

Proposed Amended USPTO Rule for Post-Grant Third-Party Submissions

§ 1.501 Citation of prior art **and written statements** in patent files.

(a) Information content of submission: At any time during the period of enforceability of a patent, any person may file a written submission with the Office under this section, which is directed to the following information:

(1) ~~cite, to the Office in writing, p~~Prior art consisting of patents or printed publications which ~~that the~~ person making the submission states to ~~be pertinent and applicable to the patent and believes to~~ have a bearing on the patentability of any claim of the patent; or

(2) ~~. If the citation is made by~~Statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of the patent, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Such citations shall be entered in the patent file except as set forth in §§ 1.502 and 1.902. Any statement submitted under this paragraph must be accompanied by any other documents, pleadings, or evidence from the proceeding in which the statement was filed that address the written statement, and such statement and accompanying information under this paragraph must be submitted in redacted form to exclude information subject to an applicable protective order. Submission of a statement of the patent owner made outside of a Federal court or Office proceeding and later filed for inclusion in a Federal court or Office proceeding is not permitted by this section, and such a submission will not be entered into the patent file.

(b) Explanation included: A submission pursuant to paragraph (a) of this section:

(1) Must explain in writing the pertinence and manner of applying any prior art submitted under paragraph (a)(1) of this section and any written statement and accompanying information submitted under paragraph (a)(2) of this section to at least one claim of the patent, in order for the submission to become a part of the official file of the patent; and

(2) May, if the submission is made by the patent owner, include an explanation of how the claims differ from any prior art submitted under paragraph (a)(1) of this section or any written statements and accompanying information submitted under paragraph (a)(2) of this section.

(c) Reexamination pending: If a reexamination proceeding has been requested and is pending for the patent in which the submission is filed, entry of the submission into the official file of the patent is subject to the provisions of §§ 1.502 and 1.902.

(d) Identity: ~~(b)~~—If the person making the citation wishes his or her identity to be excluded from the patent file and kept confidential, the citation papers must be submitted without any identification of the person making the submission.

(e) Service of the submission: A submission made under this section must reflect that a copy of the submission has been served upon the patent owner at the correspondence address of record in the patent, in accordance with §1.248, or that a bona fide attempt of service was made. A submission that fails to include either proof of service or a sufficient explanation and proof of a bona fide attempt of service will not be entered into the patent file, and will be expunged if inadvertently

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~~entered. (e) Citation of patents or printed publications by the public in patent files should either: (1) Reflect that a copy of the same has been mailed to the patent owner at the address as provided for in § 1.33(e); or in the event service is not possible (2) Be filed with the Office in duplicate.~~

~~(f) Consideration of statements of patent owner: Statements of the patent owner and accompanying information submitted under paragraph (a)(2) of this section shall not be considered by the Office for any purpose other than as provided for in 35 U.S.C. 301(d) . If reexamination is ordered, the patent owner statements submitted pursuant to § 301(a)(2) will be considered when determining the scope of any claims in the patent subject to reexamination.~~