

# Third-Party Preissuance Submission under 37 CFR 1.290

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### **I. Introduction**

Under 35 U.S.C. 122(e), a third party is permitted to submit patents, published patent applications or printed publications along with a concise description of the relevance of each document to the Office for consideration during the examination of a patent application. This provision applies to any patent application filed before, on, or after September 16, 2012.

Third-Party Submissions must be made (1) before the later of (i) 6 months after the date the application is first published by the Office, or (ii) the date of a first Office action on the merits rejecting any claim, and (2) before the date a notice of allowance is given or mailed.

A Third-Party Submission may be made in any non-provisional utility, design, or plant application, including any continuing application. The application may be pending or abandoned and need not be published. Third-Party Submissions are not permitted in reissue applications and reexamination proceedings.

The resource page for Third-Party Submissions is located at:

[http://www.uspto.gov/aia\\_implementation/patents.sp#heading-7](http://www.uspto.gov/aia_implementation/patents.sp#heading-7)

### **II. Requirements**

A Third-Party Submission must include:

- (1) Form PTO/SB/429 (or equivalent document list), identifying the publications, or portions of publications, being submitted in accordance with § 1.290(e);
- (2) A concise description of the asserted relevance of each item identified in the document list;
- (3) A legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications;
- (4) An English language translation of any non-English language item identified in the document list;
- (5) Statements by the party making the submission that:
  - (i) The party is not an individual who has a duty to disclose information with respect to the application under § 1.56; and
  - (ii) The submission complies with the requirements of 35 U.S.C. 122(e) and § 1.290; and
- (6) Any required fee, or the § 1.290(g) statement that the fee exemption applies to the submission.

Third-Party Submissions will be reviewed for compliance with 35 U.S.C. 122(e) and § 1.290 before being entered into the image file wrapper (IFW) record of an application. If a Third-Party Submission is found to be non-compliant, no time period will be set to file a corrected Third-Party Submission and amendments to a non-compliant submission previously filed will not be accepted. Instead, the third party may file another complete submission, provided the time period for doing so has not closed.

## (1) Document List (PTO/SB/429)

Detailed field-by-field instructions for completing the form PTO/SB/429 are listed below. Use form PTO/SB/429 **for paper submissions only**. Do not submit form PTO/SB/429 electronically via EFS-Web. The Office has developed a dedicated Web-based interface to permit electronic filing of Third-Party Submissions located at <http://www.uspto.gov/patents/process/file/efs/index.jsp>. A completed form PTO/SB/429 will be automatically generated for electronic submissions.

### Third-Party Submission under 37 CFR 1.290 Header:

Application Number	Enter the U.S. application number (i.e., the series code and serial number) to which the Third-Party Submission is directed, for example 99/999,999.
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### U.S. Patents and U.S. Patent Application Publications:

Cite No.	Enter a citation number, increment by one for each subsequent citation.
Document Number	Enter the 7-digit U.S. Patent Number, for example 9,999,999, or 11-digit U.S. Patent Application Publication Number, for example YYYY/9999999. If known, enter the kind of U.S. Patent or U.S. Patent Application Publication by the appropriate symbols indicated on the document under WIPO Standard ST. 16. See the attached <a href="#">WIPO ST.16 Table</a> .
Issue Date or Publication Date	Enter the issue date of the U.S. Patent or the publication date of the U.S. Patent Application Publication.
First Named Inventor	Enter the first and last name of the first named inventor of the U.S. Patent or U.S. Patent Application Publication.

