PATENT QUALITY: WHAT WOULD A ZERO-BASED PATENTING PARADIGM LOOK LIKE?

File, Examine and Issue Patents in One Year
Leverage Applicant Disclosures to Optimize Quality/Productivity

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Zero-Based Patenting: One-Year Examination Paradigm

Provisional Patent Filing

Foreign Priority Patent Filing

Grace Period: Technical Journal Publication

Encourage use of a one-year provisional-grace-priority period in before the definitive patent filing triggering the 20-year term.

Option to treat as provisional filing.

Nonprovisional [NP] Patent Filing

NP Filing Must Be Accompanied by an IDS


Patent issues unless application abandoned within 1 month after all claims allowed.

PTAB Appeal Process ca. 3 months

§ 257 SE-type reexam then declared

At 3-years, pending claims issue if rejected claims remain.

Maximun pendency is 3 years – no PTA – 17-year patent life guarantee.

3-Year RCE limit; no Divisional, CIP, or Other Continuing Applications.

Every NP Application Published Upon Filing

2 months to first action

2 months applicant response

2 months to final action

2 months to final response

Provisional filing fees credited against NP appl. fee

Single Filing-Search-Examination-Issue Fee for Each Independent Claim

Zero-Based Patenting: One-Year Examination Paradigm

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§ 1.56 Disclosure of Information to the Office.

(a) REQUIREMENTS WITH RESPECT TO DISCLOSURES.—

(1) IN GENERAL.—An individual submitting information in a matter before the Office must not—

(A) falsify, conceal, or cover up by any trick, scheme, or device a material fact;

(B) make any materially false, fictitious, or fraudulent statement or representation; or

(C) make or use any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry.

(2) MATERIALITY; RELEVANT PRIOR ART.—

(A) RELEVANCE TO AN EXAMINED CLAIM REQUIRED FOR MATERIALITY.—Information or its misrepresentation is not material to the examination of an application for patent unless the information or its misrepresentation is relevant to the patentability of a claim being examined in the application.

(B) RELEVANT PRIOR ART.—An item of prior art that has not previously been considered by the Office during examination of an application is relevant to the patentability of a claim in the application if, taking account any prior art that may already be under consideration by the Office, consideration of the item not previously disclosed would allow the Office to reject the claim as unpatentable on a new ground that could not have been raised without a citation to such item.

(C) MATERIALITY LIMITATION.—Notwithstanding subparagraph (B), information or its misrepresentation is not material to the patentability of a claim in an application if, were such claim to be patented on the application, the claim would not be invalid.

(b) ITEMS OF PRIOR ART NOT TO BE DISCLOSED.—

(1) IN GENERAL.—An individual who submits one or more items of prior art to the Office in connection with the examination of a patent application must limit such a submission of prior art to items for which such individual has a good faith belief that each submitted item is possibly relevant to the patentability of at least one claim being examined in the application.

(2) POSSIBLE RELEVANCE.—An individual item of prior art is of possible relevance to the patentability of a claim under paragraph (1) if a reasonable possibility exists that such item could qualify as relevant to patentability, as set out under subparagraph (a)(2)(B).

(3) SAFE HARBORS.—

(A) NO VIOLATION OF PROHIBITION.—A submitter's disclosure of an item of prior art shall be deemed not to violate the prohibition on disclosures under paragraph (1) if the submitter's disclosure of such item is accompanied by a concise statement setting forth the submitter's belief as to the item's content that is of possible relevance to the examination of the application in which it is disclosed.

(B) REPRESENTATIONS AS TO CONTENT AND POSSIBLE RELEVANCE.—No representation by a submitter that is made in the manner described under subparagraph (A) may be cited in support of a contention that a disclosure requirement under subsection (a) has been violated.

(C) NO ADMISSION OF RELEVANCE.—No statement made under subparagraph (A) may be cited by the Office or the courts as an admission that an item is material in fact to patentability or otherwise of any relevance in fact to patentability, including as an admission that such item could be relied upon by the Office in support of a rejection of any claim being examined in the application.

(d) EFFECTS OF INFORMATION DISCLOSURE.—

(1) CONSIDERATION BY THE OFFICE.—For the purposes of this section, no item of prior art shall be deemed to have been considered by the Office in determining the patentability of the claims in an application unless such item was—

(A) relied upon by the Office in support of a rejection of at least one claim in the application;

(B) submitted in the application, by or on behalf of the applicant, together with a concise statement accurately identifying the content of the item that is possibly relevant to patentability; or

(C) submitted to the Office by a third party in connection with the application in a preissuance submission meeting the requirements under 35 U.S.C. § 122(e).

(2) OTHER PROCEEDINGS.—In determining the validity of a patent in a proceeding in which the patent is presumed to be valid, only prior art deemed under paragraph (1) to have been considered by the Office in the application on which the patent issued shall be regarded as having been before the Office in the examination of the patent.
Rule 56(a) bars material omissions and misrepresentations using the same framework as 18 U.S.C. § 1001(a).

Possible relevance requires that reasonable likelihood that item of prior art could qualify as relevant.

3-Pt Materiality Standard: (1) Must be relevant to an examined claim, (2) relevance of prior art to a claim requires ability to cite in support of a new ground of rejection, and (3) no materiality to a claim unless the claim, if patented, would be invalid.

Rule 56(b) bars the disclosure of item of prior art absent good faith believe of possible relevance to an examined claim.

1st Safe Harbor – No Rule 56(b) violation for a prior art item accompanied by concise description of submitter’s good faith belief as to content of possible relevance.

2nd Safe Harbor – No Rule 56(a) violation a representation made under the 1st Safe Harbor.

3rd Safe Harbor – Representation under 1st Safe Harbor cannot be cited by the USPTO or courts as material to patentability or otherwise relevant to patentability—or could be relied upon to support a claim rejection.

Rule 56(d) (1) – Prior art not deemed considered by the USPTO unless (1) submitted by applicant under 1st Safe Harbor, (2) cited in support of a rejection, or (3) filed under 35 U.S.C. § 122(e).

Rule 56(d)(2) – Only Rule 56(d)(1) prior art to be regarded as before the USPTO in assessing presumptively valid patents.

Rule 56(c) – Affirmative statement required as to existence of relevant prior art.

Rule 56(b)(3) – Three Safe Harbors
A Zero-Based Patenting Paradigm Would:

Enact greater incentives to utilize provisional filings—nonprovisional fee credit, immediate publication of nonprovisional filings upon filing, and immediate IDS obligation upon nonprovisional filing; permit certain “grace period” publications to provide the priority (and require NP filing at the end of the 1-year “grace period”).

Create a one-year pendency goal, start-to-finish—one filing, one comprehensive fee due at NP filing (per independent claim), one examination, one patent issuance—and no divisional, CIP, or other continuing applications permitted.

Provide a 3-year maximum pendency—if necessary, issue patents with rejected claims into a § 257 SE-type reexaminations. Allow early post-grant review initiation.

Rationalize applicant disclosure obligations—incentives to limit what information is disclosed and to vastly improve the content of information that is disclosed.