

# Chapter 2600 Optional Inter Partes Reexamination

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The reexamination statute was amended on November 29, 1999 by Public Law 106-113. Public

Law 106-113 expanded reexamination by providing an “*inter partes*” option; it authorized the extension of reexamination proceedings via an optional *inter partes* reexamination procedure in addition to the existing *ex parte* reexamination procedure. See Title IV, subtitle F (§§ 4601 through 4608) of the “Intellectual Property and Communications Omnibus Reform Act of 1999,” S. 1948 (106th Cong. 1st Sess. (1999)). Section 1000(a)(9), Division B, of Public Law 106-113 incorporated and enacted into law the “Intellectual Property and Communications Omnibus Reform Act of 1999” (S. 1948). As a result, new sections 311-318 of title 35 United States Code directed to the optional *inter partes* reexamination proceeding were added by Public Law 106-113.

The reexamination statute was again amended on November 2, 2002, by Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002). Public Law 107-273 expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based (see MPEP § 2642, POLICY IN SPECIFIC SITUATIONS, part A), expanded the third party requester’s appeal rights to include appeal to the Court of Appeals for the Federal Circuit (see MPEP § 2679), and made technical corrections to the statute. See the 21st Century Department of Justice Appropriations Authorization Act, TITLE III - INTELLECTUAL PROPERTY, Subtitle A - Patent and Trademark Office, Section 13105, of the “Patent and Trademark Office Authorization Act of 2002” - Enacted as part of Public Law 107-273 on November 2, 2002.

The optional *inter partes* alternative provides third party requesters with a greater opportunity to participate in reexamination proceedings, while maintaining most of the features which make reexamination a desirable alternative to litigation in the Federal Courts (e.g., low cost relative to Court proceedings, expedited procedure).

The optional *inter partes* alternative also provides third party requesters with appeal rights to appeal to the Board of Patent Appeals and Interferences (Board) and to participate in the patent owner’s appeal to the Board.

For any *inter partes* reexamination proceeding commenced on or after November 2, 2002, the third party requester also has the appeal rights to appeal to the Court of Appeals for the Federal Circuit and to

participate in the patent owner's appeal to the Federal Circuit. For an *inter partes* reexamination proceeding commenced prior to November 2, 2002, however, no appeal rights are provided for the third party requester to appeal to the Court of Appeals for the Federal Circuit, nor to participate in the patent owner's appeal to the Court. See MPEP § 2683.

Exercising the *inter partes* option is conditioned (by Public Law 106-113) on the third party requester accepting a statutory estoppel against subsequent review, either by the Office or by a Federal Court, of the issues that were or could have been raised in the reexamination proceeding. These limits, which will be discussed in this Chapter are aimed at preventing *inter partes* reexamination proceedings from being used to harass patent owners.

The final rules to implement the statutory *inter partes* reexamination option was published in the Federal Register on December 7, 2000 (65 Fed. Reg. 76756) and in the *Official Gazette* on January 2, 2001 (1243 O.G. 12). The final rule notice stated that the changes to the rules of practice to implement the optional *inter partes* reexamination provisions of the American Inventors Protection Act of 1999 would become effective on February 5, 2001. The notice includes not only the text of the final rules, but also a discussion of the rules and analysis of the comments

received, which serve as guidance in the implementation of the rules.

Both the statutory *inter partes* reexamination option, 35 U.S.C., Chapter 31, and the new *inter partes* reexamination rules, 37 CFR, Sub-part H, apply to all reexamination proceedings for patents issuing from applications filed on or after November 29, 1999. For a patent issued from an application filed prior to November 29, 1999, the statutory *inter partes* reexamination option is not available, only the *ex parte* reexamination is available (see 37 CFR, Sub-part D, 37 CFR 1.510 *et seq.*).

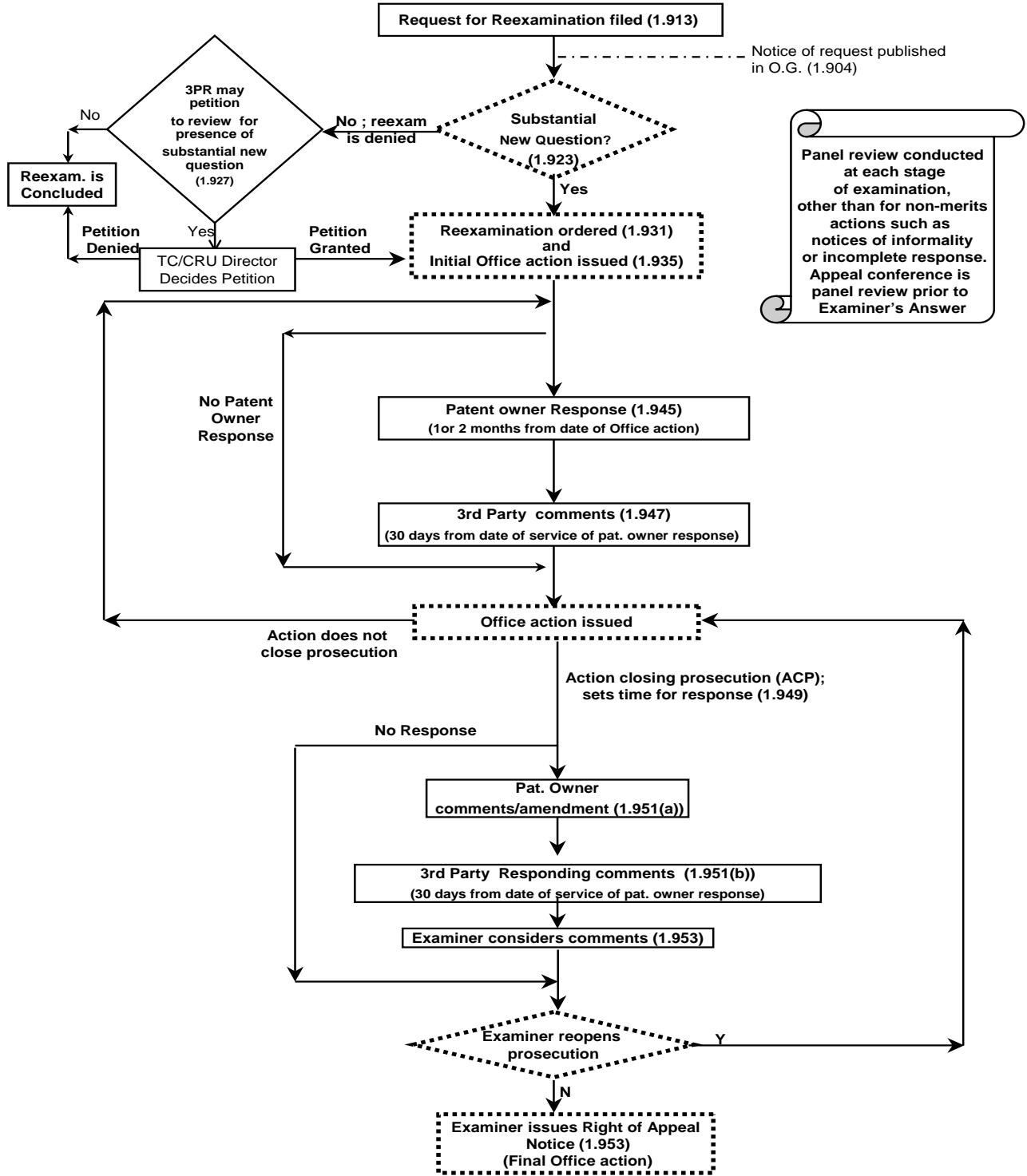
See MPEP Chapter 2200 (section 2209 *et seq.*) for guidance on the procedures for *ex parte* reexamination proceedings.

### 2601.01 Flowcharts [R-5]

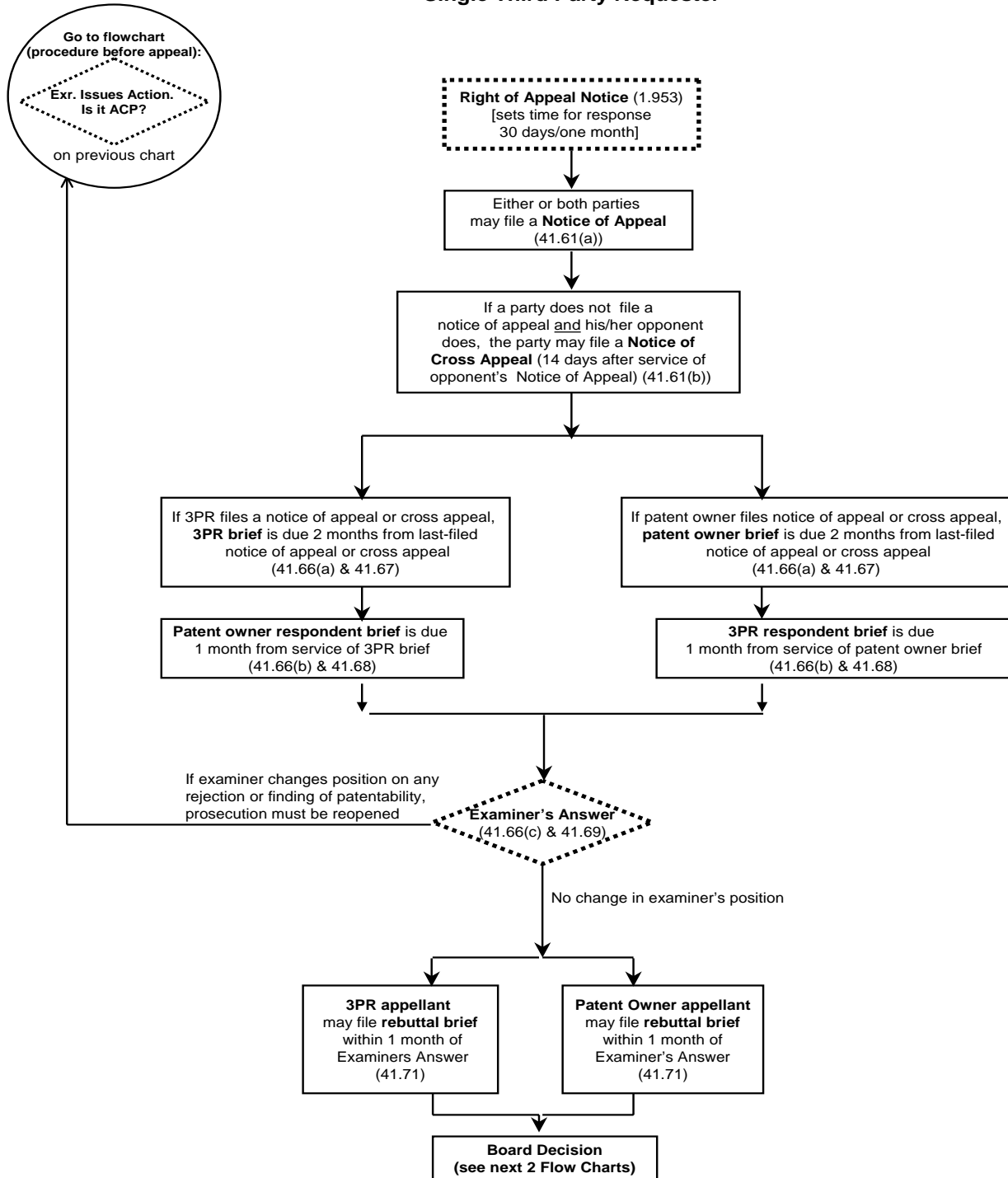
The flowcharts show the general flow for the various stages of *inter partes* reexamination proceedings. The first flowchart shows the procedures before appeal. The second flowchart shows the appeal procedure with a single 3<sup>rd</sup> party requester. The third flowchart shows the procedures following a Board decision for reexamination proceedings commenced prior to November 2, 2002. The fourth flowchart shows the procedures following a Board decision for reexamination proceedings commenced on or after November 2, 2002.

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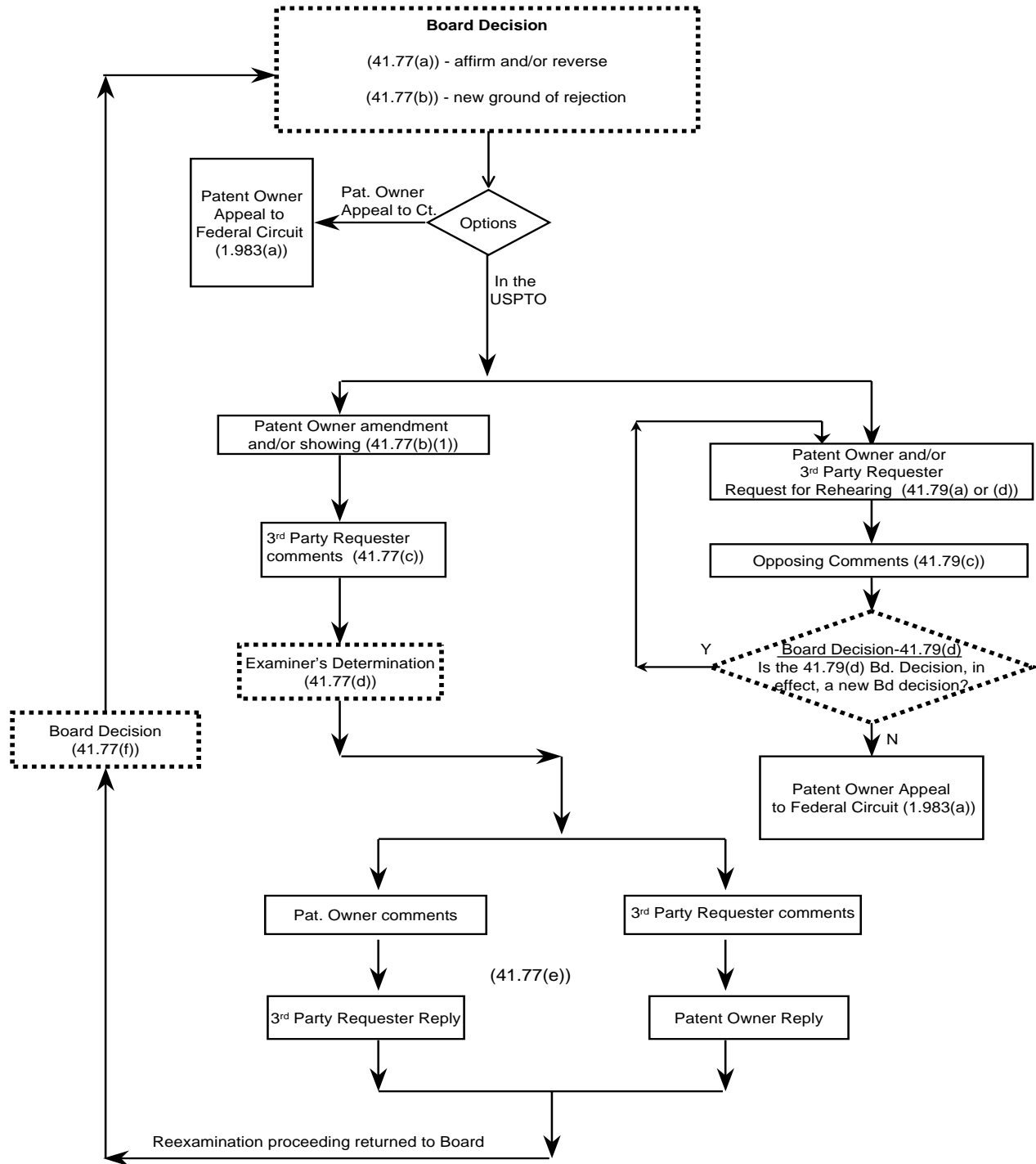
**Inter Partes Reexamination (applicable rule section)  
PROCEDURE BEFORE APPEAL**



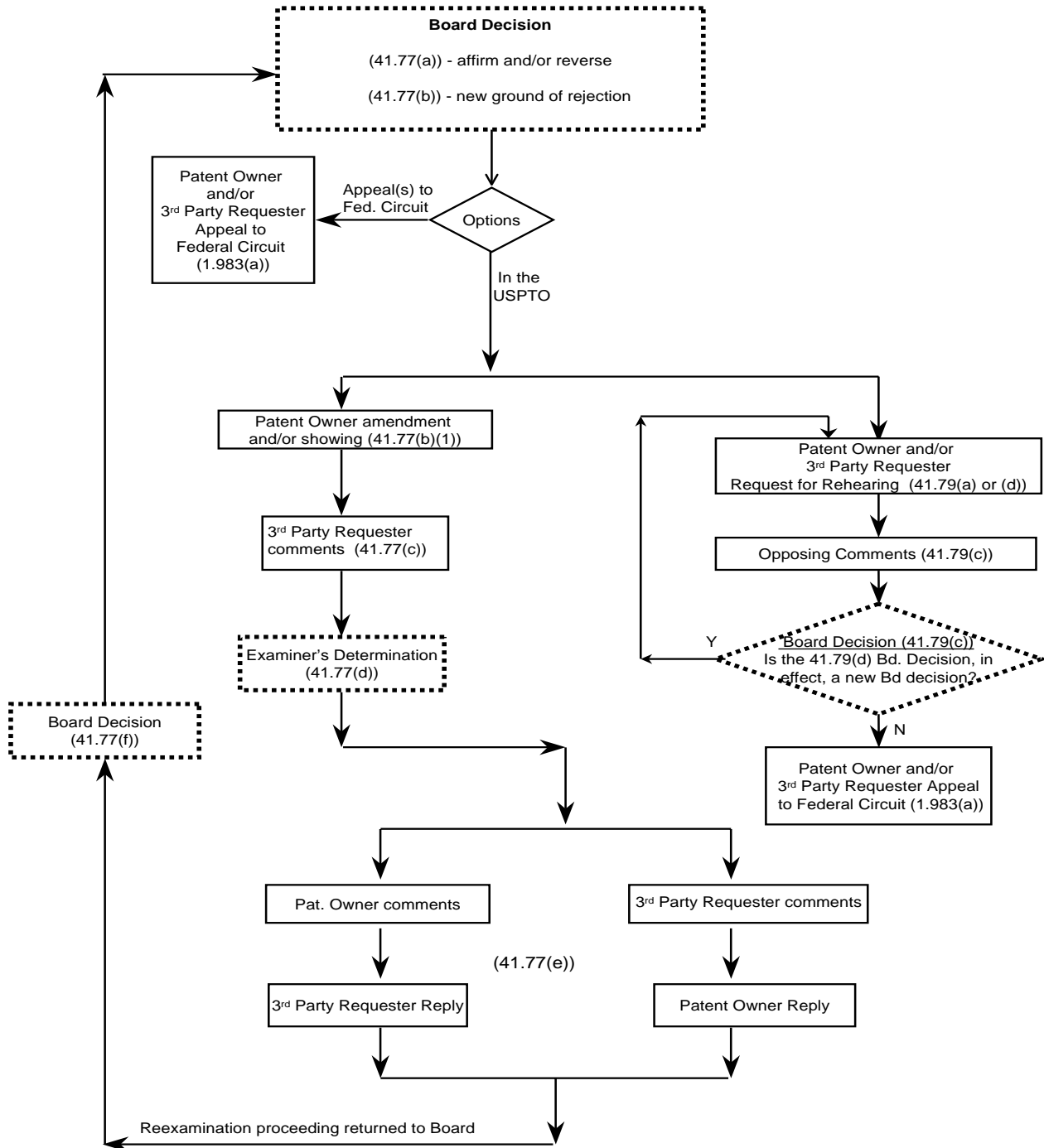
*Inter Partes* Reexamination (applicable rule section)  
**APPEAL PROCEDURE**  
 Single Third Party Requester



**Inter Partes Reexamination (applicable rule section)  
 Procedures Following Board Decision for Reexaminations  
 Commenced Prior to November 2, 2002**



**Inter Partes Reexamination (applicable rule section)  
 Procedure Following Board Decision for Reexaminations  
 Commenced On or After November 2, 2002**



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## 2602 Citation of Prior Art [R-7]

### 35 U.S.C. 301. Citation of prior art.

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

### 37 CFR 1.501. Citation of prior art in patent files.

(a) At any time during the period of enforceability of a patent, any person may cite, to the Office in writing, prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Such citations shall be entered in the patent file except as set forth in §§ 1.502 and 1.902.

(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) Citation of patents 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 for in § 1.33(c); or in the event service is not possible (2) Be filed with the Office in duplicate.

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

\*\*>Citations by the patent owner in accordance with § 1.933 and by an *inter partes* reexamination third party requester under § 1.915 or § 1.948 will be entered in the *inter partes* reexamination file. The entry in the patent file of other citations submitted after the date of an order for reexamination pursuant to § 1.931 by persons other than the patent owner, or the third party requester under either § 1.913 or § 1.948, will be delayed until the *inter partes* reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate. See § 1.502 for processing of prior art citations in patent and reexamination files during an *ex parte* reexamination proceeding filed under § 1.510.<

Public Law 106-113 did not affect the manner of the public's citation of prior art under 37 CFR 1.501 in a patent. Likewise, it did not affect the Office's handling of a 37 CFR 1.501 prior art citation in a patent where no reexamination proceeding is pending for that patent when the citation is filed.

Where an *inter partes* reexamination proceeding is pending when a prior art citation is filed, the following applies:

If the prior art citation satisfies 37 CFR 1.501 and is submitted prior to an order to reexamine, the cited documents (citations) will be considered in an *inter partes* reexamination proceeding as a prior art citation would be considered in an *ex parte* reexamination proceeding. See MPEP § 2206.

If the prior art citation satisfies 37 CFR 1.501 and is submitted **after an order to reexamine**, the citation will be treated as follows:

(A) A patent owner citation will normally be considered if it is submitted in time to do so before the reexamination certificate issues.

(B) A third party requester citation will be considered if it is submitted as part of a third party requester comments submission under 37 CFR 1.947 or 1.951(b) (made as required by 37 CFR 1.948), or in a properly filed request for reexamination under 37 CFR 1.915 or 1.510.

(C) Any other prior art citation satisfying 37 CFR 1.501 which is submitted after an order to reexamine will be retained (stored) in the Central Reexamination Unit or Technology Center (in which the reexamination proceeding is being examined) until the reexamination is concluded >by the issuance and publication of a reexamination certificate<, after which it will be placed in the file of the patent. 37 CFR 1.902.

See MPEP §§ 2202 through 2206 and 2208 for the manner of making such citations and Office handling of same.

## 2609 *Inter Partes* Reexamination [R-7]

The *inter partes* reexamination statute and rules permit any third party requester to request *inter partes* reexamination of a patent which issued from an original application was filed on or after November 29, 1999, where the request contains certain elements (see 37 CFR 1.915(b)) and is accompanied by the fee required under 37 CFR 1.20(c)(2). The Office initially determines if "a substantial new question of patentability" (35 U.S.C. 312(a)) is presented. If such a new question has been presented, reexamination will be ordered. The reexamination proceedings which follow the order for reexamination are somewhat similar to regular examination procedures in patent applications; however, there are notable differences. For example, there are certain limitations as to the kind of rejections which may be made, a third party requester



may participate throughout the proceeding, there is an “action closing prosecution” and a “right of appeal notice” rather than a final rejection, special reexamination forms are to be used, and time periods are set to provide “special dispatch.” When the prosecution of an *inter partes* reexamination proceeding is terminated, an *inter partes* reexamination certificate is issued to indicate the status of all claims following the reexamination and concludes the reexamination proceeding.

The basic characteristics of *inter partes* reexamination are as follows:

(A) Any third party requester can request *inter partes* reexamination at any time during the period of enforceability of the patent (for a patent issued from an original application filed on or after November 29, 1999);

(B) Prior art considered during reexamination is limited to prior patents or printed publications applied under the appropriate parts of 35 U.S.C. 102 and 103;

(C) A substantial new question of patentability must be present for reexamination to be ordered;

(D) If ordered, the actual reexamination proceeding is essentially *inter partes* in nature;

(E) Decision on the request must be made not later than *three months* from its filing date, and the remainder of proceedings must proceed with “special dispatch” within the Office;

(F) If ordered, a reexamination proceeding will normally be conducted to its conclusion and the issuance of an *inter partes* reexamination certificate;

(G) The scope of the patent claims cannot be enlarged by amendment;

(H) Reexamination and patent files are open to the public, but see paragraph (I) below;

(I) The reexamination file is scanned to provide an electronic copy of the file. All public access to and copying of reexamination proceedings may be had from the electronic copy. The paper file is not available to the public.

>Patent owners and third party requesters are cautioned that the reexamination statute, regulations, and published examining procedures do not countenance so-called “litigation tactics” in reexamination proceedings. The parties are expected to conduct themselves accordingly. For example, it is expected that submissions of papers that are not provided for in the

reexamination regulations and/or appear to be excluded by the regulation will either be filed with an appropriate petition to accept the paper and/or waive the regulation(s), or not filed at all. Parties are advised that multiple submissions, such as a reply to a paper opposing a petition and a sur-reply directed to such a reply are not provided for in the regulations or examining procedures governing *inter partes* reexamination. It is expected that the parties will adhere to the provisions of 37 CFR 10.18(b) throughout the course of a reexamination proceeding.<

## 2610 Request for *Inter Partes* Reexamination [R-7]

### 35 U.S.C. 311. Request for *inter partes* reexamination

(a) IN GENERAL.— Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

(b) REQUIREMENTS.— The request shall—

(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an *inter partes* reexamination fee established by the Director under section 41; and

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

(c) COPY.— The Director promptly shall send a copy of the request to the owner of record of the patent.

### 37 CFR 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.

### 37 CFR 1.915. Content of request for *inter partes* reexamination.

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

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

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

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

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

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

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

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

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

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

(c) **\*\*>**If an *inter partes* request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34.<

(d) If the *inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

### 37 CFR 1.919. Filing date of request for *inter partes* reexamination.

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

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Any third-party requester, at any time during the period of enforceability of a **patent issued from an original application filed on or after November 29, 1999**, may file a request for an *inter partes* reexamination by the Office of any claim of the patent based on prior patents or printed publications. (Note: “original application” is defined in MPEP § 2611.)

The request must include the elements set forth in 37 CFR 1.915(b) (see MPEP § 2614) and must be accompanied by the fee as set forth in 37 CFR 1.20(c)(2). See MPEP § 2612 for situations where a

party may be barred from filing a request for *inter partes* reexamination.

After the request for *inter partes* reexamination, including the entire fee for requesting reexamination, is received in the Office, no abandonment, withdrawal, or striking, of the request is possible, regardless of who requests the same. In some limited circumstances, such as after a final court decision where all of the claims are held invalid, a reexamination order may be vacated. See MPEP § 2686.04.

## 2611 Time for Requesting *Inter Partes* Reexamination [R-7]

An *inter partes* reexamination can be filed for a patent issued from an original application filed on or after November 29, 1999. For a patent which issued from an original application filed prior to November 29, 1999, the statutory *inter partes* reexamination option is **not available**, only the *ex parte* reexamination is available. See Chapter 2200, section 2209 *et seq.* as to *ex parte* reexamination.

Public Law 106-113 >(the American Inventor’s Protection Act of 1999)<, see section 4608 of S.1948, states the effective date and applicability of the Optional *Inter Partes* Reexamination Procedure established by Subtitle F of the Act. Specifically, Section 4608 states that the changes in Subtitle F.. “shall take effect on the date of enactment of this Act and shall apply to any patent that issues from an original application filed in the United States on or after that date.” The phrase “original application” is interpreted to encompass utility, plant and design applications, including first filed applications, continuations, divisionals, continuations-in-part, continued prosecution applications (CPAs) and the national stage phase of international applications. This interpretation is consistent with the use of the phrase in 35 U.S.C. 251 and the federal rules pertaining to reexamination. In addition, MPEP § 201.04(a) defines an original application as “... an application which is not a reissue application.” MPEP § 201.04(a) further states that “[a]n original application may be a first filing or a continuing application”. Therefore, the optional *inter partes* reexamination is available to patents which issued from all applications (except for reissues) filed on or after November 29, 1999. A patent which issued from an application filed prior to November 29, 1999, in which a request for continued examination (RCE)

under 37 CFR 1.114 was filed on or after May 29, 2000, however, is not eligible for optional *inter partes* reexamination. An RCE is not considered a filing of an original application; rather it is a continuation of the prosecution of the application in which it is filed. See 35 U.S.C. 132(b), 37 CFR 1.114 and MPEP § 706.07(h).

Under 37 CFR 1.913, any third-party requester may, during the period of enforceability of a patent, file a request for *inter partes* reexamination. This period of enforceability was set by rule since no useful purpose was seen for expending Office resources on deciding patent validity questions in patents which cannot be enforced. In this regard, see *Patlex Corporation v. Mossinghoff*, 758 F.2d 594, 225 USPQ 243, 249 (Fed. Cir. 1985). The period of enforceability is determined by adding 6 years to the date on which the patent expires. The patent expiration date for a utility patent, for example, is determined by taking into account the term of the patent, whether maintenance fees have been paid for the patent, whether any disclaimer was filed as to the patent to shorten its term, any patent term extensions or adjustments for delays within the Office under 35 U.S.C. 154 (see MPEP § 2710, *et seq.*), and any patent term extensions available under 35 U.S.C. 156 for premarket regulatory review (see MPEP § 2750 *et seq.*). Any other relevant information should also be taken into account. In addition, if litigation is instituted within the period of the statute of limitations, requests for *inter partes* reexamination may be filed after the statute of limitations has expired, as long as the patent is still enforceable against someone.

## 2612 Persons Who May File a Request [R-7]

*37 CFR 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.

*37 CFR 1.907. Inter partes reexamination prohibited.*

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent

until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.

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

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

As stated in 37 CFR 1.913, except as provided in 37 CFR 1.907, any person other than the patent owner may file a request for *inter partes* reexamination of a patent. The patent owner is precluded from initiating an *inter partes* reexamination of its patent because 35 U.S.C. 311(a)(as technically corrected by Section 13202 of Public Law 107-273) provides that “[a]ny third party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.” *Ex parte* reexamination (see Chapter 2200) and reissue (see Chapter 1400) are available to the patent owner to have its patent reviewed.

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an *inter partes* reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the *inter partes* reexamination request >by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request)<. The certification identified in 37 CFR 1.915(b)(7) will constitute a *prima facie* showing that the party requesting the *inter partes* reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. >A challenge to the accuracy of the certification must facially establish that the third party requesting the *inter partes* reexamination is barred

from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a “real party in interest,” the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a “real party in interest.”<

Some of the persons likely to use *inter partes* reexamination are: licensees, potential licensees, infringers, potential exporters, patent litigants, interference applicants, and International Trade Commission respondents. The name of the person who files the request will not be maintained in confidence, and pursuant to 37 CFR 1.915(b)(8), the filing of the request must include a “statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.”

## 2613 Representative of Requester [R-7]

37 CFR 1.915. *Content of request for inter partes reexamination.*

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

from that party or be acting in a representative capacity pursuant to § 1.34.<

Where an attorney or agent files a request for an *inter partes* reexamination for an identified client (the third party requester), he or she may act under a power of attorney from the client or may act in a representative capacity under 37 CFR 1.34\*. See 37 CFR 1.915(c). While the filing of the power of attorney is desirable, processing of the reexamination request will not be delayed due to its absence.

>In order to act in a representative capacity under 37 CFR 1.34, an attorney or agent must set forth his or her registration number, his or her name and signature. In order to act under a power of attorney from a requester, an attorney or agent must be provided with a power of attorney. 37 CFR 1.32(c) provides that a “power of attorney may only name as representative” the inventors or registered patent practitioners. Thus, an attorney or agent representing a requester must be a registered patent practitioner.<

If any question of authority to act is raised, proof of authority may be required by the Office.

All correspondence for a third party requester \*\*>is< addressed to the representative of the requester, unless a specific indication is made to forward correspondence to another address.

A third party requester may not be represented during a reexamination proceeding by an attorney or other person who is not registered to practice before the Office.

## 2614 Content of Request for *Inter Partes* Reexamination [R-7]

37 CFR 1.915. *Content of request for inter partes reexamination.*

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

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

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

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

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

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

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

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

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

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

(c) **\*\*>**If an *inter partes* request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34.<

(d) If the *inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

## I. FEE FOR REQUEST FOR *INTER PARTES* REEXAMINATION

37 CFR 1.915(a) requires the payment of a fee specified in 37 CFR 1.20(c)(2). See MPEP § 2615 for a discussion of the fee to be paid. It is noted that, unlike a request for *ex parte* reexamination, a request for an *inter partes* reexamination cannot be filed by the patent owner; thus, there will be no proposed amendment to generate excess claims fees under 37 CFR 1.20(c)(3) and (c)(4) at the filing of a request for *inter partes* reexamination.

