TABOO, THE GAME: PATENT OFFICE EDITION—THE NEW PREISSUANCE SUBMISSIONS UNDER THE AMERICA INVENTS ACT

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ABSTRACT

Thorough patent examination ensures that issued patents confer constitutionally granted incentives to innovate but do not create inappropriately broad monopolies. Examiners at the United States Patent and Trademark Office are alone tasked with striking this proper balance, in part by searching the universe of existing published knowledge to determine the originality of the applied-for invention.

In 2011, Congress enacted the Leahy-Smith America Invents Act, which included a provision allowing the public to present examiners with relevant publications that the examiners' own searches might not otherwise uncover. However, this "preissuance submissions" provision and its related administrative rule are tempered by 35 U.S.C. § 122(c) (2006), which prohibits any third-party, pre-grant "protest or other form of [preissuance] opposition" to an application. Thus, although a party may describe to an examiner how its submission is relevant to an application, that party is prohibited from arguing how the submission renders that application unpatentable.

This Note argues that Congress should amend § 122(c) to permit preissuance third-party argumentation for two reasons. First, the current scheme arguably violates that law already. Second, a rule allowing submitter argumentation would better incentivize participation by competitive parties who fear that examiners might not recognize their submitted publications' full invalidating potential.

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INTRODUCTION

Taboo, the game of "unspeakable fun" and popular variation on the classic game of charades, invites one player to verbally suggest to his teammates a word or phrase printed on each game card.[1] The catch: that player may neither say the given word or phrase, nor say any of the commonly associated words or phrases that are also listed on the card.[2] This rule forces participants to be creative and indirect in their communication under time pressure, for if the speaker utters any of the "taboo" words during his round, a buzzer sounds and his team loses points.[3]

On September 16, 2012, the United States Patent and Trademark Office (the Office) effected its latest variation on the game of Taboo,[4] although one much less common at family game night. In accord with the changes to patent prosecution procedure set forth in the Leahy-Smith America Invents Act (the AIA),[5] the Office's 2012 regulations[6] permit the public to submit to the Office any patents or printed publications that bear upon the patentability of pending patent applications.[7] Thus, in an effort to thwart a competitor's pending application, a party may submit any printed publications that, alone

1. Milton Bradley Co., Taboo™ Instructions 2 (1989), *available at* http://www.hasbro.com/common/instruct/Taboo_(1989).pdf. Taboo is different from the nonverbal game of charades because it allows verbal, and only verbal, communication.

2. *Id.*

3. To illustrate, consider a hypothetical game card displaying the words "Duke University" such that the cardholder's object is to induce his teammates to guess those words aloud. Printed below "Duke University" would be commonly associated words such as "devils," "Krzyzewski," "Durham, North Carolina," and "blue." Because the cardholder is prohibited from communicating any of these words to his teammates, he might instead say, "It's a college in the ACC, spouse of a duchess," and so on. The buzzer possessor, a member from the opposing team, also reviews the card and monitors the speaker's compliance with the word restrictions. *Id.*

4. Although the Office did not call its system Taboo, this Note outlines the similarities.

5. Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (to be codified as amended in scattered sections of 15, 28, 35, 42, and 51 U.S.C.).

6. Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 42,150 (July 17, 2012) (to be codified at 37 C.F.R. pt. 1).

7. *See id.* Preissuance submissions must be filed prior to either six months from the time the patent application is published on the Internet or the date of the examiner's first rejection, whichever occurs later. *Id.* at 42,173. The Office has not limited the scope of permissible publications to prior art, *id.* at 42,161, which are existing patents or publications that bear on the originality of a proposed invention.

or in the aggregate, suggest that the application should be rejected on any of the various grounds for unpatentability.[8]

Submitting parties are also required to describe how each submitted patent or publication is relevant to the target application.[9] The catch: like the speakers in the game of Taboo, third-party submitters are prohibited from *directly* revealing their suggested theories of unpatentability or directly arguing the merits of those theories.[10] Instead, submitters must communicate only indirectly with the Office's examiners,[11] pointing them in a desired direction by providing strategically chosen publications and craftily worded descriptions of relevance. From these submissions, the examiners must independently derive their own arguments against patentability. If a submission does not comply with the Office's restrictions, the metaphorical buzzer sounds, and the submission is discarded in its entirety.[12]

The restriction on third-party arguments opposing patentability stems from 35 U.S.C. § 122(c), which bars any "protest or other form of pre-issuance opposition" to a pending application after the Office publishes that application.[13] Almost immediately after Congress codified § 122(c) in 1999,[14] the Office nonetheless created a limited avenue for third parties to assist examiners in locating publications relevant to any published application's patentability.[15] Building upon

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8. A patent application may be rejected for many reasons. For example, the invention may encompass nonpatentable subject matter, *see* 35 U.S.C. § 101 (2006 & Supp. V 2011), some of the claims may be indefinite or the application might fail to enable a person skilled in the art to recreate the invention, *see* 35 U.S.C. § 112, or the invention might be preempted or made obvious by earlier patents or other publications, *see* 35 U.S.C. §§ 102–103.

9. Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,173 (to be codified at 37 C.F.R. § 1.290(d)(2)).

10. *See id*. at 42,156 ("[The rule] is not an invitation to a third party to propose rejections of the claims or set forth arguments . . . ."); *id.* at 42,159 ("Unlike the concise description of relevance required . . . for a preissuance submission, the concise explanation for [a different procedure] allows for arguments against patentability.").

11. *See id.*

12. *See id.* at 42,152 ("Third-party submissions that are not compliant with the statute will not be entered into the [image file wrapper] of an application or considered, and will be discarded.").

13. 35 U.S.C. § 122(c) (2006).

14. American Inventors Protection Act of 1999, Pub. L. 106-113, tit. IV, 113 Stat. 1501, 1501A-552 (codified as amended at 35 U.S.C. § 122(c)).

15. *See* Changes To Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. 57,024, 57,056 (Sept. 20, 2000) (codified at 37 C.F.R. pt. 1). For further discussion of this limited avenue, see *infra* part I.B.

the Office's procedural innovation, Congress enacted the America Invents Act in 2011, including within it a provision greatly expanding the Office's earlier procedure.[16]

Pursuant to the AIA, the Office promulgated its current rule in 2012.[17] This rule requires third parties to include with each of their submitted documents "[a] concise description of the [document's] asserted relevance" to the pending application,[18] so long as that description does not amount to a rejection proposal or an argument against patentability.[19] The AIA preissuance submissions provision and the ensuing Office rule have provided third parties more tools than ever to win the metaphorical game of Taboo and effectively oppose pending patent applications.

Problematically, Congress left § 122(c) and its prohibition against pre-grant opposition fully intact. Congress's inaction here results in two problems. First, particularly between the Office's new preissuance submissions rule and § 122(c), there now exists significant tension in the law. Although the Office has responded with attempts to delineate a clear distinction between preissuance submissions and those actions that are prohibited by § 122(c), this Note argues that the distinction is not clear at all.[20] Second, because of the limitations imposed by § 122(c), the preissuance submission rule provides inadequate incentives for competition-driven third parties to participate. Since an issued patent is presumed valid during litigation,[21] it can be presumed to have overcome all references included within its application file. As a result of this post-issuance presumption, potential litigants are generally reluctant to contribute references to such a file because those references will have diminished value in the event of litigation.[22] That reluctance is at a maximum when the rules prevent submitters' clearest argumentation, thereby reducing the perceived likelihood that examiners will

16. *See* Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 8, 125 Stat. 284, 315 (2011) (to be codified at 35 U.S.C. § 122(e)) (allowing submissions of any printed publications with accompanying descriptions of relevance).

17. *See* Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,173 (to be codified at 37 C.F.R. § 1.290).

18. *Id.* at 42,173 (to be codified at § 1.290(d)(2)).

19. *Id.* at 42,156.

20. *See infra* Part II.A.

21. 35 U.S.C. § 282(a) (2006).

22. Salvador M. Bezos, *Third-Party Submissions*, *in* 2 PATENT OFFICE LITIGATION § 14:39 (Robert Sterne et al. eds., 2012).

recognize and employ the submitted references' full invalidating potential.

Although Congress made great strides in amending the preissuance submissions procedure to allow greater public involvement in patent prosecution, this Note argues that it should take one additional small step to eliminate the legal tension between the Office's new preissuance submissions rule and § 122(c) and to further boost participation of third parties.[23] Congress should amend § 122(c) to permit third parties to supplement their submitted references with direct arguments explaining not only how those references are relevant to a pending application, but also how they specifically render that application unpatentable.[24]

This Note proceeds in two parts. Part I traces the evolution of the current preissuance submissions rule. To this end, subparts I.A and I.B outline the history of the Office's prior programs providing for different levels of third-party participation in patent prosecution. Subpart I.C summarizes the legislative history of the AIA with respect to its preissuance submissions provision. Subpart I.D examines the Office's rulemaking in response to the AIA, with particular emphasis on the Office's justifications for the current rule. Part II advocates for further change in the law to provide greater third-party participation in patent prosecution. Subpart II.A argues that the Office's current preissuance submission program is now so extensive that it already transgresses § 122(c)'s restriction against post-publication opposition. Finally, Subpart II.B proposes that Congress should further the policy objectives behind the AIA by amending § 122(c) to allow for third parties to supplement their submissions with direct arguments against patentability.

I. HISTORY AND DEVELOPMENT OF PREISSUANCE THIRD-PARTY INVOLVEMENT

A 1998 empirical study of three hundred patent-validity cases found that 46 percent of challenged patents had been held invalid.[25] Commentators have long lamented that the existence of so many "bad patents" has a detrimental effect on the economy and society as

23. *See infra* Part II.

