

Chapter 18

Protests and filing of prior art

- 18.01 Filing prior art
- 18.02 Protests
- 18.03 Affidavits
- 18.04 Applying protests or filing of prior art
- 18.05 Protests or filing of prior art and confidentiality

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18.01 Filing prior art

Under section 34.1 of the *Patent Act*, any person may file prior art with the Commissioner. This prior art can consist of patents, applications for patents open to public inspection, or publications that the person believes have a bearing on the patentability of any claim in a patent application. Prior art filed with the Commissioner under section 34.1 of the *Patent Act* must be accompanied by an explanation of why the art is pertinent. If the application referred to by the person submitting the prior art is a PCT application which has not yet entered the national phase in Canada, the Canadian Patent Office will retain the submission until the last date for late national entry in Canada has expired.

When prior art is received under the provisions of section 34.1 of the *Patent Act*, the provider is notified that the filing of prior art has been received, but the provider will not be informed regarding the action taken thereon¹. The prior art material is made part of the file of the application and the applicant of that application is notified that a submission of prior art has been made. The prior art is only considered by the examiner after a request for examination has been received. The normal prosecution, including allowance of applications, continues despite the submission of a filing of prior art², unless sufficient grounds are presented to warrant action based on this filing of prior art.

When there is no prior art listed or when there is no explanation of why the art is pertinent, in a “filing of prior art” letter, this letter is then treated and considered as a protest.

18.02 Protests

In accordance with section 10 of the *Patent Rules*, any written communication made to the Commissioner with the stated or apparent intention of protesting against the granting of a patent is acknowledged by the Commissioner. The protestor will not be informed regarding the action taken thereon¹. However a protestor may have access to

the prosecution file of the application at the time of opening to public inspection. When the information is available during the pendency of an application, a protest provides an adequate alternative remedy that should be exhausted by a competitor before seeking judicial review³.

Protests may develop as a result of public inspection of opened applications. A protest may also develop as a result of a search request under section 11 of the *Patent Act* by means of which the protestor has discovered that there is a pending application that corresponds to a foreign patent. In these cases the protestor should identify the Canadian patent publication number (if following a public inspection of opened applications), or the foreign patent publication (if following a request under section 11 of the *Patent Act*). Any protest that fails to identify an application by number, inventor or applicant reduces the likelihood of the Commissioner locating the application and therefore reduces the effectiveness of the protest.

Each time a protest is received, the Patent Office carries out a search to identify or to confirm (when the application(s) is/are identified by the protestor) the application(s) to which the protest applies. If the application(s) is/are found, the protest is made part of the file of the application and therefore when the file is opened any action taken on the protest is also available. A notification that a protest has been received in the Patent Office will be sent to the applicant of any application against which a protest is made. The protestor will also be advised of the receipt of the protest in the Patent Office (the application number will not be Disclosed if this application is not already opened for public inspection). When the specific application cannot be located (e.g. when the application has not already been filed at the Patent Office or when there is not enough information in the protest to identify the application), the protest is classified in its most relevant class(es), unless the application is located before being brought to the examiner. The examiner keeps the protest for two years.

If the protestor wishes to submit further details or another protest, he/she is welcome to do so, but each time the protestor will only receive a notice of acknowledgment. The examiner will not discuss the prosecution of the application(s) with the protestor. The normal prosecution, including allowance of applications, continues despite the submission of a protest unless sufficient grounds are presented to warrant action based on the protest.

18.03 Affidavits

Affidavits containing allegations not backed by dated documentation will usually not be sufficient reason for the Commissioner not to grant the patent. The affidavits may however contain information that could raise serious reasons as to why a patent should not be granted or lead to documentation that could be very pertinent. Someone who submits affidavits should support his/her allegations with dated material or give details to locate such material.

18.04 Applying protests or filing of prior art

A protest or a filing of prior art is only considered by the patent examiner after the request for examination is received. Information in a protest or a filing of prior art is taken into account by the examiner, and if it provides sufficient grounds for objection, it will be cited. In the event that the application has previously been allowed by the examiner but has not yet been issued, the pertinence of the protest or of the filing of prior art will determine whether the notice of allowance will be withdrawn. If further action is required in view of the protest or of the filing of prior art, the application will be returned to the examiner. See chapter 13 for more information on notice of allowance and withdrawal thereof.

18.05 Protests or filing of prior art and confidentiality

Any protest or filing of prior art will become part of the opened application file (available to the public), therefore, any protest or filing of prior art requesting confidentiality will be returned to the sender. Information supplied in such a confidential document will not be considered by the patent examiner.

Endnotes for Chapter 18

- ¹ Section 10 of the *Patent Rules*: "... no information shall be given as to the action taken".
- ² *Monsanto Company et al. v. Commissioner of Patents et al.* (1999), 1 C.P.R. (4th) 500 at 511
"*...Notice of Allowance is not a decision subject to judicial review either by the applicant or a third party.*"
- ³ *Pharmascience Inc. v. Commissioner of Patents et al.* (1998), 85 C.P.R. (3d) 59 at 66,
affirmed 5 C.P.R. (4th) 428