

Executive Order (E.O.) 12866

The Department of the Interior (DOI) reviewed this proposed rule under E.O. 12866 and determined that this document is not a significant rule.

Regulatory Flexibility Act

The DOI has determined that this proposed rule will not have a significant economic effect on a substantial number of small entities. Any direct effects of this rulemaking will primarily affect OCS lessees and operators—entities that are generally not small due to the technical complexities and financial resources necessary to conduct OCS activities.

Paperwork Reduction Act

The Office of Management and Budget (OMB) approved the collections of information contained in this proposed rule under 44 U.S.C. 3501 et seq., and assigned clearance numbers 1010-0050 and 1010-0006.

Takings Implication Assessment

The DOI certifies that the proposed rule does not represent a governmental action capable of interference with constitutionally protected property rights. This action does not require a Takings Implication Assessment prepared pursuant to E.O. 12630, Government Action and Interference with Constitutionally Protected Property Rights.

E.O. 12778

The DOI has certified to OMB that this proposed rule meets the applicable civil justice reform standards provided in Sections 2(a) and 2(b)(2) of E.O. 12778.

National Environmental Policy Act

The DOI has determined that this action does not constitute a major Federal action significantly affecting the quality of the human environment; therefore, this action does not require the preparation of an Environmental Impact Statement.

List of Subjects*30 CFR Part 250*

Continental shelf, Environmental impact statements, Environmental protection, Government contracts, Incorporation by reference, Investigations, Mineral royalties, Oil and gas development and production, Oil and gas exploration, Oil and gas reserves, Penalties, Pipelines, Public lands—mineral resources, Public lands—rights-of-way, Reporting and recordkeeping requirements, Sulphur development and production, Sulphur exploration, Surety bonds.

30 CFR Part 256

Administrative practice and procedure, Continental shelf, Government contracts, Incorporation by reference, Oil and gas exploration, Public lands—mineral resources, Reporting and recordkeeping requirements, Surety bonds.

Dated: May 12, 1995.

Bob Armstrong,

Assistant Secretary, Land and Minerals Management.

For the reasons set out in the preamble, 30 CFR parts 250 and 256 are proposed to be amended as follows:

PART 250—OIL AND GAS AND SULPHUR OPERATIONS IN THE OUTER CONTINENTAL SHELF

1. The authority citation for part 250 is amended to read as follows:

Authority: 43 U.S.C. 1334.

2. Section 250.160 is amended by revising the fifth sentence and adding a new sentence following the fifth sentence in paragraph (a) to read as follows:

§ 250.160 Applications for a pipeline right-of-way grant.

(a) * * * A nonrefundable filing fee of \$2,350 and the rental required under § 250.159(c)(2) of this part must accompany a new right-of-way application. MMS will periodically make technical amendments to adjust the filing fee according to the Consumer Price Index “U”. * * *

3. Section 250.163 is amended by revising the last sentence in paragraph (b) and adding a new sentence following the last sentence to read as follows:

§ 250.163 Assignment of a right-of-way grant.

(b) * * * A nonrefundable filing fee of \$60 must accompany the application for the approval of an assignment. MMS will periodically make technical amendments to adjust the filing fee according to the Consumer Price Index “U”.

PART 256—LEASING OF SULPHUR OR OIL AND GAS IN THE OUTER CONTINENTAL SHELF

4. The authority citation for part 256 continues to read as follows:

Authority: 43 U.S.C. 1331 et seq.

5. Section 256.64 is amended by revising the first sentence in paragraph (a)(2) and adding a new sentence following the first sentence to read as follows:

§ 256.64 Requirements for filing of transfers.

(a) * * *
(2) A nonrefundable filing fee of \$185 must accompany an application for approval of any instrument of transfer required to be filed. MMS will periodically make technical amendments to adjust the filing fee according to the Consumer Price Index “U”. * * *

[FR Doc. 95-19233 Filed 8-10-95; 8:45 am]

BILLING CODE 4310-MR-M

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

[Docket No. 95-0720187-5187-01]

RIN 0651-AA79

Rules of Practice in Patent Cases; Reexamination Proceedings

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The Patent and Trademark Office (Office) is proposing to amend its rules of practice in patent cases to provide revised procedures for the reexamination of patents. H.R. 1732 proposes to authorize the extension of reexamination proceedings as a means for improving the quality of United States patents. The Office intends, through this proposed amendment of its rules, to provide patent owners and the public with guidance on the procedures the Office would follow in conducting reexamination proceedings.

DATES: A public hearing will be held on Wednesday, September 20, 1995, at the Stouffer Renaissance Crystal City Hotel, 2399 Jefferson Davis Highway, Arlington, Virginia, 22202 at 9:30 a.m. Those wishing to present oral testimony must request an opportunity to do so no later than September 14, 1995. Written comments must be submitted on or before September 22, 1995.

ADDRESSES: Written comments concerning the rule changes should be addressed to the Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231, marked to the attention of Gerald A. Dost, Senior Legal Advisor, Special Program Law Office, Crystal Park 1, Suite 520. In addition, written comments may also be sent by facsimile transmission to (703) 308-6919 with a confirmation copy mailed to the above address, or by electronic mail messages over the Internet to reexamrule@uspto.gov.

Written comments concerning reexamination rule matters will be available for public inspection on October 2, 1995, in Room 520 of Crystal Park One, 2011 Crystal Drive, Arlington, Virginia.

FOR FURTHER INFORMATION CONTACT:

Gerald A. Dost or Lawrence E. Anderson by telephone at (703) 305-9285, by electronic mail at landerso@uspto.gov, or by mail to Gerald A. Dost to his attention addressed to the Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.

SUPPLEMENTARY INFORMATION:

Background

This proposed rulemaking sets forth distinct procedures directed towards determining and improving the quality and reliability of United States patents. The procedures are proposed to provide for the expanded reexamination of patents as proposed in H.R. 1732.

Discussion of General Issues Involved

The proposals are in response to H.R. 1782 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 rules proposed herein, third party requesters will have greater opportunity to participate in reexamination proceedings in keeping with the spirit and intent of the proposed law. At the same time, participation will be limited to minimize the costs and other effects of reexamination requests on patentees.

If H.R. 1732 is amended during the legislative process, the final rules will comply with this legislation as enacted. If H.R. 1732 is not enacted, the proposed rules for expanded reexamination of patents would be withdrawn.

Because reexamination filed before the proposed law takes effect will continue to be governed by 37 CFR 1.501-1.570, to avoid confusion between the new and old rules the newly proposed reexamination rules have been numbered 37 CFR 1.901-1.997.

Regarding the reexamination fee, 35 U.S.C. 41(d) requires the Commissioner to set the fee for reexamination at a level which will recover the estimated average cost to the Office. The estimated average cost is \$4,500 per patent owner requested reexamination and \$11,000 for third party requested reexaminations. The difference in price takes into account the estimate that the examiner will spend twice the amount

of time examining a case where a third party requester is present and additional costs incurred during the appellate stages incident to additional processing steps required in the third party proceedings.

Discussion of the Major Specific Issues Involved

The proposed rules relating to reexamination proceedings are directed to the procedures set forth in proposed Chapter 30 of Title 35 of the United States Code (35 U.S.C. 301-307). This proposed Chapter provides for the citation of prior art in patents, filing of requests for reexamination, decisions on such requests, reexamination and appeal from reexamination decisions, and the issuance of a certificate at the termination of the reexamination proceedings.

Section 1.4 is proposed to be amended so that paragraph (a)(2) includes the reexamination §§ 1.901-1.997.

Section 1.6 is proposed to be amended so that paragraph (d)(5) includes § 1.913, which related to the exception of the use of facsimile transmission for filing the request for reexamination.

Section 1.11 is proposed to be amended so that paragraph (c), which relates to reexaminations at the initiative of the Commissioner, includes the reference to reexamination § 1.929.

Section 1.17 is proposed to be amended so that paragraph (l) reflects the fact that in the case of reexaminations filed after January 1, 1996, petitions for revival of a reexamination proceeding terminated for an unavoidable failure to respond require the fees of \$55.00 for a small entity and \$110.00 for other than small entity. Also, § 1.17 is proposed to be amended so that paragraph (m) reflects the fact that in the case of reexaminations filed after January 1, 1996, petitions for revival of a reexamination proceeding terminated for an unintentional failure to respond require the fees of \$605.00 for a small entity and \$1,1210.00 for other than small entity. The Office has proposed an increase in the fee set by § 1.17(m). See "Revision of Patent and Trademark Fees" published in the **Federal Register** at 60 FR 27934 (May 26, 1995) and in the Patent and Trademark Office *Official Gazette* at 1174 Off. Gaz. Pat. Office 134 (May 30, 1995).

Section 1.20 is proposed to be amended so that paragraph (c) reflects the fact that in the case of reexaminations filed after January 1, 1996, there is a two tier fee scale in which patent owner requesters will be

charged \$4,500 and third party requesters will be charged \$11,000.

Section 1.25 is proposed to be amended so that paragraph (b), which relates to requests for reexaminations, includes the reference to reexamination § 1.913.

