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37 CFR Part 1

Rules to Implement Optional Inter Partes Reexamination Proceedings; Final Rule

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

RIN 0651–AB04

Rules to Implement Optional Inter Partes Reexamination Proceedings

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The U.S. Patent and Trademark Office (the Office) is amending 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* (multiparty) reexamination procedure in addition to the present *ex parte* (single party) 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: *Effective Date:* February 5, 2001.

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, D.C. 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, D.C. 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 final rule 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 (Public Law 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 August 1995, the Office published proposed rules in anticipation of H.R. 1732, 104th Cong., 1st Sess. (1995), a predecessor of the present *inter partes* reexamination statute. H.R. 1732 did not, however, mature into a statute. The August 1995 Notice of Proposed Rulemaking entitled ''Rules of Practice in Patent Cases; Reexamination Proceedings,'' 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 sets of 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.

In response to the 1999 Public Law 106–113, a notice of proposed rulemaking was published in the **Federal Register** on April 6, 2000, at 65 FR 18154–18186, and in the *Official Gazette* on May 23, 2000, at 1234 O.G. 93–123. The 2000 notice of proposed rulemaking addressed, and took into consideration, the comments received in response to the 1995 proposed rules. A public hearing was not held.

Discussion of General Issues Involved

This final rule 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 set forth in this final rule notice, 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 1.510–1.570. The final rules for optional *inter partes* reexamination proceedings 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, apply only 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. An ''original application'' filed in the United States prior to November 29, 1999, is defined in the notice entitled ''Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term 'Original Application' in the American Inventors Protection Act of 1999'' which notice was published in the *Official Gazette* at 1233 Off. Gaz. Pat. Office 54 (April 11, 2000). The phrase ''original application'' is interpreted to encompass utility, plant and design applications, including first filed applications, continuations, divisionals, continuations-in-part, continued prosecution applications and the national stage phase of international applications. Therefore, the optional *inter partes* reexamination, and the application of the conforming amendments to 35 U.S.C. 134, 141, 143 and 145 for both *inter partes* and *ex parte* reexamination proceedings is applicable to patents which issue from all applications (except for reissue applications) filed on or after November 29, 1999. A patent which issues from an application filed prior to November 29, 1999, with a request for continued examination (defined in section 4403 of the Act) made on or after May 29, 2000, however, is not eligible for the optional *inter partes* reexamination procedure nor application of the conforming amendments discussed above, because a request for continued examination is not a filing of an application.

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 to provide the patent owner with a remedy for an unintentionally delayed response 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 this amendment to 35 U.S.C. 41(a)(7) 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 Commissioner of the United States Patent and Trademark Office (the Commissioner) 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 the cost 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 takes into account the additional processing steps that are expected during an *inter partes* reexamination proceeding.

Discussion of the Major Specific Issues Involved (1999 Statute)

The 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.

This final rule contains a number of changes to the text of the rules that were proposed for comment. The significant changes (as opposed to grammatical corrections) are discussed below. Familiarity with the Notice of Proposed Rulemaking is assumed.

Section 4732 of the American Inventors Protection Act of 1999 changed (among other things) the title ''Commissioner'' to ''Director.'' In the Notice of Proposed Rulemaking the title ''Commissioner'' was revised to read ''Director'' in the current rules, or portions of the current rules, that were proposed to be amended; and in the proposed new rules the new title ''Director'' was used in place of the former title ''Commissioner.'' In this final rule, however, the title ''Commissioner'' is not being changed to ''Director'' where it appears in the current rules of practice involved in this final rule, and the title ''Commissioner'' and not ''Director'' is used in the new rules adopted in this final rule. This is because legislation is pending before Congress that (if enacted) would restore the former title ''Commissioner.'' *See* Intellectual Property Technical Amendments Act of 2000, H.R. 4870, 106th Cong. (2000).

The USPTO received 10 sets of written comments (from Intellectual Property Organizations, Law Firms, Businesses and Patent Practitioners) in response to the Notice of Proposed Rulemaking. The written comments have been analyzed. General comments are addressed as a group separately from the specific rules. Comments directed to specific rules and the response to each comment are provided with the discussion of the specific rule. Comments in support of proposed rules generally have not been reported in the responses to comments section.

Discussion of General Comments

General Comment 1: Examiner Assignment (selection of examiner)

Two comments were received directed to the selection of the examiner who will be assigned the *inter partes* reexamination. One comment suggested that the ''rules'' rather than policy should provide that an *inter partes* reexamination be handled by an examiner other than the one who originally examined the application.

The second comment expressed support for the Office's announced intention to adopt a policy that a different examiner, other than those actually involved in the examination and issuing of the patent, will be assigned the *inter partes* reexamination.

Response to General Comment 1

The Office's intention to adopt a policy that a different examiner, other than those actually involved in the examination and issuing of the patent, will be assigned the *inter partes* reexamination was announced in the proposed rules. *See* Notice of proposed rulemaking, Rules to Implement Optional Inter Partes Reexamination Proceedings, 65 FR 18154, 18157–58 (April 6, 2000), 1234 OG 93, 96 (May 23, 2000), Response to Issue 4, first paragraph. As noted therein, studies conducted by the Office as to the selection of the examiner have not shown any examiner 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, the resolution of a new question of patentability. In spite of these findings, the Office is, for the most part, adopting the comments suggesting assignment of the reexamination to an examiner other than the one who originally examined and issued the patent. The new policy is being adopted in order to eliminate any perception by the public of bias by the original examiner who handled the patent. The change in the manner of examiner selection, however, will be implemented as a matter of policy,

rather than by rule change. Specific guidance as to policies, practice and procedure as they will apply to examiner selection in *inter partes* reexamination proceedings will be forthcoming in a separate *Official Gazette* notice to be published in conjunction with the final rules on *inter partes* reexamination.

General Comment 2: Panel Review of Examiner Actions

Two comments were received directed to the review of the examiner's actions during the examination process. One comment expressed support for the Office's announced intention to adopt a policy to hold a panel review of the examiner's proposed action at selected times during the examination. The comment suggested that such a review, however, be conducted of each action by the examiner that includes an action on the merits of the claims rather than the announced intention of holding such a review just prior to the decision to order reexamination and at the close of prosecution.

The second comment expressed support for the proposed policy for better review of the (single) examiner's decision during the reexamination. The comment, however, erroneously identified the announced change in policy as a rule proposal.

Response to General Comment 2

The Office's intention to adopt a policy to hold a patentability review conference (panel review) during the examination process was announced in the proposed rules. *See* Notice of proposed rulemaking, Rules to Implement Optional Inter Partes Reexamination Proceedings, 65 FR 18154, 18158 (April 6, 2000), 1234 OG 93, 96 (May 23, 2000), Response to Issue 4, last paragraph. It was noted therein that, in order to provide a thorough review by a team of examiners, a practice was being considered to hold a panel review just prior to when 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 would be similar to the appeal conference review done in an application on appeal to the Board of Patent Appeals and Interferences. Upon reconsideration, it has been decided that a panel review will not be conducted just prior to the decision on the request for reexamination (order/denial) and just prior to the ''allowance'' of the reexamination, *i.e.,* issuance of a Notice of Intent to Issue a Reexamination Certificate (NIRC). A panel review is not necessary at the time of the initial determination to order/deny the request for *inter partes* reexamination. If reexamination is ordered, prosecution proceeds, and both the patent owner and the third party requester will have the opportunity to address the position of the examiner set forth in the first Office action. Further, patentability panel reviews will be conducted later in the examination of the case. If the reexamination request is denied, the third party requester has the opportunity under § 1.927 to request a *de novo* review by the TC Group Director of the examiner's decision denying reexamination. A panel review is not necessary at the time of the ''allowance'' of the reexamination because the ''allowance'' of the reexamination in an *inter partes* reexamination proceeding is essentially a ministerial act performed (a) after patent owner fails to respond to an Office action and no claims have been found patentable, (b) after a ''right of appeal notice and final rejection'' is issued, where neither party timely appeals (or the appeal is dismissed), or (c) after a final decision by the Board of Patent Appeals and Interferences or the court where no further appeal is timely taken. Accordingly, no panel review is needed just prior to the decision on the request for reexamination (order/denial) and just prior to issuance of the NIRC. Rather, the two panel reviews will be held at the critical stages of the proceeding or just prior to issuing an action closing prosecution and just prior to issuing a right of appeal notice and final rejection. Specific guidance as to policies, practice and procedure as they will apply to panel review of examiner's actions in *inter partes* reexamination proceedings will be forthcoming in a separate Official Gazette Notice to be published in conjunction with the final rules on *inter partes* reexamination.

It should further be noted that appeal conferences are already mandatory in *ex parte* reexamination proceedings just prior to issuance of an examiner's answer to an appeal to the Board of Patent Appeals and Interferences. Such appeal conferences will also be mandatory in *inter partes* reexamination proceedings. The two patentability panel reviews coupled with the appeal conference will provide three instances of multi-examiner reviews available in any *inter partes* reexamination proceeding which is prosecuted to the appeal stage.

As to the first comment's suggestion that a panel review be conducted of ''each'' action by the examiner that includes an action on the merits of the claims, the Office plans to provide oversight by a legal advisor for each such action (as discussed below in general comment 3) in order to ensure that the examiner addresses each issue presented by parties to the proceeding. This oversight, coupled with the three multi-examiner reviews available in any *inter partes* reexamination proceeding which is prosecuted to the appeal stage, should ensure a high-quality, multi-dimensional examination of the proceeding.

As to the second comment supporting the ''rule proposal'' for better review of the examiner's decisions, it should be noted that a ''rule'' was not proposed for implementation of this practice. The Notice of Proposed Rulemaking stated the practice would be implemented as a matter of policy rather than by rule.

