



# PRE-ISSUANCE (THIRD-PARTY) SUBMISSIONS

BY:  
KIRBY DRAKE

KLEMCHUK LP

P 214-367-6000    E [info@klemchuk.com](mailto:info@klemchuk.com)    8150 N Central Expressway | 10th Floor  
F 214-367-6001    W [klemchuk.com](http://klemchuk.com)    Dallas, Texas 75206

# Overview

- Submissions permitted in applications already on file with PTO as of September 16, 2012
- Allows third parties to submit patents and printed publications to be considered during patent examination



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

8150 N Central Expressway | 10th Floor

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

Dallas, Texas 75206

# What Can Be Submitted

- Patents
- Printed Publications
- Can submit art already in file along with brief explanation of how it should be applied



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

8150 N Central Expressway | 10th Floor

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

Dallas, Texas 75206

# Other Types of Submissions

- Not restricted to novelty and non-obviousness
- Definiteness issue – dictionary definition
- New matter question – related parent patent application
- Enablement question – could have expert do a report to submit– however PTO has said that it will not accept materials created just for purpose of challenging application



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

8150 N Central Expressway | 10th Floor

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

Dallas, Texas 75206

# Form of Submission

- Identify items being submitted with concise description of relevance of each item listed
- Provide legible copy of each non-U.S. patent document listed and English language translation of any non-English language item listed
- Statement by party making submission that it complies with statute and rule along with fee (if required)



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

8150 N Central Expressway | 10th Floor

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

Dallas, Texas 75206

# When Submissions May Be Made

- Submit before first office action rejection mailed OR within 6 months from publication of application (to account for first action allowance or quick action by PTO)
- Will NOT consider submissions made after Notice of Allowance mailed



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

8150 N Central Expressway | 10th Floor  
Dallas, Texas 75206

# Cost of Submission

- Up to three items submitted = Free
- Up to ten items submitted = \$180



KLEMCHUK LLP

P 214-367-6000 E [info@klemchuk.com](mailto:info@klemchuk.com) 8150 N Central Expressway | 10th Floor  
F 214-367-6001 W [klemchuk.com](http://klemchuk.com) Dallas, Texas 75206

# How to Submit

- Dedicated Web-based interface to permit third-party submissions to be filed electronically (select pre-issuance submissions filing option in EFS-Web)
- Also permitted to file in paper form



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

8150 N Central Expressway | 10th Floor

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

Dallas, Texas 75206



# Anonymity of Submission

- May submit anonymously even if submitted electronically
- No requirement for third party to serve applicant with copy of submission – PTO will notify applicant if participating in e-Office Action program



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

8150 N Central Expressway | 10th Floor

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

Dallas, Texas 75206

# Notice of Submission



OFFICE OF THE COMMISSIONER OF PATENTS  
 VIRGINIA, UNITED STATES OF AMERICA

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
13/460,635	30 April, 2012	TOWNSLEY, EVAN	63203-5009

JEFFER, MANGELS, BUTLER & MITCHELL, LLP 1900 AVENUE OF THE STARS, 7TH FLOOR LOS ANGELES, CA 90067	<b>EXAMINER</b>	
	JEAN VOLLANO	
	<b>ART UNIT</b>	<b>PAPER</b>
	1600	20121015

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

A third-party submission under 37 CFR 1.290 has been filed on 10/5/2012, and is being entered in the above-identified application. Please allow a few days for the submission to be visible in the Patent Application Information Retrieval (PAIR) system. Note that the submission will be identified using the "Information Disclosure Statement Filed" Document Description. This Document Description is being used for the internal purposes only. The Office does not consider the submission to be an Information Disclosure Statement under 37 CFR 1.97 and 1.98.



KLEMCHUK LLP

P 214-367-6000    E info@klemchuk.com    8150 N Central Expressway | 10th Floor  
 F 214-367-6001    W klemchuk.com    Dallas, Texas 75206

# Review for Compliance

- Submissions (electronic or paper) not automatically made of record in application file
- PTO will review to determine compliance before being made of record



KLEMCHUK LLP

P 214-367-6000 E [info@klemchuk.com](mailto:info@klemchuk.com) 8150 N Central Expressway | 10th Floor  
F 214-367-6001 W [klemchuk.com](http://klemchuk.com) Dallas, Texas 75206

# Example: Appl. No. 12/829,968

- 1/5/12: Notice of Publication
- 9/17/12: Third-Party Submission Filed
- 9/25/12: Notice sent to Applicant
- 11/15/12: Non-Final Rejection



KLEMCHUK LLP

P 214-367-6000 E [info@klemchuk.com](mailto:info@klemchuk.com) 8150 N Central Expressway | 10th Floor  
F 214-367-6001 W [klemchuk.com](http://klemchuk.com) Dallas, Texas 75206

# Example: Appl. No. 12/829,968

German patent application publication DE102004061543A1 assigned to MesoTec GmbH (“German publication”) was filed on December 21, 2004 and published on October 29, 2006, prior to the filing of the Li patent. Similar to the claims of the Li patent, the German publication describes an implantable sensor in a patient’s eye. It describes an invention related “to an implant for intraocular measurements, comprising a sensor device ... for detecting intraocular pressure, an inductive coil ... for telemetrically transmitting the pressure values measure by the sensor device..., and a carrier ... for the sensor device ..., wherein the implant body comprising the sensor device..., the inductive coil... and the carrier... has the shape of an open ring...” Abstract. The below claim chart identifies the particular paragraph numbers where the claims of the Li patent are disclosed in the German publication.

