

**DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office****37 CFR Part 1**

[Docket No. 000308064-0064-01]

RIN 0651-AB04

**Rules To Implement Optional Inter Partes Reexamination Proceedings****AGENCY:** U.S. Patent and Trademark Office, Commerce.**ACTION:** Notice of proposed rulemaking.

**SUMMARY:** The U. S. Patent and Trademark Office (the Office) is proposing to amend its rules of practice in patent cases to provide revised procedures for the reexamination of patents and thereby implement certain provisions of "the American Inventors Protection Act of 1999." "The American Inventors Protection Act of 1999" included an amendment to the Patent Act to authorize the extension of reexamination proceedings via an optional *inter partes* reexamination procedure in addition to the present *ex parte* reexamination procedure as a means for improving the quality of United States patents. The Office intends, through this amendment of its rules, to provide patent owners and the public with guidance on the procedures that the Office will follow in conducting optional inter partes reexamination proceedings in addition to the present *ex parte* reexamination proceedings.

The American Inventors Protection Act of 1999" also made other miscellaneous changes to the Patent Act which relate to reexamination, and it is intended that this amendment of the Office's rules will implement those changes relating to reexamination.

**DATES:** *Comment Deadline Date:* To ensure consideration of written comments, they must be received at the Office no later than June 12, 2000. While comments may be submitted after this date, the Office cannot ensure that consideration will be given to such comments. No public hearing will be held.

*Public Inspection of Comments:* Written comments will be available for public inspection on or about June 20, 2000.

**ADDRESSES:** Those interested in submitting written comments should send their written comments to the attention of Kenneth M. Schor, Senior Legal Advisor, by electronic mail message over the Internet addressed to reexam.rules@uspto.gov and titled "Inter Partes Reexamination." Written comments may also be submitted by

mail addressed to U.S. Patent and Trademark Office, Box Comments—Patents, Commissioner for Patents, Washington, DC 20231, marked to the attention of Kenneth M. Schor; or by facsimile transmission to (703) 872-9408, marked to the attention of Kenneth M. Schor. Although comments may be submitted by e-mail, mail, or facsimile, the Office prefers to receive comments via e-mail over the Internet. Where comments are submitted by mail, the Office would prefer that the comments be submitted on a DOS formatted 3¼ inch disk accompanied by a paper copy.

Written comments will be available for public inspection at the Patent Examination Policy Law Office, Office of the Deputy Assistant Commissioner for Patent Policy and Projects, located at Crystal Plaza Four, Room 3C23 (receptionist), 2201 South Clark Place, Arlington, Virginia. In addition, written comments in electronic form may be made available via the Office's World Wide Web site at <http://www.uspto.gov>.

**FOR FURTHER INFORMATION CONTACT:** Kenneth M. Schor or Gerald A. Dost, Senior Legal Advisors. Kenneth M. Schor may be contacted (a) by telephone at (703) 305-1616; (b) by mail addressed to: U.S. Patent and Trademark Office, Box Comments—Patents, Commissioner for Patents, Washington, DC 20231, marked to the attention of Kenneth M. Schor; (c) by facsimile transmission to (703) 872-9408, marked to the attention of Kenneth M. Schor; or (d) by electronic mail message over the Internet addressed to reexam.rules@uspto.gov and titled "Inter Partes Reexamination."

Gerald A. Dost may be contacted (a) by telephone at (703) 305-1616; (b) by mail addressed to: U.S. Patent and Trademark Office, Box Comments—Patents, Commissioner for Patents, Washington, DC 20231, marked to the attention of Gerald A. Dost; (c) by facsimile transmission to (703) 308-6916, marked to the attention of Gerald A. Dost; or (d) by electronic mail message over the Internet addressed to reexam.rules@uspto.gov and titled "Inter Partes Reexamination."

**SUPPLEMENTARY INFORMATION:****Background**

This proposed rulemaking sets forth distinct procedures directed toward determining and improving the quality and reliability of United States patents. The procedures provide for the optional *inter partes* reexamination procedures in addition to the present *ex parte* reexamination procedures for the reexamination of patents as provided for

by the American Inventors Protection Act of 1999 as part of the conference report (H. Rep. 106-479) on H.R. 3194, Consolidated Appropriations Act, Fiscal Year 2000. The text of the American Inventors Protection Act of 1999, is contained in Title IV of S. 1948, the Intellectual Property and Communications Omnibus Reform Act of 1999 (Pub. L. 106-113), the Act which is incorporated by reference in Division B of the conference report. The procedures also provide for implementation of other miscellaneous changes to the reexamination of patents also provided for in Public Law 106-113.

In 1995, the Office published proposed rules in anticipation of H.R. 1732, 104th Cong., 1st Sess. (1995), a predecessor for the present *inter partes* reexamination statute. H.R. 1732 did not, however, mature into a statute. H.R. 1732 resulted from suggestions and comments to the Administration by the public, bar groups, and the August 1992 Advisory Commission on Patent Law Reform suggesting more participation in the reexamination proceeding by third-party requesters. In response to H.R. 1732, the Office issued a Notice of Proposed Rulemaking entitled "Rules of Practice in Patent Cases; Reexamination Proceedings," which Notice was published in the **Federal Register** at 60 FR 41035 (August 11, 1995) and in the *Official Gazette* at 1177 Off. Gaz. Pat. Office 130 (August 22, 1995). Sixteen written comments were received in response to the August 1995 Notice of Proposed Rulemaking. A public hearing was held at 9:30 a.m. on September 20, 1995. Eight individuals offered oral comments at the hearing. The sixteen written comments and a transcript of the hearing are available for public inspection in the Patent Examination Policy Law Office, Office of the Deputy Commissioner for Patent Examination Policy, located at Crystal Plaza Four, Room 3C23 (receptionist), 2201 South Clark Place, Arlington, Virginia. The present proposed rulemaking addresses, and takes into consideration, the comments received in response to the 1995 proposed rules.

**Discussion of General Issues Involved**

This proposed rulemaking is in response to Public Law 106-113, the Act which resulted from suggestions and comments to the Administration by the public, bar groups, and the August 1992 Advisory Commission on Patent Law Reform suggesting more participation in the reexamination proceeding by third-party requesters. Under the *inter partes* reexamination rules proposed herein, third-party

requesters will have greater opportunity to participate in reexamination proceedings in keeping with the spirit and intent of the new law. At the same time, participation will be limited to minimize the costs and other effects of reexamination requests on patentees, especially individuals and small businesses.

*Ex parte* reexamination proceedings filed under Chapter 30 of 35 U.S.C. (both before and after the effective date, November 29, 1999, of the new law) will continue to be governed by 37 CFR 1.501–1.570. The proposed rules for optional *inter partes* reexaminations under Chapter 31 of 35 U.S.C. have been numbered 37 CFR 1.902–1.997.

The effective date of the statute with respect to the optional *inter partes* reexamination proceedings as well as to the existing *ex parte* reexamination proceedings is complex. With the exception of the amendments to 35 U.S.C. 41(a)(7) directed to the revival of terminated *ex parte* and *inter partes* reexamination proceedings, the new statute and the conforming amendments to the present statute take effect on the date of enactment, November 29, 1999. The changes, however, only apply to a reexamination of a patent that issues from an original application which was filed in the United States on or after November 29, 1999. Thus, for *inter partes* reexaminations, the effective date language (in section 4608 of S. 1948) limits the applicability of the new *inter partes* reexamination Chapter 31 of 35 U.S.C., and that of the conforming amendments to 35 U.S.C. 134, 141, 143 and 145, to any patent that issues from an original application filed in the United States on or after November 29, 1999, the effective date of Public Law 106–113. For *ex parte* reexaminations filed under Chapter 30 of 35 U.S.C., the conforming amendments to 35 U.S.C. 134, 141, 143 and 145, only apply to those *ex parte* reexamination proceedings filed under § 1.510 for patents that issue from an original application that is filed in the United States on or after November 29, 1999. The conforming amendments to 35 U.S.C. 134, 141, 143 and 145, correspondingly, will not apply to *ex parte* reexamination proceedings filed under § 1.510 for patents that issue from an original application filed in the United States prior to November 29, 1999.

The conforming amendments also amend 35 U.S.C. 41(a)(7) to include the words “any reexamination proceeding” under the “unintentional” revival provisions of the statute for an unintentionally delayed response by the patent owner in any reexamination

proceeding. These words “any reexamination proceeding” clearly make this section applicable to both *ex parte* reexaminations and *inter partes* reexaminations. The effective date of the amendment to 35 U.S.C. 41(a)(7), however, is one year after the date of enactment of the Act, or November 29, 2000. See section 4608 of S. 1948. Thus, as of November 29, 2000, any *ex parte* or *inter partes* reexamination filed before, on, or after November 29, 2000, is subject to the “unintentional” revival provisions of the statute.

Regarding the reexamination fee, 35 U.S.C. 41(d) requires the Director of the United States Patent and Trademark Office (the Director) to set the fee for the new optional *inter partes* reexamination at a level which will recover the estimated average cost of the reexamination proceeding to the Office. The estimated average cost is \$8,800 for an *inter partes* reexamination proceeding. The difference in price between an *ex parte* reexamination (\$2,520) and an *inter partes* reexamination (\$8,800) takes into account that the Office will expend substantially more resources for examination, supervision, training, etc., where the third-party requester participates in an *inter partes* reexamination proceeding, and for the additional processing steps that are expected during an *inter partes* reexamination proceeding.

#### Considerations of the Comments Responding to the August 1995 Notice of Proposed Rulemaking

In 1995 the Office published proposed rules in anticipation of a predecessor bill to the present *inter partes* reexamination statute, which bill did not mature into a statute. The Office issued a notice of proposed rulemaking entitled “Rules of Practice in Patent Cases; Reexamination Proceedings,” which was published in the **Federal Register** at 60 FR 41035 (August 11, 1995) and in the *Official Gazette* at 1177 Off. Gaz. Pat. Office 121 (August 22, 1995). Sixteen written comments were received in response to the August 1995 notice. Also, a public hearing was held on September 20, 1995, during which eight individuals offered oral comments. The following 28 issues summarize the comments, and the Office response.

##### Issue 1

Eleven comments addressed the issue of the reexamination filing fees set in the August 11, 1995, Notice of Proposed Rulemaking. The fees set in 1995 were \$4,500 for a request by a patent owner and \$11,000 for a request by a third-party requester. The discussion below

relates to the 1995 proposed fees. The current proposed \$8,800 *inter partes* reexamination fee is the result of a reevaluation of the *inter partes* reexamination parameters, and how *inter partes* reexamination will be conducted in view of the comments.

A first comment questioned why the reexamination filing fees set in the August 11, 1995, Notice of Proposed Rulemaking were many times those for original and reissue applications. A second comment questioned the disparity between fees for the patent owner and the third-party requester, suggesting that more reasonable fees be set initially until actual costs become known, since higher fees will discourage reexaminations. Further, it was urged that the distinction in the fees was inappropriately being based upon the legal positions of the parties (upholding or striking down a patent). Even further, it was pointed out that the fee structure provides a possibility of a windfall of \$15,500 should both a patent owner and a third-party requester file a request for reexamination. A third comment asserted that the disparity was greater than a factor of two, whereas the reason given was that it would entail twice the effort. A fourth comment supported the fees, suggesting that the fee of \$11,000 will discourage inappropriate requests and the harassing of individual inventors and small businesses. A fifth comment suggested that the cost of the reexamination proceedings be subsidized by fees collected from other services offered by the Office, that the fees should be apportioned in stages and charged as the reexamination progresses (*e.g.*, higher fees for appeals), and that there should be legislation to permit small entity discounts for reexamination fees. A sixth comment also suggested that the fees should be apportioned and charged as the reexamination progresses. The sixth comment additionally suggested that if the higher fees are warranted, there should be a more thorough examination of all cited and searched prior art by an independent supervisory examiner or a board of three examiners. A seventh comment asserted that since no new search is required of the examiner in the reexamination proceeding, the time and effort expended in a reexamination do not warrant a fee that is 14 times that of a regular application, which is not consistent with Congressional intent to provide a low cost alternative to litigation, and in view of the alternative to prepare and file another patent application and where appropriate initiate a more costly interference

proceeding. An eighth comment suggested that there should be a special reduced fee for reexamination requested within a short period (e.g., six months) following the issuance of a patent, since the reexamination could be assigned to an examiner already familiar with the case, which fee should be the same as a continuing application for patent owners and double for third-party requesters. The ninth and tenth comments were directed to the impact of the \$11,000 fee on independent inventors and small companies. The ninth comment suggested that the fees favored large businesses. The tenth comment suggested that a fee waiver system similar to that for Freedom of Information Act (FOIA) requests be adopted. In contrast, the eleventh comment stated that the fee was not a pivotal issue with respect to third parties participating in reexaminations, rather the pivotal issue is the perception today (under current rules) that the reexamination proceeding is not a level playing field. Accordingly, the fee should not be subsidized.

#### Response to Issue 1

Initially, it is noted that the *inter partes* reexamination fee structure has been reevaluated by the Office. The estimated average cost is \$8,800 for an *inter partes* reexamination. Accordingly, § 1.20, as proposed in the present rule making, will require a filing fee of \$8,800 for an *inter partes* reexamination under § 1.915(a).

As to the first and seventh comments asserting the disparity between costs for a regular patent application and an *inter partes* reexamination, it is not appropriate to compare these figures. Fees for filing an application are set by statute under 35 U.S.C. 41(a) and are not set at a cost recovery level. In fact, the statutory filing fee for an application is much lower than the average cost of the examination of the application. In contrast, the statutory patent maintenance fees set forth in 35 U.S.C. 41(b) are a significant source of income to the Office for very little actual work, which are, in effect, an offset for the application filing fee. On the other hand, the reexamination fees under 35 U.S.C. 41(d) must fully recover the cost of the reexamination. The submissions will be numerous in an *inter partes* reexamination proceeding, e.g., multiple responses and comments by the patent owner and third-party requester responsive to the Office and to each other. Further, these responses and comments are expected to be thorough and extensive which in turn must be analyzed by the examiner, requiring the expenditure of substantial time and

resources. The additional examination hours, supervisory oversight, and other processing steps unique to *inter partes* reexamination have to be factored into the fees. The *inter partes* examination process is expected to require close policy oversight by legal advisors in the Patent Examination Policy Law Office, in addition to the extra resources needed to handle the anticipated increased number of submissions by the parties. The reexamination filing fee being set in the present rule package is \$8,800 for filing a request for an *inter partes* reexamination under proposed § 1.913(a). This fee is considered to be appropriate based on the Office projections of the amount of work that will be required.

As to the second and third comments, directed to the disparity between fees for the patent owner and the third-party requester, it is noted that the current statute retains the current *ex parte* reexamination statute and provides an optional *inter partes* reexamination. It is anticipated that the expense of an *inter partes* reexamination will be substantially more than the expense of an *ex parte* reexamination and, consequently, the fees reflect this. Generally speaking, during the examination of an *ex parte* reexamination, the examiner applies the best art and normally limits the number of rejections made for a given claim to the best grounds. When responding to a third-party requester of an *inter partes* reexamination, the Office's preparation of an Office action will include responding to all of the multiple alleged grounds for rejections put forward (proposed) by the third-party requester. All of the grounds proposed by the third-party requester must be addressed by the examiner, because any proposed ground of rejection not adopted is a decision favorable to patentability which is subject to appeal by the third-party requester to the Board of Patent Appeals and Interferences. Thus, the extra effort needed for an *inter partes* reexamination entails not merely responding to amendments and arguments of the patent owner, but the substantially higher burden of responding to the arguments of the third-party requester and the many multiple decisions as to why a particular rejection is or is not an appropriate one to make. As to the second comment in particular, the difference in the amount of the fees is based on these projected costs and not on the legal position of the parties. As to the fourth comment regarding the discouragement of inappropriate requests, the setting of the filing fees is

strictly based on cost expectations and not for the purpose of discouraging inappropriate reexamination requests.

Subsidizing of the cost of the reexamination proceedings (as suggested by the fifth comment and opposed by the eleventh comment) through increased costs to users of other services offered by the Office (as an alternative to pricing based on cost recovery) would naturally be viewed with disfavor by the users of other services. Also, the Office is not authorized to permit small entity reductions in reexamination filing fees. As to the suggestion regarding the apportionment of costs in stages as the proceeding evolves (e.g., higher fees at the appeal stage) (mentioned in the fifth and sixth comments), this is not practical since there would be no way to guarantee recovery of the total cost of reexamination. A third-party requester may decide to drop out of the reexamination and not pay the next required fee. The reexamination, however, would have to continue to resolve issues that had been raised. Moreover, appeal fees are set by statute under 35 U.S.C. 41(a)(6) and are not part of the reexamination filing fee. As to the utilization of a team of examiners to facilitate a review by a panel prior to forwarding the reexamination to the Board of Patent Appeals and Interferences, it is anticipated that appeal conferences will be made mandatory so that all work of an examiner will be thoroughly reviewed prior to the filing of an examiner's answer. Implementation of such review is better set by Office policy rather than by rule making.

As to the suggestion in the eighth comment that the fees be reduced for filing a request for reexamination within a short period (e.g., six months) following the issuance of a patent, reexaminations are generally based upon new prior art raising new issues so that the benefits (if any) of filing a reexamination within a short time after issuance of a patent would not warrant a reduction in fees. The ninth and tenth comments were directed to the impact of the \$11,000 fee required in the August 11, 1995, Notice of Proposed Rulemaking (for all reexaminations) will have on independent inventors and small companies. With respect to this, it should be noted that, as the statute has now been drafted and passed into law (Pub. L. 106-113), the filing of an *ex parte* reexamination is still available to a third-party requester, and the filing fee for such is \$2,520. Thus, a less costly *ex parte* reexamination will be available to members of the public who may not be able to afford a full scale *inter partes*

reexamination which has a currently proposed filing fee of \$8,800.

#### Issue 2

Two comments in response to the August 11, 1995, Notice of Proposed Rulemaking suggested that the Office reconsider the refund provisions. One comment suggested that the 75% refund of the fee should be reduced, since third parties who file unjustified requests should not be rewarded by so great a refund. Another comment suggested that the difference between the fees for a patent owner and a third-party requester varied by more than a factor of two and that it was difficult to rationalize why a refund of 75% would be provided for both instead of charging a flat fee of \$1500 if the Director decides not to institute a reexamination proceeding (since the amount of work done in both cases should not differ).

#### Response to Issue 2

The comments have been adopted. Section 1.26(c), as currently proposed, sets the amount of refund to provide for the retention of a uniform fee of \$830, with the remainder of the filing fee being refunded, for all reexamination requests where the Director decides not to institute a reexamination proceeding. For the *ex parte* reexamination fee of \$2,520, an amount of \$1,690 will be returned, thus resulting in a retention of \$830. For the *inter partes* reexamination fee of \$8,800, an amount of \$7,970 will be returned, again resulting in a retention of \$830. The amount of \$830 being retained by the Office is based on projected cost expectations and is not for the purposes of penalizing unwarranted requests, since it is neither desirable nor appropriate to penalize parties for whom requests for reexamination are denied.

#### Issue 3

One comment in response to the August 11, 1995, Notice of Proposed Rulemaking suggested that the third-party requester should be required to certify that the request for reexamination contains all information that the requester regards as materially adverse to the patentability of the patent.

