

UNITED STATES
PATENT AND TRADEMARK OFFICE



Preissuance Submissions By Third Parties

USPTO PUBLIC ENGAGEMENT
PARTNERSHIP MEETING SERIES

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UNITED STATES
PATENT AND TRADEMARK OFFICE ®

What is a third-party presissuance submission?

- A way for third parties to contribute to the quality of issued patents by submitting, for consideration in another party's patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application

Legal basis

35 U.S.C. 122 *Confidential status of applications; publication of patent applications.*

(e) PREISSUANCE SUBMISSIONS BY THIRD PARTIES.—

(1) IN GENERAL.—Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of—

(A) 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 on which the application for patent is first published under section 122 by the Office, or

(ii) the date of the first rejection under section 132 of any claim by the examiner during the examination of the application for patent.

(2) OTHER REQUIREMENTS.—Any submission under paragraph (1) shall—

(A) set forth a concise description of the asserted relevance of each submitted document;

(B) be accompanied by such fee as the Director may prescribe; and

(C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.

Where can I submit my information?

- In non-provisional utility, design, and plant applications
 - Can be pending or abandoned
 - Need not be published
- Not in provisional applications, issued patents, reissue applications, or reexamination proceedings

Who can file a third-party submission?

- Any member of the public (e.g., private persons and corporate entities)
- Not an individual who has a duty to disclose information with respect to the application (e.g., the applicant, inventor, attorney of record)
 - Individuals associated with the filing and prosecution of a patent application have a "duty to disclose to the Office" material information
- Does not need to be filed by a registered practitioner
- ❖ **TIP:** To remain anonymous, another party can file on the third party's behalf, but the submitter will need to be identified

When can I file a third-party submission?

- Submission *must be* timely
- Filed before the date a notice of allowance is mailed and before the later of:
 - The 6-month post-publication date; or
 - The date of first claim rejection
- ❖ **TIP:** A third-party submission cannot be filed in an application where a notice of allowance has been issued, regardless of whether that notice of allowance is subsequently withdrawn

How do I find timing information?

- Use Patent Center to search for the application

Search for a patent application

Search by application number, patent number, PCT number, publication number or international design registration number.

- Go to “Documents & Transactions”

The screenshot shows the Patent Center interface. On the left, a vertical menu contains the following items: 'Application Data', 'Documents & Transactions' (highlighted with a blue border), 'Continuity', 'Patent Term Adjustment', and 'Foreign Priority'. To the right, the main content area is titled 'Documents & transaction history' and contains two sub-sections: 'Documents' and 'Transactions'.

- ❖ **TIP:** To locate applications of interest, use the USPTO’s Patent Public Search tool (ppubs.uspto.gov/pubwebapp/static/pages/landing.html)

How do I find timing information? (cont.)

- Look for a notice of allowance

Application Data	Documents & transaction history				
Documents & Transactions	Documents Transactions				
Continuity	Showing 1 to 81 of 81 entries				
Patent Term Adjustment					
Foreign Priority					
Fee payment history					
Address & Attorney/Agent Information	Mail room date ↑ ↓	Doc code ↑ ↓	Doc description ↑ ↓	Pages ↑ ↓	
Supplemental Content	10/27/2021	ISSUE.NTF	Issue Notification	1	Preview
Assignments	10/13/2021	IFEE	Issue Fee Payment (PTO-85B)	1	Preview
Display References	10/13/2021	WFEE	Fee Worksheet (SB06)	2	Preview
	10/13/2021	N417	Electronic Filing System Acknowledgment Receipt	2	Preview
	09/07/2021	NOA	Notice of Allowance and Fees Due (PTOL-85)	7	Preview

- A third-party submission cannot be filed in an application where a notice of allowance has already been issued in the application

How do I find timing information? (cont.)

- Look for a first rejection of a claim

Application Data	Documents & transaction history				
Documents & Transactions	Documents Transactions				
Continuity	Showing 1 to 81 of 81 entries				
Patent Term Adjustment	Mail room date ↑ ↓	Doc code ↑ ↓	Doc description ↑ ↓	Pages ↑ ↓	
Foreign Priority	03/25/2021	CTNF	Non-Final Rejection	17	Preview
Fee payment history	03/25/2021	892	List of references cited by examiner	2	Preview
Address & Attorney/Agent Information					
Supplemental Content					
Assignments					
Display References					

- ❖ **TIP:** Not every office action will start the clock ticking. There are certain exceptions, such as if the office action does not include rejections of the patent application claims for lack of patentability.

How do I find timing information? (cont.)