Section 1.26 is proposed to be amended so as to reflect that in the case of reexaminations filed after January 1, 1996, a refund of seventy-five percent (75%) of the fee paid for filing the request for reexamination will be made to the requester.

Section 1.112 is proposed to be amended so that the last sentence reflects the fact that in the case of reexamination filed after January 1, 1996, the examiner may close prosecution prior to making the action final. Section 1.113, which provides for a final rejection or action in a reexamination proceeding, is proposed to be amended so that its application is limited to applicants and patent owners in reexaminations filed before January 1, 1996. For reexaminations filed after January 1, 1996, the new reexamination rules will apply.

Section 1.115, which provides for amendments by the patent owner in a reexamination proceeding, is proposed to be amended so that its application is limited to applicants and patent owners in reexaminations filed before January 1, 1996. For reexaminations filed after January 1, 1996, the new reexamination rules will apply.

Section 1.116, which provides for amendments after final action in reexamination proceedings, is proposed to be amended so that its application is permissible after an action closing prosecution for patent owners in reexaminations filed on or after January 1, 1996. Also, for clarity, the rule is amended to provide that for reexaminations filed after January 1, 1996, no appeal is permitted until a right of appeal notice has been issued.

Section 1.136, which provides for filing of timely responses with petitions and fee for extension of time and extensions of time for cause, is amended to make it clear that for reexamination proceedings filed on or after January 1, 1996, § 1.957 is controlling for extensions of time.

Section 1.137, which provides for revival of abandoned applications or lapsed patents, is proposed to be amended to change the title and add new paragraphs (g) and (h). Paragraph (f) is proposed to be utilized for provisional applications. Paragraph (g) is proposed to be added to provide for revival of unavoidably terminated proceedings for reexamination proceedings filed before January 1,

1996. Paragraph (h) is proposed to be added to make it clear that for reexamination proceedings filed on or after January 1, 1996, § 1.958 is controlling.

Section 1.191, which provides for appeal to the Board of Patent Appeals and Interferences by the patent owner from any decision adverse to patentability, is proposed to be amended so as to be applicable to reexaminations filed before January 1, 1996. For reexamination proceedings filed on or after January 1, 1996, § 1.959 is controlling.

Section 1.192, which provides two months from the date of the Notice of Appeal for the patent owner to file an appeal brief in a reexamination proceeding, is proposed to be amended so as to be applicable to reexaminations filed before January 1, 1996. For reexamination proceedings filed on or after January 1, 1996, § 1.965 is controlling.

Section 1.193, which provides for the Examiner's answer and reply brief, is proposed to be amended so as to be applicable to reexaminations filed before January 1, 1996. For reexamination proceedings filed on or after January 1, 1996, §§ 1.969 and 1.971 are controlling.

Section 1.194, which provides for the oral hearing, is proposed to be amended so as to be applicable to reexaminations filed before January 1, 1996. For reexamination proceedings filed on or after January 1, 1996, § 1.973 is controlling.

Section 1.195, which provides for the affidavits or declarations after appeal, is proposed to be amended so as to be applicable to reexaminations filed before January 1, 1996. For reexamination proceedings filed on or after January 1, 1996, § 1.975 is controlling.

Section 1.196, which provides for the decision of the Board of Patent Appeals and Interferences, is proposed to be amended so as to be applicable to reexaminations filed before January 1, 1996. For reexamination proceedings filed on or after January 1, 1996, § 1.977 is controlling.

Section 1.197, which provides for action following the decision, is proposed to be amended so as to be applicable to reexaminations filed before January 1, 1996. For reexamination proceedings filed on or after January 1, 1996, § 1.979 is controlling.

Section 1.198, which provides for reopening after the decision, is proposed to be amended so as to be applicable to reexaminations filed before January 1, 1996. For

reexamination proceedings filed on or after January 1, 1996, § 1.981 is controlling.

Section 1.301, which provides for appeal by the owner of a patent in reexamination proceedings to the U.S. Court of Appeals for the Federal Circuit, is proposed to be amended so as to be applicable to reexaminations filed before January 1, 1996. For reexamination proceedings filed on or after January 1, 1996, § 1.983 is controlling.

Section 1.303, which provides for remedy by civil action under 35 U.S.C. 145 for the owner of a patent in reexamination proceedings, is proposed to be amended so as to be applicable to reexaminations filed before January 1, 1996. For reexamination proceedings filed on or after January 1, 1996, § 1.993 is controlling.

Section 1.304 which provides for time for appeal or civil action, is proposed to be amended so as to refer also to § 1.957.

The title to Subpart D is proposed to be amended to provide that the reexamination rules in this part apply only to reexamination proceedings filed before January 1, 1996.

The proposed title to Subpart H provides that the reexamination rules in this part apply only to reexamination proceedings filed on or after January 1, 1996.

Proposed § 1.901 provides a system for citation of patents and printed publications to the Office for placement in the patent file by a person during the period of enforceability of the patent in accordance with 35 U.S.C. 301. The section provides for citations limited to patents and printed publications when the person making the citation states the pertinency and applicability of the citation to the patent and the bearing the citation has on the patentability of at least one claim of the patent. The rule provides that a citation made by the patent owner may include an explanation of how the claims differ from the prior art cited. Any citations which include items other than patents and printed publications will not be entered in the patent file. This does not, of course, limit in any manner the kinds and types of information which can be relied upon in protests against pending patent applications, whether such be original applications or reissue applications. The term "period of enforceability of a patent" includes any period for which recovery can be had for infringement. Under usual circumstances, this would be the term of the patent plus the six years provided by 35 U.S.C. 286.

Proposed § 1.902 provides for the processing of prior art citations during a reexamination proceeding.

Proposed § 1.903 provides for the service of papers on parties.

Proposed § 1.904 provides that the notices published in the Official Gazette will be considered to be constructive notice.

Proposed § 1.905 provides for submission of papers by the public.

Proposed § 1.906 covers the scope of reexamination in a reexamination proceeding. While it is not intended that the examiners will routinely complete a new search when conducting reexamination, the examiners will be free to, and will, very likely, conduct additional searches and cite and apply additional prior patents and publications when they consider it is appropriate and beneficial to do so. Insofar as the actual reexamination is concerned, the examination is only on the basis of patents or printed publications and on the basis of the requirements of 35 U.S.C. 112, except for the best mode requirement. Claims in a reexamination proceeding must not enlarge the scope of the claims of the patent and must not introduce new matter. Paragraph (c) provides that questions relating to matters other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding, but will be noted by the examiner as being an open question in the record. Patent owners could then file a reissue application if they wish such questions to be resolved.

Proposed § 1.907 sets forth when reexamination is prohibited. Once an order to reexamine has been issued under § 1.931, neither the patent owner nor the third party requester, if any, nor privies of either, may file a subsequent request for reexamination of the patent until a reexamination certificate is issued under § 1.997, unless authorized by the Commissioner. 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 in which the party did not sustain its burden of proving invalidity of any patent claim in suit, then neither that party nor its privies may thereafter request 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 reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office.

Proposed § 1.909 provides for estoppel of their party requesters from previous reexamination proceedings. A third party requester, or its privy, who,

during a reexamination proceeding, has filed a notice of appeal to the Court of Appeals for the Federal Circuit, or who has participated as a party to an appeal by the patent owner, under the provisions of 35 U.S.C. 141 to 144, is estopped from later asserting, in a subsequent reexamination proceeding, the invalidity of any claim determined to be patentable on appeal on any ground which the third party requester, or its privy, raised or could have raised during the prior reexamination proceeding. A third party requester, or its privy, is deemed not to have participated as a party to an appeal by the patent owner unless, within twenty days after the patent owner has filed notice of appeal, the third party (or its privy) files notice with the Commissioner electing to participate.

Proposed § 1.911 provides factors for consideration of privies and persons bound. For the purposes of § 1.907, a determination of whether person is a privy with respect to the patent owner shall include consideration of whether there is: (1) a mutual, concurrent or successive relationship to the same property rights in the patent involved in the reexamination proceeding; or (2) representation of the interests of the patent owner concerning the patent. For the purposes of §§ 1.907 and 1.909, a determination of whether a person is a privy with respect to a third party requester shall include consideration of whether there is: (1) a mutual, concurrent or successive relationship to the same property rights which are or may be affected by and/or infringe the patent involved in the reexamination proceeding; or (2) representation of the interests of the other party which are or may be affected by and/or potentially infringe the patent. For the purposes of §§ 1.907 and 1.909, a person who is not a party to the reexamination proceeding but who controls or substantially participates in the control of the presentation of the reexamination proceeding on behalf of a party is bound by the determination of issues decided as though he or she were a named party. To have control of the presentation requires that person to have effective choice as to the legal theories and/or grounds of rejection or defenses to be advanced on behalf of the party to the reexamination proceeding. Under this section a party would be precluded from hiring another law firm and having that firm file a subsequent reexamination request in order to avoid the prohibitions of 35 U.S.C. 307(c) or 308.

