

# Chapter 1900 Protest

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## **1901 Protest Under 37 CFR 1.291 [R-10.2019]**

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

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

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

(1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is filed prior to the date a notice of allowance under [§ 1.311](#) was given or mailed in the application.

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

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

(1) An information list of the documents, portions of documents, or other information being submitted, where each:

(i) U.S. patent is identified by patent number, first named inventor, and issue date;

(ii) U.S. patent application publication is identified by patent application publication number, first named inventor, and publication date;

(iii) Foreign patent or published foreign patent application is identified by the country or patent office that issued the patent or published the application; an appropriate document number; the applicant, patentee, or first named inventor; and the publication date indicated on the patent or published application;

(iv) Non-patent publication is identified by author (if any), title, pages being submitted, publication date, and, where available, publisher and place of publication; and

(v) Item of other information is identified by date, if known;

(2) A concise explanation of the relevance of each item identified in the information list pursuant to paragraph (c)(1) of this section;

(3) A legible copy of each item identified in the information list, other than U.S. patents and U.S. patent application publications;

(4) An English language translation of any non-English language item identified in the information list; and

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

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

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

(f) In the absence of a request by the Office, an applicant need not reply to a protest.

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

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

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

- (1) By delivering a copy of the paper to the person served;
- (2) By leaving a copy at the usual place of business of the person served with someone in his employment;
- (3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;
- (4) Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service;
- (5) Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the *Official Gazette*.

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

- (1) An acknowledgement of service by or on behalf of the person served or
- (2) A statement signed by the attorney or agent containing the information required by this section.

(c) See [§ 41.106\(e\)](#) or [§ 42.6\(e\)](#) of this title for service of papers in contested cases or trials before the Patent Trial and Appeal Board.

The degree of participation allowed a protestor is solely within the discretion of the Director of the USPTO.

[37 CFR 1.291](#) gives recognition to the value of written protests in bringing information to the attention of the Office and in avoiding the issuance of invalid patents. With the exception of a protest accompanied by a written consent of the applicant, all protests must be submitted prior to the publication of the application or the date a notice of allowance is given or mailed, whichever occurs first. No protest or "other form of preissuance opposition to the grant of a patent" may be initiated after publication of the application without the applicant's express written consent as specified by [35 U.S.C. 122\(c\)](#). Even if applicant's express written consent is given, the protest must be filed prior to the date a notice of allowance is given or mailed. Third parties wishing to submit information in the form of patents and printed publications after publication of the

application might consider whether a third-party submission under [35 U.S.C. 122\(e\)](#) would be appropriate. See [MPEP § 1134.01](#).

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

A protest may not be filed in a provisional application because provisional applications are not examined. A protest filed in a provisional application will not be entered and will be discarded pursuant to [37 CFR 1.291\(g\)](#).

[37 CFR 1.291\(b\)](#) provides that a timely received protest will be entered into the record of the application if, in addition to complying with the requirements of [37 CFR 1.291\(c\)](#), the protest is accompanied by the statement under [37 CFR 1.291\(b\)\(2\)](#) or it complies with [37 CFR 1.291\(c\)\(5\)](#), and is either served upon the applicant, or is filed in duplicate in the event service is not possible. In the event a duplicate protest is enclosed for the applicant, the protest should be accompanied by an explanation of why service on applicant could not be made.

[37 CFR 1.291\(c\)](#) requires that the protest must include:

(A) An information list of the documents, portions of documents, or other information being submitted, where each:

- (1) U.S. patent is identified by patent number, first named inventor, and issue date;
- (2) U.S. patent application publication is identified by patent application publication number, first named inventor, and publication date;

(3) Foreign patent or published foreign patent application is identified by the country or patent office that issued the patent or published the application; an appropriate document number; the applicant, patentee, or first named inventor; and the publication date indicated on the patent or published application;

(4) Non-patent publication is identified by author (if any), title, pages being submitted, publication date, and, where available, publisher and place of publication; and

(5) Item of other information is identified by date, if known.

(B) A concise explanation of the relevance of each item identified in the information list;

(C) A legible copy of each item identified in the information list, other than U.S. patents and U.S. patent application publications;

(D) An English language translation of any non-English language item identified in the information list; and

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

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

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

(3) the processing fee under [37 CFR 1.17\(i\)](#).