#### Response to Issue 3

This suggestion has not been adopted since it is in the third-party requester's best interests to submit all information that the requester regards as materially adverse to patentability with the request for reexamination in order to increase the possibility of the request for reexamination being granted. Moreover, proposed § 1.948 of the present rule

package now provides that prior art submissions by the third-party requester filed after the *inter partes* reexamination order shall be limited to: (1) Any prior art which is necessary to rebut a finding of fact by the examiner or a response of the patent owner; or (2) any prior art which became known or available to the third-party requester after the filing of the *inter partes* reexamination proceeding. This is additional incentive to submit all known (and available) material prior art with the request.

#### Issue 4

Four comments in response to the August 11, 1995, Notice of Proposed Rulemaking were directed to the selection of the examiner and/or number of examiners. A first comment opined that it was Office practice to assign the reexamination to the examiner who originally examined and issued the patent and not on the basis of the classification of the art. The comment further noted the assignment to the same examiner defeats the underlying purpose of reexamination and petitioning for a transfer to a different art unit based on the classification of the art can also be unsuccessful, despite the "Transfer Procedure" in MPEP Section 2237 for those times when a reexamination request should be assigned to a different group art unit. The comment suggested that if a third-party requester requests a reexamination, it should be conducted by a different examiner, and further, if appropriate, assigned to a different art unit. A second comment noted that § 1.931(b) of the August 11, 1995, Notice of Proposed Rulemaking provides the only limitation placed on the selection of the examiner, namely that an examiner whose decision refusing reexamination has been reversed will not ordinarily conduct the reexamination. The comment suggested reevaluating the practice of assigning the same examiner who prosecuted the application which issued as a patent to conduct the reexamination, since many practitioners feel that the original examiner may have a bias against fully considering prior art during a reexamination proceeding. A third comment stated that since an *inter partes* reexamination proceeding is more complicated to manage than an *ex parte* reexamination proceeding, the *inter partes* reexamination proceeding is likely to require a higher degree of technical and legal competence in making a determination of patentability than is normally required in an *ex parte* reexamination proceeding. An examiner in an *inter partes* reexamination proceeding will be required to weigh

and assess the credibility of often conflicting arguments, theories of operation, and evidence when making a determination of patentability. Although statistics appear to indicate that there is no inherent bias in the conduct of a reexamination proceeding when the proceeding is assigned to the same examiner who issued the patent, many perceive a bias (in favor of the patent owner) when the reexamination proceeding is assigned to the same examiner. The comment advocated assigning the reexamination proceeding to the best qualified examiner available, given the technical, legal, and procedural complexities that are likely to arise in the reexamination proceeding. The comment also suggested the formation of a separate unit of examiners to handle the new reexamination proceedings, or at least those which involve a third-party requester. The fourth comment suggested that the number of examiners be increased from one to three, including a supervisory primary examiner and a Group Director, in order to increase the probability of a "correct" decision and develop a higher degree of confidence in the reexamination process, and avoid situations where a third-party requester feels the examiner did not understand the prior art, the interview, or the declarations, etc. The comment suggested that the small increase in Office costs, and fees to be charged to participants, will probably be offset by having fewer appeals (and law suits) filed (which is of benefit to the public), and will still be a cost-effective means of resolving patent disputes, as compared to litigation. The fifth comment suggested that more than one examiner be responsible for issuing the Right of Appeal Notice, similar to the European Patent Office. Modification of the proposed rules to allow a decision from a panel of three capable examiners, would result in a higher degree of quality in the reexamination process and less ancillary issues later being raised (such as examiner bias or an examiner's lack of understanding of the relevant art or law). The comment suggested that the panel could include, for example, a legal specialist within the Examining Group, the original examiner of the application, and a primary examiner having knowledge of the relevant technical field and the record would reflect when a panel member concurs or dissents.

#### Response to Issue 4

As to the selection of the examiner, studies conducted by the Office have not discovered any bias irrespective of whether the same or a different

examiner handles the reexamination. The same examiner should not be biased toward confirming patentability, because a reexamination is not a rehash of old issues, but rather, a new question of patentability. In spite of the above, the Office is, for the most part, adopting the comment suggesting assignment of the reexamination to an examiner other than the one who originally examined and issued the patent. The comment is being adopted in order to eliminate public perception of bias by the original examiner who handled the patent. The comment will be implemented as a matter of policy, rather than by rule change. The MPEP will be revised to set policy that unless a Group Director needs to make an exception, a reexamination will not be assigned to a Supervisory Patent Examiner, a primary examiner, or a junior examiner who was actually involved (by preparing/signing an action on the merits) in the examination and issuance of the patent undergoing reexamination.

As to the Office personnel to be involved in the reexamination proceedings, the Office is considering the creation of a special group/unit having legal advisors trained in *inter partes* reexamination procedures to oversee the examination of the *inter partes* reexamination by the patent examiner in the examining group. For technical expertise, an examiner selected from the groups will be assigned the reexamination. The advantage of such a special group/unit is that it will include the examiner most familiar with the technology to make the patentability decisions and legal advisors to provide uniformity of the reexamination practice and procedure.

As to the comment suggesting that the number of examiners handling a reexamination proceeding be increased from one to three, the following is to be noted. In order to provide a thorough review by a team of examiners, a practice is being considered to hold a panel review just prior to the decision on the request for reexamination (order/denial) is issued and at the close of prosecution (i.e., just prior to "allowance" of the reexamination or just prior to issuing a right of appeal notice and final rejection). The panel review will be similar to the appeal conference review done in an application on appeal. It should further be noted that appeal conferences are already mandatory before a reexamination leaves the examiner for a decision by the Board of Patent Appeals and Interferences. If adopted, this will be implemented as a matter of policy, rather than by rule change.

#### Issue 5

One comment responding to the August 11, 1995, Notice of Proposed Rulemaking suggested that the content of the "prior art" made available for review by the Office should also include *inter partes* sworn testimony of the inventor(s) and others associated with the implementation of the invention and any patent work thereon covering their knowledge of the known prior art, related industry practices, and the like, which evidence may also impeach the inventor(s) and others in the sense of withholding known prior art from the Office.

#### Response to Issue 5

*The Advisory Commission on Patent Law Reform: A Report to the Secretary of Commerce, August 1992*, at page 117, recommended limitations on the scope of documentary prior art evidence and cautioned against reliance on testimonial evidence in light of the abuses of the process which occurred in the reissue protest proceedings under the Dann Amendments. The Commission found the Office to be an inappropriate forum for addressing all issues of validity. Affidavits or declarations which merely explain the contents or pertinent dates of prior patents or printed publications in more detail may be considered during reexamination, but any rejection must be in accordance with proposed § 1.906(a) (Scope of reexamination in reexamination proceeding). Proposed § 1.906(a) limits the scope of reexamination in that claims in an *inter partes* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

#### Issue 6

One comment in response to the August 11, 1995, Notice of Proposed Rulemaking suggested that when an examiner allows a claim, the decision of the examiner should be supported by a well-reasoned opinion establishing the examiner's reasons for allowance. The comment stated that although § 1.109 provides that the examiner "may set forth such reasoning" for the allowance, this is rarely done and often with only a brief note. It was pointed out that well-reasoned opinions are critically important in *inter partes* reexamination procedure to third-party requesters (or patent owners) who are actively participating and who need the reasons for allowance (or for final rejection) in deciding whether to appeal.

#### Response to Issue 6

Office policy will direct the examiner to make a complete record of the reasons for allowing or rejecting a claim at various stages during the proceeding. Note further that, according to currently proposed § 1.953 (Examiner's Right of Appeal Notice), the Right of Appeal Notice is required to include "an identification of the status of each claim, and the reasons for patentability and/or the grounds of rejection for each claim." Thus, the examiner's reasons for patentability and/or the grounds of rejection will be available in *inter partes* reexamination procedure to the third-party requesters (and patent owners) who are actively participating and who need the reasons for allowance (or the grounds for final rejection) in deciding whether to appeal.

#### Issue 7

One comment in responding to the August 11, 1995, Notice of Proposed Rulemaking questioned whether in view of the new fee structure, the examiner will be required to do a new search of the prior art.

#### Response to Issue 7

The Office has chosen to rely upon the examiner's judgment and expertise in determining how much searching should be done in the reexamination proceeding. If the examiner believes that additional prior art patents and publications can be readily obtained by searching to supply any deficiencies in the prior art cited in a request, the examiner has the option of performing an additional search. The examiner is not required to, and will not routinely, make a full search.

#### Comments Directed to Specific Rules

##### Issue 8

One comment stated the belief that § 1.901 of the August 11, 1995, Notice of Proposed Rulemaking (which relates to the submission of prior art) places an unnecessary burden on a person to cite art to be placed in the file of an issued patent. A patentee who obtains prior art as a result of a foreign search report or by a competitor may believe it to be irrelevant and should be encouraged to file it without any statement that the art is pertinent, since it may turn out to be relevant when combined with other unknown prior art.

#### Response to Issue 8

Current § 1.501 is being retained, and thus there is no need for proposed § 1.901 of the August 11, 1995, Notice of Proposed Rulemaking which was to track and replace § 1.501. Section 1.501

provides a system for citation of patents and printed publications to the Office for placement in the patent file by any person during the period of enforceability of the patent in accordance with 35 U.S.C. 301. Section 1.501 requires the citation to state the pertinency and applicability of the cited documents to the patent and the bearing the documents have on the patentability of at least one claim of the patent pursuant to the same statutory requirement set forth in 35 U.S.C. 301.

#### Issue 9

Two comments suggested clarification of the language of the third-party estoppel provisions proscribed by §§ 1.907 and 1.909 of the August 11, 1995, Notice of Proposed Rulemaking, specifically the language “could have raised” used in both rules. One comment recommended that the third-party requester have the same obligation to raise issues known to him as the patent owner has. Another comment opined that the phrase “or could have raised during the prior reexamination proceeding” could be construed broadly, so as to stop a third-party requester from challenging the invalidity of a claim based on prior art which was in the possession of the third-party requester at the time of a prior reexamination proceeding, but which was not discovered at that time. Thus, depending on how the expression “could have” is interpreted, this could place a substantial burden on a large corporation. It was also suggested that the duty of individuals to disclose information known to them to be material to patentability is another difficult provision, particularly the phrase “and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding.”

#### Response to Issue 9

35 U.S.C. 315(c) and 317(b) of the Act use the phraseology “could have raised” with respect to issues of the third-party. The Office, as the sole agency that administers the patent statute, properly interprets statutory language in the first instance, subject to review by the courts. The question of whether an issue could have been raised must be decided on a case-by-case basis, evaluating all the facts and circumstances of each individual situation. It would not be appropriate at this time to provide an “all encompassing” definition, that might not account for facts which could arise in the future which cannot be anticipated. As to the duty of disclosure, proposed § 1.933 is substantially unchanged from existing § 1.555, which

was formulated to balance the interests of the patent owner with the benefits to the public interest of the disclosure of material prior art.

#### Issue 10

One comment suggested that § 1.915(b)(7) of the August 11, 1995, Notice of Proposed Rulemaking be amended to specifically refer to reexaminations under the newly proposed regulations. As § 1.915(b)(7) was drafted, the required certification that the person filing an additional reexamination during the pendency of an ongoing reexamination is not a privy of the patent owner or of the third-party requester of the ongoing reexamination would include an ongoing reexamination proceeding ordered under the old regulations. Since one of the purposes of the new reexamination legislation is to permit participation by a third-party requester, no useful or public purpose would be served by precluding a third-party requester from filing a request for reexamination under the new regulations where there was a pending reexamination initiated under the old regulations.

#### Response to Issue 10

The language of proposed § 1.915(b)(7) has been drafted to specifically refer to an *inter partes* reexamination; this should accurately track the statutory prohibition of a third-party requester of an ongoing (pending) *inter partes* reexamination from requesting another *inter partes* reexamination. Note, however, that the current proposed rules do not preclude an *ex parte* third-party requester from filing an *inter partes* reexamination request.

#### Issue 11

Two comments responding to the August 11, 1995, Notice of Proposed Rulemaking were directed to the identification of the real party in interest. One comment suggested that as to the identification of the real party in interest, § 1.915(b)(10) of the August 11, 1995, Notice needs to be clarified on the question of whether a third-party requester filing in the name of an attorney must be identified. A second comment suggested that the real party in interest should be identified at least by the time of filing of the notice of appeal to the Court of Appeals for the Federal Circuit.

#### Response to Issue 11

The real party in interest must be set out in the request. 35 U.S.C. 311(b)(1) requires that the request “include the identity of the real party in interest.”

Proposed § 1.915(b)(8) (previously § 1.915(b)(10) in the 1995 rule package) tracks this provision of the statute and requires the requester to identify the real party in interest at the time of filing the request. If an attorney is filing a request for *inter partes* reexamination on behalf of another party, that other party must be identified. Thus, the third-party requester will be identified. As to the patent owner, proposed § 1.965(c)(1) requires the identification of the real party in interest at the time of the filing of the appellant brief, and proposed § 1.967(b)(1) requires the identification of the real party in interest at the filing of the respondent brief. Accordingly, the real parties in interest, for both the third-party requester and the patent owner, should be identified prior to an appeal to the Court of Appeals for the Federal Circuit by the patent owner (the current statute prohibits the third-party requester from appealing to the courts).

#### Issue 12

One comment responding to the August 11, 1995, Notice of Proposed Rulemaking was concerned that active third-party requesters representing large businesses could mount a series of attacks through “fourth parties” and “tie up” the invention of a small inventor for years.

#### Response to Issue 12

The statute is structured to balance the interests of the patent owners (to reduce costs and prevent harassment) and the public interest in promoting the validity of patents. Proposed § 1.907 tracks 35 U.S.C. 317 and is intended to prevent repeated challenges to the patent by third parties and their privies. In accordance with 35 U.S.C. 317(a), proposed § 1.907(a) prohibits the filing of a subsequent *inter partes* request for reexamination of the patent by the third-party requester or its privies until a reexamination certificate has been issued. In accordance with 35 U.S.C. 317(b), § 1.907(c) provides that if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to patentability of a claim, the third-party requester and its privies may not later request another *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding. Moreover, proposed § 1.915(b)(8) (previously § 1.915(b)(10) in the 1995 rule package) tracks 35 U.S.C. 311(b)(1) and requires the requester to identify the real party

in interest at the time of filing of the *inter partes* request.

#### Issue 13

One comment suggested that in regard to §§ 1.921 and 1.945 of the August 11, 1995, Notice of Proposed Rulemaking, supplemental responses and new prior art submissions should be permitted by the patent owner in order to substantiate certain points at issue (e.g., secondary considerations). It was further suggested that supplementation of responses be permitted. It was also suggested that submission of new publications by the third-party requester should be permitted in response to any amendment made by the patent owner which reduces the scope of the original claims.

#### Response to Issue 13

Proposed § 1.945 permits the patent owner to respond to any Office action, which response may include arguments and proposed amendments. There is no proscription regarding the submission of evidence relating to secondary considerations. As to third-party requesters, proposed § 1.948 provides that prior art submissions by the third-party requester filed after the *inter partes* reexamination order shall be limited to: (1) Any prior art which is necessary to rebut a finding of fact by the examiner or a response of the patent owner; or (2) any prior art which became known or available to the third-party requester after the filing of the *inter partes* reexamination proceeding. Accordingly, submission of new publications by the third-party requester in response to an amendment made by the patent owner which reduces the scope of the original claims would be permitted as a rebuttal of a "response of the patent owner."

#### Issue 14

One comment stated that as to § 1.927 of the August 11, 1995, Notice of Proposed Rulemaking, a determination by the Director refusing to initiate reexamination is final and nonappealable by a third-party. The rule should be amended to allow the third-party to appeal, since without an opportunity to appeal, a third-party's interests would be seriously jeopardized.

#### Response to Issue 14

Proposed § 1.927 of the present rule package (petition to review denial of the request for reexamination) has been drafted to track 35 U.S.C. 312(c). Proposed § 1.927 provides that "[t]he third-party requester may seek review by a petition to the Director under

§ 1.181 within one month of the mailing date of the examiner's determination refusing reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable." Thus, although the third-party requester does not have an appeal right, it may obtain a review of the decision of the examiner refusing reexamination by filing a petition. If the decision on the petition, however, affirms that no substantial new question of patentability has been raised, the determination is final and nonappealable, as is statutorily required by 35 U.S.C. 312(c).

#### Issue 15

Two comments were directed to the length of briefs specified in § 1.943 of the August 11, 1995, Notice of Proposed Rulemaking. One comment suggested that the length of briefs would be more meaningful if the size of the paper and the type font were specified. A second comment stated that the page limitation on briefs in § 1.943 is too restrictive, especially for patent owners, since there is no limitation on the number of issues which a third-party can raise, which may require a longer response from the patent owner. It was suggested that the rule should permit longer briefs upon a showing of good cause.

#### Response to Issue 15

As to the first comment, this comment is being adopted. Section 1.943, as proposed in the present rule package, has been drafted to set forth (by reference to § 1.530(d)(5)) the requirements for responses, amendments, briefs, appendices and other documents including the size of the paper, the minimum size of the type font (11-point), the line spacing and the margin requirements.

As to the second comment, the 50-page limit for amendments proposed to be set in § 1.943 is considered to be sufficient to deal with the third-party requester's comments. Note that the 50-page limit excludes reference materials such as prior art references. Where an extraordinary situation arises where justice requires the 50-page limit to be exceeded, the patent owner may petition under § 1.183 to suspend the page limit requirement of § 1.943.

The page limit set in proposed § 1.943 of the present rule package for briefs is such that appellant briefs shall not exceed 30 pages or 14,000 words in length (excluding appendices of claims and reference materials), and all other

briefs by any party shall not exceed 15 pages or 7,000 words in length. These numbers of pages are in line with procedural rules of the Federal Courts; see for example Rule 32(a)(7)(A) of the Federal Rules of Appellate Procedure or Rule 33 of the Rules of the Supreme Court of the United States (Practice & Procedure).

#### Issue 16

Several comments were concerned with the time periods for response and extensions of time. Two comments suggested that the time periods for response for § 1.945 (patent owner) and § 1.947 (third-party requester) of the August 11, 1995, Notice of Proposed Rulemaking should be a minimum of two months for each party. A third comment suggested only that the patent owner be given two months to respond. The first comment suggested that the first month extension should be available upon payment of a fee (as in regular patent applications), with further requests requiring justification or cause. The second comment suggested that §§ 1.945 and 1.947 should be made consistent with each other (30 days versus one month) to alleviate any confusion by stating the number in months. The second comment further suggested that the extension of time procedure is unworkable since the Office could not act on the request for an extension of time (if filed within the one-month period of time) before the deadline for the response. Instead, the usual extension of time procedure used for regular patent applications should be available. The fourth comment stated that the time periods for submitting a response, a written comment, an appeal brief, and a respondent brief and for appealing or cross-appealing (§§ 1.945, 1.947, 1.951, 1.953, 1.959, 1.963, 1.971, 1.973, 1.979, 1.983, and 1.993) are too short, especially for residents outside of the United States (due to mailing delay).