24. *See infra* Part II.

25. John R. Allison & Mark A. Lemley, *Empirical Evidence on the Validity of Litigated Patents*, 26 AIPLA Q.J. 185, 205–06 (1998).

a whole.[26] For instance, validity disputes in court "impose litigation costs on society."[27] Also, owners of bad patents unjustly burden others with license fees.[28] In addition, because litigation is a lengthy process that often costs millions of dollars,[29] some licensees may opt to continue paying royalties in lieu of challenging bad patents in court.[30] Finally, technology firms may choose not to enter a given market if they find that competitors already hold overbroad patents in that market.[31]

In an attempt to identify a potential source of the weaknesses in patent quality, some commentators have noted that Office examiners spend only about eighteen hours reviewing a given patent application.[32] In that short time and among many other duties, each examiner must search the entire universe of technical information for invalidating prior art—existing patents or publications that either disclose all elements of the claimed invention or render the claimed invention obvious.[33] One option for alleviating this heavy burden on the Office is to invite interested members of the public to provide examiners with prior art or other forms of assistance.[34] The remainder of this Part discusses the various programs that the Office has

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26. *See, e.g.*, Mark A. Lemley, *Rational Ignorance at the Patent Office*, 95 NW. U. L. REV. 1495, 1515–20 (2001) (discussing "the social costs of bad patents"); FED. TRADE COMM'N, TO PROMOTE INNOVATION: THE PROPER BALANCE OF COMPETITION AND PATENT LAW AND POLICY 5–6 (Oct. 2003), *available at* http://www.ftc.gov/os/2003/10/innovationrpt.pdf (discussing "questionable patents").

27. Lemley, *supra* note 26, at 1515; *see also* Doug Harvey, Comment, *Reinventing the U.S. Patent System: A Discussion of Patent Reform Through an Analysis of the Proposed Patent Reform Act of 2005*, 38 TEX. TECH L. REV. 1133, 1164 (2006) ("[L]itigation over the validity of a patent is costly and time-consuming.").

28. Lemley, *supra* note 26, at 1515.

29. FEDERAL TRADE COMM'N, *supra* note 26, at 6; *see also* Qin Shi, *Reexamination, Opposition, or Litigation? Legislative Efforts To Create A Post-Grant Patent Quality Control System*, 31 AIPLA Q.J. 433, 435 (2003).

30. Lemley, *supra* note 26, at 1515; Joseph Farrell & Robert P. Merges, *Incentives To Challenge and Defend Patents: Why Litigation Won't Reliably Fix Patent Office Errors and Why Administrative Patent Review Might Help*, 19 BERKELEY TECH. L.J. 943, 954 (2004).

31. *See* Lemley, *supra* note 26, at 1515–16 (noting the potential of patents to deter competition). Professor Lemley also notes that, in practice, many companies do not actually search for others' patents in an effort to avoid knowingly infringing upon those patents. *Id.* at 1516.

32. *See, e.g.*, Michael Meehan, *Increasing Certainty and Harnessing Private Information in the U.S. Patent System: A Proposal for Reform*, 2010 STAN. TECH. L. REV. 1, ¶ 80, http://stlr.stanford.edu/pdf/meehan-increasing-certainty.

33. *Id.*

34. *Id.*

implemented to increasingly integrate third parties into patent prosecution.

A. Evolution of the Protest

In 1977, with the intention of both "improving the quality of issued patents" and "avoiding the issuance of invalid patents," the Office promulgated a rule, 37 C.F.R. § 1.291 (Rule 291),[35] which established a written protest procedure for third parties to challenge pending patent applications.[36] In 1982, the Office clarified that protests "may include any grounds which the member of the public filing the protest believes to be applicable."[37] Among other requirements, protest submissions must include "(1) a listing of the patents, publications or other information relied upon; [and] (2) a concise explanation of the relevance of each listed item."[38] Emphasizing the restrictive nature of the protest procedure, the 1982 amendment provides that "the active participation of the member of the public filing a protest . . . ends with the filing of the protest."[39]

Until 2000, the Office kept pending patent applications confidential.[40] Therefore, third parties were generally unaware of pending patent applications and rarely invoked the protest procedure.[41] In the 1990s, however, several legislative efforts

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35. Patent Examining and Appeal Procedures, 42 Fed. Reg. 5588, 5589 (Jan. 28, 1977) (codified at 37 C.F.R. § 1.291 (1980)).

36. The Office had previously provided for a "public use proceeding," a limited method for persons "having information of the pendency of an application" to demonstrate that an invention claimed in a pending application "had been in public use or on sale one year before the filing of the application." 37 C.F.R. § 1.292 (1976). Because the public use proceeding was used infrequently, was rarely successful in leading to claim rejection, was a cause of prosecution delay, and became redundant to the protest procedure, the Office abandoned it in 2012. *See* Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 42,150, 42,151, 42,160 (July 17, 2012) (to be codified at 37 C.F.R. pt. 1).

37. Reissue, Reexamination, Protest and Examination Procedures in Patent Cases, 47 Fed. Reg. 21,746, 21,749 (May 19, 1982) (codified at 37 C.F.R. pt. 1).

38. *Id.* at 21,752.

39. *Id.*

40. *See* 35 U.S.C. § 122 (Supp. V 1999) ("Prior to amendment, text read as follows: 'Applications for patents shall be kept in confidence by the Patent and Trademark Office . . . .'" (quoting 35 U.S.C. § 122 (1994))).

41. Mark D. Janis, *Rethinking Reexamination: Toward A Viable Administrative Revocation System for U.S. Patent Law*, 11 HARV. J.L. & TECH. 1, 16 (1997). However, protests were also allowed during postissuance, patentee-initiated "reissue" proceedings, which were made public. Patent Examining and Appeal Procedures, 42 Fed. Reg. 5588, 5589 (Jan. 28, 1977) (codified as amended at 37 C.F.R. § 1.291).

proposed that pending patent applications should be published and made available to the public.[42] During a 1996 notice-and-comment rulemaking by the Office, several commenters raised concerns that protests could be abused as pre-grant opposition if applications were published.[43] Opponents were concerned that such procedures would lead to delay of patent prosecution and harassment of patent applicants.[44] Although the Office declined at that time to change its policies,[45] Congress soon addressed the opponents' concerns.

The proposed Moorhead-Schroeder Patent Reform Act of 1996 (the 1996 Act) included an amendment to § 122,[46] providing that patent applications would be published eighteen months after their filing.[47] To allay fears that publication would lead to delay, the 1996 Act also mandated that the amendment could not be used "to create any new opportunity for pre-issuance or pre-grant opposition."[48] While the 1996 Act was never passed, a third iteration of patent reform proposals, the American Inventors Protection Act of 1999 (the AIPA),[49] was successfully enacted on November 29, 1999.[50] As the previous legislative efforts had attempted, the AIPA amended § 122 to provide for pre-grant publication of patent applications.[51]

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42. *See infra* notes 46–51 and accompanying text.

43. *See* Miscellaneous Changes in Patent Practice, 61 Fed. Reg. 42,790, 42,799 (Aug. 19, 1996) (codified as amended at 35 C.F.R. pt. 1).

44. *Cf.* Jay P. Kesan, *Carrots and Sticks To Create a Better Patent System*, 17 BERKELEY TECH. L.J. 763, 783 (2002) ("For example, large companies with ample resources may choose to stall the issuance of patents by small inventors."). The Japanese Patent Office at one time allowed third parties to initiate "slow moving" pre-grant opposition proceedings, but it eliminated that procedure in the mid-1990s pursuant to an agreement with the United States. Sri Krishna Sankaran, *Patent Flooding in the United States and Japan*, 40 IDEA 393, 405–07 (2000). Unlike this Note's proposed system, which would allow mere submissions of prior art and accompanying argumentation, the more formal Japanese oppositions required examiners to individually decide upon and respond to each opposition. U.S. GEN. ACCOUNTING OFFICE, GAO/GGD-93-126, INTELLECTUAL PROPERTY RIGHTS: U.S. COMPANIES' PATENT EXPERIENCES IN JAPAN 32–33 (1993). The Japanese process often delayed issuance for up to five years. *Id.* at 33.

45. *See* Miscellaneous Changes in Patent Practice, 61 Fed. Reg. at 42,800 ("Nevertheless, as neither H.R. 1732 nor H.R. 1733 has presently been enacted, analysis of whether modification of §1.291 . . . is desirable in a pre-grant publication or expanded reexamination system is held in abeyance pending enactment of H.R. 1733 or 1732.").

46. Moorhead-Schroeder Patent Reform Act, H.R. 3460, 104th Cong. (1996).

47. *Id.* § 202.

48. *Id.*

49. American Inventors Protection Act of 1999, Pub. L. No. 106-113, tit. IV, 113 Stat. 1501, 1501A-552 (1999) (codified as amended at 35 U.S.C. §§ 5, 6, 273, 297, 311–318).

50. *Id.*

51. *Id*. § 4502.

