for clinical study growth data rather than the NCHS growth charts.

(Issue 6c) In proposed § 106.97(a)(1)(i)(A), the agency would require that manufacturers conduct clinical studies that are no less than 4 months in duration, enrolling infants no more than 1 month old at time of entry into the study. The IFS of the FAC recommended that infants be enrolled by 14 days of age. FDA requests comments on the appropriate age for infants enrollment into clinical studies and on the duration of the studies.

(Issue 7) In proposed § 106.97(a)(1)(ii), the agency states provisions that it recommends manufacturers include in a clinical study protocol. Proposed § 106.97(a)(1)(ii)(C) discusses review and approval by an Institutional Review Board (IRB) in accordance with part 56 (21 CFR part 56), and the need for obtaining written informed consent from parents or legal representatives of the infants in accordance with part 50 (21 CFR part 50). Subsequent to the publication of the 1996 proposal, the agency issued an interim final rule entitled ''Additional Safeguards for Children in Clinical Investigations of FDA-Regulated Products'' (66 FR 20589, April 24, 2001), which amended parts 50 and 56 to include, within the scope of that rule, data and information about a clinical study of an infant formula when submitted as part of an infant formula notification under section 412(c) of the act. Thus, requirements related to IRB review and informed consent for such clinical studies are dealt with in that interim final rule, and therefore, reference to IRB review and informed consent will be removed from the 1996 proposal. With respect to the other clinical study protocol provisions in proposed § 106.97(a)(1)(ii), the agency intends to remove them from the proposed rule and develop a guidance document on what it recommends be included in a clinical study protocol for infant formula that is submitted as part of an infant formula notification under section 412(c) of the act.

III. How to Submit Comments

Interested persons may submit to the Dockets Management Branch (*see* **ADDRESSES**) written or electronic comments regarding this document. Submit a single copy of electronic comments to *http://www.fda.gov/dockets/ecomments* or two paper copies of any mailed comments, except that individuals may submit one paper copy. Comments are to be identified with the docket number found in brackets in the heading of this document. Received comments may be seen in the Docket Management Branch between 9 a.m. and 4 p.m., Monday through Friday.

IV. References

FDA has placed the following references on display in the Dockets Management Branch (*see* **ADDRESSES**) and may be seen by interested persons between 9 a.m. and 4 p.m., Monday through Friday.

1. Centers for Disease Control and Prevention, ''*Enterobacter sakazakii* Infections Associated With the Use of Powdered Infant Formula–Tennessee, 2001,'' 51(14):297, *Morbidity and Mortality Weekly Report*, April 12, 2002.

2. FDA, Agency response letter to GRAS notice number GRN 00049, March 19, 2002.

Dated: April 15, 2003.

Jeffrey Shuren,

Assistant Commissioner for Policy.

[FR Doc. 03–10301 Filed 4–25–03; 8:45 am]

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DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No.: 2003–P–001]

RIN 0651–AB57

Changes To Implement the 2002 *Inter Partes* Reexamination and Other Technical Amendments to the Patent Statute

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The 21st Century Department of Justice Appropriations Authorization Act contains a title relating to intellectual property. The patent-related provisions in the intellectual property title of the 21st Century Department of Justice Appropriations Authorization Act include provisions permitting a third party requester in an *inter partes* reexamination proceeding to appeal a final decision by the Board of Patent Appeals and Interferences (BPAI) to the U.S. Court of Appeals for the Federal Circuit (Federal Circuit), and to participate in the patent owner's appeal of a final decision by the BPAI to the Federal Circuit. Also included are technical amendments to statutory provisions directed to *inter partes* reexamination, 18-month publication of patent applications and provisional rights, and issuance of patents. The United States Patent and Trademark Office (Office) is in this notice proposing changes to the rules of practice to implement the patent-related provisions of the 21st Century Department of Justice Appropriations Authorization Act, and other miscellaneous changes related to appeals in reexamination proceedings.

DATES: To be ensured of consideration, written comments must be received on or before June 27, 2003. No public hearing will be held.

ADDRESSES: Comments should be sent by electronic mail message over the Internet addressed to *AB57Comments@uspto.gov.* Comments may also be submitted by mail addressed to: Box Comments—Patents, Commissioner for Patents, Washington, DC 20231, or by facsimile to (703) 872–9408, marked to the attention of Kenneth M. Schor, Senior Legal Advisor. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. If comments are submitted by mail, the Office prefers that the comments be submitted on a DOS formatted 3½ inch disk accompanied by a paper copy.

The comments will be available for public inspection at the Office of the Commissioner for Patents, located in Crystal Park 2, Suite 910, 2121 Crystal Drive, Arlington, Virginia, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: *http://www.uspto.gov*). Since comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Kenneth M. Schor or Gerald A. Dost, Senior Legal Advisors. Kenneth M. Schor may be contacted by telephone at (703) 308–6710; by mail addressed to: U.S. Patent and Trademark Office, Box Comments—Patents, Commissioner for Patents, Washington, DC 20231, marked to the attention of Kenneth M. Schor; by facsimile transmission to (703) 872–9408, marked to the attention of Kenneth M. Schor; or by electronic mail message over the Internet addressed to *kenneth.schor@uspto.gov.* Gerald A. Dost may be contacted by telephone at (703) 305–8610; by mail addressed to: U.S. Patent and Trademark Office, Box Comments—Patents, Commissioner for Patents, Washington, DC 20231, marked to the attention of Gerald A. Dost; by facsimile transmission to (703) 308–6916, marked to the attention of Gerald A. Dost; or by electronic mail message over the Internet addressed to *gerald.dost@uspto.gov.*

SUPPLEMENTARY INFORMATION: The American Inventors Protection Act of 1999 (AIPA), enacted on November 29,

1999, contained a number of changes to title 35, United States Code (U.S.C.). *See* Pub. L. 106–113, 113 Stat. 1501, 1501A–552 through 1501A–591 (1999). The 21st Century Department of Justice Appropriations Authorization Act, enacted on November 2, 2002, contained technical corrections to the AIPA as well as other technical amendments to title 35, U.S.C. *See* Pub. L. 107–273, 116 Stat. 1758, 1899–1906 (2002). This notice proposes changes to the rules of practice in title 37 CFR to implement the patent-related provisions of the 21st Century Department of Justice Appropriations Authorization Act (and other related miscellaneous changes).

I. Third Party Requester Appeal Rights to United States Court of Appeals for the Federal Circuit: Optional *inter partes* reexamination was newly enacted in the AIPA. The AIPA provided that the patent owner in an *inter partes* reexamination could appeal a decision of the BPAI (adverse to patent owner) to the Federal Circuit. The third party requester of the *inter partes* reexamination, however, was specifically precluded from appealing a decision of the BPAI to the Federal Circuit. 35 U.S.C. 134(c). In addition, no provision was made in the statute for the third party requester to be a party to, *i.e.,* participate in, an appeal taken by the patent owner to the Federal Circuit.