As to item (A) above, [37 CFR 1.291\(c\)\(1\)\(iii\)](#) provides flexibility in permitting identification of foreign patents and published foreign patent applications by the applicant, patentee or first named inventor. Likewise, [37 CFR 1.291\(c\)\(1\)\(iv\)](#) only requires identification of the author, publisher, and place of publication of a non-patent publication if that information is available. It is noted that [37 CFR 1.291\(c\)\(1\)\(iv\)](#) does not preclude a protestor from providing additional information that is not specified. For example, a protestor may provide a journal title and volume/issue information for a journal article. [37 CFR 1.291\(c\)\(1\)\(v\)](#) provides for the submission of information other than patents and publications, including any facts or information adverse to

patentability, and requires that each item of “other information” be identified by date, if known. For example, if a publication date for a document is not known and the document is not being relied upon as a publication, the protestor may list such document as an item of other information under [37 CFR 1.291\(c\)\(1\)\(v\)](#).

As to item (C) above, where only a portion of a document is listed as an item in the information list, only a copy of that portion must be submitted. It is not required to submit the entire document. In addition, when only a portion of a document is submitted, the protestor should also submit copies of pages of the document that provide identifying information. For example, if the item in the information list is identified as a certain chapter in a text book, then only a copy of that identified chapter along with copies of the pages that provide identifying information (e.g., a copy of the cover, title page, and copyright information page) should be submitted with the protest.

As to item (D) above, the required English language translation of any non-English item of information may be a reliable machine translation and need not be certified. In addition, where only a portion of a non-English language document is listed as an item in the information list, only a copy of that portion must be submitted along with an English translation of that portion.

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

A party obtaining knowledge of an application pending in the Office may file a protest against the application and may therein call attention to any facts within protestor’s knowledge which, in the protestor’s opinion, would make the grant of a patent on the application improper. The party should include with the protest whatever information the party is aware of that would facilitate identification of the application and matching the protest with the application. Where the protest specifically identifies the application, and is otherwise compliant, the protest will be considered by the Office if it is

matched with the application in time to permit review by the examiner during prosecution. If there is insufficient information to identify the application, the protest may not be matched at all or not timely matched with the intended application to permit review by the examiner during prosecution of the application, in which case, the protest may not be entered and may be returned to the protestor where practical. If return is not practical, the protest will be discarded. [37 CFR 1.291\(a\)](#). See [MPEP § 1901.03](#).

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

### **1901.01 Who Can Protest [R-10.2019]**

Any member of the public, including private persons, corporate entities, and government agencies, may file a protest under [37 CFR 1.291](#). A protest may be filed by an attorney or other representative on behalf of an unnamed real party in interest. [37 CFR 1.291](#) does not require that the real party in interest be identified. In accordance with [37 CFR 1.291\(b\)\(2\)](#), a statement must accompany the protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest. Where a protest is not the first protest by the real party in interest, [37 CFR 1.291\(b\)\(2\)](#) requires compliance with [37 CFR 1.291\(c\)\(5\)](#). The requirements of [37 CFR 1.291\(c\)\(5\)](#) cannot be avoided by multiple protests submitted by different people representing the same real party in interest. [37 CFR 1.291\(b\)\(2\)](#) does not apply to the first protest in an application. A protestor may not know if a protest has already been filed (by another), and may have no way of checking (e.g., a non-reissue application for which the file wrapper is not publicly available). Should the protest (inadvertently or otherwise) fail to include

the statement that the protest is the first protest by the real party in interest filing the current protest and fail to comply with [37 CFR 1.291\(c\)\(5\)](#), if, in fact, the protest is the first filed protest in an application, it will be considered where all other conditions are met.

### **1901.02 Information Which Can Be Relied on in Protest [R-10.2019]**

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

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

(A) Information demonstrating that the invention was publicly known or used by others and is barred from patenting under [35 U.S.C. 102\(a\)\(1\)](#) and/or [103](#) or [pre-AIA 35 U.S.C. 102\(a\)](#) and/or [103](#).

(B) Information that the invention was in public use or on sale and is barred from patenting under [35 U.S.C. 102\(a\)\(1\)](#) or [pre-AIA 35 U.S.C. 102\(b\)](#).

(C) Information that the inventor “has abandoned the invention” ([pre-AIA 35 U.S.C. 102\(c\)](#)) or “did not himself invent the subject matter sought to be patented” ([35 U.S.C. 101](#) and/or [pre-AIA 35 U.S.C. 102\(f\)](#)).

(D) Information relating to inventorship under [pre-AIA 35 U.S.C. 102\(g\)](#).

(E) Information relating to compliance with [35 U.S.C. 112](#).

