

# Chapter 1900 Protest

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## 1901 Protest Under 37 CFR 1.291 [R-3]

37 CFR 1.291. *Protests by the public against pending applications.*

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(a) A protest may be filed by a member of the public against a pending application, and it will be matched with the application file if it adequately identifies the patent application. A protest submitted within the time frame of paragraph (b) of this section, which is not matched in a timely manner to permit review by the examiner during prosecution, due to inadequate identification, may not be entered and may be returned to the protestor where practical, or, if return is not practical, discarded.

(b) The protest will be entered into the record of the application if, in addition to complying with paragraph (c) of this section, the protest has been served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and, except for paragraph (b)(1) of this section, the protest was filed prior to the date the application was published under § 1.211, or a notice of allowance under § 1.311 was mailed, whichever occurs first:

(1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is matched with the application in time to permit review during prosecution.

(2) A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with paragraph (c)(5) of this section. This section does not apply to the first protest filed in an application.

(c) In addition to compliance with paragraphs (a) and (b) of this section, a protest must include:

(1) A listing of the patents, publication, or other information relied upon;

(2) A concise explanation of the relevance of each item listed pursuant to paragraph (c)(1) of this section;

(3) A copy of each listed patent, publication, or other item of information in written form, or at least the pertinent portions thereof;

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information relied upon; and

(5) If it is a second or subsequent protest by the same party in interest, an explanation as to why the issue(s) raised in the second or subsequent protest are significantly different than those raised earlier and why the significantly different issue(s) were not presented earlier, and a processing fee under § 1.17(i) must be submitted.

(d) A member of the public filing a protest in an application under this section will not receive any communication from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgement by the Office that the protest has been received. The limited involvement of the member of the public filing a protest pursuant to this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, unless the submission is made pursuant to paragraph (c)(5) of this section.

(e) Where a protest raising inequitable conduct issues satisfies the provisions of this section for entry, it will be entered into the application file, generally without comment on the inequitable conduct issues raised in it.

(f) In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a protest.

(g) Protests that fail to comply with paragraphs (b) or (c) of this section may not be entered, and if not entered, will be returned to the protestor, or discarded, at the option of the Office.<

37 CFR 1.248. *Service of papers; manner of service; proof of service; proof of service in cases other than interferences.*

(a) Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:

(1) By delivering a copy of the paper to the person served;

(2) By leaving a copy at the usual place of business of the person served with someone in his employment;

(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;

(4) Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service;

(5) Whenever it shall be satisfactorily shown to the \* > Director< that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the *Official Gazette*.

(b) Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service, proof of service shall also include the name of

any person served, certified by the person who made service. Proof of service may be made by:

(1) An acknowledgement of service by or on behalf of the person served or

(2) A statement signed by the attorney or agent containing the information required by this section.

(c) \*\* >See § 41.106(e) of this title for service of papers in contested cases before the Board of Patent Appeals and Interferences<.

The degree of participation allowed a protestor is solely within the discretion of the \*\* >Director of the USPTO<.

37 CFR 1.291 \* gives recognition to the value of written protests in bringing information to the attention of the Office and in avoiding the issuance of invalid patents. \* >With the exception of a protest accompanied by a written consent of the applicant, all< protests must be submitted prior to the publication of the application or the mailing of a notice of allowance, whichever occurs first\*\*>. No< protest or other form of preissuance opposition to the grant of a patent may be initiated after publication of the application without the applicant's express written consent as specified by 35 U.S.C. 122(c).

\*\* >It is noted that a protest filed in a reissue application is not a "form of preissuance opposition to the grant of a patent" since the patent to be reissued has already been granted. Thus, a protest may be filed in a reissue application throughout the pendency of the reissue application prior to the date of mailing of a notice of allowance subject to the timing constraints of the examination. A protest with regard to a reissue application should, however, be filed within the 2-month period following the announcement of the filing of the reissue application in the *Official Gazette*. See MPEP § 1441.01 for guidance as to the filing of a protest in a reissue application.

37 CFR 1.291(b) provides that a protest will be entered into the record of the application if, in addition to complying with the requirements of 37 CFR 1.291(c), the protest is either served upon the applicant, or is filed in duplicate in the event service is not possible. In the event a duplicate protest is enclosed for the applicant, the protest should be accompanied by an explanation of why service on applicant could not be made.

37 CFR 1.291(c) requires that the protest must include:<

(A) a listing of the patents, publications, or other information relied on;

(B) a concise explanation of the relevance of each listed item;

(C) a copy of each listed patent, publication, or other item of information in written form, or at least the pertinent portions thereof; \*

(D) an English language translation of all necessary and pertinent parts of any non-English language \*\* >patent, publication, or other information relied upon; and

(E) if the protest is a second or subsequent protest by the same real party in interest, the protest must further include:

(1) an explanation as to why the issue(s) being raised in the second or subsequent protest are significantly different than those raised earlier;

(2) an explanation as to why the significantly different issue(s) were not presented to the Office earlier; and

(3) the processing fee under 37 CFR 1.17(i).