The Office published a final rule in December of 2000 revising the rules of practice in patent cases to implement the optional *inter partes* reexamination provisions of the AIPA. *See Rules to Implement Optional Inter Partes Reexamination Proceedings,* 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule). In this final rule, § 1.983 was promulgated to track the patent owner's statutory right, under 35 U.S.C. 141, to appeal to the Federal Circuit in *inter partes* reexamination proceedings. Because the third-party requester of an *inter partes* reexamination was explicitly precluded under 35 U.S.C. 134(c) from appealing the decision of the BPAI to the Federal Circuit, no such provision of the rules was provided. Likewise, because there was no authority in the statute for the third party requester to participate in an appeal taken by the patent owner to the Federal Circuit, no such provision of the rules was provided. Finally, because the third-party requester of an *inter partes* reexamination was precluded under 35 U.S.C. 134(c) from appealing the decision of the BPAI to the Federal Circuit, no provision in the rules concerning patent owner participation in a third-party requester appeal was provided.

Section 13106 of Public Law 107–273 grants the *inter partes* reexamination third party requester the right to appeal an adverse decision of the BPAI to the Federal Circuit. 35 U.S.C. 315(b)(1). It further authorizes the third party requester to be a party to any appeal taken by the patent owner to the Federal Circuit. 35 U.S.C. 315(b)(1). Moreover, section 13106 also permits the patent owner to be a party to an appeal taken by the third party requester to the Federal Circuit. This is so because 35 U.S.C. 315(a)(2) as enacted by the AIPA states that the patent owner involved in an *inter partes* reexamination proceeding ''may be a party to any appeal taken by a third-party requester under subsection (b).''

It is being proposed that § 1.983 be amended to implement this statutory revision, and conforming/ancillary amendments be made to §§ 1.301, 1.304, and 1.979.

II. *Technical amendments to the inter partes reexamination provisions of the American Inventors Protection Act of 1999:* Section 13202 of Public Law 107–273 made technical corrections to statutory provisions directed to *inter partes* and *ex parte* reexamination. Amendments to §§ 1.191, 1.303, and 1.913 are being proposed to address the *inter partes* and *ex parte* reexamination technical corrections.

III. Other miscellaneous changes made as to reexamination: Additionally, revision of the *inter partes* reexamination rules is being proposed to avoid the loss of appeal rights during appeals to the BPAI due to certain inadvertent errors on the part of the patent owner or third party requester. Revision of the *inter partes* reexamination rules is also being proposed to expedite the prosecution leading to the appeal stage. Finally, revision is proposed for clarifying the *inter partes* and *ex parte* reexamination appeal rules. Amendments to these ends are proposed below for §§ 1.302, 1.949, 1.953, 1.959, 1.965, 1.967, 1.971, and 1.977.

IV. Patent and Trademark Efficiency Act Amendments: Section 13203 of Public Law 107–273 is directed to efficiency amendments to the statute. It is proposed that § 1.13(b) be amended to eliminate its requirement for an attestation for certified copies of documents, similar to the elimination of the attestation requirement in 35 U.S.C. 153 as provided in section 13203(c) of Public Law 107–273.

V. Technical amendment related to eighteen-month publication of applications and provisional rights: Sections 13203(c), 13204 and 13205 of Public Law 107–273 made technical corrections to provisions directed to the eighteen-month publication of patent applications and provisional rights, and the issuance of patents. The proposed changes to §§ 1.14, 1.78, 1.417, and 1.495 are directed to implementation of the statutory revisions made by these sections of Public Law 107–273.

Section-by-Section Discussion

Section 1.1: It is proposed that § 1.1(c) be amended to provide separate mail stops for *ex parte* reexamination proceedings and for *inter partes* reexamination proceedings. It is also proposed that § 1.1(c) be amended to make it clear that the mail stop for *ex parte* reexamination proceedings is only for the original request papers for *ex parte* reexamination. The new mail stop for *inter partes* reexamination would be for original request papers and all subsequent correspondence filed in the Office (other than correspondence to the Office of the Solicitor pursuant to § 1.1(a)(3) and § 1.302(c)), since the nature of such proceedings is complex and correspondence is best handled at a central location, where the personnel have specific expertise in *inter partes* reexamination.

Section 1.13: It is proposed that § 1.13(b) be amended to delete ''attested by an officer of the United States Patent and Trademark Office authorized by the Director.'' Section 13203(c) of Public Law 107–273 eliminated the requirement in 35 U.S.C. 153 that the signature of the Director for issued patents be attested to by an officer of the Office. To achieve further efficiencies, it is proposed that certified copies of documents would no longer include an attestation for the Director's signature. Accordingly, it is proposed that § 1.13(b) be amended to eliminate the requirement for an attestation for certified copies of documents.

Section 1.14: It is proposed that § 1.14(i)(2) be amended by inserting ''of the publication'' after ''English language translation'' in the sole sentence of the paragraph. Section 13204 of Public Law 107–273 made a technical change to the provisional rights provisions of the patent statute as to international applications to clarify that a translation of the international publication, as opposed to the international application, is required to be filed in order for a patent owner to obtain provisional rights pursuant to 35 U.S.C. 154(d). In view of this change to the statute, the corresponding reference to the translation in § 1.14 is proposed to be changed to add ''the publication of an international application'' after ''English language translation of.'' In addition, it is proposed that the

parenthetical phrase at the end of paragraph (i)(2), referencing the fee for a copy of a document in a file, be corrected to refer to § 1.19(b)(4) rather than § 1.19(b)(2) or (3).

Section 1.78: It is proposed that § 1.78, paragraph (a)(3), be amended by deleting the phrase ''in a nonprovisional application'' in the first sentence of the paragraph.