Proposed § 1.913 sets forth procedures for any person to request reexamination in accordance with 35 U.S.C. 302 and limits the period for such request to the

period of enforceability of the patent for which the request is filed.

Proposed § 1.915(a) requires payment of the fee for requesting reexamination. Paragraph (b) of new § 1.915 indicates what each request for reexamination must include. Paragraph (c) of new § 1.915 covers amendments which a patent owner can propose. Such amendments can accompany a request for reexamination by the patent owner. Paragraph (d) indicates that requests for reexamination may be filed by attorneys or agents on behalf of a requester, but it is noted that the real party in interest must be identified in accordance with § 1.915(b)(10).

Proposed § 1.917 indicates what will be done if the request is incomplete.

Proposed § 1.919 indicates the date on which the entire fee is received will be considered to be the date of the request for reexamination.

Proposed § 1.921 provides that prior art submissions by the third party requester filed after the reexamination order shall be limited solely to prior art which is used to rebut a finding a fact by the examiner or a response of the patent owner.

Proposed § 1.923 relates to a determination as to whether the request has presented a substantial new question of patentability under 35 U.S.C. 303 and requires that the determination be made within 3 months of the filing date of the request.

Proposed § 1.925 refers to the refund provisions.

Proposed § 1.927 provides for review by petition to the Commissioner of any decision refusing reexamination.

Proposed § 1.929 provides for reexamination at the initiative of the Commissioner under the provisions of the last sentence of paragraph (a) of 35 U.S.C. 303.

Proposed § 1.931 provides for ordering reexamination where a substantial new question of patentability has been found pursuant to §§ 1.923 or 1.929. Under paragraph (b), the only limitation placed on the selection of the examiner by the Office is that the same examiner whose decision was reversed on petition ordinarily will not conduct the reexamination.

Proposed § 1.933 covers the duty of disclosure by a patent owner in a reexamination proceeding involving the owner's patent.

Proposed § 1.935 indicates that the initial Office action normally accompanies the reexamination order.

Proposed § 1.937 provides that in accordance with 35 U.S.C. 305(c), unless otherwise provided by the Commissioner for good cause, all

reexamination proceedings will be conducted with special dispatch. Paragraph (b) covers the basic items relating to the conduct of reexamination proceedings.

Proposed § 1.939 provides that no paper shall be filed before the first Office action.

Proposed § 1.941 provides for proposed amendments provided for the second sentence of 35 U.S.C. 305. Amendments submitted by the patent owner cannot enlarge the scope of a claim in the patent. Amendments will not be effectively entered into the patent until the certificate under § 1.997 and 35 U.S.C. 307 is issued.

Proposed § 1.943 provides a page limit for responses and briefs of 50 pages. Prior art references and Appendix of claims would not be included in this total.

Proposed § 1.945 provides that a patent owner will be given at least thirty days to respond to any Office action. Although problems may arise in certain cases and extensions of time may be granted, it is felt that relatively short response times are necessary in order to process reexaminations with "special dispatch."

Proposed § 1.9347 provides that in accordance with 35 U.S.C. 305(b)(3), if a patent owner files a response to any Office action on the merits, the third party requester may once file written comments.

Proposed § 1.949 provides when prosecution may be closed.

Proposed § 1.951 provides for responses by the parties after an Office action closing prosecution. The responses and time periods provided for by paragraphs (a) and (b) may run concurrently.

Proposed § 1.953 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 or final decision favorable to patentability in accordance with 35 U.S.C. 134. The intent of limiting the appeal rights until after the examiner issues a "Right of Appeal Notice" is to specifically preclude the possibility of one party attempting to appeal prematurely while prosecution before the examiner is being continued by the other party.

Proposed § 1.955 relates to the conduct of interviews in reexamination proceedings. The third party requested is permitted to attend all interviews. Interviews are permitted before the first Office action only when initiated by the examiner.

Proposed § 1.957 relates to extensions of time and termination of

reexamination proceedings. In circumstances where the response by the patent owner is not required by the examiner and is merely discretionary, such as when all claims are allowed or their patentability is confirmed and the patent owner is merely given the opportunity for comment, such a failure to comment is not type of lack of response contemplated by paragraphs (b) and (c) and, therefore, not grounds for termination or limiting prosecution.

Proposed § 1.958 relates to revival of terminated proceedings.

Proposed § 1.959 relates to appeals and cross appeals to the Board of Patent Appeals and Interferences. Both patent owners and third party requesters are given appeal rights in accordance with 35 U.S.C. 306.

Proposed § 1.961 relates to time of transfer of the jurisdiction of the appeal over to the Board of Patent Appeals and Interferences.

Proposed § 1.962 relates to the definition of appellant and respondent.

Proposed § 1.963 relates to the time periods for filing briefs.

Proposed § 1.965 relates to the appellant brief.

Proposed § 1.967 relates to the respondent brief.

Proposed § 1.969 relates to the examiner's answer.

Proposed § 1.971 relates to the reply brief.

Proposed § 1.973 relates to the oral hearing.

Proposed § 1.975 relates to affidavits or declarations after appeal.

Proposed § 1.977 relates to the decision by the Board of Patent Appeals and Interferences.

Proposed § 1.979 relates to the procedures following the decision by the Board of Patent Appeals and Interferences.

Proposed § 1.981 relates to the procedure for reopening prosecution following the decision by the Board of Patent Appeals and Interferences.

Proposed § 1.983 relates to appeals to the United States Court of Appeals for the Federal Circuit, in accordance with 35 U.S.C. 306. Under H.R. 1732, civil actions under 35 U.S.C. 145 are not permitted in reexamination proceedings filed on or after January 1, 1996.

Proposed § 1.985 relates to notification or prior or concurrent proceedings.

Proposed § 1.987 relates to the stay of concurrent proceedings. Decisions as to whether to delay or combine cases will be made on a case-by-case basis to minimize delays and to protect the interests of all parties concerned.

Proposed § 1.989 relates to the merger of concurrent proceedings.

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

Proposed § 1.993 relates to the stay of a concurrent interference and reexamination proceeding.

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

Proposed § 1.997 concerns the issuance of the reexamination certificate under 35 U.S.C. 307 after the conclusion of reexamination proceedings. 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 claim 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 or other Office proceeding relating to a patent in which such a certificate has been issued will be terminated.

This provides a degree of assurance to the public that patents with all the claims canceled via reexamination proceedings will not again be asserted. It is intended that copies of the certificate will continue to be part of subsequently sold copies of the patent.

Other Considerations

The proposed rule changes are in conformity with the requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*), Executive Order 12612, and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.* It has been determined that this rulemaking is not significant for the purposes of Executive Order 12866.

The Assistant General Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that these proposed rule changes will not have a significant economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The principal impacts of these proposed changes are to expand the grounds for requesting a reexamination and to permit the third party to participate more extensively during the reexamination proceeding as well as having appeal rights.

The Office has also determined that this notice has no Federalism implications affecting the relationship between the National Government and the States as outlined in Executive Order 12612.

These rule changes contain collection of information requirements subject to the Paperwork Reduction Act of 1980,

44 U.S.C. 3501 *et seq.*, which is currently approved by the Office of Management and Budget under Control No. 0651-0033. The public reporting burden for the collection of information for requests for reexamination is estimated to average 2.0 hours each including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information. Send comments regarding this burden estimate or any other aspect of this collection of information, including suggestions for reducing this burden to the Office of System Quality and Enhancement, Patent and Trademark Office, Washington, D.C. 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Washington, DC 20503 (ATTN: Paperwork Reduction Act Project 0651-0033).

Notice is hereby given that pursuant to the authority granted to the Commissioner of Patents and Trademarks by 35 U.S.C. 6, the Patent and Trademark Office proposed to amend Title 37 of the Code of Federal Regulations as set forth below.

List of Subjects in 37 CFR Part 1

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

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

PART 1—RULES OF PRACTICE IN PATENT CASES

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

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

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

§ 1.4 Nature of correspondence and signature requirements.

(a) * * *

(2) Correspondence in and relating to a particular application or other proceeding in the Office. See particularly the rules relating to the filing, processing, or other proceedings of national applications in Subpart B, §§ 1.31 to 1.378; of international applications in Subpart C, §§ 1.401 to 1.499; or reexamination of patents filed before January 1, 1996, in Subpart D,

1.501 to 1.570, and of reexaminations filed on or after January 1, 1996, in Subpart H, §§ 1.901-1.997; of interferences in Subpart E; §§ 1.601 to 1.690; of extension of patent term in Subpart F, §§ 1.710 to 1.785; and of trademark applications §§ 2.11 to 2.189.

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

§ 1.6 Receipt of correspondence.

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

4. Section 1.11(c) is proposed to be revised to read as follows:

§ 1.11 Files open to the public.

(c) All requests for reexamination for which the fee under 1.20(c) has been paid, will be announced in the Official Gazette. Any reexaminations at the initiative of the Commissioner pursuant to 1.520 or 1.929 will also be announced in the Official Gazette. The announcement shall include at least the date of the request, if any, the reexamination request control number of the Commissioner initiated order control number, patent number, title, class and subclass, name of the inventor, name of the patent owner of record, and the examining group to which the reexamination is assigned.