## II. REQUIRED ELEMENTS OF REQUEST FOR *INTER PARTES* REEXAMINATION

37 CFR 1.915(b) sets forth the required elements of a request for *inter partes* reexamination. The elements are as follows:

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

The request should identify the patent by stating the patent number. Although not required by rule, it is strongly suggested that the request should also state the patentee and the title of the patent, so that they are available for comparison, in the event there is an error in the typing of the patent number. The patentee who would be stated is the first named inventor on the patent.

The request should clearly identify every claim that requester wants reexamined.

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

The patents and printed publications which are presented in the request to provide a substantial new question of patentability must be listed. A form PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having a format equivalent to one of these forms), should be provided by the requester as part of the request, and all the art (patents and printed publications) cited would be listed thereon.

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

The request must assert a substantial new question of patentability. A statement which clearly points out what the requester considers to be the substantial new question of patentability based on cited patents and publications (the prior art or double patenting art) which would warrant a reexamination must be included. **\*\*>**The request must identify **each** substantial new question of patentability raised and **each** proposed ground of rejection separately. For each identified substantial new question of patentability and each identified proposed ground of rejection, the request must explain how the cited documents identi-

fied for that substantial new question of patentability/proposed ground of rejection raise a substantial new question of patentability. The request must apply all of the cited prior art to the claims for which reexamination is requested. For each identified substantial new question of patentability and each identified proposed ground of rejection, the request must explain how the cited documents identified for that substantial new question of patentability/proposed ground of rejection are applied to meet or teach the patent claim limitations to thus establish the identified substantial new question of patentability or proposed ground of rejection. See also MPEP § 2616 and § 2617.

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

A copy of each cited patent or printed publication, as well as a translation of each non-English document (or a translation of at least the portion(s) relied upon), is required so that all materials will be available to the examiner for full consideration. See MPEP § 2618. A listing of the patents and printed publications as provided for in 37 CFR 1.98 must also be provided. A comprehensive listing is required, since the identification of the cited art in reexamination by the requester is no less important than that of a patent owner or applicant, and furthers the statutory mandate of 35 U.S.C. 305 that reexamination proceedings must be “conducted with special dispatch within the Office.”

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

A copy of the patent, for which reexamination is requested, should be provided with the specification and claims submitted in a **double** column format. The drawing pages of the printed patent should be presented as they appear in the printed patent; the same is true for the front page of the patent. Thus, a full copy of the printed patent (including the front page) can be used to provide the abstract, drawings, specification, and claims of the patent for the reexamination request. The printed patent is to be reproduced on only one

side of the paper; a two-sided copy of the patent is not proper.

A copy of any prior disclaimer, certificate of correction, or reexamination certificate issued for the patent should also be included with the request; since these are a part of the patent. Again, the copy must have each page plainly written on only one side of a sheet of paper. See also MPEP § 2619.

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

The request must include a certification that a copy of the request papers has been served on the patent owner. The certification must set forth the name and address employed in serving patent owner. If service was not possible after a reasonable effort to do so, a duplicate copy of the request must be supplied to the Office together with a **cover letter** including an explanation of what effort was made to effect service, and why that effort was not successful. To avoid the possibility of the Office erroneously charging a duplicate filing fee, requesters are strongly encouraged to clearly word the cover letter by stating, for example, in bold print in the heading “**Duplicate Copy of Request Filed under 37 CFR 1.915(b)(6) When Service on the Patent Owner Was Not Possible.**”

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

The third party requester must make the certification required by 37 CFR 1.915(b)(7) in order to certify that the requester is not precluded from filing the request for reexamination by: 37 CFR 1.907 and the statute upon which those rules are based (35 U.S.C. 317). See MPEP § 2612.

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

The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same

patent, in making the certifications required by 37 CFR 1.915(b)(8).

37 CFR 1.915(c) states that if the request is filed by an attorney or agent and identifies another party on whose behalf the request is being filed, a power of attorney must be attached, or the attorney or agent must be acting in a representative capacity pursuant to 37 CFR 1.34.

The request should be as complete as possible, since there is no guarantee that the examiner will consider other art (patents and printed publications) when making the decision on the request.

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

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

\*\*\*\*\*

In order to obtain a reexamination filing date, the request papers must include the fee for requesting

*inter partes* reexamination required by 37 CFR 1.915(a) and must satisfy all the requirements set forth in 37 CFR 1.915. 37 CFR 1.919(a). Request papers that fail to satisfy all the requirements of 37 CFR 1.915 are incomplete and will not be granted a filing date. See MPEP § 2627.

>An application data sheet (ADS) under 37 CFR 1.76 cannot be submitted in a reexamination proceeding since a reexamination proceeding is not an “application.”<

Form PTO/SB/58, reproduced following this page, is encouraged for use as the transmittal form and cover sheet of a request for *inter partes* reexamination. The use of this form is encouraged; however, its use is not a requirement of the law nor of the rules. Immediately following is a Form PTO/SB/58 and a sample of a request for reexamination that would be attached to the Form PTO/SB/58 cover sheet (that would be filled out by requester).

\*\*>

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(Also referred to as FORM PTO-1465)

**REQUEST FOR INTER PARTES REEXAMINATION TRANSMITTAL FORM**

Address to:  
**Mail Stop Inter Partes Reexam  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**Attorney Docket No.:**

**Date:**

1.  This is a request for *inter partes* reexamination pursuant to 37 CFR 1.913 of patent number \_\_\_\_\_ issued \_\_\_\_\_. The request is made by a third party requester, identified herein below.
2.  a. The name and address of the person requesting reexamination is:  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_
- b. The real party in interest (37 CFR 1.915(b)(8)) is: \_\_\_\_\_
3.  a. A check in the amount of \$ \_\_\_\_\_ is enclosed to cover the reexamination fee, 37 CFR 1.20(c)(2);  
 b. The Director is hereby authorized to charge the fee as set forth in 37 CFR 1.20(c)(2) to Deposit Account No. \_\_\_\_\_ (submit duplicative copy for fee processing); or  
 c. Payment by credit card. Form PTO-2038 is attached.
4.  Any refund should be made by  check or  credit to Deposit Account No. \_\_\_\_\_. 37 CFR 1.26(c). If payment is made by credit card, refund must be made to credit card account.
5.  A copy of the patent to be reexamined having a double column format on one side of a separate paper is enclosed. 37 CFR 1.915(b)(5)
6.  CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table  
 Landscape Table on CD
7.  Nucleotide and/or Amino Acid Sequence Submission  
*If applicable, items a. – c. are required.*
  - a.  Computer Readable Form (CRF)
  - b. Specification Sequence Listing on:
    - i  CD-ROM (2 copies) or CD-R (2 copies); or
    - ii  paper
  - c.  Statements verifying identity of above copies
8.  A copy of any disclaimer, certificate of correction or reexamination certificate issued in the patent is included.
9.  Reexamination of claim(s) \_\_\_\_\_ is requested.
10.  A copy of every patent or printed publication relied upon is submitted herewith including a listing thereof on Form PTO/SB/08, PTO-1449, or equivalent.
11.  An English language translation of all necessary and pertinent non-English language patents and/or printed publications is included.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.915. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Inter Partes Reexam, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*



OPTIONAL INTER PARTES REEXAMINATION

2614

PTO/SB/58 (09-07)

Approved for use through 08/31/2010. OMB 0651-0033

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

12.  The attached detailed request includes at least the following items:

- a. A statement identifying each substantial new question of patentability based on prior patents and printed publications. 37 CFR 1.915(b)(3)
- b. An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited art to every claim for which reexamination is requested. 37 CFR 1.915(b)(1) and (3)

13.  It is certified that the estoppel provisions of 37 CFR 1.907 do not prohibit this reexamination. 37 CFR 1.915(b)(7)

14.  a. It is certified that a copy of this request has been served in its entirety on the patent owner as provided in 37 CFR 1.33(c).  
The name and address of the party served and the date of service are:

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

Date of Service: \_\_\_\_\_; or

b. A duplicate copy is enclosed since service on patent owner was not possible.

15. Correspondence Address: Direct all communications about the application to:

The address associated with Customer Number:

**OR**

Firm or Individual Name

Address

City	State	Zip
Country		
Telephone	Email	

16.  The patent is currently the subject of the following concurrent proceeding(s):

- a. Copending reissue Application No. \_\_\_\_\_.
- b. Copending reexamination Control No. \_\_\_\_\_.
- c. Copending Interference No. \_\_\_\_\_.
- d. Copending litigation styled: \_\_\_\_\_.

\_\_\_\_\_

\_\_\_\_\_

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

Authorized Signature For Third Party Requester	Date
Typed/Printed Name	Registration Number, if applicable

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

&lt;

Attachment to Form PTO/SB/58

**REQUEST FOR REEXAMINATION OF U.S. PATENT 9,999,999**Identification of Claims for Which Reexamination Is Requested

In accordance with 35 U.S.C. 311 and 37 CFR 1.913, reexamination of claims 1-5 of U.S. Patent 9,999,999 is requested, in view of the following references:

Smith, U.S. Patent 8,999,999

Jones, U.S. Patent 8,555,555

Cooper, U.S. Patent 8,333,333

Reexamination of claim 1 is requested in view of the Smith patent. Reexamination of claim 2 is requested in view of the combination of Smith in view of Jones. Reexamination of claims 3-5 is requested in view of the combination of Smith in view of Jones, and further in view of Cooper. U.S. Patent 9,999,999 is still enforceable.

Statement Pointing Out Each Substantial New Question of Patentability

The Smith and Jones references were not of record in the file of U.S. Patent 9,999,999. Smith discloses a filter comprising a housing containing activated carbon, where the housing has an outer wall, a closed end, an open end, and a lid attachable to the open end as recited in claim 1 (see col. 6, lines 2-3; Figure 3; col. 12, lines 1-3). Jones teaches the activated carbon and ion exchange resin mixture of claim 2 in lines 4-5 column 9. Because these teachings of Smith and Jones provide subject matter of the U.S. Patent 9,999,999 claims that was not taught in any prior art cited during the prosecution of U.S. Patent 9,999,999, the teachings of Smith and Jones each raise a substantial new question of patentability. The Cooper reference was cited in the prosecution of U.S. Patent 9,999,999, but was never relied upon in any rejection of the claims. Cooper discloses the iodinated exchange resin of claims 3-5 in lines 8-10 of column 5. Because this teaching of Cooper was not applied in any rejection of the claims during the prosecution of U.S. Patent 9,999,999, a substantial new question of patentability is raised by Cooper.

Detailed Explanation Under 37 CFR 1.915(b)

1. Claim 1 of U.S. Patent 9,999,999 is unpatentable under 35 U.S.C. 102(b) as being anticipated by Smith, as shown by the following claim chart:

U.S. Patent 9,999,999

**Claim 1.** A filter comprising a housing, the housing having an outer wall, a closed end, an open end, and a lid attachable to the open end. . .

. . . wherein the housing contains a filter material, the filter material comprising activated carbon. . . .

Smith

Smith teaches “the filter housing having an outer wall **1**, a closed end **2**, an open end **3**, and a hinged lid **4** that is securable to the open end **3** via clamp **5**.” (col. 6, lines 2-3; Figure 3). The hinged lid **4** of Smith is attachable to the outer rim of the open end **3** via clamp **5**.

Smith teaches activated carbon as a filter material: “the filter housing containing filter materials, wherein the filter materials include any mixture of known filter materials such as clay, activated carbon, and any other known filter materials.” (col. 12, lines 1-3).

2. Claim 2 of U.S. Patent 9,999,999 is unpatentable under 35 U.S.C. 103 as being obvious over Smith in view of Jones, as shown by the following claim chart:

U.S. Patent 9,999,999

**Claim 2.** The filter of claim 1, wherein the filter material further comprises a mixture of activated carbon and ion exchange resin.

Jones

Jones teaches “preferably, the filter material mixture includes activated carbon and ion exchange resin.” (col. 9, lines 4-5). Smith teaches that the filter materials include “any mixture of known filter materials”, including activated carbon (col. 12, lines 1-3). It would have been obvious to utilize the activated carbon and ion exchange mixture of Jones in the housing of Smith since the mixture of Jones is a “mixture of known filter materials” as taught by Smith.

3. Claims 3-5 of U.S. Patent 9,999,999 are unpatentable under 35 U.S.C. 103 as being obvious over Smith in view of Jones, and further in view of Cooper, as shown by the following claim chart:

U.S. Patent 9,999,999

**Claim 3.** The filter of claim 2, wherein the ion exchange resin is iodinated exchange resin.

Cooper

Cooper teaches “the use of iodinated exchange resin in filter material mixtures for its sterilization properties is preferred.” (col. 5, lines 8-10). The substitution of the iodinated exchange resin of Cooper for the ion exchange resin of the Smith/Jones combination would have been obvious to provide sterilization properties as taught by Cooper.

U.S. Patent 9,999,999

**Claim 4.** The filter of claim 3, wherein the housing is made of metal.

Smith

Smith teaches a metal housing (col. 7, line 8) and a red-colored housing (col. 11, line 3).

**Claim 5.** The filter of claim 3, wherein the housing is red.

Conclusion

For the reasons given above, reexamination of claims 1-5 of U.S. Patent 9,999,999 is requested.

Signed,

John Q. Attorney, Reg. No. 29760  
Attorney for Requester

## 2615 Fee for Requesting *Inter Partes* Reexamination [R-5]

37 CFR 1.915. Content of request for *inter partes* reexamination.

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

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In order for a request to be accepted, given a filing date, and published in the *Official Gazette*, \*\*>the request papers must satisfy all the requirements of 37 CFR 1.915 and the entire< fee required under 37 CFR 1.20(c)(2) for filing a request for *inter partes* reexamination >must be paid<. If the entire filing fee is not paid, the request will be considered to be incomplete.

If the entire fee for requesting reexamination has not been paid after requester has been given an opportunity to do so, no determination on the request will be made. The request papers will ordinarily be placed in the patent file as a prior art citation if they comply with the requirements of 37 CFR 1.501. See MPEP § 2206 for handling of prior art citations.

\*\*>If the request for *inter partes* reexamination is denied (see MPEP § 2647 and § 2648), or if an ordered reexamination is vacated (see MPEP § 2627 and § 2646, subsection I), a refund in accordance with 37 CFR 1.26(c) will be made to the identified requester. If the request for *inter partes* reexamination is found to be incomplete and the defect is not cured (see MPEP § 2627), a refund in accordance with 37 CFR 1.26(a) will be made to the identified requester.<

See MPEP § 2634 for processing of the filing fee.

## 2616 Substantial New Question of Patentability [R-7]

Under 35 U.S.C. 312 and 313, the Office must determine whether “a substantial new question of patentability” affecting any claim of the patent has been raised. 37 CFR 1.915(b)(3) requires that the request include “a statement pointing out each substantial new question of patentability based on the cited patents and printed publications....” Accordingly, it is extremely important that the request clearly set forth in detail exactly what the third party requester consid-

ers the “substantial new question of patentability” to be. The request \*>must< point out how any questions of patentability raised are substantially different from those raised in the previous examination of the patent before the Office. \*\*

>It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested. See also MPEP § 2642.

The legal standard for ordering *inter partes* reexamination, as set forth in 35 U.S.C. 312(a), requires a substantial new question of patentability. The substantial new question of patentability may be based on art previously considered by the Office if the reference is presented in a new light or a different way that escaped review during earlier examination. The clarification of the legal standard for determining obviousness under 35 U.S.C. 103 in *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. \_\_\_\_, 82 USPQ2d 1385 (2007) does not alter the legal standard for determining whether a substantial new question of patentability exists. The requirement for a substantial new question of patentability remains in place even if it is clear from the record of a patent for which reexamination is requested that the patent was granted because the Office did not show “motivation” to combine, or otherwise satisfy the teaching, suggestion, or motivation (TSM) test. Thus, a reexamination request relying on previously applied prior art that asks the Office to look at the art again based solely on the Supreme Court’s clarification of the legal standard for determining obviousness under 35 U.S.C. 103 in *KSR*, without presenting the art in new light or different way, will not raise a substantial new question of patentability as to the patent claims, and reexamination will not be ordered.

After the enactment of the Patent and Trademark Office Authorization Act of 2002 (“the 2002 Act”), a substantial new question of patentability can be raised by patents and printed publications “previously cited

by or to the Office or considered by the Office” (“old art”). The 2002 Act did not negate the statutory requirement for a substantial new question of patentability that requires raising new questions about pre-existing technology. In the implementation of the 2002 Act, MPEP § 2642, subsection II.A. was revised. The revision permits raising a substantial new question of patentability based solely on old art, but only if the old art is “presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request.” Thus, a request may properly raise a substantial new question of patentability by raising a material new analysis of previously considered reference(s) under the rationales authorized by *KSR*.<

Questions relating to grounds of rejection other than those based on prior art patents or printed publications should not be included in the request and will not be considered by the examiner if included. Examples of such questions that will not be considered are questions as to public use, on sale, \*>conduct<, and compliance of the claims with 35 U.S.C. 112.

Affidavits or declarations which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination. See MPEP § 2258.

See MPEP § 2617 for a discussion of the statement in the request which applies the prior art patents or printed publications (the art) to establish the substantial new question(s) of patentability upon which the request for reexamination is based.

## 2617 Statement in the Request Applying Prior Art [R-7]

35 U.S.C. 311(b)(2) states that the request for *inter partes* reexamination must “set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.” 37 CFR 1.915(b)(3) requires that the request include “[a] statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.”

The prior art applied may only consist of prior art patents or printed publications. Substantial new questions of patentability may be based upon the following portions of 35 U.S.C. 102:

*35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.*

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

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(d) the invention was first patented or caused to be patented, or was the subject of an inventor’s certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor’s certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

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(g) \*\*>...< (2) before such person’s invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Similarly, substantial new questions of patentability may also be made under 35 U.S.C. 103 which are based on the above-indicated portions of 35 U.S.C. 102. See also Chapter 2100.

Substantial new questions of patentability must be based on prior art patents or printed publications. Other matters, such as public use or sale, inventorship, 35 U.S.C. 101, 35 U.S.C. 112, fraud, etc., will not be considered when making the determination on

the request and should not be presented in the request. Further, a prior art patent or printed publication cannot be properly applied as a ground for reexamination if it is merely used as evidence of alleged prior public use or on sale. The prior art patent or printed publication must be applied directly to claims under 35 U.S.C. 103 and/or an appropriate portion of 35 U.S.C. 102 or relate to the application of other prior art patents or printed publications to claims on such grounds.

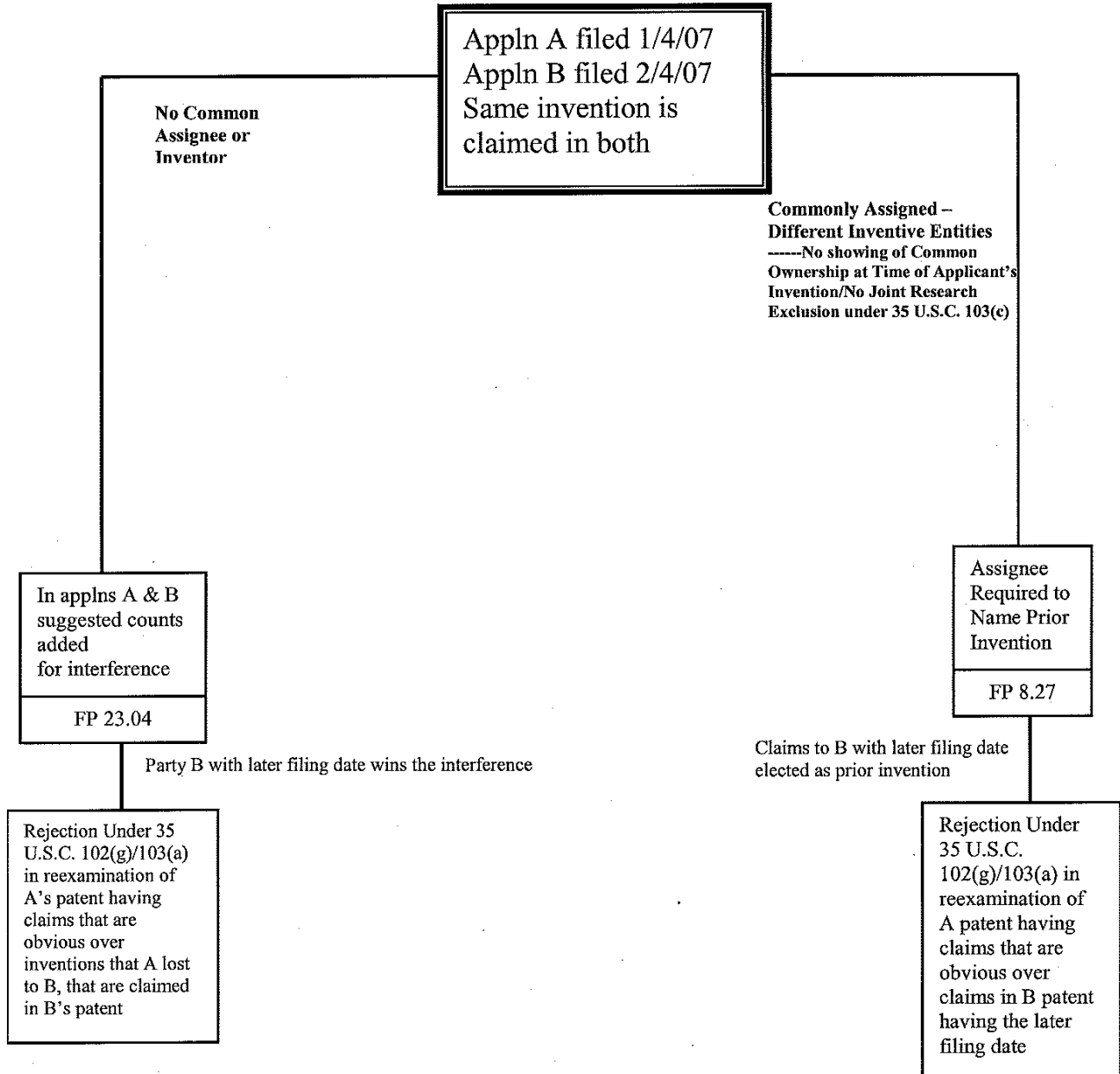
The statement applying the prior art may, where appropriate, point out that claims in the patent for which reexamination is requested are entitled only to the filing date of that patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, even where a patent is a continuing application under 35 U.S.C. 120, the effective date of some of the claims could be the filing date of the child application which resulted in the patent, because those claims were not

supported in the parent application. Therefore, any intervening patents or printed publications would be available as prior art. See *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). See also MPEP § 201.11.

\*\*>Typically, substantial new questions of patentability in a reexamination proceeding are based on “prior art” patents and publications. There are exceptions, however. For example, in *In re Lonardo*, 119 F.3d 960, 43 USPQ2d 1262 (Fed. Cir. 1997), the Federal Circuit upheld a nonstatutory double patenting rejection in which the patent upon which the rejection was based and the patent under reexamination shared the same effective filing date. See also the discussion as to double patenting in MPEP § 2258 . Analogously, a 35 U.S.C. 102 (g)(2) rejection may be asserted in a reexamination proceeding based on the examples illustrated in the chart below:<

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**Rejection of claims in patent with earlier filing date over claims of patent having later filing date- using 35 U.S.C. 102(g), in a manner analogous to double patenting**



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## I. EXPLANATION MUST BE COMPLETE

The mere citation of new patents or printed publications without an explanation does not comply with 37 CFR 1.915(b)(3). Requester should present *an explanation of how* the cited patents or printed publications are *applied* to all claims which the requester considers to merit reexamination based on patents or printed publications. This not only sets forth the requester's position to the Office, but also to the patent owner.

Thus, for example, once the request has cited documents (patents and printed publications) and proposed combinations of the documents as to patent claims 1-10 (for example), the request must explain how *each* of the proposed combinations specifically applies to each claim that it is asserted against (i.e., claims 1 – 10), explaining how each document (reference) identified for the combination is used.

Ideally, the required explanation can be provided using an appropriately detailed claim chart that compares, limitation by limitation, each claim for which reexamination is requested with the relevant teachings of each reference cited in the request. See the sample request for reexamination in MPEP § 2614.

For proposed obviousness rejections, requester **must provide** at least one *basis* for combining the cited references, and a statement of why the claim(s) under reexamination would have been obvious over the proposed reference combination. Preferably, the requester should quote the pertinent teachings in the reference, referencing each quote by page, column and line number and any relevant figure numbers. The explanation **must not** lump together the proposed rejections or proposed combinations of references.

### *Examples of inappropriate language:*

- Claim 1 is unpatentable under 35 U.S.C. 102(b) as being anticipated by, **or in the alternative**, under 35 U.S.C. 103 as being obvious over the Smith reference.
- Claim 1 is unpatentable under 35 U.S.C. 103 as being obvious over Smith **and/or** Charles.
- Claim 2 is unpatentable under 35 U.S.C. 103 as being obvious over Smith in view of Jones **or** Harvey. (This could however be used if both Jones and Harvey provide a minor teaching which can be articulated in a sentence or two.)

- Claims 3 - 10 are unpatentable under 35 U.S.C. 103 as being obvious over Smith in view of either Jones **and** Cooper **or** Harvey **and** Cooper.
- Claims 3 - 10 are unpatentable under 35 U.S.C. 103 as being obvious over Smith in view of Harvey, **taken alone or further in view of** Cooper.

### *Examples of appropriate language:*

- Claim 1 is unpatentable under 35 U.S.C. 102(b) as being anticipated by Smith.
- Claim 1 is unpatentable under 35 U.S.C. 103 as being obvious over Smith.
- Claim 1 is unpatentable under 35 U.S.C. 103 as being obvious over Charles.
- Claim 2 is unpatentable under 35 U.S.C. 103 as being obvious over Smith in view of Jones.
- Claim 2 is unpatentable under 35 U.S.C. 103 as being obvious over Smith in view of Harvey.
- Claims 3 - 10 are unpatentable under 35 U.S.C. 103 as being obvious over Smith in view of Jones, and further in view of Cooper.
- Claims 3 - 10 are unpatentable under 35 U.S.C. 103 as being obvious over Smith in view of Harvey, and further in view of Cooper.

Any failure to provide the required explanation for any document, combination, or claim will be identified in a "Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements" (see MPEP § 2627). If a requester receives such a notice that identifies one or more documents, combinations, or claims for which an explanation was not given, the requester has the option to respond by either:

(A) providing a separate explanation for each combination, document, and claim identified in the notice as lacking explanation; or

(B) explicitly withdrawing any document, combination, or claim for which reexamination was requested for which there is no explanation. Obviously, once this is done, requester need not provide an explanation for the withdrawn document, combination, or claim. Thus, for example, if the requester's response to the notice explicitly withdraws the request as to claims 6-10, then the documents and their combinations need only be applied separately as to claims 1-5 of the patent. Likewise, if the requester's response to the notice explicitly withdraws the Jones patent from the request, then no explanation is required as to

the Jones reference, and all combinations advanced in the request that contained Jones are deemed to be withdrawn.

Even if the request fails to comply with one of the above-identified requirements, the request may be accepted if it is readily understood from the explanation provided in the request as to how the cited patents or printed publications are applied to all claims which requester considers to merit reexamination.

## II. AFFIDAVITS/DECLARATIONS/OTHER WRITTEN EVIDENCE

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in any reexamination. See MPEP § 2258.

## III. ADMISSIONS

The consideration under 35 U.S.C. 312 of a request for reexamination is limited to prior art patents and printed publications. See *Ex parte McGaughey*, 6 USPQ2d 1334, 1337 (Bd. Pat. App. & Inter. 1988). An admission by the patent owner of record in the file or in a court record may be utilized in combination with a patent or printed publication, for establishing a substantial new question of patentability. An admission, *per se*, may not be the basis for establishing a substantial new question of patentability.

For handling of admissions during the examination stage of a reexamination proceeding (i.e., after reexamination has been ordered), see MPEP § 2258.

The admission can reside in the patent file (made of record during the prosecution of the patent application) or may be presented during the pendency of the reexamination proceeding or in litigation. Admissions by the patent owner as to any matter affecting patentability may be utilized to determine the scope and content of the prior art **in conjunction with patents and printed publications**, whether such admissions are found in patents or printed publications or in some other source. An admission relating to any prior art established in the record of the file or in a court record may be used by the examiner in combination with patents or printed publications in a reexamination proceeding. Information supplementing or further defining the admission would be improper.

Any admission submitted by the patent owner is proper. A third party, however, may not submit admissions of the patent owner made outside the record of the file or a court record>, unless such admissions were entered into a court record. If an admission made outside the record of the file or the court record is entered into a court record and a copy thereof is then filed in a reexamination (as a copy of a paper filed in the court), such paper could be admitted pursuant to MPEP § 2686, however, such would not be given weight as an admission with respect to use in establishing a substantial new question of patentability, or as a basis in rejecting claims<. Such a submission would be outside the scope of reexamination.

## 2618 Copies of Prior Art (Patents and Printed Publications) [R-7]

It is required that a copy of each patent or printed publication relied upon, or referred to, in the request be filed with the request (37 CFR 1.915(b)(4)). If the copy provided is not legible, or is such that its image scanned into the Image File Wrapper system (IFW) will not be legible, it is deemed to not have been provided.>The appropriate “Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements” (see MPEP § 2627) will identify this defect.< An exception is color photographs and like color submissions, which, if legible as presented, will be retained in an “artifact” file and used as such. If any of the documents are not in the English language, an English language translation of all necessary and pertinent parts is also required. See MPEP § 609.04(a), subsection III. An English language summary, or abstract of a non-English language document, is usually **not** sufficient. There is no assurance that the Office will consider the non-English language patent or printed publication beyond the translation matter that is submitted.

It is also helpful to include copies of the prior art considered (via a 37 CFR 1.555 information disclosure statement – separate from the listing of the patents or printed publications relied upon as raising a substantial new question of patentability) during earlier prosecution of the patent for which reexamination is requested. The presence of both the old and the new prior art allows a comparison to be made to determine whether a substantial new question of patentability is indeed present.

\*\*>As to the requirement for a copy of every patent or printed publication relied upon or referred to in the request, or submitted under 37 CFR 1.98, this requirement is not currently being enforced to require copies of U.S. patents and U.S. patent publications; and the requirement is deemed waived to that extent. In addition, it is not required nor is it permitted that parties submit copies of copending reexamination proceedings and applications (which copies can be mistaken for a new request/filing); rather, submitters may provide the application/proceeding number and its status (note that a submission that is not permitted entry will be returned, expunged or discarded, at the sole discretion of the Office). For example, where the patent for which reexamination is requested is a continuation in part of a parent application, the requester would notify the Office of the application number of the parent application and its status if the asserted substantial new question of patentability relates to a proposed rejection based on an intervening art and the question of whether the claimed subject matter in the patent has support in the parent application is relevant.<

## 2619 Copy of Printed Patent [Added R-2]

The Office will prepare a separate file wrapper for each reexamination request, which will become part of the patent file. Since in some instances it may not be possible to obtain the patent file promptly, requesters are required under 37 CFR 1.915(b)(5) to include a copy of the printed patent for which reexamination is requested. The copy of the patent for which reexamination is requested should be provided in a double column format. The full copy of the printed patent (including the front page) is employed to provide the abstract, drawings, specification, and claims of the patent for the reexamination request and resulting reexamination proceeding.

A copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent must also be included, so that a complete history of the patent (for which reexamination is requested) is before the Office for consideration. A copy of any Federal Court decision, complaint in a pending civil action, or interference decision should also be submitted.

## 2620 Certificate of Service [R-7]

The third party requester must serve the owner of the patent with a copy of the request in its entirety. See 37 CFR 1.915(b)(6). The service \*must< be made \*\*>on the patent owner's< correspondence address >in the patent file< as indicated in 37 CFR 1.33(c). The name and address of the person served and the certificate of service should be indicated on the request.

\*\* See also MPEP §2666.06 regarding service on the requester and patent owner.

It is required that third party requester set forth the name and address of the party served and the mode method of service on the certificate of service attached to the request. Further, the requester must include a copy of the certificate of service with the copy of the request served on the patent owner. If service was not possible >after a reasonable effort to do so<, a duplicate copy of the request papers must be supplied to the Office together with >a **cover letter** including< an explanation of what effort was made to effect service, and why that effort was not successful. >To avoid the possibility of the Office erroneously charging a duplicate filing fee, requesters are strongly encouraged to clearly word the cover letter by stating, for example, in bold print in the heading “**Duplicate Copy of Request Filed under 37 CFR 1.915(b)(6) When Service on the Patent Owner Was Not Possible.**”<

## 2622 Address of Patent Owner [R-7]

*37 CFR 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings.*

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(c) \*\*>All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the correspondence address. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.<

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**\*\*>Address of Patent Owner:** The correspondence address for the patent to be reexamined, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings. See 37 CFR 1.33(c).