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

(G) Information indicating “fraud” or “violation of the duty of disclosure” under [37 CFR 1.56](#) may be the subject of a protest under [37 CFR 1.291](#). Protests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues. [37 CFR 1.291\(e\)](#). See [MPEP § 2013](#).

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

In a protest based on an alleged public use or sale, 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, 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.

While the forms in which evidence and/or information may be submitted with, or as a part of, a protest under [37 CFR 1.291](#), are not limited, protestors must recognize that such submissions may encounter problems such as establishing authenticity and/or the probative value to apply to the evidence. Obviously, the Office will have to evaluate each item of evidence and/or information submitted with

a view as to both its authenticity and what weight to give thereto.

Information which is subject to a court-imposed protective or secrecy order may be submitted with, or as a part of, a protest under [37 CFR 1.291](#). Trade secret information which was obtained by a protestor through agreements with others can likewise be submitted. Such information, if submitted in accordance with [MPEP § 724](#), will be treated as set forth therein 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. To ensure that the Office recognizes the protected/secret material, the protestor should follow the procedures in [MPEP § 724](#).

### **1901.03 How Protest Is Submitted [R-10.2019]**

A protest under [37 CFR 1.291](#) must be submitted in writing, must specifically identify the application to which the protest is directed by application number or serial number and filing date, and must include an information list of all documents, portions of documents, or other information submitted; a concise explanation of the relevance of each listed item; an English language translation of any non-English language document or other information identified in the information list; and be accompanied by a copy of each item in the information list except for U.S. patents and U.S. patent application publications. Protestors are encouraged to use form PTO/SB/08A and 08B “Information Disclosure Statement By Applicant” (or an equivalent form) when preparing a protest under [37 CFR 1.291](#), especially the information list under [37 CFR 1.291\(c\)\(1\)](#). See [MPEP § 609.04\(a\)](#). In addition, the protest and any accompanying papers must either (1) reflect that a copy of the same has been served upon the applicant or upon the applicant’s attorney or agent of record; or (2) be filed with the Office in duplicate in the event service is not possible. In the event a duplicate protest is enclosed for the applicant, the protest should be accompanied by an explanation of why service on applicant could not be made.

Each protest should be clearly identified as a “PROTEST UNDER [37 CFR 1.291](#).” It is also 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 first page of the protest:

- (A) Name of inventor(s)
- (B) Name of applicant(s).
- (C) Application number.
- (D) Filing date of application.
- (E) Title of invention.
- (F) Art unit number (if known).
- (G) Name of examiner to whom the application is assigned (if known).

In addition to the above information, if the protest includes exhibits or other attachments, these should also contain identifying information thereon in order to prevent them from becoming inadvertently separated and lost.

Any protest can be submitted by mail to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. A protest must NOT be submitted electronically via EFS-Web.

If the protestor is unable to specifically identify the application to which the protest is directed by application number, but, nevertheless, believes such an application to be pending, the protest should be directed to the attention of the Office of Petitions (using Mail Stop Petition), along with as much identifying data for the application as possible. Protests which do not adequately identify a pending patent application will be returned to the protestor or discarded, and will not be further considered by the Office.

Where a protest is directed to a reissue application for a patent which is involved in litigation, the outside envelope and the top right-hand portion of the protest should be conspicuously marked with the words "REISSUE LITIGATION." Any "REISSUE LITIGATION" protest mailed to the Office should be so marked and mailed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

## I. A PROTEST SUBMISSION MUST BE COMPLETE

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

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

Every effort should be made by a protestor to serve a copy of the protest upon the attorney or agent of

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

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 protest will not be entered. If the protest is filed in duplicate and otherwise compliant, the Office will forward the protest to the correspondence address of record, and 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 application file history.

#### **1901.04 When Can the Protest Be Submitted [R-10.2019]**

Pursuant to [37 CFR 1.291\(b\)](#), a protest is timely if (1) filed prior to the date the application was published under [37 CFR 1.211](#) or the date a notice of allowance under [37 CFR 1.311](#) was given or mailed, whichever occurs first, or (2) accompanied by written consent of the applicant and filed prior to the date a notice of allowance under [37 CFR 1.311](#) was given or mailed in the application. Publication under the Patent Cooperation Treaty (PCT) by the World Intellectual Property Organization (WIPO) of an international application would not trigger the end of the [37 CFR 1.291\(b\)](#) time period for submitting a protest in a national stage application under [35 U.S.C. 371](#). Likewise, publication under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs by WIPO of an international registration would not trigger the end of the [37 CFR 1.291\(b\)](#) time period for submitting a protest in a nonprovisional international design application.