General Comment 3: Where Reexamination is Conducted in Office

Three comments were directed to where in the Office, and by whom, the reexamination will be conducted. The first comment suggested that the *inter partes* reexamination proceeding should be conducted by a council system comprising experienced examiners.

The second comment suggested that a special Reexamination Corps be established for conducting the *inter partes* reexamination proceeding. The examiners in the special Reexamination Corps would have an independent status such as that of the members of the Board of Patent Appeals and Interferences.

The third comment expressed support for the Office's announced intention to consider the creation of a special group of legal advisors to assist the patent examiner in an *inter partes* reexamination proceeding.

Response to General Comment 3

As to the first and second comments suggesting a council system of multiple examiners, or a special ''Board'' status for the examiner, the comments are not adopted in view of the Office's intention to provide oversight by legal advisors as set forth below.

The third comment supports oversight of the examiners by legal advisors consistent with the Office's intention as announced in the proposed rules. *See* Notice of Proposed Rulemaking, Rules to Implement Optional Inter Partes Reexamination Proceedings, 65 FR 18154, 18158 (April 6, 2000), 1234 OG 93, 96 (May 23, 2000), Response to Issue 4, second paragraph. As noted therein, 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 examining group will be assigned the reexamination. The advantage of providing oversight to ensure timely, full, and appropriate treatment of all issues is that it will include (a) an examiner familiar with the technology to make the patentability decisions, and (b) legal advisors to provide uniformity of the reexamination practice and procedure. Specific guidance as to policies, practice and procedure as they will apply to policy oversight of examiner's actions in *inter partes* reexamination proceedings will be forthcoming in a separate *Official Gazette* notice to be published in conjunction with the final rules on *inter partes* reexamination.

General Comment 4: Definition of the Statutory Term ''Privies''

One comment was received directed to the statutory term ''privies.'' The term is used in 35 U.S.C. 317 to dictate which parties are prohibited from filing a reexamination, based upon action by other parties with whom they are in privity. The comment states that this important statutory term is not defined in either the statute or the rules, and is dangerously ambiguous without a definition.

Response to General Comment 4

To the extent that the comment proposed that ''privies'' be defined in the rules package, it is not adopted. 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 a party is a privy 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 facts cannot be anticipated.

It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of § 1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

General Comment 5: Incorporation of Certain Case Law Into the Rules

One comment asked whether the rules would codify the case law relating to claim construction, claim scope, the burden of establishing facts and the burden of persuasion (and their standards) as they apply to reexamination.

Response to General Comment 5

The comment is not adopted. The rules will not state how the Office should view claim construction, claim scope, the burden of establishing facts and the burden of persuasion (and their standards) in reexamination. Rather, the Office's view of these issues and other like issues will continue to track the case law which is a continually evolving body of law. Instructions to the examiner on these issues will continue to be provided in *Official Gazette* Notices and in the Manual of Patent Examining Procedure.

Discussion of Specific Rules and Response to Comments

Section 1.4(a)(2) is being amended to include *inter partes* reexamination under §§ 1.902–1.997. No comment was received on this section. It is adopted as proposed.

Section 1.6(d)(5) is being amended to include filing a request for *inter partes* reexamination under § 1.913 as an exception to the use of facsimile transmission. No comment was received on this section. It is adopted as proposed.

The Notice of Proposed Rulemaking included a proposed amendment to § 1.17 to implement § 4605(a) of the American Inventors Protection Act of 1999. This proposed amendment has, however, already been made in the final rule to implement eighteen-month publication of patent applications. See Changes to Implement Eighteen-Month Publication of Patent Applications, Final Rule, 65 FR 57024 (September 20, 2000); 1239 Off. Gaz. Pat. Office 63 (October 10, 2000). Accordingly, it is no longer necessary to make that amendment of the rule in the present *inter partes* reexamination rule package. Section 1.17 was amended in the final rule to implement eighteen-month publication 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(l) was amended to reflect 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 timely respond will require the fees of $55 for a small entity and $110 for a large entity. Also, § 1.17(m) was amended to reflect the fact that in the case of reexaminations, petitions for revival of a reexamination proceeding terminated for an unintentional failure to timely 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. No comment was received on this section. Sections 1.17(l) and (m) as proposed in the Notice of Proposed Rulemaking for the present rule package were adopted in the final rule to implement eighteen-month publication of patent applications.

Section 1.20(c) is being amended to reflect 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. For any request for *inter partes* reexamination filed prior to the effective date of this final rule, the request must be accompanied by the $2,520.00 fee for a request for reexamination set forth in § 1.20(c) (as in effect prior to the effective date of this final rule). The $6,280.00 balance of the $8,800.00 fee set forth in § 1.20(c)(2) will be due on the effective date of this final rule in any *inter partes* reexamination still pending on the effective date of this final rule. Three comments were received and directed to this section.

Comments: The first comment noted that the Office reduced the filing fee of $11,000, proposed in the 1995 proposed rules, to $8,800 in the 2000 Notice of Proposed Rulemaking, but gave no explanation for the reduction. The comment opines that the reason for the reduction was the many objections to the high fee. The comment recommends that the Office consider further reducing the fee or at least make arrangements for conducting a review of the actual costs involved in *inter partes* reexaminations after the procedure has been in effect for a reasonable amount of time.

The second comment suggested that considering the advantages and disadvantages to the third party requester involved in reexamination, the *inter partes* reexamination is not significantly more advantageous to the third party requester than is *ex parte* reexamination. The comment noted the difference between the $2,520 fee for *ex parte* reexamination and the $8,800 fee for *inter partes* and opined that the high fee will severely curtail the use of *inter*

partes reexamination. The comment suggested the third party requester should not be burdened with the full cost of *inter partes* reexamination, and that an appropriate reexamination filing fee would be less than $4,000.

The third comment suggested the $8,800 *inter partes* reexamination filing fee will be an effective barrier to an intended aim of *inter partes* reexamination, *i.e.,* to provide a viable alternative to the great cost and uncertainty of patent litigation.

Response to Comment: The first comment speculates as to why the filing fee was reduced from $11,000 as proposed in the 1995 Notice of Proposed Rulemaking to $8,800 as proposed in the 2000 Notice of Proposed Rulemaking. The fee was readjusted when, upon further analysis, the Office realized that the proposed $11,000 fee should not have included projected costs incurred by the Board of Patent Appeals and Interferences and the Solicitor's Office. Appeal fees are set by statute under 35 U.S.C. 41(a)(6) and thus are not cost recoverable as part of the reexamination filing fee under 35 U.S.C. 41(d). Accordingly, the proposed filing fee was adjusted downwardly.

As to the first comment suggesting re-evaluating the filing fee after the procedure has been in effect for a reasonable amount of time, this is required by statute. Section 4606 of S. 1948 requires the Commissioner, not later than November 29, 2004, to submit to the Congress a report evaluating whether the *inter partes* reexamination proceedings established by this legislation is inequitable to any of the parties. Such evaluation would include an analysis of the filing fee, and its burden on the third party requester.

The second comment suggests (1) that the third party requester should not be burdened with the full cost of the *inter partes* reexamination, and (2) that a reduced fee of less than $4,000 be set. The statute, however, requires that the third party requester pay the reexamination filing fee established by the Commissioner in accordance with 35 U.S.C. 41(d). Further, the reexamination fees must under 35 U.S.C. 41(d) fully recover the cost of the reexamination and the full amount of the estimated fee must be charged.

As to the second and third comments asserting that the high fee would severely curtail the use of *inter partes* reexamination, it is noted that the overall costs of requesting and participating in an *inter partes* reexamination would include, in addition to the $8,800 filing fee, the attorney/agent fees throughout the proceeding (including appeal costs) and other prosecution-related costs (testing, declarations, etc.). *Inter partes* reexaminations will be hotly-contested, adversarial proceedings. The estoppel provisions of the statute will maximize the third party requester's incentives to prevail in the reexamination. The overall cost of such proceedings to the third party requester could easily reach $50,000 to $150,000, the amount varying depending on variables such as parties, number of claims, type of evidence needed, etc. The $8,800 filing fee is not perceived to be excessive in light of the potential overall cost of an *inter partes* reexamination proceeding, and thus the filing fee would not in itself be a deterrent to the filing of a request for *inter partes* reexamination. In those instances where a member of the public deems the $8,800 cost of an *inter partes* reexamination too high for his or her needs or purposes, the filing of an *ex parte* reexamination remains available at a relatively low filing fee of $2,520. The comments are not adopted, and the section is adopted as proposed.

Section 1.25(b), which provides for charging fees to deposit accounts, is being amended to include a reference to *inter partes* reexaminations under § 1.913. No comment was received on this section. It is adopted as proposed.

Section 1.26 is being amended so as to reflect the refund to the reexamination requester where the Commissioner 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 estimated average cost of the reexamination proceeding through the denial of the reexamination request. No comment was received on this section. It is adopted as proposed.

Section 1.112 is being amended to also provide that after the patent owner response under § 1.945 and the third party requester comments under § 1.947, the patent undergoing *inter partes* reexamination will be reconsidered and again examined. Section 1.112 is being further 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). No comment was received on this section. It is adopted as proposed.

Sections 1.113 and 1.116. Section 1.113, which provides for a final rejection or action, is being 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 being amended so that the title includes a reference to an action closing prosecution and a right of appeal notice in *inter partes* reexaminations. Section 1.116(b), which provides for amendments after final action, is being amended to apply to amendments filed by the patent owner after an action closing prosecution in *inter partes* reexaminations filed under § 1.913. Also, § 1.116(b) is being amended to preclude amendments after the right of appeal notice under § 1.953 except as provided for in § 1.116(d). Section 1.116(d), which provides for amendments after the decision on appeal, is being amended to provide for amendments after the decision on appeal in an *inter partes* reexamination. One comment was directed to these sections.