**Representative of Patent Owner:** < As a general rule, the attorney-client relationship terminates when the purpose for which the attorney was employed is accomplished; e.g., the issuance of a patent to the client. However, apart from the attorney-client relationship, the Office has, by regulation, 37 CFR 10.23(c)(8), made it the responsibility of every “practitioner,” by virtue of his/her registration, “to inform a client or former client... of correspondence received from the Office... when the correspondence (i) could have a significant effect on a matter pending before the Office, (ii) is received by the practitioner on behalf of a client or former client, and (iii) is correspondence of which a reasonable practitioner would believe under the circumstances the client or former client should be notified.” (Emphasis added.) This responsibility of a practitioner to a former client manifestly is not eliminated by withdrawing as an attorney or agent of record. The practitioner if he/she so desires, can minimize the need for forwarding correspondence concerning issued patents by having the correspondence address changed after the patent issues if the correspondence address is the practitioner’s address, which frequently is the case where the practitioner is the attorney or agent of record.

Further, 37 CFR 10.23(c)(8) requires a practitioner to “timely notify the Office of an inability to notify a client or former client of correspondence received from the Office.” (Emphasis added.) As the language of this requirement clearly indicates, the duty to notify

the Office is a consequence, not of any attorney-client relationship, but rather arises by virtue of the practitioner’s status as a registered patent attorney or agent.

If the patent owner desires that a different attorney or agent receive correspondence, then a new power of attorney must be filed. **\*\*>See MPEP § 324** for establishing an assignee’s right to take action when submitting a power of attorney.<

Submissions to the Office to change the correspondence address or power of attorney in the record of the patent should be addressed as follows:

Where a request for *inter partes* reexamination has been filed and a reexamination proceeding is accordingly pending as to a patent.

Mail Stop “*Inter Partes* Reexam”  
Attn: Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Where no request for reexamination has been filed and the patent is in storage:

Mail Stop Document Services  
Director of the U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

It is strongly recommended that the Mail Stop information be placed in a prominent position on the first page of each paper being filed utilizing a sufficiently large font size that will direct attention to it.

A sample form for changing correspondence address or power of attorney is set forth below.

OPTIONAL INTER PARTES REEXAMINATION

2622

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PTO/SB/81 (07-08)

Approved for use through 12/31/2008. OMB 0651-0035

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>POWER OF ATTORNEY OR REVOCATION OF POWER OF ATTORNEY WITH A NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS</b>	<b>Application Number</b>	
	<b>Filing Date</b>	
	<b>First Named Inventor</b>	
	<b>Title</b>	
	<b>Art Unit</b>	
	<b>Examiner Name</b>	
	<b>Attorney Docket Number</b>	

I hereby revoke all previous powers of attorney given in the above-identified application.

A Power of Attorney is submitted herewith.

**OR**

I hereby appoint Practitioner(s) associated with the following Customer Number as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

**OR**

I hereby appoint Practitioner(s) named below as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

Practitioner(s) Name	Registration Number

Please recognize or change the correspondence address for the above-identified application to:

The address associated with the above-mentioned Customer Number.

**OR**

The address associated with Customer Number:

<input type="checkbox"/> Firm or Individual Name			
Address			
City	State	Zip	
Country			
Telephone	Email		

I am the:

Applicant/Inventor.

**OR**

Assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) (Form PTO/SB/96) submitted herewith or filed on \_\_\_\_\_.

**SIGNATURE of Applicant or Assignee of Record**

Signature	Date
Name	Telephone
Title and Company	

**NOTE:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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**2623 Withdrawal of Attorney or Agent  
[R-7]**

Any request by an attorney or agent of record to withdraw from a patent will normally be approved

only if at least 30 days remain in any running period for response. See also MPEP § 402.06.

A sample form for a request by an attorney or agent of record to withdraw from a patent is set forth below.

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Doc Code: PET.POA.WDRW

Document Description: Petition to withdraw attorney or agent (SB83)

PTO/SB/83 (04-08)

Approved for use through 12/31/2008. OMB 0651-0035

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS</b>	Application Number	
	Filing Date	
	First Named Inventor	
	Art Unit	
	Examiner Name	
	Attorney Docket Number	

To: Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Please withdraw me as attorney or agent for the above identified patent application, and

- all the practitioners of record;
- the practitioners (with registration numbers) of record listed on the attached paper(s); or
- the practitioners of record associated with Customer Number: \_\_\_\_\_

**NOTE:** The immediately preceding box should only be marked when the practitioners were appointed using the listed Customer Number.

The reason(s) for this request are those described in 37 CFR :

- |   |  |  |  |
|---|--|--|--|
| <input type="checkbox"/> 10.40(b)(1)    | <input type="checkbox"/> 10.40(b)(2)     | <input type="checkbox"/> 10.40(b)(3)                       | <input type="checkbox"/> 10.40(b)(4)     |
| <input type="checkbox"/> 10.40(c)(1)(i) | <input type="checkbox"/> 10.40(c)(1)(ii) | <input type="checkbox"/> 10.40(c)(1)(iii)                  | <input type="checkbox"/> 10.40(c)(1)(iv) |
| <input type="checkbox"/> 10.40(c)(1)(v) | <input type="checkbox"/> 10.40(c)(1)(vi) | <input type="checkbox"/> 10.40(c)(2)                       | <input type="checkbox"/> 10.40(c)(3)     |
| <input type="checkbox"/> 10.40(c)(4)    | <input type="checkbox"/> 10.40(c)(5)     | <input type="checkbox"/> 10.40(c)(6) Please explain below: |  |

**Certifications**

**Check each box below that is factually correct. WARNING: If a box is left unchecked, the request will likely not be approved.**

1.  I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment.
2.  I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled.
3.  I/We have notified the client of any responses that may be due and the time frame within which the client must respond.

Please provide an explanation, if necessary:

[Page 1 of 2]

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS</b>			
<b>Complete the following section only when the correspondence address will change. Changes of address will only be accepted to an inventor or an assignee that has properly made itself of record pursuant to 37 CFR 3.71.</b>			
Change the correspondence address and direct all future correspondence to:			
A. <input type="checkbox"/>	The address of the inventor or assignee associated with Customer Number: _____		
<b>OR</b>			
B. <input type="checkbox"/>	Inventor or Assignee name		
Address			
City	State	Zip	Country
Telephone			Email
I am authorized to sign on behalf of myself and all withdrawing practitioners.			
Signature			
Name			Registration No.
Address			
City	State	Zip	Country
Date	Telephone No.		
<b>NOTE: Withdrawal is effective when approved rather than when received.</b>			

[Page 2 of 2]

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*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

&lt;

## 2624 Correspondence [R-7]

All requests for *inter partes* reexamination (original request papers) and all subsequent *inter partes* reexamination correspondence mailed to the U.S. Patent and Trademark Office via the U.S. Postal Service Mail, other than correspondence to the Office of the General Counsel pursuant to 37 CFR 1.1(a)(3) and 1.302(e), should be addressed:

Mail Stop “*Inter Partes* Reexam”  
Attn: Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

All such correspondence hand carried to the Office, or submitted by delivery service (e.g., Federal Express, DHL, etc., which are commercial mail or delivery services) should be carried to:

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Hand-carried correspondence and correspondence submitted by delivery service should also be marked “Mail Stop *Inter Partes* Reexam.” Whether the correspondence is mailed via the U.S. Postal Service mail or is hand-carried to the Office, it is strongly recommended that the Mail Stop information be placed in a prominent position on the first page of each paper being filed utilizing a sufficiently large font size that will direct attention to it.

A request for *inter partes* reexamination may not be sent by facsimile transmission (FAX). See 37 CFR 1.6(d)(5). >This is also true for a corrected/completed request sent in response to a notice that the original request was not filing date compliant, since the corrected/completed request stands in place of, or is a completion of, the original request papers.< All subsequent *inter partes* reexamination correspondence, however, may be FAXed to:

Central Reexamination Unit  
(571) 273-9900.

>Effective July 9, 2007, the U.S. Patent and Trademark Office began accepting requests for reexamina-

tion, and “follow-on” papers (i.e., subsequent correspondence in reexamination proceedings) submitted via the Office’s Web-based electronic filing system (EFS-Web). The Office has updated the Legal Framework for EFS-Web to set forth that requests for reexamination, and reexamination “follow-on” papers are permitted to be submitted using EFS-Web. The current version of the Legal Framework for EFS-Web may be accessed at: <http://www.uspto.gov/ebc/portal/efs/legal.htm>.<

After the filing of the request for *inter partes* reexamination, any letters sent to the Office relating to the reexamination proceeding should identify the proceeding by the number of the patent undergoing reexamination, the reexamination request control number assigned, the name of the examiner, and the examiner’s Art Unit. \*\*

>The certificate of mailing and transmission procedures (37 CFR 1.8) may be used to file any paper in an *inter partes* reexamination proceeding, except for a request for reexamination and a corrected/replacement request for reexamination. See MPEP § 512 as to the use of the certificate of mailing and transmission procedures. The “Express Mail” mailing procedure (37 CFR 1.10) may be used to file any paper in an *inter partes* reexamination proceeding. See MPEP § 513 as to the use of the “Express Mail” mailing procedure.<

Communications from the Office to the patent owner will be directed to the \*\*>correspondence address for the patent being reexamined. See< 37 CFR 1.33(c).

Amendments and other papers filed on behalf of patent owners must be signed by the patent owners, or the registered attorney or agent of record in the patent file, or any registered attorney or agent acting in a representative capacity under 37 CFR 1.34\*.

Double correspondence with the patent owners and the attorney or agent normally will not be undertaken by the Office.

Where no correspondence address is otherwise specified, correspondence will be with the most recent attorney or agent made of record by the patent owner.

Note MPEP § 2620 for certificate of service.

See MPEP § 2224 for correspondence in *ex parte* reexamination proceedings.

## 2625 Untimely Paper Filed Prior to First Office Action [R-7]

37 CFR 1.939. *Unauthorized papers in inter partes reexamination*

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

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

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

\*\*>Citations by the patent owner in accordance with § 1.933 and by an *inter partes* reexamination third party requester under § 1.915 or § 1.948 will be entered in the *inter partes* reexamination file. The entry in the patent file of other citations submitted after the date of an order for reexamination pursuant to § 1.931 by persons other than the patent owner, or the third party requester under either § 1.913 or § 1.948, will be delayed until the *inter partes* reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate. See § 1.502 for processing of prior art citations in patent and reexamination files during an *ex parte* reexamination proceeding filed under § 1.510.<

Pursuant to 37 CFR 1.939, after filing of a request for *inter partes* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 and 1.933, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2686, should be filed with the Office prior to the date of the first Office action in the reexamination proceeding. Any papers directed to the merits of the reexamination, other than those under 37 CFR 1.501, 1.933, 1.510 or 1.915, or under MPEP § 2686, filed prior to the date of the first Office action will be returned to the sender without consideration. >If the papers are entered prior to discovery of the impropriety, such papers will be expunged from the record.< A copy of the letter \*>providing notification of< the returned papers >or expungement< will be made of record in the patent file. However, no copy of the \*>returned/expunged< papers will be retained by the Office. If the submission of the \*>returned/expunged< papers is appropriate later in the proceedings, they may be filed, and accepted by the Office, at

that time. See *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985); *In re Knight*, 217 USPQ 294 (Comm'r Pat.1982); and *In re Amp*, 212 USPQ 826 (Comm'r Pat. 1981) which addressed the situation analogous to the present situation for *ex parte* reexamination proceedings.

## 2626 Initial Processing of Request for Inter Partes Reexamination [Added R-2]

The opening of all mail marked “Mail Stop *Inter Partes* Reexam” and all initial clerical processing of requests for *inter partes* reexamination will be performed by the reexamination preprocessing staff in the Office of Patent Legal Administration, Central Reexamination Unit.

## 2627 Incomplete Request for Inter Partes Reexamination [R-7]

37 CFR 1.915. *Content of request for inter partes reexamination.*

\*\*\*\*\*

(d) If the *inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

\*\*\*\*\*

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

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

\*\*\*\*\*

Request papers that fail to satisfy all the requirements of 37 CFR 1.915 are incomplete and will not be granted a filing date.

## OFFICE PROCEDURE WHERE THE REQUEST FAILS TO COMPLY WITH REQUIREMENTS FOR A FILING DATE

### A. *Discovery of Non-Compliance with Filing Date Requirement(s) Prior to Assigning a Filing Date*

#### 1. **Notice of Failure to Comply with Reexamination Request Filing Requirements**

The Central Reexamination Unit (CRU) Legal Instrument Examiner (LIE) and CRU Paralegal check the request for compliance with the reexamination filing date requirements. If it is determined that the request fails to meet one or more of the filing date requirements (see MPEP § 2614), the person identified as requesting reexamination will be so notified and will be given an opportunity to complete the requirements of the request within a specified time (generally 30 days). Form PTOL-2076, “Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements,” is used to provide the notification for *inter partes* reexamination. If explanation is needed as to a non-compliance item, the box at the bottom of the form will be checked. An attachment will then be completed to specifically explain why the request does not comply. If there is a filing fee deficiency, a form, PTOL-2057, is completed and attached to form PTOL-2077.

#### 2. **Failure to Remedy Defect(s) in “Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements”**

If after receiving a “Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements,” the requester does not remedy the defects in the request papers that are pointed out, then the request papers will not be given a filing date, but the assigned control number will be retained. Examples of a failure to remedy the defect(s) in the notice are (A) where the third party requester does not timely respond to the notice, and (B) where requester does respond, but the response does not cure the defect(s) identified to requester and/or introduces a new defect or deficiency.

If the third party requester timely responds to the “Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements,” the CRU

LIE and CRU Paralegal will check the request, as supplemented by the response, for correction of all non-compliance items identified in the notice. If any identified non-compliance item has not been corrected, a filing date will not be assigned to the request papers. It is to be noted that a single failure to comply with the “Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements” will ordinarily result in the reexamination request not being granted a filing date. 37 CFR 1.915(d) provides that “[f]ailure to comply with the notice may result in the *inter partes* reexamination request not being granted a filing date.” Thus, absent extraordinary circumstances, requester will be given only one opportunity to correct the non-compliance. Similarly, if the response introduces a new defect or deficiency into the request papers, the *inter partes* reexamination request will not be granted a filing date absent extraordinary circumstances. \*\*

If the request papers are not made filing-date-compliant in response to the Office’s “Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements,” the CRU LIE will prepare a “Notice of Disposition of *Inter Partes* Reexamination Request,” form PTOL-2078, identifying what defects have not been corrected.

### B. *Non-Compliance with Filing Date Requirement(s) Discovered After Initial Issuance of Notice of Reexamination Request Filing Date*

#### 1. **Decision Vacating Filing Date**

After a filing date and control number are assigned to the request papers, the examiner reviews the request to decide whether to grant or deny reexamination. If, in the process of reviewing the request, the examiner notes a non-compliance item not earlier recognized, the examiner will forward a memo to his/her CRU Supervisory Patent Examiner (SPE) detailing any such non-compliance item(s); a “cc” of the e-mail is provided to the Director of the CRU and to a Senior Legal Advisor in the Office of Patent Legal Administration (OPLA) overseeing reexamination. The CRU SPE will screen the memo and discuss the case with an appropriate OPLA Legal Advisor. Upon confirmation of the existence of any such non-compliant item(s), OPLA will issue a decision vacating the assigned reexamination filing date.

In OPLA's decision, the requester will be notified of the non-compliant item(s) and given time to correct the non-compliance. As noted above, 37 CFR 1.915(d) provides that "[f]ailure to comply with the notice may result in the *inter partes* reexamination request not being granted a filing date." Thus, absent extraordinary circumstances, requester will only be given one opportunity to correct the non-compliant item(s) identified in the Decision Vacating Filing Date. This category also includes instances where the Office becomes aware of a check returned for insufficient fund or a stopped payment of a check after a filing date has been assigned, and prior to the decision on the request for reexamination.

## 2. Failure to Remedy Defect in Decision Vacating Filing Date

If the third party requester does not timely respond to the Office's notice, the CRU LIE will so inform a Senior Legal Advisor in the OPLA overseeing reexamination, and OPLA will issue a Decision Vacating the Proceeding.

If the requester timely responds to the Decision Vacating Filing Date, but the response fails to satisfy all the non-compliance items identified in the decision or introduces a new defect into the request papers, the examiner will prepare a memo to that effect. In the memo, the examiner will point out why the defect(s) have not been appropriately dealt with, and whether the non-compliant request papers qualify as a 37 CFR 1.501 submission or not (and why). The examiner will forward the memo to his/her \*>CRU SPE<; a "cc" of the memo is provided to the Director of the CRU and to a Senior Legal Advisor in the OPLA overseeing reexamination. The \*>CRU SPE< will screen the memo and discuss the case with an appropriate OPLA Legal Advisor. Where the defects are not remedied or a new defect has been added, OPLA will issue a Decision Vacating the Proceeding.

The Decision Vacating the Proceeding will identify the items that do not comply with the filing date requirements which were not rectified, or are newly added, using the content of the examiner's memo to explain why the defects are present. The decision will also point out the disposition of the request papers (treated as a 37 CFR 1.501 submission or discarded) and why.

## 2629 Notice of Request for *Inter Partes* Reexamination in *Official Gazette* [R-7]

Notice of filing of all complete requests for *inter partes* reexamination will be published in the *Official Gazette*, approximately 4-5 weeks after filing.

Reexamination requests that have been assigned a filing date will be announced in the *Official Gazette*. The reexamination preprocessing staff of the Office of Patent Legal Administration, Central Reexamination Unit (CRU) will complete a form with the information needed to print the notice. The forms are forwarded at the end of each week to the Office of \*>Data Management< for printing in the *Official Gazette*. The *Official Gazette* notice will appear in the notice section of the *Official Gazette* under the heading of Requests for *Inter Partes* Reexamination Filed and will include the name of any requester along with the other items set forth in 37 CFR 1.11(c).

In addition, a record of requests filed will be located in the Patent Search Room and in the reexamination preprocessing area of the CRU. Office personnel may use the PALM system to determine if a request for reexamination has been filed in a particular patent. See MPEP § 2632.

## 2630 Constructive Notice to Patent Owner [Added R-2]

In some instances, it may not be possible to deliver mail to the patent owner because no current address is available. If all efforts to correspond with the patent owner fail, the reexamination proceeding will proceed without the patent owner. The publication in the *Official Gazette* of the notice of the filing of the *inter partes* reexamination request will serve as constructive notice to the patent owner in such an instance.

## 2631 Processing of Request Corrections [R-5]

\*\*>All processing of submissions to cure an incomplete request for *inter partes* reexamination (see MPEP § 2627) is carried out in the preprocessing area of the Central Reexamination Unit (CRU). Any such submission should be marked "Mail Stop *Inter Partes* Reexam" in the manner discussed in MPEP § 2624 so

that the submission may be promptly forwarded to the reexamination preprocessing staff of the CRU.<

## 2632 Public Access [R-7]

Reexamination files are open to inspection by the general public by way of the Public PAIR via the USPTO Internet site. In viewing the images of the reexamination proceedings, members of the public will be able to view the entire content of the reexamination file >with the exception of non-patent literature<. To access Public PAIR, a member of the public would (A) go to the USPTO web site at <http://www.uspto.gov>, (B) click on the “Site Index” link, (C) click on the letter “E” in the index, (D) click on the link to the Electronic Business Center, (E) in the “Patents” column, click on the “? Status & View Documents” link, (F) under “Patent Application Information Retrieval” in the “\*\*>Search for Application<” box, change the item to “Control Number,” (G) enter the control number of the reexamination proceeding in the “Enter Number” box, and (H) click on “\*>SEARCH<.”

If a copy of the reexamination file is requested, it may be ordered from the Document Services Division of the Office of Public Records (OPR). Orders for such copies must indicate the control number of the reexamination proceeding. Orders should be addressed as follows:

Mail Stop Document Services

Director of the U.S. Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

Requests for a copy of a request may also be sent via e-mail to: [dsd@uspto.gov](mailto:dsd@uspto.gov), and the cost of the copy may be charged to a credit card or deposit account. Alternatively, a copy may be obtained from IFW via PAIR.

To obtain a “certified copy” of a reexamination file, a CD-ROM may be purchased from Document Services Division of OPR.

## 2632.01 Determining If a Reexamination >Request< Was Filed for a Patent [R-7]

### DETERMINING ON PALM IF A REEXAMINATION REQUEST HAS BEEN FILED FOR A GIVEN PATENT NUMBER

Both the Internet and the USPTO Intranet can be accessed to determine if a reexamination request has been filed for a particular patent.

#### A. Using the Internet

- Log on to the Internet.
- Go to USPTO Website located at <http://www.uspto.gov>.
- Click on the “Site Index” link.
- Click on the letter “E” in the index.
- Click on the link to the Electronic Business Center.
- Click on the “? Status & View Documents” link.
- Under “Patent Application Information Retrieval” in the “\*\*>Search for Application<” box, change the item to “Patent Number” and enter the patent number (e.g., 5806063 – no commas are to be inserted) in the “Enter Number” box.
- Click on “\*>SEARCH<.”
- Click the “Continuity Data” button.
- Scroll to “Child Continuity Data” where any related reexamination will be listed. *Ex parte* reexaminations are identified by the unique “90” series code, e.g., 90/005,727. *Inter partes* reexaminations are identified by the unique “95” series code, e.g., 95/000,001.
- Clicking on the underlined (hyper linked) reexamination number will reveal the “Contents” for the reexamination file.

#### B. Using the USPTO Intranet

- From the USPTO Intranet site <http://ptoweb/ptointranet/index.htm>, Office personnel can click on “PALM” and then “General Information” which opens the PALM INTRANET General Information Display.
- From here, enter the patent number in the box labeled Patent #.

- Click on “Search” and when the “Patent Number Information” appears, click on “Continuity Data” to obtain the reexamination number.

Any reexamination for the patent number will be listed.

There will be about a ten (10) day lag between filing and data entry into the PALM database.

## 2633 Workflow [R-7]

After the reexamination file has been reviewed in the Central Reexamination Unit (CRU) to ensure that it is ready for examination, the reexamination proceeding will be assigned to an examiner.

In the event the \*>CRU Supervisory Patent Examiner (SPE)< believes that another Art Unit within the CRU should examine the reexamination >file<, see MPEP § 2637 for procedures for transferring the reexamination >file<.

After the examiner receives the new *inter partes* reexamination file, the examiner will, no later than one week after receipt of the *inter partes* reexamination file, prepare for an initial consultation conference with the Reexamination Legal Advisor (RLA) and notify the \*>CRU SPE< that he/she is ready for the conference and specify the days and times that he/she is available. The \*>CRU SPE< will schedule the consultation conference with the RLA. At the scheduled conference, the consultation will be conducted with the examiner, a \*>CRU SPE<, and the RLA being present. At the consultation conference, the RLA will provide instructions as to preparation of the decision on the request for *inter partes* reexamination and (where reexamination is granted) a first action which would accompany an order granting reexamination. The RLA provides guidance regarding the formalities governing the structure of the examiner’s decision on the request for *inter partes* reexamination and accompanying first action. In the rare circumstances where a first action is not to be provided with the order granting reexamination (see MPEP § 2660), the RLA will so instruct the examiner. The consultation conference should be completed within two weeks of when the case was initially forwarded to the examiner.

After the consultation conference, the examiner will prepare a decision on the request for reexamination, and, where applicable, a first Office action to accompany the decision no later than two weeks from

the date of the consultation conference (unless otherwise authorized by the CRU Director or a RLA). \*\* After the primary examiner signs the decision and/or action, the appropriate materials, e.g., copies of references as needed and a copy of the Office action for the patent owner and the third party requester, will be compiled and any needed copying will be performed by the CRU support staff. Thereafter, the reexamination file will be forwarded to the \*>CRU SPE< for review. The \*>CRU SPE< will then arrange for the decision and/or action to be **hand-carried** directly to the RLA.

The \*>CRU SPE< will have one (1) week from the SPE’s receipt of the reexamination file from the examiner to perform the review, to obtain needed corrections, and to forward the reexamination file to the RLA. **At the very latest**, the decision and action prepared by the examiner must be forwarded to the RLA within nine (9) weeks of the filing date of the request (unless otherwise authorized by the CRU Director or a RLA). After the \*>CRU SPE< approves the Office action, the examiner’s decision and action are **hand-carried** directly to the RLA for a final review. The RLA performs a general review of the decision and action, and then the decision and action are mailed from the CRU. A transmittal form PTOL-501 with the third party requester’s address will be completed, if a copy for mailing is not already available. The transmittal form PTOL-501 is used to forward copies of Office actions (and any references cited in the actions) to the third party requester. Whenever an Office action is issued, a copy of this form will be made and attached to a copy of the Office action. The use of this form removes the need to retype the third party requester’s address each time a mailing is required. In conjunction with the mailing, any appropriate processing (e.g., PALM work, update scanning) is carried out by the staff of the CRU. Ordinarily, there is no counting of actions in a reexamination proceeding; all time spent on reexamination is reported as set forth in MPEP § 2638. Where the reexamination has been merged with a reissue (see MPEP § 2686.03), the merged proceeding will generally be conducted in the TC, and reissue counting will be done by the TC.

Upon receipt of a patent owner response to the action (and third party requester comments where permitted) by the CRU, or upon the expiration of the time to submit same, the examiner will be notified and the



reexamination file is messaged to the examiner. The examiner will review the response and comments, decide on a proposed course of action, consult with the RLA (with the \*>CRU SPE or Technology Center (TC) Quality Assurance Specialist (QAS)< being present) and then prepare the appropriate action for the reexamination. The action will be reviewed and mailed as discussed above. Further prosecution and examination will follow in a similar manner. See MPEP § 2671.03 for panel review prior to issuing Office actions. See MPEP § 2676 for appeal conferences and MPEP § 2677 for Examiner's Answers.

### 2634 Fee Processing and Procedure [R-5]

All fees in an *inter partes* reexamination proceeding (including the fee for filing the request for *inter partes* reexamination (see MPEP § 2615)) are processed by the Central Reexamination Unit (CRU)\*\*. The fees will be posted by the CRU via the Revenue Accounting and Managing (RAM) program.

In an *inter partes* reexamination proceeding, fees are due for the request (37 CFR 1.915(a)), for the addition of claims by the patent owner during the proceeding (excess claims fees under 37 CFR 1.20(c)(3) and (c)(4)), for an extension of time under 37 CFR 1.956, and for any appeal, brief, and oral hearing under 37 CFR 41.20(b). Any petitions filed under 37 CFR 1.137, 37 CFR 1.182 or 37 CFR 1.183 relating to a reexamination proceeding require fees (37 CFR 1.17(f), (l) and (m)).

No fee is required for the issuance of a reexamination certificate.

Small entity reductions under 35 U.S.C. 41(h)(1) are available to the patent owner for appeal fees, brief fees, oral hearing fees, excess claims fees, and the petition fee under 37 CFR 1.958. Small entity reductions are available to the third party requester for appeal fees, brief fees, and oral hearing fees. Small entity reductions in fees are not available for the reexamination filing fee, for extension of time fees, nor for petition fees for petitions filed under 37 CFR 1.182 and 1.183.

When a fee is required in a merged proceeding, only a single fee is needed, even though multiple copies of the submissions (one for each file) are required. See MPEP § 2686.01.

### 2635 Record Systems [R-7]

The Patent Application Locating and Monitoring (PALM) system is used to support the reexamination process. The sections below delineate PALM related activities.

(A) *Reexamination File Data on PALM* - The routine PALM retrieval transactions are used to obtain data on reexamination files. From the USPTO Intranet site <http://ptoweb/ptointranet/index.htm> "PALM" and then "General Information" which opens the PALM INTRANET General Information Display. From here, enter the patent number in the box labeled Patent #. Then click on "Search" and when the "Patent Number Information" appears, click on "Continuity Data" to obtain the reexamination number.

(B) *Reexamination e-File* - The papers of a reexamination proceeding may be viewed on IFW. PALM provides information for the reexamination proceeding as to the patent owner and requester, contents, status, and related Office proceedings (applications, patents and reexamination proceedings). Some of the data entry for reexamination in PALM is different from that of a regular patent application. There are also differences in the status codes - all reexamination proceedings have status codes in the "400" or "800" range, while patent applications have status codes ranging from "020" to over "100."

(C) *Patent File Location Control for Patents Not Available on IFW, i.e., Available Only in Paper File* - The movement of paper patent files related to requests for reexamination throughout the Office is monitored by the PALM system in the normal fashion. The patent file will be charged to the examiner assigned the reexamination file, and the patent file will be kept in the examiner's office until the proceeding is concluded. After the reexamination proceeding has been concluded, the patent file should be forwarded by the examiner, via the \*\*>Technology Center (TC) Quality Assurance Specialist (QAS) or the Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) to the CRU support staff<. After review and processing in the CRU and by the Office of Patent Legal Administration as appropriate, the patent \*>file< will be forwarded to the Office of \*>Data Management<. The Office of \*>Data Management< will forward the patent file to the Record Room after printing of the certificate.

(D) *Reporting Events to PALM* - The PALM system is used to monitor major events that take place in processing reexamination proceedings. All major examination events are reported. The mailing of examiner's actions are reported, as well as owner's responses and third party requester comments. The CRU support staff is responsible for reporting these events using the reexamination icon and window initiated in the PALM EXPO program. Events that will be reported include the following:

- (1) Determination Mailed-Denial of request for reexamination;
- (2) Determination Mailed-Grant of request for reexamination;
- (3) Petition for reconsideration of determination received;
- (4) Decision on petition mailed-Denied;
- (5) Decision on petition mailed-Granted;
- (6) Mailing of all examiner actions;
- (7) Patent owner responses to Office Actions
- (8) Third party requester comments after a patent owner response.

All events will be permanently recorded and displayed in the "Contents" portion of PALM. In addition, status representative of these events will also be displayed.

(E) *Status Reports* - Various weekly "tickler" reports can be generated for each TC, given the event reporting discussed above. The primary purpose of these computer outputs is to assure that reexaminations are, in fact, processed with "special dispatch".

## 2636 Assignment of Reexamination [R-7]

### I. EXAMINER ASSIGNMENT OF THE REEXAMINATION PROCEEDING

Reexamination requests will normally be assigned to the Central Reexamination Unit (CRU) art unit which examines the technology (Chemical, Electrical, Mechanical, etc.) in which the patent to be reexamined is currently classified as an original. In that art unit, the **\*\*>Supervisory Patent Examiner (SPE)<** assigns the reexamination request to a primary examiner, other than the examiner that originally examined the patent (see "Examiner Assignment Policy" below), who is most familiar with the claimed subject matter of the patent. **\*\*>In an extremely rare situa-**

tion, where a proceeding is still in a Technology Center (TC) rather than the CRU, the reexamination may be assigned to an assistant examiner if no knowledgeable primary examiner is available.< In such an instance a primary examiner must sign all actions and take responsibility for all actions taken.

#### (A) *Examiner Assignment Policy*

It is the policy of the Office that the CRU **\*>SPE<** will assign the reexamination request to an examiner different from the examiner(s) who examined the patent application. Thus, under normal circumstances, the reexamination request will not be assigned to a primary examiner or assistant examiner who was involved in any part of the examination of the patent for which reexamination is requested (e.g., by preparing/signing an action), or was so involved in the examination of the parent of the patent. This would preclude assignment of the request to an examiner who was a conferee in an appeal conference or panel review conference in an earlier concluded examination of the patent (e.g., the application for patent, a reissue, or a prior concluded reexamination proceeding). The conferee is considered to have participated in preparing the Office action which is preceded by the conference.

**Exceptions to this general policy include** cases where the original examiner is the only examiner with adequate knowledge of the relevant technology to examine the case. In the unusual case where there is a need to assign the request to the original examiner, the assignment must be approved by the CRU Director, and the fact that such approval was given by the CRU Director must be stated (by the examiner) in the decision on the request for reexamination.

It should be noted that while an examiner who examined an earlier **concluded** reexamination proceeding is generally excluded from assignment of a newly filed reexamination, *if the earlier reexamination is still **ongoing**, the same examiner will be assigned the new reexamination.*

#### **Copending reissue and reexamination proceeding:**

- (1) When a reissue application is pending for a patent, and a reexamination request is filed for the same patent, the reexamination request is generally assigned to an examiner who did not examine the original patent application even though the examiner

who examined the patent application is handling the reissue application. If the reexamination request is granted and the reissue and reexamination proceedings are merged (see MPEP § 2686.03), the merged proceeding will be handled by a TC examiner other than the examiner who examined the original patent application. In that instance, the reissue application would be transferred (reassigned) from the originally assigned examiner.

(2) When a reexamination proceeding is pending for a patent, and a reissue application is filed for the same patent:

(a) Where reexamination has already been ordered (granted) in the reexamination proceeding, the Office of Patent Legal Administration (OPLA) should be notified, as promptly as possible after the reissue application reaches the TC, that the proceedings are ready for consideration of merger. If any of the reexamination file, the reissue application, and the patent file are paper files, they should be hand delivered to OPLA at the time of the notification to OPLA (see MPEP § 2686.03). If the reissue and reexamination proceedings are merged by OPLA, the reissue will generally be assigned in the TC having the reissue (upon return of the files from OPLA) to the TC examiner who would ordinarily handle the reissue application. However, if that examiner was involved in any part of the examination of the patent for which reexamination is requested (e.g., by preparing/signing an action), or was so involved in the examination of the parent application of the patent, a different TC examiner will be assigned. If the reissue and reexamination proceedings are not merged by OPLA, the decision will provide guidance as to assignment of the reissue proceeding depending on the individual fact situation.

