Third Party Attempts to Oppose or Protest - OG Date: 22 April 2003

United States Patent and Trademark Office OG Notices: 22 April 2003 Third Party Attempts to Protest or Otherwise Oppose the Grant of a Published Application


The eighteen-month publication provisions of the AIPA also provide that the USPTO "shall establish appropriate procedures to ensure that no 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." See 35 U.S.C. 122(c) (emphasis added). Third parties may submit patents or publications for consideration in a pending published application, with no further comment or explanation, pursuant to 37 CFR 1.99. Despite the provisions of 35 U.S.C. 122(c), the USPTO occasionally receives third-party inquiries or submissions (other than under 37 CFR 1.99) regarding applications that have been published under the eighteen-month publication provisions of 35 U.S.C. 122(b). For example, third parties have inquired into the timing of future actions on an application, and some third parties have insisted that the USPTO withdraw an application from issue under 37 CFR 1.313 on the basis of unpatentability of a claim. The USPTO considers any third-party inquiry or submission that is not provided for in 37 CFR 1.99 in a published application in which the applicant has not provided an express written consent to protest or pre-issuance opposition to be inappropriate.

The USPTO interprets the provisions of 35 U.S.C. 122(c) as requiring, rather than simply empowering, the USPTO to ensure that no protest or other form of pre-issuance opposition to an application may be initiated after its publication without the express written consent of the applicant. See 145 Cong. Rec. S14,708, S12,719 (daily ed. Nov. 17, 1999) (35 U.S.C. 122(c) "requires the Director to establish procedures to ensure that no 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" (emphasis added)).

Following enactment of 35 U.S.C. 122(c), the USPTO revised 37 CFR 1.291 and 1.292 to prohibit third parties from submitting any protest or initiating any public use proceedings (the only forms of third party protest or pre-issuance opposition to a pending application permitted by the rules of practice) after publication of an application. To balance the mandate of 35 U.S.C.

1While the Conference Report resulting in Pub. L. 106-113 does not contain any discussion (other than the incorporated language) of the AIPA, a section-by-section analysis of the AIPA (among other provisions of Pub. L. 106-113) was printed in the Congressional Record at the request of Senator Lott.
122(c) that the USPTO establish "appropriate procedures" to ensure that third parties may not initiate protest or other pre-issuance opposition to an application after its publication (without the express written consent of the applicant) and the USPTO's authority and responsibility under 35 U.S.C. 131 and 151 to issue a patent only if "it appears that the applicant is entitled to a patent under the law," the USPTO promulgated 37 CFR 1.99 to permit third parties to submit patents and publications (i.e., prior art documents that are public information and which the USPTO would discover on its own with an ideal prior art search) during a limited period after publication of an application. However, 37 CFR 1.99 prohibits third parties from submitting any explanation of the patents or publications, or submitting any other information. See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR at 57032-33, 57042-44, 1239 Off. Gaz. Pat. Office 71, 79-81.

Pursuant to the mandate of 35 U.S.C. 122(c) that the USPTO establish "appropriate procedures" to ensure that third parties may not initiate protest or other pre-issuance opposition to an application after its publication (without the express written consent of the applicant), the USPTO is instructing the Patent Examining Corps to: (1) not reply to any third-party inquiry or other submission in a published application that is still pending before the USPTO; (2) not act upon any third-party inquiry or other submission in a published application, except for written submissions that are provided for in 37 CFR 1.99 and written submissions in applications in which the applicant has provided an express written consent to protest or pre-issuance opposition; and (3) decline to accept oral or telephoned comments or submissions about published applications from third parties. When refusing third-party telephone or oral discussions, examiners may call the party's attention to the statutory prohibition on initiating protests, to this Notice, or to 37 CFR 1.2 (all Office business should be transacted in writing), if appropriate. The USPTO may also refer third-party inquiries or submissions not provided for in 37 CFR 1.99 by registered practitioners in published applications in which the applicant has not provided an express written consent to protest or pre-issuance opposition to the Office of Enrollment and Discipline for appropriate action.

Finally, the provisions of 35 U.S.C. 122(c) and 37 CFR 1.99, 1.291, and 1.292 limit a third party's ability to protest, oppose the grant of, or have information entered and considered in an application pending before the USPTO. However, these provisions (and this notice) do not limit the USPTO's authority to independently re-open the prosecution of a pending application on the USPTO's own initiative and consider information deemed relevant to the patentability of any claim in the application. See Blacklight v. Dickinson, 295 F.3d 1269, 63 USPQ2d 1534 (Fed. Cir. 2002).

Inquiries concerning this notice may be addressed to Robert W. Bahr at 703-305-8850.

March 26, 2003

STEPHEN G. KUNIN
Deputy Commissioner for Patent Examination Policy