1901 Protest Under 37 CFR 1.291 [R-14]

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

(a) Protests by a member of the public against pending applications will be referred to the examiner having charge of the subject matter involved. A protest specifically identifying the application to which the protest is directed will be entered in the application file if>:<

(1) *>The< protest is timely submitted; and

(2) *>The< protest is either served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.

>Protests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues. Protests which do not adequately identify a pending patent application will be disposed of and will not be considered by the Office.<

(b) A protest submitted in accordance with the second sentence of paragraph (a) of this section will be considered by the Office if it includes (1) a listing of the patents, publications or other information relied upon; (2) a concise explanation of the relevance of each listed item; (3) a copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.

(c) **A member of the public filing a protest >in an application< under paragraph (a) of this section ** will not receive any communications from the Office relating to the protest, other than the return of 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 Office *>may< communicate with the applicant regarding any protest ** and may require the applicant to **>respond to specific questions raised by the protest. In the absence of a request by the Office, an applicant has no duty to, and need not, respond to a protest. The limited involvement< of the member of the public filing a protest pursuant to paragraph (a) of this section ends with the filing of the protest>,< and no further submission on behalf of the protestor will be ** considered unless such submission raises new issues which could not have been earlier presented **.

[Paras. (a) and (c) revised, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992]

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 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) Transmissions 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 Commissioner 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 § 1.646 for service of papers in interferences.

See >37 CFR< 1.646 for service of papers in interferences.

37 CFR 1.291(a) 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. 37 CFR 1.291(a) provides that public protests against pending applications will be referred to the examiner having charge of the subject matter involved and will, if timely submitted and either served upon the applicant or filed in duplicate in the event service is not possible, be entered in the application file. *Paragraph (b) of 37 CFR 1.291 assures members of the public that a protest will be fully considered by the Office if it is submitted in accordance with 37 CFR 1.291(a) and includes (1) a listing of the patents, publications or other information relied upon; (2) a concise explanation of the relevance of each listed item; (3) a copy of each listed patent, publication or other item of information in written form, or at least the pertinent portions thereof; and (4) an English language translation of all necessary and pertinent parts of any non-English language document relied upon. 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 protestor's opinion, would make the grant of a patent thereon improper.

A protestor does not, however, by the mere filing of a protest, obtain the "right" to argue the protest before the Office. The degree of participation allowed a protestor is, of course, solely within the discretion of the Commissioner of Patents and Trademarks and the Commissioner exercised his discretion to restrict such participation effective December 8, 1981: "Interim Reissue, . . . Protest, And Examination Procedures. . . .", 1013 O.G. 18-19; Final rule: "Reissue, Reexamination, Protest and Examination Procedures in Patent Cases", 47 Fed. Reg. 21746-21753, May 19, 1982. As provided effective December 8, 1981 in said "Interim . . . Protest . . . Procedures", and in 37 CFR 1.291(c), ** 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 such submission raises new issues which could not have been earlier presented, and thereby constitutes a new protest. **>37 CFR 1.291<(c) provides for the acknowledgment of the *>receipt< of a protest in >an original or< a reissue application file >only if a self addressed post card 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-14]

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 principal since 37 CFR 1.291 does not require that the principal be identified.

1901.02 Information Which Can Be Relied on in Protest [R-14]

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(a). While prior art documents>,< such as patents and publications, are most often the subject of protests, 37 CFR 1.291(a) 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 upon. The Office recognizes that when evidence other than prior art documents is relied upon 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 upon 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(b).

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

(1) Information demonstrating that the subject matter to which the protest is directed 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.

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

(3) 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)).

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

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

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

(7) Information indicating "fraud" or a "violation of the duty of disclosure" under 37 CFR 1.56* may be the subject of a protest under 37 CFR 1.291(a).

