

publication. Replacement paper drawings may currently be included in any patent application publication, so long as the drawings are accompanied by a petition under § 1.182 and a petition fee set forth in § 1.17(h) and are timely received. Deletion of the requirement for a petition and replacement of the petition fee set forth in § 1.17(h) with a processing fee set forth in § 1.17(i) will reduce burdens upon applicants, while retaining the ability of the Office to recover the costs associated with processing the replacement drawings that have not been required by the Office. See *Drawings in Patent Application Publications and Patents*, 1242 *Off. Gaz. Pat. Office* 114 (Jan. 16, 2001).

Section 1.215(c) is proposed to be amended to provide that applicant has until the later of: (1) A month after the mailing date of the first Office communication that includes a confirmation number for the application; or (2) fourteen months after the earliest filing date claimed under title 35, United States Code, to file an amended version of an application through EFS, for publication purposes. This new time frame is also being applied to submission of replacement paper drawings pursuant to § 1.215(a). This change has already been implemented. See *Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes*, 1241 *Off. Gaz. Pat. Office* 97 (Dec. 26, 2000).

Section 1.291: Section 1.291 is proposed to be amended to require that when a protest under § 1.291 is filed in an application, the real party in interest that files the protest must be named; *i.e.*, the naming of the real party in interest would be a requirement of the filing of a proper protest. An exception to this requirement would be provided in that a protester desiring anonymity could submit a statement (together with a processing fee under § 1.17(i)) that the protest being submitted is the first protest submitted in the application by the real party in interest on behalf of whom the protest is being submitted. Additionally, § 1.291, as it is proposed to be amended, is reformatted for clarity.

Currently, a protest may be submitted without identification of the real party in interest on behalf of whom the protest is being submitted. Further, there is no explicit bar in the rule against multiple piecemeal protest submissions (raising a slightly different issue in each of multiple protest submissions) other than that they should be submitted before prosecution

closes in an application. Thus, § 1.291, as it currently exists, is subject to abuse by, for example, the filing of multiple protests in a single application by practitioners of the same firm, with a different practitioner signing each protest, and additionally, by any of the inventors and/or assignees, where essentially the same grounds of protest are presented in each of the protests. In order to eliminate such potential for harassment of the prosecution process via multiple filings of protests in an application by persons serving the same interest, it is proposed that § 1.291 be amended to require the naming of the real party in interest, or privy thereof, when a protest is filed.

The party on whose behalf the protest is being filed is required to be identified by either: (1) The name of the business or other organizational entity (*e.g.*, name of corporation) and its principal address, its place of formation (*e.g.*, incorporation) and any other name under which the business or other organizational entity is doing business (d/b/a) or conducting operations; or (2) the name and residence of the individual who is directing the submission of the protest.

The concept of identifying the “real party in interest” is not new to the Office; it is required by statute (35 U.S.C. 311) and by rule (§ 1.915) in *inter partes* reexamination practice with respect to identifying the *inter partes* third party reexamination requester. It is to be noted that the term “privy” is construed to include any party related to the real party in interest (filing the protest) as employer, employee, co-employee of the same employer, assignee, legal representative, licensee or hired contractor of the assignee or employer.

Where a genuine reason for not identifying the real party in interest exists (such as concern by an employee as to retaliation by his/her employer which is the assignee of the application), § 1.291(b)(3) would permit a statement in substitution for identifying the real party in interest. The § 1.291(b)(3) substitute statement must aver that the protest being submitted is, to the best of the knowledge of the submitting party, the first protest submitted by the real party in interest. A processing fee under § 1.17(i) must be included with the § 1.291(b)(3) substitute statement.

While an examiner is always free to look at or consider any documents submitted in an application, under § 1.291 as it is proposed to be amended, there would be no requirement that an examiner consider a second protest filed on behalf of the same real party in

interest, unless: (1) The second protest submission (a) includes additional art directed to the patentability of the claims, or (b) otherwise raises new issues substantially different from issues earlier presented and affecting the patentability of the claims, which could not have been earlier presented; and (2) the second protest submission includes an explanation of what is added by the additional art or new issue(s) raised, and why such could not have been earlier presented.

Finally, once a protest has been matched with an application, the examiner is always free to look at, or consider, any document(s) or other information submitted in that protest whether or not the protest complies with § 1.291. This is true both for § 1.291 as it presently exists, and § 1.291 as it would be revised via the present proposal. Section 1.291 exists as a matter of administrative convenience for the Office, and a third party's failure to comply with any of the requirements of § 1.291 does not vest the applicant with any “right” to preclude consideration of information in a non-compliant protest by the examiner.

Section 1.291(a): In order for a protest submission to be matched with an application, it must include sufficient information to adequately identify the application for which the submission is being made.

Where possible, the protest should specifically identify the application to which the protest is directed by application number and filing date. If, however, the protestor is unable to specifically identify the application to which the protest is directed by application number and filing date, but, nevertheless, believes such an application to be pending, the protest should be directed to the attention of the Office of Petitions, along with as much identifying data for the application as is possible. If sufficient information is provided in the protest to match it to an application, it will be matched. If not, the protest submission will be returned to the party that submitted it.

Section 1.291(b): Section 1.291(b) is proposed to be amended to provide that a protest may be filed “[a]t any time if it is accompanied by the written consent of the applicant to the filing of the protest being submitted.” 35 U.S.C. 122(c) prohibits the filing of a protest in an application after the application has been published without the express written consent of the applicant. In order to provide for the filing of protests after publication of patent applications, § 1.291(b)(2) requires that a filing of a protest after publication (of an