Note that item (E) above does not apply if the protest is accompanied by a statement that it is the first protest submitted in the application by the real party in interest, or if the protest is the first protest ever to be filed in the application. 37 CFR 1.291(b)(2).<

A party obtaining knowledge of an application pending in the Office may file a protest against the application and may therein call attention to any facts within protestor's knowledge which, in >the< protestor's opinion, would make the grant of a patent \*\* >on the application improper. The party should include with the protest whatever information the party is aware of that would facilitate identification of the application and matching the protest with the application. If there is insufficient information to identify the application, the protest may not be matched at all or not timely matched with the intended application to permit review by the examiner during prosecution of the application, in which case, the protest may not be entered and may be returned to the protestor where practical. If return is not practical, the protest will be discarded. 37 CFR 1.291(a). See MPEP § 1901.03.<

A protestor does not,\* by the mere filing of a protest, obtain the "right" to argue the protest before the

Office. Active participation by a protestor \*ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, \*\* >unless the submission is made pursuant to 37 CFR 1.291(c)(5). See 37 CFR 1.291(d).< The USPTO will acknowledge the receipt of a protest in an original or a reissue application file >,< only if a self-addressed postcard is included with the protest (see MPEP § 1901.05). The question of whether or not a patent will issue is a matter between the applicant and the Office acting on behalf of the public.

### 1901.01 Who Can Protest [R-3]

Any member of the public, including private persons, corporate entities, and government agencies, may file a protest under 37 CFR 1.291. A protest may be filed by an attorney or other representative on behalf of an unnamed \*\* >real party in interest. 37 CFR 1.291 does not require that the real party in interest be identified. Where a protest is not the first protest by the real party in interest, 37 CFR 1.291(b)(2) requires compliance with 37 CFR 1.291(c)(5). The requirements of 37 CFR 1.291(c)(5) cannot be avoided by multiple protests submitted by different people representing the same real party in interest.<

### 1901.02 Information Which Can Be Relied on in Protest [R-3]

Any information which, in the protestor's opinion, would make the grant of a patent improper can be relied on in a protest under 37 CFR 1.291\*. While prior art documents, such as patents and publications, are most often the types of information relied on in protests, 37 CFR 1.291\* is not limited to prior art documents. Protests may be based on any facts or information adverse to patentability. The content and substance of the protest are more important than whether prior art documents, or some other form of evidence adverse to patentability, are being relied on. The Office recognizes that when evidence other than prior art documents is relied on, problems may arise as to authentication and the probative value to assign to such evidence. However, the fact that such problems may arise, and have to be resolved, does not preclude the Office from considering such evidence, nor does it mean that such evidence cannot be relied on in

a protest under 37 CFR 1.291. Information in a protest should be set forth in the manner required by 37 CFR 1.291(\*>c<).

The following are examples of the kinds of information, in addition to prior art documents, which can be relied on in a protest under 37 CFR 1.291\*:

(A) Information demonstrating that the invention was publicly “known or used by others in this country... before the invention thereof by the applicant for patent” and is therefore barred under 35 U.S.C. 102(a) and/or 103.

(B) Information that the invention was “in public use or on sale in this country, more than 1 year prior to the date of the application for patent in the United States” (35 U.S.C. 102(b)).

(C) Information that the applicant “has abandoned the invention” (35 U.S.C. 102(c)) or “did not himself invent the subject matter sought to be patented” (35 U.S.C. 102(f)).

(D) Information relating to inventorship under 35 U.S.C. 102(g).

(E) Information relating to sufficiency of disclosure or failure to disclose best mode, under 35 U.S.C. 112.

(F) Any other information demonstrating that the application lacks compliance with the statutory requirements for patentability.

(G) Information indicating “fraud” or “violation of the duty of disclosure” under 37 CFR 1.56 may be the subject of a protest under 37 CFR 1.291\*. Protests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues. 37 CFR 1.291(\*>e<).

Different forms of evidence may accompany, or be submitted as a part of, a protest under 37 CFR 1.291\*. Conventional prior art documents such as patents and publications are the most common form of evidence. However, other forms of evidence can likewise be submitted. Some representative examples of other forms of evidence are litigation-related materials such as complaints, answers, depositions, answers to interrogatories, exhibits, transcripts of hearings or trials, court orders and opinions, stipulations of the parties, etc. Where only a portion of the litigation-related materials is relevant to the protest, protestors are encouraged to submit only the relevant portion(s).

In a protest based on an alleged public use or sale by, or on behalf of, the applicant or applicant's assignee, evidence of such public use or sale may be submitted along with affidavits or declarations identifying the source(s) of the evidence and explaining its relevance and meaning. Such evidence might include documents containing offers for sale by applicant or applicant's assignee, orders, invoices, receipts, delivery schedules, etc. The Office will make a decision as to whether or not public use or sale has been established based on the evidence the Office has available. If applicant denies the authenticity of the documents and/or evidence, or if the alleged public use and/or sale is by a party other than applicant or applicant's assignee, protestor may find it desirable or necessary to proceed via 37 CFR 1.292 (public use proceedings) rather than by a protest under 37 CFR 1.291.