Section 4508 of the AIPA as originally enacted did not make the 18-month publication amendments to 35 U.S.C. 119 and 120 applicable to an international application unless and until it enters the national stage under 35 U.S.C. 371. *See* Public Law 106–113, 113 Stat. at 1501A–566 through 1501A–567. Section 13205 of Public Law 107–273 amended section 4508 of the AIPA to make the 18-month publication amendments to 35 U.S.C. 119 and 120 also applicable during the international stage of an international application. With regard to international applications, § 1.78(a)(2)(ii) requires that the reference required by § 1.78(a)(2)(i) be submitted: (1) During the pendency of the later-filed application; and (2) within the later of (A) four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or (B) 16 months from the filing date of the prior-filed application. An abandoned international application is not a nonprovisional application; thus, as § 1.78(a)(3) currently reads, the petition procedure set forth in § 1.78(a)(3) would not be applicable to a delayed priority claim in an abandoned international application. If the presently proposed amendment to § 1.78(a)(3) is adopted, then the petition procedure set forth in § 1.78(a)(3) would be applicable to submitting a delayed priority claim in an abandoned international application including an international application that has not entered the national stage under 35 U.S.C. 371. In view of the statutory change to the applicability of the 18-month publication amendments to 35 U.S.C. 119 and 120 and the presently proposed change to § 1.78(a)(3), when filing a ''bypass'' continuation application under 35 U.S.C. 111(a) that claims the benefit of the international application with a filing date on or after November 29, 2000, that could have but did not claim the benefit of an earlier U.S. application and the benefit claim is to be added, a petition under § 1.78(a)(3) will be required in the international application. A ''bypass'' continuation application is an application for patent filed under 35 U.S.C. 111(a) that claims the benefit of the filing date of an earlier international application that did not enter the national stage under 35 U.S.C. 371. *See* H.R. Rep. No. 107–685, at 222 (2002). Thus, applicants should no longer rely upon the advice that to amend a later-filed abandoned international application to add a claim to the benefit of a prior-filed nonprovisional application, or a prior-filed international application designating the United States, an applicant need only file a petition under § 1.182 to amend an abandoned application (the later-filed international application) with the claim to the benefit of a prior-filed application. *See Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications,* 66 FR 67087, 67092 (Dec. 28, 2001), 1254 *Off. Gaz. Pat. Office* 121, 125 (Jan. 22, 2002) (final rule) (response to comment 6).

Section 1.191: It is proposed that § 1.191 be amended by revising paragraph (a) to delete each appearance of ''for a patent that issued from an original application filed in the United States.'' Section 13202(d) of Public Law 107–273 provided a technical correction for the effective date set forth in the AIPA for appeals to the BPAI as follows:

> Effective Date—The amendments made by section 4605(b), (c), and (e) of the Intellectual Property and Communications Omnibus Reform Act, as enacted by section 1000(a)(9) of Public Law 106–113, shall apply to any reexamination filed in the United States Patent and Trademark Office on or after the date of enactment of Public Law 106–113.

The effective date language in section 4608 of the AIPA limited the applicability of the conforming amendments to 35 U.S.C. 134 to a reexamination of a patent that issued from an original application which was filed on or after November 29, 1999. Thus, the conforming amendments to 35 U.S.C. 134 applied only to those *ex parte* reexamination proceedings filed under § 1.510 for patents that issued from an original application which was filed on or after November 29, 1999. Public Law 107–273 revised the applicability of the conforming amendments to 35 U.S.C. 134 such that the conforming amendments are applicable to a reexamination of a patent where the request for *ex parte* reexamination was filed on or after November 29, 1999. Accordingly, § 1.191 is proposed to be amended to track the statutory revision of effective date.

Section 1.197: It is proposed that § 1.197(c) be amended to provide that an appeal to the Federal Circuit is terminated when the mandate is issued by the Court, rather than when the mandate is received by the Office. This proposed change to § 1.197(c) is for consistency with a 1998 amendment to rule 41 of the Federal Rules of Appellate Procedure. The commentary on the addition of subdivision (c) to rule 41 of the Federal Rules of Appellate Procedure indicates that this provision is intended to make clear that the court's mandate is effective upon issuance, and that its effectiveness is not delayed until receipt of the mandate by the trial court or agency, or until the trial court or agency acts upon the mandate.

Section 1.301: It is proposed that the last sentence of § 1.301 be amended by inserting ''appeals by patent owners and third party requesters in'' before ''*inter partes* reexamination proceedings.'' The revision would make it clear that appeals by third party requesters of *inter partes* reexamination proceedings are controlled by § 1.983.

Section 1.302: It is proposed that § 1.302 be revised by adding new paragraphs (c) and (d), and redesignating existing paragraph (c) as paragraph (e). New paragraph (c) would point out that when an appeal is taken to the Federal Circuit in an *ex parte* reexamination proceeding, the appellant must serve notice as provided in § 1.550(f). New paragraph (d) would point out that when an appeal is taken to the Federal Circuit in an *inter partes* reexamination proceeding, the appellant must serve notice as provided in § 1.903. The proposed revisions are made to focus parties on the unique service that must be made in *ex parte* and *inter partes* reexamination proceedings, when appealing to the Federal Circuit.

Section 1.303: It is proposed that § 1.303 be amended by revising paragraphs (a), (b) and (d) to delete the appearance of ''for a patent that issued from an original application filed in the United States'' in each paragraph. This proposed revision is made for the reasons stated in the above discussion of the proposed revision of § 1.191.

Section 1.304: It is proposed that § 1.304 be amended by revising paragraph (a)(1) to add after the second sentence, the following sentence: ''If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 1.979(a), the time for filing an appeal shall expire two months after action on the last such request made by the parties.'' In addition, reference to § 1.979(a) in the second sentence would be deleted. Further, it is proposed that all of the current provisions relating to interferences be included in § 1.304(i), and that § 1.304(ii) provide that in *inter partes* reexaminations, the time for

filing a cross-appeal expires: (1) 14 days after service of the notice of appeal; or (2) two months after the date of decision of the BPAI, whichever is later.

The proposed revision to § 1.304(a)(1) provides that an *inter partes* third party requester can appeal to the Federal Circuit and can participate in the patent owner's appeal to the Federal Circuit. The time for filing an appeal to the Federal Circuit will expire two months after ''action on the last such request made by the parties,'' as opposed to the sentence which precedes the added sentence where time for filing an appeal to the Federal Circuit is stated to expire two months after ''action on the request.'' Thus, the potential for rehearing or reconsideration by more than one party is factored into the time for appeal to the Federal Circuit. Since a party may not challenge a BPAI decision in an *inter partes* reexamination in a civil action under 35 U.S.C. 145, § 1.304(a)(1) provides that ''the time for filing an appeal shall expire * * *'' and not ''the time for filing an appeal or commencing a civil action * * *'' (which appears in the sentence which precedes the added sentence).

The proposed revision to § 1.304(a)(1) also conforms to the change proposed for § 1.983, by addressing the potential for cross appeal to the Federal Circuit in an *inter partes* reexamination (in addition to that in an interference).

Section 1.417: As pointed out in the discussion above of the proposed revision to § 1.14, the statute has been revised to clarify that a translation of the international publication, as opposed to the international application, must be filed in order for a patent owner to obtain the provisional right of a reasonable royalty under 35 U.S.C. 154(d). Accordingly, it is proposed that § 1.417 be amended: (1) To delete ''the international publication or''; (2) to add ''of the publication'' after ''English language translation''; and (3) to delete '', unless it is being submitted pursuant to § 1.495,''.