### Foreign Patents and Published Foreign Patent Applications:

Cite No.	Enter a citation number, increment by one for each subsequent citation.
Country or Patent Office and Document Number	<ul style="list-style-type: none"><li>Enter the country or patent office that issued the Foreign Patent or published the Foreign Patent Application by two-letter country code under WIPO Standard ST.3. See the attached <a href="#">WIPO ST.3 Table</a> for the correct 2-digit code.</li><li>Enter the document number of the Foreign Patent or Published Foreign Patent Application. For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.</li><li>If known, enter the kind of Foreign Patent or Published Foreign Patent Application by the appropriate symbols indicated on the document under WIPO Standard ST.16. See the attached <a href="#">WIPO ST.16 Table</a>.</li></ul>
Publication Date	Enter the publication date of the Foreign Patent or Published Foreign Patent Application.
Applicant, Patentee or First Named Inventor	Enter the name of the applicant, patentee or first named inventor of the Foreign Patent or Published Foreign Patent Application.
Translation Attached	Check the box if an English language translation of the Foreign Patent or Published Foreign Patent Application is attached to the Third-Party Submission.

**Non-Patent Publications (e.g., journal article, Office action):**

Cite No.	Enter a citation number, increment by one for each subsequent citation.
Author (if any), title of the publication, page(s) being submitted, publication date, publisher (where available), place of publication (where available)	Enter the author (if any), title of the publication, page(s) being submitted, publication date, publisher (where available), and place of publication (where available) for the Non-Patent Publication. For publications obtained from the Internet, the uniform resource locator (URL) of the Web page that is the source of the publication must be provided for the place of publication (e.g., "http://www.uspto.gov"). Additional information not specified above (e.g., journal title and volume/issue information for a journal article) may be provided. Where the actual publication date is not known, provide a date of retrieval or a time frame (e.g., a year, a month and year, a certain period of time) when the document was available as a publication, in addition to attaching evidence that establishes the document as a publication.
Translation Attached	Check the box if an English language translation of the Non-Patent Publication is attached to the Third-Party Submission.
Evidence Attached	Check the box if evidence of publication is attached to the Third-Party Submission. A Third-Party Submission must either include items that are <i>prima facie</i> publications, or evidence that establishes that they are publications. Such evidence may be in the form of, for example, affidavits, declarations, a printout from a Web site, or any other appropriate format.

**Statements:**

The party making the submission is not an individual who has a duty to disclose information with respect to the above-identified application under 37 CFR 1.56.	Required statement under § 1.290(d)(5)(i).
The submission complies with the requirements of 35 U.S.C. 122(e) and 37 CFR 1.290.	Required statement under § 1.290(d)(5)(ii).
The following fee set forth in 37 CFR 1.290(f) has been submitted herewith:	Select this box if a fee is due for the Third-Party Submission.
Regular Undiscounted	Select this box if the party making the submission is not asserting small entity status.
Small Entity	Select this box if the party making the submission asserts that the party qualifies as a small entity. A third party is not eligible for the micro entity discount.
The fee set forth in 37 CFR 1.290(f) is not required because this submission lists three or fewer total items and, to the knowledge of the person signing the statement after making reasonable inquiry, this submission is the first and the only submission under 35 U.S.C. 122(e) filed in the above-identified application by the party making the submission or by a party in privity with the party.	Select this box if the fee exemption pursuant to § 1.290(g) applies to the Third-Party Submission.

**Signature:**

Signature	The Third-Party Submissions is required to be signed. Enter the signature of the individual submitting the Third-Party Submission. The submitter of the Third-Party Submission will be identified but a real party in interest need not be identified.
Date	Enter the date of submission of the Third-Party Submission.
Name (Printed/Typed)	Print/type the name of the submitter.
Reg. No., if applicable	Enter the Registration Number of the U.S. Patent Practitioner who is submitting the Third-Party Submission, if applicable.
Examiner Signature/Date Considered	Examiner's signature will indicate that all items listed have been considered, except for citations through which a line is drawn. A copy of this form will be included with the next communication to applicant.

## **(2) Concise Description of Relevance**

A Third-Party Submission must include a concise description of relevance for each item identified in the document list. The concise description of relevance is a statement of facts explaining how the document is of potential relevance to the examination of the application. A concise description of relevance is not an invitation for the third party to participate in the prosecution of the application. The concise description must not include arguments against patentability or set forth conclusions regarding whether one or more claims are patentable, and must not include proposed rejections of the claims or arguments relating to an Office action or an applicant's reply in the application. Provide the concise description of relevance for each item listed as a separate paper clearly labeled as to which item in the document list it pertains. Do not combine concise descriptions for different documents in a single paper.