- Look at the “Preview” of the office action to determine if the “Office Action Summary” identifies a rejection of the patent application claims for lack of patentability

Disposition of Claims*

- 5) Claim(s) 1-12 is/are pending in the application.
5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) Claim(s) ____ is/are allowed.
- 7) Claim(s) 1-12 is/are rejected.
- 8) Claim(s) ____ is/are objected to.
- 9) Claim(s) ____ are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.



- ❖ **TIP:** A “requirement for restriction” will not initiate the time period for making a submission (if two or more independent and distinct inventions are claimed in a single application, the examiner may require the applicant to designate a single invention to which the claims will be limited)

How do I find timing information? (cont.)

- Determine the 6-month post-publication date

Application Data	Documents & transaction history				
Documents & Transactions	Documents Transactions				
Continuity	Showing 1 to 81 of 81 entries				
Patent Term Adjustment					
Foreign Priority					
Fee payment history					
Address & Attorney/Agent Information					
Supplemental Content					
	Mail room ↑			Pages ↑	
	06/18/2020	NTC.PUB	Notice of Publication	1	Preview
	03/10/2020	WCLM	Claims Worksheet (PTO-2022)	1	Preview

Title: SAMPLE APPLICATION

Publication No US-2020-XXXXXXX-A1

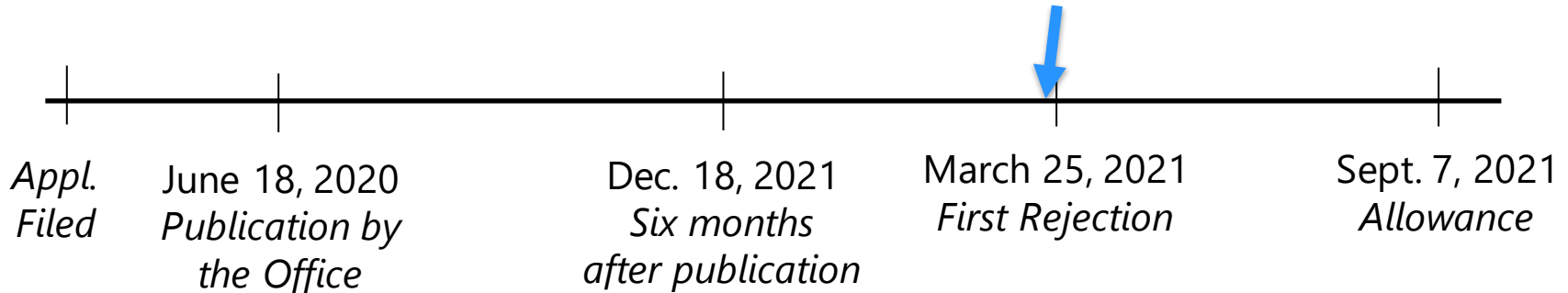
Publication Date: 06/18/2020

NOTICE OF PUBLICATION OF APPLICATION

The above-identified application will be electronically published as a patent application publication pursuant to 37 CFR 1.211, et seq. The patent application publication number and publication date are set forth above.

Timing example 1

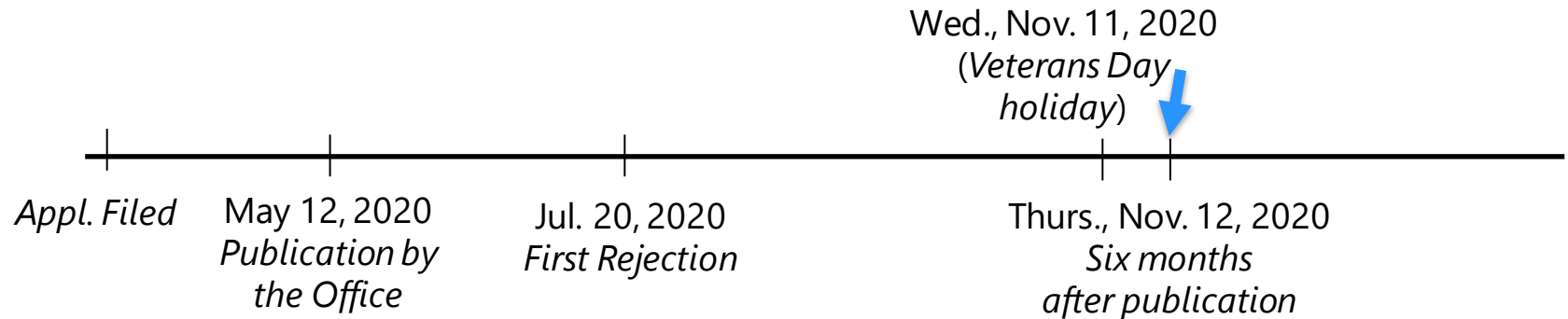
- Any third-party submission must have been filed on or before March 24, 2021



- ❖ **TIP:** If the filing deadline for an application is missed, track related applications, such as continuation applications. It might be possible to make a submission in a related application.