#### Response to Issue 16

Proposed § 1.947 of the present rule package has been drafted to provide for a 30-day response period (from service of the patent owner's response on the third-party requester) for third-party requester comments. This tracks the requirement of 35 U.S.C. 314 that third-party requester comments be filed "within 30 days after the date of service of the patent owner's response." Proposed § 1.945 has been drafted to provide for an "at least 30 days" response period for the patent owner. This tracks the requirement of 35 U.S.C. 133 that the time for response to an Office action shall be "not less than 30



days." A shortened statutory period of two months will generally be set for patent owner responses to Office actions on the merits; however, where litigation has been suspended pending a determination in the reexamination proceeding, or for a like reason, the period will be shortened to one month or 30 days as is appropriate.

The suggestion that §§ 1.945 and 1.947 be made consistent with each other has been adopted to the extent that the currently proposed rules (§§ 1.945 and 1.947) recite both time periods in terms of days rather than months. The period for the patent owner response to an Office action will not, however, be made 30 days to correspond to the third-party comment period mandated by statute. While the statute limits the third-party requester to 30 days to comment on patent owner responses, a longer period for the patent owner to respond is appropriate in view of the potential need for counsel to consult with the patent owner, consider amendments, etc.

As to extensions of time, 35 U.S.C. 305 provides that all reexamination proceedings will be conducted with special dispatch within the Office. Section 1.956 provides that extensions of time will be available to the patent owner upon a showing of sufficient cause. Third-party requester's 30-day time period for comments is statutory; thus, it cannot be extended. This is consistent with the recommendation (VII-B) of *The Advisory Commission on Patent Law Reform: A Report to the Secretary of Commerce, August 1992* to provide for the opportunity for the third-party requester to submit written comments "within strict time deadlines."

#### Issue 17

One comment suggested that, as to § 1.949 of the August 11, 1995, Notice of Proposed Rulemaking, a more flexible policy on closing prosecution be adopted in a reexamination proceeding than is currently applied by the Office in its final action practice. Specifically, this proposed section indicates that prosecution will not normally close if there is a new ground of rejection (not previously addressed by the patent owner) which was not necessitated by an amendment to the claims by the patent owner. There was particular concern in the comments about a situation where new prior art is relied on even if it was necessitated by an amendment to the claims. It was noted that the proposed practice may serve a useful purpose in the normal examination of patent applications, where an applicant always has the

opportunity to file a continuing application to make any further amendments to the claims that may be desirable to address the new ground of rejection; however, in a reexamination proceeding, where the patent owner is precluded from having any right to amend the claims to address the new ground of rejection or to file another request for reexamination, the patent owner may be trapped with no effective way to address new prior art that has been introduced for the first time in the Office action that simultaneously closes the prosecution. It was urged that this could be fundamentally unfair to the patent owner. Where new prior art is asserted by the examiner, the patent owner should have the opportunity to amend the claims.

#### Response to Issue 17

By weighing and balancing the interests of the parties, it is believed the rule as proposed is fair and reasonable. A rule which would prohibit an Office action from closing prosecution following a new art rejection responsive to a patent owner amendment would conceivably be subject to abuse, since patent owners could purposely add an amendment in each response to thus necessitate a new art rejection and thereby preclude the closing of prosecution for an unlimited number of cycles.

#### Issue 18

Eight comments were directed to interviews (provided for in § 1.955 of the August 11, 1995, Notice of Proposed Rulemaking). One comment suggested the need for a more accurate statement of why claims were found to be allowable as the result of an interview. A second comment suggested that the Office rules be modified to specifically require a means for more accurately recording what transpires at interviews, regardless of which party requests the interviews or whether all parties are present. The comment further stated that "recording" did not imply physical recording by electronic means or by a court reporter, but by a more thorough method of reporting by an examiner as to what transpired at the interview (which would be particularly effective with a multi-examiner review system). The comment indicated that the reporting of the "minutes" should be done to all parties, including a brief, non-binding, and informal opinion by the examiner on the resolution of the issues presented, so as to give all parties the opportunity to respond to the issues raised at the interview. A third comment suggested that the proposed rules should be modified to achieve two

objectives. The first objective would be to provide an opportunity to better communicate issues to examiners (particularly those issues which are difficult to express on paper and might be better demonstrated; e.g., by charts, tables, or physical demonstration) of what is purported to be the main technical aspect of an invention, and how that technical aspect is or is not suggested by the prior art, either before or after the formal submission, so that they will have a better understanding of what the data represents. A second objective should be to provide a complete record for later review for a judge or an attorney who reviews the file history for a decision on patentability or infringement assessment. The proposed § 1.955 was stated to benefit the patent owner, who is the only party allowed to request an interview, thereby providing a tremendous advantage and, therefore, the rule should be modified to allow a third-party requester the opportunity to initiate an interview. The comment further criticized the lack of a specific requirement for recording what transpires at interviews, on the basis that an Examiner Interview Summary Record would be of little value in an *inter partes* reexamination proceeding, since the record is too abbreviated to be of any real value in subsequent proceedings and it is unlikely that much detail could be put into any interview record if more than one party, as well as a senior level official (whose presence would be required under the proposed rule) are all present and are relying upon an examiner to hurriedly write a summary of the interview. The comment suggested modification of § 1.955 to include an effective procedure for recording the details of what transpired at an interview. A fourth comment suggested that, in view of the criticality of the content of interviews in subsequent litigation, a mechanism should be made available for recording statements made at substantive interviews that occur during reexamination, whereby any party to a reexamination should be permitted to have a transcript of the substantive interviews made of record at their own expense. The comment further suggested that requesting parties would both supply the means for transcription and would bear the costs associated therewith. A fifth comment suggested that the third-party requester be allowed not only to participate but also initiate an interview, and that the third-party requester be provided, at a sufficient time prior to the interview, the particulars of the claim at issue at the



interview, the objective of the interview, and the specific data to be used at the interview, so that the third-party requester would be able to take substantial part in the discussion at the interview. A sixth comment was in favor of the third-party requesters having the right to participate in interviews but opposed giving third parties the right to initiate them. The reason given was that the rules need to balance the right to encourage third parties to participate with the need to keep reexamination quick and inexpensive. The comment further stated that in view of the expense, including the time required to review the transcript and the continuing attempts to make corrections and clarifications, a rule change to permit or require transcription of interviews is not recommended. Such a rule would make reexaminations more like court proceedings. A seventh comment suggested that § 1.955 should be changed to permit the third-party requester to request an interview because the third-party requester, like the patent owner, may have experts and/or documentary evidence that is not suitable for written declarations. An eighth comment suggested that if interviews are to be recorded, consideration should be given as to whether participants would be under oath.

#### Response to Issue 18

The Office has reconsidered its initial position (taken in the August 11, 1995, Notice of Proposed Rulemaking) to permit owner-initiated interviews in which the patent owner and the third-party requester participate. The presence of a third-party requester will complicate the reexamination proceeding and delay it. There is no reason to further complicate and delay the proceeding with *inter partes* interviews, which past history has shown to be not only resource intensive, but unwieldy. *Inter partes* interviews are difficult to arrange, control, and conduct. There would be interaction between the patent owner's representative and its experts, the third-party's representative and its experts, the examiner, and the "senior level official" which would be difficult to regulate and control. It is difficult to record what happened, and cross-transcripts would result in delay and complications. In addition, the time to arrange and conduct the interview would greatly extend the *inter partes* proceeding time line, and this is clearly contrary to the "special dispatch" required by 35 U.S.C. 314(c) for the *inter partes* reexamination proceeding. As to

the comments suggesting that the third-party should be permitted to initiate interviews, this would even further complicate the proceeding, adding undue cost to the parties and the Office and further delay to the proceeding.

Accordingly, the Office has decided that the third-party requester of the *inter partes* reexamination should neither be permitted to initiate nor be permitted to participate in an interview which addresses the merits of the proceeding. If, however, the patent owner is permitted to initiate and participate in an interview which addresses the merits of the proceeding while the third-party requester is not, this will create an advantage to the patent owner which is contrary to the intent and purpose of the *inter partes* reexamination addition to the statute. Thus, to "level the playing field" in the Office, in accordance with the intent and purpose of the statute, the patent owner will neither be permitted to initiate nor be permitted to participate in an interview which addresses the merits of the proceeding. In other words, no interviews which address the merits of the proceeding will be permitted (or held) in an *inter partes* reexamination proceeding. This offers the additional advantage of further shortening the proceeding, pursuant to the dictates of "special dispatch" in 35 U.S.C. 314(c). Even further, this deals with the comments which argued that the content of the *inter partes* interview cannot be adequately captured without the use of expensive and complex transcripts. Anything stated or decided in the proceeding will be on the record, in writing.

As to the comments regarding improving the record of what transpired at interviews, clarity of the record is a concern to the Office. Accordingly, in § 1.560(b) (Interviews in *ex parte* reexamination proceedings), it is required for interviews in *ex parte* reexamination proceedings that "[i]n every instance of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner." (Emphasis added). The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the *ex parte* reexamination interview, or as a separate paper within one month from the date of the *ex parte* reexamination interview, whichever is later. Regarding *inter partes* reexamination proceedings, there will be no interviews at all which address the merits of the *inter partes* reexamination proceeding, as discussed in the previous paragraph, thus the

comments regarding improving the record of what transpired at interviews are moot as to *inter partes* reexamination proceedings.

With respect to the suggestion of prior notice of what issues will be discussed (the specific objective of the interview and the materials to be presented), patent owners requesting interviews in *ex parte* reexamination proceedings are in fact expected to submit such materials prior to the interview with ample time for review. As to whether participants at recorded interviews (which are only permitted in special circumstances in *ex parte* reexamination proceedings) should be under oath, this is believed to be unnecessary in view of 18 U.S.C. 1001, which provides "[w]hoever, in any matter within the jurisdiction of any department or agency of the United States knowingly and willfully falsifies, conceals or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be fined not more than \$10,000 or imprisoned not more than five years, or both."

#### Issue 19

One comment stated that, as to § 1.959(a)(2) of the August 11, 1995, Notice of Proposed Rulemaking, the introduction of a right to appeal by a third-party requester who is dissatisfied with an examiner's favorable consideration of a claim is an important and beneficial aspect of the new reexamination proceedings. However, the apparent unqualified opportunity to file an appeal at this advanced stage in the proceedings raises a concern that the appeal procedure could be used to compromise the patent owner's ability to address the reasons and the evidence that the third-party requester might use in its appeal and to add (perhaps intentionally) considerable length to a proceeding that is to be conducted with special dispatch. The comment was concerned that the likelihood exists that the first time the patent owner will be made aware of the grounds of rejection to be relied upon by the third-party requester will be upon receiving the third-party's appeal brief, adding complexity and length to the proceeding. In spite of this, the provisions in § 1.967(b) relating to the respondent brief apparently do not contemplate any opportunity for the patent owner to offer an amendment or material appropriate to the new ground of rejection, as is permitted when an

examiner makes a new ground of rejection in the examiner's answer (see proposed § 1.971(b)). The comment suggested that consideration must be given to setting appropriate limits on the grounds of rejection that the third-party requester can rely upon in its appeal; including consideration to requiring the third party requester who files a notice of appeal under proposed § 1.959(a)(2) to identify in this notice the grounds of rejection that it will rely upon in its appeal.

#### Response to Issue 19

Third-party requester's prior art submissions in an *inter partes* reexamination (after reexamination is ordered) are limited by the currently proposed § 1.948 to prior art: (1) Which is necessary to rebut a finding of fact by the examiner; (2) which is necessary to rebut a response of the patent owner; or (3) which became known or available to the third-party requester after the filing of the *inter partes* reexamination proceeding. Under § 1.947 (Response by third-party requester to patent owner's response), the third-party requester's comments shall be limited to issues raised by the action of the Office or the patent owner's response. Accordingly, the third-party requester could not advance a new ground of rejection based upon new prior art at the appeal stage. Although the notice of appeal does not require specific identification of the issues, the appellant's brief does. See currently proposed §§ 1.965(c)(6) (appellant brief), 1.967(b)(6) (respondent brief) and 1.971 (rebuttal brief), all of which specifically prohibit the third-party from introducing new grounds of rejection at each respective stage of the appeal.

#### Issue 20

One comment submitted in response to the August 11, 1995, Notice of Proposed Rulemaking suggested that the enforcement role of the Office should be such that the examiner is obligated to issue an examiner's answer in every reexamination proceeding. The comment noted that present (1995) rules provide that an examiner may issue an examiner's answer. It was urged that when the Office decides that an invention is unpatentable, it is incumbent that the Office not rely upon the third-party requester exclusively, and therefore, examiner's answers should be mandatory.

#### Response to Issue 20

Although the currently proposed § 1.969(a) (and § 1.193(a)(1)) indicates that an examiner's answer may be furnished, common practice is to

furnish an examiner's answer. This practice is implemented through procedures set forth in the MPEP. Moreover, the examiner cannot be obligated to issue an examiner's answer in every instance, since, in rare instances, it will become necessary to reopen prosecution for consideration of a recently discovered new ground of rejection or reason for patentability.

#### Issue 21

One comment responding to the August 11, 1995, Notice of Proposed Rulemaking suggested that appellant should be given the opportunity to reply to both the opening brief of the respondent and the examiner's answer, either by filing briefs in response to each, or by a single reply brief after the examiner's answer.

#### Response to Issue 21

The second option of the comment has been adopted. The currently proposed § 1.971 (Rebuttal Brief) provides that, following the examiner's answer, any appellant may once submit a rebuttal brief. The rebuttal brief of the patent owner may be directed to the examiner's answer and/or any respondent brief. The rebuttal brief of any third-party requester may be directed to the examiner's answer and/or the respondent brief of the patent owner. The rebuttal brief of a third-party requester may not be directed to the respondent brief of any other third-party requester. No new ground of rejection can be proposed by a third-party requester appellant.

#### Issue 22

One comment responsive to the August 11, 1995, Notice of Proposed Rulemaking suggested that because both the request for oral argument and the briefs replying to the examiner's answer are due within one month, the parties will likely not be able to consider each other's final written submissions before requesting oral argument and, therefore, the period for requesting an oral hearing be lengthened to 45 days, thus giving the parties 15 days to consider each other's final written submissions.

#### Response to Issue 22

This comment has been adopted as follows. Section 1.973(b) (Oral Hearing) as proposed provides that the parties have two months after the date of the examiner's answer to file a written request for oral hearing.

#### Issue 23

One comment suggested that proposed § 1.979(b) of the August 11, 1995, Notice of Proposed Rulemaking

provides an opportunity for each party to file a single request for rehearing (referred to as "request for reconsideration" in the comment) of the decision of the Board of Patent Appeals and Interferences. However, there is no apparent opportunity for the other party to provide comments on that request. The lack of this opportunity is not consistent with the general approach in the new reexamination process of providing an opportunity for both parties to provide comments before any action is taken by the Office, and it was suggested once a request for rehearing has been filed by either or both parties, that the other party have a one-month period to offer comments on the request for rehearing.

#### Response to Issue 23

This comment has been adopted. The third-party requester, by virtue of the statute, has no opportunity to appeal the decision of the Board of Patent Appeals and Interferences to the U.S. Court of Appeals for the Federal Circuit. In addition, § 1.979(d), as presently proposed, permits the party requesting rehearing (in addition to stating "the points believed to have been misapprehended or overlooked in rendering the decision") to also state "all other grounds upon which rehearing is sought." It is only fair to give the third-party requester an opportunity to comment on newly provided "other grounds upon which rehearing is sought." The patent owner should likewise be given the same opportunity to comment in order to create a level "playing field" in the Office. Accordingly, currently proposed § 1.979(b) has been drafted to give both the patent owner and the third-party requester a right to comment on each other's request for rehearing of the decision of the Board of Patent Appeals and Interferences.

#### Issue 24

One comment suggested that § 1.985 of the August 11, 1995, Notice of Proposed Rulemaking, which permits any person to advise the Office about a concurrent proceeding involving the patent being reexamined, should be changed to require the patent owner to advise the Office (and therefore any third-party requester) of any concurrent proceeding involving the patent being reexamined. The comment also stated that similar mandatory requirements are contained in § 1.660 relating to the conduct of an interference proceeding involving an application or a patent.

## Response to Issue 24

The suggestion has been adopted. Currently proposed § 1.985(a) (Notification of prior or concurrent proceedings) is drafted to direct that in any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissue, reexaminations, or litigation and the results of such proceeding.

## Issue 25

Regarding § 1.989 of the August 11, 1995, Notice of Proposed Rulemaking, one comment stated that the merger of multiple reexamination proceedings on unrelated issues by unrelated parties will result in undue complications of the proceedings, particularly during interviews and hearings.

## Response to Issue 25

As pointed out above in the response to Comment 18, the Office has reconsidered its initial position (taken in the August 11, 1995, Notice of Proposed Rulemaking) and will not permit any interview which addresses the merits in an *inter partes* reexamination proceeding. Thus, the comment is moot as to complications caused by an *inter partes* interview. Although multiple parties can, to some degree, increase the complexity of the proceeding even in areas other than the interviews focused upon by the commenter, the general policy of the Office is that concurrent reexamination proceedings will not be conducted separately at the same time on the same patent. The reasons for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally the proceedings will be merged whenever it is desirable to do so in the interest of expediting the prosecution of all proceedings.

## Issue 26

One comment responding to the August 11, 1995, Notice of Proposed Rulemaking suggested that it would be beneficial for the rules to provide specific procedures for consolidating multiple reexamination requests of the same patent, since the procedure is too complicated for the public to simply rely upon internal Office policy.

## Response to Issue 26

Section 1.989, as proposed in the present rule package, provides for the merging of multiple reexaminations. As to the details of the merger procedure,

it is believed to be more appropriate to incorporate same in the MPEP, because it is less cumbersome and easier to revise the details via the MPEP as needed to react to input as the practice evolves, than it would be to revise the rules. Further, where it becomes known that an area of the merger procedure is not being understood by the public, it will be easier to add more explanation to the MPEP, than to make the rules more comprehensive. Accordingly, the MPEP will contain the detailed discussion of the merger procedure.

## Issue 27

One comment stated that as to § 1.991 of the August 11, 1995, Notice of Proposed Rulemaking, a merged reissue/reexamination proceeding will be conducted according to provisions applicable to the reissue application except that the participation by a third-party requester shall be limited to issues within the scope of reexamination. Since a third-party requester has a right to inspect a reissue application and file a protest involving any issue considered in a reissue application, consideration should be given to permitting participation by a third-party requester in the full scope of issues addressed under the reissue statute. It was urged that the right of appeal and participation in the appeal process by the third-party requester should be limited to the scope permitted under the reexamination statute. The comment further questioned how the third-party requester will be notified of its right to appeal within the scope of the reexamination proceeding, since typically there would be no separate action closing prosecution and right to appeal in a reissue proceeding.

## Response to Issue 27

When an *inter partes* reexamination proceeding is merged with a reissue application, the participation by the third-party requester shall be limited to issues within the scope of the *inter partes* reexamination. This is consistent with the recommendations of *The Advisory Commission on Patent Law Reform: A Report to the Secretary of Commerce, August 1992* at page 117, "that a full *inter partes* proceeding, even with certain restrictions, would lead to abuses of the process much as occurred in the reissue protests under the Dann amendments \* \* \* [and] the USPTO is not an appropriate forum for an *inter partes* adversarial proceeding addressing all potential issues of validity." [Emphasis added]

As to how the third-party requester will be notified (in the merged proceeding) of its right to appeal within

the scope of the reexamination proceeding, since there is no provision in the reissue rules for a separate action closing prosecution and right to appeal, currently proposed § 1.995 provides that when a third-party requester is involved in one or more proceedings including an *inter partes* reexamination proceeding, the merger of such proceedings will be accomplished so as to preserve a third-party requester's right to participate to the extent specifically provided for in these regulations. Due to the complexity of the merged reissue/reexamination proceedings and the varying issues presented as a result of the merger, the decision merging the reissue and reexamination proceedings will set forth the framework for various courses of action by the parties, including appeal notification and rights.

