

# Chapter 1900 Protest

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## 1901 Protest Under 37 CFR 1.291

*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 submitted prior to the mailing of a notice of allowance under § 1.311; 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.

(b) 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 returned to the protestor and will not be further considered by the Office. A protest submitted in accordance with the second sentence of paragraph (a) of this section will be considered by the Office if the application is still pending when the protest and application file are brought before the examiner and 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 a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgment by the Office that the protest has been received. In the absence of a request by the Office, an applicant has no duty to, and need not, reply 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, except for additional prior art, or unless such submission raises new issues which could not have been earlier presented.

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

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

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

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

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

(4) 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.

The degree of participation allowed a protestor is solely within the discretion of the Commissioner of Patents and Trademarks. Any protest against a pending application which is filed after December 8, 1981 will be treated in accordance with the procedures set forth in this Chapter. 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. 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.

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 submitted prior to the mailing of a notice of allowance under 37 CFR 1.311 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 the protest is submitted in accordance with 37 CFR 1.291(a), the application is still pending when the protest and application file are brought before the examiner, and the protest includes:

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

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

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

(D) an English language translation of all necessary and pertinent parts of any non-English language document relied on.

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. Active participation by a protestor "ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, except for additional prior art, or unless such submission raises new issues which could not have been earlier presented." 37 CFR 1.291(c). The PTO will acknowledge the receipt of a protest in an original or a reissue application file only if a self-addressed postcard is included with the protest (see MPEP § 1901.05). The question of whether or not a patent will issue is a matter between the applicant and the Office acting on behalf of the public.

### 1901.01 Who Can Protest

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

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 on. The Office recognizes that when evidence other than prior art documents is relied on, problems may arise as to authentication and the probative

value to assign to such evidence. However, the fact that such problems may arise, and have to be resolved, does not preclude the Office from considering such evidence, nor does it mean that such evidence cannot be relied on in a protest under 37 CFR 1.291. Information in a protest should be set forth in the manner required by 37 CFR 1.291(b).

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

(A) 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.

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

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

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

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

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

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

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 evi-

dence 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

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 on; 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 on. Protestors are encouraged to use form PTO-1449 "Information Disclosure Statement" 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:

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

In addition to the above information, the protest itself should be clearly identified as a "PROTEST UNDER 37 CFR 1.291(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 Assistant Commissioner for Patents, 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 Petitions, Crystal Park 1, Room 520, along with as much identifying data for the application as possible. Protests which do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office.

Where a protest is directed to a reissue application for a patent which is involved in litigation, the outside envelope and the top right-hand portion of the protest should be marked with the words "REISSUE LITIGATION." The notations preferably should be written in a bright color with a felt point marker. Any "REISSUE LITIGATION" protest mailed to the Office should be so marked and mailed to 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 replies should be hand-carried to the appropriate area in the Office.

**INITIAL PROTEST SUBMISSION MUST BE COMPLETE**

A protest must be complete and contain a copy of every document relied on by protestor, whether the document is a prior art document, court litigation material, affidavit, or declaration, etc., because a protestor will *not* be given an opportunity to supplement or complete any protest which is incomplete. Active participation by protestor ends with the filing of the initial protest, as provided in 37 CFR 1.291(c), and no further submission on behalf of protestor will be acknowledged or considered, except for additional prior art, or 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 reply would not qualify as a new protest. Likewise, additional comments seeking to bring in further or even new data or information with respect to an issue previously raised by protestor would not qualify as a new protest.

Even new protests which also argue Office actions or replies or any matter beyond the new issue should not be accepted. Improper protests will be returned 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 on in order to ensure consideration by the examiner, although a protest without copies of prior art documents will not necessarily be ignored. While a protest without copies of documents will not necessarily be ignored, the submission of such documents with the protest will obviously expedite 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 serve a copy of the protest upon the attorney or agent of record or upon the applicant if no attorney or agent is of record. Of course, the copy served upon applicant or upon applicant's attorney or agent should be a complete copy including a copy of each prior art or other document relied on in the same manner as required by 37 CFR 1.291(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**

A protest under 37 CFR 1.291(a) must be submitted prior to the mailing of a notice of allowance under 37 CFR 1.311 and the application must be pending when the protest and application file are brought before the examiner in order to be ensured of consideration. As a practical matter, any protest should be submitted as soon as possible after the protestor becomes aware of the existence of the application to which the protest is to be directed. By submitting a protest early in the examination process, i.e., before the Office acts on the application if possible, the protestor ensures that the protest will receive maximum consideration and will be of the most benefit to the Office in its examination of the application. A protest submitted after the mailing of the notice of allowance will not knowingly be ignored if the protest includes prior art documents which clearly anticipate or clearly render obvious one or more claims. However, the likelihood of consideration of a protest decreases as the patent date approaches.