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 be of the most benefit to the Office in its examination of the application. A protest submitted on or after the date a notice of allowance under [37 CFR 1.311](#) was given or mailed will not be entered and will be discarded pursuant to [37 CFR 1.291\(g\)](#).

A protest filed after final rejection (and prior to the date the notice of allowance is given or mailed) and complying with all the requirements of [37 CFR 1.291](#) will be considered if the application is still pending. However, prosecution will not ordinarily be reopened after final rejection if the prior art cited in the protest is merely cumulative of the prior art cited in the final rejection.

A protest filed in a reissue application is not a "form of preissuance opposition to the grant of a patent" because the patent to be reissued has already been granted. Thus, a protest may be filed in a reissue application throughout the pendency of the reissue application prior to the date a notice of allowance is given or mailed subject to the timing constraint of the examination. A protest with regard to a reissue application should, however, be filed within the 2-month period following announcement of the filing of the reissue application in the *Official Gazette*. See [MPEP § 1441.01](#). If, for some reason, the protest of the reissue application cannot be filed within the 2-month period provided by [MPEP § 1441](#), the protest can be submitted at a later time, but the protestor must be aware that reissue applications are "special" and a later filed protest may be received after action by the examiner. Any request by a protestor in a reissue application for an extension of the 2-month period following the announcement in the *Official Gazette*, and a delay of the examination until the extended period expires, will be considered only if filed in the form of a petition under [37 CFR 1.182](#) and accompanied by the petition fee set forth in [37 CFR 1.17\(f\)](#). The petition under [37 CFR 1.182](#) and the petition fee must be filed prior to the expiration of the 2-month period provided by [MPEP § 1441](#). The petition must explain why the additional

time is necessary and the nature of the protest intended. A copy of such petition must be served upon applicant in accordance with [37 CFR 1.248](#). The petition should be directed to the appropriate Technology Center (TC) which will forward the petition to the Office of Patent Legal Administration for decision. Any such petition will be critically reviewed as to demonstrate need before being granted since the delay of examination of a reissue application of another party is being requested. Accordingly, the requests should be made only where necessary, for the minimum period required, and with a justification establishing the necessity for the extension.

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

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

### **1901.05 Acknowledgment of Protest [R-10.2019]**

A protestor in an original or reissue application will not receive any communications from the Office

relating to the protest, or to the application, other than the return of a self-addressed postcard which protestor may include with the protest in order to receive an acknowledgment that the protest has been received by the Office. [37 CFR 1.291\(d\)](#). Where a self-addressed postcard is included with the protest, the Office will acknowledge receipt of the protest by return of the self-addressed postcard. Thus, it is to be noted that the receipt of the self-addressed postcard from the Office is not an indication that the protest complies with [37 CFR 1.291](#).

### **I. 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. See [MPEP § 1134](#). Original applications are, of course, required by [35 U.S.C. 122](#) to be kept in confidence unless published pursuant to [35 U.S.C. 122\(b\)](#) or are available to the public pursuant to [37 CFR 1.14\(a\)\(1\)\(iv\), \(v\), or \(vi\)](#). Thus, unless a protestor has been granted access to an original application, the protestor is not entitled to obtain from the Office any information concerning the same, including the mere fact that such an application exists. Petitions for access to patent applications with the exception of applications involved in or related to a proceeding before the Patent Trial and Appeal Board are decided by the Office of Petitions pursuant to delegation contained in [MPEP § 1002.02\(b\)](#). Reissue applications filed on, or after, March 1, 1977 are pursuant to [37 CFR 1.11\(b\)](#) “open to inspection by the public.” After an application is published pursuant to [35 U.S.C. 122\(b\)](#), the application file contents become available to the public through the Office’s public application image file wrapper via the Office’s website. In addition, a copy of the file content of the published application may be requested by filing a written request under [37 CFR 1.14\(a\)\(1\)\(i\)](#) including the fee as set forth in [37 CFR 1.19\(b\)](#).

The Office will communicate with the applicant regarding any protest entered in an application file



and may require the applicant to supply information pursuant to [37 CFR 1.291\(f\)](#), including replies to specific questions raised by the protest, in order for the Office to decide any issues raised thereby. Under [37 CFR 1.291\(f\)](#), the examiner can require the applicant to reply to the protest and answer specific questions raised by the protest. See [MPEP § 1901.06](#), subsection II.

