

The Limited Monopoly™

Protest - A little known, little used process in our U.S. patent system

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A Protest is the filing of papers with the United States Patent and Trademark Office against a pending patent application that calls attention to any facts within the Protestor's knowledge which, in the Protestor's opinion, would make the grant of a patent on the application improper. A Protest may be filed by any member of the public.¹ The ability to Protest is nothing new. However, before you become concerned about the safety of your pending patent application, or run out to file one on a competitor, there are a few things you should know.

To begin, Chapter 1900 of the Manual of Patent Examining Procedure (MPEP) provides the details. But most patent agents and attorneys have never dealt with a Protest, nor have many Examiners. Protests are a bit quirky, and also have some pitfalls. So before you deal with this little known part of our patent system, talk with a patent practitioner that knows the issues surrounding the filing or receiving of a Protest.

How a Protest is Filed

A Protest can be filed by any member of the public. While we are not sure how you become a member of the public, that is what the Patent Rules say. A Protest is an "Ex Parte" act, meaning the Protestor can take no part in the process other than filing the initial set of papers. The Patent Office and the Examiner cannot even acknowledge that the alleged patent application exists. Most Agents and Attorneys do not feel comfortable with providing a one sided submission without being given the opportunity to respond further. So the Protest process favors the Applicant.

Now this is where things get a bit strange. A Protest can only be filed if the patent application has not been published or if a Notice of Allowance has not been mailed, *unless* the Applicant gives

written permission to the Protestor to file a Protest after the application has been published. (Now why would an Applicant do that?) And things get stranger yet. The Manual of Patent Examining Procedure, section 1901.03 says that the Protest must include the application serial number; it is "mandatory."

So how does one find out the application serial number if the patent application has not been published? Good question. Usually

with the application serial number. That is something that should NEVER be done. Unfortunately, we have seen company web pages brag about application serial numbers as if they are patent numbers, something that we strongly discourage. The moral of the story is to keep your patent application serial numbers confidential, and be sure that your employees understand the importance of this practice.

Now suppose that you have come into possession of a competitor's patent application number through one of the above ill-advised disclosures. Certain documents are required in a Protest according to the Patent Rules¹. Once the Protest papers are compiled, they are filed in the United States Patent and Trademark Office. A copy of the Protest must also be served on the Applicant or the Applicant's Agent or Attorney. As part of the Protest, copies of all patent and non-patent references must also be submitted to both parties.

What the Examiner Does When Receiving a Protest

When an Examiner receives the Protest, he is forbidden from corresponding in any way with the Protestor. The

Examiner will then look to see that the submission is complete, and review the prior art reference that was sent with the Protest to see if the reference(s) submitted with the Protest anticipates the invention under 35 USC 102 or renders it obvious under 35 USC 103. The Examiner can only make a rejection based on the Protest if it is supported by the law under 35 USC 102 or 103. If the Protest contains allegations of fraud, inequitable conduct, or violation of the duty of disclosure, it will be entered in the application file without comment by the Examiner.

The Examiner may also request written



the serial number of a pending application is only known to those that are close to the patent application, such as employees in a company. But what about "members of the public," as stated in the Patent Rules? They would have no way of knowing the serial number of an unpublished patent application, unless the Applicants tell them, deliberately or otherwise.

Suppose your company has a pending patent application on a product. If your website or product packaging is marked "Patent Pending," that is not enough information for a would-be Protestor, unless you further mark your product information

comments on the Protest from the Applicant, as long as the questions pertain to patentability, and not to matters of fraud, inequitable conduct or violation of the duty of disclosure. Once the Examiner has considered the Protest, the results are reported to the Examiner's Technology Center Director, and examination of the application continues. The Protest may result in a rejection of the application, or the Protest may be duly noted as considered with no rejections to the application.

What you should do if you receive a Protest Letter

If you receive a Protest letter on your pending patent application by service of process, you should consult with your patent practitioner. Be comforted in the fact that the Protestor has only one shot at your patent application, and cannot do anything further. The Protestor is not able to refute or comment, or even see, the Examiner's response or your reply to questions if the Examiner elects to request comments from you as the Applicant. So you are still in control of your patent application. If the Examiner requests written comments, they should be provided. If the Examiner rejects based on a prior art reference submitted, it should be dealt with in the same way that it would be dealt with if the Examiner discovered the reference in his own search. Many times, however, Protest submissions fail because the Protestor either did not comply with the submission requirements, or failed to provide information in the Protest that would allow the Examiner to reject based on the law. If the Protest is dismissed, before you celebrate you may now want to consider some offensive strategic actions with the help of your patent practitioner.

Offensive Actions

Consider filing the Protest copy that was served on you in an Information Disclosure Statement to the Patent Office. Why in the world would you want to do this? For one, if the Protest is dismissed by the Examiner, the Examiner may not always cite the Protest papers "on the record." If the Examiner does not cite the references, you should. Otherwise, if your patent application results in an issued patent, the Protestor can take another shot at it by way of an Ex-Parte Reexamination Request². This process asks the Patent Office to take a second look at an issued patent in light of prior art that was not considered by the Examiner. Defending against an Ex-Parte Reexamination Request can be expensive. If the prior art of the Protest was made "of record," and considered by the Examiner, you shut the door to the Protestor taking another bite of the apple. You also limit a potential financial liability.

When you submit the Protest papers in a timely filed Information Disclosure Statement, all of the documents are made public record. This may include poor choices of words made by the Protestor

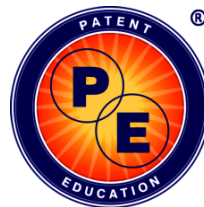
that may help in any future patent litigation. For example, the Protestor may inadvertently make an admission of infringement in the Protest that could be used later by the Applicant to enforce their newly granted patent rights. Truly a gift from the Protestor.

If the Protest is dismissed and you have ensured that the Protest is made "of record" and the references have been considered by the Examiner, you have shut the door on a Reexamination request. The only thing left is for the Protestor to attempt to invalidate your newly issued patent in court. But if the Protest references were considered by the Examiner, there is a presumption of validity. Basically, the patent is considered valid unless the Protestor can persuade a court to rule that the patent is invalid. If the reference(s) of the Protest were considered by the Examiner during prosecution of your patent application, the Protestor will have a more difficult time trying to invalidate the Examiner's findings in court. The court will give the Examiner's findings considerable weight. The Protestor would have a better chance if the Examiner never considered the reference(s), arguing that the Examiner missed the reference and did not consider it in prosecution. Making sure the Protest papers are made of record and considered by the Examiner undermines the Protestor's case should he decide to take it to court after the patent issues.

So if you receive a Protest letter, deal with it strategically and use the opportunity to strengthen your patent position. And if you decide you want to submit a Protest letter, be sure you understand all of the consequences of your actions. There are many things to consider if you are involved in this rather arcane process of our patent system, so be sure to consult an experienced patent practitioner. □

1. 37 CFR 1.291
2. See our February 2007 article entitled "Reexamination of the Peanut and Butter Jelly Sandwich" for more on Ex parte Reexaminations. A copy can be obtained free of charge at www.patenteducation.com.

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