

Chapter 1900 Protest

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1901 Protest Under 37 CFR 1.291 [R-6]

- 37 CFR 1.291. *Protests by public.* (a) Protests against pending applications will be acknowledged and 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 and, if timely submitted and accompanied by a copy of each prior art document relied upon, will be considered by the examiner.
- (b) (Reserved)
- (c) Protests by the public and any accompanying papers should either (1) reflect that a copy of the same has been served upon the applicant in accordance with § 1.248 or (2) be filed with the Office in duplicate in the event service is not possible.

37 CFR 1.248. Service of papers; manner of service; proof of service.

(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 acknowledgment 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.

Section 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. Section 1.291 (a) provides that public protests against pending applications will be entered in the application file and will, if the protest meets certain requirements, be considered by the examiner. 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. While the filing of a protest does not give the protestor a "right" to further participation before the Office, in certain circumstances the Office has, and may,

determine that further participation by a protestor beyond the mere filing of a protest is beneficial to, and of assistance to, the Office in its examination of the application. In general, the degree of protestor participation will be determined by the Office on the basis of the amount of assistance the Office is likely to derive from increased protestor participation and not by any mere desire by the protestor to participate. Consideration will be given to insuring the protestor a fair opportunity to present protestor's case. In addition, the desires of a Court with related litigation before it will be considered. The Office will determine the extent to which protestor participation would be of assistance. 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-1]

Any member of the public, including both 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 § 1.291 does not require that the principal be identified.

1901.02 Information Which Can Be Relied On In Protest [R-6]

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, § 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.

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(a) may be the subject of either a protest under § 1.291(a) or a petition to strike the application under 37 CFR 1.56(d).

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) unless the Office later requests more.

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 § 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 § 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 § 724, and will be made public if material to the examination of the application as defined in 37 CFR 1.56(a).

1901.03 How Protest Is Submitted [R-1]

A protest under 37 CFR 1.291(a) must be submitted in writing, should where possible specifically identify the application to which the protest is directed, and should be accompanied by a copy of each prior art or other document relied upon. 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.
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 words "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 filed alleging "fraud" or "violation of the duty of disclosure" 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 Office of the Assistant Commissioner for Patents, Building 3, Room 11A13. Protests based on grounds other than "fraud" or "violation of the duty of disclosure" can also 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, Building 3, Room 11A13, 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 in accordance with the O.G. Notice of January 4, 1980. 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 avoid any unnecessary delays.

It is extremely important that a protest contain a copy of every document relied upon by protestor, whether that document is a prior art document, court litigation material, affidavit or declaration, etc.

As indicated in § 1.291(a), 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 prior art 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 § 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 § 1.291(c). 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-1]

A protest under § 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 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. Where a protest is intended against a reissue application, but cannot be submitted within the two months provided following the announcement in the Official Gazette, the protestor can request an additional specified period within which to file the protest, explaining why the additional time is necessary and the nature of the protest intended. A copy of any such request for additional time to protest a reissue application beyond the two months provided must be served on the reissue applicant. The request for additional time should be directed to the appropriate group director. The request for additional time beyond the two months provided 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 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 § 1901.05, and referred to the examiner having charge of the subject matter involved for entry in the application file, if the protest sufficiently identifies the application, and for such consideration as is warranted.

1901.05 Initial Office Handling and Acknowledgment of Protest [R-1]

Section 1.291(a) indicates that protests submitted under the section will be acknowledged. The type and form of the acknowledgment, and by whom it is made, will be determined by the nature of the issues raised in the protest, and whether or not the protestor has access to the application to which the protest is directed.

Protests filed alleging, or involving, "fraud" or "violation of the duty of disclosure" will normally be acknowledged by the Office of the Assistant Commissioner for Patents. Other protests not alleging or involving "fraud" or "violation of the duty of disclosure" will normally be acknowledged by the group director of the examining group where the application is pending.

The type and form of the acknowledgment will depend upon whether or not protestor has access to the application. Original applications are 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

applications are decided by the Solicitor pursuant to delegation contained in § 1002.02(k). Reissue applications filed on, or after, March 1, 1977, are, pursuant to 37 CFR 1.11(b), "open to inspection by the general public." Accordingly, unless protestor has been granted access to an original application or the protest is filed in an open reissue application, the acknowledgment must be carefully worded so as not to disclose whether or not an application exists. Office personnel must exercise care not to inadvertently disclose the existence or status of applications to protestors unless they are entitled to access.