Importantly for the purposes of this Note, the AIPA also included an amendment to § 122(c), providing that "the Director shall establish appropriate procedures to ensure that no *protest* or *other form of pre-issuance opposition* to the grant of a patent on an application may be initiated *after publication of the application* without the express written consent of the applicant."[52]

Accordingly, in September 2000, the Office amended the protest rules pursuant to the AIPA "to provide that a protest must be submitted prior to the date the application [is] published."[53] Because preissuance protests are permissible only before the Office informs the public of any given application, it is likely that they are rarely, if ever, employed.[54]

B. Rule 99 Third-Party Submissions in Published Applications

Despite the restriction in § 122(c) on preissuance protests and on any other form of pre-grant opposition,[55] the Office invoked its procedural rulemaking power in 2000 to create a new avenue for third-party involvement in patent prosecution.[56] Under the new 37 C.F.R. § 1.99 (Rule 99), interested third parties could submit relevant prior art to a patent application file within a narrow two-month window beginning when that application was published.[57] For each $180 payment,[58] any member of the public could submit up to ten patents or publications to be entered into an application file and

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52. *Id.* (emphasis added).

53. Changes To Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. 57,024, 57,038 (Sept. 20, 2000) (codified as amended at 37 C.F.R. pt. 1).

54. The Office does not release usage statistics for the protest procedure. Nonetheless, commentators have theorized that, based on obvious limitations, preissuance protests are rare. *See* Janis, *supra* note 41, at 16.

55. *See* 35 U.S.C. § 122(c) (2006).

56. *See* Changes To Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. at 57,056.

57. Third-Party Submission in Published Application, 37 C.F.R. § 1.99 (2011). Rule 99 has since been repealed and reserved. *See* Changes To Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 42,150, 42,173 (July 15, 2012) (to be codified at 37 C.F.R. § 1.99).

58. *See* 37 C.F.R. § 1.99(b)(1) (requiring inclusion of "[t]he fee set forth in [37 C.F.R.] § 1.17(p)"); *cf.* 37 C.F.R. § 1.17(p) (requiring a fee of $180). Rule 99 did not limit the number of submissions made by any single party, so long as $180 was paid for each ten patents or publications. Bradley William Baumeister, *Critique of the New Rule 1.99: Third-Party Information Disclosure Procedure for Published Pre-Grant Applications*, 83 J. PAT. & TRADEMARK OFF. SOC'Y 381, 406 (2001).

considered by an examiner.[59] Purportedly keeping in line with § 122(c), the rule barred third parties from including with their submitted patents or publications any explanation or other information.[60] It was, therefore, left to the examiner to determine how, if at all, the submitted prior art was relevant to the pending application.

In its continuing quest to minimize the issuance of invalid patents,[61] the Office justified its rulemaking as necessary to "improve the quality of examination."[62] Because examiners' increased exposure to relevant prior art should lead to more effective examination, the goal of Rule 99 was to harness the collective knowledge of the public to bring that art to the attention of the Office, and ultimately, to foster the issuance of only valid patents.[63]

It is not obvious how Rule 99 can be reconciled with the apparent congressional intent to restrict third-party involvement in patent prosecution post-publication.[64] For instance, the Office appears to have drafted Rule 99 using the existing protest procedures as a template,[65] whereas Congress explicitly banned the use of protests post-publication.[66] Further, § 122(c)'s prohibition of any "other form of pre-issuance opposition"[67] suggests that Congress may have intended a sweeping ban on third-party involvement. Under such an interpretation of § 122(c), "any form of a complaint, objection, or display of unwillingness to an idea or course of action whatsoever" would be included in the terms "protest" and "opposition."[68] As one commentator reasoned,

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59. 37 C.F.R. § 1.99(d).

60. *Id.*

61. The Office's protest procedure was justified on the same grounds. *See* Patent Examining and Appeal Procedures, 42 Fed. Reg. 5588, 5589 (Jan. 28, 1977) (codified as amended at 37 C.F.R. pt. 1).

62. Changes To Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. 57,024, 57,043 (Sept. 20, 2000) (codified as amended at 37 C.F.R. pt. 1).

63. *See id.*; U.S. PATENT & TRADEMARK OFFICE, U.S. DEP'T OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE § 1134.01 (8th ed., rev. 9, 2012) (explaining that the Office allows the public to submit prior art "which [it] would discover on its own with an ideal . . . search" to carry out its responsibility to issue only valid patents).

64. *Cf.* Baumeister, *supra* note 58, at 387 ("To stem any potential tide of post-publication protest harassment by third parties, Congress included [§ 122(c)] within . . . the AIPA.").

65. *See id.* at 388 (noting the nearly identical form and language between Rule 99 and Rule 291 as of 2001).

66. 35 U.S.C. § 122(c) (2006).

67. *Id.*

68. Baumeister, *supra* note 58, at 391.

> [S]ince the third party's ultimate purpose of filing a [Rule 99] submission is to provide the examiner with a prior art reference that will tend to negate the patentability of the application's claims, the submission of any reference, even without the inclusion of additional explanations or commentary, would itself inherently constitute a complaint or objection to the granting of a patent on the application. Thus, any submission of relevant prior art *per se* rises to the level of a protest or opposition.[69]

In response to a comment raising these objections during rulemaking, the Office announced that it would not adopt such a broad interpretation of § 122(c),[70] but instead argued that "[a] submission under [Rule 99] . . . is different from either an 'opposition' proceeding or a 'protest' that would fall under [that] provision[]."[71] The Office interpreted "opposition" not as it is commonly used by the ordinary person, but rather as a specialized term of art, defined by existing "opposition" procedures in the trademark realm and in practice at foreign patent offices.[72] Oppositions of this sort are described as "complex" in nature, involving "full adversarial proceedings similar to a trial, complete with pleadings, notice, discovery, stipulations, motions, briefs, evidence, and opportunity for oral argument."[73] Because the Office likened oppositions to inter partes civil actions, the relatively detached nature of Rule 99 submissions rendered the two procedures easily distinguishable.[74]

However, the mere fact that Rule 99 submissions were neither complex nor involved did not alone clear them of the restrictions set forth in § 122(c). Section 122(c) refers explicitly to protests,[75] which do not fall under the Office's interpretation of "opposition."[76] Undeterred, the Office argued that "a third-party submission of patents and publications under [Rule 99 was] not a 'protest.'"[77] In contrast to its treatment of the word "opposition," the Office

69. *Id.*

70. *See* Changes To Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. 57,024, 57,042 (Sept. 20, 2000) (codified as amended at 37 C.F.R. pt. 1).

71. *Id.*

72. *Id.*

73. *Id.*

74. *Id.*

75. 35 U.S.C. § 122(c) (2006).

76. For a description of the ex parte nature of protests, see *supra* notes 38–39.

77. Changes To Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. at 57,042.

interpreted "protest" based on that word's definition as it is "generally understood."[78] Consulting a dictionary, the Office defined a protest as "a complaint, objection, or display of unwillingness usually to an idea or course of action."[79] The Office adopted a formalistic interpretation of "complaint or objection," arguing that a Rule 99 submission did not amount to either for two reasons. First, the Office argued that the rule did not allow the submissions to contain any form of adversarial arguments—only the prior art documents themselves were permitted.[80] Second, the Office argued that "patents and publications [could have been] submitted for various reasons," not only by a person filing with the intention to foil the application's success.[81]

The Office also contrasted Rule 99 submissions with the existing protest procedures.[82] The Office argued that unlike a protest under Rule 291, a Rule 99 submission "does not permit the third party to transmit any commentary or adversarial arguments objecting to a patent application."[83] The Office also argued that the two procedures were different because Rule 99 allowed only for submission of *prior art* patents and publications,[84] whereas Rule 291 protests allowed submissions of *any* information related to a pending application's patentability.[85]

Finally, the Office considered § 122(c) as a whole and interpreted it "to mean that the Office is to ensure that no third party is given the ability (or right) to have input on the examination of the application after publication and argue against the application's patentability."[86] It argued that to conform to § 122(c), Rule 99 would "ensure that no third parties enter written, adversarial arguments, thereby coloring

78. *Id.*

79. *See id.* (citing MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY 938 (10th ed. 1993)).

80. *Id.*

81. *See id.* ("Individuals may wish to submit patents or publications to help the examiner understand the technology or the appropriate field of search.").

82. *Id.*

83. *Id.*

84. *See id.* ("Only patents and publications (*i.e.*, prior art documents that are public information that are theoretically available to the examiner and which the Office would discover on its own in an ideal world) may be supplied to the examiner in a submission under [Rule 99].").

85. *See* 37 C.F.R. § 1.291(c) (2012) ("[A] protest must include . . . [a] copy of each listed patent, publication, *or other item of information* . . . .") (emphasis added).

86. Changes To Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. at 57,043.

the ex parte process."[87] To that end, the Office even refused to permit third parties to mark or otherwise highlight their submitted prior-art documents.[88]

Despite the Office's goal to provide for greater involvement by third parties,[89] the public likely never embraced Rule 99 submissions to any great extent for several reasons.[90] First, Rule 99 limited the window of opportunity for third parties to submit prior art to only two months following the application's publication.[91] Such a narrow time frame required third parties to remain highly vigilant of Office publications.

Second, Rule 99's prohibition of accompanying explanatory material[92] also weakened the procedure's appeal. Prior-art documents submitted pursuant to Rule 99 were entered into the patent application's permanent file.[93] In general, if a patentee is successful during examination and ultimately obtains a patent, the patent "shall be presumed valid" during subsequent litigation.[94] Further, "a patent is presumed to have overcome any references introduced during its examination."[95] Therefore, any prior art submitted under Rule 99 instantly lost some of its potential to invalidate the patent in future litigation.[96]

Unlike during litigation, Rule 99 submitters were not allowed to attach any commentary to their prior art, and therefore, submitters

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87. *Id.*

88. Baumeister, *supra* note 58, at 400. Third parties could, however, submit redacted versions of prior art documents, *effectively* highlighting the most relevant parts. *See* Changes To Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. at 57,043. At least one commentator has argued that there is little, if any, distinction between highlights or markings for the purpose of emphasis and redacted copies, and that such a broad interpretation of § 122(c) "would cast upon the legitimacy of Rule 99 *in toto*." *See* Baumeister, *supra* note 58, at 401 ("The only real reason a third party would file a [Rule 99] submission at all is exactly the same as the reason for highlighting the references contained therein: to inform the examiner of particular disclosures that cast doubt upon the validity of a given application's claims.").