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

§ 1.17 Patent application processing fees.

(l) For filing a petition:

(1) For the revival of an unavoidably abandoned application under 35 U.S.C. 111, 133, 364, or 371,

(2) For delayed payment of the issue fee under 35 U.S.C. 151, or,

(3) For the revival of an unavoidably terminated reexamination proceeding:

By a small entity (§ 1.9(f)).....55.00
By other than a small entity110.00

(m) For filing a petition:

(1) For revival of an unintentionally abandoned application,

(2) For the unintentionally delayed payment of the fee for issuing a patent, or

(3) For reexamination proceedings filed on or after January 1, 1996, for the revival of an unintentionally terminated reexamination proceeding:

By a small entity (§ 1.9(f)).....605.00
By other than a small entity1,210.00

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

§ 1.20 Post issuance fees.

(c) For filing a request for reexamination (§ 1.915(a)):

By a patent owner\$4,500.00
By a third party requester.....\$11,000.00

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

§ 1.25 Deposit accounts.

(b) Filing, issue, appeal, international-type search report, international application processing, petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. A general authorization to charge all fees, or only certain fees, set forth in §§ 1.16 to 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular paper filed. An authorization charge to a deposit account the fee for a request for reexamination pursuant to § 1.510 or § 1.915 and any other fees required in a reexamination proceeding in a patent may also be filed with the request for reexamination. 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.

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

§ 1.26 Refunds.

(c) If the Commissioner decides not to institute a reexamination proceeding, for reexaminations filed on or after January 1, 1996, a refund of seventy-five percent (75%) of the fee paid for filing the request for reexamination will be made to the requester. Reexamination requesters should indicate whether any refund should be made by check or by credit to a deposit account.

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

§ 1.112 Reconsideration.

After response by applicant or patent owner (§ 1.111), the application or patent under reexamination will be reconsidered and again examined. The applicant or patent owner will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination. Applicant or patent owner

may respond to such Office action in the same manner provided in § 1.111, with or without amendment. Any amendments after the second Office action must ordinarily be restricted to the rejection or to the objections or requirements made. The application or patent under reexamination will be again considered, and so on repeatedly, unless the examiner has indicated that the action is final or is an action closing prosecution.

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

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or (for reexaminations filed before January 1, 1996) patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the response to a final rejection or action must comply with any requirements or objection as to form.

11. Section 1.115 is proposed to be revised to read as follows:

§ 1.115 Amendment.

The applicant may amend before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in § 1.112 or when and as specifically required by the examiner. For reexaminations filed before January 1, 1996, the patent owner may amend in accordance with §§ 1.510(e) and 1.530(b) prior to reexamination, and during reexamination proceedings in accordance with §§ 1.112 and 1.116. For reexaminations filed on or after January 1, 1996, the patent owner may amend in accordance with § 1.915(c) prior to reexamination, and during reexamination proceedings in accordance with §§ 1.941 and 1.945.

12. Section 1.116(a) is proposed to be revised to read as follows:

§ 1.116 Amendments after final action.

(a) After final rejection or action (§ 1.113) or action closing prosecution (§ 1.949) for reexaminations filed on or after January 1, 1996, amendments may be made cancelling claims or complying with any requirement of form which has been made. Amendments presenting

rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall 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. Notwithstanding the above, for reexamination proceedings filed on or after January 1, 1996, no appeal may be had until a right of appeal notice has been issued pursuant to § 1.953.

* * * * *

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

§ 1.136 Filing of timely responses with petition and fee for extension of time and extensions of time for cause.

(a) * * *

(2) The date on which the response, the petition, and the fee have been filed is the date of the response and also 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. In no case may an applicant respond 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. See § 1.304 for extension of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action. See § 1.550(c) for extension of time in reexamination proceedings filed before January 1, 1996, § 1.957 for extension of time in reexamination proceedings filed on or after January 1, 1996, and § 1.645 for extension of time in interference proceedings.

(b) When a response with petition and fee for extension of time cannot be filed pursuant to paragraph (a) of this section, the time for response 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 applicant is due, but in no case will the mere filing of the request effect any extension. In no case can any extension carry the date on which response to an Office action is due beyond the maximum time period set by statute or be granted when the provisions of paragraph (a) of this section are available. See § 1.304 for extension of time to appeal to the U.S. Court of

Appeals for the Federal Circuit or to commence a civil action, § 1.645 for extension of time in interference proceedings, § 1.550(c) for extension of time in reexamination proceedings filed before January 1, 1996, and § 1.957 for extension of time in reexamination proceedings filed on or after January 1, 1996.

14. Section 1.137 (g) and (h) are proposed to be added and the Section heading revised to read as follows:

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

* * * * *

(g) A reexamination proceeding filed before January 1, 1996, which is terminated for failure to prosecute may be revised as a pending proceeding if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A petition to revive an unavoidably terminated reexamination proceeding must be promptly filed after the patent owner is notified of, or otherwise becomes aware of, the termination of the proceeding, and must be accompanied by:

(1) a proposed response to continue prosecution of that proceeding unless it has been previously filed;

(2) the petition fee as set forth in § 1.17(1); and

(3) a showing that the delay was unavoidable. The showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(h) For reexamination proceedings filed on or after January 1, 1996, see § 1.958.

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

§ 1.191 Appeal to Board of Patent Appeals and Interferences.

(a) Every applicant for a patent or for reissue of a patent, or every owner of a patent under reexamination (for reexaminations filed before January 1, 1996), any of the claims of which have been twice rejected or who has been given a final rejection (§ 1.113), may, upon the payment of the fee set forth in § 1.17(e), appeal from the decision of the examiner to the Board of Patent Appeals and Interferences within the time allowed for response. Notwithstanding the above, for reexamination proceedings filed on or after January 1, 1996, § 1.959 et seq., is controlling.

* * * * *

16. Section 1.192(a) is proposed to be revised to read as follows:

§ 1.192 Applicant's brief.

(a) The appellant shall, within 2 months from the date of the notice of

appeal under § 1.191 in an application, reissue application, or patent under reexamination (for reexaminations filed before January 1, 1996), or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate. The brief must be accompanied by the requisite fee set forth in § 1.17(f) and must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief may be refused consideration by the Board of Patent Appeals and Interferences.

Notwithstanding the above, for reexamination proceedings filed on or after January 1, 1996, § 1.965 is controlling.

* * * * *

17. Section 1.193 is proposed to be amended by adding a paragraph (c) to read as follows:

§ 1.193 Examiner's answer.

* * * * *

(c) Notwithstanding the above, for reexamination proceedings filed on or after January 1, 1996, §§ 1.969 and 1.971 are controlling.

18. Section 1.194 is proposed to be amended by adding a paragraph (d) to read as follows:

§ 1.194 Oral hearing.

* * * * *

(d) Notwithstanding the above, for reexamination proceedings filed on or after January 1, 1996, § 1.973 is controlling.

19. Section 1.195 is proposed to be revised to read as follows:

§ 1.195 Affidavits or declarations after appeal.

Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented. Notwithstanding the above, for reexamination proceedings filed on or after January 1, 1996, § 1.975 is controlling.

20. Section 1.196 is proposed to be amended by adding a paragraph (g) to read as follows:

§ 1.196 Decision by the Board of Patent Appeals and Interferences.

* * * * *

(g) Notwithstanding the above, for reexamination proceedings filed on or after January 1, 1996, § 1.977 is controlling.

21. Section 1.197 is proposed to be amended by adding a paragraph (d) to read as follows:

§ 1.197 Action following decision.

* * * * *

(d) Notwithstanding the above, for reexamination proceedings filed on or after January 1, 1996, § 1.979 is controlling.

22. Section 1.198 is proposed to be revised to read as follows:

§ 1.198 Reopening after decision.

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 § 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown. Notwithstanding the above, for reexamination proceedings filed on or after January 1, 1996, § 1.981 is controlling.

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

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

Any applicant or any owner of a patent involved in a reexamination proceeding (filed before January 1, 1996) 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 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. Notwithstanding the above, for reexamination proceedings filed on or after January 1, 1996, § 1.983 is controlling.

24. Section 1.303 is proposed to be amended by revising paragraphs (a) and (b) and 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 a reexamination proceeding (filed before January 1, 1996) dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party 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 a reexamination proceeding (filed before January 1, 1996) 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 reexamination proceedings filed on or after January 1, 1996, no remedy by civil action under 35 U.S.C. 145 is available.

25. Section 1.304(a)(2) is proposed to be revised to read as follows:

§ 1.304 Time for appeal or civil action.

(a) * * *

(2) The time periods set forth in this section are not subject to the provisions of §§ 1.136, 1.550(c), 1.957 or 1.645 (a) or (b).