While the forms in which evidence and/or information may be submitted with, or as a part of, a protest under 37 CFR 1.291\*, are not limited, protestors must recognize that such submissions may encounter problems such as establishing authenticity and/or the probative value to apply to the evidence. Obviously, the Office will have to evaluate each item of evidence and/or information submitted with a view as to both its authenticity and what weight to give thereto.

Information which is subject to a court-imposed protective or secrecy order may be submitted with, or as a part of, a protest under 37 CFR 1.291\*. Trade secret information which was obtained by a protestor through agreements with others can likewise be submitted. Such information, if submitted, will be treated in accordance with the guidelines set forth in MPEP § 724 and will be made public if a reasonable examiner would consider the information important in deciding whether to allow the application to issue as a patent.

### 1901.03 How Protest Is Submitted [R-3]

A protest under 37 CFR 1.291\* must be submitted in writing, must specifically identify the application to which the protest is directed by application number or serial number and filing date, and must include a listing of all patents, publications, or other information relied on; a concise explanation of the relevance of each listed item; an English language translation of all relevant parts of any non-English language \* >patent, publication, or other information relied upon<; and be

accompanied by a copy of each patent, publication, or other document relied on. Protestors are encouraged to use form \*\* >PTO/SB/08A and 08B< “Information Disclosure Statement >By Applicant<” (or an equivalent form) when preparing a protest under 37 CFR 1.291, especially the listing enumerated under 37 CFR 1.291(\*>c<)(1). See MPEP § \* >609.04(a)<. In addition, the protest and any accompanying papers must either (1) reflect that a copy of the same has been served upon the applicant or upon the applicant's attorney or agent of record; or (2) be filed with the Office in duplicate in the event service is not possible.

It is important that any protest against a pending application specifically identify the application to which the protest is directed with the identification being as complete as possible. If possible, the following information should be placed on the protest:

- (A) Name of Applicant(s).
- (B) Application number (mandatory).
- (C) Filing date of application.
- (D) Title of invention.
- (E) Group art unit number (if known).
- (F) Name of examiner to whom the application is assigned (if known).
- (G) Current status and location of application (if known).
- (H) The word “ATTENTION:” followed by the area of the Office to which the protest is directed as set forth below.

In addition to the above information, the protest itself should be clearly identified as a “PROTEST UNDER 37 CFR 1.291\*.” If the protest includes exhibits or other attachments, these should also contain identifying information thereon in order to prevent them from becoming inadvertently separated and lost.

Any protest can be submitted by mail to the \* Commissioner for Patents, \*\* >P.O. Box 1450, Alexandria, VA 22313-1450<, and should be directed to the attention of the Director of the particular Technology Center in which the application is pending. If the protestor is unable to specifically identify the application to which the protest is directed, but, nevertheless, believes such an application to be pending, the protest should be directed to the attention of the Office of Petitions >(using Mail Stop Petition)<, along with as much identifying data for the application as possible.

Protests which do not adequately identify a pending patent application will be returned to the protestor >or discarded,< and will not be further considered by the Office.

Where a protest is directed to a reissue application for a patent which is involved in litigation, the outside envelope and the top right-hand portion of the protest should be marked with the words "REISSUE LITIGATION." The notations preferably should be written in a bright color with a felt point marker. Any "REISSUE LITIGATION" protest mailed to the Office should be so marked and mailed to \*\* >Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.<

### **INITIAL PROTEST SUBMISSION MUST BE COMPLETE**

A protest must be complete and contain a copy of every document relied on by >the< protestor, whether the document is a prior art document, court litigation material, affidavit, or declaration, etc., because a protestor will *not* be given an opportunity to supplement or complete any protest which is incomplete. Active participation by protestor ends with the filing of the initial protest, as provided in 37 CFR 1.291(\*>d<), and no further submission on behalf of protestor will be acknowledged or considered, \*\* >unless the submission is made pursuant to 37 CFR 1.291(c)(5). 37 CFR 1.291(c)(5) requires that any further submission by the same party in interest must be directed to significantly different issue(s) than those raised in the earlier protest. 37 CFR 1.291(c)(5) requires (A) an explanation as to how the issue(s) raised are significantly different, (B) why the different issue(s) were not presented in the earlier protest, and (C) the processing fee under 37 CFR 1.17(i). Submissions< which will not be entered in the application file include \* further submissions in violation of 37 CFR 1.291\* by which protestor merely seeks to participate in the examination process. For example, mere arguments relating to an Office action or an applicant's reply would not qualify as a new protest. Likewise, additional comments seeking to bring in further or even new data or information with respect to an issue previously raised by protestor would not qualify as a new protest. The Office will not add these arguments or comments to the original protest and will not enter them in the application file.

Even new protests which also argue Office actions or replies or any matter beyond the new issue should not be accepted. Improper protests will be returned \*\* >to the protestor, or discarded, at the option of the Office. 37 CFR 1.291(g)<. While improper protests will be returned >or discarded<, a new protest by an earlier protestor will be proper and can be entered if it \*\* >complies with 37 CFR 1.291(c)(5)<.