Timing example 2

- Because the last day for filing (Nov. 11, 2020) falls on a Federal holiday, any third-party submission must be filed on or before Nov. 12, 2020



- ❖ **TIP:** The “holiday/weekend rule” applies to a third-party submission. When the last day fixed by statute for filing a third-party submission falls on Saturday, Sunday, or on a Federal holiday, the third-party submission may be filed on the next succeeding **business day** which is not a Saturday, Sunday, or a Federal holiday.

How do I file a third-party submission?

- **Electronically**
 - Dedicated third-party preissuance submission Patent Center interface (“dedicated Patent Center interface”)
 - See link to “File a Third-Party Preissuance Submission” at www.uspto.gov/patent/initiatives/third-party-preissuance-submissions.html
 - Electronic submissions not made via the dedicated Patent Center interface are **prohibited**
- **In paper**
 - First-class United States Postal Service (USPS) mail
 - USPS Priority Mail Express®
 - Hand delivery to USPTO Customer Service Window (Knox Building, 501 Dulany Street, Alexandria, VA 22314)
 - Not by facsimile
- ❖ **TIP:** Filing via the dedicated Patent Center interface is the **most efficient**; entry of **paper filings will be delayed due to the additional processing required**

How do I file a third-party submission? (cont.)

- A third-party submission is filed on its date of receipt in the Office
 - Except for Priority Mail Express[®], which is filed on its *date of deposit* with the USPS
- ❖ **TIP:** File via USPS Priority Mail Express[®] service, hand delivery, or **preferably** via the dedicated Patent Center interface to ensure the submission is accorded a specific date of receipt

What must be included in a submission?

- 37 CFR 1.290 identifies the required content

37 C.F.R. 1.290 Submissions by third parties in applications.

- (c) Any third-party submission under this section must be made in writing.
 - (d) Any third-party submission under this section must include:
 - (1) A document list identifying the documents, or portions of documents, being submitted in accordance with paragraph (e) of this section;
 - (2) A concise description of the asserted relevance of each item identified in the document list;
 - (3) A legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications;
 - (4) An English language translation of any non-English language item identified in the document list; and
 - (5) A statement by the party making the submission that:
 - (i) The party is not an individual who has a duty to disclose information with respect to the application under § 1.56; and
 - (ii) The submission complies with the requirements of 35 U.S.C. 122(e) and this section.
- *****
- (f) Any third-party submission under this section must be accompanied by the fee set forth in § 1.17(o) for every ten items or fraction thereof identified in the document list.

Filing checklist

- Document list
- Copies (if required) and translations (if applicable)
- Concise description of relevance
- Statements
 - Compliance with statute and rule
 - Submitting party does not have a duty of disclosure
 - "First and only" submission (if fee exemption applies)
- Fee
 - Every 10 documents listed or fraction thereof
 - \$180 (undiscounted)
 - \$72 (small entity)
 - Note: a third party is not eligible for the micro entity discount
 - First submission of 3 or fewer total documents
 - No fee (with "first and only" statement)

Document list

- Must properly identify the documents being submitted
- List is automatically generated when filing electronically via the dedicated Patent Center interface
- When filing in paper can use form PTO/SB/429
 - Available at: www.uspto.gov/patents/apply/forms
- ❖ **TIP:** Using the dedicated Patent Center interface or form PTO/SB/429 helps ensure that important document listing requirements are not overlooked

Form PTO/SB/429

Doc Code: IDS.3P

Document Description: Information Disclosure Statement Filed

PTO/SB/429 (06-15)

Approved for use through 07/31/2018. 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

Application Number (required):

(Do **not** submit this form electronically via EFS-Web)

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-		

Document list (cont.)

- Types of documents that may be listed
 - U.S. patents and patent application publications
 - Foreign patents and published foreign patent applications
 - Non-patent documents that qualify as publications

Examples of non-patent publications: published articles, office actions issued in published U.S. patent applications, and communications from foreign patent offices issued in published foreign patent applications

Document list (cont.)

- Documents that do not qualify as publications must not be submitted

Examples of documents that do *not* qualify: 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, email correspondence not widely disseminated to the public

- A submission is required to be made in writing
- ❖ **TIP:** Published information, such as the visual output of a software program or a video, may be submitted only if **reduced to writing**, such as in the form of screen shots

Document list (cont.)

- U.S. patents/patent application publications must be identified by:
 - Patent number/patent application publication number
 - First named inventor
 - Issue date/publication date

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-		

- ❖ **TIP:** When using the dedicated Patent Center interface, the patent number or publication number entered will be validated against the USPTO database and the First Named Inventor and Issue Date/Publication Date fields will be **automatically filled in**

Document list (cont.)