89. *See supra* notes 61–63 and accompanying text.

90. *See* Matthew John Duane, *Lending A Hand: The Need for Public Participation in Patent Examination and Beyond*, 7 CHI.-KENT J. INTELL. PROP. 57, 63 (2008). As with data on protests, the Office did not release statistics on Rule 99 submission rates.

91. 37 C.F.R. § 1.99(e) (2011).

92. *Id.* § 1.99(d).

93. *Id.* § 1.99(a).

94. 35 U.S.C. § 282(a) (2006).

95. Duane, *supra* note 90, at 63 (citing Gould v. Gen. Photonics Corp., 534 F. Supp. 399, 400 (N.D. Cal. 1982)).

96. *Id.*

risked the possibility that examiners would overlook or misconstrue their submission's relevance to the application.[97] Assuming that most would-be Rule 99 submitters were competitors of the applicants, they were likely not eager to show their cards without supporting commentary and, thereby, potentially compromise what might otherwise be strong litigation material.[98]

Ultimately, Rule 99 was replaced in September 2012 with an expanded version of essentially the same rule.[99] The following section discusses that transition.

C. Congressional Amendment of § 122(e)

With the weaknesses of the Rule 99 submissions in mind, some commentators proposed that the procedures for preissuance submissions should be amended to allow for greater participation by third parties.[100] Because competitors and otherwise-interested third parties collectively constitute a vast resource of knowledge regarding prior art, these proposals argued that a mechanism for harnessing that resource should better incentivize third-party action.[101]

Under one commentator's proposal, third parties would be allowed to submit "all types of information," not merely prior art.[102] Also, third parties would be allowed to supplement their submissions with "a brief statement of relevancy for all information submitted."[103] Such a proposal would "improve[] the quality of information submitted and decrease[] the burden on [the Office] to independently establish relevancy."[104] This proposal would also directly address

97. *Id.*

98. *See id.*

99. *See* Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 42,150, 42,173 (July 17, 2012) (to be codified at 37 C.F.R. § 1.290).

100. *See, e.g.*, Kevin Mack, *Reforming Inequitable Conduct To Improve Patent Quality: Cleansing Unclean Hands*, 21 BERKELEY TECH. L.J. 147, 169–70 (2006); *see also* FED. TRADE COMM'N, *supra* note 26, at 18 ("Some urged that pre-grant opposition would have the advantage of introducing third-party participation before the PTO is on record with a position, thereby avoiding any undue tendency to affirm prior acts.").

101. *See* Mack, *supra* note 100, at 169.

102. *Id.* at 170. For a list of some hypothetical examples of non-prior-art submissions, see *infra* notes 180–87 and accompanying text.

103. *Id.*

104. *Id.*

submitters' fears that their submissions would be weakened and potentially compromised without the possibility for explanation.[105]

Concerns about the underutilization of Rule 99 submissions ultimately gained the attention of Congress. On June 8, 2005, Representative Lamar Smith introduced the Patent Reform Act of 2005 (the 2005 Act),[106] which included, among other important patent reforms,[107] an expansion of the ability of third parties to submit prior art to pending application files.[108] In pertinent part, the 2005 Act proposed amending § 122 to allow for anonymous, third-party preissuance submissions of patents or publications "of potential relevance to the examination of the application" submitted before the examiner's first rejection of that application, but not before six months after the application's publication.[109] In its most significant departure from Rule 99, the proposed amendment to § 122(e) required that third parties include with their submissions "a concise description of the asserted relevance of each submitted document."[110] However, the 2005 Act failed to be enacted.[111]

Two years later, proponents of patent reform introduced a similar bill, the Patent Reform Act of 2007 (the 2007 Act),[112] which included a nearly identical preissuance-submissions provision.[113] A report from the Committee on the Judiciary on the 2007 Act (the 2007 Committee Report) provided some insight into Congress's rationale for the amendment to § 122(e).[114] The 2007 Committee Report cited growing concerns about "the quality of issued patents . . . in recent years."[115] It noted that "patents have issued on

105. *See supra* notes 92–98 and accompanying text.

106. Patent Reform Act of 2005, H.R. 2795, 109th Cong. (2005).

107. Billed as "without question, the most comprehensive change to U.S. patent law since Congress passed the 1952 Patent Act," the 2005 Act proposed a change of application priority from first-to-invent to first-to-file, deleted the "best mode" disclosure requirement, and created a new post-grant opposition procedure. Press Release, Congressman Lamar Smith, Smith Introduces Patent Reform Bill (June 8, 2005), *available at* http://web.archive.org/web/20060927203732/http://lamarsmith.house.gov/News.asp?FormMode=Detail&ID=669.

108. H.R. 2795 § 10.

109. *Id.*

110. *Id.*

111. *H.R. 2795 (109th): Patent Act of 2005*, GOVTRACK.US, http://www.govtrack.us/congress/bills/109/hr2795 (last visited Aug. 3, 2013).

112. Patent Reform Act of 2007, H.R. 1908, 110th Cong. (2007).

113. *See id.* § 9. However, the new version also required third parties to "identify the real party-in-interest making the submission." *Id.*

114. H.R. Rep. No. 110-314 (2007).

115. *Id.* at 36–37.

inventions that were publically known and in use prior to the filing of the applications" especially in "newer areas of technology."[116] In these areas, patent examiners have struggled to locate "all of the prior art that exists in those fields."[117] To remedy this problem, the drafters sought to amend § 122(e) "to allow third parties to submit prior art that may be known to the public, but not readily available to the examiner."[118]

Importantly, the 2007 Act did not propose to repeal the § 122(c) ban on pre-grant protests and oppositions. The 2007 Committee Report acknowledged that Rule 99's limiting conditions on submissions (the narrow two-month window of submission acceptance and the prohibition on accompanying explanations) were designed to comply with § 122(c).[119] By amending § 122(e) but "leaving § 122(c) intact," the drafters of the 2007 Act intended to "include broader circumstances under which third parties may submit prior art in a published application" without "allow[ing] for additional third party input that would amount to a protest or pre-issuance opposition."[120] By requiring submitters to "include an explanation of the relevance of the prior art," the drafters sought both "to assist the examiner in focusing on the relevant information" and to "reduce the likelihood that a third party [would] submit large numbers of irrelevant or cumulative references."[121] Although the 2007 Act was passed by the House of Representatives on September 7, 2007, it failed to win the support of the Senate and was ultimately abandoned.[122]

On January 25, 2011, Senator Patrick Leahy introduced yet another iteration of patent reform, the AIA. Finally, both the House and the Senate passed their respective versions of this bill, and President Barack Obama signed the measure into law on September

116. *Id.* The 2007 Committee Report identified software and business method patents as those most susceptible to examiner error, in part because "those areas do not have a well-developed tradition of, or system for, publication in readily searchable printed journals." *Id.* at 37.

117. *Id.*

118. *Id.*

119. *Id.*

120. *Id.*

121. *Id.*

122. *H.R. 1908 (110th): Patent Reform Act of 2007*, GOVTRACK.US, http://www.govtrack.us/congress/bills/110/hr1908 (last visited Aug. 3, 2013).

16, 2011.[123] The AIA codified the oft-proposed amendment to § 122(e).[124] Under the law, "[a]ny 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" before the later of six months from the date the application is published or the date of the examiner's first rejection of any claim.[125] The law contains no requirement that the submitter identify the real party in interest behind the submission and mandates that all submissions must "set forth a concise description of the asserted relevance of each submitted document."[126]

D. The Office Promulgates Rule 290 Pursuant to Amended § 122(e)

On July 17, 2012, the Office abandoned Rule 99 and promulgated a new regulation providing for preissuance submissions by third parties pursuant to the AIA.[127] New 37 C.F.R. § 1.290 (Rule 290), titled "[s]ubmissions by third parties in applications," went into effect on September 16, 2012, and "appl[ies] to any application filed before, on, or after" that date.[128]

The Office embraced the new changes set forth in the AIA as an opportunity to broadly expand upon the ability of third parties to assist patent examiners during an examination in three ways.[129] First, the Office interpreted § 122(e) to allow third parties to submit almost *any* printed publications to the examination of an application, not just those that are prior art.[130] Amended § 122(e) provides, "[a]ny third

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123. *See H.R. 1249 (112th): Leahy-Smith America Invents Act*, GOVTRACK.US, http://www.govtrack.us/congress/bills/112/hr1249 (last visited Aug. 3, 2013) (noting that the House version of the Act passed on June 23, 2011); *S. 23 (112th): America Invents Act*, GOVTRACK.US, http://www.govtrack.us/congress/bills/112/s23 (last visited Aug. 3, 2013) (noting that the Senate version of the Act passed on March 8, 2011).

124. Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 8, 125 Stat. 284, 315 (2011) (to be codified at 35 U.S.C. § 122(e)).

125. *Id.* (to be codified at 35 U.S.C. § 122(e)(1)).

126. *See id.* (to be codified at 35 U.S.C. § 122(e)(2)(A)).

127. Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 42,150, 42,173 (July 17, 2012) (to be codified at 37 C.F.R. § 1.290).