As indicated in 37 CFR 1.291(\*>c<)(3), a protest must be accompanied by a copy of each prior art document relied on in order to ensure consideration by the examiner, although a protest without copies of prior art documents will not necessarily be ignored. While a protest without copies of documents will not necessarily be ignored, the submission of such documents with the protest will obviously expedite \*\* consideration of the documents, which consideration might not otherwise occur. Further, some documents which are available to protestor may not be otherwise available to the Office.

Every effort should be made by a protestor to serve a copy of the protest upon the attorney or agent of record or upon the applicant if no attorney or agent is of record. Of course, the copy served upon applicant or upon applicant's attorney or agent should be a complete copy including a copy of each prior art or other document relied on in the same manner as required by 37 CFR 1.291\*>(c)(3)< for the Office copy. The protest filed in the Office should reflect, by an appropriate "Certificate of Service," that service has been made as provided in 37 CFR 1.291(\*>b<). Only in those instances where service is not possible should the protest be filed in duplicate in order that the Office can attempt service.

### **1901.04 When Should the Protest Be Submitted [R-3]**

\* >Except where a protest is accompanied by the written consent of the applicant as provided in 37 CFR 1.291(b)(1), a< protest under 37 CFR 1.291(a) must be submitted prior to the date the application was published >under 37 CFR 1.211< or the mailing of a notice of allowance under 37 CFR 1.311, whichever occurs first, and the application must be pending when the protest and application file are brought before the examiner in order to be ensured of consideration. As a practical matter, any protest should be submitted as soon as possible after the protestor

becomes aware of the existence of the application to which the protest is to be directed. By submitting a protest early in the examination process, i.e., before the Office acts on the application if possible, the protestor ensures that the protest will receive maximum consideration and will be of the most benefit to the Office in its examination of the application. A protest submitted after the mailing of the notice of allowance will not knowingly be ignored if the protest includes prior art documents which clearly anticipate or clearly render obvious one or more claims. However, the likelihood of consideration of a protest decreases as the patent date approaches.

A protest filed after final rejection and complying with all the requirements of 37 CFR 1.291\* will be considered if the application is still pending when the protest and application are provided to the examiner. However, prosecution will not ordinarily be reopened after final rejection if the prior art cited in the protest is merely cumulative of the prior art cited in the final rejection. \*\*

A protest filed in a reissue application is not a “form of preissuance opposition to the grant of a patent” since the patent to be reissued has already been granted. Thus, a protest may be filed in a reissue application throughout the pendency of the reissue application prior to the date of mailing of a notice of allowance subject to the timing constraint of the examination. A protest with regard to a reissue application should, however, be filed within the 2-month period following announcement of the filing of the reissue application in the *Official Gazette*. See MPEP § 1441.01. If, for some reason, the protest of the reissue application cannot be filed within the 2-month period provided by MPEP § 1441, the protest can be submitted at a later time, but the protestor must be aware that reissue applications are “special” and a later filed protest may be received after action by the examiner. Any request by a protestor in a reissue application for an extension of the 2-month period following the announcement in the *Official Gazette*, and a delay of the examination until the extended period expires, will be considered only if filed in the form of a petition under 37 CFR 1.182 and accompanied by the petition fee set forth in 37 CFR

1.17(f). The petition under 37 CFR 1.182 and the petition fee must be filed prior to the expiration of the 2-month period provided by MPEP § 1441. The petition must explain why the additional time is necessary and the nature of the protest intended. A copy of such petition must be served upon applicant in accordance with 37 CFR 1.248. The petition should be directed to the appropriate Technology Center (TC) which will forward the petition to the Office of Patent Legal Administration for decision. Any such petition will be critically reviewed as to demonstrated need before being granted since the delay of examination of a reissue application of another party is being requested. Accordingly, the requests should be made only where necessary, for the minimum period required, and with a justification establishing the necessity for the extension.

Where a protest of a reissue application is submitted after the 2-month period, no petition for entry of the protest under 37 CFR 1.182 is needed with respect to the protest being submitted after the 2 months, unless a final rejection has been issued or prosecution on the merits has been closed for the reissue application. See MPEP § 1441.01. In situations where a final rejection has been issued, or prosecution on the merits has been otherwise closed, a petition under 37 CFR 1.182 along with the petition fee under 37 CFR 1.17(f) must be submitted with the protest. The petition must include an explanation as to why the additional time was necessary and identify the nature of the protest submitted. A copy of the petition must be served upon the applicant in accordance with 37 CFR 1.248. The petition should be directed to the Office of Petitions.