## Issue 28

One comment asked what relationship will there be between the § 1.993 request to stay an interference (of the August 11, 1995, Notice of Proposed Rulemaking) and the § 1.644(a) petition in interference, since the § 1.993 "request to stay an interference" is really a form of a petition and should be covered or cross-referenced in § 1.644(a).

## Response to Issue 28

The request to stay an interference under § 1.993 as currently proposed, and under present § 1.565(e) is not an exact fit under any of subsections (1)-(3) of § 1.644(a); thus, it provides an additional aspect of relief to the public. While subsection (2) of § 1.644(a) might appear to overlap the § 1.565(e) and § 1.993 request to stay an interference, § 1.644(b) states that "[a] petition under paragraph (a)(2) of this section shall not be filed prior to the party's brief for final hearing (see § 1.656)." Just as petitions under § 1.644 are decided by the Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences, a request to stay an interference under § 1.565(e) and § 1.993 will likewise be decided by the Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences. The decision of *Shaked v. Taniguchi*, 21 USPQ2d 1289 (Comm'r Pat. 1991) should be noted, where it was pointed out that neither the reexamination nor the interference will ordinarily be stayed in this situation.

**Discussion of the Major Specific Issues Involved (1999 Statute)**

The proposed rules relating to *inter partes* reexamination proceedings are directed to the provisions set forth in Chapter 31 of Title 35 of the United

States Code (35 U.S.C. 311–318). This Chapter provides for the filing of requests for *inter partes* reexamination, decisions on such requests, *inter partes* reexamination, appeal from *inter partes* reexamination decisions, and the issuance of a certificate at the termination of the *inter partes* reexamination proceedings.

#### Discussion of Specific Rules

Section 1.4 is proposed to be amended so that paragraph (a)(2) includes the *inter partes* reexamination under §§ 1.902–1.997.

Section 1.6 is proposed to be amended so that paragraph (d)(5) includes filing a request for *inter partes* reexamination under § 1.913 as an exception to the use of facsimile transmission.

Section 1.17 is proposed to be amended so that the title includes a reference to reexamination to clearly indicate that the enumerated fees may apply to reexaminations as well as to patent applications. Section 1.17 is proposed to be amended so that paragraph (l) reflects the fact that in the case of reexaminations, petitions for revival of a reexamination proceeding terminated for an unavoidable failure of the patent owner to respond will require the fees of \$55 for a small entity and \$110 for a large entity. Also, § 1.17 is proposed to be amended so that paragraph (m) reflects the fact that in the case of reexaminations, petitions for revival of a reexamination proceeding terminated for an unintentional failure to respond will require the fees of \$605 for a small entity and \$1,210 for a large entity. Note, however, that the unintentional revival provisions of the statute are not effective in any reexamination until November 29, 2000.

Section 1.20 is proposed to be amended so that paragraph (c) reflects the fact that a request for an *ex parte* reexamination under § 1.510(a) will require a filing fee of \$2,520; and that a request for an *inter partes* reexamination under § 1.915(a) will require a filing fee of \$8,800.

Section 1.25, which provides for charging fees to deposit accounts, is proposed to be amended so that paragraph (b) includes a reference to *inter partes* reexaminations under § 1.913.

Section 1.26 is proposed to be amended so as to reflect the refund to the reexamination requester where the Director decides not to institute a reexamination proceeding. For *ex parte* reexaminations filed under § 1.510, a refund of \$1,690 will be made to the reexamination requester. For *inter partes* reexaminations filed under

§ 1.913, a refund of \$7,970 will be made to the reexamination requester. In both cases \$830 of the filing fee will be retained, which amount reflects the cost of the reexamination proceeding through the denial of the reexamination request.

Section 1.112 is proposed to be amended so that the last sentence reflects the fact that in the case of *inter partes* reexaminations, the right to reply may be limited by an action closing prosecution under § 1.949 (prior to the final action) or by a right of appeal notice under § 1.953 (which is a final action).

Section 1.113, which provides for a final rejection or action, is proposed to be amended to limit its applicability to applications and *ex parte* reexaminations filed under § 1.510. For final rejections or actions in an *inter partes* reexamination filed under § 1.913, new § 1.953 will control.

Section 1.116 is proposed to be amended so that the title includes a reference to an action closing prosecution and a right of appeal notice in *inter partes* reexaminations. Paragraph (a), which provides for amendments after final action, is proposed to be amended to apply to amendments after an action closing prosecution by patent owners in *inter partes* reexaminations filed under § 1.913. Also § 1.116(a) is proposed to be amended to preclude amendments after the right of appeal notice under § 1.953 except as provided for in § 1.116(c). Paragraph (c), which provides for amendments after the decision on appeal, is proposed to be amended to provide for amendments after the decision on appeal in an *inter partes* reexamination.

Section 1.121(c), which provides for the manner of making amendments to the description and claims in reexamination proceedings, is proposed to be amended to specify that such amendments are made in accordance with § 1.530(d) in both *ex parte* reexaminations filed under § 1.510 and *inter partes* reexaminations filed under § 1.913.

Parts (a)(2) and (b) of § 1.136, which provide for filing of timely replies with petitions for extensions of time, are proposed to be amended to make it clear that § 1.956 is controlling for extensions of time in *inter partes* reexaminations.

Section 1.137, which provides for revival of abandoned applications or lapsed patents, is proposed to be amended to provide for revival of *ex parte* reexamination proceedings terminated under § 1.550(d), for revival of *inter partes* reexamination proceedings terminated under

§ 1.957(b), or for revival of rejected claims terminated under § 1.957(c) in an *inter partes* reexamination proceeding where further prosecution has been limited to claims found allowable at the time of the failure to respond. The title is being amended to include a terminated reexamination proceeding. Paragraph (a) is being amended to include revival of unavoidably terminated reexamination proceedings. The unavoidable delay provisions of 35 U.S.C. 133 are imported into and are applicable to reexamination proceedings by 35 U.S.C. 305 and 314. See *In re Katrapat*, 6 USPQ2d 1863 (Comm'r Pats. 1988). Paragraph (b) is being amended to provide for revival of unintentionally terminated reexamination proceedings. The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into and are applicable to all reexamination proceedings by section 4605 of S. 1948. Note that these changes pertain to *all* reexaminations (i.e., both *ex parte* reexaminations filed under § 1.510 and *inter partes* reexaminations filed under § 1.913) and become effective on November 29, 2000 (one year after enactment of statute). Paragraph (d) is being amended to provide that extensions of time for requesting reconsideration of a decision dismissing or denying a petition requesting revival of a terminated reexamination proceeding under subsections (a) or (b) must be filed under § 1.550(c) for a terminated *ex parte* reexamination proceeding, or under § 1.956 for a terminated *inter partes* reexamination proceeding.

Section 1.181, is proposed to be amended so that paragraphs (a) and (c) reflect the fact that such a petition may be filed in a reexamination proceeding.

Section 1.191, which provides for appeal to the Board of Patent Appeals and Interferences by the patent owner from any decision adverse to patentability, is proposed to be amended so as to be applicable to applications and *ex parte* reexaminations filed under § 1.510, but not to *inter partes* reexamination proceedings filed under § 1.913. Specifically, proposed § 1.191 would point out that appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under § 1.913 are controlled by §§ 1.959 through 1.981, and that §§ 1.191 through 1.198 are not applicable to appeals in *inter partes* reexamination proceedings filed under § 1.913.

Section 1.191 is further proposed to be amended to distinguish between *ex parte* reexamination proceedings filed under § 1.510 for patents that issued

from an original application filed in the United States prior to November 29, 1999 (where an appeal is permitted when claims have been twice or finally rejected), and *ex parte* reexamination proceedings filed for patents that issued from an original application filed in the United States on or after November 29, 1999 (where an appeal is only possible when claims have been finally rejected). This date distinction is necessitated by the conforming amendments to 35 U.S.C. 134 in S. 1948 and the effective date of the changes to the statute which are keyed to the original filing date of the application which issued as the patent under reexamination. The effective date language in section 4608 of S. 1948 limits the applicability of the new *inter partes* reexamination Chapter 31, and the conforming amendments to 35 U.S.C. 134, 141, 143 and 145, to a reexamination of any patent that issues from an original application which is filed in the United States on or after November 29, 1999. Thus, for *ex parte* reexaminations filed under Chapter 30, the conforming amendments to 35 U.S.C. 134, 141, 143 and 145 only apply to those *ex parte* reexamination proceedings filed under § 1.510 for patents that issue from an original application which is filed in the United States on or after November 29, 1999. The conforming amendments will not apply to *ex parte* reexamination proceedings filed under § 1.510 for patents that have issued or will issue from an original application which was filed in the United States prior to November 29, 1999.

Section 1.301, which provides for appeal by the patent owner in a reexamination proceeding to the U.S. Court of Appeals for the Federal Circuit, is proposed to be amended so as to be applicable to *ex parte* reexamination proceedings filed under § 1.510 and to indicate, for *inter partes* reexamination proceedings filed under § 1.913, that § 1.983 is controlling.

Parts (a) and (b) of section 1.303, which provide for remedy by civil action under 35 U.S.C. 145 for the patent owner in a reexamination proceeding, are proposed to be amended so as to be applicable in reexamination only to *ex parte* reexaminations filed under § 1.510 for patents that issue from an original application which is filed in the United States prior to November 29, 1999. This date distinction is necessitated by the conforming amendments to 35 U.S.C. 141 and the effective date of the statute which is keyed to the original filing date of the application which issues as the patent under reexamination. See sections 4605 and 4608 of S. 1948. The effective date

language limits the applicability of the new *inter partes* reexamination Chapter 31, and the conforming amendments to 35 U.S.C. 141, to any patent that issues from an original application which is filed in the United States on or after November 29, 1999. Thus, for *ex parte* reexaminations filed under Chapter 30, the conforming amendments to 35 U.S.C. 141, which limit the patent owner to an appeal only to the U.S. Court of Appeals for the Federal Circuit, only apply to those *ex parte* reexamination proceedings filed under § 1.510 for patents that issue from an original application which is filed in the United States on or after November 29, 1999. The conforming amendments in section 4605 of S. 1948 will not apply to *ex parte* reexamination proceedings filed under § 1.510 for patents that issue from an original application which is filed in the United States prior to November 29, 1999. It is further proposed to amend § 1.303 by adding a new subsection (d) to clearly note that no remedy by civil action under 35 U.S.C. 145 is available to the patent owner for *ex parte* reexamination proceedings filed under § 1.510 for patents that issue from an original application which is filed in the United States on or after November 29, 1999, and for any *inter partes* reexamination proceedings filed under § 1.913.

Section 1.304, which provides for the time for appeal by the patent owner in a reexamination proceeding to the U.S. Court of Appeals for the Federal Circuit, is proposed to be amended so as to be applicable to *inter partes* reexamination proceedings filed under § 1.913.

The section heading (title) to Subpart D is proposed to be amended by inserting "Ex Parte" before Reexamination to provide that the reexamination rules in this part generally apply to *ex parte* reexamination proceedings. Since some of the rules also apply to *inter partes* reexamination, they are specifically incorporated into the *inter partes* reexamination rules, e.g., § 1.933 (patent owner duty of disclosure) incorporates § 1.555; and § 1.943 (manner of making amendments) incorporates § 1.530(d)(5). Unless specifically stated otherwise, in this subpart the term "reply" shall also mean "response."

The titles of §§ 1.501–1.570 and the undesignated center headings for Subpart D are proposed to be amended by revising them to be limited to *ex parte* reexamination except as specifically stated otherwise (e.g., §§ 1.530, 1.555 and 1.565).

Proposed section 1.501, which provides for citations of prior art in patent files, sets forth the procedure that

citations shall be entered in the patent file unless a reexamination proceeding is pending and reexamination has been ordered. In this situation, only citations by the patent owner under § 1.555 and by a third-party requester under either § 1.510 or § 1.535 will be entered during the pendency of the reexamination proceeding. Citations by other parties filed during the pendency of the reexamination proceeding will not be entered into the patent file or the reexamination file until the reexamination proceeding is concluded. The section is further amended to indicate that processing of prior art citations in patent files during an *inter partes* reexamination proceeding filed under § 1.913 is controlled by § 1.902.

Section 1.510, which relates to the contents of the reexamination request, is proposed to be amended to limit the section to *ex parte* reexamination proceedings. In addition, § 1.510(b)(4) is proposed to be amended to delete the requirement of mounting the copy of the patent to be reexamined in single column format. Instead, a copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent will be required. All copies must have each page plainly written on only one side of a sheet of paper.

It is proposed to amend §§ 1.515, 1.520, 1.525, 1.530, 1.535, and 1.540 to recite the reexamination as "*ex parte*" reexamination where appropriate, to eliminate any potential for confusion. Further, § 1.530(d) is proposed to be revised so that it applies to both *ex parte* reexamination and *inter partes* reexamination proceedings.

Section 1.550, which provides for the conduct of the reexamination proceeding, is proposed to be amended to limit the section to *ex parte* reexamination proceedings filed under § 1.510. In addition, § 1.550(d) is proposed to be amended to clarify that the failure to file a written statement of an interview required under § 1.560(b) shall be the basis for terminating a reexamination proceeding. Proposed § 1.550(e)(1) specifically provides for the revival of terminated *ex parte* reexamination proceedings under the unavoidable delay provisions of § 1.137(a). The unavoidable delay provisions of 35 U.S.C. 133 are imported into and are applicable to *ex parte* reexamination proceedings by 35 U.S.C. 305. Proposed § 1.550(e)(2) provides for the revival of terminated *ex parte* reexamination proceedings under the

unintentional provisions of § 1.137(b). The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into and are applicable to *ex parte* and *inter partes* reexamination proceedings by section 4605 of S. 1948. Note, however, the unintentional delay fee provisions of 35 U.S.C. 41(a)(7) only become effective in reexamination proceedings on November 29, 2000 (one year after enactment of statute).

Section 1.560, which provides for interviews in reexamination proceedings, is proposed to be amended to limit the section to *ex parte* reexamination proceedings filed under § 1.510. Note, however, that there will be no interviews which address the issues of the proceeding permitted in *inter partes* reexamination proceedings under § 1.913. See § 1.955.

In addition, § 1.560(b) is proposed to be amended to clarify that the patent owner must file a written statement of an interview after an interview is held. The written statement may be filed either as a separate paper or as a separate part of a response to an outstanding Office action, whichever is later.

Section 1.565, which provides for concurrent Office proceedings, is proposed to be amended to limit the section to *ex parte* reexamination proceedings filed under § 1.510. In addition, § 1.565(e) is proposed to be amended to change "examiner-in-chief" to "administrative patent judge" to reflect their current title. Also, the appropriate references for concurrent *ex parte* and *inter partes* reexamination situations have been added. Section 1.565(c) is proposed to be amended to make it clear that after prosecution has been terminated in a pending reexamination proceeding (e.g., by the issuance of a Notice of Intent to Issue a Reexamination Certificate) there is no right of merger of any subsequently filed reexamination request.

It is proposed to amend § 1.570 to recite the reexamination as "*ex parte*" reexamination where appropriate, to eliminate any potential for confusion.

In the current rules, or portions of the rules, that are amended in this package, "Commissioner," has been revised to read "Director" in accordance with section 4732 of S. 1948. As to the rules, or portion of the rules, not being revised in this package, it is anticipated that the technical correction of "Commissioner" to "Director" will be effected in a future rule package directed to technical corrections that will be issued in due course.

The proposed title to Subpart H provides that the reexamination rules in this part generally apply to *inter partes*

reexamination proceedings. Some of the *inter partes* reexamination rules specifically incorporate *ex parte* reexamination rules, e.g., § 1.943 (manner of making amendments) incorporates § 1.530(d)(5), and § 1.933 (patent owner duty of disclosure) incorporates § 1.555. Unless specifically stated otherwise, in this subpart the term "reply" shall also mean "response."

Proposed § 1.902 provides for the processing of prior art citations during an *inter partes* reexamination proceeding and is consistent with the provisions of § 1.501 which deals with prior art citations in patent files and in *ex parte* reexamination proceedings.

Proposed § 1.903 provides that the patent owner and the third-party requester shall be sent copies of all Office actions, and that the patent owner and the third-party requester must serve copies of all papers on all other parties in the *inter partes* reexamination proceeding or they may be refused consideration by the Office. This is analogous to the provisions of § 1.550(e).

Proposed § 1.904 provides that the notices of filing of *inter partes* reexamination requests will be published in the *Official Gazette* under § 1.11(c) and that such a notice will be considered to be constructive notice to the patent owner.

Proposed § 1.905 provides that, unless otherwise provided for, submission of papers by the public other than third-party requesters in an *inter partes* reexamination proceeding will not be considered in the proceeding and will be treated in accordance with the requirements of a prior art submission under § 1.902. Submissions not in accordance with § 1.902 will be returned to the sender.

Proposed § 1.906 covers the scope of reexamination in an *inter partes* reexamination proceeding. While it is not intended that the examiners will routinely complete a new search when conducting an *inter partes* reexamination, the examiners may conduct additional searches and cite and apply additional prior patents and printed publications when they consider it appropriate and beneficial to do so. Paragraph (a) provides that the examination is only on the basis of patents or printed publications and on the basis of the requirements of 35 U.S.C. 112 with respect to subject matter added or deleted during the *inter partes* reexamination. Paragraph (b) provides that claims in a reexamination proceeding must not enlarge the scope of the claims of the patent and must not introduce new matter. Paragraph (c)

provides that issues relating to matters other than those indicated in paragraphs (a) and (b) of this section (e.g., on sale, public use, duty of disclosure, etc.) will not be resolved in a reexamination proceeding, but will be noted by the examiner as being an open issue in the record. The examiner should only raise an issue under § 1.906(c) with caution after careful consideration, and should only raise the issue once. Patent owners could then file a reissue application if they wish such issues to be resolved.

Proposed § 1.907 sets forth prohibitions on the filing of an *inter partes* reexamination request. The basis for this section is 35 U.S.C. 317. Under § 1.907(a), once an order for *inter partes* reexamination has been issued, neither the third-party requester, nor any of its privies, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director. Under subsection (b) once a final decision has been entered against a party in a civil action that the party has not sustained its burden of proving invalidity of any patent claim in suit, then that party, and its privies, are thereafter precluded from requesting an *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office. Under subsection (c) if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to patentability of any patent claim, then that party, or its privies, may not thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

Proposed § 1.913 provides for any third-party requester (except if the estoppel provisions of § 1.907 apply) to file a request under 35 U.S.C. 311 for an *inter partes* reexamination of a patent which issued from an original application filed in the United States on or after November 29, 1999. The time period for filing such a request is limited to the period of enforceability of the patent for which the request is filed.