(b) If reexamination has not yet been ordered (granted) in the reexamination proceeding, a TC Quality Assurance Specialist (QAS) will ensure that the reissue application is not assigned nor acted on, and the decision on the reexamination request will be made. If reexamination is denied, the reexamination proceeding will be concluded pursuant to MPEP § 2694, and the reissue application assigned in accordance with MPEP § 1440. If reexamination is granted, a first Office action will not accompany the order granting reexamination. The signed order should be (after review by the CRU SPE) promptly for-

warded to the OPLA for mailing. At the same time, the OPLA should be notified that the proceedings are ready for consideration of merger. If any of the reexamination file, the reissue application, and the patent file are paper files, they should be hand delivered to OPLA at the time of the e-mail notification to OPLA (see MPEP § 2686.03). If the reissue and reexamination proceedings are merged by OPLA, the reissue application will generally be assigned in the TC having the reissue (upon return of the files from OPLA) to the TC examiner who ordinarily handle the reissue application. However, if that examiner was involved in any part of the examination of the patent for which reexamination is requested (e.g., by preparing/signing the action), or was so involved in examination of the parent application of the patent, a different TC examiner will be assigned. If the reissue and reexamination proceedings are not merged by OPLA, the decision will provide guidance as to assignment of the reissue proceeding depending on the individual fact situation.

**(B) Consequences of Inadvertent Assignment to an “Original Examiner”**

Should a reexamination be inadvertently assigned to an “original examiner” (in a situation where the TC or CRU Director’s approval is not stated in the decision on the request), the patent owner or the third party requester who objects must promptly file a paper alerting the Office of this fact. Any request challenging the assignment of an examiner to the case must be made within two months of the first Office action or other Office communication indicating the examiner assignment, or reassignment will not be considered. Reassignment of the reexamination to a different examiner will be addressed on a case-by-case basis. In no event will the assignment to the original examiner, by itself, be grounds for vacating any Office decision(s) or action(s) and “restarting” the reexamination.

A situation may arise where a party timely (i.e., within the two months noted above) files a paper alerting the Office to the assignment of a reexamination to the “original examiner,” but that paper does not have a right of entry under the rules (e.g., where an order granting reexamination was issued by the “original examiner” but a first action on the merits did not accompany the order, the patent owner timely files a paper alerting the Office of the fact that the “original

examiner” has been assigned the reexamination proceeding. Pursuant to 37 CFR 1.939(b), that paper does not have a right of entry since a first Office action on the merits has not yet been issued.) In such situations, the Office may waive the rules to the extent that the paper directed to the examiner assignment will be entered and considered.

## II. MECHANICS OF ASSIGNMENT

When a request for reexamination is received in the Office, it will be processed by the CRU support staff. After the case file has been reviewed in the CRU to ensure it is ready for examination, the CRU support staff will docket the case to the examiner assigned to the reexamination proceeding by the \*>CRU SPE<.

In the event the \*>CRU SPE< believes that another Art Unit should examine the case, see MPEP § 2637 for procedures for transferring the case.

### 2637 Transfer Procedure [R-7]

Although the number of reexamination requests which must be transferred should be very small, the following procedures have been established for an expeditious resolution of any such problems.

An *inter partes* reexamination request is normally assigned to the Central Reexamination (CRU) art unit which examines the technology (Chemical, Electrical, Mechanical, etc.) in which the patent to be reexamined is currently classified as an original. If the CRU \*>Supervisory Patent Examiner (SPE)< (to whose art unit the reexamination has been assigned) believes that the reexamination should be assigned to another art unit, he or she must obtain the consent of the CRU \*>SPE< of the art unit to which a transfer is desired. Pursuant to 35 U.S.C. 314(c), all *inter partes* reexamination proceedings must be conducted with special dispatch within the Office. This applies to the transfer of reexamination proceedings. Accordingly, the CRU \*>SPE< to whose art unit the reexamination has been assigned should expeditiously make any request for transfer of a reexamination proceeding to the CRU \*>SPE< of the art unit to which a transfer is desired (the “new” art unit). Further, the CRU \*>SPE< to whose art unit the reexamination has been assigned should hand-carry any paper patent file for the reexamination proceeding to the SPE of the art unit to

which a transfer is desired. Any conflict which cannot be resolved by the \*>SPEs< will be resolved by the CRU Director.

If the “new” art unit accepts assignment of the reexamination request, the “new” CRU \*>SPE< assigns the request to an examiner in that unit.

### 2638 Time Reporting [R-7]

\*>Reexamination fees are based on full cost recovery, and it is essential that all time expended on reexamination activities be reported accurately. Thus, all USPTO personnel should report all time spent on reexamination on their individual Time and Attendance Reports. Even activities such as supervision, copying, typing, and docketing should be included.<

### 2640 Decision on Request [R-7]

35 U.S.C. 312. *Determination of issue by Director*

(a) REEXAMINATION.— Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

(b) RECORD.— A record of the Director’s determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester.

(c) FINAL DECISION.— A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the inter partes reexamination fee required under section 311.

37 CFR 1.923. *Examiner’s determination on the request for inter partes reexamination.*

\*>Within three months following the filing date of a request for *inter partes* reexamination under § 1.915, the examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art citation. The examiner’s determination will be based on the claims in effect at the time of the determination, will become a part of the official file of the patent, and will be mailed to the patent owner at the address as provided for in § 1.33(c) and to the third party requester. If the examiner determines that no substantial new question of patentability is present, the examiner shall refuse the request and shall not order *inter partes* reexamination.<

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

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

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

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

Prior to making a determination on the request for reexamination, the examiner must request a litigation \* search by the Scientific and Technical Information Center (STIC) to check if the patent has been, or is, involved in litigation. A copy of the STIC search is scanned into the IFW reexamination file history. The "Litigation Review" box on the reexamination IFW file jacket form is completed to indicate that the review was conducted and the results thereof, and the reexamination file jacket form is then scanned into the IFW reexamination file history. In the rare instance where the record of the reexamination proceeding or the STIC search indicates that additional information is desirable, guidance as to making an additional litigation search may be obtained from the library of the Office of the Solicitor. If the patent is or was involved in litigation, and a paper referring to the Court proceeding has been filed, reference to the paper by number should be made in the "Litigation Review" box of the IFW file jacket form as, for example, "litigation; see paper filed 7-14-2005." If a litigation records search is already noted on the file, the examiner need not repeat or update it.

If litigation has concluded or is taking place in the patent on which a request for reexamination has been filed, the request must be promptly brought to the attention of the Reexamination Legal Advisor assigned to the case who should review the decision on the request and any examiner's action to ensure conformance to the current Office litigation policy and guidelines. See MPEP § 2686.04.

35 U.S.C. 312 requires that the Director of the Office determine whether or not a "substantial new question of patentability" affecting any claim of the patent of which reexamination is desired, is raised in

the request not later than 3 months after the filing date of a request. See also MPEP § 2641. Such a determination may be made with or without consideration of other patents or printed publications in addition to those cited in the request. No input from the patent owner is considered prior to the determination. See *Patlex v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985).

The patent claims in effect at the time of the determination will be the basis for deciding whether a substantial new question of patentability has been raised (37 CFR 1.923). See MPEP § 2643. Amendments which (A) have been filed in a copending reexamination proceeding in which the reexamination certificate has not been issued, or (B) have been submitted in a reissue application on which no reissue patent has been issued, will not be considered or commented upon when deciding a request for reexamination.

The decision on the request for reexamination has as its main object either the granting or denial of the request for reexamination. This decision is based on whether or not "a substantial new question of patentability" is found. A \*\*>determination as to patentability/unpatentability< of the claims is **not** made in the decision >on the request<; rather, it is made later, during the examination stage of the reexamination proceeding >if reexamination is ordered<. Accordingly, no *prima facie* case of unpatentability need be found to grant an order for reexamination. >If a decision to deny an order for reexamination is made, the requester may seek review by a petition under 37 CFR 1.181. See 37 CFR 1.927.< It should be noted that a decision to deny the request for reexamination is equivalent to a final holding (subject >only< to a petition pursuant to 37 CFR 1.927 for review of the denial), that the \*\*>request failed to raise a substantial new question of patentability based on< the cited art (patents and printed publications).

Where there have been prior decisions relating to the patent, see MPEP § 2642.

It is only necessary to establish that a substantial new question of patentability exists as to one of the patent claims in order to grant reexamination. The Office's determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the claim(s) for which reexamination was requested. If the requester was interested in having all of the claims

reexamined, requester had the opportunity to include them in its request for reexamination. However, if the requester chose not to do so, those claim(s) for which reexamination was not requested will generally not be reexamined by the Office. It is further noted that 35 U.S.C. 311(b)(2) requires that a requester “set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.” If the requester fails to apply the art to certain claims, then the requester is not statutorily entitled to reexamination of such claims. If a request fails to set forth the pertinency and manner of applying the cited art to any claim for which reexamination is requested as required by 37 CFR 1.915(b), that claim will generally not be reexamined. The decision to reexamine any claim for which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts and situation of each individual case. If the Office chooses to reexamine any claim for which reexamination has not been requested, it is permitted to do so. In addition, the Office may always initiate a reexamination on its own initiative of the non-requested claim (35 U.S.C. 303(a)). See *Sony Computer Entertainment America Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va 2006). It is to be noted that if a request fails to set forth the pertinency and manner of applying the cited art to any claim for which reexamination is requested as required by 37 CFR 1.915, a filing date will not be awarded to the request. See MPEP § 2617 and § 2627.<

One instance where reexamination was carried out only for the claims requested occurred in reexamination control numbers 95/000,093 and 95/000,094, where reexamination was requested for patent claims which were being litigated, but not for claims which were not being litigated. In that instance, the entirety of the reexamination was limited to the claims which were being litigated, for which reexamination was requested. The Office’s authority to carry out reexamination only for the claims for which reexamination was requested in reexamination control numbers 95/000,093 and 95/000,094 was confirmed by the court in *Sony, supra*. See MPEP § 2642 for the situation where there was a prior final federal court decision as to the invalidity/unenforceability of some of the claims, as another example of non-examination of

some of the patent claims in a reexamination proceeding.

The decision on the request for reexamination should discuss all of the patent claims requested for reexamination. The examiner should limit the discussion of those claims in the order for reexamination as to whether a substantial new question of patentability has been raised. The examiner SHOULD NOT reject claims in the order for reexamination. Rather, any rejection of the claims will be made in the first Office action that normally will accompany the order for reexamination. See MPEP § 2660.

The Director of the Office has the authority to order reexamination only for a request which raises a substantial new question of patentability. The substantial new question of patentability requirement protects patentees from having to respond to, or participate in, unjustified reexaminations. See *Patlex v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985, 989 (Fed. Cir. 1985).

## **I. REQUEST FOR REEXAMINATION OF THE PATENT AFTER REISSUE OF THE PATENT**

Where a request for reexamination is filed on a patent after a reissue patent for that patent has already issued, reexamination will be denied, because the patent on which the request for reexamination is based has been surrendered. Should reexamination of the reissued patent be desired, a new request for reexamination, including and based on the specification and claims of the reissue patent, must be filed. Where the reissue patent issues after the filing of a request for reexamination, see MPEP § 2686.03.

## **II. SECOND OR SUBSEQUENT REQUEST FILED DURING REEXAMINATION**

See MPEP § 2686.01 for a comprehensive discussion of the situation where a first reexamination is pending at the time a second or subsequent request for reexamination is to be decided, and one of the two is an *inter partes* reexamination. The present subsection merely provides guidance on the standard for the substantial new question of patentability to be applied in the decision on the second or subsequent request.

If a second or subsequent request for reexamination is filed (by any party permitted to do so) while a first reexamination is pending, the presence of a substantial new question of patentability depends on the art

(patents and printed publications) cited by the second or subsequent request. The cited art will be reviewed for a substantial new question of patentability based on the following guidelines:

**A. If one of the two reexaminations is an *inter partes* reexamination, the following possibilities exist:**

(1) An ordered *inter partes* reexamination is pending, and an *ex parte* reexamination request is subsequently filed.

(2) An ordered *inter partes* reexamination is pending, and an *inter partes* reexamination request is subsequently filed.

(3) An ordered *ex parte* reexamination is pending, and an *inter partes* reexamination request is subsequently filed.

In all three instances, if the subsequent request includes the art which raised a substantial new question in the earlier pending reexamination, then reexamination should be ordered only if the art cited raises a substantial new question of patentability which is different from that raised in the earlier pending reexamination. If the art cited in the subsequent request raises the same substantial new question of patentability as that raised in the earlier pending reexamination, the subsequent request should be denied. Where the request raises a different substantial new question of patentability as to some patent claims, but not as to others, the request would be granted in part; see the order issued in reexamination control number 90/007,843 and 90/007,844. If the subsequent request does **not** include the art which raised the substantial new question of patentability in the earlier pending reexamination, reexamination may or may not be ordered, depending on whether the different art cited raises a substantial new question of patentability.

The second or subsequent request for reexamination may provide information raising a substantial new question of patentability with respect to any new or amended claim which has been proposed in the first (or prior) pending reexamination proceeding. However, in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is **different from** that raised in the pending reexamination for **the claims in effect at the time of the determina-**

**tion.** The decision on the second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.923). If a “different” substantial new question of patentability is not provided by the second or subsequent request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied since the Office is only authorized by statute to grant a reexamination proceeding based on a substantial new question of patentability “affecting any claim of the patent.” See 35 U.S.C. 312(a). Accordingly, there must be at least one substantial new question of patentability established for the existing claims in the patent in order to grant reexamination.

Once the second or subsequent request has provided a “different” substantial new question of patentability based on the claims in effect at the time of the determination, the second or subsequent request for reexamination may also provide information directed to any proposed new or amended claim in the pending reexamination, to permit examination of the entire patent package. The information directed to a proposed new or amended claim in the pending reexamination is addressed during the later filed reexamination (where a substantial new question of patentability is raised in the later filed request for reexamination for the existing claims in the patent), in order to permit examination of the entire patent package. When a proper basis for the second or subsequent request for reexamination is established, it would be a waste of resources to prevent addressing the proposed new or amended claims, by requiring parties to wait until the certificate issues for the proposed new or amended claims, and only then to file a new reexamination request challenging the claims as revised via the certificate. This also prevents a patent owner from simply amending all the claims in some nominal fashion to preclude a subsequent reexamination request during the pendency of the reexamination proceeding.

Where reexamination is granted on a second or subsequent request, but the patent owner can clearly show that the second or subsequent request was filed for purposes of harassment, the patent owner *can petition under 37 CFR 1.182* that the second or subsequent request should be suspended. If such a petition is granted, prosecution on the second or subsequent

reexamination would be suspended until conclusion of proceedings in the first reexamination. In such an instance, merger of the second (or subsequent) reexamination with the first would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement that the reexamination proceeding be conducted with special dispatch.

Where an ordered *inter partes* reexamination is pending, and an *inter partes* reexamination request is subsequently filed, the prohibition provision of 37 CFR 1.907(a) must be borne in mind. Once an order for *inter partes* reexamination has been issued, neither the third party requester of the *inter partes* reexamination, nor its privies, may file a subsequent request for *inter partes* reexamination of the same patent until an *inter partes* reexamination certificate has been issued, unless expressly authorized by the Director of the Office. Note that 37 CFR 1.907(a) tracks the statutory provision of 35 U.S.C. 317(a). A petition for such express authorization is a request for extraordinary relief and will not be granted where there is a more conventional avenue to accomplish the same purpose and provide relief analogous to that requested. See also *Cantello v. Rasmussen*, 220 USPQ 664 (Comm'r Pat. 1982) for the principle that extraordinary relief will not normally be considered if the rules provide an avenue for obtaining the relief sought.

>For additional treatment of cases in which either the first or subsequent request for examination, or both, is/are an *inter partes* reexamination proceeding, see MPEP § 2640 and § 2686.01.

For additional treatment of cases in which a first *ex parte* reexamination is pending at the time a second or subsequent request for *ex parte* reexamination is to be decided, see MPEP § 2283.<

## 2641 Time for Deciding Request [R-7]

The determination of whether or not to reexamine must be made (completed and mailed) not later than three (3) months after the filing date of a request. See 35 U.S.C. 312(a) and 37 CFR 1.923. *If the 3-month period ends on a Saturday, Sunday or Federal holiday within the District of Columbia*, then the determination must be mailed by the **preceding** business day.

Generally, the Central Reexamination Unit (CRU) forwards the *inter partes* reexamination case to the examiner within two (2) weeks of the filing date of the request.

(A) The examiner has one (1) week from his/her receipt of the reexamination to prepare for an initial consultation conference with a Reexamination Legal Advisor (RLA).

After the consultation with the RLA, the examiner has two (2) weeks from the date of the consultation conference to prepare the decision on the request and an Office action (if reexamination is granted), and forwards the reexamination to the **>CRU** Supervisory Patent Examiner (SPE)<.

The decision and the action will be reviewed by the **>CRU** SPE< and the reexamination file along with the decision and action will be forwarded (hand carried) to the RLA.

(B) **At the very latest**, the decision and action prepared by the examiner must be hand carried by the SPRE to the RLA within nine (9) weeks from the filing date of the request (unless otherwise authorized by the CRU Director or a RLA).

(C) It should be noted that the first Office action ordinarily accompanies an order for reexamination; however, if the issuance of the first Office action would delay the order to the extent that a critical deadline will not be met, the order will be mailed and the first action will follow in due course, as per the guidance set forth in MPEP § 2660.

## 2642 Criteria for Deciding Request [R-7]

### I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY

The presence or absence of “a substantial new question of patentability” determines whether or not reexamination is ordered. The meaning and scope of the term “a substantial new question of patentability” is not defined in the statute and must be developed to some extent on a case-by-case basis, using the case law to provide guidance as will be discussed in this section.

If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, unless the same question of patentability has already been decided by (A) a final holding of invalidity, after all appeals, or (B) by the Office in a previous examination or pending reexamination of the patent. A “previous examination” of the patent is: (A) the original examination of the



application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in a reissue of the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination. The answer to the question of whether a “substantial new question of patentability” exists, and therefore whether reexamination may be had, is decided by the Director of the Office, and as 35 U.S.C. 312(c) provides, that determination is final, i.e., not subject to appeal on the merits of the decision. See *In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) which was decided for the *ex parte* reexamination statute (note that 35 U.S.C. 312(c) for the *inter partes* reexamination statute contains the same language as 35 U.S.C. 303(c) for *ex parte* reexamination). But see *Heinl v. Godici*, 143 F.Supp.2d 593, 596-98 (E.D. Va. 2001) (35 U.S.C. 303 addresses only USPTO decisions to deny a request for reexamination and does not bar review of *ultra vires* USPTO decisions to grant reexamination requests. However, a decision to grant a reexamination request is not a final agency decision and is not ordinarily subject to judicial review.).

A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication **important** in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find “a substantial new question of patentability” unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by the Federal court system or by the Office in a previous examination. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications to be merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.

Accordingly, for “a substantial new question of patentability” to be present, it is only necessary that:

(A) The prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the prior art patents and printed publications is such that a reasonable examiner would consider the teaching to

be **important** in deciding whether or not the claim is patentable; and

(B) The same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

It is not necessary that a “*prima facie*” case of unpatentability exist as to the claim in order for “a substantial new question of patentability” to be present as to the claim. Thus, “a substantial new question of patentability” as to a patent claim could be present even if the examiner would not necessarily reject the claim as either anticipated by, or obvious in view of, the prior art patents or printed publications. The difference between “a substantial new question of patentability” and a “*prima facie*” case of unpatentability is important. See generally *In re Etter*, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985).

>Note that the clarification of the legal standard for determining obviousness under 35 U.S.C. 103 in *KSR International Co. v. Teleflex Inc.*(*KSR*), 550 U.S. \_\_\_\_, 82 USPQ2d 1385 (2007) does not alter the legal standard for determining whether a substantial new question of patentability exists. See the discussion in MPEP § 2616.< It should be >also< noted that the “substantial new question of patentability” standard for granting reexamination on a request for an *inter partes* reexamination is the same as the “substantial new question of patentability” standard for granting reexamination on a request for an *ex parte* reexamination.

Where a >second or subsequent< request for reexamination of a patent is made before the conclusion of an earlier filed reexamination proceeding pending (ongoing) for that patent, **\*\*>**the second or subsequent request for reexamination may provide information raising a substantial new question of patentability with respect to any new or amended claim which has been proposed under 37 CFR 1.530(d) in the ongoing pending reexamination proceeding. However, in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is **different from** that raised in the pending reexamination for **the claims in effect at the time of the determination**. The decision

on the second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.923). If a “different” substantial new question of patentability is not provided by the second or subsequent request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied since the Office is only authorized by statute to grant a reexamination proceeding based on a substantial new question of patentability “affecting any claim of the patent.” See 35 U.S.C. 312. Accordingly, there must be at least one substantial new question of patentability established for the existing claims in the patent in order to grant reexamination.

Once the second or subsequent request has provided a “different” substantial new question of patentability based on the claims in effect at the time of the determination, the second or subsequent request for reexamination may also provide information directed to any proposed new or amended claim in the pending reexamination, to permit examination of the entire patent package. The information directed to a proposed new or amended claim in the pending reexamination is addressed during the later filed reexamination (where a substantial new question is raised in the later reexamination for the existing claims in the patent), in order to permit examination of the entire patent package. When a proper basis for the subsequent reexamination is established, it would be a waste of resources to prevent addressing the proposed new or amended claims, by requiring parties to wait until the certificate issues for the proposed new or amended claims, and only then to file a new reexamination request challenging the claims as revised via the certificate. This also prevents a patent owner from simply amending all the claims in some nominal fashion to preclude a subsequent reexamination request during the pendency of the reexamination proceeding.<

## II. POLICY IN SPECIFIC SITUATIONS

In order to further clarify the meaning of “a substantial new question of patentability,” certain situations are outlined below which, if present, should be considered when making a decision as to whether or not “a substantial new question of patentability” is present.

### A. *Prior Favorable Decisions by the U.S. Patent and Trademark Office on the Same or Substantially Identical Prior Art in Relation to the Same Patent.*

A “substantial new question of patentability” is not raised by the prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent’s file history to ascertain whether any of the prior art now advanced by requester *was* previously cited/considered in an earlier Office examination of the patent (e.g., in the examination of the application for the patent, or in a concluded or pending reexamination proceeding). For the sake of expediency, such art is referred to as “old art” throughout, since the term “old art” was coined by the Federal Circuit in its decision of *In re Hiniker Co.*, 150 F.3d 1362, 1365-66, 47 USPQ2d 1523, 1526 (Fed. Cir. 1998).

In a decision to order reexamination made on or after November 2, 2002, reliance on old art does not necessarily preclude the existence of a substantial new question of patentability \* that is based exclusively on that old art. See Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002), which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based. Determinations on whether a \*>substantial new question of patentability< exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a \*>substantial new question of patentability< may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier \* examination(s), in view of a material new argument or interpretation presented in the request.

When it is determined that a \*>substantial new question of patentability< based solely on old art is raised, form paragraph 22.01.01 should be included in the order for reexamination.

¶ 22.01.01 *Criteria for Applying “Old Art” as Sole Basis for Reexamination*

The above [1] is based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

“The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.”

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., “old art,” does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, there exists a SNQ based solely on [2]. A discussion of the specifics now follows:

[3]

**Examiner Note:**

1. In bracket 1, insert “substantial new question of patentability” if the present form paragraph is used in an order granting reexamination (or a TC or CRU Director’s decision on petition of the denial of reexamination). If this form paragraph is used in an Office action, insert “ground of rejection”.

2. In bracket 2, insert the old art that is being applied as the sole basis of the SNQ. For example, “the patent to Schor” or “the patent to Schor when taken with the Jones publication” or “the combination of the patent to Schor and the Smith publication” could be inserted. Where more than one SNQ is presented based solely on old art, the examiner would insert all such bases for SNQ.

3. In bracket 3, for each basis identified in bracket 2, explain how and why that fact situation applies in the proceeding being acted on. The explanation could be for example that the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. See *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

4. This form paragraph is only used the first time the “already cited/considered” art is applied, and is not repeated for the same art in subsequent Office actions.

See MPEP § 2258.01 for a discussion of the use of “old art” in the examination stage of an ordered reexamination (as a basis for rejecting patent claims).

**B. *Prior Adverse Decisions by the Office on the Same or Substantially Identical Prior Art in the Same Patent.***

A prior decision adverse to the patentability of a claim of a patent by the Office based upon prior art patents or printed publications would usually mean that “a substantially new question of patentability” is present. Such an adverse decision by the Office could arise from a reissue application which was abandoned after rejection of the claim and without disclaiming the patent claim.

**C. *Prior Adverse Reissue Application Final Decision by the Director of the Office or the Board of Patent Appeals and Interferences Based Upon Grounds Other Than Patents or Printed Publications.***

Any prior adverse final decision by the Director of the Office, or the Board of Patent Appeals and Interferences, on an application seeking to reissue the same patent on which reexamination is requested will be considered by the examiner when determining whether or not a “substantial new question of patentability” is present. \*>However, to< the extent that such prior adverse final decision was based upon grounds other than patents or printed publications, the prior adverse final decision will not be considered in determining whether or not a “substantial new question of patentability” is present.

**D. *Prior Favorable or Adverse Decisions on the Same or Substantially Identical Prior Art Patents or Printed Publications in Other Cases not Involving the Patent.***

While the Office would consider decisions involving substantially identical patents or printed publications in determining whether a “substantial new question of patentability” is raised, the weight to be given such decisions will depend upon the circumstances.

\*>

**III. < POLICY WHERE A FEDERAL COURT DECISION HAS BEEN ISSUED ON THE PATENT**

As to A - C which follow, see *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).

### A. *Final Holding of Validity by the Courts.*

When the initial question as to whether the prior art raises a substantial new question of patentability as to a patent claim is under consideration, the existence of a final court decision of claim *validity* in view of the same or different prior art does not necessarily mean that no new question is present, because of the different standards of proof employed by the Federal District Courts and the Office. While the Office may accord deference to factual findings made by the court, the determination of whether a substantial new question of patentability exists will be made independently of the court's decision on validity, because it is not controlling on the Office.

### B. *Non-final Holding of Invalidity or Unenforceability by the Courts.*

A *non-final* holding of claim invalidity or unenforceability will not be controlling on the question of whether a substantial new question of patentability is present.

### C. *Final Holding of Invalidity or Unenforceability by the Courts.*

A final holding of claim invalidity or unenforceability, after all appeals, is controlling on the Office. In such cases, a substantial new question of patentability would not be present as to the claims finally held invalid or unenforceable.

**Note:** Any situations requiring clarification should be brought to the attention of the Office of Patent Legal Administration.

## 2643 Claims Considered in Deciding Request [R-7]

The claims >of the patent< in effect at the time of the determination will be the basis for deciding whether “a substantial new question of patentability” is present. 37 CFR 1.923. The Office's determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the claim(s) for which reexamination was requested. If the requester was interested in having all of the claims reexamined, requester had the opportunity to include them in its request for reexamination. However, if the requester chose not to do so, those claim(s) for which reexami-

nation was not requested will generally not be reexamined by the Office. It is further noted that 35 U.S.C. 311(b)(2) requires that a requester “set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.” If requester fails to apply the art to certain claims, requester is not statutorily entitled to reexamination of such claims. If a request fails to set forth the pertinency and manner of applying the cited art to any claim for which reexamination is requested as required by 37 CFR 1.915(b), that claim will generally not be reexamined. The decision to reexamine any claim for which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts and situation of each individual case. If the Office chooses to reexamine any claim for which reexamination has not been requested, it is permitted to do so, since the Office may always initiate a reexamination on its own initiative of the non-requested claim (35 U.S.C. 303(a)). Thus, while the examiner will ordinarily concentrate on those claims for which reexamination is requested, the finding of “a substantial new question of patentability” can be based upon a claim of the patent other than the ones for which reexamination is requested. For example, the request might seek reexamination of particular claims only (i.e., claims 1-4), but the examiner is not limited to those claims. The examiner can make a determination that “a substantial new question of patentability” is present as to other claims in the patent (i.e., claims 5-7), without necessarily finding “a substantial new question” with regard to the claims requested (i.e., claims 1-4).

The decision on the request for reexamination should discuss all of the patent claims requested for reexamination. The examiner should limit the discussion of those claims in the order for reexamination as to whether a substantial new question of patentability has been raised.

See MPEP § 2642 for a discussion of patent claims which have been the subject of a prior decision.

Amendments and/or new claims present in any copending reexamination or reissue proceeding for the patent to be reexamined will \*>not< (see MPEP § 2640, subsection II.(A)) \* be considered nor commented upon when deciding a request for reexamination. Where a request for reexamination is granted and reexamination is ordered, the first Office action

(which ordinarily accompanies the order) and any subsequent reexamination prosecution should be on the basis of the claims as amended by any copending reexamination or reissue proceeding.

## 2644 Prior Art on Which the Determination Is Based [Added R-2]

The determination of whether or not “a substantial new question of patentability” is present can be based upon any prior art patents or printed publications. 35 U.S.C. 312(a) provides that the determination on a request will be made “with or without consideration of other patents or printed publications,” i.e., other than those relied upon in the request. The examiner is not limited in making the determination based on the patents and printed publications relied upon in the request. The examiner can find “a substantial new question of patentability” based upon the prior art patents or printed publications relied upon in the request, a combination of the prior art relied upon in the request and other prior art found elsewhere, or based entirely on different patents or printed publications. The primary source of patents and printed publications used in making the determination are those relied on in the request. For reexamination ordered on or after November 2, 2002, see MPEP § 2642, subsection II.A. for a discussion of “old art.” The examiner can also consider any patents and printed publications of record in the patent file from submissions under 37 CFR 1.501 which are in compliance with 37 CFR 1.98 in making the determination. If the examiner believes that additional prior art patents and publications can be readily obtained by searching to supply any deficiencies in the prior art cited in the request, the examiner can perform such an additional search. Such a search should be limited to that area most likely to contain the deficiency of the prior art previously considered and should be made only where there is a reasonable likelihood that prior art can be found to supply any deficiency necessary to “a substantial new question of patentability.”

The determination should be made on the claims in effect at the time the determination is made. 37 CFR 1.923.

## 2646 Decision Ordering Reexamination [R-7]

35 U.S.C. 313. *Inter partes reexamination order by Director*

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.

37 CFR 1.931. *Order for inter partes reexamination*

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

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

If a request for reexamination is granted, the examiner’s decision granting the request will conclude that a substantial new question of patentability has been raised by (A) identifying all claims and issues, (B) identifying the patents and/or printed publications relied upon, and (C) providing a brief statement of the rationale supporting each new question.

In the examiner’s decision, the examiner must identify at least one substantial new question of patentability and explain how the prior art patents and/or printed publications raise that question. In a simple case, this may entail adoption of the reasons provided by the third party requester. The references relied on by the examiner should be cited on a PTO-892 form, unless already listed on a form PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having a format equivalent to one of these forms) submitted by the third party requester. A copy of the reference should be supplied only where it has not been previously supplied to the patent owner and third party requester.

As to each substantial new question of patentability identified in the decision, the decision should point out:

- (A) The prior art patents and printed publications which add some new teaching as to at least one claim;
- (B) What that new teaching is;
- (C) The claims that the new teaching is directed to;

(D) That the new teaching was not previously considered nor addressed in the prior examination of the patent or a final holding of invalidity by the Federal Courts;

(E) That the new teaching is such that a reasonable examiner would consider the new teaching to be important in deciding to allow the claim being considered; and

(F) Where the question is raised, or where it is not clear that a patent or printed publication pre-dates the patent claims, a discussion should be provided as to why the patent or printed publication is deemed to be available against the patent claims.

If arguments are raised by the third party requester as to grounds not based on patents or printed publications, such as those based on public use or on sale under 35 U.S.C. 102(b), or abandonment under 35 U.S.C. 102(c), the examiner should note that such grounds are improper for reexamination and are not considered or commented upon. See 37 CFR 1.906(c).

In the decision on the request, the examiner will not decide, and no statement should be made as to, whether the claims are rejected over the patents and printed publications. The examiner does not decide on the question of patentability of the claims in the decision on the request. The examiner only decides whether there is a substantial new question of patentability to grant the request to order reexamination.

The decision granting the request is made using form PTOL-2063 as a cover sheet. See MPEP § 2647.01 for an example of a decision granting a request for *inter partes* reexamination.

