

## AUTHORS

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## RELATED PRACTICES

Patent Prosecution and  
Counseling

Patent Litigation

AIA *Inter Partes* Litigation

## ARCHIVES

2012 2008 2004

2011 2007 2003

2010 2006 2002

2009 2005

## Articles

August 15, 2012

### USPTO Issues Final Rules: Citation of Prior Art and Written Statements in a Patent File

On September 16, 2012, final rules issued by the U.S. Patent and Trademark Office (the rules) that implement provisions of the Leahy-Smith America Invents Act related to citation of prior art and written statements in a patent file become effective. The rules modify existing practice by allowing any person to file a written submission directed to (1) prior art consisting of patents or printed publications that the person making the submission believes to have a bearing on the patentability of any claim of the patent; or (2) statements of the patent owner filed by the patent owner in a proceeding before a federal court or the USPTO in which a patent owner took a position on the scope of any claim of the patent.

Any submission relating to statements of the patent owner must include any other documents, pleadings or evidence from the proceeding in which the statement was filed that address the written statement. Further, the submission must also include the forum and proceeding in which the patent owner filed each statement, the specific papers and portions of the papers that contain the statements, and how each statement submitted is one in which the patent owner took a position on the scope of any claim in the patent. The other documents, pleadings or evidence must be submitted in redacted form to exclude information subject to a protective order.

Any submission directed to prior art must include an explanation in writing of the pertinence and manner of applying the prior art to at least one claim of the patent. If the submission also includes a patent owner's written statement, the submission must include an explanation in writing of the pertinence and manner of applying the written statement to at least one patent claim. These explanations are required for the submission to become a part of the patent file.

The rules include several other aspects. For example, in submissions made by a patent owner, the owner may include an explanation of how the claims differ from any of the submitted prior art or the submitted written statements and accompanying information. A person may anonymously submit the submission. Any submission made by a person other than the patent owner must include a certification that a copy of the submission was served upon the patent owner or the submission will not be entered into the patent file.