128. *Id.* at 42,150.

129. Perhaps the Office's new rule has impermissibly surpassed the intent of Congress with respect to both § 122(e) and § 122(c). *See infra* Part II.

130. *See* Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,154. ("Because . . . § 122(e) does not limit the type of information that may be submitted to only that which is prior art, there is no requirement in [Rule 290] that the information submitted be prior art . . . .").

party may submit . . . any patent, published patent application, or other printed publication of potential relevance to the examination of the application."[131] To that end, Rule 290 merely requires that the documents qualify as "printed publications" under the definition set forth in § 2128 of the Manual of Patent Examining Procedure (MPEP).[132] According to the MPEP, a "printed publication" is broadly defined as any reference that "is accessible to the public."[133] However, to weed out any "improper attempt by the third party to impermissibly participate in the examination of the application," the Office cautioned that submitted documents that appear to have been "drafted after the application was filed solely to contest patentability" may not be accepted.[134]

Second, pursuant to amended § 122(e),[135] Rule 290 requires third parties to provide a "concise description of the asserted relevance of each item" submitted.[136] These descriptions are required to contain at least some substance: Rule 290 provides that, "[a]t a minimum, [the description] must be more than a bare statement that the document is relevant" and that it instead must be "meaningful."[137] By contrast, under Rule 99, third parties were prohibited from including any markings or explanations on their submitted documents.[138] Therefore, even if third parties had been allowed to submit non-prior-art documents under that rule, those submissions likely would have been ambiguous or otherwise unhelpful to examiners without any clarification.[139]

Under Rule 290, however, even vague submissions of any variety become much more powerful now that submitters are able to assert

131. Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 8, 125 Stat. at 316 (to be codified at 35 U.S.C. § 122(e)).

132. Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,154 (citing U.S. PATENT & TRADEMARK OFFICE, *supra* note 63, § 2128).

133. U.S. PATENT & TRADEMARK OFFICE, *supra* note 63, § 2128.

134. *See* Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,163.

135. *See* Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 8, 125 Stat. at 316 (to be codified at 35 U.S.C. § 122(e)).

136. Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,173.

137. *Id*. at 42,156.

138. *See supra* notes 86–88 and accompanying text.

139. In such a case, examiners would be left guessing to where in the often many-page application the submitter is referring.

an association between the submission and a specific part of the application. The Office has stated that it is interpreting the concise description-of-relevance requirement "*liberally* because [it] anticipates that third parties will be motivated to . . . effectively draw the examiner's attention to the potential relevance of a submitted document."[140] Rule 290 suggests that "a narrative description or a claim chart," in which various portions of a submitted document are "mapped"—or assigned—to different claim elements in the application, would be acceptable.[141]

Third, Rule 290 expands upon the ability of third parties to assist patent examiners by reducing submission cost barriers. While the Office had previously charged third parties a processing fee for submitted documents under Rule 99,[142] Rule 290 retains the old fee structure but provides an exemption for the first three documents submitted by any party (or a party in privity with that party) in any given application.[143] The Office reasoned that the "submission of a limited number of documents is more likely to assist in the examination process and thus offset the cost of processing the submission."[144] Even if the $180 processing fee had not been a major deterrent for competitive submitters under Rule 99, this fee waiver should make Rule 290 a viable procedure for disinterested third parties, such as students, who otherwise might not be inclined to spend more than their time assisting in patent examination.[145]

In sum, Rule 290 replaces Rule 99 with a much more attractive procedure for third parties to cheaply and anonymously[146] submit any published documents relevant to an invention's patentability.[147] However, despite Rule 290's benefits, its expansive nature leads it to conflict with the § 122(c) ban on preissuance opposition, making further change necessary to eliminate the tension between § 122(c)

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140. Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,156 (emphasis added).

141. *Id.*

142. *See supra* notes 58–59 and accompanying text.

143. Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,153.

144. *Id.*

145. For further discussion on disinterested submitters, see *infra* notes 162–65 and accompanying text.

146. While the party in interest may remain anonymous, that party's submitting agent will be identified. Rule 290 requires signed statements by the submitter that the submission is in compliance with the rule. *See id.* at 42,154 (to be codified at 37 C.F.R. § 1.290(d)(5), (g)).

147. *See id.* (to be codified at 37 C.F.R. § 1.290).

and § 122(e) and to further encourage third-party participation in patent prosecution.

II. THE PROHIBITION ON PRE-GRANT, THIRD-PARTY ARGUMENTS SHOULD BE CURTAILED

Because Rule 290 went into effect on September 16, 2012,[148] time will tell whether the new procedure will be more widely embraced than its predecessor. Despite the apparent advantages over the old system, some commentators are not optimistic that the changes are drastic enough to adequately encourage competitive participation.[149] One commentator has simply argued that "even if submission practice is improved" over Rule 99, "[t]he small possibility of stopping a patent 'on the cheap' does not provide much incentive to study applications as they are published."[150]

Thus, to address these concerns and foster greater third-party participation, Congress should recognize that even the new procedure enables enough third-party involvement that it already conflicts with § 122(c)'s prohibition on pre-grant protests and opposition. Congress should amend § 122(c) to relieve this tension and permit third parties to supplement their submitted references with direct arguments explaining how those references render the application unpatentable. This way, from the perspective of potential submitters, there is less risk that examiners will fail to fully recognize the value of submitted references.

A. Lifting the Ban on Third-Party Preissuance Argumentation Would Eliminate the Tension Between § 122(c) and § 122(e).

As a relatively small provision largely overshadowed by the more significant and controversial patent reforms enacted through the AIA,[151] the "Preissuance Submissions" amendment to § 122(e) has not raised many suspicious eyebrows.[152] To the contrary, many have

148. *Id*. at 42,150.

149. *See, e.g.*, Bezos, *supra* note 22, § 14.39.

150. Rochelle Dreyfuss, *Pathological Patenting: The PTO as Cause or Cure*, 104 MICH. L. REV. 1559, 1573 (2006).

151. The AIA also changes patent awarding priority from first-to-invent to first-to-file, *see* Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 3, 125 Stat. 284, 285 (2011), and establishes new post-grant opposition proceedings, *see id.* § 6.

152. *See* James G. McEwen, *Is the Cure Worse than the Disease? An Overview of the Patent Reform Act of 2005*, 5 J. MARSHALL REV. INTELL. PROP. L. 55, 72 (2005) ("Because this

applauded the amendment as a step in the right direction for improving the quality of issued patents.[153] However, this Note argues that although the AIA's allowance of increased third-party participation in patent prosecution was sound in policy, it nonetheless has led the Office to violate § 122(c)'s overly restrictive ban on preissuance opposition.

1. *Even the Office's Prior Rule 99 Submission Procedure Arguably Violated § 122(c).* Rule 290 is merely the latest in a series of attempts by the Office to push the boundaries of § 122(c). The Office first chipped away at the statutory ban on preissuance opposition by establishing the Rule 99 third-party submissions procedure almost immediately after Congress enacted § 122(c). At that time, the Office argued that Rule 99 submissions did not violate § 122(c) because the submissions amounted to neither a protest nor an opposition.[154] However, even then the Office may have interpreted § 122(c) too narrowly for two reasons.

First, the Office argued that § 122(c)'s ban on "protest[s] or other form[s] of pre-issuance opposition"[155] applied only to "protest[s]" and "opposition[s]" as they are separately understood in the patent industry.[156] The Office defined an "opposition" narrowly as a complex, inter partes procedure similar to civil litigation in federal court.[157] However, § 122(c) explicitly bars any "protest or *other* form of pre-issuance opposition,"[158] indicating that protests are intended to be an *example* of preissuance opposition.[159] Because a protest allows only very limited third-party participation, it cannot be characterized

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improvement in patent quality is a generally acknowledged goal, this passage has not generated a great deal of controversy.").

153. *See id.*; Dylan M. Aste, *To Disclose or Not To Disclose: Why the United States Properly Adopted the European Model for Third-Party Participation During Patent Prosecution*, 3 CASE W. RES. J.L. TECH. & INTERNET 153, 181–85 (2012) (arguing that increased third-party participation in patent prosecution should result in fewer invalid patents, less litigation, and stronger patent applications).

154. *See supra* notes 70–88 and accompanying text.

155. 35 U.S.C. § 122(c) (2006).

156. *See supra* notes 70–88 and accompanying text.

157. *See supra* notes 72–74 and accompanying text.

158. 35 U.S.C. § 122(c) (emphasis added).

159. *See* 2A NORMAN J. SINGER & J.D. SHAMBIE SINGER, SUTHERLAND STATUES AND STATUTORY CONSTRUCTION § 47:17 (7th ed. 2007) ("Where general words follow specific words in a statutory enumeration, the general words are construed to embrace only objects similar in nature to those objects enumerated by the preceding specific words." (citations omitted)).

as a complex opposition procedure of the type described by the Office.[160] Therefore, § 122(c) should be interpreted to ban post-publication, preissuance protests *and other third-party antagonism that resembles a protest*. Especially because the format and language of Rule 99 strongly resemble those of Rule 291 protests,[161] it is possible that Rule 99 would have been invalid under this interpretation.