Proposed § 1.915(a) requires payment of the fee for requesting an *inter partes* reexamination which is set forth in § 1.20(c)(2). Paragraph (b) of § 1.915 indicates what each request for *inter partes* reexamination must include. The requirements are analogous to the

requirements of § 1.510(b) for filing an *ex parte* reexamination request with the most notable difference being that the third-party requester must be identified in an *inter partes* reexamination request. Paragraph (c) indicates that requests for an *inter partes* reexamination may be filed by attorneys or agents on behalf of a third-party requester, but it is noted that the real party in interest must be identified. Paragraph (d) provides that if the request for *inter partes* reexamination does not meet all the requirements of paragraph (b), the third-party requester may be given an opportunity to complete the *inter partes* reexamination request to avoid having the proceeding vacated.

Proposed § 1.919 indicates that the date on which the entire fee for a request for *inter partes* reexamination is received will be considered to be the filing date of the request for *inter partes* reexamination.

Proposed § 1.923 provides for a determination by the examiner as to whether the request has presented a substantial new question of patentability under 35 U.S.C. 312 and requires that the determination be made within 3 months of the filing date of the request.

Proposed § 1.925 provides for a refund under § 1.26(c) of a portion of the filing fee if *inter partes* reexamination is not ordered. See the discussion of § 1.26(c) above as to the amount of the refund.

Proposed § 1.927 provides for review by petition to the Director of a decision refusing *inter partes* reexamination.

Proposed § 1.931 provides for ordering *inter partes* reexamination where a substantial new question of patentability has been found pursuant to § 1.923. Under paragraph (b), the only limitation placed on the selection of the examiner by the Office is that the same examiner whose decision refusing *inter partes* reexamination was reversed on petition filed under § 1.927 ordinarily will not conduct the *inter partes* reexamination ordered in the decision granting the petition.

Proposed § 1.933 covers the duty of disclosure by a patent owner in an *inter partes* reexamination proceeding. The rule provides that the duty in an *inter partes* reexamination proceeding is the same as the patent owner's duty in an *ex parte* reexamination proceeding as set forth in § 1.555 (a) and (b), and is satisfied by filing a paper in compliance with § 1.555 (a) and (b).

Proposed § 1.935 indicates that the initial Office action on the merits usually accompanies the *inter partes* reexamination order as expressly provided for as an option in 35 U.S.C.

313. It is contemplated that the initial paper from the examiner will comprise two parts. The first part will address the issue as to whether the prior art raises a substantial new question of patentability (SNQ). If the examiner determines that the prior art does not raise an SNQ, reexamination is denied. No patentability question would be addressed by the examiner. If the examiner determines that the prior art does raise an SNQ, reexamination will be ordered. In this situation, a second part of the initial Office action will usually be issued which would address the patentability issues and will constitute the first Office action on the merits.

Proposed § 1.937 would cover the basic items relating to the conduct of *inter partes* reexamination proceedings. Paragraph (a) provides that, in accordance with 35 U.S.C. 314(c), unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings will be conducted with special dispatch.

Paragraph (b) provides that all *inter partes* reexamination proceedings will be conducted according to the procedures established for initial examination under §§ 1.104–1.116. These proceedings will basically follow the procedures for examining patent applications. Paragraph (c) provides that all communications between the Office and the parties to the *inter partes* reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

Proposed § 1.939 provides for the return of unauthorized papers filed by any party in an *inter partes* reexamination, and that unless otherwise authorized, no paper shall be filed in an *inter partes* reexamination before the initial Office action on the merits.

Proposed § 1.941 provides that amendments made by the patent owner in an *inter partes* reexamination must be made in accordance with the requirements of §§ 1.530(d) and 1.943.

Proposed § 1.943, paragraph (a) provides that the form of responses, briefs, appendices, and other papers must be in accordance with § 1.530(d)(5). Paragraph (b) provides for page limits for responses by the patent owner and written comments by the third-party requester (other than briefs). Amendments, appendices of claims, and reference materials such as prior art references would not be included in this total. Paragraph (c) provides for page limits or total word limits for briefs.

Proposed § 1.945 provides that a patent owner will be given at least thirty

days to respond to any Office action on the merits. Although problems may arise in certain cases and extensions of time may be granted under § 1.956, it is felt that relatively short response times are necessary in order to process reexaminations with "special dispatch." While the Office intends to set a two-month period for patent owner to respond to an Office action on the merits in usual situations, the minimum period will always be at least 30 days.

Proposed § 1.947 provides that each time a patent owner files a response to any Office action on the merits, the third-party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. Since 35 U.S.C. 314(b)(3) statutorily imposes this period for third-party requester comments, this time may not be extended. Thus, any third-party comments, including any supplemental comments, filed after expiration of 30 days from the date of service of the patent owner's response shall be considered to be untimely filed and unauthorized, and shall be returned to the third-party in accordance with § 1.939.

Proposed § 1.948 provides that additional third-party requester prior art submissions as defined under § 1.501 may be filed after the *inter partes* reexamination order only if they are submitted as part of a comments submission under § 1.947 (written comments to a patent owner response to an Office action on the merits) and limited to: (1) Any prior art which is necessary to rebut a finding of fact by the examiner; (2) any prior art which is necessary to rebut a response of the patent owner; or (3) any prior art which became known or available to the third-party requester after the filing of the *inter partes* request for reexamination where a discussion of the pertinency of each reference to the patentability of at least one claim is included. The purpose of this rule is twofold. First, the third-party requester may cite any prior art needed to rebut a position taken by the examiner or the patent owner. Second, the third-party requester may submit prior art newly discovered or newly available since the filing of the *inter partes* reexamination request provided a discussion of the pertinency of each reference to the patentability of at least one claim is included. The only limitation is that the prior art may only be submitted along with written comments filed by the third-party requester under § 1.947 in response to a patent owner response to an Office action on the merits. Limiting prior art submissions to newly discovered or



newly available prior art (except when used for rebuttal purposes) will encourage the third-party requester to submit all known pertinent prior art along with the initial request for *inter partes* reexamination. Later submission of previously known or available prior art would only be permissible to rebut a position taken by the examiner or the patent owner, or through the filing of an *ex parte* reexamination request (which, if ordered, would be merged with the *inter partes* reexamination proceeding). Permitting the third-party requester to timely submit newly discovered or previously unavailable prior art, however, will obviate the need for the third-party requester to have to file an *ex parte* request for reexamination. To prevent harassment of the patent owner due to frequent submissions of prior art citations during a reexamination proceeding, such submissions may only be filed along with written comments filed by the third-party requester in response to a patent owner response to an Office action on the merits or after an action closing prosecution.

Proposed § 1.949 provides for the close of prosecution on the second or subsequent Office action, as opposed to a final rejection or a final action which would be issued in an *ex parte* reexamination proceeding. The distinction between a final action (including a final rejection) and an action closing prosecution is important as appeal rights to the Board of Patent Appeals and Interferences under 35 U.S.C. 134 (b) and (c) mature only with a final action (as opposed to "twice rejected" in an application under 35 U.S.C. 134(a)). The statute permits the patent owner to appeal finally rejected claims, and the third-party requester to appeal final decisions favorable to patentability to the Board of Patent Appeals and Interferences. The rules were drafted to provide for both the patent owner and the third-party requester to submit comments on the examiner's patentability findings prior to making such findings final. The action closing prosecution (in lieu of a final action) is needed to preclude one party from filing a notice of appeal while another party is filing comments seeking reconsideration of an examiner's decision. It is only after the examiner has considered all the comments submitted by all the parties that a final rejection and final decision favorable to patentability will be issued by way of the Right of Appeal Notice under § 1.953. At that time, both the patent owner and the third-party requester may appeal to the Board of Patent Appeals and Interferences.

Proposed § 1.951 provides the options available to the parties after an Office action closing prosecution. Both the patent owner and the third-party requester may once file a response limited to issues raised in the action closing prosecution. The patent owner may also submit proposed amendments (subject to the criteria of § 1.116 as to whether or not the amendments shall be admitted). If one party files a response, the other party may once file written comments on the other's response. The time periods within which the patent owner and the third-party requester may act (as provided for by this section) may run concurrently. In this manner all parties are provided an equal opportunity to contest the examiner's patentability findings before the findings are made final and ripe for appeal.

Proposed § 1.953(a) provides that, following the responses or expiration of the time for response in § 1.951, the examiner may issue a right of appeal notice which shall include a final rejection and/or final decision favorable to patentability in accordance with 35 U.S.C. 134. The intent of limiting the appeal rights until after the examiner issues a "Right of Appeal Notice" is to specifically preclude the possibility of one party attempting to appeal prematurely while prosecution before the examiner is being continued by the other party.

Proposed § 1.953(b) provides that any time after the initial Office action on the merits in an *inter partes* reexamination, the patent owner and all third-party requesters may stipulate that the issues are appropriate for a final action, which would include a final rejection and/or a final determination favorable to patentability, and may request the issuance of a Right of Appeal Notice. If the examiner determines that no other issues are present or should be raised, a Right of Appeal Notice limited to the identified issues shall be issued. The request for an expedited notice will enable the parties to accelerate the *inter partes* reexamination proceeding. Proposed § 1.953(c) provides that the Right of Appeal Notice shall be a final action, which would include a final rejection and/or final decision favorable to patentability, and that no amendment under § 1.116 can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no appeal is filed, the reexamination proceeding will be terminated, and the Director will proceed to issue a certificate under § 1.997 in accordance with the Right of Appeal Notice.

Proposed § 1.955 provides that interviews between the examiner and the patent owner and/or the third-party requester which discuss the merits of the proceeding will not be permitted in *inter partes* reexamination proceedings. Thus, no separate *ex parte* interviews will be permitted, and no *inter partes* interviews will be permitted. All communications between the Office and the patent owner which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding. An informal amendment will not be accepted, as that would amount to an informal *ex parte* interview. The Office has reconsidered its initial position taken in the August 11, 1995, Notice of Proposed Rulemaking which proposed to permit owner-initiated interviews in which the patent owner and the third-party requester participate. Thus, in the present rule package, no interviews will be held, nor be permitted, in *inter partes* reexamination cases which discuss the merits of the proceeding. In other words, neither the patent owner nor the third-party requester will be able to initiate, nor participate in, an *ex parte* nor an *inter partes* interview which discusses the merits of the proceeding in an *inter partes* reexamination proceeding. The rationale for this is discussed above in Issue 18 of the consideration of the comments responsive to the August 11, 1995, Notice of Proposed Rulemaking.

Proposed § 1.956 relates to patent owner extensions of time for responding to a requirement of the Office in *inter partes* reexamination proceedings. As in *ex parte* reexamination practice, a patent owner may only obtain an extension of time for sufficient cause, and the request for such extension must be filed on or before the end of the period for response. Note that the time for the third-party requester to file comments to patent owner responses may not be extended, as set forth in § 1.947.

Proposed § 1.957(a) provides that a third-party requester's submission in *inter partes* reexamination may be refused consideration if it is untimely or is inappropriate. Proposed § 1.957(b) and (c) relate to the patent owner's failure to timely or appropriately respond in *inter partes* reexamination proceedings. In this event, if no claims are found patentable, the proceeding shall be terminated and a reexamination certificate shall be issued. If claims are found patentable, further prosecution shall be limited to the patentable claims, and any additional claims that do not expand the scope of the patentable claims. Proposed § 1.957(d) provides

that when the action by the patent owner is a bona fide attempt to respond and to advance the case, and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

Proposed § 1.958(a) provides for the revival of terminated *inter partes* reexamination proceedings under the unavoidable delay provisions of § 1.137(a). The unavoidable delay provisions of 35 U.S.C. 133 are imported into and are applicable to *inter partes* reexamination proceedings under 35 U.S.C. 314. Proposed § 1.958(b) provides for the revival of terminated *inter partes* reexamination proceedings under the unintentional provisions of § 1.137(b). The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into and are applicable to *inter partes* reexamination proceedings under section 4605 of S. 1948. Note, however, the unintentional delay fee provisions of 35 U.S.C. 41(a)(7) only become effective in reexamination proceedings on November 29, 2000 (one year after enactment of statute).

Proposed § 1.959 relates to appeals and cross appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings. Both patent owners and third-party requesters are given appeal rights in accordance with 35 U.S.C. 315.

Proposed § 1.961 relates to time of transfer of the jurisdiction of the appeal over to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings.

Proposed § 1.962 relates to the definition of appellant and respondent in *inter partes* reexamination proceedings.

Proposed § 1.963 relates to the time periods for filing briefs in *inter partes* reexamination proceedings.

Proposed § 1.965 relates to the requirements of the appellant brief in *inter partes* reexamination proceedings.

Proposed § 1.967 relates to the requirements of the respondent brief in *inter partes* reexamination proceedings.

Proposed § 1.969 relates to the examiner's answer. An examiner's answer may not include a new ground of rejection nor a new decision favorable to patentability. In either case (if there is to be a new ground of rejection or a new decision favorable to patentability), prosecution should be reopened.

Proposed § 1.971 gives any appellant one opportunity to file a rebuttal brief following the examiner's answer. The rebuttal brief filed by an appellant who is the patent owner is limited to the

issues raised in the examiner's answer and/or in any respondent brief. The rebuttal brief filed by an appellant who is a third-party requester is limited to the issues raised in the examiner's answer and/or in the patent owner's respondent brief. The rebuttal brief of a third-party requester may not be directed to the respondent brief of any other third-party requester. No new ground of rejection can be proposed by a third-party requester appellant.

Proposed § 1.973 relates to the oral hearing in *inter partes* reexamination proceedings.

Proposed § 1.975 relates to affidavits or declarations after appeal in *inter partes* reexamination proceedings.

Proposed § 1.977 relates to the decision by the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings. A reversal of an examiner's decision favorable to patentability (*i.e.*, a decision not to make a rejection proposed by the third-party requester) constitutes a decision adverse to patentability which will be set forth as a new ground of rejection under § 1.977(b).

Proposed § 1.979 relates to the procedure following the decision or dismissal by the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings.

Proposed § 1.981 relates to the procedure for the reopening of prosecution following the decision by the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings.

Proposed § 1.983 relates to the patent owner's right to appeal to the United States Court of Appeals for the Federal Circuit in *inter partes* reexamination proceedings. Under section 141, the patent owner in *inter partes* reexamination proceedings may appeal the decision of the Board of Patent Appeals and Interferences only to the United States Court of Appeals for the Federal Circuit. Under section 134(c), the third-party requester in *inter partes* reexamination proceedings may not appeal the decision of the Board of Patent Appeals and Interferences.

Proposed § 1.985 relates to notification of prior or concurrent proceedings in *inter partes* reexamination proceedings. Paragraph (a) requires the patent owner to notify the Office of any prior or concurrent proceeding involving the patent under *inter partes* reexamination. Paragraph (b) permits any member of the public to notify the Office of any prior or concurrent proceeding involving the patent under *inter partes* reexamination. Such notice, however, must be limited to merely providing notice without

discussion of the issues in the *inter partes* reexamination. Any notice that includes a discussion of the issues will be returned to the sender.

Proposed § 1.987 provides that when a patent involved in an *inter partes* reexamination is concurrently involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

Proposed § 1.989 relates to the merger of concurrent reexamination proceedings.

Proposed § 1.991 relates to the merger of a concurrent reissue application and an *inter partes* reexamination proceeding.

Proposed § 1.993 relates to the suspension of a concurrent interference or an *inter partes* reexamination proceeding.

Proposed § 1.995 relates to the third-party requester's participation rights being preserved in a merged proceeding.

Proposed § 1.997 provides for the issuance of the reexamination certificate under 35 U.S.C. 316 after conclusion of an *inter partes* reexamination proceeding. The certificate will cancel any patent claims determined to be unpatentable, confirm any patent claims determined to be patentable, and incorporate into the patent any amended or new claims determined to be patentable. Once all of the claims have been canceled from the patent, the patent ceases to be enforceable for any purpose. Accordingly, any pending reissue proceeding or other Office proceeding relating to a patent for which a certificate that cancelled all of the patent claims has been issued will be terminated. This provides a degree of assurance to the public that patents with all the claims canceled via *inter partes* reexamination proceedings will not again be asserted.

## Classification

### Regulatory Flexibility Act

The Chief Counsel for Regulation of the Department of Commerce certified to the Chief Counsel for Advocacy, Small Business Administration, that the changes proposed in this notice, if adopted, would not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). This rulemaking implements the provisions of Title IV, subtitle F (sections 4601 through 4608) of the "American Inventors Protection Act of 1999," which permits a third-party requester to participate more extensively during the reexamination proceeding as well as giving them appeal rights. The changes proposed in

this notice (if adopted) would provide procedures for a third-party to request optional *inter partes* reexamination of a patent. The new *inter partes* proceedings are similar to the *ex parte* proceedings, although they are more complicated procedurally to accommodate the presence of the third-party.

Taking into account the overall similarities and additional complexity, it is reasonable to assume that a similar proportion of small entities will request *inter partes* reexamination as have requested *ex parte* reexamination. Furthermore, it is anticipated that *inter partes* reexamination requests will be filed by third-party requesters, while patent owners will continue to file *ex parte* reexamination requests. Approximately 400 *ex parte* reexamination filings have been received each year since 1992, of which 55% or 220 have been filed by third-party requesters. Since the beginning of the reexamination procedure, about 22.5% of the *ex parte* reexamination requesters have been small entities. If all 220 of the third-party filed reexamination requests were filed as requests for *inter partes* reexaminations, approximately 50 requests (22.5%) would come from small entities. The higher cost of the *inter partes* reexamination fee (\$8,800) compared to the *ex parte* reexamination fee (\$2,520) reflects the greatly expanded participation available to the third-party requester. In the *inter partes* proceeding, the third party requester has the right to comment on every response by the patent owner to the PTO, to be a party to any appeal by the patent owner to the Board of Patent Appeals and Interferences, and to appeal any determination of patentability to the Board. In the *ex parte* proceeding, the third-party requester's role is limited to the request for reexamination and a single reply to the patent owner's response. The third party requester also has no appeal rights in an *ex parte* reexamination. Therefore, the number of small businesses affected by these proposed optional *inter parte* reexamination rules is not significant, and the impact on each business, considering the benefits of greater participation throughout the *inter partes* proceeding, is not significant.

#### Executive Order 13132

This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (August 4, 1999).

#### Executive Order 12866

This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (September 30, 1993).

#### Paperwork Reduction Act

This notice of proposed rulemaking involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collection of information involved in this notice of proposed rulemaking has been reviewed and previously approved by OMB under OMB control number 0651-0033.

As required by the Paperwork Reduction Act of 1995 (44 U.S.C. 3507(d)), the Patent and Trademark Office has submitted an information collection package to OMB for its review and approval of the proposed information collections under OMB control number 0651-0033. The Patent and Trademark Office is submitting this information collection to OMB for its review and approval because this notice of proposed rulemaking will add the request for optional *inter partes* reexamination of a patent to that collection.

The title, description and respondent description of the information collection is shown below with an estimate of the annual reporting burdens. Included in this estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impact of the changes in this notice of proposed rulemaking is to implement the changes to Office practice necessitated by Title IV, subtitle F (sections 4601 through 4608) of the "American Inventors Protection Act of 1999" (enacted into law by § 1000(a)(9), Division B, of Pub. L. 106-113).

*OMB Number:* 0651-0033.

*Title:* Post Allowance and Refiling.

*Form Numbers:* PTO/SB/13/14/44/50-57; PTOL-85b.

*Type of Review:* Approved through September of 2000.

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions and Federal Government.