If the protest is a “REISSUE LITIGATION” protest, it is particularly important that it be filed early if protestor wishes it considered at the time the Office first acts on the application. Protestors should be aware that the Office will entertain petitions from reissue applicants under 37 CFR 1.182 \*\* to waive the 2-month delay period of MPEP § 1441 in appropriate circumstances. Accordingly, protestors to reissue applications cannot automatically assume that the full 2-month delay period of MPEP § 1441 will always be available. \*\*

## 1901.05 Initial Office Handling and Acknowledgment of Protest [R-3]

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### I. < PROTESTS REFERRED TO EXAMINER

Protests filed against pending applications will be referred to the examiner having charge of the application involved. 37 CFR 1.291(a). A protest specifically identifying the application to which it is directed will be entered in the application file, if (\*>A<) the protest is >accompanied by a written consent of the applicant or is< submitted prior to the publication of the application >under 37 CFR 1.211< or the mailing of a notice of allowance under 37 CFR 1.311, whichever occurs first, (see MPEP § 1901.04) \*\* >, (B)< a copy >of the protest< has been served on applicant in accordance with 37 CFR 1.248, or a duplicate copy is filed with the Office in the event service is not possible >, and (C) the protest complies with the content requirements of 37 CFR 1.291(c)<. 37 CFR 1.291(\*>b<).

A protest where the application is specifically identified, which is submitted in conformance with 37 CFR 1.291(a)\*\*>, (b), and (c)<, will be considered by the Office >if the protest is matched with the application in time to permit review by the examiner during prosecution<.

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### II. < PROTEST DOES NOT INDICATE SERVICE

If the protest filed in the Office does not, however, indicate service on applicant or applicant's attorney or agent, and is not filed in duplicate, then the Office \* >may< undertake to determine whether or not service has been made by contacting applicant or applicant's attorney or agent by telephone or in writing to ascertain if service has been made. If service has not been made and no duplicate has been filed, then the Office may request protestor to file such a duplicate before the protest is referred to the examiner. Alternatively, if the protest involves only a few pages, the Office may, in its sole discretion, elect to reproduce the protest rather than delay referring it to the examiner. If duplicate protest papers are mailed to applicant or applicant's attorney or agent by the Office, the application

file should reflect that fact, either by a letter transmitting the protest or, if no transmittal letter is used, simply by an appropriate notation in the "Contents" section of the application file \* >history<.

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### III. < ACKNOWLEDGMENT OF PROTEST

A protestor in an original or reissue application will not receive any communications from the Office relating to the protest, or to the application, other than the return of a self-addressed postcard which protestor may include with the protest in order to receive an acknowledgment that the protest has been received by the Office. 37 CFR 1.291(\*>d<). \*>Where a self-addressed postcard is included with the protest, the< Office will acknowledge a protest by return of the self-addressed postcard prior to the protest's entry into the application file or return to the protestor, as appropriate. >Thus, it is to be noted that the receipt of the self-addressed postcard from the Office is not an indication that the protest complies with 37 CFR 1.291.<

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### IV. < APPLICATIONS AND STATUS THERE-OF MAINTAINED IN CONFIDENCE

The postcard acknowledging receipt of a protest in other than a reissue application will not and must not indicate whether such application in fact exists or the status of any such application. Office employees must exercise care to ensure that matters relating to applications are *not* discussed with protestor or communicated in writing to protestor. Original applications are, of course, required by 35 U.S.C. 122 to be kept in confidence unless published pursuant to 35 U.S.C. 122(b) >or are available to the public pursuant to 37 CFR 1.14(a)(1)(iv), (v), or (vi)<. Thus, unless a protestor has been granted access to an original application, the protestor is not entitled to obtain from the Office any information concerning the same, including the mere fact that such an application exists. Petitions for access to patent applications with the exception of applications involved in or related to a proceeding before the Board of Patent Appeals or Interferences are decided by the Office of Petitions pursuant to delegation contained in MPEP § 1002.02(b). Reissue applications filed on, or after, March 1, 1977 are pursuant to 37 CFR 1.11(b) "open

to inspection by the \* public.” After an application is published pursuant to 35 U.S.C. 122(b), >the application file contents become available to the public over the Internet through the Office’s public Patent Application Information Retrieval (PAIR) website. In addition, < a copy of the file \* >content< of the published application may be requested by filing a written request under 37 CFR 1.14\*(a)(1)< including the fee as set forth in 37 CFR 1.19(b)\*.

The Office will communicate with the applicant regarding any protest entered in an application file and may require the applicant to supply information pursuant to 37 CFR 1.291(\*>f<), including replies to specific questions raised by the protest, in order for the Office to decide any issues raised thereby. Under 37 CFR 1.291(\*>f<), the examiner can require the applicant to reply to the protest and answer specific questions raised by the protest.

### 1901.06 Examiner Treatment of Protest [R-3]

Office practice as defined in 37 CFR 1.291(a) gives recognition to the value of the written protests in avoiding the issuance of invalid patents. However, the fact that one or more protests has been filed in an application, whether the application is an original application or a reissue application, does not relieve the examiner from conducting a *normal* examination on the merits, including the required search. Evidence submitted in a protest will be considered on the same basis as other *ex parte* evidence. *In re Reuter*, 651 F.2d 751, 758, 210 USPQ 249, 255 (CCPA 1981).