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Different forms of evidence may accompany, or be submitted as a part of, a protest under 37 CFR 1.291(a). 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(a) 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(a). 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-14]

A protest under 37 CFR 1.291(a) 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 should include a listing of all patents, publications or other information relied upon; a concise explanation of the relevance of each listed item; an English language translation of all relevant parts of any non-English language document; and be accompanied by a copy of each patent, publication or other document relied upon. Protestors are encouraged to use form PTO-1449 "Information Disclosure Citation" when preparing a protest under 37 CFR 1.291, especially the listing enumerated under 37 CFR 1.291(b)(1); see MPEP >§< 609. In addition, the protest and any accompanying papers should 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:

1. Name of Applicant(s).
2. Serial number of application >(mandatory)<.
3. Filing date of application.
4. Title of invention.
5. Group art unit number. (If known)
6. Name of examiner to whom the application is assigned. (If known)
7. Current status and location of application. (If known)
8. 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(a)." If the protest is accompanied by 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 of Patents and Trademarks, Washington, D.C. 20231, ** and should be directed to the attention of the director of the particular examining group 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 the Assistant Commissioner for Patents, **>Crystal Park 2<, Room **>923<, along with as much identifying data for the application as possible.

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 BOX 7 **. However, in view of the urgent nature of most "REISSUE LITIGATION" protests, protestor may wish to hand-carry the protest to the appropriate area in order to ensure prompt receipt and >to< avoid any unnecessary delays. In litigation-type cases, all responses should be hand-carried to the appropriate area in the Office.

INITIAL PROTEST SUBMISSION MUST BE COMPLETE

It is extremely important that a protest be complete and contain a copy of every document relied upon by protestor, whether the document is a prior art document, court litigation material, affidavit or declaration, etc., since under 37 CFR 1.291(c) 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(c), and no further submission on behalf of protestor will be acknowledged or considered unless such submission clearly raises new issues which could not have been earlier presented, and thereby constitutes a new protest. Protests which will not be entered in the application file include those further submissions in violation of 37 CFR 1.291(c) by which protestor seeks to participate in the examination process. For example, mere arguments relating to an Office action or an applicant's response 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. Even new protests which also argue Office actions or responses or any matter beyond the new issue should not be accepted. Improper protests will be returned by the Examining Group Director **. While improper protests will be returned, a new protest by an earlier protestor will be proper and can be entered if it is clearly limited to new issues which could not have been earlier presented, and thereby constitutes a new protest.

As indicated in 37 CFR 1.291(b)(3), a protest must be accompanied by a copy of each prior art document relied upon in order to ensure consideration by the examiner, although a protest without copies of prior art documents will not necessarily be ignored. This requirement is similar to the requirement of 37 CFR 1.98 that copies of written documents accompany information disclosure statements. While a protest without copies of documents will not necessarily be ignored, the submission of such documents with the protest will obviously expedite and ensure 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 effect service 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 upon in the same manner as required by 37 CFR 1.291(a) 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(a). 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-14]

A protest under 37 CFR 1.291(a) must be "timely submitted" 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 with regard to a reissue application should be filed within the two-month period following announcement of the filing of the reissue application in the *Official Gazette*. If, for some reason, the protest of the reissue application cannot be filed within the two-month period provided by 37 CFR 1.176, the protest can be submitted at a later time, but 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 additional specified period in which to file a protest, beyond the **>two-month< period following the announcement in the *Official Gazette*, 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(h). 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 examining group. 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.

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 under 37 CFR 1.183, when accompanied by the petition fee set forth in 37 CFR 1.17(h), to waive the two-month delay period of 37 CFR 1.176 in appropriate circumstances. Accordingly, protestors to reissue applications cannot automatically assume that the full two-month delay period of 37 CFR 1.176 will always be available.

To ensure consideration, protests, whether in original or reissue applications, must be timely submitted, i.e., before final rejection or allowance. Consideration of protests filed after final rejection or allowance will depend upon the nature of the issues raised, the materiality of any prior art or other documents, and the point in time at which the protests and documents are submitted. Obviously if the serious nature of the issues raised requires further consideration, or if prior art documents clearly anticipate or render obvious one or more claims, the protest will not knowingly be ignored. It must be recognized, however, that the likelihood of consideration of a protest decreases as the patent date approaches. If a protest is not timely submitted, it will be acknowledged as set forth in MPEP >§< 1901.05 >only if a self-addressed post card is included with the protest<, and referred to the examiner having charge of the subject matter involved for entry in the application file, ** for such consideration as is warranted.