## **(3) Copies**

A Third-Party Submission must include a legible copy of each item identified in the document list, other than U.S. Patents and U.S. Patent Application Publications. Where only a portion of a document is listed as an item in the document list, only submit a copy of that portion and not a copy of the entire document, and also submit copies of pages of the document that provide identifying information (e.g., a copy of the cover, title page, copyright information page, etc.).

## **(4) Translations**

A Third-Party Submission must include an English language translation of any non-English language item identified in the document list. The translation should be clearly labeled as to which item in the document list it pertains. The translation may be a reliable machine translation and need not be certified. Where only a portion of a non-English language document is listed, only submit a translation of that portion and not a translation of the entire document.

## **(5) Statements**

A Third-Party Submission must include a statement that (i) the party making the submission is not an individual who has a duty to disclose information with respect to the application under § 1.56, and (ii) the submission complies with the requirements of 35 U.S.C. 122(e) and § 1.290. Form PTO/SB/429 includes both statements.

## **(6) Fees**

The regular undiscounted fee for a Third-Party Submission is currently \$180 for every 10 documents listed or fraction thereof, as set forth in 37 CFR 1.290(f) and 37 CFR 1.17(o). If the party making the submission qualifies as a **small entity** (e.g., a person, a small business, or a nonprofit organization), the fee is reduced by half. Consult the current fee schedule at: <http://www.uspto.gov/about/offices/cfo/finance/fees.jsp>.

No fee is required if the *first* submission by a third party in an application lists 3 or fewer items, and is accompanied by the statement set forth in 37 CFR 1.290(g) (select the appropriate check box on form PTO/SB/429).

Note that the appropriate fee for the number of documents being submitted (e.g., \$180 for 1-10 documents) is due upon any resubmission after a finding of non-compliance, including any resubmission of 3 or fewer documents in an application where the third party's first submission of 3 or fewer documents in the application took advantage of the fee exemption.

The fee may be paid by check, money order, credit card or deposit account. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. Use the Credit Card Payment Form (PTO-2038) located at: <http://www.uspto.gov/web/forms/2038.pdf> when paying by credit card. Credit Card Payment Form (PTO-2038) will not be included among the records open to public inspection in the patent file. To protect credit card information, form PTO-2038 must not be submitted electronically through EFS-Web.

### **III. Request for Notice of Non-compliance**

A third-party may request e-mail notification in the event the submission is found to be non-compliant. To request such notification, file a separate paper with the Third-Party Submission clearly titled “REQUEST FOR NOTIFICATION OF NON-COMPLIANT THIRD-PARTY PREISSUANCE SUBMISSION” and indicate the e-mail address to which the notification should be directed.

### **IV. Filing**

Third-Party Submissions may be submitted in paper via first-class mail, United States Postal Service (USPS) Express Mail service pursuant to § 1.10, or delivery by hand. Facsimile transmission of Third-Party Submissions is not permitted. Include a self-addressed postcard with the Third-Party Submission to receive acknowledgment of receipt by return receipt postcard.

The mailing address for Third-Party Submissions submitted in paper via first-class mail or USPS Express Mail service is:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

The delivery address for Third-Party Submissions submitted via hand-delivery is:

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

A Third-Party Submission is filed on its date of receipt in the Office as set forth in § 1.6. The certificate of mailing provisions of § 1.8 do *not* apply to Third-Party Submissions; however, the USPS Express Mail service provisions of § 1.10 do apply to Third-Party Submissions.