Claim Language	DE102004061543A1
1. A sensor comprising:	“The invention relates to an implant for intraocular measurements, comprising a sensor device 4 for detecting intraocular pressure...” Abstract
a housing having a configuration	“...wherein the implant body comprising the sensor device 4,



KLEMCHUK LLP

P 214-367-6000 E info@klemchuk.com 8150 N Central Expressway | 10th Floor  
F 214-367-6001 W klemchuk.com Dallas, Texas 75206

# Example: Appl. No. 12/829,968

Claims 1, 2, 6-8, 10-12, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 102004061 (Bodecker) (with references to the English translation).

Regarding claim 1, Bodecker discloses a sensor (Figure 1) comprising: a housing (carrier 1) having a configuration that generally conforms to a curvature of an anterior chamber of a patient's eye (see entire document, including [0014] and [0015]); and a sensing device (sensor device 4) disposed in the housing and configured to detect physiological parameters and transmit a signal representing the physiological parameters (see entire document, including abstract).



KLEMCHUK LLP

P 214-367-6000 E [info@klemchuk.com](mailto:info@klemchuk.com) 8150 N Central Expressway | 10th Floor  
F 214-367-6001 W [klemchuk.com](http://klemchuk.com) Dallas, Texas 75206

# Example: Appl. No. 13/460,635

- Continuation application
- 8/13/12: Non-Final Rejection
- 8/23/12: Notice of Publication
- 10/5/12: Third-Party Submission Filed
- 10/17/12: Notice sent to Applicant
- Notice of allowance following interview



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

8150 N Central Expressway | 10th Floor

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

Dallas, Texas 75206

# Example: Appl. No. 13/465,789

- 9/6/12: Notice of Publication
- 9/27/12: Third-Party Submission Filed
- 10/9/12: Notice Sent to Applicant
- 11/2/12: Preliminary Amendment Made to Address Third-Party Submission
- 11/20/12: Non-Final Rejection (not addressing Preliminary Amendment)



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

8150 N Central Expressway | 10th Floor  
Dallas, Texas 75206



# Example: Appl. No. 13/493,787

- 9/27/12: Non-Final Rejection
- 10/4/12: Notice of Publication
- 11/28/12: Third-Party Submission Filed
- 12/3/12: Notice to Applicant
- 12/21/12: Response Filed
- 1/3/12: Non-Final Rejection (including rejection based on third-party submission)



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

8150 N Central Expressway | 10th Floor

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

Dallas, Texas 75206

# Example: Appl. No. 13/493,787

1/3/12: Non-Final Rejection

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statement (IDS) submitted on November 28, 2012 was filed after the mailing date of the non-final Office Action on September 27, 2012. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. It is noted that the IDS was submitted by a third party under rule 37 CFR 1.290 with an accompanying Concise Description of Relevance. The Examiner appreciates the submission of both documents.



KLEMCHUK LLP

P 214-367-6000 E info@klemchuk.com 8150 N Central Expressway | 10th Floor  
F 214-367-6001 W klemchuk.com Dallas, Texas 75206

# Possible Advantages

- May be used to limit competitor patent scope
- Submissions will be listed on face of patent if submitted in compliance with rules
- Could be helpful down the road if patent is ever litigated – claim construction
- No estoppel created by submissions



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

8150 N Central Expressway | 10th Floor

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

Dallas, Texas 75206

# Possible Disadvantages

- Retaliatory competitor action
- Broad patent may still issue
- Time and effort involved in monitoring competitive patent filings



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

8150 N Central Expressway | 10th Floor

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

Dallas, Texas 75206

# Best Practice Considerations

- Need a plan to timely review competitive patent filings
- Begin with quality or on-point prior art (explanation is *prima facie* credible and well-drafted)
- Resist urge to make voluminous filings
- Concise/well-reasoned explanation should quickly lead examiner to rejection



KLEMCHUK LLP

P 214-367-6000

E [info@klemchuk.com](mailto:info@klemchuk.com)

8150 N Central Expressway | 10th Floor

F 214-367-6001

W [klemchuk.com](http://klemchuk.com)

Dallas, Texas 75206



**KLEMCHUK LLP**

**P** 214-367-6000    **E** [info@klemchuk.com](mailto:info@klemchuk.com)    8150 N Central Expressway | 10th Floor  
**F** 214-367-6001    **W** [klemchuk.com](http://klemchuk.com)    Dallas, Texas 75206