Section 1.495: It is proposed that § 1.495(c) be amended to change ''if it was originally filed in another language (35 U.S.C. 371(c)(2)'' to ''if the international application was originally filed in another language and if any English language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2)).'' The purpose of this revision is to clarify that if an English language translation of the publication has already been filed and the publication was also a translation of the international application, a second translation is not required. Instead, the translation required by 35 U.S.C. 154(d) will satisfy the requirement for a translation under 35 U.S.C. 371(c)(2). In § 1.495(g), it is proposed to delete '', except for a copy of the international publication or translation of the international application that is identified as provided in § 1.417,'' because the phrase is unnecessary, since it merely repeats a provision of § 1.417.

Section 1.913: It is proposed that § 1.913 be amended to add ''other than the patent owner or its privies'' after ''any person,'' as section 13202 of Public Law 107–273 now clarifies that there is statutory basis only for the third party requester to file a request for *inter partes* reexamination, and there is no such basis for a patent owner to do so. This position is consistent with the initial position taken by the Office during the implementation of optional *inter partes* reexamination. *See Rules to Implement Optional Inter Partes Reexamination Proceedings,* 65 FR 18153, 18178 (Apr. 6, 2000), 1234 *Off. Gaz. Pat. Office* 93, 116 (May 23, 2000) (proposed rule).

Sections 1.949 and 1.953: It is proposed that the clause ''or upon a determination of patentability of all claims'' be deleted from the first sentence of § 1.949, and the clause ''or upon a determination of patentability of all claims in the proceeding'' be added to § 1.953(a), so that § 1.953(a) would read as follows: ''Upon considering the comments of the patent owner and the third party requester subsequent to the Office action closing prosecution in an *inter partes* reexamination, or upon expiration of the time for submitting such comments, or upon a determination of patentability of all claims in the proceeding, the examiner shall issue a Right of Appeal Notice (RAN), unless the examiner reopens prosecution and issues another Office action on the merits'' (emphasis added in bold). This proposed change would be directed to streamlining prosecution in an *inter partes* reexamination by issuing a RAN under § 1.953 as soon as all claims in the proceeding are found patentable. This would be in contrast to the current procedure where an Action Closing Prosecution (ACP) under § 1.949 is issued upon a determination of patentability of all claims, and later a RAN must be issued. Thus, an extra Office action would be avoided by the current proposal.

Currently, where the examiner finds all claims to be patentable, an ACP would be issued even though the Office action being issued is the first action on the merits. The purpose in going directly to an ACP even in a first Office action is that the patent owner has nothing to respond to, upon learning that the claims are all patentable. Further, since the patent owner will not respond, the third party requester has nothing to comment upon, and is barred from filing a paper as to the merits. Statutory provision for requester's participation in the proceeding (prior to appeal) is only made for requester comments on a patent owner response. 35 U.S.C. 314(b)(3). Therefore, no reason exists to delay the closing of prosecution where all claims are found patentable, and the examiner thus issues an ACP directly. In implementing the optional *inter partes* reexamination proceedings provisions of the AIPA, the Office proposed that the examiner should not go directly to the RAN where all claims are found patentable, because that would deprive the third party requester of the right of filing comments on the examiner's Office actions prior to appeal (§ 1.951(a) as proposed provided that ''(a) After an action closing prosecution in an *inter partes* reexamination, a third-party requester may once file comments limited to the issues raised in the Office action closing prosecution''). *See Rules to Implement Optional Inter Partes Reexamination Proceedings,* 65 FR at 18180, 1234 *Off. Gaz. Pat. Office* at 117.

This third party requester's right to file original comments on the examiner's ACP pursuant to § 1.951(a), however, was not adopted in the final rule to implement optional *inter partes* reexamination proceedings. The requester's right to file original comments on the examiner's ACP was deleted in response to a comment on § 1.951(a) which pointed out that ''such 'direct' requester comments are not consistent with the statute as the statute makes it clear that the third party requester's right to comment only matures with the filing of a patent owner response to an Office action on the merits, and nowhere in the statute does it permit third party requester comments without there first being a patent owner response.'' *See Rules to Implement Optional Inter Partes Reexamination Proceedings,* 65 FR at 76768, 1242 *Off. Gaz. Pat. Office* at 22–23.

Given that the third party requester does not have a right to file original comments on the examiner's ACP, the above-discussed reason for issuing an ACP prior to a RAN where all claims are found patentable (*i.e.*, to give the requester at least one chance for input prior to appeal) no longer exists. There is no reason to issue an unnecessary ACP in this instance, since the patent

owner has no incentive to reply to the finding of all claims patentable, and thus, presumably will not file a response to the ACP. The patent owner would not argue against the allowance of all the claims, and the patent owner would not be expected to comment on any stated reasons for allowance at this point, since he or she may do so after a Notice of Intent to Issue a Reexamination Certificate is issued, while a comment at this stage would give requester an extra opportunity to participate in the proceeding. Accordingly, the present proposal would eliminate the need for an ACP where all claims are found patentable by going directly to the issuance of a RAN, and thus streamline and expedite the *inter partes* reexamination process.

Section 1.959: It is proposed that § 1.959 be revised by adding a new paragraph (f). New paragraph (f) would provide a non-extendable one-month period for correcting an inadvertent failure to comply with any requirement of § 1.959, when a notice of appeal or cross appeal is submitted. The proposed revision of § 1.959 would permit a remedy of inadvertent defects in a notice of appeal or cross appeal.

Section 1.959 relates to appeals and cross appeals to the BPAI in *inter partes* reexamination proceedings. The requirements for acceptance by the Office of a notice of appeal and cross appeal to the BPAI are: (1) Payment of the appeal fee set forth in § 1.17(b) (§§ 1.959(a) and (b)); identification of the appealed claim(s) (§ 1.959(c)); and (3) signature by the patent owner, the third party requester, or their duly authorized attorney or agent (§ 1.959(c)).