- Foreign patent applications must be identified by:
 - Country or patent office that issued the patent or published the application
 - Applicant, patentee, or first named inventor
 - An appropriate document number
 - Publication date indicated on the patent or published application

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"/>

Document list (cont.)


- Non-patent publications must be identified by:
 - Author (if any)
 - Title
 - Page(s) being submitted
 - Publication date
 - Publisher (where available)
 - Place of publication (where available)

NON-PATENT PUBLICATIONS (e.g., journal article, Office action)			
Cite No.	Author (if any), title of the publication, page(s) being submitted, publication date, publisher (where available), and place of publication (where available)	Translation Attached	Evidence of Publication Attached
		<input type="checkbox"/>	<input type="checkbox"/>

Document list (cont.)

- Evidence of publication must be provided if the date of publication is not known
 - Use affidavits, declarations, or any other appropriate format
 - Affidavits/declarations must comply with the Office’s formal requirements
- Evidence of publication date is not counted toward the item count for fee purposes
 - Unless the evidence is in the form of a publication that itself is listed and submitted for consideration by the examiner


NON-PATENT PUBLICATIONS (e.g., journal article, Office action)			
Cite No.	Author (if any), title of the publication, page(s) being submitted, publication date, publisher (where available), and place of publication (where available)	Translation Attached	Evidence of Publication Attached
		<input type="checkbox"/>	<input type="checkbox"/>



Copies and translations

- Must submit a legible copy of each item identified in the document list
 - Other than U.S. patents and U.S. patent application publications
- Must submit an English language translation of any non-English language item identified in the document list

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"/>



- ❖ **TIP:** The dedicated Patent Center interface and form PTO/SB/429 provide a “Translation Attached” checkbox

Concise description of relevance

- Must be provided for each item identified in the document list
 - May be in the form of a narrative description or a claim chart
- Should set forth facts, explaining how an item listed is of potential relevance to the examination of the application in which the third-party submission has been filed
- ❖ **TIP:** State FACTS (e.g., document teaching) not LAW (i.e., avoid making legal conclusions of unpatentability such as anticipation, obviousness, and enablement, etc.)

Concise description of relevance (cont.)

- Provide more than a bare statement
- The following statements, presented alone, would not be considered anything more than bare statements of relevance that do not rise to the level of meaningful concise descriptions:

"Document 1 is relevant."

"See Document 1."

"Document 1 discloses/may disclose the invention."

"Document 1 teaches the invention in Claim 1."

- ❖ **TIP:** A document might be relevant as prior art (i.e., for purposes of prior art rejections), but need not be prior art (e.g., a post-filing document might provide evidence of non-enablement)

Concise description of relevance (cont.)

- Example of compliant concise description formatted as a narrative:

"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 page 4 of publication Y."

- ❖ **TIP:** Map document teachings to at least a portion of one claim. Point out the relevant document sections (e.g., "See document page 3, lines 1-10...") to draw the examiner's attention to the potential relevance of the document.

Concise description of relevance (cont.)

- Example of non-compliant concise description (the non-compliant portion is shown in bold):

*"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.**"*

Statements

- Must include the following statements:
 - The party making the submission is not an individual who has a duty to disclose information with respect to the application
 - In other words, the party is not an individual associated with the filing and prosecution of the patent application
 - Intended to avoid potential misuse by applicants
 - The submission complies with the requirements of 35 U.S.C. 122(e) and 37 CFR 1.290

STATEMENTS
The party making the submission is not an individual who has a duty to disclose information with respect to the above-identified application under 37 CFR 1.56.
This submission complies with the requirements of 35 U.S.C. 122(e) and 37 CFR 1.290.

- ❖ **TIP:** The dedicated Patent Center interface and form PTO/SB/429 provide the required statements to help facilitate compliance

Fees

- No fee is due (“fee exemption”) when a third-party submission listing three or fewer total items is the first submission by a third party (or a party in privity with the third party)
- “First and only” statement
 - Fee exemption-eligible submissions must be accompanied by a statement of the third party that to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only third-party submission in the application by the third party or a party in privity with the third party
- ❖ **TIP:** The dedicated Patent Center interface and form PTO/SB/429 provide the “first and only” statement for selection when appropriate

Fees (cont.)

- When the fee exemption does not apply, must pay a fee for every ten items or fraction thereof listed in the document list
 - Current undiscounted fee is \$180
 - Current small entity fee is \$72
 - The dedicated Patent Center interface and form PTO/SB/429 provide a "small entity" radio button/checkbox
 - A third party is not eligible for the micro entity discount
- ❖ **TIP:** Check the USPTO fee schedule for up-to-date fee information (www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule)

Fees (cont.)