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#### I. < INITIAL REVIEW

An examiner initially receiving a protest will immediately review the same for the following:

(A) To ensure that either the protest or the application file \* indicates that a copy of the protest has been served on applicant or applicant’s attorney or agent. If a copy is not indicated as having been served on applicant or applicant’s attorney and is not filed in duplicate, then the examiner should undertake to determine whether or not service has been made by contacting applicant or applicant’s attorney or agent, but *not* >the< protestor. If it has, this should be noted on the protest or on the application file. If service has

not been made, the protest and application file should be brought to the attention of the TC Director for appropriate action. See MPEP § 1901.05.

(B) A protest raising issues of “fraud,” “inequitable conduct,” or “violation of duty of disclosure” will be entered in the application file, generally without comments on those issues.

If a protest is filed in a reissue application and the reissue application is related to a patent involved in a pending interference proceeding, such application should be referred to the Office of Patent Legal Administration before considering the protest and acting on the applications.

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#### II. < PERIOD FOR COMMENTS BY APPLICANT

If the primary examiner’s initial review reveals that the protest is ready for consideration during the examination, the examiner may nevertheless consider it desirable, or necessary, to obtain applicant’s comments on the protest before further action. In such situations, the examiner will offer applicant an opportunity to file comments within a set period, usually 1 month, unless circumstances warrant a longer period.

Form paragraph 19.01 can be used to offer applicant an opportunity to file comments on the protest.

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##### ¶ 19.01 Period for Comments on Protest by Applicant

A protest against issuance of a patent based upon this application has been filed under 37 CFR 1.291(a) on [1], and a copy [2]. Any comments or reply applicant desires to file before consideration of the protest must be filed by [3].

##### Examiner Note:

1. Applicant is normally given one month to submit any comments, unless circumstances in the case would warrant a longer period.
2. A copy of this Office action is **NOT** sent to the protestor. See 37 CFR 1.291(d).
3. In bracket 2, insert either-- has been served on applicant-- or-- is attached hereto--.

<

Where necessary or desirable to decide questions raised by the protest, under 37 CFR 1.291(\*>f<) the primary examiner can require the applicant to reply to the protest and answer specific questions raised by the protest. The primary examiner cannot require a reply



to questions relating to “fraud,” “inequitable conduct,” or “violation of the duty of disclosure” since those issues are generally not commented on by the Office. Any questions directed to applicant by the primary examiner must be limited to seeking answers reasonably necessary in order for the primary examiner to decide questions raised by the protest and which are before the primary examiner for decision. The primary examiner is not permitted, under 37 CFR 1.291(\*>f<), to seek answers to questions which are not before the primary examiner for decision. The primary examiner must use care in requiring information from applicant pursuant to 37 CFR 1.291(\*>f<) to ensure that the required information is necessary to the decision to be made.

Form paragraph 19.02 can be used to require additional information from applicant regarding issues raised by the protest.

¶ *19.02 Requirement for Information*

The protest under 37 CFR 1.291 filed on [1] has been considered. In order to reach a full and proper consideration of the issues raised therein, it is necessary to obtain additional information from applicant regarding these issues. In particular [2]. The failure to reply to this requirement for information within ONE MONTH or THIRTY DAYS, whichever is longer, of the mailing date of this requirement will result in abandonment of the application. This time period may be extended under the provisions of 37 CFR 1.136.

**Examiner Note:**

While the examiner normally should not need further information from applicant, this form paragraph may be used to request specific additional information from the applicant.

>

**III. < PROTESTOR NOT PERMITTED TO COMPLETE INCOMPLETE PROTEST**

A protestor may not complete an incomplete protest, nor further participate in, or inquire as to the status of, any Office proceedings relating to the initial protest. 37 CFR 1.291. The examiner must not, therefore, communicate with protestor in any way and will not consider a later submission by protestor, \*\* unless such submission \*\* >complies with 37 CFR 1.291(c)(5)< (see MPEP § 1901.07). Improper protests will be returned \*\* >to the protestor, or discarded, at the option of the Office. 37 CFR 1.291(g)<.

>

**IV. < TREATMENT OF TIMELY SUBMITTED PROTEST**

\*\* >If the protest has been timely submitted and is entered into the record of the application in time to permit review by the examiner during prosecution, the examiner must consider (A) each of the prior art or other documents submitted in conformance with 37 CFR 1.291(c) and any discussion of such documents in the protest, and (B) any non-prior art issue(s) raised by the protest, and the information supplied as to same. If the protest has been timely submitted in accordance with 37 CFR 1.291(b) but is not timely matched with the application to permit review by the examiner during prosecution, due to inadequate identification, the protest may be returned to the protestor where practical, or if return is not practical, discarded. 37 CFR 1.291(a).<

At least those prior art documents which the examiner relies on in rejecting claims will be made of record by means of form PTO-892, unless the protestor has listed such prior art or other documents on form \* >PTO/SB/08A and 08B< (or an acceptable substitute as provided by MPEP § \*>609.04(a)<), in which case the examiner will place the examiner’s initials adjacent to the citations in the boxes provided on the form \* >PTO/SB/08A and 08B< (see MPEP § \*>609.04(a)<). Where the prior art or other documents have not been cited on a PTO-892, or listed and initialed on a \* >PTO/SB/08A and 08B<, the examiner will place a notation in the protest paper adjacent to the reference to the documents. The notation should include the examiner’s initials and the term “checked.” The examiner will also indicate in the next Office action that all documents submitted have been considered.