It is proposed to revise § 1.959 by providing the third party requester one opportunity to supply, within one month, the missing fee or missing portion of the fee that was inadvertently not supplied. Section 1.957(a) provides that if ''the third party requester files an untimely or inappropriate comment [or] notice of appeal * * * in an *inter partes* reexamination, the paper will be refused consideration.'' Thus, if the third party requester inadvertently fails to pay the appeal fee or makes a payment which is deficient as to the amount specified in § 1.17(b), the requester's notice of appeal (or cross appeal) will not be considered and requester's appeal would otherwise be barred. The failure to submit the complete appeal fee cannot be considered a ''*bona fide* attempt to respond and to advance the prosecution'' where ''some requirement has been inadvertently omitted'' under § 1.957(d) (with requester then given a chance to rectify the inadvertency), since § 1.957(d) applies only to a patent owner and not to a third party requester. In addition, the third party requester does not have the opportunity to ''revive'' the appeal, as does the patent owner under § 1.137 (further, an extension of the time for filing the notice of appeal (or cross appeal) is not provided for by § 1.956, even if the requester becomes aware of the inadvertency on the last day to remedy it). Thus, the third party requester would be barred from appealing the case when a sufficient payment of the fee is inadvertently not made in the absence of the proposed revision to § 1.959. Yet, estoppel attaches to the third party requester which precludes further resolution of the issues that the requester wishes to appeal. Under the statute, requester is estopped from later asserting in any civil action, or in a subsequent *inter partes* reexamination, the invalidity/unpatentability of any claim finally determined to be valid and patentable on any ground the third party requester raised or could have raised in the *inter partes* reexamination. Requester is further estopped from later challenging in a civil action any fact determined in the *inter partes* reexamination. Accordingly, requester's loss of appeal rights because of an inadvertency is considered an unduly harsh and extreme measure. Accordingly, it is proposed to revise § 1.959 by providing the third party requester one opportunity to supply, within one month, the missing fee or missing portion of the fee that was inadvertently not supplied. As to the requirements that the notice of appeal (or cross appeal) identify the appealed claim(s) and be signed by the appellant, it may be that an opportunity to remedy the inadvertent failure to comply with same is not precluded by § 1.957(a). The refusal of consideration mandated by that section is directed only to ''untimely or inappropriate'' notices of appeal (and cross appeal). If so, the failure to sign or identify as required might not render the notice untimely, and the paper might be an ''appropriate'' paper, *i.e.*, the type of paper that is entitled to entry in an *inter partes* reexamination, but is not a complete paper. However, to cover the possibility that failure to comply with the signature or identification of claims requirement of § 1.959(c) could permanently bar the requester's appeal, the proposed new § 1.959(f) has been made broad enough to explicitly encompass these potential defects in a notice of appeal (or cross appeal). Further, the proposed new § 1.959(f) is drafted to encompass patent owner inadvertencies as well as those of the third party requester.

Sections 1.965 and 1.967: It is proposed that § 1.965, paragraph (d), be revised to insert ''paragraphs (a) and (c)'' in place of ''paragraph (c).'' It is proposed that § 1.967, paragraph (c), be revised to insert ''paragraphs (a) and (b)'' in place of ''paragraph (b).''

As § 1.965 currently reads, an inadvertent failure to comply with a § 1.965(a) requirement would permanently bar the requester's appeal from going forward. As § 1.967 currently reads, an inadvertent failure to comply with a § 1.967(a) requirement would bar the requester's participation via respondent brief in the patent owner's appeal. It is proposed to revise §§ 1.965 and 1.967 to provide the appellant and respondent, respectively, with a non-extendable one-month period for correcting an inadvertent failure to comply with a requirement of §§ 1.965(a) and 1.967(a), respectively. This revision of §§ 1.965 and 1.967 is proposed for reasons analogous to those set forth above for the proposed revision of § 1.959. Again, the loss of requester's appeal rights because of a § 1.965(a) inadvertency, and the loss of requester's participation rights because of a § 1.967(a) inadvertency, are considered to be unduly harsh and extreme measures.

It is noted that § 1.965(b) states: ''A party's appeal shall stand dismissed upon failure of that party to file an appellant's brief, accompanied by the requisite fee, within the time allowed.'' If the proposed revision to § 1.965(d) is made, the phrase ''within the time allowed'' in § 1.965(b) would be interpreted to include the filing of an ''appellant's brief, accompanied by the requisite fee'' within the one-month period for correcting an inadvertency (in failure to comply with a requirement of § 1.965(a) and/or (c)) set forth in § 1.965(d).

Section 1.971: It is proposed that § 1.971 be amended by designating the sole current paragraph of the section as paragraph (a), and adding new paragraph (b). New paragraph (b) would provide a non-extendable one-month period for correcting an inadvertent failure to comply with any requirement of paragraph (a) of § 1.971, when a rebuttal brief is submitted. Sections 1.965(d) and 1.967(c) currently provide relief for certain non-compliance inadvertencies in appellant and respondent briefs, respectively. There is no such relief provided for rebuttal briefs; yet, no reason exists as to why the relief is provided for both appellant and respondent briefs, but not for rebuttal briefs. It is proposed to revise

§ 1.971 to provide relief granted for inadvertencies in the rebuttal brief that would parallel the relief granted for inadvertencies in appellant and respondent briefs. This would be effected by providing, in § 1.971, a new paragraph (b), which is analogous to §§ 1.965(d) and 1.967(c).

Section 1.977: It is proposed that § 1.977, paragraph (g), be amended by inserting '', when the owner is responding under paragraph (b)(1) of this section'' at the end of the first sentence of the paragraph, and by adding the following new sentence as the second sentence: ''The time period set forth in paragraph (b) of this section may not be extended when the owner is responding under paragraph (b)(2) of this section.''

Current § 1.977(g) provides that ''[t]he time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956.'' Thus, an extension of time could be obtained for the filing of a patent owner amendment or showing of facts presented under § 1.977(b)(1), or the filing of a patent owner request for rehearing of the decision of the BPAI made under § 1.977(b)(2). However, § 1.979(g) states that the times for requesting rehearing under § 1.979(a) may not be extended, and a patent owner request for rehearing of the decision of the BPAI made under § 1.977(b)(2) is included as § 1.979(a)(2). Thus, the time for filing a patent owner request for rehearing under § 1.977(b)(2) cannot be extended. The proposed revision would revise § 1.977(g) to make it consistent with the language of § 1.979(g). Note further that this revision is consistent with the policy for a streamlined appeal procedure, which is reflected, for example, in § 1.959 (no extension of the time for filing the notice of appeal or cross appeal), § 1.963 (no extension of the time for filing appellant, respondent, and rebuttal briefs), and § 1.979(g) (no extension of the time for filing *any* rehearing request). Thus, it is appropriate that an extension of time cannot be obtained for the filing of a patent owner request for rehearing of the decision of the BPAI made under § 1.977(b)(2), while an extension can be obtained for the filing of a patent owner amendment or showing of facts presented under § 1.977(b)(1), which may be considered a reopening of the examination process, as opposed to the appeal process.

