

## § 1.290: Submissions by third parties in applications (new)

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- (a) A third party may submit, for consideration and entry in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application if the submission is in compliance with 35 U.S.C. 122(e) and this section. 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.
- (b) Any third-party submission under this section must be filed before the earlier of:
  - (1) The date a notice of allowance under § 1.311 is given or mailed in the application; or
  - (2) The later of:
    - (i) Six months after the date on which the application is first published by the Office under 35 U.S.C. 122(b) and § 1.211, or
    - (ii) The date the first rejection under § 1.104 of any claim by the examiner is given or mailed during the examination of the application;
- (c) Any third-party submission under this section must be made in writing, and identify on each page of the submission, except for copies required by paragraph (d)(3) of this section, the application to which the submission is directed by application number.
- (d) Any third-party submission under this section must include:
  - (1) A list of the documents being submitted;
  - (2) A concise description of the asserted relevance of each listed document;
  - (3) A legible copy of each listed document, or the portion which caused it to be listed, other than U.S. patents and U.S. patent application publications, unless required by the Office;
  - (4) An English language translation of all relevant portions of any listed non- English language document to be considered by the examiner; 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.
- (e) The list of documents required by paragraph (d)(1) of this section must list U.S. patents and U.S. patent application publications in a separate section from other documents, include a heading that identifies the listing as a third-party preissuance submission under § 1.290, and identify each:
  - (1) U.S. patent by patent number, first named inventor, and issue date;
  - (2) U.S. patent application publication by patent application publication number, first named inventor, and publication date;
  - (3) Foreign patent or published foreign patent application by the country or patent office that issued the patent or published the application, first named inventor, an appropriate document number, and the publication date indicated on the patent or published application; and
  - (4) Non-patent publication by publisher, author, title, pages being submitted, publication date, and place of publication, where available. If not apparent from the document, the third party bears the burden of establishing the date of a non-patent publication where asserted to be prior art.

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- (f) Any third-party submission under this section must be accompanied by the fee set forth in § 1.17(p) for every ten documents or fraction thereof being submitted.
- (g) The fee otherwise required by paragraph (f) of this section is not required for a submission listing three or fewer total documents that is accompanied by a statement by the party making the submission that, to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only submission under 35 U.S.C. 122(e) submitted in the application by the party or a party in privity with the party.
- (h) In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a submission under this section.
- (i) The provisions of § 1.8 do not apply to the time periods set forth in this section.