

# Protests in Reissue Patent Applications

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**P**ractically all protests occur in reissue applications. The only statute pertinent to protests is 35 U.S.C. § 122(c), which generally prohibits them: “[N]o protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.”<sup>1</sup> A protest in a reissue application, however, is not a “pre-issuance opposition to the grant of a patent” because the patent to be reissued has already been granted. Thus, the prohibition against the filing of a protest in 35 U.S.C. § 122(c) is not applicable to a reissue application, and a protest is permitted after publication of the reissue application. A reissue application is not published in its entirety like a regular patent application, but an announcement is made in the Official Gazette and the file content is made publicly available. All reissue applications are therefore published for purposes of eligibility for protests.

## WHO MAY FILE A PROTEST?

A protest may be filed by any “member of the public.”<sup>2</sup> The protest need not identify the real party in interest and thus may be filed anonymously.<sup>3</sup>

## CONTENT OF A PROTEST

There is no limit on the content of a protest. “Any information which, in the protestor’s opinion, would make the grant of a patent improper can be relied on in a protest . . . .”<sup>4</sup> Examples of issues that may be addressed in a protest include lack of compliance with §§ 101, 102, 103, 112 or any other condition of patentability

or enforceability. Unlike reexamination, a protest may concern non-printed-publication prior art such as public use, on-sale activity, invention by another or abandonment, or other issues such as improper broadening, violation of the recapture rule, incorrect inventorship, fraud or inequitable conduct. Various items may be included in a protest, such as supporting declarations or affidavits, or portions of litigation-related documents.

The required elements of a protest are set forth in 37 C.F.R. § 1.291(b), (c). Those required elements are (1) identification of the patent application; (2) certificate of service on the applicant; (3) listing of the information relied upon (Form PTO-1449 is recommended); (4) concise explanation of relevance of listed information; (5) copies of all listed information in written form (or pertinent portions thereof); (6) English translation of any non-English information; and (7) either (a) a statement that this is the first protest submitted in the application by the real party in interest or (b) an explanation why a second or subsequent protest should be entered.

The final requirement listed above is important. Protests are supposed to be one-shot opportunities for the protestor to comment in the application. A protest must be complete as filed, and the protestor is given no opportunity to supplement a protest. For that reason, Rule 291 requires that a second or subsequent protest in an application by the same protestor provide a fee and an explanation why the issues raised are “significantly different” from the ones presented earlier and why they were not presented earlier.<sup>5</sup> For example, “[s]ignificantly different issue(s) may be raised by the submission of new, non-cumulative prior art or other information not previously made of record.”<sup>6</sup>

## HOW SHOULD A PROTEST BE FILED?

Protests cannot be filed electronically; they must be filed by mail or walk-up delivery. Chapter 1900 of the MPEP contains detailed guidance regarding the addressing and labeling of a protest.

## PTO HANDLING OF A PROTEST

The PTO will not acknowledge receipt of a protest, except by return postcard, if

included with the protest filing.<sup>7</sup> The PTO will generally give the applicant an opportunity to comment on any issue raised in a proper and timely protest.<sup>8</sup> Usually, the deadline for the applicant to comment is one month. One exception to this general rule is that the PTO will not force an applicant to respond to issues of fraud, inequitable conduct or the like.<sup>9</sup>

## TIMING OF PROTESTS

Timing of a protest can be quite important. A first protest with regard to a reissue application should ideally be filed within the two-month period following the announcement of the filing of the reissue application in the Official Gazette. A protest of a reissue application can be submitted at a later time. However, if a final rejection has been issued or prosecution on the merits has been closed, then a petition for entry of the protest is required.<sup>10</sup>

Because a reissue application is considered by an examiner on a “special” basis, such that the examination is expedited, filing a protest after the two-month period risks receipt of the protest after issuance of an action by an examiner. If the first Office action is non-final, then a protest may thereafter be filed without petition and the examiner will consider the protest in the next Office action. If the first Office action is an allowance, is a *Quayle* action or otherwise closes prosecution on the merits, a protest must be accompanied by a petition under 37 C.F.R. § 1.182.

An example of the dangers of a late protest occurred during the prosecution of the reissue patent asserted in *Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*<sup>11</sup> A third party submitted a protest almost three years after the reissue application was filed. The protest was filed three days before the PTO mailed a notice of allowance, which crossed in the mail with the protest. The protest included highly relevant prior art, but the examiner gave it short shrift in a supplemental notice of allowance, demonstrating that it is harder to change the mind of a decision-maker than it is to influence his or her initial decision.

If a protest cannot be filed within the two-month period after the Official Gazette announcement of a reissue application, the protestor may file a petition within that two-month period to accept a delayed protest.<sup>12</sup> Such a petition must explain why the additional time is needed, indicate the nature of the intended protest and be served upon the applicant.

If the patent owner petitions to waive the two-month period because, for example,

the patent is involved in litigation, that can frustrate a protester's attempt to file a protest, as that would eliminate the protester's chance to be guaranteed that a protest can be timely filed.

## STRATEGIC CONSIDERATIONS

Reexamination may sometimes be an alternative or adjunct to a protest. If the basis for the protest is prior art printed publications, the content of the protest may be formulated as a request for reexamination. Most would-be protesters would generally prefer to raise their patentability arguments before the Central Reexamination Unit than the technology-center examiner who handles the reissue, including any protest filed therein, especially if the reexamination is of the *inter partes* type, allowing the challenger to fully participate. If the reexamination and reissue proceedings are not merged,<sup>13</sup> then the requester may also file the content of the reexamination request as a protest in the reissue proceeding.

If the basis for the protest is anything other than a prior art printed publication, then reexamination is not an option and, presently, a protest in a pending reissue application is the only option to raise patentability arguments at the PTO. However, when patent reform goes into effect, a would-be protester could wait until the reissue application grants and then petition for post-grant review of the reissue patent. As the patent reform legislation is currently written, grant of a reissue patent would open a new window<sup>14</sup> to institute a post-grant review proceeding in which any patentability arguments could be raised. **IP**

## ENDNOTES

1. Patent reform legislation will change 35 U.S.C. § 122 to allow third parties to submit printed publications "of potential relevance" along with "a concise description of the asserted relevance" in any application. See, e.g., S. 23, 112th Cong. § 7 (2011).
2. 37 C.F.R. § 1.291(a).
3. MPEP § 1901.01.
4. MPEP § 1901.02.
5. 37 C.F.R. § 1.291(c)(5).
6. MPEP § 1901.07(a).
7. MPEP § 1901.05(III).
8. MPEP § 1901.06(II).
9. MPEP §§ 1901.02(G), 1901.06(II).
10. MPEP § 1441.01.
11. 563 F.3d 1358 (Fed. Cir. 2009).
12. MPEP § 1441.01.
13. Kevin B. Laurence & Matthew C. Phillips, *Reexam + Reissue = Merger, Suspension or Concurrent Prosecution*, *Intell. Property Today* 14-16 (Feb. 2011).
14. S. 23, 112th Cong. § 5(d) (2011) (to be codified at 35 U.S.C. § 321(c)).