* * * * *

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

Subpart D—Reexamination of Patents for Proceedings Filed Before January 1, 1996 (For Proceeding beginning on or after January 1, 1996, see Subpart H)

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

Subpart H—Reexamination of Patents for Proceedings Filed On or After January 1, 1996 (For Proceedings beginning Before January 1, 1996, see Subpart D)

Sec.

- 1.901 Citation of prior art in patents file.
- 1.902 Processing of prior art citations in patent files during a reexamination proceeding.

Reexamination Proceedings

- 1.903 Service of papers on parties.
- 1.904 Notice of reexamination in Official Gazette.
- 1.905 Submission of papers by public.
- 1.906 Scope of reexamination in reexamination proceeding.
- 1.907 Reexamination prohibited.
- 1.909 Estoppel of third party requester from previous reexamination proceedings.
- 1.911 Privies and persons bound.

Determining if Reexamination Will Be Ordered

- 1.913 Persons eligible.
- 1.915 Content of request.
- 1.917 Omission of a requirement in the request for reexamination.
- 1.919 Filing date for request for reexamination.
- 1.921 Submission of prior art by third party following the order for reexamination.

1.923 Examiner's consideration of the request for reexamination.

1.925 Partial refund if request is denied.

1.927 Petition to review denial of the request for reexamination.

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1.929 Reexamination at the initiative of the Commissioner.

1.931 Order to reexamine.

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1.933 Information material to patentability in reexamination proceedings.

Office Actions and Responses (Before the Examiner)

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1.949 Examiner's Office action closing prosecution.

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1.955 Interviews in reexamination proceedings.

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1.957 Extensions of time and cause for termination in reexamination proceedings.

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1.959 Notice of appeal and cross appeal to Board of Patent Appeals and Interferences.

1.961 Jurisdiction over appeal.

1.962 Appellant and respondent defined.

1.963 Time for filing briefs.

1.965 Appellant brief.

1.967 Respondent brief.

1.969 Examiner's answer.

1.971 Reply brief.

1.973 Oral hearing.

1.975 Affidavits or declarations after appeal.

1.977 Decision by the Board of Patent Appeals and Interferences.

1.979 Action following decision.

1.981 Reopening after decision.

Appeal to the United States Court of Appeals for the Federal Circuit

1.983 Appeal to the United States Court of Appeals for the Federal Circuit.

Proceedings Including Same Patient as in Reexamination

1.985 Notification of prior or concurrent proceedings.

1.987 Stay of concurrent proceeding.

1.989 Merger of concurrent reexamination proceedings.

- 1.991 Merger of concurrent reissue application and reexamination proceeding.
- 1.993 Stay of concurrent interference and reexamination proceeding.
- 1.995 Third party requester's participation rights preserved in merged proceedings.

Certificate

- 1.997 Issuance of reexamination certificate after reexamination proceedings.

§ 1.901 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 Patent and Trademark 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 a particular patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an expansion of how the claims differ from the prior art.

(b) If the person making the citation wishes his or her identity to be excluded from the patent file and kept confidential, the citation papers must be submitted without any identification of the person making the submission.

(c) Citations of patent or printed publications by the public in patent files should either:

(1) reflect that a copy of the same has been mailed to the patent owner at the address as provided in § 1.33(c); or in the event service is not possible,

(2) be filed with the Office in duplicate.

(d) Except as provided in § 1.902, citations submitted in accordance with this section will be placed and made of record in the patent file.

§ 1.902 Processing of prior art citations in patent files during a reexamination proceeding.

Citations by the patent owner in accordance with § 1.933 and by a reexamination third party requester under § 1.915 will be entered in the patent file. The entry in the patent file of other citations submitted after the date of an order to reexamine pursuant to § 1.931 will be delayed until the reexamination proceeding has been terminated.

Reexamination Proceedings

§ 1.903 Service of papers on parties.

The patent owner and any third party requester will be sent copies of Office actions issued during the reexamination proceeding. After filing of a request for 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 third party requester, if any, to timely file or serve documents may result in their being refused consideration.

§ 1.904 Notice of reexamination in Official Gazette.

A notice of the filing of a reexamination request or initiation of a Commissioner-ordered reexamination will be published in the Official Gazette. The notice in the Official Gazette under § 1.11(c) will be considered to be constructive notice of the reexamination proceeding and reexamination will proceed.

§ 1.905 Submission of papers by public.

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 to reexamine pursuant to § 1.931. Submissions by third parties, other than third party requesters, filed after the date of the order to reexamine pursuant to § 1.931, must meet the requirements of § 1.901 (a) through (c) and will be treated in accordance with § 1.902.

§ 1.906 Scope of reexamination in reexamination proceeding.

(a) Claims in a reexamination proceeding will be examined on the basis of patents or printed publications and on the basis of the requirements of 35 U.S.C. 112 except for the best mode requirement.

(b) Claims in a reexamination proceeding must not enlarge the scope of the claims of the patent.

(c) Questions other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such questions are raised by the patent owner or third party requester during a reexamination proceeding, the existence of such questions 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 questions considered and resolved.

§ 1.907 Reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the patent owner nor the third party requester, if any, nor privies of either, may file a subsequent request for reexamination of the patent until a

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 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 a reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

§ 1.909 Estoppel of third party requester from previous reexamination proceedings.

A third party requester, or its privy, who, during a reexamination proceeding, has filed a notice of appeal to the Court of Appeals for the Federal Circuit, or who has participated as a party to an appeal by the patent owner, under the provisions of 35 U.S.C. 141 to 144, is estopped from later serving, in a subsequent reexamination proceeding, the invalidity of any claim determined to be patentable on appeal on any ground which the third party requester, or its privy, raised or could have raised during the prior reexamination proceeding. A third party requester, or its privy, is deemed not to have participated as a party to an appeal by the patent owner unless, within twenty days after the patent owner has filed notice of appeal, the third party, or its privy, files notice with the Commissioner's electing to participate.

§ 1.911 Privies and persons bound.

(a) For the purposes of § 1.907, a determination of whether a person is a privy with respect to the patent owner shall include consideration of whether there is:

(1) a mutual, concurrent or successive relationship to the same property rights in the patent involved in the reexamination proceeding; or

(2) representation of the interests of the patent owner concerning the patent.

(b) For the purposes of §§ 1.907 and 1.909, a determination of whether a person is a privy with respect to a third party requester shall include consideration of whether there is:

(1) a mutual, concurrent or successive relationship to the same property rights which are or may be affected by and/or infringe the patent involved in the reexamination proceeding; or

(2) representation of the interests of the other party which are or may be

affected by and/or potentially infringe the patent.

(c) For the purposes of §§ 1.907 and 1.909, a person who is not a party to the reexamination proceeding but who controls or substantially participates in the control of the presentation of the reexamination proceeding on behalf of a party is bound by the determination of issues decided as though he or she were a named party. To have control of the presentation requires that person to have effective choice as to the legal theories and/or grounds of rejection or defenses to be advanced on behalf of the party to the reexamination proceeding.

Determining if Reexamination Will Be Ordered

§ 1.913 Persons eligible.

Except as otherwise provided, any person may, at any time during the period of enforceability of a patent, file a request for reexamination by the Patent and Trademark Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.901 or on the basis of the requirements of 35 U.S.C. 112 except for the best mode requirement.

§ 1.915 Content of request.

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

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

(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications or based on the manner in which the patent specification or claims fail to comply with the requirements of 35 U.S.C. 112 except for the best mode requirement.

(2) An identification of every claim for which reexamination is requested.

(3) A detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested or a detailed explanation of the manner in which the specification or claim(s) fail to comply with 35 U.S.C. 112 except for the best mode requirement. If appropriate, the party requesting reexamination may also point out how claims distinguish over cited prior art or how 35 U.S.C. 112 requirements are complied with except for the best mode requirement.

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

(5) The entire patent for which reexamination is requested must be

furnished in the form of cut-up copies of the original patent with only a single column of the printed patent securely mounted or reproduced in permanent form on one side of a separate paper. A copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent must also be included.

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

(7) If the patent is currently involved in a reexamination proceeding for which a reexamination certificate has not been issued, a certification that the person making the request is not a privy of the patent owner or third party requester, unless otherwise authorized by the Commissioner.

(8) In a request filed by a third party requester, a certification that

(i) no final decision has been entered against that party or its privies in a civil action arising in whole or in part under 28 U.S.C. 1338 in which that party or its privies did not sustain its burden of proving the invalidity of any patent claim in suit, and

(ii) neither that party nor its privies are requesting 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.

(9) In a request filed by a third party requester, a certification that the request does not assert the invalidity of any claim determined to be patentable on appeal on any ground which the third party requester or its privy raised or could have raised during a prior reexamination proceeding in which that party or its privies filed a notice of appeal to the Court of Appeals for the Federal Circuit and/or participated as a party to an appeal by the patent owner, under the provisions of 35 U.S.C. 141 to 144.

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

(c) A request filed by the patent owner may include a proposed amendment in accordance with § 1.121(f).

(d) If a 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).

§ 1.917 Omission of a requirement in the request for reexamination.