Form Paragraph 26.01 should be used at the beginning of each decision letter granting reexamination.

¶ 26.01 *New Question of Patentability*

A substantial new question of patentability affecting claim [1] of United States Patent Number [2] is raised by the present request for *inter partes* reexamination.

Extensions of time under 37 CFR 1.136(a) will not be permitted in *inter partes* reexamination proceedings because the provisions of 37 CFR 1.136 apply only to “an applicant” and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings “will be conducted with special dispatch” (37 CFR 1.937). Patent owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner’s response is set by statute. 35 U.S.C. 314(b)(3).

Form paragraph 26.73 should be used at the end of each decision letter granting reexamination that is not being mailed concurrently with the first Office action on patentability (see MPEP § 2660).

¶ 26.73 *Correspondence and Inquiry as to Office Actions*

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

## I. PANEL REVIEW CONFERENCE

After an examiner has determined that the reexamination proceeding is ready for granting reexamination, the examiner will formulate a draft preliminary order granting reexamination. The examiner will then inform his/her **>Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE)<** of his/her intent to issue an order granting reexamination. The **>CRU SPE<** will convene a panel review conference, and the conference members will review the matter. See MPEP § 2671.03 for the make-up of the panel. If the conference confirms the examiner’s preliminary decision to grant reexamination, the proposed order granting reexamination shall be issued and signed by the examiner, with the two other conferees initialing the action (as “conferee”) to indicate their presence in the conference. If the conference does not confirm the examiner’s preliminary decision, the examiner will reevaluate and issue an appropriate communication.

## II. PETITION TO VACATE THE ORDER GRANTING REEXAMINATION

A substantive determination by the Director of the Office to institute reexamination pursuant to a finding

that the prior art patents or printed publications raise a substantial new question of patentability is not subject to review by petition or otherwise. See *Joy Mfg. Co. v. Nat'l Mine Serv. Co., Inc.*, 810 F.2d 1127, 1 USPQ2d 1627 (Fed. Cir. 1987); *Heinl v. Godici*, 143 F.Supp. 2d 593 (E.D. Va. 2001). Note further the decision of *Patlex Corp. v. Quigg*, 680 F.Supp. 33, 6 USPQ2d 1296, 1298 (D.D.C. 1988) (the legislative scheme leaves the Director's 35 U.S.C. 303 determination entirely to his discretion and not subject to judicial review). These decisions were rendered for *ex parte* reexamination; however, the holdings of these decisions apply equally in *inter partes* reexamination proceedings, since the language of 35 U.S.C. 302(c) (i.e., the *ex parte* reexamination statute) is also found in 35 U.S.C. 312(c) (i.e., the *inter partes* reexamination statute). Because the substantive determination is not subject to review by petition or otherwise, neither the patent owner nor the third party requester has a right to petition, or request reconsideration of, a finding that the prior art patents or printed publications raise a substantial new question. There is no right to petition such a finding even if the finding of a substantial new question is based on reasons other than those urged by the third party requester (or based on less than all the grounds urged by the third party requester). Where the examiner determines that a date of a reference is early enough such that the reference constitutes prior art, that determination is not petitionable (with respect to vacating the examiner's finding of a substantial new question). Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not petitionable. These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can be argued by the patent owner and appealed during the examination phase of the reexamination proceeding.

A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

"Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

(A) the reexamination order is not based on prior art patents or printed publications;

(B) reexamination is prohibited under 37 CFR 1.907;

(C) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;

(D) reexamination was ordered for the wrong patent;

(E) reexamination was ordered based on a duplicate copy of the request; or

(F) the reexamination order was based **wholly** on the same question of patentability raised by the prior art *previously considered* in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding).

As to (F), the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted. See the discussion in MPEP § 2642, subsection II.A. as to the criteria for vacating a reexamination order in view of the decision.

When a petition under 37 CFR 1.181 is filed to vacate a reexamination order, the third party requester may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 314(c), any such opposition by the third party requester must be filed within two weeks of the date upon which a copy of the original 37 CFR 1.181 petition was served on the third party requester to ensure consideration. It is advisable that, upon receipt and review of the served copy of such a 37 CFR 1.181 petition which the third party requester intends to oppose, the requester should immediately place a courtesy telephone call to the \*\*>CRU SPE< to notify the Office that an opposition to the 37 CFR 1.181 petition will be filed. Whenever possible, filing of the opposition should be submitted by facsimile transmission.

The filing of a 37 CFR 1.181 petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester.

### III. PRIOR ART SUBMITTED AFTER THE ORDER

Any prior art citations under 37 CFR 1.501 submitted after the date of the decision ordering *inter partes* reexamination should be retained in a separate file by the Technology Center (TC) (usually the TC Quality Assurance Specialist (QAS)) and stored until the reexamination proceeding is concluded, at which time the prior art citation is then entered of record in the patent file. See MPEP § 2206. Note that 37 CFR 1.902 governs submissions of prior art that can be made by *patent owners* and *third party requesters* after reexamination has been ordered.

#### 2647 Decision Denying Reexamination [R-7]

The request for reexamination will be denied if a substantial new question of patentability is not found based on patents or printed publications.

If the examiner concludes that no substantial new question of patentability has been raised, the examiner should prepare a decision denying the reexamination request. Form paragraph 26.02 should be used as the introductory paragraph in a decision denying reexamination.

##### ¶ 26.02 No New Question of Patentability

No substantial new question of patentability is raised by the present request for *inter partes* reexamination and the prior art cited therein for the reasons set forth below.

The decision denying the request will then indicate, for each patent or publication cited in the request, why the citation:

(A) Is cumulative to the teachings of the art cited in the earlier concluded examination of the patent;

(B) Is not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);

(C) Would not be important to a reasonable examiner. Even if the citation is available against the claims and it is not cumulative, it still cannot be the basis for a substantial new question of patentability if the additional teaching of the citation would not be important to a reasonable examiner in deciding whether any claim (of the patent for which reexamination is requested) is patentable; or

(D) Is one which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2642, subsection II.A.

The examiner should also, in the decision, respond to the substance of each argument raised by the third party requester which is based on patents or printed publications.

If arguments are presented as to grounds not based on prior art patents or printed publications, such as those based on public use or on sale under 35 U.S.C. 102(b), or abandonment under 35 U.S.C. 102(c), the examiner should note that such grounds are improper for reexamination and are not considered or commented upon. See 37 CFR 1.906(c).

See MPEP § 2647.01 for an example of a decision denying a request for *inter partes* reexamination.

The decision denying the request is mailed by the Central Reexamination Unit (CRU), and jurisdiction over the reexamination proceeding is retained by the CRU to await any petition seeking review of the examiner's determination refusing reexamination. If such a petition is not filed within one (1) month of the examiner's determination denying reexamination, the CRU then processes the reexamination file to provide the partial refund set forth in 37 CFR 1.26(c) (the Office of Finance no longer processes reexamination proceedings for a refund).

The reexamination proceeding is then given a 420 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen is printed, the printed copy is annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy is then scanned into IFW using the miscellaneous letter document code.

The concluded reexamination file (electronic or paper) containing the request and the decision denying the request becomes part of the patent's record.

#### PANEL REVIEW CONFERENCE

After an examiner has determined that the reexamination proceeding is ready for denying reexamination, the examiner will formulate a draft preliminary order denying reexamination. The examiner will then inform his/her CRU Supervisory Patent Examiner (SPE) of his/her intent to issue an order denying reexamination. The CRU SPE will convene a panel review conference, and the conference members will review the matter. See MPEP § 2671.03 for the



make-up of the panel. If the conference confirms the examiner's preliminary decision to deny reexamination, the proposed order denying reexamination shall be issued and signed by the examiner, with the two other conferees initialing the action (as "conferee") to indicate their presence in the conference. If the conference does not confirm the examiner's preliminary decision, the examiner will reevaluate and issue an appropriate communication.

### **2647.01 Examples of Decisions on Requests [R-7]**

Examples of decisions on requests for *inter partes* reexamination are provided below. The first example is a **grant** of an *inter partes* reexamination. The second example is a **denial** of an *inter partes* reexamination. The examiner should leave the paper number blank, since IFW files do not have a paper number.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
 UNITED STATES PATENT AND TRADEMARK OFFICE  
 P. O. Box 1450  
 ALEXANDRIA, VA 22313-1450  
 www.uspto.gov

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/999,999	09/09/09	9,999,999	999

John Able  
 2400 Any Street Road  
 Anytown, VA 22202

EXAMINER

Kenneth M. Schor

ART UNIT PAPER

3725

DATE MAILED:

### ORDER GRANTING/DENYING REQUEST FOR INTER PARTES REEXAMINATION

The request for *inter partes* reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s):  PTO-892  PTO-1449  Other: \_\_\_\_\_

1.  The request for *inter partes* reexamination is GRANTED.

An Office action is attached with this order.

An Office action will follow in due course.

2.  The request for *inter partes* reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 312(c). Requester may seek review of a denial by petition to the Director of the USPTO within ONE MONTH from the mailing date hereof. 37 CFR 1.927. EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183. In due course, a refund under 37 CFR 1.26(c) will be made to requester.

**All correspondence** relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Order.

PTOL-2063 (5/03)

DECISION GRANTING INTER PARTES REEXAMINATION

A substantial new question of patentability affecting claims 1-3 of United States Patent Number 9,999,999 to Key is raised by the present request for *inter partes* reexamination.

Extensions of time under 37 CFR 1.136(a) will not be permitted in *inter partes* reexamination proceedings because the provisions of 37 CFR 1.136 apply only to “an applicant” and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings “will be conducted with special dispatch” (37 CFR 1.937). Patent owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner’s response is set by statute. 35 U.S.C. 314(b)(3).

The patent owner is reminded of the continuing responsibility under 37 CFR 1.985(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent 9,999,999 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP § 2686 and 2686.04.

The request \*>sets forth< that the third party requester considers claims 1-3 of the Key patent to be unpatentable over Smith taken with Jones.

The request further \*>sets forth< that the requester considers claim 4 of the Key patent to be unpatentable over the Horn publication.

It is agreed that the consideration of Smith raises a substantial new question of patentability as to claims 1-3 of the Key patent. As pointed out on pages 2-3 of the request, Smith teaches using an extruder supported on springs at a 30 degree angle to the horizontal but does not teach the specific polymer of claims 1-3 which is extruded. The teaching as to spring-supporting the extruder at 30 degrees was not present in the prosecution of the application which became the Key patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claim is patentable. Accordingly, Smith raises a substantial new question of patentability as to claims 1-3, which question has not been decided in a previous examination of the Key patent.

The Horn publication does not raise a new question of patentability as to claim 4 because its teaching as to the extrusion die is a substantial equivalent of the teaching of the die by the Dorn patent which was considered in the prosecution of the application which became the Key patent. Further, the request does not present any other new question of patentability as to claim 4, and none has been found. \*\*>Accordingly, claim 4 will not be reexamined.

Finally, reexamination has not been requested for claims 5 – 20 of the Key patent. Accordingly, claims 5 – 20 will not be reexamined.

Claims 1 – 3 of the Key patent will be reexamined.<

All correspondence relating to this \*\*>*inter partes*< reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam  
\*\*  
Attn: Central Reexamination Unit  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand (or  
delivery  
service): Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

**Kenneth M. Schor**  
Kenneth M. Schor  
Primary Examiner  
>CRU< Art Unit \*>3998<

**ARI**  
Conferee

**BZ**  
Conferee



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
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 ALEXANDRIA, VA 22313-1450  
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/999,999	09/09/09	9,999,999	999

John Able  
 2400 Any Street Road  
 Anytown, VA 22202

EXAMINER	
Kenneth M. Schor	
ART UNIT	PAPER
3725	

DATE MAILED:

**ORDER GRANTING/DENYING REQUEST FOR  
 INTER PARTES REEXAMINATION**

The request for *inter partes* reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s):     PTO-892         PTO-1449         Other: \_\_\_\_\_

1.  The request for *inter partes* reexamination is GRANTED.
  - An Office action is attached with this order.
  - An Office action will follow in due course.

2.  The request for *inter partes* reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 312(c). Requester may seek review of a denial by petition to the Director of the USPTO within ONE MONTH from the mailing date hereof. 37 CFR 1.927. EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183. In due course, a refund under 37 CFR 1.26(c) will be made to requester.

**All correspondence** relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Order.

PTOL-2063 (5/03)

DECISION DENYING *INTER PARTES* REEXAMINATION

No substantial new question of patentability is raised by the present request for *inter partes* reexamination for the reasons set forth below

The request indicates that Requester considers that a substantial new question of patentability is raised as to claims 1-2 of the Key patent (Patent # 9,999,999) based on Smith taken with Jones.

The request further indicates that Requester considers that a substantial new question of patentability is raised as to claim 3 of the Key patent based on Smith taken with Jones and when further taken with the Horn publication.

The claims of the Key patent, for which reexamination is requested, require that an extruder be supported on springs at an angle of 30 degrees to the horizontal, while a specific chlorinated polymer is extruded through a specific extrusion die.

The Smith patent does not raise a substantial new question of patentability as to the Key claims. Smith's teaching as to the extruder being spring-supported at 30 degrees is a substantial equivalent of the teaching of same by the Dorn patent which was considered in the prosecution of the application which became the Key patent.

In the request for reexamination, it is argued that Jones teaches the extrusion die. However, Jones was previously used, in the prosecution of the Key application, to teach the extrusion die. Further, there is no argument in the reexamination request that Jones is being applied in a manner different than it was applied in the prosecution of the Key application.

The Horn publication has been argued to show the connection of the support means to the extruder via bolts, as recited in claim 3 of the Key patent. Although this teaching was not provided in the prosecution of the Key application, the teaching would not be considered to be important to a reasonable examiner in deciding whether or not the Key claims are patentable.

The Horn publication has been argued to show the connection of the support means to the extruder via bolts, as recited in claim 3 of the Key patent. Although this teaching was not provided in the prosecution of the Key application, the teaching would not be considered to be important to a reasonable examiner in deciding whether or not the Key claims are patentable.

The references set forth in the request have been considered both alone and in combination. They fail to raise a substantial new question of patentability as to any one of the Key patent claims.

In view of the above, the request for reexamination is DENIED.

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to:     Mail Stop *Inter Partes* Reexam  
                  \*\*  
                  Attn: Central Reexamination Unit  
                  United States Patent & Trademark Office  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

OPTIONAL INTER PARTES REEXAMINATION

2647.01

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand (or Customer Service Window  
delivery Randolph Building  
service): 401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

**Kenneth M. Schor**  
Kenneth M. Schor  
Primary Examiner  
>CRU< Art Unit \*>3998<

**ARI**  
Conferee

**BZ**  
Conferee

## 2647.02 Processing of Decision [R-7]

After the examiner has prepared the decision (and any Office action to accompany the decision) and signed the typed decision, the case is forwarded to the Central Reexamination Unit (CRU) clerical staff. The clerical staff prepares the decision (and any Office action) for mailing, but does not mail it. See MPEP § 2670.

The clerical staff will make a copy of the decision and any Office action for the patent owner and for the third party requester. The clerical staff will also make any copies of references which are needed. Thus, the clerical staff makes 2 copies of any prior art documents not already supplied by the third party requester, one for the patent owner, and one for the third party requester.

After the case is prepared for mailing, the file will be forwarded to the \*\*>CRU Supervisory Patent Examiner (SPE)< for review. The file and the decision and any Office action are forwarded to the Reexamination Legal Advisor (RLA) for review within nine (9) weeks of the filing date of the request (unless otherwise authorized by the CRU Director or a RLA). The decision (and any Office action) is given a general review by a RLA and (if proper) mailed by the CRU support staff. The CRU support staff prints the heading on the cover page (PTOL-2063) of the decision by using the computer terminal, attaches all parts of the decision, and mails it. Where the first Office action accompanies the decision, the heading is also printed on the cover page (PTOL-2064) of the first Office action, and the first Office action is mailed with the decision.

A transmittal form PTOL-501 with the third party requester's address will be completed (if a copy for mailing is not already in the case file). The transmittal form PTOL-501 is used to forward copies of Office actions and other communications to the third party requester. Whenever an Office action is issued, a copy of this form will be made and attached to a copy of the Office action. The use of this form removes the need to retype the third party requester's address each time a mailing is made.

The original signed copy of the decision, the original signed copy of any first Office action accompanying the decision, and a copy of any prior art enclosed are made of record in the reexamination e-file (file history).

Where the decision is a grant of reexamination, the first Office action on the merits will ordinarily be prepared and mailed with the order granting reexamination. See MPEP § 2660.

After the CRU mails the decision, the file will be appropriately annotated, update scanning will be effected, and appropriate PALM entries will be made.

## 2648 Petition From Denial of Request [R-7]

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

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

### PROCESSING OF PETITION UNDER 37 CFR 1.927

Once a request for *inter partes* reexamination has been denied, jurisdiction over the reexamination proceeding is retained by the Central Reexamination Unit (CRU) to await any petition seeking review of the examiner's determination refusing reexamination. If no petition is filed within one (1) month, the CRU will process the reexamination as a concluded reexamination file. See MPEP § 2647 and § 2694. If a petition is timely filed, the petition (together with the reexamination file) is forwarded to the office of the CRU Director for decision. The CRU Director will then review the examiner's determination that a substantial new question of patentability has not been raised. The CRU Director's review will be *de novo*. Each decision by the CRU Director will conclude with the following paragraph:

This decision is final and nonappealable. See 35 U.S.C. 312(c) and 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

If the petition is granted, the decision of the CRU Director should include a sentence stating that an Office action will be mailed in due course.

The CRU Director will sign the decision granting the petition, and then forward the reexamination file, together with the decision, to the CRU support staff for mailing of the decision, update scanning and



PALM processing. The CRU Supervisory Patent Examiner (SPE) will ordinarily reassign the reexamination to another examiner pursuant to 37 CFR 1.931(b), notify the CRU support staff of the assignment so that the new assignment can be entered in the PALM records, and forward the file to the new examiner to prepare a first Office action.

Reassignment to another examiner will be the general rule. Only in exceptional circumstances where no other examiner is available and capable to give a proper examination, will the case remain with the examiner who denied the request.

Under normal circumstances, the reexamination proceeding will not be reassigned to a primary examiner or assistant examiner who was involved in any part of the examination of the patent for which reexamination is requested, or was so-involved in the examination of the parent of the patent. The CRU Director can make an exception to this practice and reassign the reexamination proceeding to an examiner involved with the original examination (of the patent) only where unusual circumstances are found to exist. For example, where there are no examiners other than an original examiner of the patent and the examiner who issued the denial with adequate knowledge of the relevant technology, the CRU Director may permit reassignment of the reexamination proceeding to an examiner that originally examined the patent.

The requester may seek review of a denial of a request for reexamination only by petitioning the Director of the USPTO under 37 CFR 1.927 and 1.181 within one (1) month of the mailing date of the decision denying the request for reexamination. Additionally, any request for an extension of the time period to file such a petition from the examiner's denial of a request for reexamination can only be entertained by filing a petition under 37 CFR 1.183 with the appropriate fee to waive the time provisions of 37 CFR 1.927.

After the time for petition has expired without a petition having been filed, or a petition has been filed and the decision thereon affirms the denial of the request, a partial refund of the filing fee for the request for reexamination will be made to the third party requester. 35 U.S.C. 312(c) and 37 CFR 1.26(c). A decision on a petition under 37 CFR 1.927 and 1.181 is final and is not appealable.

Except for the limited *ultra vires* exception described in MPEP § 2646, no petition may be filed requesting review of a decision **granting** a request for reexamination even if the decision grants the request as to a specific claim for reasons other than those advanced by the third party requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937.

## 2654 Conduct of *Inter Partes* Reexamination Proceedings [Added R-2]

### 35 U.S.C. 314. Conduct of *inter partes* reexamination proceedings

(a) IN GENERAL.— Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

#### (b) RESPONSE.—

(1) With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the *inter partes* reexamination proceeding.

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

(c) SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

### 37 CFR 1.937. Conduct of *inter partes* reexamination.

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

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

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

Once *inter partes* reexamination is ordered, a first Office action on the merits will be given (the first Office action will ordinarily be mailed with the order; see MPEP § 2660), and prosecution will proceed. Each time the patent owner responds to an Office action, the third party requester may comment on the Office action and the patent owner response, and thereby participate in the proceeding.

Reexamination will proceed even if the order is returned undelivered. As pointed out in MPEP § 2630, the notice under 37 CFR 1.11(c) is constructive notice to the patent owner, and lack of response from the patent owner will not delay reexamination.

The examination will be conducted in accordance with 37 CFR 1.104, 1.105, 1.110-1.113, 1.115, and 1.116 (35 U.S.C. 132 and 133) and will result in the issuance of a reexamination certificate under 37 CFR 1.997. The proceeding shall be conducted with special dispatch within the Office pursuant to 35 U.S.C. 314(c). The patent owner and the third party requester will be sent copies of all Office actions. Also, the patent owner and the third party requester must serve copies of all their submissions to the Office on each other. Citations of art submitted in the patent file prior to issuance of an order for reexamination will be considered by the examiner during the reexamination.

## 2655 Who Reexamines [R-5]

The examination will ordinarily be conducted by the same patent examiner \*\* who made the decision on whether the reexamination request should be granted. See MPEP § 2636.

However, if a petition under 37 CFR 1.927 is granted, the reexamination will normally be conducted by another examiner. See MPEP § 2648.

## 2656 Prior Art Patents and Printed Publications Reviewed by Examiner in Reexamination [R-7]

Typically, the primary source of prior art will be the patents and printed publications cited in the request for *inter partes* reexamination.

Subject to the discussion provided below in this section, the examiner must also consider patents and printed publications:

(A) cited by another reexamination requester under 37 CFR 1.510 or 37 CFR 1.915;

(B) cited by the patent owner under a duty of disclosure (37 CFR 1.933) in compliance with 37 CFR 1.98;

(C) discovered by the examiner in searching;

(D) of record in the patent file from earlier examination;

(E) of record in the patent file from any 37 CFR 1.501 submission prior to date of an order if it complies with 37 CFR 1.98; and

(F) cited by the third party requester under appropriate circumstances pursuant to 37 CFR 1.948.

\*\* Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information. The initials of the examiner placed adjacent to the citations on the form PTO/SB/08A and 08B or its equivalent, without an indication to the contrary in the record, do not signify that the information has been considered by the examiner any further than to the extent noted above.

As to (D) above, it is pointed out that \*\* the degree of consideration of information from the patent file and its parent files is dependent on the availability of the information. Thus, for example, \*>as to< a reference other than a U.S. \*>patent< and U.S. patent publication \*\*>that is< not scanned into the Image File Wrapper (IFW) \*\* what was said about \*>that< reference in the patent's record is the full extent of consideration, unless otherwise indicated>, or unless parties appropriately supply a copy< .

As to \*\*>(B) and (E) above, 37 CFR 1.98(a)(2) requires a legible copy of:

- (1) each foreign patent;
- (2) each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
- (3) for each cited pending unpublished U.S. application, the application specification including the

claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion;

(4) all other information or that portion which caused it to be listed.

It is not required nor is it permitted that parties submit copies of copending reexamination proceedings and applications (which copies can be mistaken for a new request/filing); rather, submitters may provide the application/proceeding number and its status. A submission that is not permitted entry will be returned, expunged, or discarded at the sole discretion of the Office.<

The exception to the requirement for reference copies noted in 37 CFR 1.98(d)(1) does not apply to reexamination proceedings since a reexamination proceeding does not receive 35 U.S.C. 120 benefit from the patent.

#### **AFTER THE NOTICE OF INTENT TO ISSUE INTER PARTES REEXAMINATION CERTIFICATE (NIRC):**

Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate **>printing cycle** (452 status)<, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The **>printing cycle**< for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the **>printing**< cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its **>printing**< cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its **>printing**< cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed **>(see item (A) above)<** factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the **>printing cycle**< for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph.

#### **2657 Listing of Prior Art [R-7]**

**\*\***

**>**The reexamination request must provide a listing of the patents and printed publications (discussed in the request) as provided for in 37 CFR 1.98. See MPEP § 2614.< The examiner must **\*** list on a form PTO-892, if not already listed on a form PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having a format equivalent to one of these forms), all prior art patents or printed publications which have been cited in the decision on the request, applied in making rejections or cited as being pertinent during the reexamina-

tion proceedings. Such prior art patents or printed publications may have come to the examiner's attention because they were:

(A) of record in the patent file due to a prior art submission under 37 CFR 1.501 which was received prior to the date of the order;

(B) of record in the patent file as result of earlier examination proceedings as to the patent;

(C) discovered by the examiner during a prior art search; or

(D) submitted pursuant to 37 CFR 1.948.

All citations listed on form PTO-892, and all citations not lined-through on any form PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having a format equivalent to one of these forms), will be printed on the reexamination certificate under "References cited."

## 2658 Scope of *Inter Partes* Reexamination [R-7]

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

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

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

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

*Inter partes* reexamination differs from *ex parte* reexamination in matters of procedure, such as when the third party requester can participate, the types of Office actions and the timing of issuance of the Office actions, and the requirement for identification of the real party in interest. *Inter partes* reexamination also differs from *ex parte* reexamination in the estoppel effect it provides as to the third party requesters and when the initiation of a reexamination is prohibited.

*Inter partes* reexamination **does not**, however, differ from *ex parte* reexamination as to the substance to be considered in the proceeding.

## I. PRIOR ART PATENTS OR PRINTED PUBLICATIONS, AND DOUBLE PATENTING

Rejections on art in reexamination proceedings may only be made on the basis of prior art patents or printed publications, or double patenting. See MPEP § 2258 and § 2258.01 for a discussion of art rejections in reexamination proceedings based on prior art patents or printed publications. The discussion there includes making double patenting rejections and the use of admissions.

It is to be noted that the decisions cited in MPEP §§ 2258 and 2258.01 for determining the presence or absence of "a substantial new question of patentability" in *ex parte* reexamination proceedings apply equally in *inter partes* reexamination proceedings, since the statutory language relied upon in those decisions, which is taken from the *ex parte* reexamination statute, is also found in the *inter partes* reexamination statute.

## II. COMPLIANCE WITH 35 U.S.C. 112

Where new or amended claims are presented or where any part of the disclosure is amended, the claims of the reexamination proceeding are to be examined for compliance with 35 U.S.C. 112. See MPEP § 2258 for a discussion of the examination in a reexamination proceeding based upon 35 U.S.C. 112, which discussion applies to *inter partes* reexamination in the same way it applies to *ex parte* reexamination.

## III. CLAIMS IN PROCEEDING MUST NOT ENLARGE SCOPE OF THE CLAIMS OF THE PATENT

Where new claims are presented, or where any part of the disclosure is amended, the claims of the *inter partes* reexamination proceeding should be examined under 35 U.S.C. 314, to determine whether they enlarge the scope of the original claims. 35 U.S.C. 314(a) states that "no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted" in an *inter partes* reexamination proceeding.

### A. *Criteria for Enlargement of the Scope of the Claims*

A claim presented in a reexamination proceeding **enlarges the scope** of the claims of the patent being reexamined where the claim is broader than each and every claim of the patent. See MPEP § 1412.03 for guidance as to when the presented claim is considered to be a broadening claim as compared with the claims of the patent, i.e., what is broadening and what is not. If a claim is considered to be a broadening claim for purposes of reissue, it is likewise considered to be a broadening claim in reexamination.

### B. *Amendment of the Specification*

Where the specification is amended in a reexamination proceeding, the examiner should make certain that the amendment to the specification does not enlarge the scope of the claims of the patent. An amendment to the specification can enlarge the scope of the claims by redefining the scope of the terms in a claim, even where the claims are not amended in any respect.

### C. *Rejection of Claims Where There Is Enlargement*

Any claim which enlarges the scope of the claims of the patent should be rejected under 35 U.S.C. 314(a). Form paragraph 26.03.01 is to be employed in making the rejection.

#### ¶ 26.03.01 *Rejection, 35 U.S.C. 314(a), Claim Enlarges Scope of Patent*

Claim [1] rejected under 35 U.S.C. 314(a) as enlarging the scope of the claims of the patent being reexamined. 35 U.S.C. 314(a) states that “no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted” in an *inter partes* reexamination proceeding. A claim presented in a reexamination “enlarges the scope” of the patent claims where the claim is broader than the claims of the patent. A claim is broadened if it is broader in any one respect, even though it may be narrower in other respects. [2].

#### **Examiner Note:**

The claim limitations which are considered to broaden the scope should be identified and explained in bracket 2. See MPEP § 2658.

## IV. OTHER MATTERS

### A. *Patent Under Reexamination Subject of a Prior Office or Court Decision*

Where some of the patent claims in a patent being reexamined have been the subject of a prior Office or court decision, see MPEP § 2642. Where other proceedings involving the patent are copending with the reexamination proceeding, see MPEP § 2686 - § 2686.04.

Patent claims not subject to reexamination because of their prior adjudication by a court should be identified. See MPEP § 2642. For handling a “live” claim dependent on a patent claim not subject to reexamination, see MPEP § 2660.03. All added claims will be examined.

Where grounds set forth in a prior Office or Federal Court decision, are not based on patents or printed publications, yet clearly raise questions as to the claims, the examiner’s Office action should clearly state that the claims have not been examined as to those grounds not based on patents or printed publications nor applicable portions of 35 U.S.C. 112 stated in the prior decision. See 37 CFR 1.906(c). See *In re Knight*, 217 USPQ 294 (Comm’r Pat. 1982).

### B. *“Live” Claims That Are Reexamined During Reexamination*

The Office’s determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the “live” claims (i.e., existing claims not held invalid by a final decision, after all appeals) for which reexamination has been requested. If the requester was interested in having all of the claims reexamined, requester had the opportunity to include them in its request for reexamination. However, if the requester chose not to do so, those claim(s) for which reexamination was not requested will generally not be reexamined by the Office. It is further noted that 35 U.S.C. 311(b)(2) requires that a requester “set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.” If the requester fails to apply the art to certain claims, then the requester is not statutorily entitled to reexamination of such claims. If a request fails to set forth the pertinency and manner of applying the cited art to any claim for which reexamination is requested as

required by 37 CFR 1.915(b), that claim will generally not be reexamined.

The decision to reexamine any claim for which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts and situation of each individual case. If the Office chooses to reexamine any claim for which reexamination has not been requested, it is permitted to do so. In addition, the Office may always initiate a reexamination on its own initiative of the non-requested claim (35 U.S.C. 303(a)). Similarly, if prior art patents or printed publications are discovered during reexamination which raise a substantial new question of patentability as to one or more patent claims for which reexamination has not been ordered (while reexamination has been ordered for other claims in the patent), and these documents in turn raise a compelling rejection of such claims, then such claims may be added, within the sole discretion of the Office, during the examination phase of the proceeding.

#### **C. Restriction Not Proper in Reexamination**

Restriction requirements cannot be made in a reexamination proceeding since no statutory basis exists for restriction in a reexamination proceeding. Note also that the addition of claims to a “separate and distinct” invention to the patent would be considered as being an enlargement of the scope of the patent claims. See *Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989). See MPEP § 1412.03.

#### **D. Ancillary Matters**

There are matters ancillary to reexamination which are necessary and incident to patentability which will be considered. Amendments may be made to the specification to correct, for example, an inadvertent failure to claim foreign priority or the continuing status of the patent relative to a parent application if such correction is necessary to overcome a reference applied against a claim of the patent.

#### **E. Claiming Foreign and Domestic Priority in Reexamination**

The patent owner may obtain the right of foreign priority under 35 U.S.C. 119 (a)-(d) where a claim for priority had been made before the patent was granted, and it is only necessary for submission of the certified

copy in the reexamination proceeding to perfect priority. Likewise, patent owner may obtain the right of foreign priority under 35 U.S.C. 119 (a)-(d) where it is necessary to submit for the first time both the claim for priority and the certified copy. However, where it is necessary to submit for the first time both the claim for priority and the certified copy, and the patent to be reexamined matured from **a utility or plant application filed on or after November 29, 2000**, then the patent owner will have to also file a grantable petition for an unintentionally delayed priority claim under 37 CFR 1.55(c). See MPEP § 201.14(a).

Also, patent owner may correct the failure to adequately claim (in the application for the patent to be reexamined) benefit under 35 U.S.C. 120 of an earlier filed copending U.S. patent application. For a patent to be reexamined which matured from a utility or plant applications filed on or after November 29, 2000, the patent owner will have to file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3). See MPEP § 201.11.

For a patent to be reexamined which matured from a utility or plant application filed **before** November 29, 2000, the patent owner can correct via reexamination the failure to adequately claim benefit under 35 U.S.C. 119(e) of an earlier filed provisional application. Under no circumstances can a reexamination proceeding be employed to correct or add a benefit claim under 35 U.S.C. 119(e) for a patent matured from a utility or plant application filed on or after November 29, 2000.

