

**“Tipping Your Hand”
Considerations Before Filing Rule 99 Submissions**

by

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With the implementation of the American Inventor’s Protection Act of 1999, the U.S. Patent and Trademark Office (“PTO”) began routinely publishing patent applications eighteen months after the filing date. This significant change in U.S. patent law resulted in many related PTO rule changes. One of these new rules, 37 C.F.R. §1.99 (“Rule 99”), allows a member of the public to submit patents or publications relevant to the pending published application to the PTO. The primary benefit to a third party filing a submission under Rule 99 is that more relevant art is made available to the Examiner. This may result in additional anticipation or obviousness claim rejections and may force the applicant to make claim amendments or estoppel-creating arguments. Rule 99 does, however, have a number of limitations and implications which should be considered before filing a submission.

- 1) **No Explanation Allowed** A submission under Rule 99 may not include any explanation of the patents or publications. Therefore, the third party filing the submission must evaluate whether the Examiner will be able to independently recognize the significance of the art and apply it properly. This prohibition on explanations includes a complete restriction on any markings such as underlining or highlighting. The Rule does, however, permit redacted versions of the patents and publications which contain only the most relevant portions. A patent attorney submitting such a redacted version must remain mindful of his/her obligations under Rule 10.85 which prohibits knowingly concealing information or making a false statement.

- 2) **Presumption of Validity** The Examiner may enter the cited documents into the application file but will not necessarily thoroughly review the art. Once the patent issues, it will enjoy a strong presumption of validity over the cited art. Strategically, it may be better to use the documents in an *inter partes* reexamination, in an interference, or in litigation where the significance of the documents may be fully explained.

- 3) **Service of Applicant** Rule 99 requires that the submission be served upon the patent applicant. Thus, the member of the public loses anonymity and attracts the attention of the competitor.

4) **Quantity Limit** Subpart (d) of Rule 99 limits a submission to “ten total patents or publications.” The Rule and the corresponding provisions of the M.P.E.P. would appear to allow circumvention of this rule by filing multiple submissions (and the corresponding fee).

5) **Patents and Publications Only** A Rule 99 submission is limited to patents and publications, and thus, affidavits and declarations are not allowed.

6) **Two Month Time Limit** A submission under Rule 99 must be filed within two months from the date of publication of the application or prior to mailing the notice of allowance, whichever is earlier. Although not specifically required under Rule 99, Examiners have been known to forward submissions filed after the two month period to the applicant. This notice then places a burden on the applicant to file an information disclosure statement under 37 C.F.R. §1.97.

In conclusion, the use of Rule 99 prior art submissions results in more information being considered by the Patent Office and hence the issuance of “better” patents. This serves the public interest. But it may not necessarily benefit the third party submitter, should a patent issue, when it comes to challenging the validity of the patent in subsequent proceedings.