1901.05 Initial Office Handling and Acknowledgment of Protest [R-14]

Protests Referred to Examiner

>37 CFR<* 1.291(a) provides that protests filed against pending applications will be referred to the examiner having charge of the subject matter involved. >37 CFR<* 1.291(a) further provides that a protest specifically identifying the application to which it is directed will be entered in the application file, if (1) the protest is timely submitted (see MPEP >§< 1901.04) and (2) a copy 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.

A protest where the application is specifically identified ** which is submitted in conformance with 37 CFR 1.291 (a) and (b), will be considered by the Office.

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 will 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 wrapper.

Acknowledgement of Protest

>37 CFR<* 1.291(c) provides that **>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 acknowledgement that the protest has been received by the Office.

Applications and Status Thereof Maintained in Secrecy

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 by the . . . Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner." 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 the Assistant Commissioner for Patents pursuant to delegation contained in MPEP >§< 1002.02(a). Reissue applications filed on, or after, March 1, 1977, are pursuant to 37 CFR 1.11(b) "open to inspection by the general public."

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(c)<, and to 37 CFR 1.175(b) in reissue applications, including responses to specific questions raised by the protest, in order for the Office to decide any issues raised thereby. Under 37 CFR 1.291(c) the examiner can require the applicant to respond to the protest and answer specific questions raised by the protest.

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1901.06 Examiner Treatment of Protest [R-14]

Current 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*, 210 USPQ 249, 255 (C.C.P.A. 1981).

Initial Review

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

(1) **To ensure that either the protest or the application file wrapper 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* protestor. If it has, this should be noted on the protest or on the application file. If service hasn't been made, the protest and application file should be brought to the attention of the examining group director for appropriate action; see MPEP >§< 1901.05.

(*>2<) **>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 the Assistant Commissioner for Patents, before considering the protest and acting on the applications.

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 one 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:

¶ 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 response 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(c).

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(c) the primary examiner can require the applicant to respond to the protest and answer specific questions raised by the protest. The primary examiner cannot require response to questions relating to "fraud", "inequitable conduct", or "violation of the duty of disclosure" since those issues are >generally< not *>commented upon< 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(c), 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(c) to ensure that the required information is necessary to the decision to be made.

Form Paragraph 19.02

¶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]. Applicant's response to this requirement for information must be filed within ONE MONTH of the date of this requirement to avoid the issue of abandonment of the application.

Examiner Note:

While the examiner normally should not need further information from applicant, under circumstances such as issues relating to prior use or sale it may be necessary to seek additional information.

Clarification Sought From Protestor With Access

If the protestor has access to the application, and the protestor has participated in the proceedings before the Office prior to December 8, 1981 the examiner may communicate with the protestor in writing, with a copy to applicant, to seek clarification and/or additional information necessary to properly consider the protest. The following suggested format can be used by the examiner to seek clarification and/or additional information from the protestor having access to an application.

"The protest, as filed on — — — — —, has been noted. However, clarification and/or additional information is desired. In particular (examiner explains). Any submission of the requested information should be made within ONE MONTH of the date of this letter and the submission must indicate service on applicant."

Protestor Not Permitted To Complete Incomplete Protest

As amended July 1, 1982 >and March 16, 1992<, 37 CFR 1.291 does not permit protestor to complete an incomplete protest, nor to further participate in, or inquire as to the status of, any Office proceedings relating to the initial protest. The examiner must not, therefore, communicate with protestor in any way ** and will not consider a later submission by protestor unless such submission raises new issues which could not have been earlier raised and constitutes in effect a new protest (see MPEP § 1901.07). Improper protests will be returned by the **>Examining Group Director<.