It is not intended that the examiner be overly technical in construing 37 CFR 1.291(\*>c<) and refuse consideration of a protest because it does not include all of the contents enumerated by 37 CFR 1.291(\*>c<). The examiner should consider the protest to the extent it is helpful even though one or more of the listed items is omitted.

Where prior art or other documents are considered by the examiner, even though not submitted in full conformance with 37 CFR 1.291(\*>c<), the examiner *must*, for all those documents considered but not listed

on the form PTO-892, (A) mark “checked” and place the examiner’s initials beside each citation, or (B) where all the documents cited on a given page have been considered, mark “All checked” and place the examiner’s initials in the left-hand margin beside the citations. See MPEP § 609.04(a). Where prior art or other documents are listed by the protestor on form PTO/SB/08A and 08B, even though not submitted in full conformance with 37 CFR 1.291(c), the examiner *must*, for all those documents considered, place the examiner’s initials adjacent to the citations in the boxes provided on the form PTO/SB/08A and 08B. Where the prior art or other documents are listed by the protestor on form PTO/SB/08A and 08B, but are not submitted in full compliance with 37 CFR 1.291(c), the examiner *must*, for all those documents not considered, draw a line through the citation on the form PTO/SB/08A and 08B. See MPEP § 609.05(a). If a protest entered in an application file complies with 37 CFR 1.291(c), the examiner is required to fully consider *all* the issues, except for any issues of “fraud,” “inequitable conduct,” or “duty of disclosure” raised by the protestor, and clearly state the examiner’s position thereon in detail. 37 CFR 1.291(e).

&gt;

## V. < PROTEST FILED AFTER ALLOWANCE OR THE PUBLICATION OF THE APPLICATION

&gt;

### A. *Without the Written Consent of Applicant*

If the protest is submitted after the publication of the application under 37 CFR 1.211 or the mailing of a notice of allowance under 37 CFR 1.311, whichever occurs first, and is not accompanied by the written consent of the applicant, it should not be entered in the application file. The applicant should be notified that the protest is untimely and that it is not being entered in the application file. The handling of the protest will vary depending on the particular situation as follows.

\*&gt;

### 1. < Service of Copy Included

Where the protest includes an indication of service of copy on the applicant, the original protest should be discarded.

\*&gt;

### 2. < Service of Copy Not Included

Where the protest does not include an indication of service, the duplicate copy of the protest (if present) should be discarded and the original protest papers should be sent to the applicant along with the notification of nonentry.

&gt;

### B. *With the Written Consent of Applicant*

37 CFR 1.291(b)(1) provides that a protest may be filed at any time if it is accompanied by the written consent of the applicant to the filing of the protest being submitted as it specifically excludes the timeliness requirements of 37 CFR 1.291(b). While 37 CFR 1.291(b)(1) ensures that any (adequately identified) protest filed with the written consent of the applicant will be entered into the record of the intended application (if there is also compliance with 37 CFR 1.291(c)), 37 CFR 1.291(b)(1) makes clear that the protest must be matched with the intended application during prosecution to ensure consideration by the examiner. For example, where the protest is submitted close to publication of the patent, it is doubtful that the examiner would have time to review the protest, although the protest would be made of record. Even if not timely matched with the intended application, the examiner may still decide to consider the protest should there be sufficient time to do so.

35 U.S.C. 122(c) permits the filing of a protest in an application after the application has been published if there is express written consent of the applicant. In order to file protests after publication of patent applications, 37 CFR 1.291(b)(1) requires that the protest after publication of an application be accompanied by the written consent of the applicant. The written consent should indicate that applicant is consenting to the specific protest being submitted. Applicant may choose to provide a blanket consent to: any protests filed; protests filed by a particular real party in interest; a single protest by a particular party in interest (e.g., a protest that party Smith has informed me that

he will be submitting during the week of November 26<sup>th</sup>); a protest involving a particular item of prior art; or a particular protest that has been reviewed and applicant is willing to have considered by the Office. Where applicant consents to a protest, the Office will abide by the terms of the consent, and will enter the protest only if (A) the protest submitted is within the scope of the consent, and (B) the protest complies with the requirements of 37 CFR 1.291(b) (other than the timeliness requirement) and (c). If a properly consented to protest does not comply with some of the requirements of 37 CFR 1.291(b) or (c), the Office may choose to consider a piece of prior art permitted under the terms of the consent.<

&gt;

#### **VI. < COPIES OF DOCUMENTS NOT SUBMITTED**

If the protest is not accompanied by a copy of each prior art or other document relied on as required by 37 CFR 1.291(\*>c<), the examiner will consider the documents submitted. The protestor cannot be assured that the examiner will consider the missing document(s). However, if the examiner does so, the examiner will either cite the document on form PTO-892 or place a notation in the protest paper adjacent to the reference to the document which will include the examiner's initials and the term "checked." If the examiner considered a document not submitted, the next Office action will so indicate.