No renewal of previously made claims for foreign priority under 35 U.S.C. 119 or domestic benefit under 35 U.S.C. 119(e) or 120, is necessary during reexamination.

#### **F. Correction of Inventorship**

Correction of inventorship may also be made during reexamination. See 37 CFR 1.324 and MPEP § 1481 for petition for correction of inventorship in a patent. If a petition filed under 37 CFR 1.324 is granted, a Certificate of Correction indicating the change of inventorship will not be issued, because the reexamination certificate that will ultimately issue will contain the appropriate change-of-inventorship information (i.e., the Certificate of Correction is in effect merged with the reexamination certificate).

### G *Affidavits in Reexamination*

Affidavits under 37 CFR 1.131 and 1.132 may be utilized in a reexamination proceeding. Note, however, that an affidavit under 37 CFR 1.131 may not be used to “swear back” of a reference patent if the reference patent is claiming the same invention as the patent undergoing reexamination. In such a situation, the patent owner may, if appropriate, seek to raise this issue via an affidavit under 37 CFR 1.130 (see MPEP § 718) or in an interference proceeding via an appropriate reissue application if such a reissue application may be filed (see MPEP § 1449.02).

### H. *Issues Not Considered in Reexamination*

If questions other than those indicated above (for example, questions of patentability based on public use or on sale, \*conduct issues, abandonment under 35 U.S.C. 102(c), etc.) are raised by the third party requester or the patent owner 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. Such questions could arise in a reexamination requester’s 37 CFR 1.915 request or in 37 CFR 1.947 comments by the third party requester.

Note form paragraph 26.03.

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#### ¶ 26.03 *Issue Not Within Scope of Inter Partes Reexamination*

It is noted that an issue not within the scope of reexamination proceedings has been raised. [1].The issue will not be considered in a reexamination proceeding. 37 CFR 1.906(c). While this issue is not within the scope of reexamination, the patentee is advised that it may be desirable to consider filing a reissue application provided that the patentee believes one or more claims to be partially or wholly inoperative or invalid.

#### **Examiner Note:**

1. In bracket 1, identify the issues.
2. This paragraph may be used either when the patent owner or the third party requester raises issues such as (but not limited to) public use or on sale, conduct, or abandonment of the invention. Such issues should not be raised independently by the patent examiner.

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If questions of patentability based on public use or on sale, \*conduct issues, abandonment under 35 U.S.C. 102(c), etc. are independently discovered by the examiner during a reexamination proceeding but were not raised by the third party requester or the patent owner, the existence of such questions will not be noted by the examiner in an Office action, because 37 CFR 1.906(c) is only directed to such questions “raised by the patent owner or the third party requester.”

### I. *Request for Reexamination Filed on Patent after it Has Been Reissued*

Where a request for reexamination is filed on a patent after it has been reissued, reexamination will be denied because the patent on which the request for reexamination is based has been surrendered. Should reexamination of the reissued patent be desired, a new request for reexamination including, and based on, the specification and claims of the reissue patent must be filed.

Any amendment made by the patent owner in the prosecution of the reexamination proceeding, should treat the changes made by the granted reissue patent as the text of the patent, and all bracketing and underlining made with respect to the patent as changed by the reissue.

Where the reissue patent issues after the filing of a request for reexamination, see MPEP § 2686.03.

### 2659 *Res Judicata and Collateral Estoppel in Reexamination Proceedings [Added R-2]*

MPEP § 2642 and § 2686.04 relate to the Office policy controlling the determination on a request for reexamination and the subsequent examination phase of the reexamination, where there has been a Federal Court decision on the merits as to the patent for which reexamination is requested.

Since claims finally held invalid by a Federal Court, after all appeals, will be withdrawn from consideration and not reexamined during a reexamination proceeding, **a rejection** on the grounds of *res judicata* will not be appropriate in reexamination. In situations, where the issue decided in Court did not invalidate claims, but applies in one or more respects to the claims being reexamined, the doctrine of collateral

estoppel may be applied in reexamination to resolve the issue. Thus, for example, where a finding that reference X meets a limitation of a claim was necessary to the final decision of the Court invalidation of claim 5, collateral estoppel would attach to the same limitation in claim 2, which was not invalidated (e.g., because claim 2 contained additional limitations not found in claim 5).

## 2660 First Office Action [R-7]

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

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

*37 CFR 1.104. Nature of examination.*

### (a) Examiner's action.

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(3) An international-type search will be made in all national applications filed on and after June 1, 1978.

(4) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee set forth in § 1.21(e). The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

(b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

### (c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(3) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section.

(4) Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. 102(e), (f) or (g) may be used as prior art under 35 U.S.C. 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same person or subject to an obligation of assignment to the same person at the time the claimed invention was made.

(i) Subject matter developed by another person and a claimed invention shall be deemed to have been commonly owned by the same person or subject to an obligation of assignment to the same person in any application and in any patent granted on or after December 10, 2004, if:

(A) The claimed invention and the subject matter was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) The claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(ii) For purposes of paragraph (c)(4)(i) of this section, the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

(iii) To overcome a rejection under 35 U.S.C. 103(a) based upon subject matter which qualifies as prior art under only one or more of 35 U.S.C. 102(e), (f) or (g) via 35 U.S.C. 103(c)(2), the applicant must provide a statement to the effect that the prior art and the claimed invention were made by or on the behalf of parties to a joint research agreement, within the meaning of 35 U.S.C. 103(c)(3) and paragraph (c)(4)(ii) of this section, that was in effect on or before the date the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement.

(5) The claims in any original application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the



same subject matter is claimed in the application and the statutory invention registration. The claims in any reissue application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the reissue application seeks to claim subject matter:

(i) Which was not covered by claims issued in the patent prior to the date of publication of the statutory invention registration; and

(ii) Which was the same subject matter waived in the statutory invention registration.

(d) *Citation of references.*

(1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees will be stated. If domestic patent application publications are cited by the examiner, their publication number, publication date, and the names of the applicants will be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees will be stated, and such other data will be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon will be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, will be given.

(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

(e) *Reasons for allowance.* If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication.

## I. PREPARATION AND MAILING OF FIRST OFFICE ACTION

The first Office action on the merits will ordinarily be mailed together with the order granting reexamination. In some instances, however, it may not be practical or possible to mail the first Office action together with the order. For example, the reexamination file may have been provided to the examiner too late to include an Office action together with the order and still meet the deadline of ten weeks from the filing date of the request for mailing the order granting the

request. Another example is where certain information or copies of prior art may not be available until after the ten week time-deadline. In these situations, the order would be prepared and mailed, and the Office action would be mailed at a later date. In addition, a first Office action is not mailed with the order where the files will be forwarded for decision on merger of a reexamination proceeding with another reexamination proceeding and/or a reissue application. Rather, an Office action would be issued after the merger decision, as a single action for the merged proceeding. See MPEP § 2686.01 and MPEP § 2686.02.

Where the order will be mailed **without** the first Office action, the order must indicate that an Office action will issue in due course. Form paragraph 26.04 should be used to inform patent owner and requester that the action was not inadvertently left out or separated from the order.

### ¶ 26.04 *First Action Not Mailed With Order*

An Office action on the merits does not accompany this order for *inter partes* reexamination. An Office action on the merits will be provided in due course.

Where the Office action cannot be mailed with the order, the Office action should, in any event, be issued within **two months** from the mailing of the order, unless the case is awaiting merger, in which case the Office action should be issued within **one month** from the mailing of the merger decision.

## II. TYPES OF FIRST ACTION ON THE MERITS

Where all of the patent claims are found patentable in the first action, the examiner will issue an Action Closing Prosecution (ACP). The ACP is discussed in MPEP § 2671.02.

Where the examiner determines that one or more of the patent claims are to be rejected, the first Office action on the merits will be similar to a first action on the merits in an application (or *ex parte* reexamination) where a rejection is made. In this situation, even though the action will follow the format of an action in an application, *inter partes* reexamination practice must be followed. Accordingly, *inter partes* reexamination forms will be used, special *inter partes* reexamination time periods will be set, *inter partes* reexamination form paragraphs will be used, and the

patent owner and the third party requester must be sent a copy of the action.

### III. FORM AND CONTENT OF FIRST OFFICE ACTION ON THE MERITS THAT IS NOT AN ACP

The examiner's first Office action will be a statement of the examiner's position, and it should be so complete that the second Office action can properly be made an Action Closing Prosecution (ACP). See MPEP § 2671.02. Accordingly, it is intended that the first Office action be the primary action to establish the issues which exist, such that the patent owner response and any third party comments can place the proceeding in condition for the issuance of an ACP.

The examiner's first action should be comprehensive and address all issues as to the prior art patents and/or printed publications. The action will clearly set forth each ground of rejection and/or ground of objection, and the reasons supporting the ground. The action will also clearly set forth each determination favorable to the patentability of claims, i.e., each rejection proposed by the third party requester that the examiner refuses to adopt. Reasons why the rejection proposed by the third party requester is not appropriate (i.e., why the claim cannot be rejected under the ground proposed by the third party requester) must be clearly stated for each rejection proposed by the third party requester that the examiner refuses to adopt. Comprehensive reasons for patentability must be given for each determination favorable to patentability of claims. See MPEP § 1302.14 for examples of suitable statements of reasons. It is to be noted that the examiner is not to refuse to adopt a rejection properly proposed by the requester as being cumulative to other rejections applied. Rather, any such proposed rejection must be adopted to preserve parties' appeal rights as to such proposed rejections.

In addition to the grounds and determinations set forth in the action, the first action should respond to the substance of each argument raised in the request by the third party requester pursuant to 37 CFR 1.915. Also, it should address any issues proper for reexamination that the examiner becomes aware of independent of the request.

Where the request for reexamination includes material such as a claim chart to explain a proposed rejection in order to establish the existence of a substantial new question of patentability, the examiner may cut and paste the claim chart (or other material) to incorporate it within the body of the Office action. The examiner must, however, carefully review the claim chart (or other material) to ensure that any items incorporated in a statement of the rejection clearly and completely address the patentability of the claims. For actions subsequent to the first Office action, the examiner must be careful to additionally address all patent owner responses to previous actions and third party requester comments.

Ordinarily, there will be no patent owner amendment to address in the first Office action of the *inter partes* reexamination, because 37 CFR 1.939(b) prohibits a patent owner amendment prior to first Office action. Thus, the first Office action will ordinarily contain no rejection based on 35 U.S.C. 112; a rejection based on 35 U.S.C. 112 is proper in reexamination only when it is raised by an amendment of the patent. The only exception is where the newly requested and granted reexamination is merged with an existing reexamination proceeding which already contains an amendment. In such a case, the first Office action for the new reexamination would be a subsequent action for the existing reexamination, and the amendment in the merged proceeding would be examined for any 35 U.S.C. 112 issues raised by the amendment and any improper broadening of the claims under 35 U.S.C. 314.

In view of the requirement for "special dispatch" in *inter partes* reexamination proceedings (35 U.S.C. 314(c)), it is intended that the examiner will issue an ACP at the earliest possible time. Accordingly, the first action should include a statement cautioning the patent owner that a complete response should be made to the action, since the next action is expected to be an ACP. The first action should further caution the patent owner that the requirements of 37 CFR 1.116(b) will be strictly enforced after an ACP and that any amendment after the ACP must include "a showing of good and sufficient reasons why they are necessary and were not earlier presented" in order to be considered. Form paragraph 26.05 should be inserted at the end of the first Office action followed by form paragraph 26.73.

¶ 26.05 *Papers To Be Submitted in Response to Action*

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be an Action Closing Prosecution (ACP), will be governed by 37 CFR 1.116(b) and (d), which will be strictly enforced.

¶ 26.73 *Correspondence and Inquiry as to Office Actions*

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

The Office action cover sheet is PTOL-2064. Where the Office action is a first Office action, the space on the PTOL-2064 for the date of the communication to which the Office action is responsive to should not be filled in, since it is the order for reexamination that responds to the request for reexamination, not the first Office action.

As with all other Office correspondence on the merits in a reexamination proceeding, the first Office action must be signed by a primary examiner.

#### IV. PANEL REVIEW CONFERENCE

After an examiner has determined that the reexamination proceeding is ready for an Office action, the examiner will formulate a draft preliminary Office action. The examiner will then inform his/her \*\*>Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS)< of his/her intent to issue the Office action. The \*>CRU SPE/TC QAS< will convene a panel review conference, and the conference members will review the patentability of the claim(s) pursuant to MPEP § 2671.03. If the conference confirms the examiner's preliminary decision to reject and/or allow the claims, the proposed Office action shall be issued and signed by the examiner, with the two other conferees initialing the action (as "conferee") to indicate their presence in the conference. If the conference does not confirm the examiner's treatment of the claims, the examiner will reevaluate and issue an appropriate Office action.

#### V. SAMPLE FIRST OFFICE ACTION

A sample of a first Office action in an *inter partes* reexamination proceeding is set forth below. The examiner should leave the paper number blank, since IFW files do not have a paper number.

<b>OFFICE ACTION IN INTER PARTES REEXAMINATION</b>	<b>Control No.</b>	<b>Patent Under Reexamination</b>	
	95/999,999	9,999,999	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kenneth M. Schor	3725	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --**

Responsive to the communication(s) filed by:  
 Patent Owner on \_\_\_\_\_  
 Third Party(ies) on \_\_\_\_\_

**RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

*For Patent Owner's Response:*  
 2 MONTH(S) from the mailing date of this action. 37 CFR 1.945. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.956.

*For Third Party Requester's Comments on the Patent Owner Response:*  
 30 DAYS from the date of service of any patent owner's response. 37 CFR 1.947. NO EXTENSIONS OF TIME ARE PERMITTED. 35 U.S.C. 314(b)(2).

**All correspondence** relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

This action is not an Action Closing Prosecution under 37 CFR 1.949, nor is it a Right of Appeal Notice under 37 CFR 1.953.

**PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1.  Notice of References Cited by Examiner, PTO-892
2.  Information Disclosure Citation, PTO-1449 or PTO/SB/08
3.  \_\_\_\_\_

**PART II. SUMMARY OF ACTION:**

- 1a.  Claims 4-6 are subject to reexamination.
- 1b.  Claims 1-3 are not subject to reexamination.
2.  Claims \_\_\_\_\_ have been canceled.
3.  Claims 5 are confirmed. [Unamended patent claims]
4.  Claims \_\_\_\_\_ are patentable. [Amended or new claims]
5.  Claims 4-6 are rejected.
6.  Claims \_\_\_\_\_ are objected to.
7.  The drawings filed on \_\_\_\_\_  are acceptable  are not acceptable.
8.  The drawing correction request filed on \_\_\_\_\_ is:  approved.  disapproved.
9.  Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:  been received.  not been received.  been filed in Application/Control No \_\_\_\_\_.
10.  Other \_\_\_\_\_

This first Office action on the merits is being mailed together with the order granting reexamination. 37 CFR 1.935.

Claims 1-3:

Claims 1-3 of the Smith patent are not being reexamined in view of the final decision in the *ABC Corp. v. Smith*, 999 USPQ2d 99 (Fed. Cir. 2008). Claims 1-3 were held invalid by the Court of Appeals for the Federal Circuit.

Claims 4 and 6:

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

35 U.S.C. 103. Conditions for patentability, non-obvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 6 are rejected under 35 U.S.C. 103 as being unpatentable over Berridge in view of McGee.

Berridge teaches extruding a chlorinated polymer using the same extrusion structure recited in Claims 4 and 6 of the Smith patent. However, Berridge does not show supporting the extrusion barrel at an angle of 25-35 degrees to the horizontal, using spring supports. McGee teaches spring supporting an extrusion barrel at an angle of 30 degrees, in order to decrease imperfections in extruded chlorinated polymers. It would have been obvious to one of ordinary skill in the polymer extrusion art to support the extrusion barrel of Berridge on springs and at an angle of 30 degrees because McGee teaches this to be known in the polymer extrusion art for decreasing imperfections in extruded chlorinated polymers.

This rejection was proposed by the third party requester in the request for reexamination, and it is being adopted essentially as proposed in the request.

Claim 5:

Claim 5 is patentable over the prior art patents and printed publications because of the recitation of the specific octagonal extrusion die used with the Claim 4 spring-supported barrel. This serves to reduce imperfections in the extruded chlorinated polymers and is not taught by the art of record, alone or in combination.

Proposed third party requester rejection:

In the request, at pages 10-14, the third party requester proposes the claim 5 be rejected based upon Berridge in view of McGee, and further taken with Bupkes or Gornisht. The third party requester points out that both Bupkes and Gornisht teach the use of an octagonal extrusion die to provide a smooth unified extrusion product.

This rejection of claim 5 proposed by the third party requester is not adopted.



**Kenneth M. Schor**  
Kenneth M. Schor  
Primary Examiner  
>CRU< Art Unit \*>3998<

**ARI**  
Conferee

**BZ**  
Conferee

## VI. ACTIVITY AFTER THE DRAFT (TEXT) OF THE FIRST OFFICE ACTION HAS BEEN PREPARED

The examiner will prepare the action, ensure that clerical processing is done, and forward the reexamination to the *>CRU SPE<* no later than two (2) weeks from the date of the consultation conference. The action is reviewed by the *>CRU SPE<* (see MPEP § 2633), who then hand carries the action to the Reexamination Legal Advisor (RLA) within three (3) days of the *>CRU SPE's<* receipt of the reexamination from the examiner.

### 2660.02 The Title [R-3]

Normally, the title of the patent will not need to be changed during reexamination. In those very rare instances where a change of the title does become necessary, the examiner should point out the need for the change as early as possible in the prosecution, as a part of an Office action. This will give the patent owner an opportunity to comment on the change prior to the examiner's formal change in the title via an examiner's amendment accompanying the Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) at the time that the *>prosecution of the reexamination<* proceeding is to be terminated. A change in the title in a reexamination can only be effected via a formal examiner's amendment accompanying the NIRC. Changing the title and merely initialing the change is not permitted in reexamination.

While a change in the title may be commented on by the patent owner, the final decision as to the change is that of the examiner, and the examiner's decision is not subject to review. Accordingly, where the examiner notes the need for a change at the time of issuing the NIRC, the examiner may make the change at that point, even though the patent owner will not have an opportunity to comment on the change.

An example of a situation where it would be appropriate to change the title is where all the claims directed to one of the categories of invention (in the patent) are canceled via the reexamination proceeding, it would be appropriate to change the title to delete reference to that category.

### 2660.03 Dependent Claims [Added R-2]

If an unamended base patent claim (i.e., a claim appearing in the patent) has been rejected or canceled, any claim which is directly or indirectly dependent thereon should be indicated as patentable if it is otherwise patentable. The dependent claim should not be objected to nor rejected merely because it depends upon a rejected or canceled original patent claim. *No requirement should be made for rewriting the dependent claim in independent form.* As the original patent claim numbers are not changed in a reexamination proceeding, the content of the canceled base claim would remain in the printed patent and would be available to be read as a part of the dependent claim.

If a new base claim has been canceled in a reexamination proceeding, a claim which depends thereon should be rejected as indefinite. If an *amended* base patent claim or a new base claim is rejected, a claim dependent thereon should be objected to if it is otherwise patentable, and a requirement should be made for rewriting the dependent claim in independent form.

### 2661 Special Status for Action [Added R-2]

35 U.S.C. 314. *Special Status For Action*

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(c) SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

In view of the requirement for “special dispatch,” all reexamination proceedings will be “special” throughout their pendency in the Office. In order to further the requirement for special dispatch, the examiner's first Office action on the merits in an *inter partes* reexamination should ordinarily be mailed together with the order for reexamination. See MPEP § 2660.

Any cases involved in litigation, whether they are reexamination proceedings or reissue applications, will have priority over all other cases. Reexamination proceedings not involved in litigation will have priority over all other cases except for reexaminations or reissues involved in litigation.



## 2662 Time for Response and Comments [R-5]

The time periods for response and comments for the various stages of an *inter partes* reexamination proceeding are as follows:

(A) After an Office action that is not an Action Closing Prosecution (non-ACP Office action).

(1) Patent owner may file a patent owner's response within the time for response set in the non-ACP Office action. The time period set for response will normally be two (2) months from the mailing date of the action.

(2) Where patent owner files a timely response to the non-ACP Office action, the third party requester may once file written comments addressing issues raised by the Office action or by the patent owner response to the action. The third party requester's written comments must be submitted within 30 days from the date of service of the patent owner's response on the third party requester. The date of service can be found on the Certificate of Service that accompanies the patent owner's response.

(B) After an Office letter indicating that a response by the patent owner is not proper.

After an Office letter indicates that a response filed by the patent owner is not completely responsive to a prior Office action (i.e., an incomplete response), the patent owner is required to complete the response within the time period set in the Office letter. 37 CFR 1.957(d). A time period of 30 days or one month (whichever is longer) is normally set. Any third party requester comments on a supplemental patent owner response that completes the initial response must be filed within 30 days from the date of service of the patent owner's supplemental response on the third party requester.

(C) After an Action Closing Prosecution (ACP).

The patent owner may once file written comments and/or present a proposed amendment to the claims within the time period set in the ACP. 37 CFR 1.951(a). Normally, the ACP will set a period of 30 days or one month (whichever is longer) from the mailing date of the ACP. Where the patent owner files comments and/or a proposed amendment, the third party requester may once file comments responsive to the patent owner's submission within 30 days from

the date of service of the patent owner's submission on the third party requester. 37 CFR 1.951(b).

(D) Appeal to the Board of Patent Appeals and Interferences (Board) after the examiner issues Right of Appeal Notice.

(1) After the examiner issues a Right of Appeal Notice (RAN), the patent owner and the third party requester may each file a notice of appeal within 30 days or one month (whichever is longer) from the mailing date of the RAN. 37 CFR 1.953(c). The time for filing a notice of appeal cannot be extended. 37 CFR 41.61(e).

(2) A patent owner who has not filed a timely notice of appeal may file a notice of cross appeal (with respect to any decision adverse to the patentability of any claim) within fourteen days of service of a third party requester's notice of appeal. 37 CFR 41.61(b)(1).

A third party requester who has not filed a timely notice of appeal may file a notice of cross appeal (with respect to any final decision favorable to the patentability of any claim) within fourteen days of service of a patent owner's notice of appeal. 37 CFR 41.61(b)(2).

The time for filing a notice of cross-appeal cannot be extended. 37 CFR 41.61(e).

(E) After an Office notification of defective notice of appeal or notice of cross appeal (to the Board).

A party who is notified of a defective notice of appeal, or defective notice of cross appeal, must cure the defect within one month from the mail date of the Office letter notifying the party. (Form PTOL-2067 should be used to notify the parties.)

The time for curing a defective notice of appeal or cross-appeal cannot be extended, since the paper curing the defect is in-effect a substitute notice of appeal or cross-appeal.

(F) Filing of briefs after notice of appeal or notice of cross appeal (to the Board).

(1) Each party that filed a notice of appeal or notice of cross appeal may file an appellant brief and fee within two months after the last-filed notice of appeal or cross appeal. Additionally, if any party to the reexamination is entitled to file an appeal or cross appeal but fails to timely do so, the appellant brief and

fee may be filed within two months after the expiration of time for filing (by the last party entitled to do so) of the notice of appeal or cross appeal. 37 CFR 41.66(a).

(2) Once an appellant brief has been properly filed, an opposing party may file a respondent brief and fee within one month from the date of service of the appellant brief. 37 CFR 41.66(b).

(3) The times for filing appellant and respondent briefs may not be extended. 37 CFR 41.66(a) and (b).

(G) After an Office notification of non-compliance of appellant brief or respondent brief.

A party who is notified of non-compliance of an appellant brief or respondent brief must file an amended brief within a non-extendable time period of one month from the date of the Office letter notifying the party of the non-compliance of the brief.

(H) Rebuttal brief after the examiner issues an examiner's answer.

A third-party requester appellant and/or a patent owner appellant may each file a rebuttal brief within one month of the date of the examiner's answer. The time for filing a rebuttal brief may not be extended. 37 CFR 41.66(d).

(I) Oral Hearing.

If an appellant or a respondent (who has filed a respondent brief) desires an oral hearing by the Board, he or she must file a written request for an oral hearing accompanied by the fee set forth in 37 CFR 41.20(b)(3) within two months after the date of the examiner's answer. The time for filing a request for oral hearing may not be extended. 37 CFR 41.73(b).

(J) Appeal to Court.

The time for the patent owner and/or the third party requester to file a notice of appeal to the U.S. Court of Appeals for the Federal Circuit is two months from the date of the Board decision. If a timely request for rehearing (37 CFR 41.79) is filed, the time for the patent owner and/or the third party requester to file a notice of appeal to the Federal Circuit is two months from final Board action on the request for rehearing. 37 CFR 1.304(a)(1).

(K) Extensions of Time.

See MPEP § 2665 as to extensions of time in *inter partes* reexamination.

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(L) Litigation.

Where the reexamination results from a court order or litigation is stayed for purposes of reexamination, the shortened statutory period will generally be set at one month or thirty days, whichever is longer. In addition, if (1) there is litigation concurrent with an *inter partes* reexamination proceeding and (2) the reexamination proceeding has been pending for more than one year, the Director of the Office of Patent Legal Administration (OPLA), Director of the Central Reexamination Unit (CRU), Director of the Technology Center (TC) in which the reexamination is being conducted, or a Senior Legal Advisor of the OPLA, may approve Office actions in such reexamination proceeding setting a one-month or thirty days, whichever is longer, shortened statutory period for response rather than the two months usually set in reexamination proceedings. A statement at the end of the Office action – “One month or thirty days, whichever is longer, shortened statutory period approved,” followed by the signature of one of these officials, will designate such approval. See MPEP § 2686.04.<

## 2664 Mailing of Office Action [R-7]

After an Office action is completed and processed and has been approved by the \*\*>Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS)< and the Reexamination Legal Advisor (RLA), the action is mailed by the \*\*>CRU< support staff. In conjunction with mailing, any appropriate processing (e.g., PALM work, update scanning) is carried out.

*Inter partes* reexamination forms are structured so that the PALM printer can be used to print the identifying information for the reexamination file and the mailing address (usually the address of the patent owner's attorney or agent of record). Where there is no attorney or agent of record, the patent owner's address is printed. Only the first owner's address is printed where there are multiple partial owners; a transmittal form PTOL-2070 is also provided for each partial owner in addition to the one named on the top of the Office action.

All actions in an *inter partes* reexamination proceeding will have a copy mailed to the third party requester. A transmittal form PTOL-2070 must be

used in providing the third party requester with a copy of each Office action.

A completed transmittal form PTOL-2070 will be provided for each requester (there can be multiple requesters in a merged reexamination proceeding; see MPEP § 2686.01) and each additional partial owner as discussed above, and the appropriate address will be entered on the transmittal form(s). The number of transmittal forms provides a ready reference for the number of copies of each Office action to be made, and the transmittal form permits use of the window envelopes in mailing the copies of the action to parties other than the patent owner.

## 2665 Extension of Time for Patent Owner Response [R-5]

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

The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). 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.

The provisions of 37 CFR 1.136(a) and 1.136(b) are NOT applicable to *inter partes* reexamination proceedings under any circumstances. Public Law 97-247 amended 35 U.S.C. 41 to authorize the Director of the USPTO to provide for extensions of time to take action which do not require a reason for the extension of time in an “application.” An *inter partes* reexamination proceeding does not involve an “application.” The provisions of 37 CFR 1.136 authorize extensions of the time period only in an application in which an applicant must respond or take action. There is neither an “application,” nor an “applicant” involved in an *inter partes* reexamination proceeding.

The times for filing a notice of appeal or cross-appeal, an appellant brief, a respondent brief, submissions curing a defective appeal or brief, a rebuttal brief, and a request for oral hearing **cannot** be extended.

A request for an extension of time for filing an appeal to the U.S. Court of Appeals for the Federal Circuit is governed by 37 CFR 1.304(a). A request for

an extension of time to petition from the denial of a request for reexamination can be obtained only by filing a grantable petition under 37 CFR 1.183 (with fee) to waive the time provisions of 37 CFR 1.927.

Extensions of time in an *inter partes* reexamination proceeding are otherwise governed by 37 CFR 1.956. It should be noted that **extensions of time under 37 CFR 1.956 are not available to the third party requester.**

An extension of time in an *inter partes* reexamination proceeding is requested, where applicable, pursuant to 37 CFR 1.956. Any request for extension of time pursuant to 37 CFR 1.956 will be decided by the **>Central Reexamination Unit (CRU) Director<**. The request (A) must be filed on or before the day on which action by the patent owner is due, (B) must set forth sufficient cause for the extension, and (C) must be accompanied by the petition fee set forth in 37 CFR 1.17(g).

Requests for an extension of time in an *inter partes* reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.

The certificate of mailing and the certificate of transmission procedures (37 CFR 1.8), and the “Express Mail” mailing procedure (37 CFR 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).

As noted above, a request for extension of time under 37 CFR 1.956 will be granted only for sufficient cause, and *the request must be filed on or before the day on which action by the patent owner is due*. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does **not** apply to the first response to an Action Closing Prosecution (ACP) in an *inter partes* reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no

response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike *ex parte* reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch.

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons **must** include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.<

Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified—usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations.

## EXTENSIONS OF TIME TO SUBMIT AFFIDAVITS AFTER ACTION CLOSING PROSECUTION

Frequently, a request for an extension of time is made, stating as a reason therefor, that more time is needed in which to submit an affidavit. When such a request is filed after an ACP, the granting of the request for extension of time is without prejudice to the right of the examiner to question why the affidavit is now necessary and why it was not earlier presented.

If the showing by the patent owner is insufficient, the examiner may deny entry of the affidavit, notwithstanding the previous grant of an extension of time to submit it. The grant of an extension of time in these circumstances serves merely to give the patent owner an extended opportunity to present the affidavit or to take other appropriate action.

Affidavits submitted after an ACP are subject to the same treatment as amendments submitted after an ACP. This is analogous to the treatment of affidavits submitted after a final rejection in an application. See *In re Affidavit Filed After Final Rejection*, 152 USPQ 292, 1966 C.D. 53 (Comm'r Pat. 1966).

## 2666 Patent Owner Response to Office Action [R-7]

*37 CFR 1.111. Reply by applicant or patent owner to a non-final Office action.*

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

(2) *Supplemental replies.* (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

- (A) Cancellation of a claim(s);
- (B) Adoption of the examiner suggestion(s);
- (C) Placement of the application in condition for allowance;
- (D) Reply to an Office requirement made after the first reply was filed;
- (E) Correction of informalities (*e.g.*, typographical errors); or
- (F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable

subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

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

\*\*>

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

(b) Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

(1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;

(2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and

(3) A compelling reason to enter the supplemental response.<

## I. SUBSTANCE OF THE RESPONSE

Pursuant to 37 CFR 1.937(b):

"The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process..."

Accordingly, the provisions of 37 CFR 1.111 apply to the response by a patent owner in a reexamination proceeding.

The patent owner may request reconsideration of the position stated in the Office action, with or without amendment to the claims and/or specification. As to amendments in reexamination proceedings, see MPEP § 2666.01.

Any request for reconsideration must be in writing and must distinctly and specifically point out each supposed error in the examiner's action. A general allegation that the claims define a patentable invention, without specifically pointing out how the language of the claims patentably distinguishes them

over the references, is inadequate and is not in compliance with 37 CFR 1.111(b).

Reasons must be given as to how and why the claims define over the references, and why any rejections made under 35 U.S.C. 112 are incorrect or inapplicable.

Affidavits under 37 CFR 1.131 and 1.132 may be utilized in a reexamination proceeding. Note, however, that an affidavit under 37 CFR 1.131 may not be used to "swear back" of a reference patent if the reference patent is claiming the same invention as the patent undergoing reexamination. In such a situation, the patent owner may, if appropriate, seek to raise this issue via an affidavit under 37 CFR 1.130 (see MPEP § 718) or in an interference proceeding via an appropriate reissue application if such a reissue application may be filed (see MPEP § 1449.02).

The patent owner cannot file papers on behalf of a third party. If a third party paper accompanies or is submitted as part of a timely filed response, the response and third party paper are considered to be an improper (i.e., informal) submission, and the **entire** submission shall be returned to the patent owner since the Office will not determine which portion of the submission is the third party paper. The third party paper filed as part of the patent owner's response will not be considered. The improper response with the third party paper in it should be returned to patent owner as a defective (informal) response, using form PTOL-2069 as the cover letter. See MPEP § 2666.50. The appropriate box on the form should be checked and an explanation for the return of the paper given. The patent owner should be provided an appropriate period of time to refile the patent owner response without the third party paper.

## II. PROCEDURAL CONSIDERATIONS OF THE RESPONSE

The certificate of mailing and the certificate of transmission procedures (37 CFR 1.8), and the 'Express Mail' mailing procedure (37 CFR 1.10), may be used to file a patent owner's response, as well as any other paper in an existing *inter partes* reexamination proceeding.