Comment: The comment notes that the proposed amendments to §§ 1.113 and 1.116 are based on a version of those rules that is no longer in effect. Sections 1.113 and 1.116 were amended by virtue of the May 29, 2000 interim rule published March 20, 2000, at 65 FR 14865 to refer, *inter alia,* to the new § 1.114 and requests for continued examination. The comment suggests that it is not the intent of the reexamination rules to obviate the changes made by the May 29, 2000, interim rule and therefore the changes made by the reexamination rules should be based on the language of §§ 1.113 and 1.116 as amended by the interim rule of May 29, 2000.

Response to Comment: The comment is adopted. The final rules of this package have been revised to amend the most current version of the rules of practice.

Section 1.121(i), which provides for the manner of making amendments to the description and claims in reexamination proceedings, is being amended to specify that such amendments are made in accordance with §§ 1.530(d)—(j) in both *ex parte* reexaminations filed under § 1.510 and *inter partes* reexaminations filed under § 1.913. No comment was received on this section. It is adopted as proposed, other than to change the subsection designations for conformance with the most current version of the rules of practice as needed.

Sections 1.136(a)(2) and (b), which provide for filing extensions of time in

applications, are being amended to make it clear that § 1.956 is controlling for extensions of time in *inter partes* reexaminations. No comment was received on this section. It is adopted as proposed.

The notice of proposed rulemaking included a proposed amendment to § 1.137 to implement § 4605(a) of the American Inventors Protection Act of 1999. This proposed amendment has, however, already been made in the final rule to implement eighteen-month publication of patent applications. See Changes to Implement Eighteen-Month Publication of Patent Applications, Final Rule, 65 FR 57024 (September 20, 2000); 1239 Off. Gaz. Pat. Office 63 (October 10, 2000). Accordingly, it is no longer necessary to make that amendment of the rule in the present *inter partes* reexamination rule package. Section 1.137, which provides for revival of abandoned applications or lapsed patents, was amended in the final rule to implement eighteen-month publication 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.

In the final rule to implement eighteen-month publication, the title was amended to include a terminated reexamination proceeding. Section 1.137(a) was 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, 1865 (Comm'r Pat. 1988). Section 1.137(b) was 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 were stated by statute to become effective on November 29, 2000 (one year after enactment of the statute). Section 1.137(d) was 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 §§ 1.137(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. No comment was received on this section. Section 1.137 was adopted in the final rule to implement eighteen-month publication of patent applications in the manner as proposed in the notice of proposed rulemaking for the present rule package.

Sections 1.181(a) and (c) are being amended to reflect the fact that a petition thereunder may be filed in both *ex parte* and *inter partes* reexamination proceedings. No comment was received on this section. It is adopted as proposed.

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 being 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, § 1.191 points 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. No comment was received on this section. It is adopted as proposed.

Section 1.191 is further being amended to distinguish between (1) *ex parte* reexamination proceedings filed under § 1.510 for reexamination of patents that issued from an original application filed prior to November 29, 1999 (where an appeal is permitted when claims have been twice or finally rejected), and (2) *ex parte* reexamination proceedings filed for reexamination of patents that issued from an original application filed on or after November 29, 1999 (where an appeal is only possible when claims have been finally rejected and is not possible where claims have been twice rejected but not finally rejected). This date distinction is necessitated by the effective date of the conforming amendments made to 35 U.S.C. 134 in S. 1948 being 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 conforming amendments to 35 U.S.C. 134, 141, 143 and 145, to a reexamination of a patent that issues from an original application which is filed on or after November 29, 1999. Thus, the conforming amendments to 35 U.S.C. 134, 141, 143 and 145 apply only to those *ex parte* reexamination proceedings filed under § 1.510 for patents that issue from an original application which is filed on or after November 29, 1999. The conforming amendments do 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 prior to November 29, 1999. No comment was received on this section. It is adopted as proposed.

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 being amended to be applicable to *ex parte* reexamination proceedings filed under § 1.510 and also to indicate, that for *inter partes* reexamination proceedings filed under § 1.913, § 1.983 is controlling. No comment was received on this section. It is adopted as proposed.

Section 1.303(a) and (b), which provide for remedy by civil action under 35 U.S.C. 145 for the patent owner in a reexamination proceeding, are being amended so as to be applicable only to *ex parte* reexaminations filed under § 1.510 for patents that issue from an original application which is filed prior to November 29, 1999. This date distinction is necessitated for reasons analogous to those set forth in the discussion of § 1.191 above. Section 1.303 is further amended 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 on or after November 29, 1999, and for any *inter partes* reexamination proceedings filed under § 1.913. No comment was received on this section. It is adopted as proposed.

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 being amended so as to make it applicable to *inter partes* reexamination proceedings filed under § 1.913. No comment was received on this section. It is adopted as proposed.

The section heading (title) to subpart D and the undesignated center headings for subpart D are being amended by inserting ''*Ex Parte*'' before ''Reexamination'' to provide that the reexamination rules in this subpart generally apply to *ex parte* reexamination proceedings. Where an *ex parte* rule also applies to *inter partes*

reexamination, it is explicitly incorporated by reference into the *inter partes* reexamination rules, *e.g.,* § 1.933 (patent owner duty of disclosure) incorporates § 1.555; and § 1.943 (requirement of responses, comments and briefs) incorporates § 1.52. No comment was received on these changes. They are adopted as proposed.

Section 1.501(a), which provides for citations of prior art in patent files, is being amended to provide that a citation shall be entered in the patent file except as set forth in § 1.502 (newly created) and § 1.902. Section 1.501(a) is further amended by deleting the criteria for the processing of a prior art citation filed during an *ex parte* reexamination, and moving that criteria to § 1.502 newly created for that purpose. One comment was received directed to § 1.501.

Comment: The comment suggests the Office should re-address the prohibition on a third party from submitting prior art patents and printed publications for entry into an *ex parte* reexamination proceeding after the order to reexamine has been mailed with the prohibition applying, even where the prior art was unavailable to a third party requester at the time the *ex parte* request was filed, or known only to another member of the public. The comment argues that the present system which requires the third party to file another *ex parte* request for reexamination (which includes the new prior art) and that merger of the reexamination proceedings is a cumbersome, burdensome and time-delaying system as compared to, for example, simply permitting the entry of the new prior art and providing for one more reexamination Office action and response for new prior art found to be relevant.

Response to Comment: When promulgating the reexamination rules in 1981, it was the position of the Office that an *ex parte* proceeding best served the interests of all, and best complied with the intent of the 1980 statute. To preserve the *ex parte* nature of the proceeding, it was decided that consideration of citations of prior art submitted after the reexamination order will be delayed until the reexamination proceeding has terminated, unless the citation is submitted by the patent owner or a third party requester in a separate reexamination request or in a reply to the patent owner's statement. While the filing of a separate request for reexamination can add some delay to the proceeding, this delay would not be extensive. In contrast, permitting a third party to file citations at any time for consideration by the examiner could seriously delay the reexamination proceeding and militate against the ''special dispatch'' requirement of the statute.

New § 1.502 provides for the processing of prior art citations submitted during an *ex parte* reexamination proceeding. The substance of § 1.502 was previously contained in § 1.501(a), but was separated out as a new section for clarity. Once *ex parte* reexamination has been ordered, only citations by the patent owner under § 1.555 and by a third party requester in a filing under either § 1.510 or § 1.535 will be entered during the pendency of the reexamination proceeding. Citations by other parties (who are not a party to the reexamination) 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 unless made as a part of a request for reexamination under § 1.510.

The titles of §§ 1.510–1.570 are being amended by revising them to be limited to *ex parte* reexamination where applicable. No comment was received on these changes. They are adopted as proposed.

Section 1.510(a) is being amended to limit the section to *ex parte* reexamination proceedings. The notice of proposed rulemaking included a proposed amendment to § 1.510(b)(4) which relates to the contents of the reexamination request. This proposed amendment has, however, already been made in the final rule to implement the Patent Business Goals. See Changes to Implement the Patent Business Goals, Final Rule, 65 FR 54604 (September 8, 2000); 1238 Off. Gaz. Pat. Office 77 (September 19, 2000). Section 1.510(b)(4) was 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. Section 1.510(b)(4) is now being revised so that it applies to both *ex parte* reexamination and *inter partes* reexamination proceedings. No comment was received on this section. It is adopted as proposed.

Sections 1.515, 1.520, 1.525, 1.530, 1.535, and 1.540 are being amended to recite the reexamination as ''*ex parte*'' reexamination where appropriate, to eliminate any potential for confusion. No comment was received on these changes. They are adopted as proposed.

Section 1.530(d) is being revised so that it (and §§ 1.530(e)–(k)) apply to both *ex parte* reexamination and *inter partes* reexamination proceedings. No comment was received on this section. It is adopted as proposed.

A new § 1.530(l), directed to correction of inventorship of a patent, was added in the final rules to implement the Patent Business Goals. *See* Changes to Implement the Patent Business Goals, Final Rule, 65 FR 54604 (September 8, 2000); 1238 Off. Gaz. Pat. Office 77 (September 19, 2000). Section 1.530(l) is now being revised so that it applies to both *ex parte* reexamination and *inter partes* reexamination proceedings. Section 1.530(l) is also being revised to state ''on petition of all the parties set forth in § 1.324(b)(1)–(3)'' rather than ''on petition of all the parties'' to make it clear that all ''parties'' to the proceeding (*e.g.,* an *inter partes* reexamination third party requester) need not, and should not, join in the petition to correct inventorship.