Section 1.979: It is first proposed that § 1.979 be amended by revising its paragraphs (e) and (f) to replace ''patent owner'' with ''parties to an appeal to the Board of Patent Appeals and Interferences,'' ''party,'' ''any party,'' and ''party's,'' where each replacement is applicable, and to delete ''patent owner's'' where it appears. It is also proposed that § 1.979 be amended by deleting the first and second sentences of paragraph (f). It is also proposed that the third sentence of § 1.979(f) be amended to add ''to the Board of Patent Appeals and Interferences'' after ''An appeal'' to provide additional clarity. Section 1.979 is currently drafted to address the situation where appeal to the Federal Circuit is possible only for the patent owner. The first proposed revision would modify the language of § 1.979 to make it applicable to all parties to the *inter partes* reexamination proceeding, *i.e.,* the patent owner and any *inter partes* reexamination third party requester, who are the parties to the appeal to the BPAI. The second proposed revision would delete the current provision for termination of the third party requester's appeal, which was (before the enactment of Public Law 107–273) under criteria different than that of the patent owner (since a third party requester could not appeal to the courts under the statute prior to Public Law 107–273). The first proposed revision to the text of § 1.979(f) make the criteria for termination the same for all parties to the appeal. Finally, it is proposed that § 1.979(f) be amended to provide that an appeal to the Federal Circuit is terminated when the mandate is issued by the Court for consistency with a 1998 amendment to rule 41 of the Federal Rules of Appellate Procedure.

Undesignated center heading immediately preceding § 1.983: It is proposed that the undesignated center heading immediately preceding § 1.983 be revised to delete ''PATENT OWNER'' before ''APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT.'' The undesignated center heading immediately preceding § 1.983 is currently drafted to address the situation where appeal to the Federal Circuit is possible only for the patent owner. The proposed revision would modify the language to make it applicable to all parties to the *inter partes* reexamination proceeding who are the parties to the appeal to the BPAI.

Section 1.983: Section 13106 of Public Law 107–273 grants the *inter partes* reexamination third party requester the right to appeal an adverse decision of the BPAI to the Federal Circuit. 35 U.S.C. 315(b)(1). It further authorizes the third party requester to be a party to any appeal taken by the patent owner to the Federal Circuit. 35 U.S.C. 315(b)(1). Also, as pointed out above, section 13106 of Public Law 107–273 implicitly permits the patent owner to be a party to the newly provided-for appeal taken by the third party requester to the Federal Circuit. It is proposed that § 1.983 be amended to track this newly enacted legislation by revising its heading, dividing the existing text into paragraphs (a) and (b); revising the text of newly designated paragraphs (a) and (b), and adding new paragraphs (c) through (f).

It is proposed that the title of § 1.983 be revised by changing ''Patent owner appeal'' to ''Appeal.''

It is proposed that § 1.983(a) be revised to permit the patent owner and any third party requester who is a party to an appeal to the BPAI to (1) appeal the BPAI's decision to the Federal Circuit, and (2) to be a party to any appeal to the Federal Circuit taken from the Board's decision.

It is proposed that § 1.983(b) be revised to clarify that service of the notice of appeal or cross appeal must be made on every other party in the reexamination proceeding as required in § 1.903. The explicit statement of requirement for service on other parties also provides antecedent for the 14-day period recited in paragraph (e) of § 1.983 that follows.

It is proposed that paragraphs (c) and (d) be added to § 1.983 to provide for a cross appeal within 14 days of service of an opposing party's notice of appeal. This is analogous to the cross appeal (within 14 days of service of the notice of appeal) provided for in § 1.304(a)(1) for interferences. The interferences model is used, because an interference is the only other *inter partes* proceeding appealed to the court from the decision of the BPAI. It is to be noted that if the two-month time period from the BPAI's decision will expire after the 14-day period set for a cross appeal, then the later-expiring two-month period will control. Thus, where a first party files an appeal to the court (the Federal Circuit) 14 days after the BPAI's decision, an opposing party need not file a cross appeal 15 days later (29 days after the BPAI's decision), but rather has the remainder of the two-month period to do so.

A new paragraph (e) is proposed to be added to § 1.983, to prescribe the action a party must take in order to participate in an appellant's appeal (including cross appeal). Participation in the appellant's appeal is directed to providing argument supporting the decision of the BPAI. Such participation is in contrast to the cross appeal which would be provided for in paragraphs (c) and (d) of § 1.983, where a party challenges a decision of the BPAI adverse to that party.

New paragraph (f): Section 13106(d) of Public Law 107–273 provides the

effective date for the revision to the statute made in section 13106 as follows: ''The amendments made by this Section apply with respect to any reexamination proceeding commenced on or after the date of enactment of this Act.''

Accordingly, it is proposed that § 1.983 be amended to add a new paragraph (f) stating: ''(f) Notwithstanding any provision of the rules, in any reexamination proceeding commenced prior to November 2, 2002, the third party requester is precluded from appealing and cross appealing any decision of the BPAI to the Federal Circuit, and the third party requester is precluded from participating in any appeal taken by the patent owner to the Court.''

Rulemaking Considerations

Administrative Procedure Act: The changes proposed in this notice conform the patent-related rules of practice in 37 CFR to the changes to title 35 U.S.C. contained in Public Law 107–273. Therefore, these changes involve interpretive rules or rules of agency practice and procedure under 5 U.S.C. 553(b)(A). *See Bachow Communications Inc.* v. *FCC,* 237 F.3d 683, 690 (D.C. Cir. 2001); *Paralyzed Veterans of America* v. *West* 138 F.3d 1434, 1436 (Fed. Cir. 1998); and *Komjathy* v. *National Transportation Safety Board,* 832 F.2d 1294, 1296–97 (D.C. Cir. 1987). Therefore, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). Nevertheless, the Office is providing this opportunity for public comment on the changes proposed in this notice because the Office desires the benefit of public comment on these proposed changes.

Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), an initial regulatory flexibility analysis under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is not required. *See* 5 U.S.C. 603.

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

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

Paperwork Reduction Act: This notice involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this notice have been reviewed and previously approved by OMB under OMB control numbers: 0651–0021, 0651–0031, 0651–0032, and 0651–0033. The United States Patent and Trademark Office is not resubmitting any information collection package to OMB for its review and approval because the changes in this notice do not affect the information collection requirements associated with the information collection under these OMB control numbers.

The title, description and respondent description of each of the information collections are shown below with an estimate of each of the annual reporting burdens. Included in each estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The changes in this notice conform the patent-related rules of practice in 37 CFR to the changes to title 35 U.S.C. contained in Public Law 107–273.

OMB Number: 0651–0021.

Title: Patent Cooperation Treaty.

Form Numbers: PCT/RO/101, ANNEX/134/144, PTO–1382, PCT/IPEA/401, PCT/IB/328, PTO/SB/61/PCT, PTO/SB/64/PCT.

Type of Review: Approved through December of 2003.

Affected Public: Individuals or households, business or other for-profit, Federal agencies or employees, not-for-profit institutions, small businesses or organizations, farms, and State, local or tribal government.

Estimated Number of Respondents: 331,407.

Estimated Time Per Response: 15 minutes to 4 hours.

Estimated Total Annual Burden Hours: 401,202 hours.

Needs and Uses: The information collected is required by the Patent Cooperation Treaty (PCT). The general purpose of the PCT is to simplify the filing of patent applications on the same invention in different countries. It provides for a centralized filing procedure and a standardized application format.