*Estimated Number of Respondents:* 172,475.

*Estimated Time Per Response:* 0.3 hour.

*Estimated Total Annual Burden Hours:* 51,593.5 hours.

*Needs and Uses:* This collection of information is required to administer

the patent laws pursuant to title 35, U.S.C., concerning the issuance of patents and related actions including correcting errors in printed patents, refiling of patent applications, requesting reexamination of a patent, and requesting a reissue patent to correct an error in a patent. The affected public includes any individual or institution whose application for a patent has been allowed or who takes action as covered by the applicable rules.

*Comments are invited on:* (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Patent Examination Policy Law Office, Patent and Trademark Office, Washington, D.C. 20231, or to the Office of Information and Regulatory Affairs of OMB, New Executive Office Building, 725 17th St. NW, Room 10235, Washington, DC 20503, Attention: Desk Officer for the Patent and Trademark Office.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

#### List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.

For the reasons set out in the preamble and under the authority given to the Director of Patents and Trademarks by 35 U.S.C. 6, Part 1 of Title 37 CFR is amended as set forth below.

#### PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 would continue to read as follows:

**Authority:** 35 U.S.C. 6, unless otherwise noted.

2. Section 1.4(a)(2) is proposed to be revised to read as follows:

**§ 1.4 Nature of correspondence and signature requirements.**

(a) \* \* \*

(2) Correspondence in and relating to a particular application or other proceeding in the Office. See particularly the rules relating to the filing, processing, or other proceedings of national applications in Subpart B, §§ 1.31 to 1.378; of international applications in Subpart C, §§ 1.401 to 1.499; of ex parte reexaminations of patents in Subpart D, §§ 1.501 to 1.570; of interferences in Subpart E, §§ 1.601 to 1.690; of extension of patent term in Subpart F, §§ 1.710 to 1.785; of inter partes reexaminations of patents in Subpart H, §§ 1.902 to 1.997; and of trademark applications §§ 2.11 to 2.189.

\* \* \* \* \*

3. Section 1.6(d)(5) is proposed to be revised to read as follows:

**§ 1.6 Receipt of Correspondence.**

\* \* \* \* \*

(d) \* \* \*

(5) A request for reexamination under § 1.510 or § 1.913.

4. Sections 1.17(l) and (m) are proposed to be revised to read as follows:

**§ 1.17 Patent application and reexamination processing fees.**

\* \* \* \* \*

(l) For filing a petition for the revival of an unavoidably abandoned application under 35 U.S.C. 111, 133, 364, or 371, for the delayed payment of the issue fee under 35 U.S.C. 151, or for the revival of an unavoidably terminated reexamination proceeding under 35 U.S.C. 133 (§ 1.137(a)):

By a small entity (§ 1.9(f)) .....	\$55.00
By other than a small entity ...	110.00

(m) For filing a petition for revival of an unintentionally abandoned application, for the unintentionally delayed payment of the fee for issuing a patent, or for the revival of an unintentionally terminated reexamination proceeding under 35 U.S.C. 41(a)(7) (§ 1.137(b)):

By a small entity (§ 1.9(f)) .....	\$605.00
By other than a small entity ...	1,210.00

\* \* \* \* \*

5. Section 1.20(c) is proposed to be revised to read as follows:

**§ 1.20 Post-issuance and reexamination fees.**

\* \* \* \* \*

(c) In reexamination proceedings

(1) For filing a request for ex parte reexamination (§ 1.510(a)) .....	\$2,520.00
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(2) For filing a request for <i>inter partes</i> reexamination (§ 1.915(a)) .....	8,800.00
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\* \* \* \* \*

6. Section 1.25(b) is proposed to be revised to read as follows:

**§ 1.25 Deposit accounts.**

\* \* \* \* \*

(b) Filing, issue, appeal, international-type search report, international application processing, petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. A general authorization to charge all fees, or only certain fees, set forth in §§ 1.16 to 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular paper filed. An authorization to charge to a deposit account the fee for a request for reexamination pursuant to § 1.510 or § 1.913 and any other fees required in a reexamination proceeding of a patent may also be filed. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee.

7. Section 1.26(c) is proposed to be revised to read as follows:

**§ 1.26 Refunds.**

\* \* \* \* \*

(c) If the Director decides not to institute a reexamination proceeding, for *ex parte* reexaminations filed under § 1.510 a refund of \$1,690.00 will be made to the reexamination requester. For *inter partes* reexaminations filed under § 1.913, a refund of \$7,970 will be made to the reexamination requester. Reexamination requester should indicate the form in which any refund should be made (e.g., by check, electronic funds transfer, credit to a deposit account, etc.). Generally, reexamination refunds will be issued in the form that the original payment was provided.

8. Section 1.112 is proposed to be revised to read as follows:

**§ 1.112 Reconsideration before final action.**

After reply by applicant or patent owner (§ 1.111) to a non-final action, the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third-party requester, will be notified if claims are rejected, objections or requirements

made, or decisions favorable to patentability are made, in the same manner as after the first examination. Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111, with or without amendment, unless such Office action indicates that it is made final (§§ 1.113), or in an *inter partes* reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

9. Section 1.113(a) is proposed to be revised to read as follows:

**§ 1.113 Final rejection or action.**

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for *ex parte* reexaminations filed under § 1.510 patent owner's, reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form. For final actions in an *inter partes* reexamination filed under § 1.913, see § 1.953.

\* \* \* \* \*

10. Sections 1.116(a) and (c) are proposed to be revised to read as follows:

**§ 1.116 Amendments after final action, action closing prosecution, right of appeal notice, or appeal.**

(a) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution or any related proceedings, will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. No amendment can be

made in an *inter partes* reexamination proceeding after the right of appeal notice under § 1.953 except as provided for in paragraph (c) of this section.

\* \* \* \* \*

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under §§ 1.196 or 1.977.

11. Section 1.121(c) is proposed to be revised to read as follows:

**§ 1.121 Manner of making amendments.**

\* \* \* \* \*

(c) *Amendments in reexamination proceedings.* Any proposed amendment to the description and claims in patents involved in reexamination proceedings in both *ex parte* reexaminations filed under § 1.510 and *inter partes* reexaminations filed under § 1.913 must be made in accordance with § 1.530(d).

12. Section 1.136(a) (2) and (b) are proposed to be revised to read as follows:

**§ 1.136 Extensions of time.**

(a) \* \* \*

(2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.136(b) for extensions of time relating to proceedings pursuant to §§ 1.193(b), 1.194, 1.196 or 1.197; § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in *ex parte* reexamination proceedings, § 1.956 for extensions of time in *inter partes* reexamination proceedings; and § 1.645 for extensions of time in interference proceedings.

\* \* \* \* \*

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on

which such reply is due, but the mere filing of such a request will not effect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.645 for extensions of time in interference proceedings; § 1.550(c) for extensions of time in *ex parte* reexamination proceedings; and § 1.956 for extensions of time in *inter partes* reexamination proceedings.

13. Section 1.137 is proposed to be amended by revising its heading, the introductory text of paragraph (a), the introductory text of paragraph (b), and paragraph (d) to read as follows:

**§ 1.137 Revival of abandoned application, lapsed patent, or terminated reexamination proceeding.**

(a) *Unavoidable.* Where the delay in reply was unavoidable, a petition may be filed to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) and 1.957(b) and (c), or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

\* \* \* \* \*

(b) *Unintentional.* Where the delay in reply was unintentional, a petition may be filed to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) and 1.957(b) and (c), or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

\* \* \* \* \*

(d) Any request for reconsideration or review of a decision refusing to revive an abandoned application, a terminated reexamination proceeding, or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under the provisions of § 1.136 for an abandoned application or lapsed patent; under the provisions of § 1.550(c) for a terminated *ex parte* reexamination proceeding filed under § 1.510; and under the provisions of § 1.956 for a terminated *inter partes* reexamination proceeding filed under § 1.913.

\* \* \* \* \*

14. Sections 1.181(a) and (c) are proposed to be revised to read as follows:

**1.181 Petition to the Director.**

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances.

(4) For petitions in interferences, see § 1.644.

\* \* \* \* \*

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

\* \* \* \* \*

15. Section 1.191(a) is proposed to be revised to read as follows:

**§ 1.191 Appeal to Board of Patent Appeals and Interferences.**

(a) Every applicant for a patent or for reissue of a patent, and every owner of a patent under *ex parte* reexamination filed under § 1.510 for a patent that issued from an original application filed in the United States before November 29, 1999, any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply. Notwithstanding the above, for an *ex parte* reexamination proceeding filed under § 1.510 for a patent that issued from an original application filed in the United States on or after November 29, 1999, no appeal may be filed until the claims have been finally rejected (§ 1.113). Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under § 1.913 are controlled by §§ 1.959 through 1.981. Sections 1.191 through

1.198 are not applicable to appeals in *inter partes* reexamination proceedings filed under § 1.913.

16. Section 1.301 is proposed to be revised to read as follows:

**§ 1.301 Appeal to U.S. Court of Appeals for the Federal Circuit.**

Any applicant or any owner of a patent involved in any *ex parte* reexamination proceeding filed under § 1.510, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences, may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal: In the U.S. Patent and Trademark Office, file a written notice of appeal directed to the Director (see §§ 1.302 and 1.304); and in the Court, file a copy of the notice of appeal and pay the fee for appeal as provided by the rules of the Court. For *inter partes* reexamination proceedings filed under § 1.913, § 1.983 is controlling.

17. Section 1.303 is proposed to be amended by revising paragraphs (a) and (b) and by adding a new paragraph (d) to read as follows:

**§ 1.303 Civil action under 35 U.S.C. 145, 146, 306.**

(a) Any applicant or any owner of a patent involved in an *ex parte* reexamination proceeding filed under § 1.510 for a patent that issues from an original application filed in the United States before November 29, 1999, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in § 1.304.

(b) If an applicant in an *ex parte* case or an owner of a patent involved in an *ex parte* reexamination proceeding filed under § 1.510 for a patent that issues from an original application filed in the United States before November 29, 1999, has taken an appeal to the U.S. Court of Appeals for the Federal Circuit, he or she thereby waives his or her right to proceed under 35 U.S.C. 145.

(d) For an *ex parte* reexamination proceeding filed under § 1.510 for a patent that issues from an original application filed in the United States on

or after November 29, 1999, and for an *inter partes* reexamination proceeding filed under § 1.913, no remedy by civil action under 35 U.S.C. 145 is available.

18. Sections 1.304(a)(1) and (a)(2) are proposed to be revised to read as follows:

**§ 1.304 Time for appeal or civil action.**

(a)(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 1.197(b), § 1.658(b), or § 1.979(a), the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In interferences the time for filing a cross-appeal or cross-action expires:

(i) 14 days after service of the notice of appeal or the summons and complaint; or

(ii) Two months after the date of decision of the Board of Patent Appeals and Interferences, whichever is later.

(2) The time periods set forth in this section are not subject to the provisions of §§ 1.136, 1.550(c), 1.956, or § 1.645 (a) or (b).

19. The heading for Subpart D is proposed to be revised to read as follows:

**Subpart D—Ex Parte Reexamination of Patents**

20. Section 1.501 is proposed to be amended by revising its heading and paragraph (a) to read as follows:

**§ 1.501 Citation of prior art in patent and ex parte reexamination files.**

(a) At any time during the period of enforceability of a patent, any person may cite to the Office in writing prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Such citations shall be entered in the patent file except as set forth in this section. Citations by the patent owner under § 1.555 and by an *ex parte* reexamination requester under either § 1.510 or § 1.535 will be entered in the reexamination file during a reexamination proceeding. The entry in

the patent file of citations submitted after the date of an order to reexamine pursuant to § 1.525 by persons other than the patent owner, or an *ex parte* reexamination requester under either § 1.510 or § 1.535, will be delayed until the reexamination proceeding has been terminated. See § 1.902 for processing of prior art citations in patent files and the reexamination file during an *inter partes* reexamination proceeding filed under § 1.913.

21. The undesignated center heading following § 1.501 is proposed to be revised to read as follows:

**Request for Ex Parte Reexamination**

22. Section 1.510 is proposed to be amended by revising its heading and the text of paragraphs (a) and (b)(4) to read as follows:

**§ 1.510 Request for ex parte reexamination.**

(a) Any person may, at any time during the period of enforceability of a patent, file a request for an *ex parte* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501. The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).

(b) Any request for *ex parte* reexamination must include the following parts:

(4) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

23. Section 1.515 is proposed to be revised to read as follows:

**§ 1.515 Determination of the request for ex parte reexamination.**

(a) Within three months following the filing date of a request for an *ex parte* reexamination, an examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art cited therein, with or without consideration of other patents or printed publications. The examiner's determination will be based on the claims in effect at the time of the determination and will become a part of the official file of the patent and will be mailed to the patent owner at the

address as provided for in § 1.33(c) and to the person requesting reexamination.

(b) Where no substantial new question of patentability has been found, a refund of a portion of the fee for requesting *ex parte* reexamination will be made to the requester in accordance with § 1.26(c).

(c) The requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

24. Section 1.520 is proposed to be revised to read as follows:

**§ 1.520 *Ex parte* reexamination at the initiative of the Director.**

The Director, at any time during the period of enforceability of a patent, may determine whether or not a substantial new question of patentability is raised by patents or printed publications which have been discovered by the Director or which have been brought to the Director's attention even though no request for reexamination has been filed in accordance with § 1.510 or § 1.913. The Director may initiate *ex parte* reexamination without a request for reexamination pursuant to § 1.510 or § 1.913. Normally requests from outside the Office that the Director undertake reexamination on his own initiative will not be considered. Any determination to initiate *ex parte* reexamination under this section will become a part of the official file of the patent and will be mailed to the patent owner at the address as provided for in § 1.33(c).

25. The undesignated center heading following § 1.520 is proposed to be revised to read as follows:

***Ex Parte* Reexamination**

26. Section 1.525 is proposed to be revised to read as follows:

**§ 1.525 Order for *ex parte* reexamination.**

(a) If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for *ex parte* reexamination of the patent for resolution of the question. If the order for *ex parte* reexamination resulted from a petition pursuant to § 1.515(c), the *ex parte* reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination under § 1.515(a).

(b) The notice published in the *Official Gazette* under § 1.11(c) will be

considered to be constructive notice and *ex parte* reexamination will proceed.

27. Section 1.530 is proposed to be amended by revising its heading and paragraphs (a), (b), (c) and (d), introductory text, to read as follows:

**§ 1.530 Statement by patent owner in *ex parte* reexamination; amendment by patent owner in *ex parte* reexamination or *inter partes* reexamination.**

(a) Except as provided in § 1.510(e), no statement or other response by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515 or § 1.520. If a premature statement or other response is filed by the patent owner it will not be acknowledged or considered in making the determination.

(b) The order for *ex parte* reexamination will set a period of not less than two months from the date of the order within which the patent owner may file a statement on the new question of patentability including any proposed amendments the patent owner wishes to make.

(c) Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Where the reexamination request was filed by a third-party requester, any statement filed by the patent owner must be served upon the *ex parte* reexamination requester in accordance with § 1.248.

(d) *Amendments in reexamination proceedings.* Amendments in both *ex parte* and *inter partes* reexamination proceedings are made by filing a paper, in compliance with paragraph (d)(5) of this section, directing that specified amendments be made.

\* \* \* \* \*

28. Section 1.535 is proposed to be revised to read as follows:

**§ 1.535 Reply by third-party requester in *ex parte* reexamination.**

A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the *ex parte* reexamination requester will be considered.

29. Section 1.540 is proposed to be revised to read as follows:

**§ 1.540 Consideration of responses in *ex parte* reexamination.**

The failure to timely file or serve the documents set forth in § 1.530 or in § 1.535 may result in their being refused consideration. No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

30. Section 1.550 is proposed to be revised to read as follows:

**§ 1.550 Conduct of *ex parte* reexamination proceedings.**

(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses thereto, the examination will be conducted in accordance with §§ 1.104 through 1.116, and will result in the issuance of an *ex parte* reexamination certificate under § 1.570.

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. Such response may include further statements in response to any rejections or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

(c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request affect any extension. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the *ex parte* reexamination proceeding will be terminated and the Director will proceed to issue a certificate under § 1.570 in accordance with the last action of the Office.

(e) If a response by the patent owner is not timely filed in the Office,

(1) The delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable; a petition to accept an



unavoidably delayed response must be filed in compliance with § 1.137(a); or

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

(f) The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for *ex parte* reexamination by a third-party requester, any document filed by either the patent owner or the third-party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

(g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:

(1) In accordance with §§ 1.510 or 1.535; or

(2) Entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.

(h) Submissions by third parties, filed after the date of the order for *ex parte* reexamination pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a).

31. Section 1.552 is proposed to be revised to read as follows:

**§ 1.552 Scope of reexamination in *ex parte* reexamination proceedings.**

(a) Claims in an *ex parte* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

(b) Claims in an *ex parte* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such issues are raised by the patent owner or third-party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such issues considered and resolved.

32. Section 1.555 is proposed to be amended by revising its heading to read as follows:

**§ 1.555 Information material to patentability in *ex parte* reexamination and *inter partes* reexamination proceedings.**

\* \* \* \* \*

33. Section 1.560 is proposed to be revised to read as follows:

**§ 1.560 Interviews in *ex parte* reexamination proceedings.**

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action thereon. Interviews should be arranged for in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

34. Section 1.565 is proposed to be revised to read as follows:

**§ 1.565 Concurrent office proceedings which include an *ex parte* reexamination proceeding.**

(a) In an *ex parte* reexamination proceeding before the Office, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved such as an interference, reissue, *ex parte* reexamination, *inter partes* reexamination, or litigation and the results of such proceedings. See § 1.985 for notification of prior or concurrent proceedings in an *inter partes* reexamination proceeding.

(b) If a patent in the process of *ex parte* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the reexamination. See § 1.987 for *inter partes* reexamination proceedings.

(c) If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570. For merger of *inter partes* reexamination proceedings, see § 1.989(a). For merger of *ex parte* reexamination and *inter partes* reexamination proceedings, see § 1.989(b).

(d) If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *ex parte* reexamination proceeding is ordered, the merged examination will be conducted in accordance with §§ 1.171 through 1.179 and the patent owner will be required to place and maintain the same claims in the reissue application and the *ex parte* reexamination proceeding during the pendency of the merged proceeding. The examiner's actions and responses by the patent owner in a merged proceeding will apply to both the reissue application and the *ex parte* reexamination proceeding and be physically entered into both files. Any *ex parte* reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissued patent. For merger of a reissue application and an *inter partes* reexamination, see § 1.991.

(e) If a patent in the process of *ex parte* reexamination is or becomes involved in an interference, the Director may suspend the reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion (§ 1.635) to suspend the interference has been presented to, and denied by, an administrative patent judge and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set. For concurrent *inter partes* reexamination and interference of a patent, see § 1.993.

35. The undesignated center heading following § 1.565 is proposed to be revised to read as follows:

**Ex Parte Reexamination Certificate**

36. Section 1.570 is proposed to be revised to read as follows:

**§ 1.570 Issuance of *ex parte* reexamination certificate after *ex parte* reexamination proceedings.**

(a) Upon the conclusion of *ex parte* reexamination proceedings, the Director will issue an *ex parte* reexamination certificate in accordance with 35 U.S.C. 307 setting forth the results of the *ex parte* reexamination proceeding and the content of the patent following the *ex parte* reexamination proceeding.