Section 1.550, which provides for the conduct of the reexamination proceeding, is being amended to limit the section to *ex parte* reexamination proceedings filed under § 1.510. In addition, § 1.550(d) is being amended to clarify that the failure to file a written statement of an interview as required under § 1.560(b) shall be the basis for terminating a reexamination proceeding. Section 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. Section 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, that the unintentional delay provisions of 35 U.S.C. 41(a)(7) only become effective in reexamination proceedings on November 29, 2000 (one year after enactment of the statute). No comment was received on this section. It is adopted as proposed.

Section 1.552, which provides for the scope of reexamination in *ex parte* reexamination, is being amended to limit the section to *ex parte* reexamination proceedings filed under § 1.510. In addition, § 1.552(a) and (b) are being amended to more clearly

specify that all of the claims (new claims and amended patent claims) 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. Sections 1.552 and 1.906 of the present rule package were drafted to parallel the text of § 1.906 as it was presented in the August 1995 Notice of Proposed Rulemaking entitled ''Rules of Practice in Patent Cases; Reexamination Proceedings.'' Section 1.552(c) is further being amended to preclude the examiner from independently discovering and noting issues other than those indicated in §§ 1.552(a) and (b). In this regard, § 1.552(c) is being amended by changing the phrase ''If such questions are discovered during a reexamination proceeding,'' to now read ''If such issues are raised by the patent owner or third party requester.'' The examiner should only note an issue under § 1.552(c) after careful consideration, and should only note the raised issue once. Patent owners could then file a reissue application if they wish such issue to be resolved. It would not be appropriate for the examiner *sua sponte* to raise issues directed to the patentability of a claim of a patent which may not be resolved in the reexamination. No comment was received on this section. It is adopted as proposed.

Section 1.555, which sets forth the patent owner's duty of disclosure in reexamination, is being amended to clearly apply to both *ex parte* and *inter partes* reexaminations. In addition, § 1.552(c) is being amended to preclude the examiner from independently discovering and noting issues relating to patent owner's compliance with its duty of disclosure. In this regard, § 1.552(c) is being amended by changing the phrase ''If questions of compliance with this section are discovered during a reexamination proceeding, * * *'' to now read ''If questions of compliance with this section are raised by the patent owner or third party requester during a reexamination proceeding, * * * .'' It would not be appropriate for the examiner *sua sponte* to raise issues directed to the issue of patent owner's compliance with its duty of disclosure which may not be resolved in the reexamination. No comment was received on this section. It is adopted as proposed.

Section 1.560, which provides for interviews in reexamination proceedings, is being 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 being 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 within one month after the date of the interview, or as a separate part of a response to an outstanding Office action, whichever is later. One comment was received and directed to this section.

Comment: The comment suggests that when reexamination is requested by a third party, there is usually litigation directed to the patent for which reexamination is requested involving severely conflicting interests between the patent owner and the third party requester. The comment asserts that during reexamination, the examiner is required to maintain neutrality, and therefore the scope of the interview should be limited to that needed to deepen the examiner's understanding of the technology and to clarify points of contention and that the examiner should be prohibited from discussing amendment proposals during an interview with the patent owner.

Response to Comment: The statute, 35 U.S.C. 305, provides that reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In a very real sense, the intent of reexamination is to start over and reexamine the patent and examine new and amended claims as they would have been examined in the original application of the patent. Section 132 permits the patent owner to propose amendments to the claims which will be reexamined by the examiner. The procedures established for initial examination under section 132 permit the patent owner to propose amendments either by written response or during an interview with the examiner. See section 713.01 of the Manual of Patent Examining Procedure which provides guidance as to the submission of amendments in conjunction with interviews, and the rationale therefor. In both cases, the examiner is obligated to consider such amendment proposals when conducting his or her examination of the claims in light of the prior art. The comment is not adopted, and the section is adopted as proposed.

Section 1.565, which provides for concurrent Office proceedings, is being amended to limit the reexamination proceedings of the section to *ex parte* reexamination proceedings filed under § 1.510. In addition, § 1.565(e) is being amended to change ''examiner-in-chief'' to ''administrative patent judge'' to reflect the current title. Also, the appropriate references for concurrent proceedings which include an *inter partes* reexamination proceeding have been added. Section 1.565(c) is being 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. No comment was received on this section. It is adopted as proposed.

Section 1.570 is being amended to recite the reexamination as ''*ex parte*'' reexamination where appropriate, to eliminate any potential for confusion. No comment was received on this section. It is adopted as proposed.

A new title Subpart H—Inter Partes Reexamination of Patents (Applicable to any Patent that Issues from an Original Application Filed in the United States on or after November 29, 1999) has been added which provides that the reexamination rules in this subpart generally apply to *inter partes* reexamination proceedings on patents having a filing date on or after November 29, 1999. Some of the *inter partes* reexamination rules specifically incorporate *ex parte* reexamination rules, e.g., § 1.943 (requirement of responses, comments and briefs) incorporates § 1.52, and § 1.933 (patent owner duty of disclosure) incorporates § 1.555. One comment was received directed to this section.

Comment: The comment suggested that the heading ''Subpart H Reexamination of Patents'' as proposed in the Notice of Proposed Rulemaking be amended to add ''(Applicable to Patents having an Original United States Filing date On or After November 29, 1999).'' The comment notes that the effective date of the statute with respect to optional *inter partes* reexamination is complex, and it would be helpful to practitioners and those considering *inter partes* reexamination if they are clearly advised of what patents are subject to such proceedings.

Response to Comment: The comment is adopted in part. The heading has been amended to add ''(Applicable to any Patent that Issues from an Original Application Filed in the United States on or after November 29, 1999.)'' This language more closely tracks the language of the statute than does the language suggested in the comment.

New § 1.902 provides for the processing of prior art citations during

an *inter partes* reexamination proceeding and is analogous to new § 1.502 which deals with prior art citations during an *ex parte* reexamination proceeding. No comment was received on this section. It is adopted as proposed.

New § 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). No comment was received on this section. It is adopted as proposed.

New § 1.904 provides that a notice of the filing of an *inter partes* reexamination request 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. No comment was received on this section. It is adopted as proposed.

New § 1.905 provides that, unless otherwise provided for, a 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 if it complies with the requirements of § 1.501. Submissions not in accordance with § 1.501 will be returned to the sender. No comment was received on this section. It is adopted as proposed.

New § 1.906 covers the scope of reexamination in an *inter partes* reexamination proceeding. While it is not intended that examiners will routinely complete a new search when conducting an *inter partes* reexamination, 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. Section 1.906(a) provides that the examination is only on the basis of patents or printed publications and, with respect to subject matter added or deleted during the *inter partes* reexamination, on the basis of the requirements of 35 U.S.C. 112. Section 1.906(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. Section 1.906(c) provides that issues relating to matters other than those indicated in §§ 1.906(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 if such issues are raised by the patent owner or the third party requester. The examiner should only note an issue under § 1.906(c) after careful consideration, and should only raise the noted issue once. Patent owners could then file a reissue application if they wish such issue to be resolved. It would not be appropriate for the examiner *sua sponte* to raise issues directed to the patentability of a claim of a patent which may not be resolved in the reexamination. No comment was received on this section. It is adopted as proposed.

New § 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 an *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 such filing is authorized by the Commissioner. Under § 1.907(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 § 1.907(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 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 *inter partes* reexamination proceeding. Two comments were received directed to this section.

Comments: The first comment, directed to § 1.907(b), suggests that if the Office intends to determine on a case-by-case basis whether the third party requester could have raised an issue in a civil action, the phrase ''or could have raised'' should be deleted from § 1.907(b). The second comment directed to §§ 1.907(b) and (c) suggests that the words ''could have raised'' should be changed to ''had become or should have become known to that party upon reasonable inquiry at the time the *inter partes* reexamination was ordered.'' The comment argues the ''could have raised'' language would theoretically bar a third party from requesting a new reexamination based on any existing patent or printed publication, even those remotely located in another file of the third party.

Response to Comments: As to the first comment, under § 1.915(b)(7), a third party requester is required to include a certification that the estoppel provisions of § 1.907 do not prohibit the filing of the *inter partes* reexamination request. The Office does not intend to look beyond that certification. The Office does not plan to make a case-by-case determination. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

As to the second comment addressing §§ 1.907(b) and (c), the statute, 35 U.S.C. 317, recites ''on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding.'' The rule merely tracks the statutory language. Adoption of the suggested language would appear to enlarge the scope of the statutory estoppel. The interpretation of the statutory language is subject to statutory construction on a case-by-case basis depending on the particular facts of the individual case. As noted above, the Office does not intend to make such a determination in each reexamination, but will rely upon the certification by the third party requester under § 1.915(b)(7). The comments are not adopted, and the section is adopted as proposed.

New § 1.913 provides for any person (unless 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 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. The language ''other than the patent owner or its privy'' has been deleted from § 1.913. One comment was received addressed to this section.

Comment: Section 1.913, as proposed in the Notice of Proposed Rulemaking, excluded the patent owner or its privies from those persons who may file an *inter partes* request for reexamination. The comment suggests the Office has exceeded its authority in excluding the patent owner or its privies. The comment argues that Congress intended that the patent owner could be

permitted to file an *inter partes* reexamination because 35 U.S.C. 311(c), which requires the Commissioner to send a copy of the request to the patent owner, explicitly relieves the Commissioner of that obligation when the *inter partes* requester is the patent owner. The comment notes that a patent owner may feel the chances of staying a pending litigation are increased by requesting an *inter partes* reexamination, as compared to an *ex parte* reexamination, because of the provisions of 35 U.S.C. 318 (stay of litigation).