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Treatment of Timely Submitted Protest

If the protest has been timely submitted, i.e., before final rejection or allowance, the examiner must consider each of the prior art or other documents submitted in conformance with 37 CFR 1.291(b). 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 protestor has listed such prior art or other documents on form PTO-1449, in which case the examiner will place the examiner's initials adjacent the citations in the boxes provided on the form PTO-1449 (see MPEP >§< 609). Where the prior art or other documents have not been cited on a PTO-892, or listed and initialed on a PTO-1449 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(b) and refuse consideration of a protest because it does not include all of the contents enumerated by 37 CFR 1.291(b). The examiner should consider the protest to the extent it is helpful and valid 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(b), the examiner *must*, for all those documents considered but not listed on the form PTO-892, (1) mark "checked" and place the examiner's initials beside each citation or (2) 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. Where prior art or other documents are listed by protestor on form PTO-1449, even though not submitted in full conformance with 37 CFR 1.291(b), the examiner *must*, for all those documents considered place the examiner's initials adjacent the citations in the boxes provided on the form PTO-1449. Where the prior art or other documents are listed by protestor on form PTO-1449, but are not submitted in full compliance with 37 CFR 1.291(b), the examiner *must*, for all those documents not considered draw a line through the citation on the form PTO-1449, see MPEP >§< 609. If a protest entered in an application file complies with >37 CFR< 1.291(b), 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.

Protest Filed After Final Rejection or Allowance

If the protest is filed after final rejection or allowance of the application, but prior to the date of issuance of the patent, it may be considered "timely" for purpose of entry in the application file although it may not be considered by the examiner in view of its late submission. No assurance can be given that any protest submitted after final rejection or allowance will be considered, although the examiner will not knowingly ignore documents which clearly anticipate or render obvious one or more claims. Clearly, the extent of the consideration given by the examiner will depend upon the relevance of the prior art documents submitted and the point in time at which they are submitted. See MPEP >§< 1901.04. Documents which clearly anticipate or render obvious one or more claims will not be knowingly ignored. Prosecution of the application will be reopened where necessary.

Copies of Documents Not Submitted

If the protest is not accompanied by a copy of each prior art or other document relied upon as required by 37 CFR 1.291(b), 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.

Consideration of Protestor's Arguments

In view of the value of written protests, it is necessary that the examiner give careful consideration to the points and arguments made on behalf of protestor. Any Office action by the examiner treating the merits of a timely submitted protest complying with 37 CFR 1.291(b) 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."

Results of Consideration Reported to Group Director

After the examiner has considered the protest, the examiner will report the results of such consideration to the group director.

1901.07 Protestor Participation in the Examination [R-14]

The degree of protestor participation in the examination has been severely restricted. Any protest against a pending application which is filed after December 8, 1981 will be treated in accordance with the procedures set forth in the "Interim . . . Protest . . . Procedures" published December 8, 1981 at 1013 O.G. 18-19, and published May 19, 1982 in 47 Fed. Reg. 21746-21753. Any protest filed on or before December 8, 1981, including related protestor participation, will be handled in accordance with practices in effect prior to December 8, 1981.

In accordance with the limited protestor participation in protests filed after December 8, 1981, 37 CFR 1.291(c) was amended effective July 1, 1982 >and further amended on March 16, 1992< to provide that:

"**>limited involvement< of *>the< member of the public filing a protest . . . ends with the filing of the protest>,< and no further submission on behalf of the protestor will be ** considered unless such submission raises new issues which could not have been earlier presented**.

Mere arguments relating to an Office action or an applicant's response would not qualify as a new *>issue<. The mere filing of a protest does not grant access to protestor or relieve the Office of its obligations under 35 U.S.C. 122 to maintain applications "in confidence." Nor does the mere filing of a protest automatically mean that protestor will have any "right" to participate to any particular degree. *37 CFR 1.291(c) 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 disposition of the protest will, once it has been filed under paragraph (c), 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(c), applicant may be required by the Office to respond to a protest. Any response thereto would be ex parte and would not be served on protestor. The ex parte nature of the requirements for information under paragraph (c) differs from past practice under which information could be required, or requested, from applicant and one or more protestors.