Second, the Office's argument that Rule 99 submissions were not antagonistic in nature because the "patents and publications [could have been] submitted for various reasons"[162] is unpersuasive. The Office postulated that "[i]ndividuals may wish to submit patents or publications to help the examiner understand the technology or the appropriate field of search."[163] Although there exist no available statistics on the use of Rule 99, there is indeed evidence supporting the prediction that some disinterested third parties are willing to track applications and submit prior art. For instance, in 2007, the Center for Patent Innovations at New York Law School began a two-year Peer To Patent pilot program, providing an Internet forum for third parties to discuss and collectively submit publications to select pending applications.[164] The pilot program attracted 2,800 participant reviewers, 686 of whom became "active" on the site.[165] Of those active reviewers, 108 identified their interest in participating as either "[p]ersonal," "[c]ontributing to the issuance of quality patents," or "[contributing] to patent reform."[166] While a plurality identified their interests as "[p]rofessional," only three active reviewers explicitly stated that they were primarily motivated by "[c]ompetitive interests."[167]

The success of the Peer To Patent pilot program demonstrated that some third parties are sufficiently motivated to monitor and engage new applications without a direct financial interest in the

160. For a description of the ex parte nature of protests, see *supra* notes 38–39 and accompanying text.

161. Baumeister, *supra* note 58, at 388.

162. Changes To Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. 57,024, 57,042 (Sept. 20, 2000) (codified as amended at 37 C.F.R. pt. 1).

163. *Id.*

164. CTR. FOR PATENT INNOVATIONS, N.Y. LAW SCH., PEER TO PATENT: FIRST PILOT FINAL RESULTS 4–5 (2012), *available at* http://dl.dropbox.com/u/2541719/First%20Pilot%20Final%20Results.pdf.

165. *Id.* at 24.

166. *Id.*

167. *Id.*

outcome. However, although many third parties will likely continue to participate using the now-effective Rule 290, it seems intuitive that financially interested parties will consititute a greater portion of the participants now that the procedure is permanent.[168] Also, even those submitters whose motivations are purely altruistic typically will be adverse to the applicant.[169] Because a patent confers upon its owner an economic monopoly, both competitors and the public at large benefit from, and are motivated to ensure, appropriately narrow patents.[170]

2. *The Inconsistent Application of § 122(c) To Ban Protests but Not Preissuance Submissions Is Unprincipled.* Although the Office arguably transgressed § 122(c) by adopting Rule 99, it firmly asserted at that time that a submission would violate that statute if the submission included any non-prior-art references or contained any explanation.[171] But in 2011, Congress tossed the Office into an impossible interpretive quagmire when it amended § 122(e) and allowed third-party submissions of *any* publications and accompanying descriptions of relevance.[172] Tasked with promulgating a rule that directly violated even its narrow interpretation of § 122(c), the Office was left splitting hairs in carving out Rule 290 preissuance submissions from the ban on protests. The Office directly addressed

168. The majority of the listed motivations of Peer To Patent active participants, including those most frequently self-reported ("Professional" and "Contributing to the issuance of quality patents"), *see id.*, are notably ambiguous regarding financial interest. Further, some less ambiguously altruistic interests ("Contribute to patent reform" and "Ensure long-term commitment from [the Office] for public participation"), *see id.*, are arguably less applicable now that the sought reform—the amendment to § 122(e) and a robust Rule 290—has been achieved. *See id.* at 33 (describing the then-pending legislation as a plausible means to reward only meritorious patents "as illustrated by the success of Peer To Patent").

169. Because "[a] person shall be entitled to a patent unless" the invention has been disclosed in the prior art, 35 U.S.C. § 102 (2006), there is virtually no submission of prior art that can aid an applicant in obtaining a patent for his originally filed claims. Even submissions that serve only to direct an examiner to the appropriate field of search will have played an antagonistic role if the examiner's search leads to invalidating prior art. There is one small exception, however. Prior art references that "teach away," or suggest that the claimed invention is impractical or implausible, may be used to rebut a prima facie showing that the invention is obvious. U.S. PATENT & TRADEMARK OFFICE, *supra* note 63, § 2145(X)(D).

170. Thomas Jefferson, administrator of the early U.S. patent system, viewed patent monopolies as an evil necessary to incentivize innovation. Graham v. John Deere Co., 383 U.S. 1, 7–11 (1966). Jefferson sought to ensure that only inventions that "were new and useful" received "the special inducement of a limited monopoly." *Id.* at 9.

171. *See supra* notes 82–88 and accompanying text.

172. Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 8, 125 Stat. 284, 315–16 (2011) (to be codified at 35 U.S.C. § 122(e)).

this issue during rulemaking with three main arguments in response to comments questioning the overlap between protests and Rule 290 submissions.[173]

First, the Office argued that, although Rule 290 was created pursuant to § 122(e), protests are "supported by a separate statutory provision, [§ 122(c)], which implies the availability of submitting a protest in an application prior to publication."[174] This argument is misleading because the Office invented the protest procedure in 1977,[175] long before § 122(c) was codified in 1999.[176] Thus, § 122(c) does not "support" protests, but rather it limits them to the pre-publication time period—just as it limits *any* other procedure that amounts to preissuance opposition, arguably including Rule 290.[177]

Second, the Office reasoned that unlike Rule 290 submissions, protests permit "the submission of information other than publications, including any facts or information adverse to patentability."[178] However, the Office's liberal interpretation of "printed publications" under Rule 290 minimizes this distinction between protests and submissions.[179] The Office suggested that Rule 290 submissions "could include litigation papers and court documents

173. *See* Changes To Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 42,150, 42,151 (July 17, 2012) (to be codified at 37 C.F.R. pt. 1).

174. *Id.*

175. *See* Patent Examining and Appeal Procedures, 42 Fed. Reg. 5588, 5589 (Jan. 28, 1977) (codified at 37 C.F.R. pt. 1) (establishing the protest).

176. American Inventors Protection Act of 1999, Pub. L. No. 106-113, tit. IV, 113 Stat. 1501, 1501A-552 (1999) (codified as amended at 35 U.S.C. § 122). Admittedly, § 122 does distinguish between protests and preissuance submissions by name, though it is silent on the material differences between them.

177. One could argue that § 122(e) preissuance submissions are also restricted by § 122(c), and therefore, that Congress intended those submissions be allowed only when the submitter had received the express consent of the applicant. *See* 35 U.S.C. § 122(c) (mandating that post-publication opposition is not allowed "without the express written consent of the applicant"). While this interpretation is not a strong one, § 122(c) probably would still prohibit a hypothetical opposition rulemaking that is only thinly veiled as pursuant to § 122(e). *See* Changes To Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,156 ("[Rule 290] should not be interpreted as permitting a third party to participate in the prosecution of an application, as [§ 122(c)] prohibits the initiation of a protest or other form of pre-issuance opposition . . . .").

178. Changes To Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,151. For example, one might submit a protest containing documents that are not publically available or were created solely to contest patentability.

179. *See supra* notes 130–34 and accompanying text.

not subject to a court-imposed protective or secrecy order."[180] Such an expansive definition of admissible "printed publications" allows a savvy third party to raise any objection to a pending application's patentability.[181] For example, one could submit a page of a dictionary if one believes a term in the application's claims is indefinite.[182] One could submit a copy of the landmark Federal Circuit case, *In re Wands*,[183] to suggest that the application's specification would not enable a person skilled in the art to use the invention.[184] Or, one could submit a patent examiner's rejection memo found in a similar application file[185] if one believed the instant application could be rejected on analogous grounds. Taken to the limits of what is acceptable, one could submit even relevant sections of either the MPEP[186] or the U.S. Code[187] pertaining to patent-validity requirements.

Also, the new rule *does* allow submissions of some information in addition to the information contained in the references. Rule 290 allows parties to submit "documents that are cumulative of each other" because "the *description of relevance may provide additional information* with respect to the document such that the submission [as a whole] is not cumulative of information already of record."[188]

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180. *See* Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,154.

181. Dennis Crouch & Jason Rantanen, *Pre-Issuance Submissions*, PATENTLY-O (Sept. 15, 2012, 10:30 PM), http://www.patentlyo.com/patent/2012/09/pre-issuance-submissions.html.

182. *See id.* Indefiniteness is grounds for claim rejection. *See* 35 U.S.C. § 112(b) (2006) ("The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.").

183. *In re* Wands, 858 F.2d 731 (Fed. Cir. 1988).

184. *See id.* at 737 (providing a litany of factors for courts and examiners to consider when deciding whether the application satisfies the enablement requirement). Insufficient enablement is another ground for rejection. *See* 35 U.S.C. § 112(a) (2006).

185. Correspondence between examiners and applicants, including examiner rejection memos, are published online at the Office's website in its "Patent Application Information Retrieval" database, the same location where the Office publishes new applications. *See* U.S. Patent & Trademark Office, U.S. Dep't of Commerce, *PAIR Resources*, USPTO.GOV, http://www.uspto.gov/patents/process/status/private_pair/index.jsp (last visited Aug. 3, 2013).

186. *See* U.S. PATENT & TRADEMARK OFFICE, *supra* note 63, §§ 2103–2190 (providing an examiner's guide to patentability rejections).

187. *See* 35 U.S.C. §§ 101–103, 112 (constituting the statutory bases underlying the many patent validity criteria).

188. Changes To Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 42,150, 42,154–55 (July 17, 2012) (to be codified at 37 C.F.R. § 1.290).

Therefore, if the same submitted publication can have a different impact on an application's patentability depending only on its description of relevance, then that description must carry at least some weight as substantive information.