A protest submitted prior to the mailing of a notice of allowance under 37 CFR 1.311 will be entered in the application file. A protest filed after final rejection will be considered if the application is still pending when the protest and application are provided to the examiner. However, prosecution will not ordinarily be reopened after final rejection if the prior art cited in the protest is merely cumulative of the prior art cited in the final rejection. If a protest is not submitted prior to the mailing of a notice of allowance under 37 CFR 1.311 it will be acknowledged as set forth in MPEP § 1901.05 only if a self-addressed postcard is included with the protest, and referred to the examiner having charge of the subject matter involved for handling as set forth in MPEP § 1901.06.

A protest with regard to a reissue application should be filed within the 2-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 2-month period provided by 37 CFR 1.176, the protest can be submitted at a later time, but the protestor must be aware that reissue applications are "special" and a later filed protest may be received after action by the examiner. Any request by a protestor in a reissue application for an extension of the 2-month period following the announcement in the *Official Gazette* 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 under 37 CFR 1.182 and the petition fee must be filed prior to the expiration of the 2-

month period provided by 37 CFR 1.176. 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 which will forward the petition to the Office of the Deputy Assistant Commissioner for Patent Policy and Projects for decision. Any such petition will be critically reviewed as to demonstrated need before being granted since the delay of examination of a reissue application of another party is being requested. Accordingly, the requests should be made only where necessary, for the minimum period required, and with a justification establishing the necessity for the extension.

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 2-month delay period of 37 CFR 1.176 in appropriate circumstances. Accordingly, protestors to reissue applications cannot automatically assume that the full 2-month delay period of 37 CFR 1.176 will always be available.

If a protest is filed in a reissue application related to a patent involved in a pending interference proceeding, the reissue application should be referred to the Office of the Deputy Assistant Commissioner for Patent Policy and Projects before considering the protest and acting on the application. See also MPEP § 1441 as to the filing of a protest in a reissue application.

## **1901.05 Initial Office Handling and Acknowledgment of Protest**

### **PROTESTS REFERRED TO EXAMINER**

Protests filed against pending applications will be referred to the examiner having charge of the subject matter involved. 37 CFR 1.291(a). A protest specifically identifying the application to which it is directed will be entered in the application file, if (1) the protest is submitted prior to the mailing of a notice of allowance under 37 CFR 1.311 (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. 37 CFR 1.291(a).

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.

### **ACKNOWLEDGMENT OF PROTEST**

A protestor in an original or reissue application will not receive any communications from the Office relating to the protest, or to the application, other than the return of a self-addressed postcard which protestor may include with the protest in order to receive an acknowledgment that the protest has been received by the Office. 37 CFR 1.291(c). The Office will acknowledge a protest by return of the self-addressed postcard prior to the protest's entry into the application file or return to the protestor, as appropriate.

### **APPLICATIONS AND STATUS THEREOF MAINTAINED IN CONFIDENCE**

The postcard acknowledging receipt of a protest in other than a reissue application will not and must not indicate whether such application in fact exists or the status of any such application. Office employees must exercise care to ensure that matters relating to applications are *not* discussed with protestor or communicated in writing to protestor. Original applications are, of course, required by 35 U.S.C. 122 to be kept in confidence. Thus, unless a protestor has been granted access to an original application, the protestor is not entitled to obtain from the Office any information concerning the same, including the mere fact that such an application exists. Petitions for access to patent applications with the exception of applications involved in or related to a proceeding before the Board of Patent Appeals or Interferences are decided by the Office of Petitions pursuant to delegation contained in MPEP § 1002.02(b). Reissue applications filed on, or after, March 1, 1977 are pursuant to 37 CFR 1.11(b) "open to inspection by the 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), including replies to specific questions raised by the protest, in order for the Office to decide any issues raised thereby. Under 37 CFR 1.291(c), the examiner can require the applicant to reply to the protest and answer specific questions raised by the protest.

## 1901.06 Examiner Treatment of Protest

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

### INITIAL REVIEW

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

(A) To ensure that either the protest or the application file 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.