If the application is not available to the public and the protestor does not have access, the acknowledgment may be a bare acknowledgment of receipt such as the following:

"Receipt is acknowledged of a protest under 37 CFR 1.291 filed by _____ on _____ The protest will be referred to the examiner having charge of the subject matter involved."

A copy of the acknowledgment sent to the protestor will be made of record in the application file and another copy sent to the applicant or applicant's attorney or agent if the protest has specifically identified the application to which the protest is directed. In such a situation where the application is specifically identified, or can be identified with certainty, the protest will also be made of record in the application file.

Those protests which allege or involve "fraud" or "violation of the duty of disclosure," if not initially directed to the Office of the Assistant Commissioner for Patents, are required to be referred to that Office, along with the relevant application files, as soon as the issues relating to "fraud" or "violation of the duty of disclosure" are recognized. The Office currently follows a policy of deferring consideration of issues of "fraud" or "violation of the duty of disclosure" until all other issues are settled. Accordingly, the Office of the Assistant Commissioner for Patents will normally acknowledge the protest and return the application, along with any appropriate examining instructions, to the director of the examining group for immediate action by the examiner. If the protestor has access to the application, the acknowledgment of the protest may be included in any letter which is mailed to applicant by the Office of the Assistant Commissioner for Patents, e.g., a decision giving detailed examining instructions to the examiner. In such event, a copy of the letter to the applicant will also be mailed to the protestor. If the protestor does not have access, the acknowledgment of the pro-

test must not include any references to or identification of, the application.

If the protest filed in the Office does not 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's acknowledgment 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.

1901.06 Examiner Treatment of Protest [R-2]

Current Office practice as defined in § 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.

Initial Review

An examiner initially receiving a protest will immediately review the same to ensure that it has been considered by either the group director or the Office of the Assistant Commissioner for Patents, or both. If the application file does not reflect such consideration, the examiner will immediately refer the protest and the application, via the supervisory primary examiner, to the group director. The examiner will, in the same review, check 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 the review by the examiner reveals the presence of issues of "fraud" or "violation of the duty of disclosure," and the application has not earlier been referred to the Office of the Assistant Commissioner for Patents, the examiner will call this to the attention of the supervisory primary examiner

→ for such referral via the group director (see § 2020.03).

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 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.

The following suggested format can be used to offer applicant an opportunity to file comments on the protest:

"A protest against the issuance of a patent based on this application has been filed under 37 CFR 1.291(a) on _____ and a copy (has been indicated as having been served on applicant) (is attached hereto). Any comments or response applicant desires to file before consideration of the protest must be filed by _____."

Clarification Sought From Protestor With Access

If the protestor has access to the application, 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."

While the examiner should not normally need clarification and/or additional information from the protestor where the grounds involve only published prior art, e.g., patents, periodicals, etc., under some circumstances it may be necessary for the examiner to seek such clarification and/or additional information. For

example, if the date of a reference is in question, or some question of public use is involved, and the information being sought is within the knowledge or control of the protestor, the examiner may find it necessary to communicate with the protestor to obtain the same. Of course, if the protestor does not have access to the application the examiner cannot communicate with the protestor.

Referred From Office of Assistant Commissioner for Patents

If the protest has been referred for examination with examining instructions from the Office of the Assistant Commissioner for Patents, the examiner must carefully consider and closely follow such instructions during the examination.

Treatment of Timely Submitted Protest

If the protest has been timely submitted, i.e., before final rejection or allowance, the examiner will consider each of the prior art or other documents submitted. 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. If the examiner does not cite, on form PTO-892, all of the prior art or other documents submitted, 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.

Protest Filed After Final Rejection or Allowance

If the protest is filed after final rejection or allowance of the application, 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 § 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 Section 1.291(a), 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 appropriate 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 should 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 should be specifically covered.

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-1]

The degree of protestor participation in the examination depends, to a large extent, on whether or not protestor has access to the application. 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. Of course, if protestor does have access to the application, the protestor may monitor the proceedings and file such additional papers as the protestor considers appropriate.

1901.07(a) Service of Copies [R-2]

Where a protestor has access to an application, protestor may request the Office to supply protestor with copies of Office actions or other documents mailed by the Office. Such a request should be directed to the particular area of the Office in which the application is pending, e.g., Office of the Assistant Commissioner for Patents, or director of a particular examining group. The request should explain why the protestor needs the copies and should indicate protestor's intent to assist the Office in its examination by supplying relevant written comments and information thereon. Normally, the Office

of the Assistant Commissioner for Patents or the director will grant the request to mail copies of Office actions to a protestor where the protestor indicates an intent to review the actions and, if appropriate, comment to the Office on them. However, since the protestor has no right to copies of Office actions or other documents, the granting or denying of such requests is within the sole discretion of, and for the convenience of, the Office.