1901.07(a) Service of Copies [R-14]

In protests filed after December 8, 1981, the Office >does<* not serve copies of Office actions, or other documents mailed by the Office, on protestors; and *no longer *>requires< applicants to serve copies of papers filed with the Office on protestors: see "Interim . . . Protest . . . Procedures" published December 8, 1981 at 1013 O.G. 18-19; 47 Fed. Reg. 21746-21753 published May 19, 1982; and 37 CFR 1.291 as amended July 1, 1982 >and March 16, 1992<. In protests filed on or before December 8,

1981, service of copies will be handled under the procedures in force prior to December 8, 1981. However, if an application, in which said protest was filed on or before December 8, 1981, is abandoned and a continuation application is filed, any protest filed in said continuation application will be treated as a new protest and will be governed by the procedures in effect at the time said new protest is filed. If said new protest >was<* filed after December 8, 1981, the Office >does<* not serve copies, nor require applicant to serve copies, on protestor.

A protestor who had access to an application and had filed a protest in the application prior to December 8, 1981, can request the Office to supply protestor with copies of Office actions or other documents mailed by the Office. Protestor, however, has no right to copies of Office actions or other documents, the granting or denying of such requests being within the sole discretion of, and for the convenience of, the Office. Such a request is granted by the Office of the Assistant Commissioner for Patents or the group director only where protestor has served copies of the protest and any subsequent papers on applicant. The granting normally includes the requirement that each of the parties serve copies of any papers filed on each other, and is, as set forth above, within the sole discretion of, and for the convenience of, the Office.

When the protestor has been granted the right to receive all Office correspondence>,< the name and address of the protestor should be added to the front of the file at the correspondence box.

This will enable the clerical personnel to see that two envelopes are needed *>and that< dual mailing is required. The protestor's name and address should be added in pencil or red ink, However, the first line should read "PROTESTOR"

e.g. PROTESTOR
James Jones
ABC Corp.
720 Avenue C
New York, New York zip

Failure to put the word "PROTESTOR" above the name and address could cause the Publishing Division to assume that the first address was inadvertently not cancelled and result in the Notice of Allowance being sent to the Protestor. Use of the identifier "PROTESTOR" will result in the Publishing Division sending the Notice of Allowance (multipart forms) to the Applicant and a single copy to the protestor.

1901.07(b) Protests Limited to Single Submission [R-14]

Filing of Multiple Papers Relating to Same Issues

Previously, the filing of multiple papers by either the applicant and/or protestor(s) with respect to a specific issue(s) has created problems in that the application files became unduly expanded and unnecessary delays in the examination were encountered. Therefore, applicants and protestors were encouraged to make their first submission with regard to specific issues as complete as possible in order to avoid the necessity of filing multiple papers.

Protestors Limited to Single Submission

Where a protest is filed after December 8, 1981, protestor is limited to a single submission and thus must make such submission as complete as possible: see 37 CFR 1.291(c) as amended July 8, 1982 >and March 16, 1992<; "Interim... Protest... Procedures" published December 8,1981 at 1013 O.G. 18-19; and 47 Fed. Reg. 21746-21753 published May 19, 1982. Under *37 CFR 1.291(c) protestor participation ends with the filing of the initial protest, and protestor will not be allowed to complete any protest that is incomplete. No further submission on behalf of protestor will be ** considered unless such submission clearly raises new issues which could not have been earlier presented**. Protests which will not be entered in the application file include those further submissions in violation of 37 CFR 1.291(c) by which protestor seeks to participate in the examination process. For example, mere arguments relating to an Office action or an applicant's response would not qualify as a new *>issue<. 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 *>issue<. Even new protests which also argue Office actions or responses or any matter beyond the new issue should not be accepted. Improper protests will be refused consideration and returned by the **>Examining GroupDirector**. While improper protests will be returned, a new protest by an earlier protestor will be proper and can be entered if it is clearly limited to new issues which could not have been earlier presented**.