A copy of the response must be served on the third party requester in accordance with 37 CFR 1.248, - see also MPEP § 2666.06. Lack of service poses a problem, since a third party requester must file written

comments within a period of 30 days from the date of service of the patent owner's response, in order to be timely. Where the record does not show the response to have been served on the third party requester, see MPEP § 2666.06.

The patent owner will normally be given a period of two months to respond to an Office action. An extension of time can be obtained only in accordance with 37 CFR 1.956. Note that 37 CFR 1.136 does not apply in reexamination proceedings.

See MPEP § 2666.10 for the consequences of the failure by the patent owner to respond to the Office action.

### III. SUPPLEMENTAL RESPONSE TO OFFICE ACTION

\*\*>Pursuant to 37 CFR 1.945(b), any supplemental response to the Office action in an *inter partes* reexamination proceeding must be accompanied by a showing of sufficient cause why the supplemental response should be entered. If such a showing is not provided, the supplemental response will not be entered, and may be sealed from public view in the Image File Wrapper (IFW), if it has already been scanned into the IFW for the proceeding.

The showing of sufficient cause why the supplemental response should be entered must include:

(A) an explanation of how the requirements of 37 CFR 1.111(a)(2)(i) are satisfied;

(B) an explanation of why the supplemental response was not presented together with the original response to the Office action; and

(C) a compelling reason to enter the supplemental response.

Pursuant to 37 CFR 1.111(a)(2)(i), the Office may enter a supplemental response if the supplemental response is clearly limited to: (1) cancellation of a claim(s); (2) adoption of the examiner suggestion(s); (3) placement of the proceeding in condition for Notice of Intent to Issue Reexamination Certificate (NIRC); (4) a response to an Office requirement made after the first response was filed; (5) correction of informalities (e.g., typographical errors); or (6) simplification of issues for appeal.

In some instances, where there is a clear basis for the supplemental response, the three-prong showing

may be easily satisfied. Thus, for example, the patent claim text may have been incorrectly reproduced, where a patent claim is amended in the original response. In such an instance, the patent owner need only point to the provision of 37 CFR 1.111(a)(2)(i)(E) for the correction of the informalities (e.g., typographical errors), and state that the incorrect reproduction of the claim was not noted in the preparation of the original response. The compelling reason to enter the supplemental response is implicit in such a statement, as the record for the proceeding certainly must be corrected as to the incorrect reproduction of the claim.

Any requester comments filed after a patent owner response to an Office action must be filed "within 30 days after the date of service of the patent owner's response," to satisfy 35 U.S.C. 314(b)(2). Thus, where the patent owner files a supplemental response to an Office action, the requester would be well advised to file any comments deemed appropriate within 30 days after the date of service of the patent owner's supplemental response to preserve requester's comment right, in the event the Office exercises its discretion to enter the supplemental response. The requester's comments may address whether the patent owner showing is adequate, in addition to addressing the merits of the supplemental response. If the patent owner's supplemental response is not entered by the Office, then both the supplemental response, and any comments following that supplemental response, will either be returned to the parties or discarded at the sole discretion of the Office. If the supplemental response and/or comments were scanned into the IFW for the reexamination proceeding, and thus, the papers cannot be physically returned or discarded, then the supplemental response and/or comments entries will be marked "closed" and "non-public," and they will not constitute part of the record of the reexamination proceeding. Such papers will not be displayed in the Office's image file wrapper that is made available to the public, patent owners, and representatives of patent owners, i.e., they will not be displayed in the Patent Application Information Retrieval (PAIR) at the Office's website.<

A supplemental response, which has not been approved for entry, will not be entered when a response to a subsequent Office action is filed, even if \*\* a specific request for its entry >is made< in the

subsequent response. If a patent owner wishes to have the unentered supplemental response considered by the examiner, the patent owner must include the contents of the unentered supplemental response in a proper response to a subsequent Office action. If the next Office action is an Action Closing Prosecution under 37 CFR 1.949, or an action that otherwise closes prosecution, the entry of the response is governed by 37 CFR 1.116 (see 37 CFR 1.951(a)).

>Patent owner cannot submit an application data sheet (ADS) in a reexamination proceeding since a reexamination proceeding is not an “application” (see 37 CFR 1.76). An ADS is an improper paper in a reexamination proceeding.<

## 2666.01 Amendment by Patent Owner [R-7]

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

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

*37 CFR 1.121. Manner of making amendments in applications.*

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(j) *Amendments in reexamination proceedings.* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

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*37 CFR 1.530. Statement by patent owner in ex parte reexamination; amendment by patent owner in ex parte or inter partes reexamination; inventorship change in ex parte or inter partes reexamination.*

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

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph including

markings pursuant to paragraph (f) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph, without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ 1.96 and 1.825).

(2) *Claims.* An amendment paper must include the entire text of each patent claim which is being proposed to be changed by such amendment paper and of each new claim being proposed to be added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression “amended,” “twice amended,” *etc.*, should follow the claim number. Each patent claim proposed to be changed and each proposed added claim must include markings pursuant to paragraph (f) of this section, except that a patent claim or proposed added claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval of the changes by the examiner, only new sheets of drawings including the changes and in compliance with § 1.84 must be filed. Amended figures must be identified as “Amended,” and any added figure must be identified as “New.” In the event a figure is canceled, the figure must be surrounded by brackets and identified as “Canceled.”

(4) The formal requirements for papers making up the reexamination proceeding other than those set forth in this section are set out in § 1.52.

(e) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

(f) *Changes shown by markings.* Any changes relative to the patent being reexamined which are made to the specification, including the claims, must include the following markings:

(1) The matter to be omitted by the reexamination proceeding must be enclosed in brackets; and

(2) The matter to be added by the reexamination proceeding must be underlined.

(g) *Numbering of patent claims p.* Patent claims may not be renumbered. The numbering of any claims added in the reexamination proceeding must follow the number of the highest numbered patent claim.

(h) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(i) *Amendments made relative to patent.* All amendments must be made relative to the patent specification, including the

claims, and drawings, which are in effect as of the date of filing the request for reexamination.

(j) *No enlargement of claim scope.* 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, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.

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(k) *Amendments not effective until certificate.* Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued and published.

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

(1) When it appears in a patent being reexamined that the correct inventor or inventors were not named through error without deceptive intention on the part of the actual inventor or inventors, the Director may, on petition of all the parties set forth in § 1.324(b)(1)-(3), including the assignees, and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), or on order of a court before which such matter is called in question, include in the reexamination certificate to be issued under § 1.570 or § 1.997 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding and must satisfy the requirements of § 1.324.

(2) Notwithstanding paragraph (1)(1) of this section, if a petition to correct inventorship satisfying the requirements of § 1.324 is filed in a reexamination proceeding, and the reexamination proceeding is concluded other than by a reexamination certificate under § 1.570 or § 1.997, a certificate of correction indicating the change of inventorship stated in the petition will be issued upon request by the patentee.<

Amendments to the patent being reexamined (where the patent has not expired) may be filed by the patent owner in the reexamination proceeding. Such amendments may be provided by the patent owners after the first Office action on the merits has been issued. The first Office action on the merits will ordinarily be mailed with the order. In some instances, however, it may not be practical or possible to mail the first Office action together with the order. In the event that the first Office action is mailed after the order, it would not be proper to provide an amendment prior to the first Office action. Such an amendment would not be considered, and it would be returned to the patent owner as an improper paper.

If an amendment is submitted to add claims to the patent being reexamined (i.e., to provide new claims), then excess claims fees pursuant to 37 CFR 1.20(c)(3) and (c)(4) may be applicable to the presentation of the added claims. See MPEP § 2666.04. Amendments proposed in a reexamination will normally be entered

if timely, and will be considered to be entered for purposes of prosecution before the Office (if they are timely and comply with the rules); however, amendments do not become effective in the patent until the certificate under 35 U.S.C. 316 is issued >and published<.

Amendments must not enlarge the scope of a claim of the patent nor introduce new matter. Amended or new claims which broaden or enlarge the scope of a claim of the patent should be rejected under 35 U.S.C. 314(a). The test for when an amended or “new claim enlarges the scope of an original claim under 35 U.S.C. 314(a) is the same as that under the 2-year limitation for reissue applications adding enlarging claims under 35 U.S.C. 251, last paragraph.” *In re Freeman*, 30 F.3d 1459, 1464, 31 USPQ2d 1444, 1447 (Fed. Cir. 1994). See MPEP § 2658 for a discussion of enlargement of the claim scope. For handling of new matter, see MPEP § 2670.

If the patent expires during the reexamination procedure, and the patent claims have been amended, the Office will hold the amendments as being improper and all subsequent reexamination will be on the basis of the unamended patent claims. This procedure is necessary since no amendments will be incorporated into the patent by certificate after the expiration of the patent. See 37 CFR 1.941 and 37 CFR 1.530(j). The patent expiration date for a utility patent, for example, is determined by taking into account the term of the patent, whether maintenance fees have been paid for the patent, whether any disclaimer was filed as to the patent to shorten its term, any patent term extensions or adjustments for delays within the USPTO under 35 U.S.C. 154 (see MPEP § 2710, *et seq.*), and any patent term extensions available under 35 U.S.C. 156 for premarket regulatory review (see MPEP § 2750 *et seq.*). Any other relevant information should also be taken into account.

Once the patent expires, a narrow claim construction is applied. See MPEP § 2258, \*\*>subsection I.G.< “Claim Interpretation and Treatment.”

*Amendment Entry* - Amendments which comply with 37 CFR 1.530(d)-(j) and 37 CFR 1.943 (and are formally presented pursuant to 37 CFR 1.52(a) and (b), and contain fees required by 37 CFR 1.20(c)) will be entered in the reexamination file pursuant to the guidelines set forth in MPEP § 2234.



*Manner of Making Amendments* - Amendments in an *inter partes* reexamination proceeding are made in the same manner that amendments in an *ex parte* reexamination proceeding are made. See MPEP § 2250 for guidance as to the manner of making amendments in a reexamination proceeding.

Form paragraph 22.12 may be used to advise the patent owner of the proper manner of making amendments in an *inter partes* reexamination proceeding.

¶ 22.12 *Amendments Proposed in a Reexamination* - 37 CFR 1.530(d)-(j)

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

**Examiner Note:**

This paragraph may be used in the order granting reexamination and/or in the first Office action to advise patent owner of the proper manner of making amendments in a reexamination proceeding.

Form paragraph 26.05.01 may be used to notify patent owner in an *inter partes* reexamination proceeding that a proposed amendment in the proceeding does not comply with 37 CFR 1.530(d)-(j).

¶ 26.05.01 *Improper Amendment in an Inter Partes Reexamination* - 37 CFR 1.530(d)-(j)

The amendment filed [1] proposes amendments to [2] that do not comply with 37 CFR 1.530(d)-(j), which sets forth the manner of making amendments in reexamination proceedings. A supplemental paper correctly proposing amendments in the present *inter partes* reexamination proceeding is required.

A shortened statutory period for response to this letter is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter. If the patent owner fails to timely correct this informality, the amendment will be held not to be an appropriate response, and the consequences set forth in 37 CFR 1.957(b) or (c) will result. See MPEP § 2666.10

**Examiner Note:**

This paragraph may be used for any 37 CFR 1.530(d)-(j) informality as to a proposed amendment submitted in a reexamination proceeding.

The cover sheet to be used for mailing the notification to the patent owner will be PTOL-2069.

As an alternative to using form paragraph 26.05.01, it would also be appropriate to use form PTOL-2069, box 4.

For clerical handling of amendments, see MPEP § 2670. For entry of an amendment in a merged reex-

amination proceeding, see MPEP § 2686.01 and § 2686.03. For handling of a dependent claim in reexamination proceedings, see MPEP § 2660.03.

## 2666.02 Correction of Patent Drawings [Added R-2]

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

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

37 CFR 1.530. *Statement by patent owner in ex parte reexamination; amendment by patent owner in ex parte or inter partes reexamination; inventorship change in ex parte or inter partes reexamination.*

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

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(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval of the changes by the examiner, only new sheets of drawings including the changes and in compliance with § 1.84 must be filed. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

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In the reexamination proceeding, the copy of the patent drawings submitted pursuant to 37 CFR 1.915(b)(5) will be used for reexamination purposes, provided no change is made to the drawings. If there is **any** change in the drawings, a new sheet of drawing for each sheet changed must be submitted. The change may **not** be made on the original patent drawings. Drawing changes in an *inter partes* reexamination proceeding are made in the same manner that drawing changes in an *ex parte* reexamination proceeding are made. 37 CFR 1.530(d)(3) sets forth the

manner of making amendments to the drawings. Any amended figure(s) must be identified as “Amended” and any added figure(s) must be identified as “New.” In the event a figure is canceled, the figure must be surrounded by brackets and identified as “Canceled.”

Where the patent owner wishes to change/amend the drawings, the patent owner should submit a sketch in permanent ink showing the proposed change(s)/ amendment(s) in red, for approval by the examiner. The submitted sketch should be presented as a separate paper, and it will be made part of the record. Once the sketch is approved, sheets of substitute formal drawings must be submitted for each drawing sheet that is to be changed/amended. After receiving the new sheets of drawings from the patent owner, the examiner may have the draftsman review the new sheets of drawings if the examiner would like the draftsman’s assistance in identifying errors in the drawings. If a draftsman reviews the drawings, and finds the drawings to be unacceptable, the draftsman should complete a PTO-948 for the examiner to include with the next Office action. A draftsman’s “stamp” to indicate approval is no longer required on patent drawings, and these stamps are no longer to be used by draftsmen. The new sheets of drawings should be entered in the reexamination file.

### 2666.03 Correction of Inventorship [Added R-2]

Correction of inventorship in an *inter partes* reexamination proceeding is effected in the same manner that correction of inventorship in an *ex parte* reexamination proceeding is effected. See MPEP § 2250.02 for the manner of correcting inventorship in both *inter partes* and *ex parte* reexamination proceedings.

### 2666.04 Fees for Adding Claims [R-7]

37 CFR 1.20. Post issuance fees

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(c) In reexamination proceedings

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

\*\*>

(3) For filing with a request for reexamination or later presentation at any other time of each claim in independent form

in excess of 3 and also in excess of the number of claims in independent form in the patent under reexamination:

By a small entity (§ 1.27(a)).....\$105.00

By other than a small entity .....\$210.00

(4) For filing with a request for reexamination or later presentation at any other time of each claim (whether dependent or independent) in excess of 20 and also in excess of the number of claims in the patent under reexamination (note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes):

By a small entity (§ 1.27(a)).....\$25.00

By other than a small entity .....\$50.00

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(5) If the excess claims fees required by paragraphs (c)(3) and (c)(4) are not paid with the request for reexamination or on later presentation of the claims for which the excess claims fees are due, the fees required by paragraphs (c)(3) and (c)(4) must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

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Excess claims fees as specified in 35 U.S.C. 41(a)(2) as amended by the Consolidated Appropriations Act of 2005 are applicable to excess claims proposed to be added to a patent by their presentation during a reexamination proceeding. Under “former” 35 U.S.C. 41, excess claims fees were included as part of the “application” filing fee under 35 U.S.C. 41(a)(1), and thus did not apply during reexamination proceedings. The Consolidated Appropriations Act does not include the excess claims as part of the “application” filing fee under 35 U.S.C. 41(a)(1), but separately provides for excess claims fees in 35 U.S.C. 41(a)(2) (as being in addition to the filing fee in 35 U.S.C. 41(a)(1)). 35 U.S.C. 41(a)(2) provides that an excess claims fee is due “on filing or on presentation at any other time” (e.g., during a reexamination proceeding) of an independent claim in excess of three or of a claim (whether independent or dependent) in excess of twenty.

37 CFR 1.20 was amended, effective December 8, 2004, to provide for excess claims fees in a reexamination proceeding. The excess claims fees specified in 37 CFR 1.20(c) apply to all patents eligible for *inter partes* reexamination. The fees must be submitted for any excess claims presented in a reexamination proceeding on or after December 8, 2004 (no excess claims fee was due under 35 U.S.C. 41 for any claim presented during a reexamination proceeding before December 8, 2004). Even though a reexamination proceeding was commenced prior to December 8,

2004, the excess claims fees are due for any amendment filed on or after December 8, 2004.

When a patent owner presents an amendment to the claims (on or after December 8, 2004) during an *inter partes* reexamination proceeding, excess claims fees may be applicable. If the amendment is limited to revising the existing claims, i.e., it does not provide any new claim, there is no claim fee. The excess claims fees apply only to the submission of new, i.e., “excess” claims.

The excess claims fees specified in 37 CFR 1.20(c) apply to excess claims that result from an amendment as follows:

(A) The fee designated in 37 CFR 1.20(c)(3) as the independent claims fee must be paid for each independent claim in excess of three and also in excess of the number of independent claims in the patent being reexamined. The amendment must increase the number of independent claims to be more than both of these limits, in order for the “independent excess claims fee” to apply;

(B) The fee designated in 37 CFR 1.20(c)(4) as the total claims fee must be paid for each claim (whether independent or dependent) in excess of twenty and also in excess of the number of claims in the patent being reexamined. The amendment must increase the total number of claims to be more than both of these limits, in order for the “total excess claims fee” to apply.

The following examples illustrate the application of the excess claims fees in a patent (non-small entity) to be reexamined containing six independent claims and thirty total claims:

(A) No excess claims fee is due if the patent owner cancels ten claims, two of which are independent, and adds ten claims, two of which are independent.

(B) The 37 CFR 1.20(c)(3) excess independent claims fee for a seventh independent claim is due if the patent owner cancels ten claims, two of which are independent, and adds ten claims, three of which are independent.

(C) The 37 CFR 1.20(c)(4) excess total claims fee for a thirty-first claim is due if the patent owner cancels ten claims, two of which are independent, and adds eleven claims, two of which are independent.

(D) The 37 CFR 1.20(c)(3) excess independent claims fee for a seventh independent claim and the 37

CFR 1.20(c)(4) excess total claims fee for a thirty-first claim are due if the patent owner cancels ten claims, two of which are independent, and adds eleven claims, three of which are independent.

A claim that has been disclaimed under 35 U.S.C. 253 and 37 CFR 1.321(a) as of the date of filing of the request for reexamination is not considered to be a claim in the patent under reexamination for purposes of excess claims fee calculations. The same applies to a claim canceled via a prior Reexamination Certificate, reissue patent, or Certificate of Correction.

If the excess claims fees required by 37 CFR 1.20(c)(3) and (c)(4) are not paid with the presentation of the excess claims, a notice of fee deficiency will be issued as a Notice of Defective Paper In *Inter Partes* Reexamination, PTOL-2069. A one-month time period will be set in the form PTOL-2069 for correction of the defect, i.e., the fee deficiency. An extension of time to correct the fee deficiency may be requested under 37 CFR 1.956. If the unpaid excess claims fees required by 37 CFR 1.20(c)(3) and (c)(4) are not paid within the time period set for response to the Notice, the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the particular case), to effect the “abandonment” set forth in 37 CFR 1.20(c)(5).

### **2666.05 Third Party Comments After Patent Owner Response [R-7]**

*37 CFR 1.947. Comments by third party requester to patent owner’s response in inter partes reexamination.*

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner’s response. These comments shall be limited to issues raised by the Office action or the patent owner’s response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

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

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

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

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

(b) [Reserved].

## I. TIMELINESS

A third party requester may once file written comments on any patent owner response to an Office action, during the examination stage of an *inter partes* reexamination proceeding. The third party requester comments must be filed within a period of 30 days from the **date of service** of the patent owner's response on the third party requester. 37 CFR 1.947. The date that the Office receives the patent owner's response has no bearing on the time period for which the third party requester must file the comments.

The certificate of mailing and the certificate of transmission procedures (37 CFR 1.8), and the "Express Mail" mailing procedure (37 CFR 1.10), may be used to file comments. Any comments by the third party requester must be served upon the patent owner in accordance with 37 CFR 1.248, - see also MPEP § 2666.06.

If the third party requester comments are filed after 30 days from the **date of service** of the patent owner's response on the third party requester, the comments will not be considered. See 37 CFR 1.957(a).

>The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since

the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ...The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

When the requester takes issue with the page length of the patent owner's response and there the patent owner has not filed a petition requesting waiver of the page length requirement, the requester may file a petition to strike under 37 CFR 1.182 (with the appropriate fee) along with its comments on patent owner's response (which must be filed within 30 days from the date of service of the response). The 37 CFR 1.182 petition may request that (A) if the patent owner response is struck, then the accompanying comments should not be entered, and the requester's comment period be re-set to run 30 days from the date of service of a corrected patent owner response, and (B) if the petition to strike is denied/dismissed, then the comments accompanying the petition should be entered and that 37 CFR 1.943(b) be waived to the extent that entry of the accompanying comment paper is permitted.<

## II. CONTENT

The third party requester comments must be directed to points and issues covered by the Office action and/or the patent owner's response. The written comments filed by a third party requester should specify the issues and points in the Office action or the patent owner's response to which each comment is directed. Thus, the third party requester should (\*>1<) set forth the point or issue, (\*>2<) state the page of the Office action and/or the patent owner response where the point or issue is recited, and (\*>3<) then present the third party requester's discussion and argument as to the point or issue. If this is not done by the third party requester, the comments should not be held defective if the examiner can ascertain that all of the comments filed by the third party requester are

directed to the issues and points in the Office action and/or the patent owner's response.

Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination. \*\*

>As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.

As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

As to items (A) – (C) above where a newly proposed rejection is based on the newly presented prior

patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.<

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper. If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper\*\*>; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester. The notification to the third party requester is to provide a time period of fifteen (15)< days for the third party requester to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party >requester< with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. The loss of right to submit further comments applies only to the patent owner response at hand. See MPEP § 2666.20. >To the extent that 37 CFR 1.947 provides that the third party requester "may once" file written comments, that provision is hereby waived to the extent of providing the third party requester the one additional opportunity to remedy a comments paper containing merits-content that goes beyond what is permitted by the rules; 37 CFR 1.947 is not waived to provide any further opportunity in view of the statutory requirement for special dispatch in reexamination.

Any replacement comments submitted in response to the notification must be strictly limited to (i.e.,

must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.<

The >above< practice of giving the third party requester a time period of >15< days to rectify and refile comments that are >responsive but go beyond the regulatory requirements to the extent discussed above< should not be confused with the situation where the third party requester files comments that are late (untimely), or such comments are “inappropriate” within the meaning of 37 CFR 1.957(a) and the time for response has expired. Where the comments are late or inappropriate, an additional 30 days is not given; rather, the comments must be refused consideration pursuant to 37 CFR 1.957(a).

The third party requester is not permitted to file further papers to supplement the third party requester’s written comments. Any such improper supplemental comments will not be considered, and will be returned. A third party requester may, however, file written comments to any supplemental response filed by the patent owner.

See MPEP § 2666.20 for the situation where a third party requester elects not to file written comments on a patent owner response.

Where the patent owner does not respond to an Office action, the third party requester is prohibited from filing written comments under 37 CFR 1.947.

Note that a prior art citation which is proper under 37 CFR 1.501 and is submitted by any party as a separate paper and does not include argument and comments and does not go to the merits of the case, will not be returned, but rather will be stored until the ongoing reexamination proceeding is concluded. See MPEP § 2204 and 2206. Also note that prior art returned by the examiner in connection with the third party requester comments as discussed above can be resubmitted as a separate prior art citation under 37 CFR 1.501, and it will be stored until the ongoing reexamination proceeding is concluded.

### III. EXAMINER WITHDRAWS A GROUND OF REJECTION

If the examiner withdraws a ground of rejection at any time in the prosecution of the *inter partes* reexamination proceeding, the following guidelines apply:

(A) Where the examiner withdraws a ground of rejection originally initiated by the examiner, such withdrawal should be clearly stated in the Office action as a decision favorable to patentability with respect to the withdrawn rejection. The third party requester’s next set of comments that may be filed (after a patent owner response to an action) may propose the withdrawn rejection as a “rejection proposed by the third party requester.” In the event the patent owner fails to respond to all actions leading to the Right of Appeal Notice (RAN), including the Action Closing Prosecution (ACP), and a RAN is then issued, the third party requester may appeal this withdrawal of rejection as a final decision favorable to patentability. See 37 CFR 41.61(a)(2). Likewise, where the rejection is first withdrawn in the RAN, there will be no requester opportunity to comment prior to appeal, and the requester may appeal this withdrawal of rejection in the RAN as a final decision favorable to patentability.

(B) Where the claims have not been amended and the examiner withdraws a ground of rejection previously proposed by the third party requester (e.g., based on patent owner’s argument or evidence submitted), the examiner should treat the issue as a rejection proposed by the third party requester that the examiner refuses to adopt.

(C) Generally (subject to the below-stated exception), where the claims have been amended and the examiner withdraws a ground of rejection previously proposed by the third party requester, this is not a refusal of the examiner to adopt the rejection proposed by the requester, since the rejection was never proposed as to the amended claims. The third party requester’s next set of comments that may be filed (after a patent owner response to an action) may propose the withdrawn rejection as a “rejection proposed by the third party requester” as to the amended claims. In the event the patent owner fails to respond to all actions leading to the RAN, including the ACP, and a RAN is then issued, the third party requester may appeal this withdrawal of rejection as a final decision favorable to patentability. See 37 CFR 41.61(a)(2). Likewise, where the rejection is first withdrawn in the RAN, there will be no requester opportunity to comment prior to appeal, and the requester may appeal this withdrawal of rejection in the RAN as a final decision favorable to patentability.

(D) If a claim is amended merely to include a dependent claim that was previously subjected to a proposed requester rejection, and the examiner withdraws that ground of rejection as to the newly amended claim, such would be a refusal to adopt the third party requester's previously proposed rejection of the dependent claim. Thus, the examiner would treat the issue as a rejection proposed by the third party requester that the examiner refuses to adopt.

## 2666.06 Service of Papers [R-7]

37 CFR 1.915. *Content of request for inter partes reexamination.*

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

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

\*\*\*\*\*

37 CFR 1.903. *Service of papers on parties in inter partes reexamination.*

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

Any paper filed with the Office, i.e., any submission made, by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding including any other third party requester that is part of the proceeding due to merger of reexamination proceedings.

As proof of service, the party submitting the paper to the Office must attach a certificate of service to the paper. It is required that the certificate of service set forth the name and address of the party served and the method of service. Further, a copy of the certificate of

service must be attached with the copy of the paper that is served on the other party.

\*\*>Lack of service poses a problem, since, by statute (35 U.S.C. 314(b)(2)), a third party requester must file written comments within a period of 30 days from the date of service of the patent owner's response, in order to be timely. In any instance where proof of service is not attached to a paper<, a Notice of Defective Paper (PTOL-2069) will be mailed to the party, providing the party with a time period of one month or 30 days, whichever is longer, to complete the paper via a supplemental paper indicating the manner and date of service.

If it is known that service of a submission was not made, form paragraph 26.68 should be used to give notice to the party that made the submission of the requirement for service under 37 CFR 1.903.

¶ 26.68 *Lack of Service in inter partes examination-37 CFR 1.903*

The submission filed [1] is defective because it appears that the submission was not served on [2]. After the filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two third party requester proceedings are merged) in the *inter partes* reexamination proceeding in the manner provided in 37 CFR 1.248. See 37 CFR 1.903.

It is required that service of the submission be made, and a certificate of service be provided to the Office, within ONE MONTH from the date of this letter or within the time remaining in the response period of the last Office action (if applicable), whichever is longer.

### Examiner Note:

1. This paragraph may be used where a submission to the Office was not served as required in an *inter partes* reexamination proceeding.
2. In bracket 2, insert "patent owner" or "third party requester," whichever is appropriate.

PTOL-2071 should be used as the cover sheet for mailing the notice.

See MPEP § 2620 for service of the initial request on the patent owner.

>As pointed out above, the service provision of the statute poses a problem, since, 35 U.S.C. 314(b)(2) mandates that, in order to be timely, a third party requester must file any written comments to the patent owner's response (to an Office action on the merits) within a period of 30 days from the date of service of such patent owner's response. Accordingly, if a patent owner's response to an Office action on the

merits that is served on a third party requester is received by the third party requester more than 5 business days after the date of service set forth on the certificate of service, the third party requester may submit a verified statement, specifying the date of actual receipt, as an attachment to the third party requester's comments. The date of service will then be deemed by the Office to be the date of actual receipt by the third party requester of the patent owner's response.<

### **2666.10 Patent Owner Does Not Respond to Office Action [R-7]**

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

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

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

(c) If claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time.

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

#### **I. OFFICE ACTION PRIOR TO ACTION CLOSING PROSECUTION**

If the patent owner fails to file a timely response to any Office action prior to an Action Closing Prosecution (ACP), it will result in the following consequences set forth in 37 CFR 1.957(b) or (c):

(A) Where there were no claims found patentable in the Office action, the examiner will issue a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) terminating prosecution and indicating

the status of the claims as canceled. See MPEP § 2687.

(B) Where at least one claim is found patentable, all future prosecution will be limited to the claim(s) found patentable at the time of the failure to respond and to claims which do not expand the scope of the claim(s) found patentable at that time. The patent owner will not be permitted to add claims broader in the scope than the patentable claims which remain in the proceeding at the time of the patent owner's failure to timely respond. The examiner will proceed to issue an ACP indicating that:

(1) Any claims under rejection or objection are withdrawn from consideration and will be canceled upon publication of the certificate; and

(2) Prosecution will be limited to the claim(s) found patentable at the time of the failure to respond and to claims which do not expand the scope of the claim(s) found patentable at that time.

The ACP will set a period for the patent owner response and the third party requester comments under 37 CFR 1.951. See also MPEP § 2671.02 and § 2671.03.

#### **II. ACTION CLOSING PROSECUTION**

A response to an ACP is not required. Where the patent owner does not respond to an ACP, the Office will issue an Right of Appeal Notice (see MPEP § 2673.02) in due course. Accordingly, the consequences of 37 CFR 1.957(b) and (c), do NOT apply to the patent owner's failure to respond to an ACP.

#### **III. RIGHT OF APPEAL NOTICE AND APPEAL**

Where the patent owner fails to make a timely appeal after the issuance of a Right of Appeal Notice, or where a timely patent owner's appeal is subsequently dismissed, the following consequences would result:

(A) If no claim was found patentable at the time that the patent owner fails to take the timely action, a NIRC will immediately be issued. See MPEP § 2687.

(B) Where at least one claim was found patentable and the third party requester does not appeal, or fails to continue its appeal, the prosecution of the reexamination proceeding should be terminated in



accordance with 37 CFR 1.957(b). In order to do so, a NIRC will be issued. See MPEP § 2687.

(C) Where at least one claim was found patentable and the third party appellant continues its appeal, the claims in the proceeding will be limited to the claim(s) found patentable at the time that the patent owner fails to take the timely action, and all other claims will be withdrawn from consideration pending cancellation of same when the NIRC is issued. Any future prosecution is limited to the claims that do not expand the scope of the claim(s) found patentable at that time.

#### IV. FAILURE OF THIRD PARTY REQUESTER TO TIMELY SUBMIT PAPER

See MPEP § 2666.20 for a discussion of the consequences where the third party requester fails to timely submit a paper where a time period is set for same.

#### 2666.20 Third Party Does Not Comment After Patent Owner Response [R-3]

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

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

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Where a third party requester does not timely file written comments on a patent owner response, any subsequent submission of comments on **that response** will be refused consideration. The third party requester does not, however, lose any rights as to commenting on *future* patent owner responses. The failure to file the comments applies only to the specific response which the third party requester elects not to comment upon.

Note that where the third party requester did not file comments on a response that was determined by the Office to be incomplete, the third party requester may file comments on the response once it is completed (by patent owner's submission of a supplemental response). However, where only a fee >(other than an excess claims fee to support an amendment)< is needed to complete the response, the third party

requester may not file comments after the fee is submitted; see MPEP § 2666.40 for a detailed discussion.

Where the third party requester fails to make a timely appeal or the third party requester's appeal is dismissed, the third party requester loses further rights as **the appellant** in the appeal. However, where a patent owner appellant continues its appeal, the third party requester as the respondent can file a respondent brief. Also, the third party requester can enter the appeal pursuant to 37 CFR \*>41.77(c) and (e)< (submission after a Board of Patent Appeals and Interferences decision). In addition, the third party requester can comment on any subsequent patent owner response to any Office action, where the action is issued after the appeal.

Where the third party requester fails to timely appeal, or the requester's appeal is dismissed, and *no other appeal is pending in the proceeding*, the >prosecution of the reexamination< proceeding should be terminated by the issuance of a NIRC.