### **Additional Information**

Telephone: 1-855-HELP-AIA

E-mail: [HELP@USPTO.GOV](mailto:HELP@USPTO.GOV)

## WIPO ST.3 Table (Country/Organization Codes)

LIST OF STATES, OTHER ENTITIES AND INTERGOVERNMENTAL ORGANIZATIONS, IN ALPHABETIC SEQUENCE OF THEIR SHORT NAMES, AND THEIR CORRESPONDING CODES (as of March 22, 2007)

AFGHANISTAN	AF
AFRICAN INTELLECTUAL PROPERTY ORGANIZATION <sup>(1)</sup> (OAPI)	OA
AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANIZATION <sup>(1)</sup> (ARIPO)	AP
ALBANIA	AL
ALGERIA	DZ
ANDORRA	AD
ANGOLA	AO
ANGUILLA	AI
ANTIGUA AND BARBUDA	AG
ARGENTINA	AR
ARMENIA	AM
ARUBA	AW
AUSTRALIA	AU
AUSTRIA	AT
AZERBAIJAN	AZ
BAHAMAS	BS
BAHRAIN	BH
BANGLADESH	BD
BARBADOS	BB
BELARUS	BY
BELGIUM	BE
BELIZE	BZ
BENELUX OFFICE FOR INTELLECTUAL PROPERTY (BOIP) <sup>(2)</sup>	BX
BENIN	BJ
BERMUDA	BM
BHUTAN	BT
BOLIVIA	BO
BOSNIA AND HERZEGOVINA	BA
BOTSWANA	BW
BOUVENT ISLAND	BV
BRAZIL	BR
BRUNEI DARUSSALAM	BN
BULGARIA	BG
BURKINA FASO	BF
BURUNDI	BI
CAMBODIA	KH
CAMEROON	CM
CANADA	CA
CAPE VERDE ...	CV
CAYMAN ISLANDS	KY
CENTRAL AFRICAN REPUBLIC	CF
CHAD	TD
CHILE	CL
CHINA	CN
COMMUNITY PLANT VARIETY OFFICE (EUROPEAN COMMUNITY) (CPVO)	QZ
COLOMBIA	CO
COMOROS	KM
CONGO (see Congo, below; Democratic Republic of the Congo)	

CONGO	CG
COOK ISLANDS.	CK
COSTA RICA	CR
CÔTE D'IVOIRE	CI
CROATIA	HR
CUBA	CU
CYPRUS	CY
CZECH REPUBLIC	CZ
DEMOCRATIC PEOPLE'S REPUBLIC OF KOREA	KP
DEMOCRATIC REPUBLIC OF THE CONGO	CD
DENMARK	DK
DJIBOUTI	DJ
DOMINICA ...	DM
DOMINICAN REPUBLIC	DO
ECUADOR	EC
EGYPT	EG
EL SALVADOR	SV
EQUATORIAL GUINEA	GQ
ERITREA	ER
ESTONIA	EE
ETHIOPIA	ET
EURASIAN PATENT ORGANIZATION <sup>(1)</sup> (EAPO)	EA
EUROPEAN COMMUNITY TRADE MARK OFFICE (See Office for Harmonization in the Internal Market)	
EUROPEAN PATENT OFFICE <sup>(1)</sup> (EPO)	EP
FALKLAND ISLANDS (MALVINAS)	FK
FAROE ISLANDS	FO
FIJI	FJ
FINLAND	FI
FRANCE	FR
GABON	GA
GAMBIA	GM
GEORGIA	GE
GERMANY <sup>(3)</sup>	DE
GHANA	GH
GIBRALTAR	GI
GREECE	GR
GREENLAND ...	GL
GRENADE ...	GD
GUATEMALA ...	GT
GUERNSEY.	GG
GUINEA	GN
GUINEA-BISSAU	GW
GULF COOPERATION COUNCIL (see Patent Office of the Cooperation Council for the Arab States of the Gulf)	
GUYANA	GY
HAITI	HT
HOLY SEE ...	VA
HONDURAS	HN
HONG KONG (See The Hong Kong Special Administrative Region of the	

