



FIVE WAYS TO USE PRE-GRANT PATENT PROTESTS

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Opportunities for a third party to protest against a patent application before it is granted vary widely by jurisdiction. In Canada, section 34.1 of the *Patent Act* and section 10 of the *Patent Rules* enable a number of strategies for protesting against a pending application. Here are five ways to use Canada's pre-grant protest system.

1. Submit new prior art

One of the best ways to use the protest system is to submit prior art publications which the Canadian Examiner has not yet applied against the pending application. Accompanying the prior art with concise and convincing arguments can be especially useful to encourage the Examiner to issue rejections. Prior art submissions can be made anonymously, and can also be filed at any time prior to grant including after a notice of allowance has been issued.

2. Non prior art grounds

A protest does not have to be based on prior art. It can be filed based on any number of grounds, such as ambiguity in the claim language, lack of utility, or patent-ineligible subject matter. Protests based on such grounds can lead to Examiner rejections and, in turn, to claim amendments that can provide enhanced clarity in terms of infringement issues. With Canada's high bar for utility, a protest based on lack of demonstrated utility or sound prediction can increase the likelihood of Examiner rejections and can lead to significant reduction in claim scope. Canada also has stricter standards for patent-eligible subject matter compared the U.S., especially in the areas of business methods, computer-implemented methods, and medical treatments. When submitting protest arguments that are not based on prior art, it can also be useful to make reference to the Manual of Patent Office Practice

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(MOPOP), which is used by Canadian Examiners to formulate and support claim rejections.

3. Protest combined with third party request for examination

In Canada, to initiate examination of an application a request must be filed along with an examination fee. The deadline to file the request for examination is five years from the application's filing date, and can be further delayed in some circumstances. This relatively long delay period prior to examination can cause uncertainty in terms of the scope of protection that may eventually be granted. Typically, it is the applicant which files the request for examination when it decides to go forward with the application. However, a third party can initiate examination by filing the request for examination, thus forcing the application to be examined. Moreover, examination can be accelerated by a third party by filing a simple request and paying a fee. By forcing early and, in some cases, accelerated examination in combination with a protest, a third party can hope to quickly gain more certainty around the Examiner's view of the invention and the scope of protection that may be allowable.

4. Get prior art into a counterpart U.S. case

This strategy can be viewed as a two-for-one approach when a Canadian application also has a U.S. counterpart application. Not only will new prior art be made of record in the Canadian case, but it should also be submitted to the U.S. Examiner by the applicant or its patent attorneys via an Information Disclosure Statement (IDS) pursuant to U.S. duty of disclosure requirements. In some instances, the protest arguments themselves may be submitted to the U.S. Examiner in addition to the prior art references.

5. Comment on documents already of record

There is no obligation to submit prior art not already of record in a pending application. A protest can be filed in order to comment on any document of record in an application. A third party can file comments regarding the relevance of prior art already cited by the Examiner; the arguments or amendments submitted by the applicant during examination; or any office actions issued by the Examiner. A third party can point to a specific passage in a prior art document to highlight anticipation or obviousness issues for the Examiner; submit arguments regarding the specification and claim scope in the context of utility issues; or provide comments to directly address or counter the applicant's own arguments.

In summary, Canada's pre-grant protest system can be a useful tool for facilitating a variety of strategies to challenge pending patent applications which may not meet all of the requirements of patentability. Of course, any protest strategy should be

carefully considered and balanced against the potential risks. In general, the strength of a protest should be weighed against the risk of alerting the applicant of the importance of the patent application and against the options available to the applicant to fix or even strengthen the claims.

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