1902 Protestor Participation in Interviews [R-14]

Under *37 CFR 1.291(c), protestor participation in interviews is not permitted where the protest was filed after December 8, 1981: see "Interim...Protest...Procedures" published December 8, 1981 at 1013 O.G. 18-19; 47 Fed. Reg. 21746-21753 published May 19, 1982. In protests filed on or before December 8, 1981, protestor participation is governed by the rules and procedures in effect prior to December 8, 1981. Any such participation rights, in an application where the protest was filed on or before December 8, 1981, are limited to that application and do not carry forward to any continuing application. Any protest filed in a continuing application is treated as a new protest and will be governed by the procedures in effect at the time said new protest is filed.

Where a protest has been filed in an application prior to December 8, 1981, a protestor having access to said application can request to be allowed to participate in any interviews between applicants and the examiner, or could request an interview with the examiner on protestor's own behalf. However, interviews with a protestor, whether protestor initiated or not, will not be permitted without applicant's presence. An examiner should never communicate orally with protestor except for purely procedural matters unless applicant is repre-

sented, and protestor must refrain, unless applicant is represented, from oral communication with the examiner except to ask purely procedural questions not related to the substance of the protest or the merits of the application. No oral communications between the examiner and protestor are permitted if the protest was filed after December 8, 1981.

Normally, protestor participation in interviews with examiners will not be allowed unless special justifying circumstances exist. Where authorized, participation by the protestor in an interview will be according to guidelines set forth below in MPEP >§< 1902.01.

Where copies of Office actions are being sent to a protestor or where protestor is present at an interview, a copy of the "Interview Summary Form" and other records made at the interview (excluding any transcript) will be provided to the protestor. Where protestor participates in an interview, protestor may, or may not be required to, submit his or her own record of the interview which will be made of record in the file.

1902.01 Guidelines for *Inter Partes* Interviews [R-14]

Subject to the restrictions noted in MPEP >§< 1902, the authority for granting *inter partes* interviews resides with each **>Group Director<. Protestor participation in interviews with examiners will not *ordinarily be permitted unless protestor has access and justifying circumstances exist. Where authorized, such participation will be according to the following guidelines. The "guidelines" are being issued so as to provide some uniformity as to the propriety of interviews and the manner in which any such interviews, if granted, are to be conducted.

1902.01(a) Justifying Circumstances for *Inter Partes* Interviews [R-3]

As discussed in MPEP § 1902, protestors are not permitted to participate in interviews in applications where the protest was filed after December 8, 1981. However, where a protest has been filed in an application on or before December 8, 1981, a protestor having access to said application may request to participate in interviews in said application.

Inter partes interviews are usually due to a request by:

1. the primary examiner who feels that an *inter partes* interview would be useful,
2. the applicant who desires to have the protestor present,
3. the protestor who desires to be included at an interview,
4. the protestor who wishes to initiate an interview, or
5. a Court with related litigation which desires an interview be held.

Requests under categories 1, 2, and 5 should normally be granted since it is the primary examiner who is requesting an *inter partes* interview, the applicant desiring the presence of the protestor at an interview, or a Court desiring that the parties be permitted to conduct an interview with the examiner. In any of these situations, the group director should normally grant permission for an *inter partes* interview unless other reasons are present which, in the group director's opinion, would negate the desirability of any such interview.

Requests under category 3 are most often encountered insofar as *inter partes* interviews are concerned. Examples of situations in which an *inter partes* interview should normally be granted include those in which:

1. the court has *stayed* the litigation and/or has invited or required defendant (or plaintiff in a declaratory judgment action) to participate in the reissue proceedings and to be accorded "full participation" in the Patent and Trademark Office deliberations;
2. the nature of the issues would appear to make such an interview desirable, as for example, issues relating to public use, prior sale, inventorship and complex prior art; and
3. for other reasons where the examiner and group director feel that the protestor's participation would be helpful.

Requests under category 4 usually would not be granted since a protestor cannot initiate an interview with the examiner or attend such an interview absent an agreement by the applicant to also be present and participate.

In any event, for an *inter partes* interview to be conducted a *protest must have been filed* in the application by the protestor prior to December 8, 1981, and the protestor must have access to the application.