- Resubmission after finding of non-compliance
 - After receiving a notification of non-compliance for a submission, the third party may make necessary revisions to its submission, limited to addressing the non-compliance, and resubmit the now corrected submission *provided the statutory time period for filing a third-party submission has not closed*
- The resubmission must be another **complete** submission; amendments to the non-compliant submission will not be accepted
- ❖ **TIP:** Filing via the dedicated Patent Center interface is the **most efficient** means of receiving a compliance determination and notification thereof; prompt notification may afford more time to make a resubmission within the statutory time period

Fees (cont.)

- Fee for resubmission
 - Where the proper fee accompanied a non-compliant submission, the submitter may request that the Office apply the previously-paid fee to a resubmission
 - Where a non-compliant submission of three or fewer documents was accompanied by the “first and only” statement, the submitter may state that the fee exemption applies to a resubmission

Fees (cont.)

- ❖ **TIP:** The “Statements” sections of the dedicated Patent Center interface and form PTO/SB/429 provide radio buttons/checkboxes to identify when a fee is due and entity status, when the fee exemption applies to the submission (“first and only” statement), or when no fee is due for a resubmission

Entity status

STATEMENTS

The party making the submission is not an individual who has a duty to disclose information with respect to the above-identified application under 37 CFR 1.56.

This submission complies with the requirements of 35 U.S.C. 122(e) and 37 CFR 1.290.

The following fee set forth in 37 CFR 1.290(f) is submitted herewith: regular undiscounted small entity*

The fee set forth in 37 CFR 1.290(f) is not required because this submission lists three or fewer total items and, to the knowledge of the person signing the statement after making reasonable inquiry, this submission is the first and only submission under 35 U.S.C. 122(e) filed in the above-identified application by the party making the submission or by a party in privity with the party.

This resubmission is being made responsive to a notification of non-compliance issued for an earlier filed third-party submission. The corrections in this resubmission are limited to addressing the non-compliance. As such, the party making this resubmission: (1) requests that the Office apply the previously-paid fee set forth in 37 CFR 1.290(f), or (2) states that no fee is required to accompany this resubmission as the undersigned is again making the fee exemption statement set forth in 37 CFR 1.290(g).

Fee is due →

“First and only” statement →

Resubmission →

Fees (cont.)

- When filing electronically via the dedicated Patent Center interface, payment may be made by:
 - Credit card
 - Electronic funds transfer
 - USPTO deposit account
 - Deposit accounts are pre-paid accounts that attorneys, agents, and the general public can establish to conveniently pay fees to the USPTO
 - Authorized users for a deposit account must be listed in the USPTO's Financial Manager online fee payment management tool as authorized fee payers; the party signing the third-party submission must be an authorized fee payer
- ❖ **TIP:** Include a deposit account authorization to charge fees relating to the third-party submission to a deposit account (containing sufficient funds) to cover situations where the fee was omitted or deficient

Fees (cont.)

- When filing in paper, payment may be made by:
 - Check or money order
 - Must be made payable to the “Director of the United States Patent and Trademark Office”
 - Credit card
 - Credit Card Payment Form (PTO-2038) is available at www.uspto.gov/patents/apply/forms for making payment by credit card for paper submissions
 - USPTO deposit account

Signature

- A third-party submission must be signed by the submitter
 - Due to signature requirement for papers filed in a patent application, and
 - Required statements by the party making the submission
- There is no requirement to identify a real party in interest
 - A real party in interest can remain anonymous by having someone else make the third-party submission for them, but the submitter cannot remain anonymous

Example of improper signature: /Anonymous/
Anonymous

Notification

- An applicant will be notified upon entry of a compliant submission in an application
- A third party may request a courtesy email notification regarding whether their third-party submission is found to be compliant or non-compliant
 - The notification to the third party will not be made of record in the application

From: Third Party Submission Initial Review <ThirdPartySubmissionInitialReview@USPTO.GOV>

Sent: June 10, 2024 2:00 PM

To: Submitter

Subject: Notice of Non-Compliant Third-Party Submission under 37 CFR 1.290

Notice of Non-Compliant Third-Party Submission under 37 CFR 1.290

Attached to this message is a form PTO-2305 "Notice of Non-Compliant Third-Party Submission under 37 CFR 1.290." The third-party submission filed in application xx/xxx,xxx on xxxx has been found non-compliant for the reason(s) indicated in the attached notice.


For questions regarding the attached notice please contact xxx.

PLEASE DO NOT REPLY TO THIS MESSAGE. This mailbox is not monitored for incoming mail.

