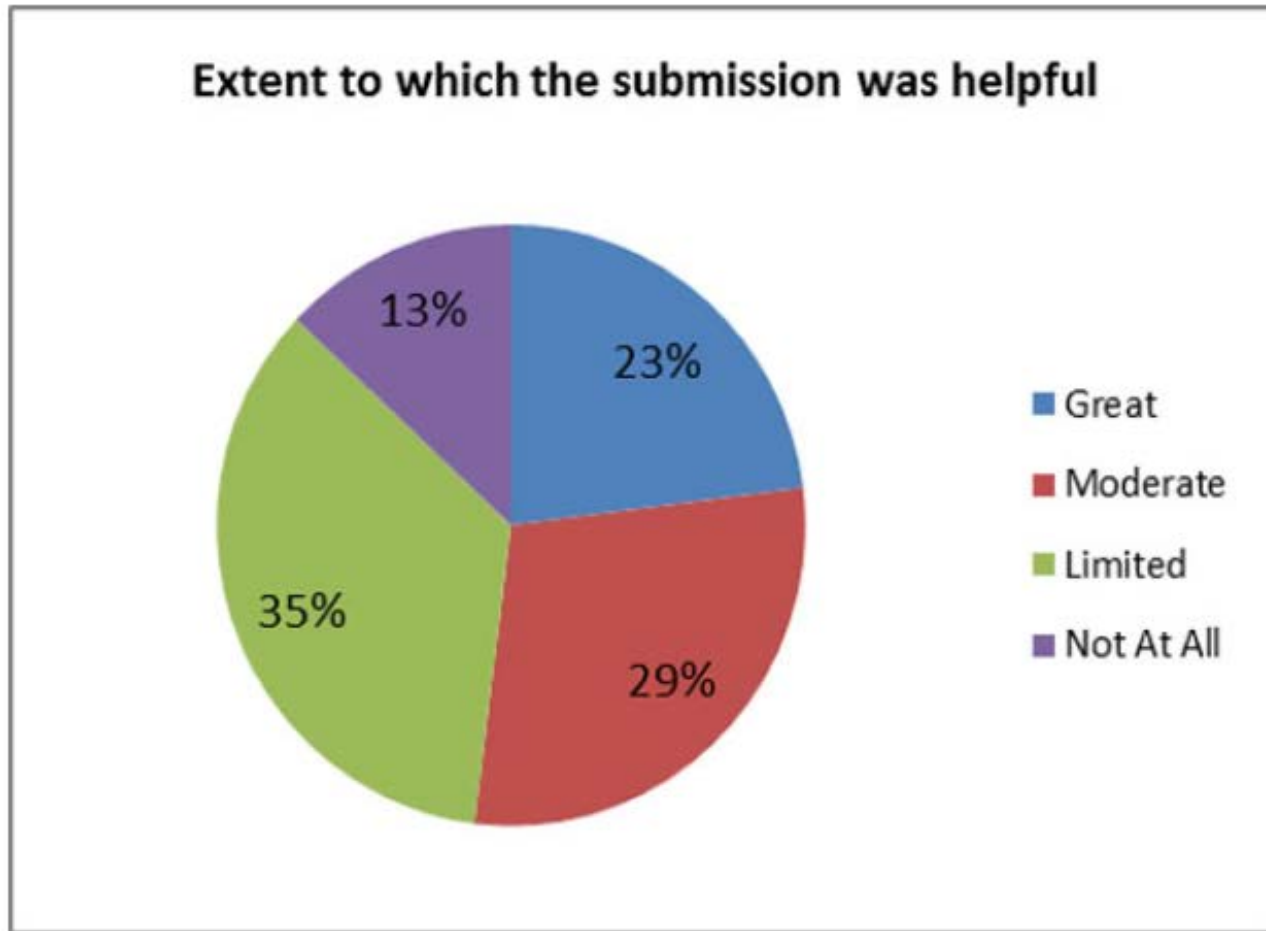
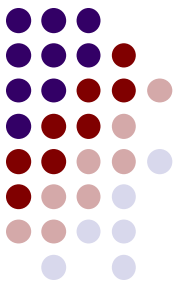