1902.01(b) Circumstances Where *Inter Partes* Interviews Would Normally Not Be Justified

Many protests are filed wherein there is no court litigation involving the parent patent. In these situations, the decision as to whether or not to grant protestor's request to participate in an *inter partes* interview must be considered from the particular facts of each application.

Normally, if only *printed prior art* of a non-complex nature has been relied upon in the protest to support allegations of unpatentability, an *inter partes* interview would not be appropriate since the primary examiner should be capable of interpreting the art. (However, in some circumstances, protestor participation may be considered useful and justify participation).

Other issues which would not normally justify an *inter partes* interview involve, for example, 35 U.S.C. 101, 251, and 112.

No interviews will be granted protestor where the protest was filed in an application after December 8, 1981.

1902.01(c) Notice of Interviews

If the protestor participation at any interview has been previously approved, applicant must thereafter request any interview in advance of the requested interview date and must represent at that time that protestor has *received* actual notice (by telephone, if necessary) of the interview request and been offered an opportunity to participate. Protestor must also inform the Patent and Trademark Office in advance whether or not protestor intends to participate in any scheduled interview. In

those situations where protestor participation has been approved, the examiner will not hold any interview relating to *matters of substance* with applicant or applicant's representative(s) unless the examiner is satisfied that protestor has *received actual and timely* notice of the interview and has been offered an opportunity to participate. Of course, this caveat does not relate to non-substantive matters such as status inquiries, but does include subsequent interviews initiated by the examiner or applicant even if only for minor amendments such as those occurring in examiner amendments. For minor matters, conference calls may be utilized if arranged by the parties.

For those interviews requested by the primary examiner and approved by the group director, the scheduling of the interview should be coordinated by the examiner.

1903 Guidelines for Conducting Interviews

Once an *inter partes* interview has been scheduled, the parties should be provided with guidelines by, or at the direction of, the group director as to the manner in which the interview will be conducted. These guidelines should address the following points:

1. The issues the examiner desires particularly addressed.

2. A requirement that applicant or protestor identify to the examiner the issues which applicant or protestor particularly wish to discuss prior to the interview along with an indication that the other party has been apprised of these issues.

3. A limitation as to the number of representatives from each party permitted to participate at the interview (normally no more than 2 or 3).

4. State that the supervisory primary examiner or in the supervisory primary examiner's absence, another primary examiner, will sit in on the interview.

5. The order in which the parties will discuss each of the issues (if appropriate and/or desirable, a time limit per issue may also be set forth).

6. An indication that the primary examiner will not make any commitment on substance during the interview, but will render a decision in writing after having an opportunity to weigh all the comments submitted by the parties following the interview.

7. That the primary examiner will not entertain any discussions relating to issues of fraud and/or duty of disclosure.

8. That the interview will be controlled by the primary examiner and will be terminated at the discretion of the primary examiner.

9. The guidelines may specify time limitations which may only be exceeded in the examiner's discretion.

10. The location at which the interview will be held.

1903.01 Record of Interviews

Following the interview, the primary examiner will require each of the parties to submit, for the record and to the other parties, a short summary of what the parties feel transpired at the interview, unless a court reporter has been allowed at the interview. A period of two weeks should be ample time for submission of the comments.

If the director determines that a court reporter's presence is desirable at the interview (if requested and paid for by any of the parties), then a transcript of the interview must be forwarded to the examiner as soon as it is available and *at no cost* to the Patent and Trademark Office. The party or parties requesting the court reporter must agree, in advance, to bear the total cost of the same, including the costs of any transcripts, and must make all the necessary arrangements for securing the reporter.

If a court reporter is not present, the primary examiner must complete "Interview Summary Form PTO-413" at the conclusion of the interview briefly summarizing the issues discussed, without commitment thereon, and provide each of the parties with a copy thereof.

If the protestor *has not* been granted permission to participate at an *inter partes* interview, but has been granted service of all Office communications of substance, it is appropriate that a copy of any interview summary be forwarded to the protestor as soon as possible. Applicant still has the usual responsibility to record the substance of the interview and protestor has the opportunity to make any observations or comments in relation thereto.