Response to Comment: The Office does not agree with the statutory interpretation presented in the comment. Portions of the language contained in sections 311, 312, 314, and 317 of the 1999 statute which suggests that the patent owner may file an *inter partes* request for reexamination are regarded as inadvertent legislative drafting errors created through the evolution of the final version of the 1999 statute. The language of the 1980 *ex parte* reexamination statute, which was used as the basis for the 1999 statute, includes language which permits either the patent owner or a third party to file a request for *ex parte* reexamination. The earlier versions of the 1999 statute merely proposed to amend the 1980 statute by making the *ex parte* reexamination more *inter partes* in nature. The final version of the 1999 statute was re-drafted at the last moment and for the first time created separate *ex parte* (chapter 30) and *inter partes* (chapter 31) reexamination statutes by modeling the *inter partes* practice on the *ex parte* practice. The drafters, however, inadvertently did not remove the language of the 1980 statute directed to patent owner filings of reexamination requests, even though an *inter partes* procedure is clearly inappropriate for a reexamination initiated by a patent owner. Note further that legislation is pending before Congress in which the noted language has been deleted or changed. *See* the Intellectual Property Technical Amendments Act of 2000, H.R. 4870, 106th Cong. (2000), which clearly limits the parties who may file an *inter partes* request for reexamination to be third parties other than the patent owner. Accordingly, the Office does not agree with the comment that the statute permits a patent owner to file an *inter partes* reexamination request.

In the interest of being consistent with the statute, the phrase ''other than the patent owner or its privies'' has been deleted from the section. The change is being made solely for the purpose of more closely following the language of the statute.

New § 1.915(a) requires payment of the fee for requesting an *inter partes* reexamination which is set forth in § 1.20(c)(2). Section 1.915(b) 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. Section 1.915(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. Section 1.915(d) provides that if the request for *inter partes* reexamination does not meet all the requirements of § 1.915(b), the third party requester may be given an opportunity to complete the *inter partes* reexamination request to avoid having the proceeding vacated. One comment was received directed to this section.

Comment: The comment noted that § 1.915(b)(8) requires any person requesting *inter partes* reexamination to specify the ''real party in interest'' in a statement. The comment asks whether this language coupled with the requirement of § 1.915(c) prohibits an attorney filing the request from being the real party in interest.

Response to Comment: Section 1.915(c) requires an attorney or agent who files a request for *inter partes* reexamination on behalf of another party to have a power of attorney or to be acting in a representative capacity under § 1.34(a). Section 1.915(c) does not preclude an attorney from filing a request for *inter partes* reexamination on behalf of himself or herself as the real party in interest. The section is adopted as proposed.

New § 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. No comment was received on this section. It is adopted as proposed.

New § 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 three months of the filing date of the request. One comment was received directed to this section.

Comment: The comment notes that section 4607 of S. 1948 provides that a third party who requests *inter partes* reexamination is estopped from challenging at a later time, in any civil action, any fact determined ''during the process of'' such reexamination. Section 1.923 provides that if the examiner determines no substantial new question of patentability is present, the examiner will deny the request and not order reexamination. The comment argues that facts determined in the decision ordering or denying reexamination are not facts determined ''during the process of'' such reexamination because a decision denying reexamination is not a decision made after full submission of all of the evidence and arguments. The comment suggests that the following sentence should be added at the end of the section in order to clearly point this out: ''Such determination does not constitute a finding of fact under the estoppel provisions of Section 4607.''

Response to Comment: Whether or not facts determined in deciding to deny or order reexamination are facts ''determined during the process of such reexamination'' is a question to be answered by the Federal courts. By statute, the estoppel arises in a civil action, not in an Office proceeding. The comment is not adopted, and the section is adopted as proposed.

New § 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. No comment was received on this section. It is adopted as proposed.

New § 1.927 provides for review by petition to the Commissioner of a decision denying *inter partes* reexamination. No comment was received on this section. It is adopted as proposed.

New § 1.931 provides for ordering *inter partes* reexamination where a substantial new question of patentability has been found pursuant to § 1.923. Section 1.931(b) places a limitation on the selection of the examiner by the Office in that the same examiner whose decision denying *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. No comment was received on this section. It is adopted as proposed.

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

with § 1.555(a) and (b). In addition, § 1.933(b) is being amended to preclude the examiner from independently raising and noting issues relating to patent owner's compliance with its duty of disclosure. In this regard, § 1.933(b) is being amended by changing the phrase ''If questions of compliance with this section are discovered during a reexamination proceeding, * * *'' to now read ''If questions of compliance with this section are raised by the patent owner or third party requester during a reexamination proceeding, * * *'' It would not be appropriate for the examiner *sua sponte* to raise issues directed to the issue of patent owner's compliance with its duty of disclosure which may not be resolved in the reexamination. No comment was received on this section. It is adopted as amended.

New § 1.935 provides that the initial Office action on the merits will usually accompany the *inter partes* reexamination order. When reexamination is ordered, the initial paper from the examiner will normally comprise two parts. The first part will address the issue as to whether the cited art raises a substantial new question of patentability (SNQ). 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 would usually be issued, which would address the patentability issues and will constitute the first Office action on the merits. If the examiner determines that the cited art does not raise an SNQ, reexamination is denied. No patentability question would be addressed by the examiner. One comment was received directed to this section. (This comment was also addressed to § 1.945 relating to patent owner's response to Office actions. The discussion below relates to both §§ 1.935 and 1.945.)

Comment: The comment notes that if the examiner refuses to adopt a ground of rejection proposed by the third party, the patent owner is not required to address this issue prior to the appeal stage. Consequently, if the refusal to adopt the ground of rejection is reversed on appeal to the Board of Patent Appeals and Interferences (Board), at that time the patent owner is given an opportunity to amend the claim. The comment suggests that, prior to the appeal stage, the patent owner should be required to respond to all of the issues raised by the requester. The comment points out that if this suggestion is implemented, the opportunity for amendment after the Board decision and the need for remand would then become unnecessary, even if the Board adopts any ground proposed by the third party requester.

Response to Comment: The patent owner has no legal compulsion to amend a claim based solely on a ground of rejection raised by the third party requester. Only after the ground of rejection is adopted by the examiner or the Board of Patent Appeals and Interferences must the patent owner consider amending the claim. The comment is not adopted, and § 1.935 is adopted as proposed. (See discussion of § 1.945.) New § 1.937 covers the basic items relating to the conduct of *inter partes* reexamination proceedings. Section 1.937(a) provides that, in accordance with 35 U.S.C. 314(c), unless otherwise provided by the Commissioner for good cause, all *inter partes* reexamination proceedings will be conducted with special dispatch. Section 1.937(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 generally follow the procedures for examining patent applications. Section 1.937(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. No comment was received on this section. It is adopted as proposed.

New § 1.939 provides for the return of unauthorized papers filed in an *inter partes* reexamination, and provides that, unless otherwise authorized, no paper shall be filed, by any party, in an *inter partes* reexamination before the initial Office action on the merits. No comment was received on this section. It is adopted as proposed.

New § 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)–(k) and 1.943. No comment was received on this section. It is adopted as proposed.

New § 1.943(a) provides that the form of responses, briefs, appendices, and other papers must be in accordance with § 1.52. Section 1.943(b) establishes 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 the page count. Section 1.943(c) provides for page limits and total word limits for briefs. No comment was received on this section. It is adopted as proposed.

New § 1.945 provides that a patent owner will be given at least 30 days to respond to any Office action on the merits. While the Office ordinarily intends to set a two-month period for the patent owner to respond to an Office action on the merits, the minimum period set will always be at least 30 days. One comment was received directed to this section. This comment was also addressed to § 1.935 relating to the patent owner's response to the initial Office action. The comment is not adopted, and § 1.945 is adopted as proposed.

New § 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 if those comments are received in the Office 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 period cannot be extended. Thus, any third party comments received in the Office after expiration of 30 days from the date of service of the patent owner's response shall be considered to be untimely and unauthorized, and thus will be returned to the third party in accordance with § 1.939. Three comments were received directed to this section.

Comments: The first and second comments suggest that it will be difficult for a foreign third party requester to timely comment within a period of 30 days from the date of service of the patent owner's response. The first comment suggests that a third party comment period of 60 days should be set. The second comment suggests that some way should be devised for receiving a substantial extension to the 30-day period.

The third comment suggests that it is unfair for the patent owner to not be able to respond to the third party comments and thereby have the last word. The comment suggests that the patent owner should have the right of last comment.

Response to Comments: As to the first comment, the statute (35 U.S.C. 314(b)(3)) specifically requires that the third party requester comments be received by the Office within 30 days after the date of service of the patent owner's response to an Office action. The rules cannot provide a period for comments that would give the third party more time to comment than that explicitly stated in the statute.

As to the second comment, because the statute specifically requires that third party requester comments be received by the Office within 30 days

after the date of service of a patent owner's response to the Office action, the rules cannot extend the period for comments in order to give the third party more time in which to file the written comments. The Office recognizes the shortness of this time period. While no relief can be granted by enlarging or extending the statutory 30-day period, a measure of relief has been granted to the third party requester in that the rule is being amended to provide that the date of Office ''receipt'' of third party requester comments will be construed to be the date of mailing if the provisions of § 1.8 are complied with when submitting the written comments.

As to the third comment, providing the patent owner with an opportunity to reply to third party comments would unduly prolong the pendency of the proceeding, contrary to the ''special dispatch'' required by 35 U.S.C. 314(c). It should also be noted that an owner response to the third party comments could be considered a (supplemental) patent owner response to the Office action which would trigger a further right to third party comment under 35 U.S.C. 316(b)(3) and thus create an endless cycle. The comments are not adopted. The rule is adopted as proposed, but amended as indicated above.