OMB Number: 0651–0031.

Title: Patent Processing (Updating).

Form Numbers: PTO/SB/08A/08B/21/22/23/24/25/26/27/30/31/32/35/37/36/42/43/61 61/PCT/62/63/64 64/PCT/67/68/91/92/96/97, PTO–2053–A/B, PTO–2054–A/B, PTO–2055–A/B.

Type of Review: Approved through April of 2003.

Affected Public: Individuals or households, State or local governments, farms, business or other for-profit institutions, not-for-profit institutions, small businesses or organizations, and Federal government.

Estimated Number of Respondents: 2,247,270.

Estimated Time Per Response: 1 minute 48 seconds to 4 hours.

Estimated Total Annual Burden Hours: 1,021,822 hours.

Needs and Uses: During the processing of an application for a patent, the applicant/agent may be required or desire to submit additional information to the Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosure Statements; Terminal Disclaimers; Petitions to Revive; Express Abandonments; Appeal Notices; Petitions for Access; Powers to Inspect; Certificates of Mailing or Transmission; Statements under § 3.73(b); Amendments, Petitions and their Transmittal Letters; and Deposit Account Order Forms.

OMB Number: 0651–0032.

Title: Initial Patent Application.

Form Number: PTO/SB/01–07/13PCT/16–19/29/101–110.

Type of Review: Approved through April of 2003.

Affected Public: Individuals or households, business or other for-profit institutions, not-for-profit institutions, farms, Federal government, and State, local, or tribal governments.

Estimated Number of Respondents: 319,350.

Estimated Time Per Response: 24 minutes to 11 hours and 18 minutes.

Estimated Total Annual Burden Hours: 2,984,360 hours.

Needs and Uses: The purpose of this information collection is to permit the Office to determine whether an application meets the criteria set forth in the patent statute and regulations. The standard Fee Transmittal form, New Utility Patent Application Transmittal form, New Design Patent Application Transmittal form, New Plant Patent Application Transmittal form, Declaration, Provisional Application Coversheet, and Plant Patent Application Declaration will assist applicants in complying with the requirements of the patent statute and regulations, and will further assist the Office in processing and examination of the application.

OMB Number: 0651–0033.

Title: Post Allowance and Refiling.

Form Numbers: PTO/SB/44/50/51, 51S/52/53/55/56/57/58, PTOL–85B.

Type of Review: Approved through January of 2004.

Affected Public: Individuals or households, business or other for-profit

institutions, not-for-profit institutions, farms, State, local and tribal governments, and Federal government.

Estimated Number of Respondents: 205,480.

Estimated Time Per Response: 2 minutes to 2 hours.

Estimated Total Annual Burden Hours: 63,640 hours.

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

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

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, United States Patent and Trademark Office, Washington, DC 20231, or to the Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10235, 725 17th Street, NW., Washington, DC 20503, Attention: Desk Officer for the Patent and Trademark Office.

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

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

For the reasons set forth in the preamble, 37 CFR part 1 is proposed to be amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES 1.

The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

2. Section 1.1 is amended by revising paragraph (c) to read:

§ 1.1 Addresses for correspondence with the United States Patent and Trademark Office.

* * * * *

(c) *For reexamination proceedings.* (1) Requests for *ex parte* reexamination (*original* request papers only) should be additionally marked ''Mail Stop *Ex Parte* Reexam.''

(2) Requests for *inter partes* reexamination for original request papers and all subsequent correspondence filed in the Office, other than correspondence to the Office of the Solicitor pursuant to § 1.1(a)(3) and § 1.302(c), should be additionally marked ''Mail Stop *Inter Partes* Reexam.''

* * * * *

3. Section 1.13 is amended by revising paragraph (b) to read:

§ 1.13 Copies and certified copies.

* * * * *

(b) Certified copies of patents, patent application publications, and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public or persons entitled thereto will be authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his or her name, upon payment of the fee for the certified copy.

4. Section 1.14 is amended by revising paragraph (i)(2) to read as follows:

§ 1.14 Patent applications preserved in confidence.

* * * * *

(i) * * *

(2) A copy of an English language translation of the publication of an international application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(4)).

* * * * *

5. Section 1.78 is amended by revising paragraph (a)(3) to read as follows:

§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) * * *

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

(i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

* * * * *

6. Section 1.191 is amended by revising paragraph (a) to read as follows:

§ 1.191 Appeal to Board of Patent Appeals and Interferences.

(a) Every applicant for a patent or for reissue of a patent, and every owner of a patent under *ex parte* reexamination filed under § 1.510 before November 29, 1999, any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply. Notwithstanding the above, for an *ex parte* reexamination proceeding filed under § 1.510 on or after November 29, 1999, no appeal may be filed until the claims have been finally rejected (§ 1.113). Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under § 1.913 are controlled by §§ 1.959 through 1.981. Sections 1.191 through 1.198 are not applicable to appeals in *inter partes* reexamination proceedings filed under § 1.913.

* * * * *

7. Section 1.197 is amended by revising paragraph (c) to read as follows:

§ 1.197 Action following decision.

* * * * *

(c) Termination of proceedings.—(1) Proceedings are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except:

(i) Where claims stand allowed in an application; or

(ii) Where the nature of the decision requires further action by the examiner.

(2) 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 court or review by civil action (§ 1.304) expires. If an appeal to the court or a civil action has been filed, proceedings are considered terminated when the appeal or civil action is terminated. An appeal to the U.S. Court of Appeals for the Federal Circuit is terminated when the mandate is issued by the Court. A civil action is terminated when the time to appeal the judgment expires.

8. Section 1.301 is revised to read as follows:

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

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

9. Section 1.302 is revised to read as follows:

§ 1.302 Notice of appeal.

(a) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof to the Director within the time specified in § 1.304.

(b) In interferences, the notice must be served as provided in § 1.646.

(c) In *ex parte* reexamination proceedings, the notice must be served as provided in § 1.550(f).

(d) In *inter partes* reexamination proceedings, the notice must be served as provided in § 1.903.

(e) Notices of appeal directed to the Director shall be mailed to or served by hand on the General Counsel as provided in § 104.2.

10. Section 1.303 is amended by revising paragraphs (a), (b), and (d) to read as follows:

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

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

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

* * * * *

(d) For an *ex parte* reexamination proceeding filed under § 1.510 on or after November 29, 1999, and for an *inter partes* reexamination proceeding filed under § 1.913, no remedy by civil action under 35 U.S.C. 145 is available.

11. Section 1.304 is amended by revising paragraph (a)(1) to read as follows:

§ 1.304 Time for appeal or civil action.