1904 Protestor Participation Before the Board of Patent Appeals and Interferences [R-14]

A protestor cannot appeal a decision by the examiner adverse to the protestor to the Board of Patent Appeals and Interferences. Further, where the protest was filed after December 8, 1981 in an application, a protestor is not permitted by *37 CFR 1.291(c) to participate in an appeal by applicant: see "Interim . . . Protest . . . Procedures" published December 8, 1981 at 1013 O.G. 18-19; 47 Fed. Reg. 21746-21753 published May 19, 1982.

Where a protest has been filed in an application on or before December 8, 1981 *and* protestor has access to said application, the Office does permit protestor participation in appeals filed by applicant under 35 U.S.C. 134 and 37 CFR 1.191. Such protestor, with access to an application appealed to the Board of Patent Appeals and Interferences, who intends to file comments or a brief, without fee, in opposition to applicant's brief should file an indication of such intention within one month after the Notice of Appeal under 37 CFR 1.191 is filed and serve a copy of the same upon applicant. The indication of intention should state that protestor agrees to file such comments or brief in triplicate, within one month after applicant's brief is filed, and also agrees to serve a copy of the comments or brief upon applicant. If such an indication is not filed and served, or the protestor's comments or brief is not timely filed in triplicate and served, no assurance is given that the examiner will consider the protestor's comments or brief during the preparation of the Examiner's Answer.

Such protester who participates by the filing of comments or a brief in opposition to the applicant's brief may also request, at the time of filing the comments or brief, to appear at any oral hearing which may be requested by the applicant. If a protestor

does not file such comments or brief, the protestor cannot be present at any oral hearing. If a protestor does file such a request, the Board of Patent Appeals and Interferences, in its discretion, will decide whether or not the issues on appeal are such that protestor's participation at the hearing would be helpful. The Board of Patent Appeals and Interferences will notify protestor whether or not the request to appear at the oral hearing is granted and, if granted, how much time will be permitted. Of course, if applicant does not request an oral hearing, or provides timely notification to the Board and protestor that applicant will not appear, the protestor will not be heard.

In rare circumstances, the Office has on petition to the Commissioner also permitted a protestor with access to the application to include, in protestor's comments or brief, a request that the Board make one or more rejections under 37 CFR 1.196(b): note *In re Khoury*, 207 USPQ 942 (Com'r. Pats. 1980).

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

As pointed out in MPEP § 1904, a protestor cannot appeal to the Board of Patent Appeals and Interferences from an adverse decision of the examiner. Further in an application where the protest was filed after December 8, 1981, a decision by examiner adverse to a protestor is final, and under the restricted protestor participation permitted under *37 CFR 1.291(c) is not petitionable to the Commissioner: see "Interim . . . Protest . . . Procedures" published December 8, 1981 at 1013 O.G. 18-19; 47 Fed. Reg. 21746-21753 published May 19, 1982. Where a protest was filed in an application on or before December 8, 1981, a decision by the examiner adverse to a protestor is final, except in instances of clear error or abuse of discretion established by petition to the Commissioner under 37 CFR 1.181. Any such petition should be directed to the appropriate group director. Also, consideration of the petition does not represent acknowledgment of any right of review in the protestor.

1907 Unauthorized Participation by Protestor

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. Where protestor has not filed a protest or otherwise participated in an application prior to December 8, 1981, the examiner must not communicate in any manner with protestor: note 37 CFR 1.291(c).

Where protestor has participated in the application on or before December 8, 1981 *and* has access to the application, the examiner may communicate in writing with protestor, such as, to request clarification of a protest or additional information. A copy of any examiner's letter or communication to a protestor will be mailed to applicant at the same time it is mailed to the protestor. Even where communication in writing with protestor is permitted, the examiner will not communicate orally with protestor and protestor must refrain from oral communications with the examiner except to ask purely procedural questions which have no relation to the substance of the protest or the merits of the application, unless specifically authorized in writing by the Assistant Commissioner for Patents.

1920 Citation of Prior Art Under 37 CFR 1.501(a) [R-14]

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.