New § 1.948 provides that 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 or 1.951(b), and are limited to: (1) Prior art necessary to rebut a finding of fact made by the examiner; (2) prior art necessary to rebut a position taken by the patent owner in a response; or (3) prior art which for the first time 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. Limiting later filed 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 during the *inter partes* reexamination proceeding will obviate the need for the third party requester 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 together with written comments 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. No comment was received on this section. The conjunction ''and'' has been replaced by ''or'' in the recitation ''§§ 1.947, 1.951(a), or 1.951(d)'' for grammatical clarity. The reference to § 1.951(a) has been deleted and § 1.951(d) has been changed to § 1.951(b) to reflect the changes made to § 1.951 pursuant to the comments. The section is adopted as amended.

New § 1.949 provides for the close of prosecution on the second or subsequent Office action which precedes a final action, a final rejection and/or a final decision favorable to patentability. The distinction between a final action and an action closing prosecution is important, since 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. One comment was received directed to this section.

Comment: The comment suggests that the examiner should be precluded from closing prosecution whenever a new ground of rejection is made, irrespective of whether a prior amendment made the new ground necessary. The comment argues that a reexamination is different from an application where the applicant is permitted to refile the application and introduce new claims, evidence and argument, because the patent owner in a reexamination cannot abandon the reexamination and file a continuing proceeding.

Response to Comment: The third party request for reexamination sets forth the grounds of rejections raised by the third party requester. The initial Office action on the merits addresses the grounds and arguments raised in the request, and sets forth the examiner's grounds of rejection including those raised by the third party requester and those raised by the examiner. The Office action also includes the examiner's reasons for not adopting other grounds of rejection proposed by the third party requester. Patent owner may consider and respond to the initial Office action, and provide amended claims ranging from the broadest claim patent owner considers to be patentable over the prior art to the narrowest claim patent owner is willing to accept. Thus, prior to the close of prosecution, the issues are well developed, patent owner is aware of the issues and positions of the third party requester and the examiner, and patent owner has the right to present evidence and argument in light of the third party arguments and the examiner's rejections and to present amended claims. While patent owner may not refile a reexamination after the close of prosecution and ''start over'' as can be done in a regular application after a final rejection, the reexamination rules do not leave the patent owner without any relief at this stage of the proceeding. In this regard, after the close of prosecution the patent owner may file comments and/or amendments under § 1.951 which will be governed by the standards of § 1.116. Under § 1.116(c), amendments may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented. This strikes a balance between timely presenting amendments and providing relief when warranted. It also provides for an orderly and timely proceeding under the special dispatch requirement of the statute. In addition, the statute does not preclude the patent owner from filing an *ex parte* request for reexamination with amended claims and/or new evidence. Once ordered, the reexamination proceedings would be merged, and the newly submitted material would be addressed in the merged proceeding. The comment is not adopted, and the section is adopted as proposed.

New § 1.951 sets forth the options available to the parties after an Office action closing prosecution. Under § 1.951(a), the patent owner may once file comments limited to issues raised in the action closing prosecution, which comments may also include proposed amendments (subject to the criteria of § 1.116 as to whether or not the amendments shall be admitted). Under § 1.951(b), when the patent owner does file comments, the third party requester may once file comments in response to the patent owner's comments. One comment was received directed to this section.

Comment: Section 1.951 as proposed in the Notice of Proposed Rulemaking included subsections (a)–(d). Proposed subsection (a) permitted the third party requester to once file comments limited to issues raised in the action closing prosecution. Proposed subsection (b) permitted the patent owner to once file comments in response to the third party requester's comments. Simultaneously to the filing of these submissions, proposed subsection (c) permitted the

patent owner to once file comments limited to issues raised in the action closing prosecution, and proposed subsection (d) permitted the third party requester to once file comments in response to the patent owner's comments. The comment suggests that the comments filed by the third party requester under proposed § 1.951(a) after the close of prosecution do not comply with the statute because they are not filed in reply to a patent owner's response to an Office action on the merits. The comment asserts that such ''direct'' requester comments are not consistent with the statute as the statute makes it clear that the third party requester's right to comment only matures with the filing of a patent owner response to an Office action on the merits, and nowhere in the statute does it permit third party requester comments without there first being a patent owner response.

Response to Comment: The comment has been adopted. Proposed subsection (a) which permitted the third party requester to once file comments limited to issues raised in the action closing prosecution, and proposed subsection (b) which permitted the patent owner to once file comments in response to the third party requester comments have been deleted. Proposed subsections (c) and (d) have been re-named (a) and (b), respectively. The purpose of proposed subsections (a) and (b) was to provide the third party requester an opportunity to better focus the issues prior to filing an appeal. Such issues may now be addressed by the requester after appeal in the appellant brief which, if persuasive, will result in the examiner adopting requester's arguments and reopening prosecution, if appropriate. While waiting until after appeal to permit ''direct'' third party requester arguments may result in protracting the proceeding, such direct third party input is consistent with the statute which permits the third party requester to appeal any final decision favorable to patentability, and be a party to any appeal taken by the patent owner to the Board of Patent Appeals and Interferences. 35 U.S.C. 315(a) and (b). The comment is adopted as amended.

New § 1.953 provides for issuance of a right of appeal notice. Section 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. Section 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 decision 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. Section 1.953(c) provides that the right of appeal notice shall be a final action, which would include a final rejection and/or a final decision favorable to patentability, and prohibits amendments under § 1.116 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 Commissioner will proceed to issue a certificate under § 1.997 in accordance with the right of appeal notice. No comment was received on this section. It is adopted as proposed.

New § 1.955 provides that interviews which discuss the merits of the proceeding will not be permitted in *inter partes* reexamination proceedings. Thus, in an *inter partes* reexamination proceeding, no separate *ex parte* interviews will be permitted, and no *inter partes* interviews will be permitted; nor will an informal amendment be accepted as that would be tantamount to an *ex parte* interview. 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. 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 would participate. Accordingly, neither the patent owner nor the third party requester in an *inter partes* reexamination is permitted to initiate, or participate in, an *ex parte* interview or an *inter partes* interview which discusses the merits of the proceeding. Four comments were received directed to this section.

Comments: The first comment asserts that because the *inter partes* reexamination may result in the cancellation of patent claims or the estoppel of one or more third party defenses in a civil action, the examiner should have access to all matters that may be necessary to reach a decision, including the testimony of experts, particularly in the face of cross-examination. Further, the comment suggests that the patent owner is forced into an *inter partes* reexamination and should not be deprived of patent rights without due process of law. The comment suggests that interviews should be provided during which each party should be permitted to present its case orally to the examiner, to present its experts and to question the other party and the other party's experts in front of the examiner, and that the examiner, in turn, should have the opportunity to question both parties and their experts.

The second comment recognizes the concerns of the Office but concludes that since the rule could be waived in appropriate circumstances, the rule does not amount to an absolute prohibition. The comment suggests interviews be permitted, particularly if they could be handled through the assistance of a special group of legal advisors trained in conducting *inter partes* hearings. The comment further suggests a rule be imposed that any oral or electronic contact with Office officials responsible for an *inter partes* proceeding be handled through a conference call with all relevant parties represented.

The third comment suggests that it is unnecessary to ban interviews across the board because an interview can be useful to help the examiner understand the points of contention, particularly so when the art is complex. If the presence of a third party requester would complicate the interview, the examiner could simply interview the parties separately. The comment suggests that since there are usually severely conflicting interests between the patent owner and the third party requester, the interview should be limited to deepening the examiner's understanding of the technology and to clarifying points of contention; the examiner should be prohibited from discussing amendment proposals.

The fourth comment suggests that while the prohibition against interviews would seem to be quite beneficial to the third party requester, a countervailing problem for the examiner and the patent owner will be an inability of the examiner to resolve complex technological issues by direct questions and answers (in an interview). The comment suggests that guidelines to the examiner on how to address such issues in the form of written questions should

be provided in the Manual of Patent Examining Procedure (MPEP).

Response to Comments: The comments suggest various formats for providing an interview including: a formal hearing format, interview oversight by trained legal advisors, conference calls, separate interviews for both parties, and limitations on the examiner from discussing amendments during an interview. While the suggested formats would tend to ease the problems associated with *inter partes* interviews, the remaining problems would still outweigh the benefits of an interview on the merits. No matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it. Past history has shown *inter partes* interviews to be both resource intensive and unwieldy. *Inter partes* interviews are difficult to arrange, conduct, and control. Inevitable 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'' would be difficult to regulate and control. Recording the substance of the interview would be difficult, and providing 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, which would be clearly contrary to the ''special dispatch'' required by 35 U.S.C. 314(c) for the *inter partes* reexamination proceeding. The suggestion as to providing guidelines on instructing the examiner on how to draft written questions is a matter to be addressed in a future MPEP revision. The comments are not adopted, and the section is adopted as proposed.

New § 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. No comment was received on this section. It is adopted as proposed.

New § 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. Sections 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. New § 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. No comment was received on this section. It is adopted as proposed.

New § 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. New § 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). No comment was received on this section. It is adopted as proposed.

New § 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. No comment was received on this section. It is adopted as proposed.

New § 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. No comment was received on this section. It is adopted as proposed.

New § 1.962 relates to the definition of appellant and respondent in *inter partes* reexamination proceedings. No comment was received on this section. It is adopted as proposed.

New § 1.963 relates to the time periods for filing briefs in *inter partes* reexamination proceedings. No comment was received on this section. It is adopted as proposed.

New § 1.965 relates to the requirements of the appellant brief in *inter partes* reexamination proceedings. No comment was received on this section. It is adopted as proposed.