❖ **TIP:** Check "spam"/"junk" folder for email notification from "ThirdPartySubmissionInitialReview@USPTO.GOV"

Notification (cont.)

- When filing in paper, include a separate paper titled "*Request For Notification Regarding Third-party Preissuance Submission*" indicating an email address to which the notification should be directed
- When filing electronically, select the appropriate check box and enter an email address to which the notification should be directed in the "*Request email notification*" section of the dedicated Patent Center interface



The screenshot shows a form titled "Request email notification" with a light blue background. It contains a checkbox and a text input field. The checkbox is currently unchecked. The text next to the checkbox reads: "I would like to receive an email indicating if the submission is found to be compliant or non-compliant. This information will not be part of the record in the application." Below this is a label "Email address" followed by a text input field.

- ❖ **TIP:** Requesting notification may provide an opportunity to correct any curable deficiencies via a resubmission if time remains within the statutory time period

Notification (cont.)

Notice of Non-Compliant Third-Party Submission under 37 CFR 1.290	Application No. Sample
<p>The Third-Party Submission filed on is non-compliant because it has failed to meet the requirements of 35 U.S.C. § 122(e) and/or 37 CFR 1.290. See <i>Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act</i>, 77 Fed. Reg. 42150 (July 17, 2012). Neither this notification nor the non-compliant third-party submission will be made of record in the application.</p> <p>This notice was sent from an unmonitored mailbox. <u>Do NOT respond to this e-mail address.</u></p>	

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE THIRD-PARTY SUBMISSION TO BE NON-COMPLIANT:

1. The third-party submission is not timely.
2. The document list does not comply with the requirements of § 1.290(e).
3. The concise description of relevance is missing or is improper.
4. A legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications, is missing.
5. An English language translation of a non-English language item identified in the document list is missing.
6. The statement(s) required under § 1.290(d)(5)(i) and/or (ii) is/are missing.
7. The required fee under § 1.290(f) is deficient or missing.
8. An item in the document list is not a publication.
9. The submission is improperly signed or not signed.
10. Other (including any explanation in support of the above items):

What happens after filing a submission?

- Third-party submissions will not be automatically entered into the electronic image file wrapper (IFW) of an application
 - Submissions will be reviewed by the Office to determine compliance with 35 U.S.C. 122(e) and 37 CFR 1.290 before being entered into the IFW
- Non-compliant third-party submissions will not be entered into the IFW of an application or considered, and will be discarded
 - The Office will not refund the required fees in the event a third-party submission is determined to be non-compliant

What happens after filing a submission? (cont.)

Application Data	Documents & transaction history																																							
Documents & Transactions	<div style="display: flex; justify-content: space-between; border-bottom: 1px solid #ccc; padding-bottom: 5px;"> Documents Transactions </div>																																							
Continuity	Showing 1 to 81 of 81 entries																																							
Patent Term Adjustment	<table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th style="width: 15%;">Mail room date</th> <th style="width: 10%;">Doc code</th> <th style="width: 55%;">Doc description</th> <th style="width: 10%;">Pages</th> <th style="width: 10%;"></th> </tr> </thead> <tbody> <tr> <td>11/10/2020</td> <td>3PTRANS.FOR</td> <td>Translation of Foreign Patent Document</td> <td>28</td> <td>Preview</td> </tr> <tr> <td>11/10/2020</td> <td>3P.RELEVANCE</td> <td>Concise Description of Relevance</td> <td>15</td> <td>Preview</td> </tr> <tr> <td>11/10/2020</td> <td>3P.RELEVANCE</td> <td>Concise Description of Relevance</td> <td>3</td> <td>Preview</td> </tr> <tr> <td>11/10/2020</td> <td>IDS.3P</td> <td>Third-Party Submission Under 37 CFR 1.290</td> <td>3</td> <td>Preview</td> </tr> <tr> <td>11/10/2020</td> <td>WFEE</td> <td>Fee Worksheet (SB06)</td> <td>2</td> <td>Preview</td> </tr> <tr> <td>11/10/2020</td> <td>N417</td> <td>Electronic Filing System Acknowledgment Receipt</td> <td>3</td> <td>Preview</td> </tr> </tbody> </table>					Mail room date	Doc code	Doc description	Pages		11/10/2020	3PTRANS.FOR	Translation of Foreign Patent Document	28	Preview	11/10/2020	3P.RELEVANCE	Concise Description of Relevance	15	Preview	11/10/2020	3P.RELEVANCE	Concise Description of Relevance	3	Preview	11/10/2020	IDS.3P	Third-Party Submission Under 37 CFR 1.290	3	Preview	11/10/2020	WFEE	Fee Worksheet (SB06)	2	Preview	11/10/2020	N417	Electronic Filing System Acknowledgment Receipt	3	Preview
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Foreign Priority																																								
Fee payment history																																								
Address & Attorney/Agent Information																																								
Supplemental Content																																								
Assignments																																								
Display References																																								

What happens after filing a submission? (cont.)