People's Republic of China)	
HUNGARY	HU
ICELAND	IS
INDIA	IN
INDONESIA	ID
INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO) <sup>(4)</sup>	IB, WO
IRAN, ISLAMIC REPUBLIC OF	IR
IRAQ	IQ
IRELAND	IE
ISLE OF MAN	IM
ISRAEL	IL
ITALY	IT
JAMAICA	JM
JAPAN	JP
JERSEY	JE
JORDAN	JO
KAZAKHSTAN	KZ
KENYA	KE
KIRIBATI	KI
KOREA (see Democratic People's Republic of Korea; Republic of Korea)	
KUWAIT	KW
KYRGYZSTAN	KG
LAO PEOPLE'S DEMOCRATIC REPUBLIC	LA
LATVIA	LV
LEBANON	LB
LESOTHO	LS
LIBERIA	LR
LIBYAN ARAB JAMAHIRIYA	LY
LIECHTENSTEIN	LI
LITHUANIA	LT
LUXEMBOURG	LU
MACAO	MO
MACEDONIA (see The former Yugoslav Republic of Macedonia)	
MADAGASCAR	MG
MALAWI	MW
MALAYSIA ...	MY
MALDIVES ...	MV
MALI	ML
MALTA	MT
MAURITANIA	MR
MAURITIUS	MU
MEXICO	MX
MOLDOVA (see Republic of Moldova)	
MONACO	MC
MONGOLIA	MN
MONTENEGRO.	ME
MONTSERRAT	MS
MOROCCO	MA
MOZAMBIQUE	MZ
MYANMAR	MM
NAMIBIA	NA
NAURU	NR
NEPAL	NP
NETHERLANDS.	NL
NETHERLANDS ANTILLES	AN
NEW ZEALAND	NZ
NICARAGUA	NI

NIGER	NE
NIGERIA	NG
NORDIC PATENT INSTITUTE (NPI)	XN
NORTHERN MARIANA ISLANDS	MP
NORWAY	NO
OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS AND DESIGNS) (OHIM)	EM
OMAN	OM
PAKISTAN ...	PK
PALAU	PW
PANAMA	PA
PAPUA NEW GUINEA	PG
PARAGUAY	PY
PATENT OFFICE OF THE COOPERATION COUNCIL FOR THE ARAB STATES OF THE GULF (GCC)	GC
PERU	PE
PHILIPPINES ...	PH
POLAND	PL
PORTUGAL	PT
QATAR	QA
REPUBLIC OF KOREA	KR
REPUBLIC OF MOLDOVA	MD
ROMANIA	RO
RUSSIAN FEDERATION	RU
RWANDA	RW
SAINT HELENA	SH
SAINT KITTS AND NEVIS ...	KN
SAINT LUCIA ...	LC
SAINT VINCENT AND THE GRENADINES	VC
SAMOA	WS
SAN MARINO	SM
SAO TOME AND PRINCIPE	ST
SAUDI ARABIA	SA
SENEGAL	SN
SERBIA	RS
SEYCHELLES	SC
SIERRA LEONE	SL
SINGAPORE	SG
SLOVAKIA ...	SK
SLOVENIA ...	SI
SOLOMON ISLANDS	SB
SOMALIA	SO
SOUTH AFRICA	ZA
SOUTH GEORGIA AND THE SOUTH SANDWICH ISLANDS	GS
SPAIN	ES
SRI LANKA	LK
SUDAN	SD
SURINAME	SR
SWAZILAND	SZ
SWEDEN	SE
SWITZERLAND	CH
SYRIAN ARAB REPUBLIC	SY
TAIWAN, PROVINCE OF CHINA	TW
TAJIKISTAN	TJ
TANZANIA (see United Republic of Tanzania)	
THAILAND ...	TH
THE FORMER YUGOSLAV REPUBLIC OF MACEDONIA	MK

THE HONG KONG SPECIAL ADMINISTRATIVE REGION OF THE PEOPLE'S REPUBLIC OF CHINA	HK
TIMOR-LESTE	TL
TOGO	TG
TONGA	TO
TRINIDAD AND TOBAGO	TT
TUNISIA	TN
TURKEY	TR
TURKMENISTAN	TM
TURKS AND CAICOS ISLANDS	TC
TUVALU	TV
UGANDA	UG
UKRAINE	UA
UNITED ARAB EMIRATES	AE
UNITED KINGDOM	GB
UNITED REPUBLIC OF TANZANIA	TZ