## **1901.06 Office Treatment of Protest [R-10.2019]**

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).

### **I. INITIAL REVIEW**

Protests will not be automatically made of record in an application. The Office has designated points of contact and established procedures for reviewing protests to determine if they are compliant with the relevant provisions of [37 CFR 1.291](#) before being made of record in an application. These procedures permit compliant protests to be entered into the record of the application and made available to the examiner for consideration as early as possible.

If a compliant protest is filed in a reissue application and the reissue application is related to a patent involved in a pending interference or derivation proceeding, such application should be referred to the Office of Patent Legal Administration before the examiner considers the protest and acts on the application.

[37 CFR 1.291\(g\)](#) provides that a protest that fails to comply with [37 CFR 1.291\(b\) or \(c\)](#) may not be entered. A protest that is non-compliant with some requirement of [37 CFR 1.291\(b\) or \(c\)](#), may be entered into the record if the reviewer determines

that the error is of such a minor character that, in the opinion of the Office, it does not raise an ambiguity as to the content of the protest. For example, if an error with respect to a requirement of [37 CFR 1.291\(c\)](#) is of such a nature that the content of the protest can still be readily ascertained (e.g., a U.S. patent is identified by the correct patent number and issue date but the name of the first named inventor is clearly misspelled), the Office may have enough information to be able to enter the protest into the record despite the error. However, the determination of whether to enter or not to enter a protest that partially complies with a requirement of [37 CFR 1.291\(b\) or \(c\)](#) will be made on a case-by-case basis and at the sole discretion of the Office (e.g., the Office may decline to enter a protest listing a U.S. patent whose patent number does not match Office records with respect to that patent number's issue date and/or first named inventor). In any event, the Office will either enter or not enter the entire protest and will not attempt to enter portions of partially compliant protests, except as noted in the paragraph below.

In the unlikely event an examiner believes a protest is non-compliant, the examiner should immediately consult the reviewer of the protest or other appropriate Technology Center point of contact. If as a result of such consultation it is determined that the examiner should not consider a listed document, the examiner should strike through the document to indicate that the examiner did not consider either the document or its accompanying concise explanation. In some instances, the stricken document may be cited by the examiner on a form PTO-892.

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

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

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

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

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

#### Examiner Note:

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

Where necessary or desirable to decide questions raised by the protest, under [37 CFR 1.291\(f\)](#) the primary examiner can require the applicant to reply to the protest and answer specific questions raised by the protest. The primary examiner cannot require a reply to questions relating to “fraud,” “inequitable conduct,” or “violation of the duty of disclosure” since those issues are generally not commented on by the Office. Any questions directed to applicant by the primary examiner must be limited to seeking answers reasonably necessary in order for the primary examiner to decide questions raised by the protest and which are before the primary examiner for decision. The primary examiner is not permitted, under [37 CFR 1.291\(f\)](#), to seek answers to questions which are not before the primary examiner for decision.

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 a shortened statutory period of **TWO (2) MONTHS** 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](#) but in no case can any extension carry the date for reply to this letter beyond the maximum period of **SIX MONTHS** set by statute ([35 U.S.C. 133](#)).

#### Examiner Note:

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

### III. EXAMINER MUST NOT COMMUNICATE WITH PROTESTOR

The examiner must not communicate with protestor in any way even if the protest is incomplete or the protestor inquires as to the status of any Office proceedings related to the protest. See [37 CFR 1.291](#). In addition, the examiner will not consider a later submission by protestor, unless such submission complies with [37 CFR 1.291\(c\)\(5\)](#) (see [MPEP § 1901.07](#)). Improper protests will be returned to the protestor, or discarded, at the option of the Office. See [37 CFR 1.291\(g\)](#).

### IV. EXAMINER TREATMENT OF AN ENTERED PROTEST

If the protest has been reviewed and entered into the record of the application in time to permit consideration by the examiner during prosecution, the examiner must consider (A) each of the prior art or other documents submitted in conformance with [37 CFR 1.291\(c\)](#) and any discussion of such documents in the protest, and (B) any non-prior art issue(s) raised by the protest that are appropriate for consideration by the primary examiner, and the information supplied as to the same.

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

## V. PROTEST FILED ON OR AFTER PUBLICATION OF THE APPLICATION

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

If a protest is submitted on or after the date the application is published under [37 CFR 1.211](#) and is not accompanied by the written consent of the applicant, it will not be entered in the application file.