- The statutory time period for making a third-party submission will not be tolled by an initial non-compliant submission
 - The Office will not set a time period to file a corrected third-party submission
- A third party who previously filed a non-compliant submission may file another complete submission, provided the statutory time period for filing a submission has not closed

What will the examiner do with my submission?

- The listed publications and accompanying concise descriptions will be considered by the examiner in the same manner as information submitted by an applicant
- A copy of the document list, indicating examiner consideration, will be provided to the applicant with the next office action
 - Examiner is not required to comment on the submitted documents or concise descriptions, but is instructed to apply the information as deemed necessary (i.e., in a rejection of a claim)
 - Considered documents will be printed on the patent
 - Consideration does not equate to agreement with third party

What will the examiner do with my submission? (cont.)

- Third party: no response from a third party with respect to an examiner's treatment of the third-party submission will be permitted or considered
- Applicant: need not reply to submission unless requested by the Office

Resources

- Manual of Patent Examining Procedure (MPEP) § 1134.01:
www.uspto.gov/web/offices/pac/mpep/index.html
- Third-Party Preissuance Submissions microsite:
www.uspto.gov/patents/initiatives/preissuance-submissions/resources
- Patent Center
 - “File Online”: www.uspto.gov/patents/apply
 - “Getting Started-new users”: www.uspto.gov/patents/apply/applying-online/getting-started-new-users
- Patent Public Search tool (to identify applications of interest):
ppubs.uspto.gov/pubwebapp/static/pages/landing.html
- Deposit account information: www.uspto.gov/learning-and-resources/fees-and-payment/deposit-account-rules-and-information

Useful USPTO contacts

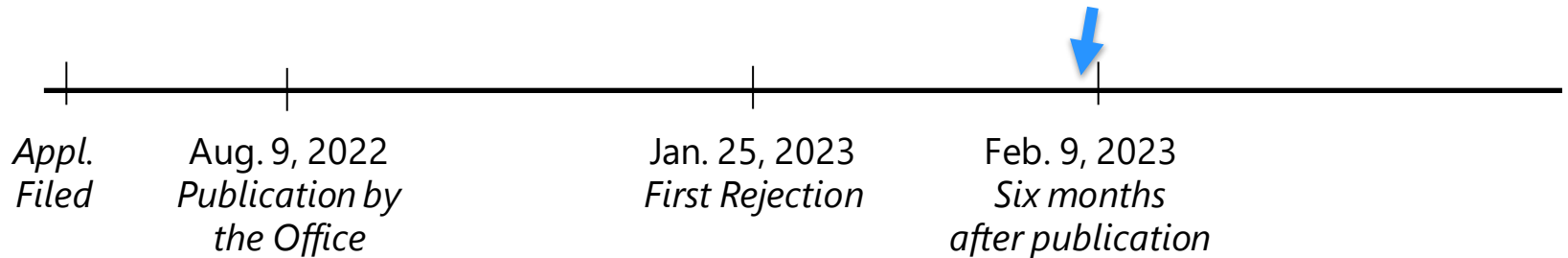
- Patent Electronic Business Center (for electronic filing): 571-272-4100
- Office of Patent Legal Administration: 571-272-7704 or PatentPractice@uspto.gov
- Receipts Accounting Division (fee payment and deposit account information): 571-272-6500
- Contact information for other USPTO offices and business centers: www.uspto.gov/about-us/contact-us

Examples appendix

Examples – timing

- File submission prior to, not on, the statutory timing dates

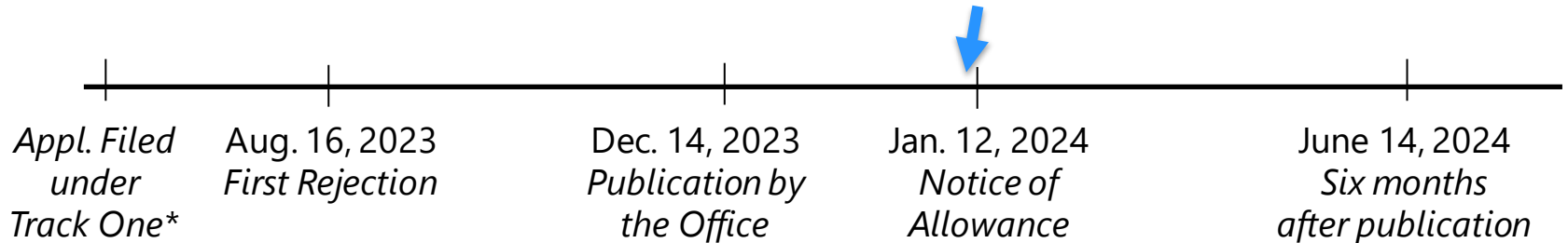
Timing example 1: third-party submission must be filed on or before Feb. 8, 2023



Examples – timing (cont.)