Third and principally, the Office argued that protests are different from Rule 290 submissions because protests allow for arguments against patentability.[189] Rule 290 submissions, on the other hand, do not allow third parties to "propose rejections of the claims or set forth arguments."[190] Highlighting the distinction in the regulations, the Office noted that protests require a "concise *explanation* of the relevance" of submitted references whereas Rule 290 requires a "concise *description* of the asserted relevance."[191]

This relatively insignificant difference in regulatory language should not be relied upon as the divergence between the two procedures. In fact, the Office itself once supported this view; in its notice of proposed rulemaking for Rule 290,[192] the Office originally planned to amend the Rule 291 protest language "to change 'explanation' to 'description' to *conform* to proposed" Rule 290.[193] The Office proposed that such an amendment "would clarify that *there is no difference* between the concise description of relevance for a third-party preissuance submission and the concise description of relevance for a protest."[194] Only after comments suggested that this proposed amendment caused "some confusion" did the Office adopt its current position that the two are different.[195]

Despite its change of course with respect to the finalized formulation of Rule 290, the Office struggled to remain consistent in its distinction between an explanation and a description. For example, Rule 290 states that the concise description should "*explain* to the examiner the relevance of the document."[196] Additionally, the Office was not alone in conflating the words "description" and

189. *Id.* at 42,151.

190. *Id.* at 42,156.

191. *Id.* at 42,151 (emphases added).

192. Changes To Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 448 (proposed Jan. 5, 2012) (to be codified at 37 C.F.R. pt. 1).

193. *Id.* at 454 (emphasis added).

194. *Id.* (emphasis added).

195. Changes To Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,151.

196. *Id.* at 42,156.

"explanation." Reporting on the proposed 2007 Act, which similarly provided that third parties must "set forth a concise *description* of the asserted relevance of each submitted document,"[197] the Committee on the Judiciary wrote that each submitted document must "include an *explanation* of [its] relevance."[198] Clarifying further, the Committee Report stated, "[T]he submitter must *explain* how the reference pertains to the invention claimed in the published application."[199]

While defenders might consider the distinction in regulatory language between descriptions and explanations to be merely symbolic of underlying substantive differences, there are at least three reasons why Rule 290 submissions may amount to rejection proposals or other arguments against patentability. First, for example, consider the Office's suggestion that a description of relevance could include a claim chart mapping the submitted publication to specific claims in the application.[200] The Office cautioned that Rule 290 "is not an invitation . . . to propose rejections."[201] But if a third party submits a prior-art reference and connects it to a specific claim in the pending application, that party is, for all practical purposes, proposing a prior-art-based rejection of that claim.

Second, a concise description of relevance can function as an argument against patentability. As one federal judge interpreted the nearly identical proposed preissuance submission language in the 2005 Act, the procedure "giv[es] a chance for the person who submits the pre-issuance submission to give his or her *written argument* as to its relevance."[202] Further, the Office has recognized that "a third party might *assert* that a particular [submitted] document is prior art."[203] In fact, the Office *requires* that concise descriptions comprise more than mere highlights, annotations, or form paragraphs.[204] Thus, parties must describe with detail the relevance of each submitted document such that each description inevitably amounts to an argument.

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197. Patent Reform Act of 2007, H.R. 1908, 110th Cong. § 9 (2007) (emphasis added).

198. H.R. Rep. No.110-314, at 36–37 (2007) (emphasis added).

199. *Id.* (emphasis added).

200. *See* Changes To Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,156.

201. *Id.*

202. Robert M.M. Seto, *A Federal Judge's View of the Most Important Changes in Patent Law in Half-A-Century*, 11 J. TECH. L. & POL'Y 141, 175 (2006) (emphasis added).

203. Changes To Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. at 42,163 (emphasis added).

204. *See id.* at 42,164.

It follows that an argument as to a document's relevance to a pending application is equivalently an argument as to how the document bears on the application's patentability. Because any document that bears on patentability necessarily either supports or opposes the application, it is not difficult to extend the logical chain one link further and equate the submission and description as a whole with an indirect argument simply supporting or opposing patentability.

It is telling that the Office has not capped the acceptable length of a concise description[205] but has vaguely warned that those "approach[ing] the length of the [submitted publications] themselves will not likely be considered 'concise.'"[206] In fact, the statutory term "concise" has been rendered almost meaningless in at least one other area of administrative law. The Administrative Procedure Act[207] requires that agencies promulgating final rules—for example, the Office's Rule 290—"incorporate . . . a concise general statement of [the rules'] basis and purpose."[208] Despite the qualifier of "concise," the strict judicial doctrine of hard look review for agency rulemaking has led agencies to be "detailed and encyclopedic" in their statements, which sometimes reach hundreds of pages in length.[209] As an example, the Office's Rule 290 statement is composed of roughly 28,000 words.[210] Therefore, if third parties are similarly given substantial leeway with the length of their concise descriptions of relevance, they could provide detailed arguments to patent examiners.

Third, some newly permissible types of submitted publications may themselves include arguments of the sort prohibited in their accompanying descriptions of relevance. The Office largely anticipated this issue by warning against the submission of printed publications that were published solely to contest a particular patent

205. *See id.* ("[W]hile third parties should refrain from submitting verbose descriptions of relevance, . . . the Office has not established an upper limit on the size of a concise description at this time.").

206. *Id.* at 42,156.

207. Administrative Procedure Act, 5 U.S.C. §§ 551–559, 701–706 (2006).

208. *Id.* § 553(c).

209. Richard J. Pierce, Jr., *Rulemaking Ossification Is Real: A Response to* Testing the Ossification Thesis, 80 GEO. WASH. L. REV. 1493, 1500 (2012).

210. *See generally* Changes To Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 42,150.

application.[211] However, some publications falling outside the scope of that exception may contain relevant arguments and thus might be used strategically to that effect. For example, the patent-validity arguments in published litigation briefs or examiner rejection memos that address inventions similar to those under review might be applicable to the instant applications. Or, query the admissibility of a printed publication that was purportedly created for *multiple* purposes—for instance, a hypothetical publication that uses a pending application as a case study within a larger work lamenting poor claim drafting. The current rule leads to a strange result: the permissibility of argumentative publications depends only on the timing and purpose of publication.

B. Lifting the Ban Would Serve the Policy Objectives Underlying § 122(e) Without Causing Harassment or Delay to Applicants.

To be sure, significant differences remain between protests and preissuance submissions. While Rule 290 submissions may often rise to the level of argumentation and thus violate § 122(c), the submissions cannot be nearly as argumentative as protests. Pursuant to Rule 290, third parties must couch their arguments against patentability either as arguments as to the relevance of submitted publications or through other indirect and crafty means.[212] Once they have provided a statement of relevance, submitters must rely upon the examiner to independently derive direct arguments against patentability from each submission. Knowing that an issued patent is presumed to have overcome any prior art known to the examiner, many competitors may remain reluctant to submit anything,[213] especially when they are prohibited from providing their own direct arguments against patentability. Therefore, a legislative relaxation of this prohibition likely would better incentivize competitor

211. *Id.* at 42,163.

212. *See supra* Part II.A.2.

213. *See* Bezos, *supra* note 22, § 14:39 (noting that potential submitters may choose to avoid the risk of hampering future litigation by "gold plating" patent applications with their submissions); Timothy Bechen & Alison McGeary, *Changes in Pre-Grant and Post-Grant Challenges at the U.S. Patent Office (USPTO)*, WILLAMS MULLEN (Sept. 15, 2011), http://www.williamsmullen.com/news/changes-pre-grant-and-post-grant-challenges-us-patent-office-uspto ("While [Rule 290] increases the window for, and scope of, third party submissions during examination, issues remain as to whether it is advisable to prepare such submissions due to the deference that can be given to [the Office] examination and the potential prejudice to raising the same prior art in a later proceeding.").

participation, ultimately resulting in the Office's issuance of fewer invalid patents.

The policy goal motivating § 122(e) was the expansion of examiner awareness of prior art that otherwise would be known only to a select few.[214] Potential increases in disinterested party participation notwithstanding, the overarching drawback to Rule 99 from the perspective of competitors—that art submitted during prosecution could be used against submitters during later validity proceedings[215]—remains largely applicable to Rule 290. Accordingly, one commentator has predicted:

> [F]or all of the efforts to make the submission process more accessible to the public and increase the quality of examination through the citation of relevant art, the use of this process will likely be significantly limited. The risk of hampering future proceedings by essentially "gold plating" a patent that issues from an application subjected to the third-party submission process will likely detract many potential submitters, or at least make it unlikely that the best art will be cited.[216]

While these concerns about "gold plating" suggest that competitors might never choose to submit prior art regardless of any ability to submit direct arguments, these concerns should not be overstated. A gold plate is not an estoppel provision. The Federal Circuit emphasized this point in 2012 in *Sciele Pharma Inc. v. Lupin Ltd.*[217] The court held that during litigation, "there is no heightened or added burden that applies to invalidity defenses that are based upon references that were before the [Office]. The burden is always the same, clear and convincing evidence."[218] Instead, the court reasoned, "it may be harder to meet the . . . burden [using] the same argument on the same reference that the [Office] already considered."[219] The fact of whether evidence had been considered by the Office goes to the weight of that evidence during litigation.[220] However, district court judges are under no legal obligation to instruct juries that the burden

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214. *See supra* notes 114–18 and accompanying text.

215. *See supra* notes 92–98 and accompanying text.

216. Bezos, *supra* note 22, § 14:39.

217. Sciele Pharma Inc. v. Lupin Ltd., 684 F.3d 1253 (Fed. Cir. 2012).

218. *Id.* at 1260.

219. *Id.* Despite this heightened practical difficulty, the court resolved the case in the defendant's favor, finding that two prior art references that had been before the Office now "raised a substantial question of validity." *Id.* at 1261–62.