If the request is not accompanied by the fee for requesting reexamination or all of the other parts required by § 1.915, the person identified as requesting reexamination will be so notified and given an opportunity to complete the request within a specified time. If the fee for requesting reexamination has been paid but the defect in the request is not corrected within the specified time, the determination whether or not to institute reexamination will be made on the request as it then exists. If the fee for requesting reexamination has not been paid, no determination will be made and the request will be placed in the patent file as a citation if it complies with the requirements of § 1.901 and/or § 1.902.

§ 1.919 Filing date for request for reexamination.

The filing date of the request is the date on which the request including the entire fee for requesting reexamination is received; or, if the request is not initially accompanied by the entire fee, the date on which the last portion of the fee is received in the Patent and Trademark Office.

§ 1.921 Submission of prior art by third party following the order for reexamination.

Prior art submissions by the third party requester filed after the reexamination order shall be limited solely to prior art which is used to rebut a finding of fact by the examiner or a response of the patent owner.

§ 1.923 Examiner's consideration of the request for reexamination.

Within three months following the filing date of a request for 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, or by the failure of the patent specification or claim(s) to comply with the requirements of 35 U.S.C. 112 except for the best mode requirement. The examiner's determination will be used on the claims in effect at the time of the determination and will become a part of the official file of the patent and will be mailed to the patent owner at the address as provided for in § 1.33(c) and to the person requesting reexamination.

§ 1.925 Partial refund if request is denied.

Where no substantial new question of patentability has been found, a refund of a portion of the fee for requesting

reexamination will be made to the requester in accordance with § 1.26(c).

§ 1.927 Petition to review denial of the request for reexamination.

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 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.

Reexamination of Patents

§ 1.929 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 or by the failure of the patent specification or claim(s) to comply with the requirements of 35 U.S.C. 112 except for the best mode requirement. The Commissioner may order reexamination even though no request for reexamination has been filed in accordance with § 1.915. Normally requests from outside the Patent and Trademark Office that the Commissioner undertake reexamination on his or her own initiative will not be considered. Any determination to initiate reexamination under this section will become a part of the official file of the patent and will be given or mailed to the patent owner at the address as provided for in § 1.33(c).

§ 1.931 Order to reexamine.

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

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

Information Disclosure

§ 1.933 Information material to patentability in reexamination proceedings.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective reexamination occurs

when, at the time a reexamination proceeding is being conducted, the Office is aware of and evaluates the teachings of all information material to patentability in a reexamination proceeding. Each individual associated with the patent owner in a 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. The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding until the claim is cancelled. Information material to the patentability of a cancelled claim need not be submitted if the information is not material to patentability of any claim remaining under consideration in the reexamination proceeding. The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

(b) Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and

(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the patent owner takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(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 discovered during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.906(c).

Office Actions and Responses (Before the Examiner)

§ 1.935 Initial Office action normally accompanies order to reexamine.

The order for reexamination will normally be accompanied by the initial Office action on the merits of the reexamination.

§ 1.937 Conduct of Reexamination.

(a) All reexamination proceedings, including any appeals to the Board of Patent Appeals and Interference, 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. A final determination that good cause exists shall not be made until the patent owner and third party requesters (if any) have had a reasonable opportunity to comment on or oppose any suspension.

(b) Except as otherwise provided, the reexamination proceeding will be conducted in accordance with the sections governing the application examination process; §§ 1.104 through 1.119, and will result in the issuance of a reexamination certificate under § 1.997.

§ 1.939 Unauthorized papers.

Unless authorized by the reexamination regulations (§§ 1.901–

1.997), no paper shall be filed prior to the first Office action. If an unauthorized paper is filed by the patent owner or third party requester, it will not be considered in making the determination under § 1.923 and will be returned.

§ 1.941 Amendments by patent owner and their effective date.

(a) Any proposed amendment to the description and claims must be made in accordance with § 1.121(f) and be accompanied by an explanation of the support for the proposed amendment in the disclosure of the patent. No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment will be incorporated into the patent by certificate issued after the expiration of the patent.

(b) Amendments made to a patent during a reexamination proceeding will not be effective until a reexamination certificate is issued.

§ 1.943 Length of responses and briefs.

Responses and appellant briefs by the patent owner (including amendments) and third party requester, if any, shall not exceed 50 pages in length, excluding Appendix of claims and reference materials such as prior art references. All further briefs by any party shall not exceed 35 pages in length.

§ 1.945 Response by patent owner.

The patent owner will be given at least thirty (30) days to respond to any Office action. Such response may include arguments in response to any rejections and/or proposed amendments or new claims to place the patent in condition where all claims, if amended as proposed, would be patentable.

§ 1.947 Response by third party requester to patent owner's response.

If the patent owner files a response to an Office action, any third party requester may once file written comments within a period of one month from the date of service of the patent owner's response. These comments shall be limited to issues covered by the action or the patent owner's response.

§ 1.949 Examiner's Office action closing prosecution.

Upon consideration of the issues and/or grounds of rejection a second or subsequent time, or upon allowance of all claims, the examiner shall issue an Office action treating all claims present in the reexamination proceeding, which may be an action closing prosecution. An action will not normally 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 Responses after Office action closing prosecution.

After any action closing prosecution issued by the examiner, the third party requester may once file written comments limited to the issues raised in the Office action closing prosecution. Such comments must be filed within the time set for response in the action closing prosecution. When the third party requester does file such comments, the patent owner may file comments responding to the third party requester's comments within one month from the date of service of the third party requester's comments on the patent owner.

(b) After any action closing prosecution issued by the examiner, the patent owner may once file written comments limited to the issues raised in the reexamination proceeding and/or present a proposed amendment to the claims which amendment will be subject to the criteria of § 1.116 as to whether it shall be entered and/or considered. Such comments and/or proposed amendments must be filed within the time set for response in the action closing prosecution. Where the patent owner does file such comments and/or proposed amendment, the third party requester may file comments responding to such comments and/or proposed amendments by the patent owner within one month from the date of service of patent owner's comments and/or proposed amendment on the third party requester.

§ 1.953 Examiner's Right of Appeal Notice.

Upon considering the responses of the patent owner and any third party requester subsequent to the Office action closing prosecution, or upon expiration of the time for submitting such responses, the examiner shall issue a "Right of Appeal Notice," unless the examiner reopens prosecution. The "Right of Appeal Notice" shall include a final rejection and/or final decision favorable to patentability which shall identify the status of each claim and reasons for patentability or grounds of rejection for each claim. It shall set a 30-day or one month time period, whichever is longer, for either party to appeal. If no appeal follows, 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.

Interviews

§ 1.955 Interviews in reexamination proceedings.

(a) Interviews in reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be had 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 should be arranged for in advance. A third party requester may not initiate an interview. A third party requester has a right to participate in an interview initiated by the patent owner or the examiner and must be given adequate notice and opportunity to participate. A senior level Office official will be present when the interview is attended by a third party requester.

(b) Interviews for the discussion of the patentability of claims in patents involved in reexamination proceedings will not be initiated by the patent owner prior to the first Office action thereon.

(c) In every instance of an interview with an examiner, each party must present a statement of the issues which were discussed. An interview does not remove the necessity for response to Office actions as specified in § 1.111.

Extensions of Time and Revival of Proceedings

§ 1.957 Extensions of time and cause for termination in reexamination proceedings.

(a) The time for taking any action by a patent owner or third party requester in a 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 or third party requester 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.

(b) If the patent owner fails to file a timely and appropriate response to any Office action in a 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, unless there is a third party requester and claims are found patentable.

(c) If there is a third party requester and claims are found patentable, and the patent owner fails to file a timely and appropriate response to any action in a reexamination proceeding,

prosecution will be limited to claims found patentable at the time of the failure to respond and to claims which do not enlarge the scope of the claims found patentable at that time.

§ 1.958 Revival of terminated proceedings.

(a) A reexamination proceeding terminated for failure to prosecute may be revived as a pending proceeding if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A petition to revive an unavoidably terminated reexamination proceeding must be promptly filed after the patent owner is notified of, or otherwise becomes aware of, the termination of the proceeding, and must be accompanied by:

(1) a proposed response to continue prosecution of that proceeding unless it has been previously filed;

(2) the petition fee as set forth in § 1.17(l); and

(3) a showing that the delay was unavoidable. The showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(b) A reexamination proceeding terminated for failure of the patent owner to prosecute may be revived as a pending proceeding if the delay in prosecution was unintentional. A petition to revive an unintentionally terminated reexamination proceeding must be:

(1) accompanied by a proposed response to continue prosecution of that proceeding unless it has been previously filed;

(2) accompanied by the petition fee as set forth in § 1.17(m);

(3) accompanied by a statement that the delay was unintentional. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) filed either:

(i) within two months of the date of the first Office notification that the proceeding has been terminated; or

(ii) within two months of the date of the first decision on a petition to revive under paragraph (a) of this section which was timely filed within the time period set forth in paragraph (b)(4)(i) of this section.