New § 1.967 relates to the requirements of the respondent brief in *inter partes* reexamination proceedings. No comment was received on this section. It is adopted as proposed.

New § 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. One comment was received directed to this section.

Comment: The comment questioned whether the examiner's answer should be optional especially when the appeal is by the patent owner.

Response to Comment: Although § 1.969(a) indicates that an examiner's answer ''may'' be furnished, common practice as set out in the procedure of the Manual of Patent Examining Procedure, is to furnish an examiner's answer. When an appeal goes forward, an examiner's answer will be mandatory. If the examiner, however, changes his or her position to issue a new ground of rejection or (when the third party participates in the appeal) to make a new finding of patentability, an examiner's answer would not be issued and prosecution would be reopened. The word ''may'' is used to cover those situations where prosecution is reopened and an examiner's answer is not issued. The word ''may'' does not authorize an examiner to send a proceeding to the Board of Patent Appeals and Interferences without issuing an examiner's answer. Section 1.969(c) is being modified by deleting ''Where a third party requester is a party to the appeal'' and a new § 1.969(d) is being added which provides clarification that any new ground of rejection or new determination not to make a proposed rejection must be made in an action reopening prosecution in accordance with the discussion of proposed § 1.969 in the notice of proposed rulemaking. The comment is not adopted and the section is adopted as modified in new § 1.969(d).

New § 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. One comment was received directed to this section.

Comment: The comment, notes that the time for filing the rebuttal brief is within one month of the examiner's answer and suggests that since the examiner's answer is not required by the rules, tying one deadline date to another date for an event that may never occur may create a problem.

Response to Comment: Although § 1.969(a) indicates that an examiner's answer ''may'' be furnished, common practice as set out in the procedure of the Manual of Patent Examining Procedure, is to furnish an examiner's answer. When an appeal goes forward, an examiner's answer will be mandatory. See the discussion set forth in response to the comment on § 1.969 above. The comment is not adopted and the section is adopted as proposed.

New § 1.973 relates to the oral hearing in *inter partes* reexamination proceedings. One comment was received directed to this section.

Comment: The comment points out that the request for oral hearing may be filed ''within one month of the examiner's answer,'' and that the rules provide that the examiner ''may'' issue an examiner's answer under 1.969(a). The comment questions what happens if the examiner does not issue an examiner's answer? The comment suggests the rule should be modified to provide that a request for oral hearing be due ''within two months after the date of the examiner's answer or the period within which the examiner's answer must be furnished.''

Response to Comment: Although § 1.969(a) indicates that an examiner's answer ''may'' be furnished, common practice as set out in the procedure of the Manual of Patent Examining Procedure, is to furnish an examiner's answer. When an appeal goes forward, an examiner's answer will be mandatory. See the discussion set forth in response to the comment on § 1.969 above. The comment is not adopted and the section is adopted as proposed.

New § 1.975 relates to affidavits or declarations after appeal in *inter partes* reexamination proceedings. No comment was received on this section. It is adopted as proposed.

New § 1.977 relates to the decision by the Board of Patent Appeals and Interferences (Board) in *inter partes* reexamination proceedings. This section generally tracks § 1.196 which governs the Board's decision in an appeal in an application. Section 1.977(a) provides that a reversal of an examiner's decision favorable to patentability (*i.e.,* the reversal of the examiner's 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). Section § 1.977 as set forth in the notice of proposed rulemaking included a § 1.977(c) which permitted the Board to include a statement that a claim may be allowable in amended form if newly revised as proposed by the Board. Proposed § 1.977(c), however, has been deleted in light of the comment and discussion that follows.

Comment: The comment notes that under 1.977(c), as proposed, the Board of Patent Appeals and Interferences (Board) may suggest an amendment for allowing a claim. The comment suggests that procedures would be too complicated to implement in the *inter partes* proceeding.

Response to Comment: The comment is adopted. Providing for patent owner and third party comment on a Board determination of the patentability of a hypothetical amended claim appears to be unduly complicated so late in the proceedings. Section 1.977(c) as proposed in the notice of proposed rulemaking has been deleted. Sections 1.977(d)–(h) as proposed in the notice of proposed rulemaking have been redesignated §§ 1.977(c)–(g), respectively, and references to these subsections in other sections have been revised to reflect these changes.

New § 1.979 relates to the procedure following the decision or dismissal by the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings. No comment was received on this section. It is adopted as proposed.

New § 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. No comment was received on this section. It is adopted as proposed.

New § 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 35 U.S.C. 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 35 U.S.C. 134(c), the third party requester in *inter partes* reexamination proceedings may not appeal the decision of the Board of Patent Appeals and Interferences. No comment was received on this section. It is adopted as proposed.

New § 1.985 relates to notification of prior or concurrent proceedings in *inter partes* reexamination proceedings. Section 1.985(a) requires the patent owner to notify the Office of any prior or concurrent proceeding involving the patent under *inter partes* reexamination. Section 1.985(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. No comment was received on this section. It is adopted as proposed.

New § 1.987 provides that when a patent involved in an *inter partes* reexamination is concurrently involved in litigation, the Commissioner shall determine whether or not to suspend the *inter partes* reexamination proceeding. No comment was received on this section. It is adopted as proposed.

New § 1.989 relates to the merger of concurrent reexamination proceedings. One comment was received directed to this section.

Comment: The comment suggests that if a third party requester in an *inter partes* reexamination files a subsequent *ex parte* reexamination request, the proceedings should not be merged, but rather the *ex parte* reexamination should be stayed. The comment argues that a third party requester in an *inter partes* reexamination should not be permitted to end-run the prohibition of 35 U.S.C. 317(a) (which prohibits a subsequent *inter partes* reexamination during the pendency of an ongoing *inter partes* reexamination) by filing a subsequent *ex parte* reexamination request.

Response to Comment: As to the suggestion that the subsequent *ex parte* reexamination be stayed, this would be in direct violation of the special dispatch requirement of the *ex parte* reexamination statute. *Ethicon* v. *Quigg,* 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). Moreover, the filing of an *ex parte* reexamination request by an *inter partes* third party requester is not an ''end-run'' of the prohibition of 35 U.S.C. 317(a), because the two

proceedings are of a different nature, and thus, the filing of the *ex parte* reexamination is not the same as the filing of a second *inter partes* reexamination. The comment is not adopted and the section is adopted as proposed.

New § 1.991 relates to the merger of a concurrent reissue application and an *inter partes* reexamination proceeding. Two comments were received directed to this section.

Comments: The first comment suggests that if the patent owner is permitted to request an interview in a merged reissue and *inter partes* reexamination, then the third party requester should be permitted to do so equally as well.

The second comment notes that the third party requester is permitted by rule in a merged reexamination and reissue to participate to the extent permitted by the reexamination rules and be limited to issues within the scope of *inter partes* reexamination. The comment questions whether this is realistic and asks (1) whether this limitation precludes a third party from acting as a protestor in the merged reissue application regarding the full scope of issues raised in the merged proceeding; and (2) since the patent owner filed the reissue, why should the third party be precluded from participating as a protestor? The comment suggests a better approach would be to permit the third party to comment on any issue, so long as it was in accord with the procedures adopted for the conduct of the merged proceeding for third parties or protestors.

Response to Comments: The first comment suggests that if the patent owner is permitted to request an interview in a merged reissue and *inter partes* reexamination, the Office should also permit the third party requester to initiate an interview in the merged proceeding. The suggestion is moot, since the patent owner will not be permitted to request an interview in a merged reissue and *inter partes* reexamination for the reasons set forth in the discussion of § 1.955 above.

As to the second comment, the rule does not preclude the third party requester from filing a protest under § 1.291 in the reissue application in the merged proceeding directed to any issue, including issues other than those relating to patent and printed publications. Such protests would be governed by the procedures adopted for protestors set forth in Chapter 1900 of the Manual of Patent Examining Procedure (MPEP). Participation in issues raised under § 1.291 will be governed by § 1.291 and the procedures adopted for protestors in MPEP 1901 through 1907. To the extent that the second comment would permit the third party requester to ''comment'' (as opposed to filing a protest) on any issue, so long as it was in accord with the procedures adopted for the conduct of the merged proceeding for third parties or protestors, the comment will not be adopted. The right to file a protest is limited as stated in MPEP chapter 1900. Thus, the permitted challenge to the patent on ''any issue'' is limited. To permit third party requester ''comments'' on ''any issue'' would increase the pendency of the proceeding contrary to special dispatch required by the statute, and would permit harassment of the patent owner on ''any issue'' in ways that the Chapter 1900 limitations on protest submissions are designed to prevent (i.e., multiple submissions on the same issue). The comments are not adopted.

New § 1.993 relates to the suspension of a concurrent interference or an *inter partes* reexamination proceeding. No comment was received on this section. It is adopted as proposed.

New § 1.995 relates to the third party requester's participation rights being preserved in a merged proceeding. No comment was received on this section. It is adopted as proposed.

New § 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 canceled 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. No comment was received on this section. It is adopted as proposed.

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 in this notice will 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 (§§ 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 in this notice will 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 percent or 220 have been filed by third party requesters. Since the beginning of the reexamination procedure, about 22.5 percent 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 USPTO, 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 of Patent Appeals and Interferences. 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 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 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 U.S. 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 U.S. Patent and Trademark Office is submitting this information collection to OMB for its review and approval because this notice of 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 rulemaking is to implement the changes to Office practice necessitated by title IV, subtitle F (§§ 4601 through 4608) of the American Inventors Protection Act of 1999 (enacted into law by § 1000(a)(9), division B, of Public Law 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, Office of Patent Legal Administration, U.S. 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 U.S. Patent and Trademark Office.