UNITED STATES OF AMERICA	US
URUGUAY ...	UY
UZBEKISTAN ...	UZ
VANUATU ...	VU
VATICAN CITY STATE (See Holy See)	
VENEZUELA	VE
VIET NAM	VN
VIRGIN ISLANDS, BRITISH	VG
WESTERN SAHARA <sup>(5)</sup>	EH
WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO) <sup>(4)</sup> (INTERNATIONAL BUREAU OF)	WO, IB
YEMEN	YE
ZAMBIA	ZM
ZIMBABWE	ZW

(1) Intergovernmental organizations (regional patent offices) acting for certain Contracting States under the PCT (Patent Cooperation Treaty). In case of the European Patent Office, it also acts as International Searching Authority and International Preliminary Examining Authority under the PCT.

(2) The Benelux Office for Intellectual Property (BOIP) (former Benelux Trademark and Designs Offices) have replaced the national Offices of Belgium, Luxembourg and the Netherlands with regard to actions relating to marks and industrial designs.

(3) In the electronic database of the International Register of Marks, the International Bureau of WIPO uses the following additional codes, not part of the active codes of Standard ST.3: "DD" to designate Germany without the territory that, prior to October 3, 1990, constituted the Federal Republic of Germany; "DT" to designate Germany without the territory that, prior to October 3, 1990, constituted the German Democratic Republic.

(4) The code "WO" is used in relation to the international publication under the Patent Cooperation Treaty (PCT) of international applications filed with any PCT receiving Office, as well as in the publication of international deposits of industrial designs under the Hague Agreement Concerning the International Deposit of Industrial Designs. In this regard, reference is made to INID code (33) given in WIPO Standards [ST.9](#) and [ST.80](#). The code "WO" is also the appropriate code to be used with respect to international registrations of marks under the Madrid Agreement and the Madrid Protocol Concerning the International Registration of Marks. The code "IB" is used in relation to the receipt of international applications under the PCT filed with the International Bureau of WIPO in its capacity as a PCT receiving Office.

(5) Provisional name.

(6) Code BF adopted in 1984..

(7) Code CD adopted in 1997.

(8) Code MM adopted in 1989.

(9) Code TL adopted on May 20, 2002.

(10) Code SY used before 1.1.1978.

(11) Code DL used before 1.1.1978.

(12) Subsequent to the country name change of "Yugoslavia" to "Serbia and Montenegro", that took effect on February 4, 2003, and to the decision by the ISO 3166/MA to use the new country name and new two-letter code "CS" (to replace "YU"), which was announced on July 23, 2003, the SCIT Standards and Documentation Working Group agreed, at its fifth session, in November 11, 2004, to recommend that the two-letter code "YU" continue to be used for "Serbia and Montenegro" in the industrial property field because code "CS" raised certain problems due to its former use to represent "Czechoslovakia" until 1993.

## WIPO ST.16 Table (Kind Codes)

Summary of USPTO Kind Codes Used on Documents Published Beginning January 2, 2001		
WIPO ST.16 Kind Codes	Kind of document	Comments
A1	Patent Application Publication	Pre-grant publication available March 2001
A2	Patent Application Publication (Republication)	Pre-grant publication available March 2001
A9	Patent Application Publication (Corrected Publication)	Pre-grant publication available March 2001
B1	Patent	No previously published pre-grant publication
B2	Patent	Having a previously published pre-grant publication and available March 2001
C1, C2, C3...	Reexamination Certificate	Previously used codes B1 and B2 are now used for granted Patents
E	Reissue Patent	No change
H	Statutory Invention Registration (SIR)	No change
P1	Plant Patent Application Publication	Pre-grant publication available March 2001
P2	Plant Patent	No previously published pre-grant publication
P3	Plant Patent	Having a previously published pre-grant publication and available March 2001
P4	Plant Patent Application Publication (Republication)	Pre-grant publication available after March 2001
P9	Plant Patent Application Publication (Corrected Publication)	Pre-grant publication available March 2001
S	Design Patent	No change