Figure 1: Extent to which the submission was helpful

Statistics

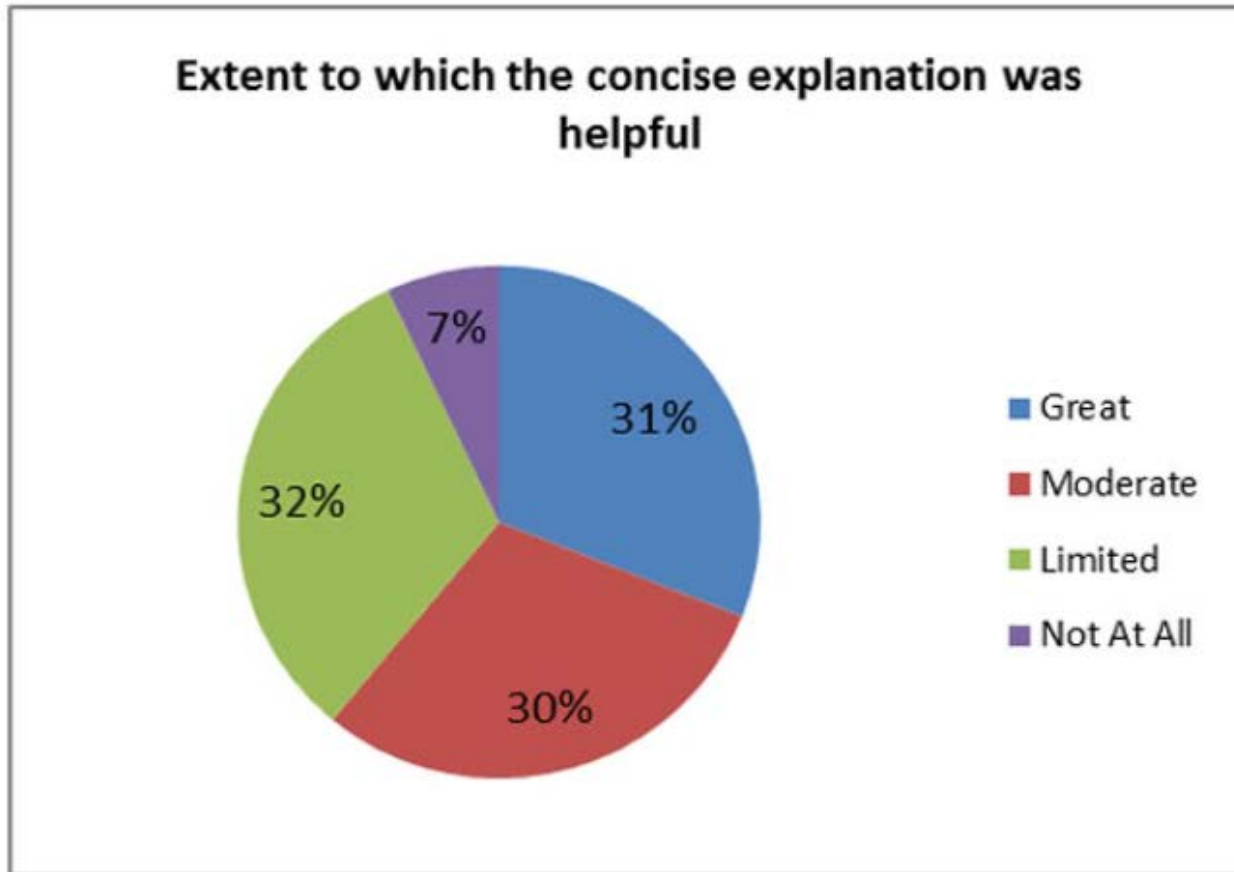
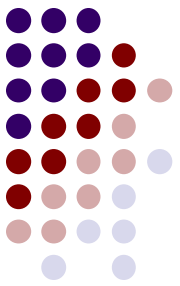
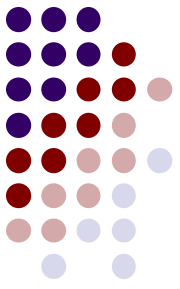


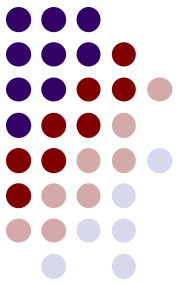
Figure 2: Extent to which the concise explanation was helpful



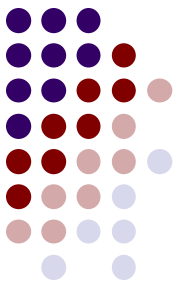
Statistics

- Only 13% of TPS is used for actual Office Action.
- But TPS is helpful to 50% of Examiners;
- Concise Description is helpful to 60% of Examiners.
- Good evidence & Excellent Concise Description → Better Chance.

Strategy



- IDS: Grade C is OK; relatively many references (to avoid inequitable conduct).
- TPS: Grade A or A+ (to help the Examiner to effectively do her or his job (prepare the Office Action)); relatively few documents (for anticipation or stronger *prima facie* case of obviousness) and easy-to-understand concise description.
- For example, better English translation (although MPEP says machine translation is acceptable).



To submit, or Not to submit?

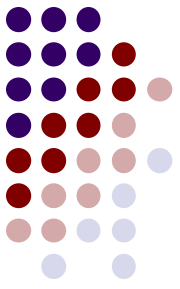
To Submit

Good:

- may anonymously prevent competitor's patent from being granted at lower cost (but no guarantee);
- for earlier business decision.

Bad:

- No estoppel, but may affect to subsequent Post Ground Procedure (IPR (*“reasonable likelihood that the petitioner would prevail”*); Post-Grant Review (*“more likely than not”*); Re-Exam (Substantial New Question of Patentability).



To submit, or Not to submit?

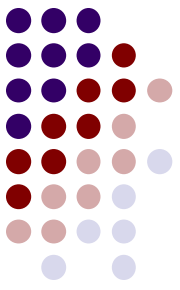
NOT to Submit

Good:

- Fully taking advantage of Post Ground Procedures and litigation (but expensive and still no guarantee to win);

Bad:

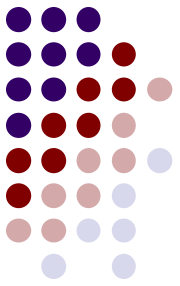
- more tangible risk (Application → Patent);
- Patentee may bother/harass your business (even if you believe it is invalid);
- still need preventive measures (e.g., opinion, negotiation).



To submit, or Not to submit?

- Consider from both legal and business viewpoints.
- What is important for your business (plan) now?
- What is important for your business in future?
- Who is Applicant? (nice guy? bad guy? elephant? ant? friend? natural enemy?)
- Weak evidence (strong patent)? Strong evidence (weak patent)? Different Kinds of Evidence?

Contact Information



- Toyohiko Konno: tk@bskb.com

Thank you!!