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

If a protest is filed in a reissue application and the reissue application is related to a patent involved in a pending interference proceeding, such application should be referred to the Special Program Law Office 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 nec-

essary, to obtain applicant's comments on the protest before further action. In such situations, the examiner will offer applicant an opportunity to file comments within a set period, usually 1 month, unless circumstances warrant a longer period.

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

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

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

#### Examiner Note:

1. Applicant is normally given one month to submit any comments, unless circumstances in the case would warrant a longer period.
2. A copy of this Office action is NOT sent to the protestor. See 37 CFR 1.291(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 reply to the protest and answer specific questions raised by the protest. The primary examiner cannot require a reply to questions relating to "fraud," "inequitable conduct," or "violation of the duty of disclosure" since those issues are generally not commented on by the Office. Any questions directed to applicant by the primary examiner must be limited to seeking answers reasonably necessary in order for the primary examiner to decide questions raised by the protest and which are before the primary examiner for decision. The primary examiner is not permitted, under 37 CFR 1.291(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 can be used to require additional information from applicant regarding issues raised by the protest.

#### ¶ 19.02 Requirement for Information

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

#### Examiner Note:

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

### **PROTESTOR NOT PERMITTED TO COMPLETE INCOMPLETE PROTEST**

A protestor may not complete an incomplete protest, nor further participate in, or inquire as to the status of, any Office proceedings relating to the initial protest. 37 CFR 1.291. The examiner must not, therefore, communicate with protestor in any way and will not consider a later submission by protestor, except for additional prior art, or 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.

### **TREATMENT OF TIMELY SUBMITTED PROTEST**

If the protest has been timely submitted, i.e., before the mailing of a notice of allowance under 37 CFR 1.311, and the application is still pending when the protest and application file are brought before the examiner, 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 the 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 to 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 the 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 to the citations in the boxes provided on the form PTO-1449. Where the prior art or other documents are listed by the 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 ALLOWANCE**

If the protest is not submitted prior to the mailing of a notice of allowance under 37 CFR 1.311, it should not be entered in the application file. The applicant should be notified that the protest is untimely and that it is not being entered in the application file. The handling of the protest will vary depending on the particular situation as follows.

#### **A. Service of Copy Included**

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

#### **B. Service of Copy Not Included**

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

### **COPIES OF DOCUMENTS NOT SUBMITTED**

If the protest is not accompanied by a copy of each prior art or other document relied on as required by 37 CFR 1.291(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, the examiner must give careful consideration to the points and arguments made on behalf of the protestor. Any Office action by the examiner treating the merits of a timely submitted protest complying with 37 CFR 1.291(b) must specifically con-

sider 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 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 December 1, 1997, 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, except for additional prior art, or unless such submission raises new issues which could not have been earlier presented."

37 CFR 1.291(c) was amended effective December 1, 1997, by removing the blanket limitation of one protest per protestor, and now provides for a second or subsequent submission in the form of additional prior art. However, mere argument that is later submitted by an initial protestor would not be entered and would be returned unless it is shown that the argument relates to a new issue that could not have been earlier raised. Prior art submitted by a previous protestor prior to the mailing of the notice of allowance under 37 CFR 1.311 will be made of record without a showing that it relates to a new issue. However, it should be noted that entry of later submitted prior art in the file record does not assure its consideration by the examiner if submitted late in the examination process. See MPEP § 1901 and § 1901.04. Accordingly, initial protests should be as complete as possible when first filed. 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 Office does not serve copies of Office actions or other documents

mailed by the Office on protestors, and does not require applicants to serve copies of papers filed with the Office on protestors. Furthermore, a protestor is not permitted to participate in interviews, appeal a decision by the examiner adverse to the protestor to the Board of Patent Appeals and Interferences, or participate in an appeal by applicant. The disposition of the protest will, 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 reply to a protest. Any reply thereto would be *ex parte* and would not be served on the 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) Filing of Multiple Papers Relating to Same Issues

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, except for additional prior art, or 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 reply 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 replies or any matter beyond the new issue should not be accepted. Improper protests will be refused consideration and 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.

#### 1906 Supervisory Review of an Examiner's Decision Adverse to Protestor

As pointed out in MPEP § 1901.07, a protestor cannot appeal to the Board of Patent Appeals and Interferences from an adverse decision of the examiner. Further, a decision by 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.

**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 the 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. See 37 CFR 1.291(c).

**1920 Citation of Prior Art Under 37 CFR1.501(a)**

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



MANUAL OF PATENT EXAMINING PROCEDURE