220. *Id.* at 1260.

may be more easily carried when challengers produce references that the Office did not consider.[221]

Contrast the relatively lax judicial prejudice against examiner-considered prior art in *Lupin* with the harsh estoppel provisions embedded within the Office's new post-grant review procedure.[222] Post-grant review, another creation of the AIA,[223] is a procedure by which third parties may challenge the validity of an issued patent within the nine months following its issuance.[224] Challengers may argue any grounds for invalidity and submit supporting patents, publications, and other relevant information to be considered by the Director.[225] If, based on the submitted evidence, the Director decides to institute a review and the Patent Trial and Appeal Board goes on to issue a final written decision, the challenger is estopped from challenging the same claims in future proceedings or litigation.[226] Thus, not only is the challenger estopped from reusing particular prior art references in later challenges, but that party, or any other party in privity with that party, is also prohibited from challenging the same claims "on any ground that the [challenger] raised or reasonably could have raised."[227] As the Federal Circuit in *Lupin* highlighted, no such estoppel surrounds prior art merely because it was previously considered by an examiner.[228]

Further moderating the futility concerns is evidence that some interested parties would be willing to submit prior art to pending applications even under the current rules. The Peer To Patent pilot program, like current Rule 290, allowed community members to review applications and submit prior art to examiners with annotations explaining the prior art's relevance.[229] While only three

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221. *See* Z4 Techs., Inc. v. Microsoft Corp., 507 F.3d 1340, 1354–55 (Fed. Cir. 2007) (holding that a jury instruction regarding the burden of proof on invalidity might lead to juror confusion).

222. *Compare Lupin*, 685 F.3d at 1260, *with* Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 6, 125 Stat. 284, 308 (2011) (to be codified at 35 U.S.C. § 325(e)).

223. Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 6, 125 Stat. at 305–11 (2011) (to be codified at 35 U.S.C. §§ 321–329).

224. *Id.* at 306 (to be codified at 35 U.S.C. § 321).

225. *Id.* at 306, 310 (to be codified at 35 U.S.C. §§ 321–322, 328).

226. *Id.* at 308 (to be codified at § 325(e)).

227. *Id.*

228. *See* Sciele Pharma Inc. v. Lupin Ltd., 684 F.3d 1253, 1260 (Fed. Cir. 2012) ("In short, there is no heightened or added burden that applies to invalidity defenses that are based upon references that were before the . . . Office.").

229. CTR. FOR PATENT INNOVATIONS, *supra* note 164, at 4–5. In compliance with § 122(c), the Peer To Patent pilot program acquired consent from participating applicants. *Id.* at 4.

"active reviewers" identified their interests in participating as "[c]ompetitive," 117 stated their interests were "[p]rofessional."[230] The top-submitting reviewer, for example, with "124 prior art contributions for 82 applications" over the course of the pilot, was a software developer working for IBM.[231]

Especially in light of the Peer To Patent pilot program's success,[232] it is reasonable to predict that allowing submitters to provide direct arguments against patentability would further incentivize participation. Because parties with competitive interests are in an excellent position to provide examiners with the most-relevant prior art, a boost in their participation would effectively carry out the policy goals of § 122(e).[233] Further, third parties' direct arguments against patentability could provide examiners with potentially strong suggestions that might otherwise be overlooked until the patent is challenged in court.[234]

Other commentators have previously argued that § 122(c) should be amended to provide third parties with greater opportunity to participate in prosecution.[235] Undoubtedly, Congress has been reluctant to take that measure because of widespread fears that third parties could then harass applicants or delay prosecution.[236] Some independent inventors have even expressed concern in the past that

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230. *Id.* at 24.

231. *Id.* at 30, 37.

232. *See id.* at 24 ("The number of active reviewers nearly doubled in the first two years of the pilot, going from 365 to 686.").

233. *See supra* notes 114–18 and accompanying text.

234. Even though examiners are experts in determining patent eligibility, the addition of a small adversarial element could help to ensure that time-strapped examiners consider all arguments bearing on patentability. Data recently released by the Office shows that the Office frequently reverses or adjusts examiner decisions postissuance when "ex parte reexaminations" are requested. *See* U.S. PATENT & TRADEMARK OFFICE, *EX PARTE* REEXAMINATION FILING DATA - JUNE 30, 2012 1–2, *available at* http://assets.sbnation.com/assets/1619547/Ex_parte_reexam_stats.pdf (providing data suggesting that only 22 percent of those patents that undergo reexamination emerge with all claims confirmed, and that 92 percent of all requests for reexamination are granted).

235. *See, e.g.*, Kesan, *supra* note 44, at 776–83 (noting that the issuance of patents with questionable validity "may be ameliorated by adopting an opposition proceeding into the patent examination process"); Christopher J. Worrel, *Improving the Patent System: Community Sourcing and Pre-Grant Opposition*, 42 U. TOL. L. REV. 833, 858 (2011) ("There is great support for utilizing third-party involvement to improve the patent examination process and the patent system's overall quality.").

236. *See* Kesan, *supra* note 44, at 783 ("Opponents of pre-grant oppositions are correct in asserting that pre-grant oppositions provide additional opportunities for delay and harassment.").

the now-codified preissuance submissions procedure would lead to the same disastrous results.[237] In balancing those concerns about § 122(e) preissuance submissions while nevertheless enacting the AIA, however, Congress resolved the issue in favor of greater public participation. Now, for multiple reasons, another incremental amendment permitting submitter arguments against patentability would not necessarily induce unfair hardship to applicants.

First, the presumption of validity for issued patents in light of their prosecution histories, though downplayed somewhat by the Federal Circuit,[238] would continue to moderate submission rates. Although competition-driven submitters would be better equipped to present their theories of invalidity, and thus would likely be more inclined to make submissions, they would still calculate the risk that the examiner might find their arguments unpersuasive.

Second, any opportunities for competitors to harass applicants under such an amendment largely exist already under Rule 290. The proposed amendment would not necessarily require examiners to respond to submissions or even consider them to any greater extent than required under the current rules.[239] Instead, the sole likely effect would be greater competitor confidence that their prior-art submissions would be applied to their full potential. Therefore, an amendment at this stage would have the greatest impact on those competitors with genuine bases for challenging the application, rather than on those who only wish to delay prosecution.

Third, according to the Office's justification for Rule 290, "Office rules already prohibit third parties from purposefully 'flooding' an application . . . to cause unnecessary delay."[240] Submitters are subject to 37 C.F.R. § 11.18(b)(2)(i),[241] which requires parties to certify that

237. *See* McEwen, *supra* note 152, at 72 n.126 ("[I]ndependent inventors have raised concerns that [the proposed § 122(e) amendment in the 2005 Act] would allow large corporations to 'endlessly contest' patent applications.").

238. *See supra* notes 217–21 and accompanying text.

239. Under Rule 290, examiners are merely required to acknowledge in the application record that they considered the submitted documents and their accompanying statements of relevance. *See* Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 42,150, 42,153 (July 17, 2012) (to be codified at 37 C.F.R. § 1.290) ("[E]xaminer consideration of a document and its accompanying concise description of relevance in a third-party submission does not mean that the examiner agrees with the third party's position regarding the document, only that the examiner considered the publication and its accompanying description.").

240. *Id.* at 42,162.

241. 37 C.F.R. § 11.18(b)(2)(i) (2012).

their submissions are "not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding."[242]

Finally, if Congress were to amend § 122(c) to prohibit only formal opposition procedures or any procedure likely to result in significant harassment or delay, for example, then the Office could impose specific measures to limit the likelihood that argument-containing submissions would be used for abusive ends.[243] For instance, to prevent harassment, the Office could limit the numbers of protests for each real party in interest.[244] Further, it could designate a more limited time window for submissions to be filed post publication. When an examiner rejects a claim, applicants are already granted the ability to subsequently amend their applications to work around the rejection and submit them to be reexamined.[245] To prevent delay and the prospect of endless contest, the Office could extend the submission time window only to the date of the first examiner rejection. This arrangement would balance the interests of patentees with those of competitors by ensuring that applicants have the opportunity to make narrowing amendments. In sum, it would be both feasible and preferable for Congress to relinquish its ax and allow the Office to wield a scalpel to specifically address harassment concerns.

CONCLUSION

An amendment to § 122(c) allowing the public to supplement their preissuance submissions with direct arguments against patentability would incentivize those submissions more effectively than the current scheme. As a result, the amendment would better carry out the long-held policy objective of the United States Patent and Trademark Office, harnessing the collective power of the public to afford greater resources to examiners in making important patentability determinations. Such a change in policy could have the

242. *Id.*

243. *See* Kesan, *supra* note 44, at 783 ("[Harassment] concerns can be addressed by procedural devices used to address similar concerns in any litigation or adjudication.").

244. *Id.*

245. *See* 35 U.S.C. § 132(a) (2006) ("[I]f after receiving [a notice of rejection], the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined.").

impact of reducing the number of invalid patents without substantially increasing the risk of harassment and delay.

From the significant breadth of Rule 290, it appears that the Office believes that increased public participation in patent examination is sound policy. However, Rule 290 and its underlying organic provision, § 122(e), are in irreconcilable tension with § 122(c)'s proscriptions. Although § 122(c) broadly prohibits all pre-grant protests and any other forms of opposition, Rule 290 submissions and protests are strikingly similar, and, in any case, Rule 290 effectively serves as a vehicle for third parties to oppose pending applications.

Congress, therefore, should end the metaphorical game of Taboo and amend § 122(c) in a manner that both relieves the legal tension and allows third parties to fully explain their submissions. Congress should delegate responsibility to the Office to promulgate targeted rules to ensure that preissuance submissions with accompanying arguments are not abused.