Similarly, where a protestor has access to an application, protestor may request that the Office require service of copies on protestor of papers filed by applicant or other parties. Such a request will be granted by the Office of the Assistant Commissioner for Patents or the director only where protestor has served copies of the protest and any subsequent papers on applicant as required by 37 CFR § 1.291(c). The granting will normally include the requirement that each of the parties serve copies of any papers on each other, and is, as set forth above, within the sole discretion of, and for the convenience of, the Office.

The following general format may be used in letters granting service of copies:

"In view of the filing of a protest on ----- and of access by reason of -----, and to expedite the proceedings before the Office, it is appropriate that copies of this decision and any subsequent actions on the merits by the examiner be mailed to the protestor -----

"Furthermore, a copy of any papers filed in this application by either the applicant or the protestor, must be *served* on the other party, which service should be reflected by a certificate of service attached to any paper filed."

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 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 Patent Issue 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 Patent Issue Division sending the Notice of Allowance (multipart forms) to the Applicant and a single copy to the protestor.

1901.07(b) Comment Period for Protestor [R-1]

Where the examiner feels that a protestor with access to an application can contribute significantly to the examination process, the protestor may be given a specific period, normally one month, within which to comment on responses submitted by patent applicants to Office actions. Such a comment period should only be provided where it would appear to be of benefit to the examination process and only with the approval of a supervisory primary examiner. Where an applicant agrees to such participation by a protestor or where a Court has suspended litigation for consideration of a related application by the Patent and Trademark Office with an expression of its desire for such protestor participation, comment periods should be more liberally granted.

1901.07(c) Filing of Multiple Papers Relating to the Same Issues [R-4]

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 file becomes unduly expanded and unnecessary delays in the examination are encountered. Therefore, applicants and protestors should endeavor to make their first submission with regard to a specific issue(s) as complete as possible in order to avoid the necessity to file multiple papers. Any rebuttal to the first submission of either party *must be timely filed and accompanied by a showing of good and sufficient reasons* why such rebuttal is necessary and was not earlier presented. Additionally, any rebuttal filed by either party should be preferably hand carried to the director of the examining group in which the application is presently located. If the application is situated in an area other than the examining group, then the rebuttal paper should be hand carried to the appropriate official of that area. If the group director or appropriate official of another area determines that an adequate showing has been made by the party so as to justify entry, the rebuttal paper will be so stamped indicating such approval and placed in the application file. Notice of its entry will

be included in the next office communication by the primary examiner or other appropriate official. Should the group director or the appropriate official of another area determine that an adequate showing *has not* been made to justify entry of the rebuttal, a written decision will be mailed to all the parties setting forth the reason(s) for the denial. Furthermore, any *future filings* by the party relating to the same issue(s) will be refused consideration and the parties will be so notified. In such case, the submission will be placed in the application file and a notation will be placed on the submission to indicate it has not been considered.

1902 Protestor Participation In Interviews [R-1]

A protestor having access to an application can request to be allowed to participate in any interviews between the applicant and the examiner, or can 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 represented, 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.

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 § 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 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-1]

The authority for granting inter partes interviews resides with each group director, unless treated by the Office of the Assistant Commissioner for Patents due to a request included in a paper before the Assistant Commissioner.

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 Inter-
views [R-1]**

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 that 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 no. 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 no. 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*, and the protestor must have access to the application.

1902.01(b) Circumstances Where Inter Partes Interviews Would Normally Not Be Justified [R-1]

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.

1. 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).

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

Of course, if the group director is of the opinion that an inter partes interview would be helpful then it may be granted regardless of the issues involved.

1902.01(c) Notice of Interviews [R-1]

If 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 inter-

view 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.

1902.01(d) Extensions of Time [R-1]

Extensions of time should normally not be granted merely to schedule and hold an inter partes interview with the examiner. If *adequate reasons* can be shown then the period for response to an Office action may be extended for a *short period* in view of the interview. In those reissue applications with related litigation where one month response periods are provided extensions may be needed more often. Where litigation is involved every effort should be made to hold any interview within the time period for response and any extension should be for no more than a few days, e.g., five working days.