(c) Any request for reconsideration or review of a decision refusing to revive a proceeding upon petition filed pursuant to paragraph (a) or (b) of this section, to be considered timely, must be filed within two months of the

decision refusing to revive or within such time as set in the decision.

(d) The time periods set forth in this section cannot be extended, except that the time period set forth in paragraph (c) of this section may be extended under the provisions of § 1.957(a).

Appeal to the Board of Patent Appeals and Interferences

§ 1.959 Notice of appeal and cross appeal to Board of Patent Appeals and Interferences.

(a) (1) Once a "Right of Appeal Notice" has been issued, by filing a notice of appeal within the time provided in § 1.953 and paying the fee set forth in § 1.17(e), the patent owner may appeal to the Board of Patent Appeals and Interferences with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent.

(2) Once a "Right of Appeal Notice" has been issued, by filing a notice of appeal within the time provided in § 1.953 and paying the fee set forth in § 1.17(e), a third party requester involved in a reexamination proceeding may appeal to the Board of Patent Appeals and Interferences with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent.

(b) (1) Within fourteen days of service of a third party requester's notice of appeal, and upon payment of the fee set forth in § 1.17(e), a patent owner who has not filed a notice of appeal may file a notice of cross appeal with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent.

(2) Within fourteen days of service of a patent owner's notice of appeal, and upon payment of the fee set forth in § 1.17(e), 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 of any original or proposed amended or new claim of the patent.

(c) The appeal in a reexamination proceeding must identify the claim(s) appealed, and must be signed by the patent owner or third party requester, or their duly authorized attorney or agent.

(d) An appeal when taken must be taken from the rejection of all claims under rejection in a Right of Appeal Notice which the patent owner proposes to contest, or from the determination of patentability of all claims indicated as patentable in a Right of Appeal Notice which the 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 can be considered.

(e) The time periods set forth in §§ 1.959 through 1.969 are subject to the provisions of § 1.957(a) for reexamination proceedings. See § 1.304(a) for extensions of time for filing a notice of appeal of the U.S. Court of Appeals for the Federal Circuit.

§ 1.961 Jurisdiction over appeal.

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

§ 1.962 Appellant and respondent defined.

For the purposes of reexamination, appellant is any party filing a notice of appeal. A respondent is any opposing party responding to the appeal of the appellant. If more than one party appeals, each is an appellant with respect to the claims to which his or her appeal is directed and, to the extent each responds, each is a respondent with respect to the claims to which his or her opponent's appeal is directed.

§ 1.963 Time for filing briefs.

(a) If a party files a notice of appeal or cross appeal, the party must file an appellant brief within two months of the date of filing of their notice of appeal or cross appeal. However, if another party files a notice of appeal or cross appeal subsequent to that of the party, then the party must file an appeal brief within two months of the date of filing of the subsequent notice of appeal or cross appeal, so that the appellant briefs of all parties filing a notice of appeal or cross appeal will be due no later than two months after the last-filed notice.

(b) Once an appellant brief has been properly filed, an opposing party may file a respondent brief within one month from the date of service of the appellant brief. The examiner will consider both the appellant and respondent briefs and prepare an examiner's answer.

(c) The third party requester and the patent owner may each file a reply brief within one month of the date of the examiner's answer. No further brief will be acknowledged or considered.

§ 1.965 Appellant brief.

(a) Appellant(s) shall, within time limits for filing set forth in § 1.963, file a brief in triplicate and serve the brief on all parties in accordance with § 1.903. The brief must be accompanied by the requisite fee set forth in § 1.17(f) and must set forth the authorities and

arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

(b) On failure of a party to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed with respect to the claims appealed by that party.

(c) The 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:

(1) *Real Party in Interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not 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 Board's decision in the pending appeal.

(3) *Status of Claims.* A statement of the status of all the claims, pending or cancelled, and identifying the claims appealed.

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

(5) *Summary of Invention.* A concise explanation of the invention or subject matter defined in the claims involved in the appeal, which shall refer 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.

(7) *Grouping of Claims.* For each ground of rejection, or, in the case where the appeal is by a third party requester, each determination of patentability or determination of inapplicability of a proposed rejection, which appellant contests and which applies to a group of two or more claims, the Board 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 or unpatentable. 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 basis therefor, with citations of the authorities, statutes, and parts of the record relief on. Each issue should be treated under a separate heading.

(i) For each rejection or, in the case where the appeal is by a third party requester, any other determination under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection or other determination and how the first paragraph of 35 U.S.C. 112 is or is not complied with, including, as appropriate, how the specification and drawings, if any,

(A) describe or fail to describe the subject matter defined by each of the appealed claims, and

(B) enable or fail to enable any person skilled in the art to make and use the subject matter defined by each of the appealed claims, and

(ii) For each rejection, or in the case where the appeal is filed by a third party requester, any determination, under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection or other determination and how the claims do or do not particularly point out and distinctly claim the subject matter which appellant regards as the invention.

(iii) For each rejection or, in the case where the appeal is by a third party requester, each determination of patentability, under 35 U.S.C. 102, the argument shall specify the errors in the rejection or determination and why the appealed claims are or are not patentable under 35 U.S.C. 102, including any specific limitations in the appealed claims which are not described in the prior art.

(iv) For each rejection or, in the case where the appeal is by a third party requester, each determination of patentability under 35 U.S.C. 103, the argument shall specify the errors in the rejection or determination and, if appropriate, the specific limitations in the appealed claims which are or are not described in the prior art, and shall explain how such limitations render the claimed subject matter obvious or unobvious over the prior art. If the rejection or determination is based upon a combination of references, the argument shall explain why the references, taken as a whole, do or do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may or may not properly be combined with

features disclosed in another reference. A general argument that all the limitations are or are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection or, in the case where the appeal is by a third party requester, any determination of patentability, other than those referred to in paragraphs (c)(8)(i) to (iv) of this section, the argument shall specify the errors in the rejection or other determination and the specific limitations in the appealed claims, if appropriate, or other reasons, which cause the rejection or other determination to be in error.

(9) *Appendix.* An appendix containing a copy of the claims involved in the appeal.

(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 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, the appeal will stand dismissed as to that party.

§ 1.967 Respondent brief.

(a) The brief(s) if the respondent(s) specified in § 1.963 must be filed in triplicate, served on all other parties in accordance with § 1.903 and be accompanied by the requisite fee set forth in § 1.17(f). 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.

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

(1) *Real party in Interest.* A statement identifying the real party in interest, if the party named as the respondent in the brief is not 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 Board's decision in the pending appeal.

(3) *Status of claims.* A statement accepting or disputing appellant's

statement of the status of claims. If appellant's statement of the status of claims is disputed, the errors in appellant's statement must be specified with particularity.

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

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

(6) *Issues.* A statement accepting or disputing appellant's statement of the issues presented for review and identifying any examiner's determination not to make a rejection proposed by the third party requester. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified with particularity. A counter statement of the issues for review may be made.

(7) *Grouping of claims.* A statement accepting or disputing any statement by appellant that allowed or rejected claims stand or fall together. If appellant's statement is disputed, the errors in appellant's statement must be specified with particularity. A counter statement may be made.

(8) *Argument.* A statement accepting or disputing the contentions of the appellant with respect to each of the issues. If a contention of the appellant or a determination of the examiner not to make a rejection proposed by the requester is disputed, the errors in appellant's argument or examiner's determination must be specified with particularity, stating the basis therefor, with citations of the authorities, statutes and parts of the record relied on. Each issue should be treated under a separate heading. An argument may be made with respect to 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 103.

(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 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 received into the record and will not be considered.

§ 1.969 Examiner's answer.

The primary examiner may, within such time as may be 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 such explanation of the invention claimed and of the references and grounds of rejection or reasons for patentability as may be necessary, supplying a copy to the patent owner and each third party requester, if any. If the primary examiner shall find that the appeal is not regular in form or does not relate to an appealable action, he or she shall so state and a petition from such decision may be taken to the Commissioner as provided in § 1.181.

§ 1.971 Reply brief.

(A) The patent owner and any third party requester may each file a reply brief directed only to such new points of argument as may be raised in the examiner's answer, within one month from the date of such answer. The new points of argument shall be specifically identified in the reply brief. If the examiner determines that the reply brief is not directly only to new points of argument raised in the examiner's answer, the examiner may refuse entry of the reply brief and will so notify the appellant.

(b) If the examiner's answer expressly states that it includes a new ground of rejection or allowance of claims not previously allowed, the party adversely affected must file a reply thereto within one month from the date of such answer to avoid dismissal of the appeal as to the claims subject to the new ground of rejection or allowance; such reply may be accompanied by any amendment (in the case of the patent owner) or material appropriate to the new ground. See § 1.957 for extensions of time for filing a reply brief.

§ 1.973 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which the appellant, or a respondent who has filed a respondent brief under § 1.967, 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 appellant, or a respondent who has filed a respondent brief under § 1.967, desires an oral hearing, he or she must file a written request for such hearing accompanied by the fee set forth in § 1.17(g) within one month after the date of the examiner's answer. If appellant, or a respondent who has filed a respondent brief under § 1.967, requests an oral hearing and submits therewith the fee set forth in § 1.17(g), an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. See § 1.957 for extensions of time in a reexamination proceeding.

