

NEW EMAIL ALERT SYSTEM ALLOWS FOR PATENT PUBLICATION MONITORING

Intellectual Property & Technology Alert
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On April 24, 2014, the United States Patent & Trademark Office (USPTO) announced the release of the Patent Application Alert Service (the Service).

The Service provides free, customized email alerts when U.S. patent applications are published. Additionally, the Service offers direct access to the published applications for convenient review.

How the Service Works

An account must be created in order to use the Service. Like most websites, creating an account requires an email address and a password. The Service only sends alert emails to the provided email address.

The Service scans newly published U.S. patent applications for text matching alerts associated with your account. Alerts can be set based on text in the title, abstract, specification, and claims in each published application. Alerts can also be set based on applicant name, inventor name, and assignee. Additionally, alerts can be set based on the published application's class (e.g., F16P 1/06 for safety devices designed for welding).

The USPTO publishes applications every Thursday. Therefore, the Service will perform searches and send alert emails once a week, often within minutes of the applications being made public.

The alerts set for each account are private. They can only be accessed by logging into the Service.

Pre-Issuance Submissions

The USPTO allows, under certain circumstances, third parties to submit patents, publications, and other written documents that are relevant to a pending application. The USPTO hopes that the Service will prompt additional pre-issuance submissions and therefore enhance the quality of examination and issued patents.

The timing requirements for pre-issuance submissions can be summarized as follows:

- a submission must be made before the **earlier of**:

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- a **notice of allowance**; or
- the **later of**:
 - **6 months** after the publication date; or
 - **date of the first rejection** of any claim by the examiner during examination.

Submissions must include a concise description of the asserted relevance of each submitted document. The concise description of relevance does not permit a third party to participate in prosecution.

Therefore, while a concise description may include claim charts (i.e., mapping various portions of a submitted document to different claim elements), one cannot propose rejections or submit arguments relating to an office action or an applicant's reply to an office action.

The USPTO requires a \$180 fee for every ten items submitted. However, no fee is required for three or fewer items when accompanied by a statement that the submission is the first and only submission filed by that party. There is also no requirement to identify "a real party in interest." That means a submission can be anonymous.

An English language translation must be provided for all relevant portions of any listed non-English language document to be considered by the examiner.

Monitoring Competitors, Keywords, Classes, and Inventors

We expect the Service will be used for much more than pre-issuance submissions.

We expect companies will use the Service to monitor competitors' applications as well as applications from key inventors in strategic market segments. We also expect that companies will use the Service to monitor specific technologies.

We can help you manage and set alerts for your business needs. If you have questions, please contact any of the attorneys listed in the sidebar.