Notwithstanding any other provision of law, no person is required to respond to or 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 recordkeeping requirements, Small businesses.

For the reasons set out in the preamble and under the authority given to the Commissioner of Patents and Trademarks by 35 U.S.C. 2(b)(2), 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 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), unless otherwise noted.

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

§ 1.6 Receipt of Correspondence.

* * * * *

(d) * * *

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

* * * * *

4. Section 1.20(c) is 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

(2) For filing a request for *inter partes* reexamination (§ 1.915(a))—$8,800.00

* * * * *

5. Section 1.25(b) is 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 a particular paper 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. An authorization to charge fees under § 1.16 in an application submitted under § 1.494 or § 1.495 will be treated as an authorization to charge fees under § 1.492. An authorization to charge fees set forth in § 1.18 to a deposit account is subject to the provisions of § 1.311(b). 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 in a patent may also be filed with the request for reexamination.

6. Section 1.26(c) is revised to read as follows:

§ 1.26 Refunds.

* * * * *

(c) If the Commissioner 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. The 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.

7. Section 1.112 is revised to read as follows:

§ 1.112 Reconsideration before final action.

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an *inter partes* reexamination requester (§ 1.947), 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 (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 1.191) has been taken (§ 1.116), or in an *inter partes* reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

8. Section 1.113(a) is 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 § 1.114 or § 1.116. Petition may be taken to the Commissioner 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 comply with § 1.114 or paragraph (c) of this section. For final actions in an *inter partes* reexamination filed under § 1.913, see § 1.953.

* * * * *

9. Sections 1.116(b) and (d) are revised to read as follows:

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

* * * * *

(b) 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 (d) of this section.

* * * * *

(d) 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.

10. Section 1.121(i) is revised to read as follows:

§ 1.121 Manner of making amendments.

* * * * *

(i) *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)–(j).

11. Sections 1.136(a)(2) and (b) are 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 affect 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.

* * * * *

12. Sections 1.181(a) and (c) are revised to read as follows:

§ 1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner:

(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 Commissioner; and

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. 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 Commissioner 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 to the petitioner.

* * * * *

13. Section 1.191(a) is 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.

* * * * *

14. Section 1.301 is 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 Commissioner (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.

15. Section 1.303 is 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.

16. Sections 1.304(a)(1) and (a)(2) are 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) Fourteen 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).

* * * * *

17. The section heading for subpart D is revised to read as follows:

Subpart D—Ex Parte Reexamination of Patents

* * * * *

18. Section 1.501 is amended by revising paragraph (a) to read as follows:

§ 1.501 Citation of prior art in patent 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 §§ 1.502 and 1.902.

* * * * *

19. New § 1.502 is added to read as follows:

§ 1.502 Processing of prior art citations during an *ex parte* reexamination proceeding.

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 and reexamination files during an *inter partes* reexamination proceeding filed under § 1.913.

20. The undesignated center heading immediately preceding § 1.510 is revised as follows:

Request for *Ex Parte* Reexamination

21. Section 1.510 is amended by revising its heading and paragraph (a) 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).

* * * * *

22. Section 1.515 is amended by revising its heading and the text 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, 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 Commissioner 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.

23. Section 1.520 is amended by revising its heading and the text to read as follows:

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

The Commissioner, 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 Commissioner or which have been brought to the Commissioner's attention, even though no request for reexamination has been filed in accordance with § 1.510 or § 1.913. The Commissioner 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 Commissioner 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).

24. The undesignated center heading following § 1.520 is revised to read as follows:

Ex Parte Reexamination

25. Section 1.525 is amended by revising its heading and the text of paragraphs (a) and (b) 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.

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

§ 1.530 Statement by patent owner in *ex parte* reexamination; amendment by patent owner in *ex parte* or *inter partes* reexamination; inventorship change in *ex parte* 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) *Making amendments in a reexamination proceeding.* A proposed amendment in an *ex parte* or an *inter partes* reexamination proceeding is made by filing a paper directing that proposed specified changes be made to the patent specification, including the claims, or to the drawings. An amendment paper directing that proposed specified changes be made in a reexamination proceeding may be submitted as an accompaniment to a request filed by the patent owner in accordance with § 1.510(e), as part of a patent owner statement in accordance with paragraph (b) of this section, or, where permitted, during the prosecution of the reexamination proceeding pursuant to § 1.550(a) or § 1.937.

* * * * *

(l) *Correction of inventorship in an ex parte or inter partes reexamination proceeding.*

(1) When it appears in a patent being reexamined that the correct inventor or inventors were not named through error without deceptive intention on the part

of the actual inventor or inventors, the Commissioner may, on petition of all the parties set forth in § 1.324(b)(1)–(3), including the assignees, and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), or on order of a court before which such matter is called in question, include in the reexamination certificate to be issued under § 1.570 or § 1.977 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding and must satisfy the requirements of § 1.324.

(2) Notwithstanding the preceding paragraph (1)(1) of this section, if a petition to correct inventorship satisfying the requirements of § 1.324 is filed in a reexamination proceeding, and the reexamination proceeding is terminated other than by a reexamination certificate under § 1.570 or § 1.977, a certificate of correction indicating the change of inventorship stated in the petition will be issued upon request by the patentee.

27. Section 1.535 is 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.

28. Section 1.540 is 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.

29. Section 1.550 is 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, 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. In response to any rejection, such response may include further statements and/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 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 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 Commissioner 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 Commissioner 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).

30. Section 1.552 is 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 consider the advisability of filing a reissue application to have such issues considered and resolved.

31. Section 1.555 is amended by revising its heading and paragraph (c) to read as follows:

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

* * * * *

(c) 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 raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.552(c).

32. Section 1.560 is 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 Commissioner. 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. Interviews should be arranged 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.

33. Section 1.565 is 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 must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, *inter partes* reexaminations, 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 Commissioner 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 in the prior *ex parte* reexamination proceeding 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 Commissioner may suspend the reexamination or the interference. The Commissioner 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.

34. The undesignated center heading following § 1.565 is revised to read as follows:

Ex Parte Reexamination Certificate

35. Section 1.570 is 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 Commissioner 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 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.

36. A new subpart H is added to read as follows:

Subpart H—*Inter Partes* Reexamination of Patents That Issued From an Original Application Filed in the United States on or After November 29, 1999

Sec.

Prior Art Citations

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

Subpart H—*Inter Partes* Reexamination of Patents That Issued From an Original Application Filed in the United States on or After November 29, 1999

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. See § 1.502 for processing of prior art citations in patent and reexamination files during an *ex parte* reexamination proceeding filed under § 1.510.

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 the 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 Commissioner.

(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 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 forth 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) through (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 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 subsection 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, 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 Commissioner 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 raised by the patent owner or the third party requester 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 Commissioner 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)–(k) 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 § 1.52.

(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's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen 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 thirty 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 pursuant to § 1.945, 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. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

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

(a) 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 or § 1.951(b) and is limited 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 for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

(b) [Reserved].

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

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability 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 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.

(b) 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 comprises 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 Commissioner 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 be no 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 Commissioner 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 Commissioner that the delay was unavoidable. A grantable 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 be accepted if the delay was unintentional. A grantable 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, 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, 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 appealed claim(s) and must be signed by the patent owner, the 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 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 Commissioner may *sua sponte* order the *inter partes* reexamination proceeding remanded to the examiner for action consistent with the Commissioner'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's brief of the patent owner, or the patent owner responding under § 1.967 to the appellant's 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's brief in an *inter partes* reexamination must be filed no later than two months from the latest 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's brief may not be extended.

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

(c) The examiner will consider both the appellant's and respondent's 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's 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) A party's appeal shall stand dismissed upon failure of that party to file an appellant's brief, accompanied by the requisite fee, within the time allowed.

(c) The appellant's 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.

(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 inventor regards 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. If appropriate, also state the specific limitations in the appealed claims which are or are not described in the prior art and 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. The argument should 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's brief in *inter partes* reexamination.

(a) Respondent(s) in an *inter partes* reexamination appeal may once, within the 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 state 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.

(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. 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, 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) of these regulations shall apply to any argument raised under 35 U.S.C. 102 or sec. 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 Commissioner, 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) An examiner's answer may not include a new determination not to make a proposed rejection of a claim.

(d) Any new ground of rejection, or any new determination not to make a proposed rejection, must be made in an Office action reopening prosecution.

§ 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. 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, as well as the primary examiner. The notice shall set a non-extendable 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. 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.

(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) Where the patent owner has responded under paragraph (b)(1) 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.

(d) Following any response by the patent owner under paragraph (b)(1) of this section and any written comments from a third party requester under paragraph (c) of this section, the reexamination proceeding will be remanded to the examiner. 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. The examiner will consider any response under paragraph (b)(1) of this section and any written comments by a third party requester under paragraph (c) of this section and issue a determination that the rejection should be maintained or has been overcome.

(e) Within one month of the examiner's determination pursuant to paragraph (d) 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. No third party requester reply may address the comments of any other third party requester reply. 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.

(f) After submission of any comments and any reply pursuant to paragraph (e) of this section, or after time has expired, 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 will incorporate the earlier decision, except for those portions specifically withdrawn.

(g) The time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956. The time periods set forth in paragraphs (c) and (e) of this section 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

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

(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. This 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, file a further request for rehearing of the new decision under this subsection.

(d) Any request for rehearing shall state 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 Commissioner 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 Commissioner, 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.

(a) 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 Commissioner 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 Commissioner 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 and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, 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 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 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 through 1.997, except that 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 Commissioner may suspend the *inter partes* reexamination or the interference. The Commissioner 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 Commissioner 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 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: November 21, 2000.

Q. Todd Dickinson,

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

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