(c) If no request and fee for oral hearing have been timely filed by an appellant or a respondent who has filed a respondent brief under § 1.967, the appeal will be assigned for consideration and decision. If an appellant or respondent who has filed a respondent brief under § 1.967 has requested an oral hearing and has submitted the fee set forth in § 1.17(g), a hearing date will be set, and notice thereof given to each appellant, to the primary examiner and to each respondent who has filed a respondent brief under § 1.967. The notice shall set a period within which all requests for oral hearing shall be submitted. Hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for each appellant and respondent, and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins.

§ 1.975 Affidavits or declarations after appeal.

Affidavits, declarations, or exhibits submitted after the case 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.

(a) The Board of Patent Appeals and Interferences, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner, or on the grounds presented by a third party requester, or remand the reexamination proceeding to the examiner for further consideration. The affirmance of the rejection or allowance of a claim on any of the grounds

specified constitutes a general affirmation of the decision of the examiner on that claim, except as to any ground specifically reversed or otherwise stated. A rejection of claims by the examiner may also be affirmed on the basis of the arguments presented by the third party requester.

(b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds for rejecting any appealed claim not raised in the appeal, it may include in the decision a statement to that effect with its reasons for so holding, which statement shall constitute a new rejection of the claims. A new rejection shall not be considered final for purposes of judicial review. When the Board of Patent Appeals and Interferences makes a new rejection of an appealed claim, the patent owner may exercise one of the following two options with respect to the new ground:

(1) The patent owner may submit an appropriate amendment of the claims so rejected or a showing of facts, or both, and have the matter reconsidered by the examiner, in which event the patent 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 for rejection stated in the decision. Should the examiner again reject the claims, the patent owner may again appeal to the Board of Patent Appeals and Interferences.

(2) The patent owner may have the case reconsidered under § 1.979(b) by the Board of Patent Appeals and Interferences upon the same record. The request for reconsideration shall address the new ground for rejection and state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which reconsideration is sought. Where request for such reconsideration is made, the Board of Patent Appeals and Interferences shall reconsider the new ground for rejection and, if necessary, rendered a new decision which shall include all grounds upon which a patent is refused. The decision on reconsideration is deemed to incorporate the earlier decision, except for those portions specifically withdrawn on reconsideration, and is final for the purpose of judicial review.

(c) Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, patent owner shall have the right to

amend in conformity with such statement which shall be binding on the examiner in the absence of new references or grounds of rejection.

(d) Although the Board of Patent Appeals and Interferences normally will confine its decision to a review of rejections and allowances made by the examiner and/or arguments of the third party requester, should it have knowledge of any grounds for rejecting any allowed claim not advanced by the examiner or third party requester, it may recommend a rejection of the claim in its decision and remand the case to the examiner. In such event, the Board shall set a period, not less than one month, within which the patent owner may submit to the examiner an appropriate amendment, a showing of facts or reasons, or both, in order to avoid any grounds for rejection set forth in the recommendation of the Board of Patent Appeals and Interferences. The examiner shall be bound by any such recommended rejection and shall enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recommended rejection. Should the examiner make the recommended rejection final the patent owner may again appeal to the Board of Patent Appeals and Interferences.

(e) Whenever a decision of the Board of Patent Appeals and Interferences includes a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

(f) See § 1.957(a) for extensions of time to take action under this section.

§ 1.979 Action following decision.

(a) After decision by the Board of Patent Appeals and Interferences, the case shall be returned to the examiner, subject to a right of appeal or other review by the appellant or respondent, for such further action by the patent owner or by the examiner, as the condition of the case may require, to carry into effect the decision.

(b) Each party may file a single request for reconsideration or modification of the decision if filed within one month from the date of the original decision, unless that decision is so modified by the decision on reconsideration as to become, the effect, a new decision, and the Board of Patent Appeals and Interferences so states. The request for reconsideration shall state with particularity the points believed to

have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which reconsideration is sought. See § 1.957(a) for extensions of time for seeking reconsideration.

(c) The appeal proceedings are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the U.S. Court of Appeals for the Federal Circuit. The date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the Federal Circuit expires. If an appeal to the Federal Circuit has been filed, proceedings are considered terminated when the appeal is terminated. An appeal to the Federal Circuit is terminated when the mandate is received by the Office. Upon termination of the reexamination proceeding, the Commission will issue a certificate under § 1.997.

§ 1.981 Reopening after decision.

(a) 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 § 1.979 without the written authority of the Commissioner, and then only for the reconsideration of matters not already adjudicated, sufficient cause being shown.

(b) In the event prosecution is reopened or the case is reconsidered by the primary examiner after decision by the Board of Patent Appeals and Interferences or by the U.S. Court of Appeals for the Federal Circuit, any third party requester who appealed or responded under § 1.967 may again present comments pursuant to § 1.947 and may appeal or participate in an appeal by the patent owner pursuant to § 1.959.

Appeal to the United States Court of Appeals for the Federal Circuit

§ 1.983 Appeal to the United States Court of Appeals for the Federal Circuit.

Any third party requester or patent owner involved in a reexamination proceeding who is a party to any appeal to the Board of Patent Appeals and Interferences and who is 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 and may be a party to any appeal thereto taken from a reexamination decision of the Board of Patent Appeals and Interferences. The appellant must take the following steps in such an appeal:

(a) in the Patent and Trademark Office file a written notice of appeal directed

to the Commissioner (see §§ 1.302 and 1.304); and

(b) in the Court, file a copy of the notice of appeal and pay the fee, as provided for in the rules of the Court. A third party requester is deemed not to have participated as a party to an appeal by the patent owner, and thereby not subject to § 1.909, unless within twenty days after the patent owner has filed notice of appeal pursuant to § 1.983(a), the third party requester files notice with the Commissioner electing to participate.

Proceedings Involving Same Patent as in Reexamination

§ 1.985 Notification of prior or concurrent proceedings.

Any person at any time may file a paper in a reexamination proceeding notifying the Office of a prior or concurrent proceeding in which the same patent is or was involved, such as interferences, reissues, reexaminations, 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 reexamination proceeding.

§ 1.987 Stay of concurrent proceeding.

If a patent in the process of reexamination is or becomes involved in litigation or a reissue application for the patent is filed or pending, the Commissioner shall determine whether or not to stay the reexamination or reissue proceeding.

§ 1.989 Merger of concurrent reexamination proceedings.

(a) If reexamination is ordered while a prior reexamination proceeding is pending for the same patent, the reexamination proceedings will be merged and result in the issuance of a single certificate under § 1.997.

(b) A reexamination proceeding filed under § 1.915 which is merged with a reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.901–1.997.

§ 1.991 Merger of concurrent reissue application and reexamination proceeding.

If a reissue application and a reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending on a patent, a decision may be made to merge the two proceedings or to stay one of the two proceedings. Where merger is a reissue application and a 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 reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding, participation by the third party requester shall be limited to issues within the scope of 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 reexamination proceeding and be physically entered into both files. Any reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissue patent.

§ 1.993 Stay of concurrent interference and reexamination proceeding.

If a patent in the process of reexamination is or becomes involved in an interference, the Commissioner may stay reexamination or the interference. The Commissioner will not consider a request to stay an interference unless a motion (§ 1.635) to stay 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 a stay 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 a 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.

Certificate

§ 1.997 Issuance of reexamination certificate after reexamination proceedings.

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

(b) A certificate will be issued in each patent in which a 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 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 certificate will also be mailed to the requester of the reexamination proceeding.

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

(e) If the reexamination proceeding is terminated by the grant of a reissued patent as provided in § 1.965(d), the reissued patent will constitute the reexamination certificate required by this section and 35 U.S.C. 307.

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

Dated: August 1, 1995.

Bruce A. Lehman,

*Assistant Secretary of Commerce and
Commissioner of Patents and Trademarks.*

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ENVIRONMENTAL PROTECTION AGENCY

40 CFR Part 300

[FRL–5269–7]

National Oil and Hazardous Substance Contingency Plan; National Priorities List Update

AGENCY: Environmental Protection Agency.

ACTION: Notice of intent to delete Ossineke Groundwater Contamination Site.

SUMMARY: The Environmental Protection Agency (EPA) announces its intent to delete the Ossineke Groundwater Contamination Site (the "OGC Site"), from the National Priorities List (NPL), 40 CFR part 300, appendix B, and requests public comment on this action. The NPL constitutes appendix B to the National Oil and Hazardous Substances Pollution Contingency Plan (NCP), which EPA promulgated pursuant to section 105 of the Comprehensive Environmental Response, Compensation, and Liability Act of 1980 (CERCLA), as amended. This action to delete the OGC Site from the NPL is proposed because EPA's Office of Superfund (OSF) and the State of Michigan Department of Natural Resources (MDNR) have determined that using the Hazardous Substance Superfund (the "Fund") to fund further