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

[35 U.S.C. 122\(c\)](#) permits the filing of a protest in an application after the application has been published if there is express written consent of the applicant. In order to file a protest after publication of a patent application, [37 CFR 1.291\(b\)\(1\)](#) requires that the protest be accompanied by the written consent of the applicant and be filed prior to the date the notice of allowance under [37 CFR 1.311](#) is given or mailed. The written consent should indicate that applicant is consenting to the specific protest being submitted. Applicant may choose to provide a blanket consent to: any protests filed; protests filed by a particular real party in interest; a single protest by a particular party in interest (e.g., a protest that party Smith has informed me that he will be submitting during the week of November 26<sup>th</sup>); a protest involving a particular item of prior art; or a particular protest that has been reviewed and applicant is willing to have considered by the Office. Where applicant consents to a protest, the Office will abide by the terms of the consent, and will enter the protest only if (A) the protest submitted is within the scope of the consent, and (B) the protest complies with the requirements of [37 CFR 1.291\(b\) and \(c\)](#). If a properly consented to protest does not comply with some of the requirements of [37 CFR 1.291\(b\) or \(c\)](#), the Office may choose to consider a piece of prior art permitted under the terms of the consent.

## VI. CONSIDERATION OF PROTESTOR'S ARGUMENTS

In view of the value of written protests, the examiner must give careful consideration to the points and arguments made on behalf of the protestor. Any Office action by the examiner treating the merits of a timely submitted protest complying with [37 CFR](#)

[1.291\(c\)](#) must specifically consider and make evident by detailed reasoning the examiner's position as to the major arguments and points raised by the protestor, except for issues related to inequitable conduct. The examiner will not, under any circumstances, treat or discuss those arguments or points directed to "fraud," "violation of duty of disclosure," or other inequitable conduct issues. See [37 CFR 1.291\(e\)](#). While it is not necessary for the examiner to respond to each and every minute argument or point, the major arguments and points, except those concerning inequitable conduct, must be specifically covered.

## VII. RESULTS OF CONSIDERATION REPORTED TO TECHNOLOGY CENTER (TC) DIRECTOR

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

### 1901.07 Protestor Participation [R-10.2019]

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

### 1901.07(a) Filing of Multiple Papers Relating to Same Issues [R-10.2019]

Under [37 CFR 1.291\(d\)](#), protestor participation ends with the filing of the protest, and protestor will not be allowed to complete any protest that is

incomplete. [37 CFR 1.291\(c\)](#) does not provide for the submission of additional protests in the same application by the same real party in interest except for submissions filed in accordance with [37 CFR 1.291\(c\)\(5\)](#). Multiple piecemeal protests (raising a slightly different issue in each protest submission) in a single application by the same real party in interest are not permitted. After the filing of the protest, no further submission of prior art by the same real party in interest will be considered, except for new, non-cumulative prior art submitted under the conditions of [37 CFR 1.291\(c\)\(5\)](#). [37 CFR 1.291\(c\)\(5\)](#) requires that a second or subsequent protest by the same real party in interest include:

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

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

(C) the processing fee under [37 CFR 1.17\(i\)](#).

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

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

An examiner will consider a compliant second or subsequent protest filed on behalf of the same real party in interest (subject to the time frames set forth in [37 CFR 1.291\(b\)](#)), the caveat that the protest can be timely matched and considered prior to the date the notice of allowance under [37 CFR 1.311](#) is given or mailed, and the content requirements of [37 CFR](#)

[1.291\(c\)\(1\) to \(4\)](#)), if the second or subsequent protest complies with [37 CFR 1.291\(c\)\(5\)](#).

## **1902-1905 [Reserved]**

### **1906 Supervisory Review of an Examiner’s Decision Adverse to Protestor [R-10.2019]**

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

### **1907 Unauthorized Participation by Protestor [R-10.2019]**

Office personnel must exercise care to ensure that substantive matters relating to the application are not discussed *ex parte* with protestor or communicated in writing *ex parte* to protestor. The examiner must not communicate in any manner with protestor. See [37 CFR 1.291\(d\)](#). See also [MPEP § 1134](#).

## **1908-1919 [Reserved]**

### **1920 Citation of Prior Art Under 37 CFR 1.501(a) [R-10.2019]**

[37 CFR 1.501\(a\)](#) permits any person at any time during the period of enforceability of a patent to file a written submission directed to 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 or statements of the patent owner filed by the patent owner in a proceeding before a federal court or the Office in which the patent owner took a position on the scope of any claim of the patent. See [MPEP § 2202 - § 2208](#).