- A third-party submission cannot be filed in an application where a notice of allowance has been issued in the application

Timing example 2: third-party submission must be filed on or before Jan. 11, 2024



* USPTO Track One prioritized examination provides for a final disposition within about twelve months

Examples – concise description of relevance

- Example of compliant concise description formatted as a claim chart for a claim having only two elements:

Claim 1	Publication X	Publication Y
Preamble	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.	Publication Y discloses a machine that performs the same function as the machine recited in claim 1.
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		Publication Y teaches a machine having element B of claim 1. See lines 1-3 on page 6 of publication Y. Publication Y teaches the benefits of using element B in this type of a machine.

Examples – concise description of relevance

- Example of non-compliant concise description formatted as a claim chart for a claim having only two elements (non-compliant portion is shown in bold):

Claim 1	Publication X	Publication Y
Preamble	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.	Publication Y discloses a machine that performs the same function as the machine recited in claim 1.
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		Publication Y teaches a machine having element B of claim 1. See lines 1-3 on page 6 of publication Y. Publication Y teaches the benefits of using element B in this type of a machine. Accordingly, claim 1 is unpatentable in view of the combination of publication X and publication Y.

Examples – fees*

- **Fee example 1:** A *first* third-party submission in an application contains 3 or fewer total items and is accompanied by the “first and only” statement
 - No fee would be required
- **Fee example 2:** A *first* third-party submission in an application contains 3 or fewer total items and is not accompanied by the “first and only” statement
 - A \$180/\$72 fee would be required
 - Third parties are not required to avail themselves of the fee exemption
 - Thus, a third party can make a first submission of 3 or fewer documents in an application and choose to pay the fee instead of making the “first and only” statement (e.g., where a third party is uncertain whether it is in “privity” with another third party that already made a submission)

* The current regular undiscounted and small entity fees are \$180 and \$72

Examples – fees (cont.)*

- **Fee example 3:** A *first* third-party submission in an application contains more than 3, but 10 or fewer total items
 - A \$180/\$72 fee would be required
- **Fee example 4:** A *first* third-party submission in an application contains more than 10, but 20 or fewer total items
 - A \$360/\$144 fee would be required
 - For example, where the first submission contains 12 documents and the third party does not qualify for the small entity discount, a fee of \$180 would be required for the first 10 documents and a fee of \$180 would be required for the remaining 2 documents, for a total fee of \$360

* The current regular undiscounted and small entity fees are \$180 and \$72

Examples – fees (cont.)*

- **Fee example 5:** *A second or subsequent* third-party submission in an application contains 3 or fewer total items
 - A \$180/\$72 fee would be required
 - The “first and only” statement does not apply to a second or subsequent submission by a third party
- **Fee example 6:** *A second or subsequent* third-party submission in an application contains more than 10, but 20 or fewer total items
 - A \$360/\$144 fee would be required

* The current regular undiscounted and small entity fees are \$180 and \$72

Examples – listing

- For publications obtained from the Internet, the uniform resource locator (URL) of the Web page that is the source of the publication must be provided for the place of publication (e.g., "www.uspto.gov")

Listing example 1: Archived Internet publication

"Hand Tools," Web page <<http://www.farmshopstore.com/handtools.html>>, 1 page, August 18, 2009, retrieved from Internet Archive Wayback Machine <<http://wayback.archive.org/web>> on December 20, 2012

- For an Internet publication obtained from a website that archives Web pages, both the URL of the archived Web page submitted for consideration and the URL of the website from which the archived copy of the Web page was obtained should be provided on the document listing

Examples – listing (cont.)

- Videos obtained from websites, such as YouTube, may be submitted only if reduced to writing in the form of screen shots
 - Include black and white screen shots of the pertinent portions of the video
 - Provide the URL of the Web site from which the video was obtained on the document listing

Listing example 2: Videos obtained from websites

Screen captures from YouTube video clip entitled "Widget Video Demonstration," 6 pages, uploaded on March 17, 2014 by user "jdoe1" at <http://www.youtube.com/widgetdemo>

- Other dates that could be provided for date of publication include the date the video was accessed by the submitter, or a date obtained from a website that archives Web pages, such as Internet Archive Wayback Machine, from which an archived copy of the website that contains the video was retrieved