(a)(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is 2 months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 1.197(b), or § 1.658(b), the time for filing an appeal or commencing a civil action shall expire 2 months after action on the request. If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 1.979(a), the time for filing an appeal shall expire 2 months after action on the last such request made by the parties.

(i) In interferences, the time for filing a cross-appeal or cross-action expires:

(A) Fourteen days after service of the notice of appeal or the summons and complaint; or

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

(ii) In *inter partes* reexaminations, the time for filing a cross-appeal expires:

(A) Fourteen days after service of the notice of appeal; or

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

* * * * *

12. Section 1.417 is revised to read as follows:

§ 1.417 Submission of translation of international publication.

The submission of an English language translation of the publication of an international application pursuant to 35 U.S.C. 154(d)(4) must clearly identify the international application to which it pertains (§ 1.5(a)) and be clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4). Otherwise, the submission will be treated as a filing under 35 U.S.C. 111(a). Such submissions should be marked ''Box PCT.''

13. Section 1.495 is amended by revising paragraphs (c) and (g) to read as follows:

§ 1.495 Entering the national stage in the United States of America.

* * * * *

(c) If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date but omits either a translation of the international application, as filed, into the English language, if the international application was originally filed in another language and if any English language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2)), or the oath or declaration of the inventor (35 U.S.C. 371(c)(4) and § 1.497), if a declaration of inventorship in compliance with § 1.497 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26*ter*.1, applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English

translation later than the expiration of thirty months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of thirty months after the priority date. A ''Sequence Listing'' need not be translated if the ''Sequence Listing'' complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b).

* * * * *

(g) The documents and fees submitted under paragraphs (b) and (c) of this section must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371. Otherwise, the submission will be considered as being made under 35 U.S.C. 111(a).

* * * * *

14. Section 1.913 is revised to read as follows:

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

Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

15. Section 1.949 is revised to read as follows:

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

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

16. Section 1.953 is amended by revising paragraph (a) to read as follows:

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

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

* * * * *

17. Section 1.959 is amended by adding a new paragraph (f) to read as follows:

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

* * * * *

(f) If a notice of appeal or cross appeal is timely filed but does not comply with any requirement of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended notice of appeal or cross appeal. If the appellant does not then file an amended notice of appeal or cross appeal within the one-month period, or files a notice which does not overcome all the reasons for non-compliance stated in the notification of the reasons for non-compliance, that appellant's appeal or cross appeal will stand dismissed.

18. Section 1.965 is amended by revising paragraph (d) to read as follows:

§ 1.965 Appellant's brief *inter partes* reexamination.

* * * * *

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

19. Section 1.967 is amended by revising paragraph (c) to read as follows:

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

* * * * *

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

20. Section 1.971 is revised to read as follows:

§ 1.971 Rebuttal brief in *inter partes* reexamination.

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

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

21. Section 1.977 is amended by revising paragraph (g) to read as follows:

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

* * * * *

(g) The time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956, when the owner is responding under paragraph (b)(1) of this section. The time period set forth in paragraph (b) of this section may not be extended when the owner is responding under paragraph (b)(2) of this section. The time periods set forth in paragraphs (c) and (e) of this section may not be extended.

22. Section 1.979 is amended by revising paragraphs (e) and (f) to read as follows:

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

* * * * *

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

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

* * * * *

23. The undesignated center heading immediately preceding § 1.983 is revised to read as follows:

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

24. Section 1.983 is revised to read as follows:

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

(a) The patent owner or third party requester in an *inter partes* reexamination proceeding who is a party to an 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, subject to § 1.979(e), 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.

(b) The appellant must take the following steps in such an appeal:

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

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

(3) Serve a copy of the notice of appeal on every other party in the reexamination proceeding in the manner provided in § 1.248.

(c) If the patent owner has filed a notice of appeal to the U.S. Court of Appeals for the Federal Circuit, the third party may cross appeal to the U.S. Court of Appeals for the Federal Circuit if also dissatisfied with the decision of the Board of Patent Appeals and Interferences.

(d) If the third party has filed a notice of appeal to the U.S. Court of Appeals for the Federal Circuit, the patent owner may cross appeal to the U.S. Court of Appeals for the Federal Circuit if also dissatisfied with the decision of the Board of Patent Appeals and Interferences.

(e) A party electing to participate in an appellant's appeal must, within 14 days of service of the appellant's notice of appeal under paragraph (b) of this section, or notice of cross appeal under paragraphs (c) or (d) of this section, take the following steps:

(1) In the U. S. Patent and Trademark Office, timely file a written notice directed to the Director electing to participate in the appellant's appeal to the Court by mail to or hand service on the General Counsel as provided in § 104.2;

(2) In the Court, file a copy of the notice electing to participate in accordance with the rules of the Court; and

(3) Serve a copy of the notice electing to participate on every other party in the reexamination proceeding in the manner provided in § 1.248.

(f) Notwithstanding any provision of the rules, in any reexamination proceeding commenced prior to November 2, 2002, the third party requester is precluded from appealing and cross appealing any decision of the Board of Patent Appeals and Interferences to the U.S. Court of Appeals for the Federal Circuit, and the third party requester is precluded from participating in any appeal taken by the patent owner to the Court.

Dated: April 22, 2003.

James E. Rogan,

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

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BILLING CODE 3510–16–P

DEPARTMENT OF THE INTERIOR

Fish and Wildlife Service

50 CFR Part 17

RIN 1018–AI48

Endangered and Threatened Wildlife and Plants; Designation of Critical Habitat for the Arizona Distinct Population Segment of the Cactus Ferruginous Pygmy-owl (*Glaucidium brasilianum cactorum*)

AGENCY: Fish and Wildlife Service, Interior.

ACTION: Proposed rule; reopening of public comment period.

SUMMARY: We, the U.S. Fish and Wildlife Service (Service), announce the reopening of the public comment period for the proposal to designate critical habitat pursuant to the Endangered Species Act of 1973, as amended (Act), for the Arizona distinct population segment of the cactus ferruginous pygmy-owl (*Glaucidium brasilianum cactorum*), and for the draft economic analysis for the proposed designation. Additional information from the administrative record concerning the locations of pygmy-owls recently has become available to the public, and therefore we are reopening the comment period for the proposal and for the draft economic analysis to allow all interested parties additional time to review the available information and provide comments. Comments previously submitted need not be resubmitted, because they will be incorporated into the public record as part of this reopening of the comment period, and will be fully considered in the final rule.

DATES: We will accept comments on both the proposed critical habitat designation and the draft economic analysis until June 27, 2003.

ADDRESSES: Send comments and information concerning the proposed critical habitat designation and draft economic analysis to the Field Supervisor, Arizona Ecological Services Office, 2321 West Royal Palm Road, Suite 103, Phoenix, AZ 85021. You also may send written comments by facsimile to 602/242–2513. For