1903 Guidelines for Conducting Interviews [R-1]

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 [R-1]

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 Appeals [R-1]

A protestor cannot appeal a decision by the examiner adverse to the protestor to the Board of Appeals. While the protestor cannot appeal the examiner's decision to the Board of Appeals, the Office does permit protestor participation in appeals filed by the applicant under 35 U.S.C. 134 and 37 CFR 1.191 if protestor has access to the application.

A protestor with access to an application appealed to the Board of Appeals who intends to file comments or a brief 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.

A protestor 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 Appeals, 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 Appeals 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).

1905 Protestor Participation Before the Office of The Assistant Commissioner for Patents [R-1]

If protestor has access, protestor may monitor the proceedings and file such papers as protestor considers appropriate. A protestor with access may also request service of copies as set forth in § 1901.07. If the protestor has access and makes appropriate written request the protestor may be permitted to participate in any proceedings before the Office of the Assistant Commissioner for Patents.

1906 Supervisory Review of an Examiner's Decision Adverse to Protestor [R-1]

As pointed out in § 1904, a protestor cannot appeal to the Board of Appeals from an adverse decision of the examiner. 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 acknowledgement of any right of review in the protestor.

1907 Unauthorized Participation By Protestor [R-1]

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.

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. While the examiner may communicate in writing with a protestor having access to the application, the examiner will not communicate orally 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 specifi-

cally authorized in writing by the Assistant Commissioner for Patents.

1920 Citation of Prior Art under 37 CFR 1.291(b) [R-1]

37 CFR 1.291(b) permits the public to submit citations of prior art and any papers related thereto to the Patent and Trademark Office after a patent has been granted. Such citations and papers will be entered in the patent file at the request of the submitting party. Both the citations and papers are entered without comment by the Office. The words "and any papers related thereto" recognize that statements as to patentability of the claims and the pertinence of prior art may be submitted. Under § 1.291(b) a member of the public can have information placed in the patented file which might have been the subject of a protest under § 1.291(a) if submitted during the pendency of the application which issued as the patent to which the information refers. The material submitted under § 1.291(b) is not examined by the Office (except where a reissue application thereon is later filed), but is available to members of the public inspecting the patent file.

As with protests any member of the public, private or corporate, and government agencies, may file the citations and papers under § 1.291(b).

Citations of prior art and papers relating thereto, to be entered in a patent file under § 1.291(b), should be filed with the Patent and Trademark Office directed "to the attention of the Record Room;" and should identify the patent by:

1. patent number;
2. patent date;
3. name(s) of patentee; and,
4. title.

1921 Service of Copies [R-1]

As required by § 1.291(c), copies of all materials submitted to the Office under § 1.291(b) should be served upon the patentee or upon the patentee's attorney or agent. The word "patentee" includes not only the person(s) to whom the patent issued, but also the successor in title to the patentee: 35 U.S.C. 100. If service is not possible, materials must be filed in duplicate so that the Office can attempt to serve the duplicate copy. However, every effort should be made by the submitting party to effect service, which service should be evidenced by a certificate of service attached to the submitted citation and papers.

1922 Handling by Office of Citations and Related Papers Filed Under § 1.291(b) [R-1]

Citations of prior art and any papers relating thereto, filed under § 1.291(b) to be made of record in a patented file, should be directed to the attention of the Record Room, where they will be entered without comment by the Office. Should a duplicate copy be received, as required by § 1.291(c) where service on the patentee or the patentee's attorney or agent has not been indicated, employees of the Record Room should mail the duplicate to the attorney or agent of record in the patent file. If the duplicate is returned undelivered, it should be re-mailed to the patentee.

The status of such duplicate papers should be

indicated by Record Room Employees as set forth above. Typical entries would appear as:

"16. Rule 1.291(b) Protect Papers/Sept. 17, 1977/(Service indicated)/(Entry clerk's name); or

16. Rule 1.291(b) Protest Papers/Sept. 17, 1977/duplicate papers mailed Oct. 14, 1977/(Entry Clerk's name)".

The entry clerk is not required to closely review these papers. However, should a cursory review indicate that they contain clearly derogatory or abusive language, the papers should be brought to the attention of the Office of the Assistant Commissioner for Patents, building 3, room 11A13.

Office personnel are cautioned that § 1.291(b) provides for entry "without comment" and this precludes substantive discussions with persons outside the Office as to the merit, or lack of merit, of any submissions under § 1.291(b).