(b) An *ex parte* reexamination certificate will be issued in each patent in which an *ex parte* reexamination proceeding has been ordered under § 1.525 and has not been merged with any *inter partes* reexamination proceeding pursuant to § 1.989(a). Any statutory disclaimer filed by the patent owner will be made part of the *ex parte* reexamination certificate.

(c) The *ex parte* reexamination certificate will be mailed on the day of its date to the patent owner at the address as provided for in § 1.33(c). A copy of the *ex parte* reexamination certificate will also be mailed to the requester of the *ex parte* reexamination proceeding.

(d) If an *ex parte* reexamination certificate has been issued which cancels all of the claims of the patent, no further Office proceedings will be conducted with regard to that patent or any reissue applications or any reexamination requests relating thereto.

(e) If the *ex parte* reexamination proceeding is terminated by the grant of a reissued patent as provided in § 1.565(d), the reissued patent will constitute the *ex parte* reexamination certificate required by this section and 35 U.S.C. 307.

(f) A notice of the issuance of each *ex parte* reexamination certificate under this section will be published in the *Official Gazette* on its date of issuance.

37. Subpart H is proposed to be added to read as follows:

**Subpart H—*Inter Partes* Reexamination of Patents****Prior Art Citations**

Sec.

1.902 Processing of prior art citations during an *inter partes* reexamination proceeding.

**Requirements for *Inter partes* Reexamination Proceedings**

1.903 Service of papers on parties in *inter partes* reexamination.  
1.904 Notice of *inter partes* reexamination in *Official Gazette*.  
1.905 Submission of papers by public in *inter partes* reexamination.

1.906 Scope of reexamination in *inter partes* reexamination proceeding.

1.907 *Inter partes* reexamination prohibited.

1.913 Persons eligible to file request for *inter partes* reexamination.

1.915 Content of request for *inter partes* reexamination.

1.919 Filing date of request for *inter partes* reexamination.

1.923 Examiner's determination on the request for *inter partes* reexamination.

1.925 Partial refund if request for *inter partes* reexamination is not ordered.

1.927 Petition to review refusal to order *inter partes* reexamination.

***Inter Partes* Reexamination of Patents**

1.931 Order for *inter partes* reexamination.

**Information Disclosure in *Inter Partes* Reexamination**

1.933 Patent owner duty of disclosure in *inter partes* reexamination proceedings.

**Office Actions and Responses (Before the Examiner) in *Inter partes* Reexamination**

1.935 Initial Office action usually accompanies order for *inter partes* reexamination.

1.937 Conduct of *inter partes* reexamination.

1.939 Unauthorized papers in *inter partes* reexamination.

1.941 Amendments by patent owner in *inter partes* reexamination.

1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination.

1.945 Response to Office action by patent owner in *inter partes* reexamination.

1.947 Comments by third-party requester to patent owner's response in *inter partes* reexamination.

1.948 Limitations on submission of prior art by third-party requester following the order for *inter partes* reexamination.

1.949 Examiner's Office action closing prosecution in *inter partes* reexamination.

1.951 Options after Office action closing prosecution in *inter partes* reexamination.

1.953 Examiner's Right of Appeal Notice in *inter partes* reexamination.

**Interviews Prohibited in *Inter Partes* Reexamination**

1.955 Interviews prohibited in *inter partes* reexamination proceedings.

**Extensions of Time, Termination of Proceedings, and Petitions to Revive in *Inter Partes* Reexamination**

1.956 Patent owner extensions of time in *inter partes* reexamination.

1.957 Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.

1.958 Petition to revive terminated *inter partes* reexamination or claims terminated for lack of patent owner response.

**Appeal to the Board of Patent Appeals and Interferences in *Inter Partes* Reexamination**

1.959 Notice of appeal and cross appeal to Board of Patent Appeals and Interferences in *inter partes* reexamination.

1.961 Jurisdiction over appeal in *inter partes* reexamination.

1.962 Appellant and respondent in *inter partes* reexamination defined.

1.963 Time for filing briefs in *inter partes* reexamination.

1.965 Appellant brief in *inter partes* reexamination.

1.967 Respondent brief in *inter partes* reexamination.

1.969 Examiner's answer in *inter partes* reexamination.

1.971 Rebuttal brief in *inter partes* reexamination.

1.973 Oral hearing in *inter partes* reexamination.

1.975 Affidavits or declarations after appeal in *inter partes* reexamination.

1.977 Decision by the Board of Patent Appeals and Interferences; remand to examiner in *inter partes* reexamination.

1.979 Action following decision by the Board of Patent Appeals and Interferences or dismissal of appeal in *inter partes* reexamination.

1.981 Reopening after decision by the Board of Patent Appeals and Interferences in *inter partes* reexamination.

**Patent Owner Appeal to the United States Court of Appeals for the Federal Circuit in *Inter Partes* Reexamination**

1.983 Patent owner appeal to the United States Court of Appeals for the Federal Circuit in *inter partes* reexamination.

**Concurrent Proceedings Involving Same Patent in *Inter Partes* Reexamination**

1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

1.987 Suspension of *inter partes* reexamination proceeding due to litigation.

1.989 Merger of concurrent reexamination proceedings.

1.991 Merger of concurrent reissue application and *inter partes* reexamination proceeding.

1.993 Suspension of concurrent interference and *inter partes* reexamination proceeding.

1.995 Third-party requester's participation rights preserved in merged proceeding.

**Reexamination Certificate in *Inter Partes* Reexamination**

1.997 Issuance of *inter partes* reexamination certificate.

**Prior Art Citations****§ 1.902 Processing of prior art citations during an *inter partes* reexamination proceeding.**

Citations by the patent owner in accordance with § 1.933 and by an *inter partes* reexamination third-party requester under §§ 1.915 or 1.948 will be entered in the *inter partes*

reexamination file. The entry in the patent file of other citations submitted after the date of an order for reexamination pursuant to § 1.931 by persons other than the patent owner, or the third-party requester under either § 1.915 or § 1.948, will be delayed until the *inter partes* reexamination proceeding has been terminated.

#### Requirements for *Inter Partes* Reexamination Proceedings

##### § 1.903 Service of papers on parties in *inter partes* reexamination.

The patent owner and the third-party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third-party requester, any document filed by either the patent owner or the third-party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third-party requester to serve documents may result in their being refused consideration.

##### § 1.904 Notice of *inter partes* reexamination in *Official Gazette*.

A notice of the filing of an *inter partes* reexamination request will be published in the *Official Gazette*. The notice published in the *Official Gazette* under § 1.11(c) will be considered to be constructive notice of the *inter partes* reexamination proceeding and *inter partes* reexamination will proceed.

##### § 1.905 Submission of papers by public in *inter partes* reexamination.

Unless specifically provided for, no submissions on behalf of any third parties other than third-party requesters as defined in 35 U.S.C. 100(e) will be considered unless such submissions are in accordance with § 1.915 or entered in the patent file prior to the date of the order for reexamination pursuant to § 1.931. Submissions by third parties, other than third-party requesters, filed after the date of the order for reexamination pursuant to § 1.931, must meet the requirements of § 1.501 and will be treated in accordance with § 1.902. Submissions which do not meet the requirements of § 1.501 will be returned.

##### § 1.906 Scope of reexamination in *inter partes* reexamination proceeding.

(a) Claims in an *inter partes* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect

to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

(b) Claims in an *inter partes* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in an *inter partes* reexamination proceeding. If such issues are raised by the patent owner or the third-party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such issues considered and resolved.

##### § 1.907 *Inter partes* reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the third-party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim in suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

##### § 1.913 Persons eligible to file request for *inter partes* reexamination.

Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a

request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

##### § 1.915 Content of request for *inter partes* reexamination.

(a) The request must be accompanied by the fee for requesting *inter partes* reexamination set in § 1.20(c)(2).

(b) A request for *inter partes* reexamination must include the following parts:

(1) An identification of the patent by patent number and every claim for which reexamination is requested.

(2) A citation of the patents and printed publications which are presented to provide a substantial new question of patentability.

(3) A statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.

(4) A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1)–(3) of this section, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document.

(5) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

(6) A certification by the third-party requester that a copy of the request has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy of the request must be supplied to the Office.

(7) A certification by the third-party requester that the estoppel provisions of § 1.907 do not prohibit the *inter partes* reexamination.

(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

(c) If an *inter partes* request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must

have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34(a).

(d) If the *inter partes* request does not meet all the requirements of § 1.915(b), the person identified as requesting *inter partes* reexamination may be so notified and given an opportunity to complete the formal requirements of the request within a specified time. Failure to comply with the notice may result in the *inter partes* reexamination proceeding being vacated.

**§ 1.919 Filing date of request for *inter partes* reexamination.**

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies the fee requirement of § 1.915(a).

(b) If the request is not granted a filing date, the request will be placed in the patent file as a citation of prior art if it complies with the requirements of § 1.501.

**§ 1.923 Examiner's determination on the request for *inter partes* reexamination.**

Within three months following the filing date of a request for *inter partes* reexamination under § 1.919, the examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art citation. The examiner's determination will be based on the claims in effect at the time of the determination and will become a part of the official file of the patent and will be mailed to the patent owner at the address as provided for in § 1.33(c) and to the third-party requester. If the examiner determines that no substantial new question of patentability is present, the examiner shall refuse the request and shall not order *inter partes* reexamination.

**§ 1.925 Partial refund if request for *inter partes* reexamination is not ordered.**

Where *inter partes* reexamination is not ordered, a refund of a portion of the fee for requesting *inter partes* reexamination will be made to the requester in accordance with § 1.26(c).

**§ 1.927 Petition to review refusal to order *inter partes* reexamination.**

The third-party requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing to order *inter partes* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed, or if the decision on petition affirms that no substantial new question of patentability has been

raised, the determination shall be final and nonappealable.

***Inter Partes* Reexamination of Patents**

**§ 1.931 Order for *inter partes* reexamination.**

(a) If a substantial new question of patentability is found, the determination will include an order for *inter partes* reexamination of the patent for resolution of the question.

(b) If the order for *inter partes* reexamination resulted from a petition pursuant to § 1.927, the *inter partes* reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination under § 1.923.

**Information Disclosure in *inter partes* Reexamination**

**§ 1.933 Patent owner duty of disclosure in *inter partes* reexamination proceedings.**

(a) Each individual associated with the patent owner in an *inter partes* reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding as set forth in § 1.555(a) and (b). The duty to disclose all information known to be material to patentability in an *inter partes* reexamination proceeding is deemed to be satisfied by filing a paper in compliance with the requirements set forth in § 1.555(a) and (b).

(b) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section, and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are discovered during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.906(c).

**Office Actions and Responses (Before the Examiner) in *inter partes* Reexamination**

**§ 1.935 Initial Office action usually accompanies order for *inter partes* reexamination.**

The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

**§ 1.937 Conduct of *inter partes* reexamination.**

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and

Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

(b) The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an *inter partes* reexamination certificate under § 1.997, except as otherwise provided.

(c) All communications between the Office and the parties to the *inter partes* reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

**§ 1.939 Unauthorized papers in *inter partes* reexamination.**

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

**§ 1.941 Amendments by patent owner in *inter partes* reexamination.**

Amendments by patent owner in *inter partes* reexamination proceedings are made by filing a paper in compliance with §§ 1.530(d) and 1.943.

**§ 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination.**

(a) The form of responses, written comments, briefs, appendices, and other papers must be in accordance with the requirements of § 1.530(d)(5).

(b) Responses by the patent owner and written comments by the third-party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

(c) Appellant briefs by the patent owner and the third-party requester shall not exceed 30 pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs by any party shall not exceed 15 pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

**§ 1.945 Response to Office action by patent owner in *inter partes* reexamination.**

The patent owner will be given at least 30 days to file a response to any Office action on the merits of the *inter partes* reexamination.

**§ 1.947 Comments by third-party requester to patent owner's response in *inter partes* reexamination.**

Each time the patent owner files a response to an Office action on the merits, a third-party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third-party requester may not be extended.

**§ 1.948 Limitations on submission of prior art by third-party requester following the order for *inter partes* reexamination.**

After the *inter partes* reexamination order, the third-party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under §§ 1.947, 1.951(a) and 1.951(d), and is limited to prior art:

- (a) Which is necessary to rebut a finding of fact by the examiner;
- (b) Which is necessary to rebut a response of the patent owner; or,
- (c) Which became known or available to the third-party requester after the filing of the request for *inter partes* reexamination proceeding where a discussion of the pertinency of each reference to the patentability of at least one claim is included. Prior art submitted under this paragraph (c) must be accompanied by a statement as to when the prior art first became known or available to the third-party requester.

**§ 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination.**

Upon consideration of the issues a second or subsequent time, or upon allowance of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.

**§ 1.951 Options after Office action closing prosecution in *inter partes* reexamination.**

(a) After an action closing prosecution in an *inter partes* reexamination, a third-party requester may once file comments limited to the issues raised in the Office action closing prosecution. Such comments must be filed within the time set for response in the Office action closing prosecution.

(b) When a third-party requester does file comments, the patent owner may once file comments responsive to the third-party requester's comments within 30 days from the date of service of the third-party requester's comments on the patent owner.

(c) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

(d) When the patent owner does file comments, a third-party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third-party requester.

**§ 1.953 Examiner's Right of Appeal Notice in *inter partes* reexamination.**

(a) Upon considering the comments of the patent owner and the third-party requester subsequent to the Office action closing prosecution in an *inter partes* reexamination, or upon expiration of the time for submitting such comments, the examiner shall issue a Right of Appeal Notice, unless the examiner reopens prosecution and issues another Office action on the merits.

(b) Expedited Right of Appeal Notice: At any time after the patent owner's response to the initial Office action on the merits in an *inter partes* reexamination, the patent owner and all third-party requesters may stipulate that the issues are appropriate for a final action, which would include a final rejection and/or a final determination favorable to patentability, and may request the issuance of a Right of Appeal Notice. The request must have the concurrence of the patent owner and all third-party requesters present in the proceeding and must identify all the appealable issues, and the positions of the patent owner and all third-party requesters on those issues. If the examiner determines that no other issues are present or should be raised, a Right of Appeal Notice limited to the identified issues shall be issued. Any appeal by the parties shall be conducted in accordance with §§ 1.959–1.983.

(c) The Right of Appeal Notice shall be a final action, which includes a final rejection setting forth each ground of rejection and/or final decision favorable

to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, the *inter partes* reexamination proceeding will be terminated, and the Director will proceed to issue a certificate under § 1.997 in accordance with the Right of Appeal Notice.

**Interviews Prohibited in *Inter Partes* Reexamination**

**§ 1.955 Interviews prohibited in *inter partes* reexamination proceedings.**

There will not be any interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

**EXTENSIONS OF TIME, TERMINATION OF PROCEEDINGS, AND PETITIONS TO REVIVE IN *inter partes* REEXAMINATION**

**§ 1.956 Patent owner extensions of time in *inter partes* reexamination.**

The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.

**§ 1.957 Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.**

(a) If the third-party requester files an untimely or inappropriate comment, notice of appeal or brief in an *inter partes* reexamination, the paper will be refused consideration.

(b) If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the reexamination proceeding will be terminated and the Director will proceed to issue a certificate under § 1.997 in accordance with the last action of the Office.

(c) If claims are found patentable, and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at

the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time.

(d) When action by the patent owner is a *bona fide* attempt to respond and to advance the prosecution, and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

**§ 1.958 Petition to revive terminated *inter partes* reexamination or claims terminated for lack of patent owner response.**

(a) If a response by the patent owner is not timely filed in the Office, the delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable. A petition to accept an unavoidably delayed response must be filed in compliance with § 1.137(a).

(b) Any response by the patent owner not timely filed in the Office may nevertheless be accepted if the delay was unintentional. A petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

**Appeal to the Board of Patent Appeals and Interferences in *Inter Partes* Reexamination**

**§ 1.959 Notice of appeal and cross appeal to Board of Patent Appeals and Interferences in *inter partes* reexamination.**

(a)(1) Upon the issuance of a Right of Appeal Notice under § 1.953, the patent owner involved in an *inter partes* reexamination proceeding may appeal to the Board of Patent Appeals and Interferences with respect to the final rejection of any claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 1.17(b).

(2) Upon the issuance of a Right of Appeal Notice under § 1.953, a third-party requester involved in an *inter partes* reexamination proceeding may appeal to the Board of Patent Appeals and Interferences with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original or proposed amended or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 1.17(b).

(b)(1) Within fourteen days of service of a third-party requester's notice of appeal under paragraph (a)(2) of this section, and upon payment of the fee set forth in § 1.17(b), a patent owner who

has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of a patent owner's notice of appeal under paragraph (a)(1) of this section, and upon payment of the fee set forth in § 1.17(b), a third-party requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original or proposed amended or new claim of the patent.

(c) The notice of appeal or cross appeal in an *inter partes* reexamination proceeding must identify the claim(s) with respect to which an appeal is being taken, and must be signed by the patent owner or third-party requester, or their duly authorized attorney or agent.

(d) An appeal or cross appeal when taken must be taken from all the rejections of the claims under rejection in a Right of Appeal Notice which the patent owner proposes to contest, or from all the determinations favorable to patentability, including any final determination not to make a proposed rejection, in a Right of Appeal Notice which a third-party requester proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal is decided.

(e) The times for filing a notice of appeal or cross-appeal may not be extended.

**§ 1.961 Jurisdiction over appeal in *inter partes* reexamination.**

Jurisdiction over the *inter partes* reexamination proceeding passes to the Board of Patent Appeals and Interferences upon transmittal of the file, including all briefs and examiner's answers, to the Board of Patent Appeals and Interferences. Prior to the entry of a decision on the appeal, the Director may sua sponte order the *inter partes* reexamination proceeding remanded to the examiner, for action consistent with the Director's order.

**§ 1.962 Appellant and respondent in *inter partes* reexamination defined.**

For the purposes of *inter partes* reexamination, appellant is any party, whether the patent owner or a third-party requester, filing a notice of appeal or cross appeal. If more than one party appeals or cross appeals, each appealing or cross appealing party is an appellant with respect to the claims to which his or her appeal or cross appeal is directed. A respondent is any third-party requester responding under § 1.967 to

the appellant brief of the patent owner, or the patent owner responding under § 1.967 to the appellant brief of any third-party requester. No third-party requester may be a respondent to the appellant brief of any other third-party requester.

**§ 1.963 Time for filing briefs in *inter partes* reexamination.**

(a) An appellant brief in an *inter partes* reexamination must be filed no later than two months from the latest of the filing date of the last-filed notice of appeal or cross appeal or if any party to the *inter partes* reexamination is entitled to file an appeal or cross appeal but fails to timely do so, the expiration of time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant brief may not be extended.

(b) Once an appellant brief has been properly filed, any respondent brief must be filed within one month from the date of service of the appellant brief. The time for filing a respondent brief may not be extended.

(c) The examiner will consider both the appellant and respondent briefs and may prepare an examiner's answer under § 1.969.

(d) Any appellant may file a rebuttal brief under § 1.971 within one month of the date of the examiner's answer. The time for filing a rebuttal brief may not be extended.

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939.

