

**From:** Sundby, Suzannah [e-mail address redacted]  
**Sent:** Sunday, March 04, 2012 6:27 PM  
**To:** preissuance\_submissions  
**Subject:** Third Party Submission of Prior Art in a Patent Application (Response to Proposed Rules)

ATTN: Nicole D. Haines  
Legal Advisor  
Office of Patent Legal Administration  
Office of the Associate Commissioner for Patent Examination Policy

Dear Ms. Haines:

1. Proposed Sec.1.290(d)(2) and Sec. 1.291(c)(2) require a concise description of the asserted relevance of each listed document. Although the supplementary comments to the proposed rules indicate that the USPTO does not propose to evaluate the sufficiency of the concise description other than determining whether such a concise description has been submitted and whether it is not merely a bare statement that does not amount to a meaningful concise description, the USPTO then attempts to explain what a concise description is and that one should refrain from submitting a verbose description of relevance. As the concise description is a requirement and failure to comply with such will result in the third party submission or protest not being entered in the record, I respectfully request more guidance and examples as to what the USPTO interprets as being a concise description and what the USPTO would consider to be too verbose and/or non-compliant. Such guidance should also take into account that certain technologies and legal issues may require a more detailed explanation in order for the examiner to fully appreciate the significance of the submission. Further, I recommend procedures for notifying a third party submitter of a non-compliant concise description and procedures for curing such a defect.

2. The USPTO proposes to remove Sec. 1.99 which allows a third party to submit patents, published patent applications, or printed publications without comment. I recommend that Sec. 1.99 remain as one may desire to make such a submission without comment and requiring one to provide a concise description (by making Sec.1.290(d)(2) and Sec. 1.291(c)(2) the only procedures for third party submissions) may inhibit one from making such a submission. Therefore, keeping Sec. 1.99 would help ensure that the examiner is aware of and considers art which the public deems to be relevant and thereby improve patent quality. I also recommend that the time for making such a submission under Sec. 1.99 be amended to be the same as that for proposed Sec. 1.290. Finally, with regard to the failure to submit a concise description under Sec.1.290(d)(2) and Sec. 1.291(c)(2), I recommend considering a rule where the failure to provide a concise description in a submission under Sec.1.290 or Sec. 1.291 automatically defaults the submission to one under Sec. 1.99.

3. The USPTO does not propose to notify an applicant that there has been a third party submission until the examiner issues an office action. I recommend that the USPTO implements procedures for notifying an applicant of such a submission as it may increase patent quality, examination and application pendency. In particular, an

applicant may decide to submit claim amendments and/or remarks prior to an office action in order to compact prosecution.

4. The document listing requirements for proposed Sec.1.290 are quite specific and proposed Sec. 1.290(a) states that a "third-party submission in an application will not be entered or considered by the Office if the submission is not in compliance with 35 U.S.C. 122(e) and this section". If a submission is non-compliant, no refund is provided and no notice of non-compliance is sent to the submitter. Thus, it is respectfully requested that the USPTO provides guidance as to what types of mistakes would still result in a compliant submission, e.g. a typographical error in the patent number of a listed patent, incorrectly providing the first inventor's name, or issue date, if the correct information may be readily determined by the concise description, or by the patent itself (in the case where the patent number is correct, but the inventor's name or issue date is wrong). In addition, I recommend partial acceptance of a third party submission if the defect cannot be cured. For example, if the non-compliance relates to only one of the submitted documents, I recommend redacting the non-compliant parts of the submission such that the other documents and their concise descriptions may be entered and then considered by the examiner so long as the process does not cause any undue delay in the examination of the application.

Thank you for this opportunity to comment on the proposed third party submission rules.

Best regards,  
Suzannah K. Sundby, Esq.  
Reg. No. 43,172

*The views expressed herein are mine and are not to be attributed to any other person or entity including Smith, Gambrell & Russell, LLP or any client of the firm.*

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