&gt;

#### **VII. < CONSIDERATION OF PROTESTOR'S ARGUMENTS**

In view of the value of written protests, the examiner must give careful consideration to the points and arguments made on behalf of the protestor. Any Office action by the examiner treating the merits of a timely submitted protest complying with 37 CFR 1.291(\*>c<) must specifically consider and make evident by detailed reasoning the examiner's position as to the major arguments and points raised by the protestor. While it is not necessary for the examiner to respond to each and every minute argument or point, the major arguments and points must be specifically covered. The examiner will not, under any circumstances, treat or discuss those arguments or points

directed to "fraud," "inequitable conduct," or "violation of duty of disclosure.">37 CFR 1.291(e).<

&gt;

#### **VIII. < RESULTS OF CONSIDERATION REPORTED TO TECHNOLOGY CENTER (TC) DIRECTOR**

After the examiner has considered the protest, the examiner will report the results of such consideration to the TC Director.

#### **1901.07 Protestor Participation [R-3]**

\*\* 37 CFR 1.291\* does not permit protestor, or any other member of the public, to contact or receive information from the Office as to the disposition or status of the protest, or the application to which it is directed, or to participate in any Office proceedings relating to the protest. The Office does not serve copies of Office actions or other documents mailed by the Office on protestors, and does not require applicants to serve copies of papers filed with the Office on protestors. Furthermore, a protestor is not permitted to participate in interviews, appeal a decision by the examiner adverse to the protestor to the Board of Patent Appeals and Interferences, or participate in an appeal by applicant. The disposition of the protest will \*\* be an *ex parte* matter between the Office and the applicant. Where protestor has access to an application, for example, a reissue application which is open to the public and may be inspected under 37 CFR 1.11, the proceedings may thereby be monitored.

Under 37 CFR 1.291(\*>f<), applicant may be required by the Office to reply to a protest. Any reply thereto would be *ex parte* and would not be served on the protestor. \*\*

#### **1901.07(a) Filing of Multiple Papers Relating to Same Issues [R-3]**

Under 37 CFR 1.291(\*>d<), protestor participation ends with the filing of the initial protest, and protestor will not be allowed to complete any protest that is incomplete. \*\* >Effective November 22, 2004, 37 CFR 1.291(c) was amended to no longer permit the submission of additional (cumulative) prior art by the same real party in interest. Multiple piecemeal protests (raising a slightly different issue in each protest submission) in a single application by the same real

party in interest are not permitted. After the filing of the initial protest, no further submission of prior art by the same real party in interest will be considered, except for new, non-cumulative prior art submitted under the conditions of 37 CFR 1.291(c)(5). 37 CFR 1.291(c)(5) requires that a second or subsequent protest by the same real party in interest include:

(A) an explanation as to why the issue(s) raised in the second or subsequent protest are significantly different than those raised earlier;

(B) an explanation as to why the significantly different issue(s) were not earlier presented; and

(C) the processing fee under 37 CFR 1.17(i).

Significantly different issue(s) may be raised by the submission of new, non-cumulative prior art or other information not previously made of record. Additional comments seeking to bring in further or even new data or information with respect to an issue previously raised by the same real party in interest would not qualify as a significantly different issue. By imposing requirements for second or subsequent protests on “the same real party in interest,” the requirements of 37 CFR 1.291(c)(5) cannot be avoided by multiple protests submitted by different people representing the same real party in interest.

Second or subsequent protest by the same real party in interest that do not comply with 37 CFR 1.291(c)(5) will not be entered in the intended application and will be returned to the protestor, or discarded, at the option of the Office. 37 CFR 1.291(g).

An examiner will consider a second or subsequent protest filed on behalf of the same real party in interest (subject to the time frames set forth in 37 CFR 1.291(b), the caveat that the protest can be timely matched and considered prior to the issuance of the

patent, and the content requirements of 37 CFR 1.291(c)(1) to (4)), if the second or subsequent protest complies with 37 CFR 1.291(c)(5).<

**1906 Supervisory Review of an Examiner’s Decision Adverse to Protestor [R-3]**

As pointed out in MPEP § 1901.07, a protestor cannot appeal to the Board of Patent Appeals and Interferences from an adverse decision of the examiner. Further, a decision by >the< examiner adverse to a protestor is final, and under the restricted protestor participation permitted under 37 CFR 1.291(\*>d<) is not petitionable to the \* >Director<.

**1907 Unauthorized Participation by Protestor [R-3]**

Office personnel must exercise care to ensure that substantive matters relating to the application are not discussed *ex parte* with protestor or communicated in writing *ex parte* to protestor. The examiner must not communicate in any manner with protestor. See 37 CFR 1.291(\*>d<).

**1920 Citation of Prior Art Under 37 CFR 1.501(a)**

37 CFR 1.501(a) permits any person at any time during the period of enforceability of a patent to cite to the Office, in writing, prior art consisting of patent and printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim(s) of the patent. See MPEP § 2202 - § 2208.