**§ 1.965 Appellant brief in *inter partes* reexamination.**

(a) Appellant(s) may once, within time limits for filing set forth in § 1.963, file a brief in triplicate and serve the brief on all other parties to the *inter partes* reexamination proceeding in accordance with § 1.903. The brief must be signed by the appellant, or the appellant's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 1.17(c). The brief must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

(b) On failure of a party to file an appellant brief, accompanied by the requisite fee, within the time allowed, that party's appeal shall stand dismissed.

(c) The appellant brief shall contain the following items under appropriate

headings and in the order indicated below, unless the brief is filed by a party who is not represented by a registered practitioner. The brief may include an appendix containing only those portions of the record on which reliance has been made.

(1) *Real Party in Interest.* A statement identifying the real party in interest.

(2) *Related Appeals and Interferences.* A statement identifying by number and filing date all other appeals or interferences known to the appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the decision of the Board of Patent Appeals and Interferences in the pending appeal.

(3) *Status of Claims.* A statement of the status of all the claims, pending or canceled. If the appellant is the patent owner, the appellant must also identify the rejected claims whose rejection is being appealed. If the appellant is a third-party requester, the appellant must identify the claims that the examiner has made a determination favorable to patentability, which determination is being appealed.

(4) *Status of Amendments.* A statement of the status of any amendment filed subsequent to the close of prosecution.

(5) *Summary of Invention.* A concise explanation of the invention or subject matter defined in the claims involved in the appeal, which shall refer to the specification by column and line number, and to the drawing(s), if any, by reference characters.

(6) *Issues.* A concise statement of the issues presented for review. No new ground of rejection can be proposed by a third-party requester appellant.

(7) *Grouping of Claims.* If the appellant is the patent owner, for each ground of rejection in the right of appeal notice which appellant contests and which applies to a group of two or more claims, the Board of Patent Appeals and Interferences shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of this group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) *Argument.* The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the bases

therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate, numbered heading.

(i) For each rejection under 35 U.S.C. 112, first paragraph, or for each determination favorable to patentability including a determination not to make a proposed rejection under 35 U.S.C. 112, first paragraph, which appellant contests, the argument shall specify the errors in the rejection or the determination and how the first paragraph of 35 U.S.C. 112 is complied with, if the appellant is the patent owner, or is not complied with, if the appellant is a third-party requester, including, as appropriate, how the specification and drawing(s), if any,

(A) Describe, if the appellant is the patent owner, or fail to describe, if the appellant is a third-party requester, the subject matter defined by each of the appealed claims, and  
(B) Enable, if the appellant is the patent owner, or fail to enable, if the appellant is a third-party requester, any person skilled in the art to make and use the subject matter defined by each of the appealed claims, and

(ii) For each rejection under 35 U.S.C. 112, second paragraph, or for each determination favorable to patentability including a determination not to make a proposed rejection under 35 U.S.C. 112, second paragraph, which appellant contests, the argument shall specify the errors in the rejection, if the appellant is the patent owner, or the determination, if the appellant is a third-party requester, and how the claims do, if the appellant is the patent owner, or do not, if the appellant is a third-party requester, particularly point out and distinctly claim the subject matter which the inventors regard as the invention.

(iii) For each rejection under 35 U.S.C. 102 or for each determination favorable to patentability including a determination not to make a proposed rejection under 35 U.S.C. 102 which appellant contests, the argument shall specify the errors in the rejection, if the appellant is the patent owner, or determination, if the appellant is a third-party requester, and why the appealed claims are, if the appellant is the patent owner, or are not, if the appellant is a third-party requester, patentable under 35 U.S.C. 102, including any specific limitations in the appealed claims which are or are not described in the prior art.

(iv) For each rejection under 35 U.S.C. 103 or for each determination favorable to patentability including a determination not to make a proposed

rejection under 35 U.S.C. 103 which appellant contests, the argument shall specify the errors in the rejection, if the appellant is the patent owner, or determination, if the appellant is a third-party requester, and, if appropriate, the specific limitations in the appealed claims which are or are not described in the prior art, and shall explain how such limitations render the claimed subject matter obvious, if the appellant is a third-party requester, or unobvious, if the appellant is the patent owner, over the prior art. If the rejection or determination is based upon a combination of references, the argument shall explain why the references, taken as a whole, do or do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may or may not properly be combined with features disclosed in another reference. A general argument that all the limitations are or are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section or for each determination favorable to patentability including any determination not to make a proposed rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section which appellant contests, the argument shall specify the errors in the rejection, if the appellant is the patent owner, or determination, if the appellant is a third-party requester, and the specific limitations in the appealed claims, if appropriate, or other reasons, which cause the rejection or determination to be in error.

(9) *Appendix.* An appendix containing a copy of the claims appealed by the appellant.

(10) *Certificate of Service.* A certification that a copy of the brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended brief. If the appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.



**§ 1.967 Respondent brief in *inter partes* reexamination.**

(a) Respondent(s) in an *inter partes* reexamination appeal may once, within time limit for filing set forth in § 1.963, file a respondent brief in triplicate and serve the brief on all parties in accordance with § 1.903. The brief must be signed by the party, or the party's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 1.17(c). The brief must set forth the authorities and arguments on which respondent will rely. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown. The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed. A third-party respondent brief may not address any brief of any other third-party.

(b) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

(1) *Real Party in Interest.* A statement identifying the real party in interest.

(2) *Related Appeals and Interferences.* A statement identifying by number and filing date all other appeals or interferences known to the respondent, the respondent's legal representative, or assignee (if any) which will directly affect or be directly affected by or have a bearing on the decision of the Board of Patent Appeals and Interferences in the pending appeal.

(3) *Status of claims.* A statement accepting or disputing appellant's statement of the status of claims. If appellant's statement of the status of claims is disputed, the errors in appellant's statement must be specified with particularity.

(4) *Status of amendments.* A statement accepting or disputing appellant's statement of the status of amendments. If appellant's statement of the status of amendments is disputed, the errors in appellant's statement must be specified with particularity.

(5) *Summary of invention.* A statement accepting or disputing appellant's summary of the invention or subject matter defined in the claims involved in the appeal. If appellant's summary of the invention or subject matter defined in the claims involved in the appeal is disputed, the errors in appellant's summary must be specified with particularity.

(6) *Issues.* A statement accepting or disputing appellant's statement of the

issues presented for review. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified with particularity. A counter statement of the issues for review may be made. No new ground of rejection can be proposed by a third-party requester respondent.

(7) *Argument.* A statement accepting or disputing the contentions of the appellant with each of the issues. If a contention of the appellant is disputed, the errors in appellant's argument must be specified with particularity, stating the basis therefor, with citations of the authorities, statutes and parts of the record relied on. Each issue should be treated under a separate heading. An argument may be made with each of the issues stated in the counter statement of the issues, with each counter-stated issue being treated under a separate heading. The provisions of §§ 1.965(c)(8)(iii) and (iv) shall apply to any argument raised under 35 U.S.C. 102 or 103.

(8) *Certificate of Service.* A certification that a copy of the respondent brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(c) If a respondent brief is filed which does not comply with all the requirements of paragraph (b) of this section, respondent will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended brief. If the respondent does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief will not be considered.

**§ 1.969 Examiner's answer in *inter partes* reexamination.**

(a) The primary examiner in an *inter partes* reexamination appeal may, within such time as directed by the Director, furnish a written statement in answer to the patent owner's and/or third-party requester's appellant brief or respondent brief including, as may be necessary, such explanation of the invention claimed and of the references, the grounds of rejection, and the reasons for patentability including grounds for not adopting a proposed rejection. A copy of the answer shall be supplied to all parties to the reexamination proceeding. If the primary examiner finds that the appeal is not regular in form or does not relate to an appealable action, he or she shall so state.

(b) An examiner's answer may not include a new ground of rejection.

(c) Where a third-party requester is a party to the appeal, an examiner's answer may not include a new determination not to make a proposed rejection of a claim.

**§ 1.971 Rebuttal brief in *inter partes* reexamination.**

Within one month of the examiner's answer in an *inter partes* reexamination appeal, any appellant may once file a rebuttal brief in triplicate. The rebuttal brief of the patent owner may be directed to the examiner's answer and/or any respondent brief. The rebuttal brief of any third-party requester may be directed to the examiner's answer and/or the respondent brief of the patent owner. The rebuttal brief of a third-party requester may not be directed to the respondent brief of any other third-party requester. No new ground of rejection can be proposed by a third-party requester appellant. The time for filing a rebuttal brief may not be extended. The rebuttal brief must include a certification that a copy of the rebuttal brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

**§ 1.973 Oral hearing in *inter partes* reexamination.**

(a) An oral hearing in an *inter partes* reexamination appeal should be requested only in those circumstances in which an appellant or a respondent considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as an appeal decided after oral hearing.

(b) If an appellant or a respondent desires an oral hearing, he or she must file a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months after the date of the examiner's answer. The time for requesting an oral hearing may not be extended.

(c) An oral argument may be presented at oral hearing by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board of Patent Appeals and Interferences.

(d) If an appellant or a respondent has requested an oral hearing and has submitted the fee set forth in § 1.17(d), a hearing date will be set, and notice given to all parties to the reexamination proceeding, and to the primary examiner. The notice shall set a period within which all requests for oral

hearing shall be submitted by any other party to the appeal desiring to participate in the oral hearing, which period will not be extended. A hearing will be held as stated in the notice, and oral argument will be limited to thirty minutes for each appellant and respondent who has requested an oral hearing, and twenty minutes for the primary examiner unless otherwise ordered before the hearing begins. No appellant or respondent will be permitted to participate in an oral hearing unless he or she has requested an oral hearing and submitted the fee set forth in § 1.17(d).

(e) If no request and fee for oral hearing have been timely filed by an appellant or a respondent, the appeal will be assigned for consideration and decision on the written record.

**§ 1.975 Affidavits or declarations after appeal in *inter partes* reexamination.**

Affidavits, declarations, or exhibits submitted after the *inter partes* reexamination has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.

**§ 1.977 Decision by the Board of Patent Appeals and Interferences; remand to examiner in *inter partes* reexamination.**

(a) The Board of Patent Appeals and Interferences, in its decision, may affirm or reverse each decision of the examiner on all issues raised on each appealed claim, or remand the reexamination proceeding to the examiner for further consideration. The reversal of the examiner's determination not to make a rejection proposed by the third-party requester constitutes a decision adverse to the patentability of the claims which are subject to that proposed rejection which will be set forth in the decision of the Board of Patent Appeals and Interferences as a new ground of rejection under paragraph (b) of this section. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.

(b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds not raised in the appeal for rejecting any pending claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement shall constitute a new ground of rejection of the claim. A decision which includes a new ground of rejection shall not be considered final for purposes of judicial review. When the Board of Patent Appeals and Interferences makes a new

ground of rejection, the patent owner, within one month from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal proceeding as to the rejected claim:

(1) The patent owner may submit an appropriate amendment of the claim so rejected or a showing of facts relating to the claim, or both. The reexamination proceeding will be remanded to the examiner for consideration. The statement of the Board of Patent Appeals and Interferences shall be binding upon the examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the examiner, overcomes the new ground of rejection.

(2) The patent owner may file a request for rehearing of the decision of the Board of Patent Appeals and Interferences under § 1.979(a).

(c) The Board of Patent Appeals and Interferences, in its decision, may include an explicit statement that a claim may be allowed in amended form. The decision shall not be considered a final decision for purposes of judicial review if the patent owner, within one month of the date of the decision, submits an appropriate amendment of the claim in conformity with such statement, in which event the reexamination proceeding will be remanded to the examiner. The statement shall be binding on the examiner in the absence of new references or new grounds of rejection.

(d) Where the patent owner has responded under paragraph (b)(1) or (c) of this section, any third-party requester, within one month of the date of service of the patent owner response, may once file comments on the response. Such written comments must be limited to the issues raised by the decision of the Board of Patent Appeals and Interferences and the patent owner's response. Any third-party requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under §§ 1.17(b) and (c), respectively, which must accompany the comments or reply.

(e) Following any response by the patent owner under paragraph (b)(1) or (c) of this section and any written comments from a third-party requester under paragraph (d) of this section, the reexamination proceeding will be remanded to the examiner. The examiner will consider any response under paragraph (b)(1) or (c) of this section and any written comments by a third-party requester under paragraph

(d) of this section and issue a determination that the rejection should be maintained or has been overcome.

(f) Within one month of the examiner's determination pursuant to paragraph (e) of this section, the patent owner or any third-party requester may once submit comments in response to the examiner's determination. Within one month of the date of service of comments in response to the examiner's determination, any party may file a reply to the comments. Any third-party requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under §§ 1.17(b) and (c), respectively, which must accompany the comments or reply.

(g) After submission of any comments and any reply pursuant to paragraph (f) of this section, or after time has expired therefor, the reexamination proceeding will be returned to the Board of Patent Appeals and Interferences which shall reconsider the matter and issue a new decision. The new decision is deemed to incorporate the earlier decision, except for those portions specifically withdrawn.

(h) The time periods set forth in paragraphs (b) and (c) of this section are subject to the extension of time provisions of § 1.956. The time periods set forth in subsections (d) and (f) may not be extended.

**§ 1.979 Action following decision by the Board of Patent Appeals and Interferences or dismissal of appeal in *inter partes* reexamination.**

(a) Parties to the appeal may file a request for rehearing of the decision within one month of the date of:

(1) The original decision of the Board of Patent Appeals and Interferences under § 1.977(a),

(2) The original § 1.977(b) decision under the provisions of § 1.977(b)(2),

(3) The expiration of the time for the patent owner to take action under § 1.977(b)(2) or (c), or

(4) The new decision of the Board of Patent Appeals and Interferences under § 1.977(g).

(b) Within one month of the date of service of any request for rehearing under paragraph (a) of this section, or any further request for rehearing under paragraph (c) of this section, any party to the appeal may once file comments in opposition to the request for rehearing or the further request for rehearing. The comments in opposition must be limited to the issues raised in the request for rehearing or the further request for rehearing.

(c) If a party to an appeal files a request for rehearing under paragraph

(a) of this section, or a further request for rehearing under this section, the Board of Patent Appeals and Interferences will issue a decision on rehearing which decision is deemed to incorporate the earlier decision, except for those portions specifically withdrawn. If the decision on rehearing becomes, in effect, a new decision, and the Board of Patent Appeals and Interferences so states, then any party to the appeal may, within one month of the new decision, once file a further request for rehearing of the new decision under this subsection.

(d) Any request for rehearing shall state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought.

(e) The patent owner may not appeal to the U.S. Court of Appeals for the Federal Circuit under § 1.983 until all parties' rights to request rehearing have been exhausted, at which time the decision of the Board of Patent Appeals and Interferences is final and appealable by the patent owner.

(f) An appeal by a third-party requester is considered terminated by the dismissal of the third-party requester's appeal, the failure of the third-party requester to timely request rehearing under §§ 1.979(a) or (c), or a final decision under § 1.979(e). The date of such termination is the date on which the appeal is dismissed, the date on which the time for rehearing expires, or the decision of the Board of Patent Appeals and Interferences is final. An appeal by the patent owner is considered terminated by the dismissal of the patent owner's appeal, the failure of the patent owner to timely request rehearing under §§ 1.979(a) or (c), or the failure of the patent owner to timely file an appeal to the U.S. Court of Appeals for the Federal Circuit under § 1.983. The date of such termination is the date on which the appeal is dismissed, the date on which the time for rehearing expires, or the date on which the time for the patent owner's appeal to the U.S. Court of Appeals for the Federal Circuit expires. If an appeal to the U.S. Court of Appeals for the Federal Circuit has been filed, the patent owner's appeal is considered terminated when the mandate is received by the Office. Upon termination of an appeal, if no other appeal is present, the reexamination proceeding will be terminated and the Director will issue a certificate under § 1.997.

(g) The times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (c) of this section, and for

submitting comments under paragraph (b) of this section may not be extended.

**§ 1.981 Reopening after decision by the Board of Patent Appeals and Interferences in *inter partes* reexamination.**

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.977 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

**Patent Owner Appeal to the United States Court of Appeals for the Federal Circuit in *inter partes* Reexamination**

**§ 1.983 Patent owner appeal to the United States Court of Appeals for the Federal Circuit in *inter partes* reexamination.**

The patent owner in a reexamination proceeding who is dissatisfied with the decision of the Board of Patent Appeals and Interferences may, subject to § 1.979(e), appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal:

(1) In the U. S. Patent and Trademark Office file a timely written notice of appeal directed to the Director in accordance with §§ 1.302 and 1.304; and

(2) In the Court, file a copy of the notice of appeal and pay the fee, as provided for in the rules of the Court.

**Concurrent Proceedings Involving Same Patent in *inter partes* Reexamination**

**§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.**

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

(b) Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender.

**§ 1.987 Suspension of *inter partes* reexamination proceeding due to litigation.**

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

**§ 1.989 Merger of concurrent reexamination proceedings.**

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902–1.997, except that the rights of any third-party requester of the *ex parte* reexamination shall be governed by §§ 1.510–1.560.

**§ 1.991 Merger of concurrent reissue application and *inter partes* reexamination proceeding.**

If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179 and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third-party requester may participate to the extent provided under §§ 1.902–1.997, except such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third-party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files. Any *inter partes* reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissued patent.

**§ 1.993 Suspension of concurrent interference and *inter partes* reexamination proceeding.**

If a patent in the process of *inter partes* reexamination is or becomes involved in an interference, the Director may suspend the *inter partes* reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion under § 1.635 to suspend the interference has been presented to, and denied by, an administrative patent judge and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set.

**§ 1.995 Third-party requester's participation rights preserved in merged proceeding.**

When a third-party requester is involved in one or more proceedings including an *inter partes* reexamination proceeding, the merger of such proceedings will be accomplished so as to preserve the third-party requester's

right to participate to the extent specifically provided for in these regulations. In merged proceedings involving different requesters, any paper filed by one party in the merged proceeding shall be served on all other parties of the merged proceeding.

**Reexamination Certificate in *inter partes* Reexamination**

**§ 1.997 Issuance of *inter partes* reexamination certificate.**

(a) Upon the conclusion of an *inter partes* reexamination proceeding, the Director will issue a certificate in accordance with 35 U.S.C. 316 setting forth the results of the *inter partes* reexamination proceeding and the content of the patent following the *inter partes* reexamination proceeding.

(b) A certificate will be issued in each patent in which an *inter partes* reexamination proceeding has been ordered under § 1.931. Any statutory disclaimer filed by the patent owner will be made part of the certificate.

(c) The certificate will be sent to the patent owner at the address as provided

for in § 1.33(c). A copy of the certificate will also be sent to the third-party requester of the *inter partes* reexamination proceeding.

(d) If a certificate has been issued which cancels all of the claims of the patent, no further Office proceedings will be conducted with regard to that patent or any reissue applications or any reexamination requests relating thereto.

(e) If the *inter partes* reexamination proceeding is terminated by the grant of a reissued patent as provided in § 1.991, the reissued patent will constitute the reexamination certificate required by this section and 35 U.S.C. 316.

(f) A notice of the issuance of each certificate under this section will be published in the *Official Gazette*.

Dated: March 30, 2000.

**Q. Todd Dickinson,**

*Under Secretary of Commerce for Intellectual Property and Director of the United States, Patent and Trademark Office.*

[FR Doc. 00-8284 Filed 4-5-00; 8:45 am]

**BILLING CODE 3510-16-P**