#### 2666.30 Submission Not Fully Responsive to Non-final Office Action [R-3]

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

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

A response by the patent owner will be considered not fully responsive to a non-final Office action where a *bona fide* response to an examiner's Office action is filed before the expiration of the permissible response period but through an apparent oversight or inadvertence, some point necessary to a full response has been omitted (i.e., appropriate consideration of a matter that the action raised, or compliance with some requirement, has been omitted). In this situation, >the prosecution of< the reexamination proceeding should not be terminated. Rather, the examiner may, pursuant to 37 CFR 1.957(d), treat the patent owner submission which is not fully responsive to an Office action by:

(A) waiving the deficiencies (if not serious) in the response and acting on the patent owner submission;

(B) treating the amendment/response as an incomplete response to the Office action and notifying the patent owner (via a written notification action pursuant to 37 CFR 1.957(d)) that the response must be completed within the period for response set in the notification action (or within any extension pursuant to 37 CFR 1.956)) to avoid \*>termination< of the prosecution (pursuant to 37 CFR 1.957(b)) or limiting prosecution of the claims to those found patentable (pursuant to 37 CFR 1.957(c)).

*Discussion of Option (A).* Where a patent owner submission responds to the rejections, objections, or requirements in an Office action and is a *bona fide* attempt to advance the reexamination proceeding to final action, but contains a minor deficiency (e.g., fails to treat every rejection, objection, or requirement), the examiner may simply act on the amendment and issue a new Office action. The new Office action may simply reiterate the rejection, objection, or requirement not addressed by the patent owner submission, or the action may indicate that such rejection, objection, or requirement is no longer applicable. In the new Office action, the examiner will identify the part of the previous Office action which was not responded to and clearly indicate what is needed. This course of action would not be appropriate in instances in which a patent owner submission contains a serious deficiency (e.g., the patent owner submission does not appear to have been filed in response to the Office action).

*Discussion of Option (B).* Where the patent owner's submission contains a serious deficiency, i.e., omission, to be dealt with prior to issuing an action on the merits and the period for response has expired, or there is insufficient time remaining to take corrective action before the expiration of the period for response, *the patent owner should be notified of the deficiency and the correction needed, and given a new time period for response (usually 1 month)* pursuant to 37 CFR 1.957(d). The patent owner must then supply the omission within the new time period for response or any extensions under 37 CFR 1.956 thereof to avoid \*>termination< of the prosecution (pursuant to 37 CFR 1.957(b)) or limiting prosecution of the claims to those found patentable (pursuant to 37 CFR 1.957(c)).

Form paragraph 26.06 may be used where option (B) is employed by the examiner to obtain correction of the deficiency.

\*\*>

¶ 26.06 *Submission Not Fully Responsive to Office Action*

The communication filed on [1] is not fully responsive to the prior Office action. [2]. The response appears to be *bona fide*, but through an apparent oversight or inadvertence, consideration of some matter or compliance with some requirement has been omitted. Patent owner is required to supply the omission or correction to thereby provide a full response to the prior Office action.

A shortened statutory period for response to this letter is set to expire (a) ONE MONTH, or THIRTY DAYS (whichever is longer), from the mailing date of this letter, or (b) after the due date for response to the last Office action, whichever of (a) or (b) is longer. THE PERIOD FOR RESPONSE SET IN THIS LETTER MAY BE EXTENDED UNDER 37 CFR 1.956.

If patent owner fails to timely supply the omission or correction and thereby provide a full response to the prior Office action, the consequences set forth in 37 CFR 1.957(b) or (c) will result. See MPEP § 2666.10.

**Examiner Note:**

1. In bracket 2, the examiner should explain the nature of the omitted point necessary to complete the response, i.e., what part of the Office action was not responded to. The examiner should also clearly indicate what is needed to correct the omission.
2. This paragraph may be used for a patent owner communication that is not completely responsive to the outstanding (i.e., prior) Office action. See MPEP § 2666.30.
3. This practice does not apply where there has been a deliberate omission of some necessary part of a complete response. See MPEP § 2666.30.

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**I. NO NOTIFICATION BY TELEPHONE**

It should be noted that the patent owner cannot simply be notified by telephone that the omission must be supplied within the remaining time period for response. This notification would be an interview, and interviews are prohibited in *inter partes* reexamination. 37 CFR 1.955.

**II. FURTHER DISCUSSION**

The practice of giving the patent owner a time period to supply an omission in a *bona fide* response (pursuant to 37 CFR 1.957(d)) does not apply where there has been a deliberate omission of some necessary part of a complete response. It is applicable **only** when the missing matter or lack of compliance is considered by the examiner as being “inadvertently omit-

ted” pursuant to 37 CFR 1.957(d). Once an inadvertent omission is brought to the attention of the patent owner, the question of inadvertence no longer exists. Therefore, a second written notification action giving another new (1 month) time period to supply the omission would not be appropriate. However, if the patent owner’s response to the notification of the omission raises a **different** issue of a different inadvertently omitted matter, a second written notification action may be given.

This practice authorizes, but does not require, an examiner to give the patent owner a new time period to supply an omission. Thus, where the examiner concludes that the patent owner is attempting to abuse the practice to obtain additional time for filing a response, the practice should not be followed.

#### **2666.40 Patent Owner Completion of Response and Third Party Comments Thereon [R-3]**

In most cases, the patent owner will have 30-days or one month (whichever is longer) to complete the response. After the owner completes the response, the examiner will wait two months from the date of service of the patent owner’s completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time.

The third party requester may file comments on the response as completed. This is true whether or not the third party requester filed comments on the response that was incomplete. The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to respond and has 30 days to do so.

In some instances, only a fee will be needed for the patent owner to complete the response. In these instances >(other than a failure to pay excess claims fees)<, any third party requester comments must be filed within 30 days from the date of service of the patent owner’s original response (which was indicated by the Office as incomplete due to the omission of the necessary fee). The third party requester is not permitted to file comments in response to the submission of the fee, because the submission of a fee clearly adds nothing on the merits. An example of this would be where a terminal disclaimer is newly required in a reexamination proceeding and is submitted, but the

fee is inadvertently omitted. The response would then be incomplete only as to the omitted fee. Any third party requester comments on the terminal disclaimer must be filed within 30 days from the date of service of the patent owner’s terminal disclaimer on the third party requester. Where the patent owner then completes the response by filing the fee, the third party requester is not permitted to then comment. However, if the patent owner’s response is not limited to the bare submission of the fee, i.e., if the response also includes argument, then the third party can comment since the patent owner has addressed the merits of the case.

>In those instances where there is a failure to pay an excess claims fee by the patent owner, the third party requester does not have the new claim “package” to comment on. Thus, the third party requester comments may be filed within 30 days from the date of service of the patent owner’s response correcting the excess claims fee deficiency.<

#### **2666.50 Examiner Issues Notice of Defective Paper in *Inter Partes* Reexamination [R-5]**

Even if the substance of a submission is complete, the submission can still be defective, i.e., an “informal submission.” Defects in the submission can be, for example:

- (A) The paper filed does not include proof of service;
- (B) The paper filed is unsigned;
- (C) The paper filed is signed by a person who is not of record;
- (D) The amendment filed by the patent owner does not comply with 37 CFR 1.530(d)-(j); or
- (E) The amendment filed by the patent owner does not comply with 37 CFR 1.20(c)(3) and/or (c)(4).

Where a submission made is defective (informal), form PTOL-2069 is used to provide notification of the defects present in the submission. Form PTOL-2069 is reproduced below. In many cases, it is only necessary to check the appropriate box on the form and fill in the blanks. However, if the defect denoted by one of the entries on form PTOL-2069 needs further clarification (such as the specifics of why the amendment does not comply with 37 CFR 1.530(d)-(j)), the

additional information should be set forth on a separate sheet of paper which is then attached to the form PTOL-2069.

The defects identified in (A) through (E) above are specifically included in form PTOL-2069. If the submission contains a defect other than those specifically included on the form, the "Other" box on the form is to be checked and the defect explained in the space provided for the explanation. For example, a response might be presented on easily erasable paper, and thus, a new submission would be needed.

Where both the patent owner response and the third party comments are defective, a first form PTOL-2069 should be completed for the patent owner (setting forth the defects in the patent owner response), and a second form PTOL-2069 completed for the third party requester (setting forth the defects in the third party requester's comments). A copy of both completed forms would then be sent to all parties.

A time period of one month or thirty days, whichever is longer, from the mailing date of the PTOL-2069 letter will be set in the letter for correcting the defect(s). The patent owner may request an extension of time to correct the defect(s) under 37 CFR 1.956.

The third party requester, however, is barred from requesting an extension of time by statute. 35 U.S.C. 314(b)(2). >If, in response to the notice, the defect still is not corrected, the submission will not be entered. If the failure to comply with the notice results in a patent owner failure to file a timely and appropriate response to any Office action, the prosecution of the reexamination proceeding generally will be terminated or limited under 37 CFR 1.957 (whichever is appropriate).<

If the defect in the patent owner response or the third party requester comments is limited to a problem with the signature, claim format, or some other obvious defect (easily corrected), and such is noted by the staff of the Office of Patent Legal Administration (OPLA) processing the papers, then the staff of OPLA may, in some instances, issue form PTOL-2069 to notify parties of the defect, and obtain a response to the form, prior to forwarding the case to the examiner. Otherwise, the responsibility is with the examiner to obtain the needed correction of the defects in the papers, which defects are either identified to the examiner by the staff of OPLA in an informal memo, or noted independently by the examiner.

<b>NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION</b>	<b>Control No.</b>	<b>Patent Under Reexamination</b>	
	<b>Examiner</b>	<b>Art Unit</b>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --**

1.  No proof of service is included with the paper filed by  owner  requester on \_\_\_\_\_. 37 CFR 1.248 and 1.903. Proof of service is required within a time period of 30-days or one month from the date of this letter, whichever is longer. Failure to serve the paper may result in the paper being refused consideration. If the failure to comply with this requirement results in a patent owner failure to file a timely and appropriate response to any Office action, the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case).
  
2.  The paper filed on \_\_\_\_\_ by the  owner  requester is unsigned. A duplicate paper or ratification, properly signed, is required within a time period of 30-days or one month from the date of this letter, whichever is longer. Failure to comply with this requirement will result in the paper not being considered. If the failure to comply results in a patent owner failure to file a timely and appropriate response to any Office action, the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case).
  
3.  The paper filed on \_\_\_\_\_ by the  owner  requester is signed by \_\_\_\_\_ who is not of record. A ratification or a new power of attorney with a ratification, or a duplicate paper signed by a person of record, is required within a time period of 30-days or one month from the date of this letter, whichever is longer. Failure to comply with this requirement will result in the paper not being considered. If the failure to comply results in a patent owner failure to file a timely and appropriate response to any Office action, the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case).
  
4.  The amendment filed by owner on \_\_\_\_\_, does not comply with 37 CFR 1.530. Patent owner is given a time period of 30-days or one month from the date of this letter, whichever is longer, to correct this informality, or the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case). The amendment will not be entered, although the argument therein will be considered as it applies to the proceeding without the amendment, should the prosecution be limited under 37 CFR 1.957(c).
  
5.  The amendment filed by owner on \_\_\_\_\_, does not comply with 37 CFR 1.20(c)(3) and/or 1.20(c)(4), as to excess claim fees. Patent owner is given a time period of 30-days or one month from the date of this letter, whichever is longer, to correct this fee deficiency, or the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case), to effect the "abandonment" set forth in 37 CFR 1.20(c)(5).
  
6.  Other: \_\_\_\_\_

**NOTE: PATENT OWNER EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.956. NO EXTENSION OF TIME IS PERMITTED FOR THIRD PARTY REQUESTER. 35 U.S.C. § 314(b)(2).**

**All correspondence** relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

### 2666.60 Response by Patent Owner/ Third Party to Notice of Defective Paper [R-3]

The patent owner and/or the third party requester will be given a time period of **>one month or thirty days, whichever is longer,** from the mailing date of the notice of defective paper or the time remaining in the response/comments period set in the last Office action to correct the defect in a submission. If, in response to the notice, the defect still is not corrected, the submission will not be entered. **>If the failure to comply with the notice results in a patent owner failure to file a timely and appropriate response to any Office action, the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate for the case).**

After the patent owner or the third party requester has provided a submission directed solely to correcting the defect, the other party is not permitted to comment on the submission correcting the defect, since the submission correcting the defect is directed to form and does not go to the merits of the case. This would be the case, for example, where the failure to provide a signature or a certificate of service is corrected, or where a permanent copy is submitted to replace an “easily erasable” paper that was originally submitted.

In the case of correcting a defective amendment, however, other issues come into play. Where for example, new claims 10-20 are improperly presented in a patent owner response (e.g., not properly underlined), they generally will not be entered and form PTOL-2069 (Box 4) will be used to notify the patent owner of the need to correct this defect. Until the defect is corrected, claims 10-20 do not yet exist in the proceeding for the third party requester to comment on. Likewise, any argument that was directed to such claims is not truly ripe for the third party requester comment. After the patent owner corrects the defect, claims 10-20 come into existence in the proceeding, and the argument presented by the patent owner becomes relevant. At this point, the third party requester has a right to provide comments in response to the patent owner’s argument, whether or not the argument that was included in the original patent owner submission is re-presented with the paper cor-

recting the defect. Thus, any third party requester comments submitted either in response to the patent owner’s initial paper (presenting the informal claims) or in response to the patent owner’s supplemental paper (correcting the informality) will be considered by the examiner.

Any submission correcting the defect which provides a discussion of the merits should (A) set forth that discussion separately from the portion of the response that corrects the defect, and (B) clearly identify the additional discussion as going to the merits. The additional discussion going to the merits must, in and of itself, have an entry right, or the entire submission will be returned to the party that submitted it, and **one** additional opportunity (30-days or one month, whichever is longer) will be provided, to correct the defect without a discussion of the merits. If the portion directed to the merits is not clearly delineated and identified, the entire submission may be returned to the party that submitted it, and **one** additional opportunity (30-days or one month, whichever is longer) is then given for that party to correct the defect without intermixed discussion of the merits. The examiner may, however, choose to permit entry of such a paper.

### 2667 Handling of Inappropriate or Untimely Filed Papers [R-7]

*37 CFR 1.939. Unauthorized papers in inter partes reexamination.*

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

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

The applicable regulations (such as 37 CFR 1.501, 1.902 and 1.905, 1.948 and 1.939) provide that certain types of correspondence will not be considered. Whenever reexamination correspondence is received, a decision is required of the Office as to the action to be taken on the correspondence based on what type of paper it is and whether it is timely. In certain instances, the submitted correspondence (submission) will be entered into the reexamination file and be considered. In other instances, the correspondence will be entered into the reexamination file, but will not be considered. In still other instances,

the correspondence will not be entered into the reexamination file and will be returned to the party that sent it. The return of certain inappropriate submissions, not being considered, reduces the amount of paper which would ultimately have to be scanned into the record. >Where an inappropriate (unauthorized, improper) paper has already been scanned into the Image File Wrapper (IFW) of the reexamination proceeding before discovery of the inappropriate nature of the paper, the paper cannot be physically returned to the party that submitted it. Instead, the paper will be “returned” by expunging it, i.e., by marking the paper as “non-public” and “closed” so that the paper does not appear in the active IFW record with the other active papers that comprise the public record of the reexamination proceeding.<

Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or be forwarded to one of three places: the reexamination file (paper file or IFW file history); the patent file (paper file or IFW file history); or the storage area (paper file). Any papers returned to the sender must be accompanied by a letter as to the return. The letter is prepared by the Central Reexamination Unit (CRU) Director (or in some instances, by the Office of Patent Legal Administration (OPLA)) and is forwarded to the CRU support staff for mailing. The original of the letter returning the paper will be retained in the file and given a paper number.

## **I. TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED**

### **A. Filed by Patent Owner**

#### **1. Premature Response/Comments by Patent Owner**

Any response/comments as to materials of record or any amendment filed by the patent owner prior to the first Office action is premature and will be returned and will not be considered. 37 CFR 1.939. Where a paper is to be returned based on the above reason, and the paper is not accompanied by a petition under 37 CFR 1.182 or 1.183, the CRU Director or the Reexamination Legal Advisor (RLA) will return the paper. Where the submission is accompanied by a

petition under 37 CFR 1.182 or 1.183, the reexamination proceeding should be addressed in the OPLA, to issue a decision on the petition.

Any petition requesting merger of a reexamination with a reexamination or reissue, or a stay of a reexamination or reissue in place of merger, that is filed prior the order to reexamine (37 CFR 1.931) will be returned and will not be considered. See MPEP § 2686.01 and § 2686.03. The reexamination proceeding should be addressed in the OPLA, to issue a decision on the petition.

## **2. Response Is Too Long**

Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options:

(A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or

(B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.

The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper patent owner submission will not be considered. If the submission was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding is either terminated pursuant to 37 CFR 1.957(b) or limited pursuant to 37 CFR 1.957(c). Any previously submitted third party comments in response to this improper patent owner submission would also not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules.

If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner’s response to the Notice, within 30 days from the date of service of the patent owner’s response to the Notice.

>With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the pro-

visions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.<

### **3. Improper Patent Owner Response**

The patent owner can only file once under 37 CFR 1.951(a). Any second or supplemental submission after ACP by the patent owner will be returned, unless prosecution has been reopened. See MPEP § 2672.

Where a paper is to be returned based on the above reason or other appropriate reasons, and the paper is not accompanied by a petition under 37 CFR 1.182 or 1.183, the CRU Director or the RLA will return the paper. Where a petition under 37 CFR 1.182 or 1.183

has been filed, the reexamination proceeding should be addressed in the OPLA, to issue a decision on the petition.

### **B. Filed by Third Party Requester**

#### **1. Premature Comments by Third Party Requester**

Any comments filed by a third party requester subsequent to the request for reexamination (i.e., not part of it) and prior to the first Office action is premature, and it will be returned and will not be considered. 37 CFR 1.939. Any petition to stay a reexamination proceeding because of an interference (MPEP § 2686.02), which is filed prior to the first Office action in the reexamination proceeding will be returned and will not be considered.

Any submission of comments filed by a third party requester where the patent owner has not responded to the outstanding Office action is premature, and it will be returned and will not be considered. 37 CFR 1.947.

Where a paper is to be returned based on the above reason, and the paper is not accompanied by a petition under 37 CFR 1.182 or 1.183, the CRU Director or the RLA will return the paper. Where the premature submission is accompanied by a petition under 37 CFR 1.182 or 1.183, the reexamination proceeding should be addressed in the OPLA, to issue a decision on the petition.

#### **2. Response Is Too Long**

Where the length of the third party requester submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, a Notice will be issued by the examiner and mailed to the third party requester permitting the third party requester to exercise one of the following two options:

(A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or

(B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.

The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper third party requester submission will not be considered.



>For additional information with respect to the length of the papers, see subsection I.A.2. above.<

### 3. Improper Comments

Where the third party requester comments are not limited to the scope provided by the rules, they are improper and will be returned by the examiner (or the Reexamination Legal Advisor) and will not be considered. 37 CFR 1.947 and 1.951(b). For example, comments following the patent owner's response to a first Office action must be limited to issues and/or points covered by the first action and/or the patent owner's response (in accordance with 37 CFR 1.947); if they are not, they will be returned. See MPEP § 2666.05 for action to be taken by the examiner.

For any third party requester comments containing a submission of prior art, the prior art must be limited solely to prior art which is necessary to rebut a finding of fact by the examiner, which is necessary to rebut a response of the patent owner, or, which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination. Prior art submitted for the reason that it became known or available to the third party requester for the first time after the filing of the request for *inter partes* reexamination must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim. If the prior art submission does not satisfy at least one of the criteria noted above, the comments are improper and will be returned and will not be considered. See MPEP § 2666.05 for action to be taken by the examiner.

Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed. Such supplemental comments are improper, will not be considered, and will be returned. However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response. Supplemental third party comments are also permitted in response to a supplemental patent owner response.

The third party requester can only respond to a patent owner submission after an Action Closing

Prosecution (ACP), and may only do so once under 37 CFR 1.951(b). Any original third party requester comments (where the patent owner does not respond) or any second or supplemental responsive comments after ACP are improper and will be returned. See MPEP § 2672.

Third party comments in response to a patent owner submission which does not respond to an Office action are not permitted, since 37 CFR 1.947 only permits comments in response to the patent owner's response to an Office action. For example, where the patent owner submits a new power of attorney, the third party requester is not permitted to submit a set of comments, because the patent owner submission is not a response to an Office action. If the third party requester does comment, it will be returned.

### 4. Improper Petition

Any petition to stay a reexamination proceeding because of an interference (MPEP § 2686.02), which is filed prior to the first Office action in the reexamination proceeding will be returned and will not be considered. 37 CFR 1.939.

Any petition by a third party requester to stay a reexamination proceeding because of an interference where the third party is not a party to the interference will be returned and will not be considered. See MPEP § 2686.02.

Any petition requesting merger of a reexamination with a reexamination or reissue, or a stay of a reexamination or reissue in place of merger, that is filed prior to the order to reexamine (37 CFR 1.931) will be returned and will not be considered. See MPEP § 2686.01 and § 2686.03. Note, also, that a petition by the third party requester requesting that a later-filed case should not be merged (see MPEP § 2640 "Second Or Subsequent Request...") will be returned and will not be considered, where it is filed prior to the order to reexamine. Prior to the order, such a petition is not ripe for decision because it is possible that reexamination will not be granted and there will be nothing to merge.

In all these situations, the reexamination proceeding should be addressed in the OPLA, to issue a decision on the petition.

>Note that after an opposition to any patent owner petition is filed by a third party requester (regardless of whether such opposition has an entry right or not),

any further paper in opposition/rebuttal/response to the third party opposition paper will not be considered and will be returned. There must be a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. Likewise, after an opposition to any requester petition is filed by the patent owner (regardless of whether such opposition has an entry right or not), any further paper in opposition/rebuttal/response to the patent owner opposition paper will not be considered and will be returned. There must be a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. Further, any petition requesting that an extension of time be denied will be returned, since a requester does not have a statutory right to challenge this discretionary procedural process in the reexamination proceeding; whether or not the time is extended clearly does not go to the merits of the reexamination proceeding. The same would apply to oppositions as to petitions for revival of a terminated prosecution, petitions challenging the finality of an Office action, and the like.<

**C. Filed by Third Party Other Than Third Party Requester**

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 37 CFR 1.915 or are one of the exceptions noted below. Thus, a petition to merge a reexamination, or stay one of them because of the other, which is filed by a party other than the patent owner or the third party requester of reexamination will not be considered, but will be returned to that party as being improper under 37 CFR 1.905. See also MPEP § 2686.01 and MPEP § 2686.03.

A paper submitted by a third party other than a third party requester must be (1) a 37 CFR 1.501 art citation limited to the citation of patents and printed publications and an explanation of the pertinency and applicability of the patents and printed publications, or (2) bare notice of suits and other proceedings involving the patent (see MPEP § 2686 and § 2686.04) which may include copies of decisions or other court papers, or papers filed in the court, from litigations or other proceedings involving the patent. Such submissions must be without additional comment and cannot include further arguments or infor-

mation. If the submission by the third party is not one of the above-described two types of papers, it will be returned to an identified third party or destroyed if the submitter is unidentified. If a submission by the third party of either of the above-described two types of papers contains additional material that goes beyond the scope of what is permitted, the paper will be returned to an identified third party, or destroyed if the third party submitter is unidentified. If a proper 37 CFR 1.501 submission is filed by a third party after the order to reexamine, it will be stored in the storage area-see below.

**II. TYPES OF DEFECTIVE PAPERS TO BE LOCATED IN THE “REEXAMINATION FILE”**

**A. Filed by Patent Owner**

**1. Unsigned Papers**

Papers filed by the patent owner which are unsigned, or signed by less than all of the patent owners where no attorney or agent is of record or acting in representative capacity, will be denied consideration, but will be retained in the file. 37 CFR 1.33.

**2. No Proof of Service**

Papers filed by the patent owner in which no proof of service is included, and proof of service is required, may be denied consideration. Such papers should be denied consideration where it cannot be determined that service was in fact made and the third party requester’s response/comment/appeal/brief period is to be set by the date of service. See 37 CFR 1.248 and MPEP § 2666.06.

**3. Late Papers**

Where patent owner has filed a paper which was filed after the period for response set by the Office, the paper will be retained in the file but will not be considered.

A patent owner submission following a third party requester submission, where the patent owner submission is filed subsequent to the permitted time from the date of service of third party requester’s submission, will be retained in the file but will not be considered. The date that the Office actually receives the third party requester’s submission has no bearing here; it is

the date of service on the patent owner which is critical.

#### 4. Defective Amendment

A proposed amendment to the description and claims which does not comply with 37 CFR 1.530(d)-(k) will be retained in the file, but the amendment will not be considered. An exception to this is where the only defect in the amendment is that it enlarges the scope of the claims of the patent or introduces new matter. Such an amendment *will be considered*, and a rejection will be made in the next Office action.

#### 5. Premature Appeal

Where a notice of appeal or notice of cross appeal is filed before a Right of Appeal Notice (RAN) has been issued, the paper will be retained in the file but will not be considered (other than to inform the parties that the appeal is not acceptable).

#### B. Filed by Third Party Requester

##### 1. Unsigned Papers

Papers filed by a third party requester which are unsigned or not signed by the third party requester or requester's attorney/agent of record or attorney/agent acting in representative capacity will be denied consideration. 37 CFR 1.33.

##### 2. No Proof of Service

Papers filed by a third party requester in which no proof of service is included as to the patent owner and/or any other third party requester, and proof of service is required, may be denied consideration. Such papers should be denied consideration where it cannot be determined that service was in fact made and another party's response/comment/appeal/brief period is to be set by the date of service. 37 CFR 1.248.

##### 3. Late Papers

Any third party requester submission following a patent owner's submission, where the third party requester submission is filed subsequent to the permitted time from the date of service of the patent owner's submission, will be retained in the file, but will not be considered. Note, for example, a 37 CFR 1.947 submission of third party comments following the patent owner's response. Where the third party

comments are submitted subsequent to 30 days from the date of service of the patent owner's response, they will be retained in the file but will not be considered. The date that the Office actually receives the patent owner's response has no bearing here; it is the date of service on the third party requester which is critical.

Where the third party requester has filed a paper which is untimely, that is, it was filed after the period set by the Office for response, the paper will be retained in the file, but will not be considered.

>Thus, for example, in instances where there is a right to file an opposition to a petition, any such opposition must be filed within two weeks of the date upon which a copy of the original petition was served on the opposing party, to ensure consideration. Any such opposition that is filed after the two-week period will remain in the record, even though it is not considered.<

#### 4. Premature Appeal

Where a notice of appeal or notice of cross appeal is filed before a Right of Appeal Notice (RAN) has been issued, the paper will be retained in the file, but will not be considered (other than to inform the parties that the appeal is not acceptable). 37 CFR 41.61.

### III. PAPERS LOCATED IN THE "STORAGE AREA"

A storage area for submissions of art citations in an *inter partes* reexamination will be maintained separate and apart from the reexamination and patent files, and at a location in the CRU.

Submission of art citations in an *inter partes* reexamination is permitted by the patent owner and the third party requester to the extent stated in the regulations. 37 CFR 1.501 and 1.902. All other submissions of art citations based solely on prior patents or publications filed after the date of the order to reexamine are retained in the storage area. Such citations are not entered into the patent file, but rather are delayed until the reexamination proceedings have been concluded. See MPEP § 2602. (Proper timely filed submissions of art citations made prior to the order to reexamine are placed in the reexamination file.)

## 2668 Petition for Entry of Late Papers for Revival of Reexamination Proceeding [R-7]

35 U.S.C. 41. Patent fees; patent and trademark search systems.

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(7) On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$110.

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35 U.S.C. 133. Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.137. Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

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

(1) The reply required to the outstanding Office action or notice, unless previously filed;

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

(3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

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

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Direc-

tor may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

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(e) *Request for reconsideration*. Any request for reconsideration or review of a decision refusing to revive an abandoned application, a terminated or limited reexamination prosecution, or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under:

(1) The provisions of § 1.136 for an abandoned application or lapsed patent;

(2) The provisions of § 1.550(c) for a terminated *ex parte* reexamination prosecution, where the *ex parte* reexamination was filed under § 1.510; or

(3) The provisions of § 1.956 for a terminated *inter partes* reexamination prosecution or an *inter partes* reexamination limited as to further prosecution, where the *inter partes* reexamination was filed under § 1.913.<

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If the patent owner in an *inter partes* reexamination proceeding fails to file a timely and appropriate response to any Office action and no claims are allowable, then pursuant to 37 CFR 1.957(b), the prosecution of the reexamination proceeding is terminated, and a certificate under 37 CFR 1.997 is issued canceling all claims of the patent.

An *inter partes* reexamination prosecution terminated under 37 CFR 1.957(b) can be revived if the delay in response by the patent owner was unavoidable in accordance with 37 CFR 1.137(a), or unintentional in accordance with 37 CFR 1.137(b).

If the patent owner in an *inter partes* reexamination proceeding fails to file a timely and appropriate response to any Office action and at least one claim is allowable, then pursuant to 37 CFR 1.957(c), the proceeding continues but is limited to the claim(s) found allowable at the time of the failure to respond (i.e., in the Office action).

Rejected claims terminated under 37 CFR 1.957(c) can be revived if the delay in response by the patent owner was unavoidable in accordance with 37 CFR 1.137(a), or unintentional in accordance with 37 CFR 1.137(b).

All petitions in reexamination proceedings to accept late papers and revive will be decided in the Office of Patent Legal Administration (OPLA).

## I. PETITION BASED ON UNAVOIDABLE DELAY

The unavoidable delay provisions of 35 U.S.C. 133 are imported into, and are applicable to, reexamination proceedings by 35 U.S.C. 305 and 314. See *In re Katrapat*, 6 USPQ2d 1863 (Comm'r Pat. 1988). Accordingly, the Office will consider, in appropriate circumstances, a petition showing unavoidable delay under 37 CFR 1.137(a) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide an adequate showing of the cause of unavoidable delay, including the details of the circumstances surrounding the unavoidable delay and evidence to support the showing. Additionally, the petition must be accompanied by a proposed response to continue prosecution (unless it has been previously filed) and by the petition fee required by 37 CFR 1.17(l).

## II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

## III. RENEWED PETITION

Reconsideration may be requested of a decision dismissing or denying a petition under 37 CFR 1.137(a) or (b) to revive a terminated reexamination prosecution. The request for reconsideration must be submitted within one (1) month from the mail date of the decision for which reconsideration is requested. An extension of time may be requested only under 37 CFR 1.956; extensions of time under 37 CFR 1.136 are not available in reexamination proceedings. Any reconsideration request which is submitted should include a cover letter entitled "Renewed Peti-

tion under 37 CFR 1.137(a)" (for an "unavoidable" petition) or "Renewed Petition under 37 CFR 1.137(b)" (for an "unintentional" petition).

## IV. PETITION REQUIREMENTS

See also MPEP § 711.03(c), \*sub>section< III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and 37 CFR 1.137(b).

### 2670 Clerical Handling [R-7]

Central Reexamination Unit (CRU) support staff, will carry out clerical handling and processing of *inter partes* reexamination cases. The clerical staff will perform all PALM matters needed for the case, e.g., PALMing in the file and PALMing it to the examiner. After the examiner has completed a decision on the request for *inter partes* reexamination and/or an Office action, the clerical staff will make a copy of the decision and/or Office action for the patent owner and for the third party requester(s). The clerical staff will also make copies of any references which are needed. A transmittal form PTOL-2070 with the third party requester's address will be completed. The clerical staff will coordinate its activities with those of the examiner and the \*\*>CRU Supervisory Patent Examiners (SPEs) or Technology Center (TC) Quality Assurance Specialists (QASs) and the< paralegals.

Amendments in an *inter partes* reexamination proceeding (which comply with 37 CFR 1.941) are entered by the CRU clerical staff.

See MPEP § 2234 and § 2250 for manner of entering amendments.

For entry of amendments in a merged *inter partes* reexamination proceeding (i.e., an *inter partes* reexamination proceeding merged with another reexamination proceeding or with a reissue application), see MPEP § 2686.01 and § 2686.03.

Where an amendment is submitted in proper form and it is otherwise appropriate to enter the amendment, the amendment will be entered for purposes of the reexamination proceeding, even though the amendment does not have legal effect until the certificate is issued. Any "new matter" amendment to the disclosure (35 U.S.C. 132) will be required to be canceled, and claims containing new matter will be rejected under 35 U.S.C. 112. A "new matter" amendment to the drawing is ordinarily not entered. See MPEP § 608.04, § 608.04(a) and § 608.04(c). Where

an amendment enlarges the scope of the claims of the patent, the claims will be rejected under 35 U.S.C. 314(a).

## 2671 Examiner Action Following Response/Comments or Expiration of Time for Same [R-7]

### I. RECONSIDERATION

After response by the patent owner and any third party comments, the patent under reexamination will be reconsidered. The patent owner and the third party requester will be notified as to any claims rejected, any claims found patentable and any objections or requirements made. The patent owner may respond to such Office action with or without amendment, and the third party requester may provide comments after the patent owner's response. If the patent owner response contains an amendment, the examiner will consider the amendment to determine whether the amendment raises issues of 35 U.S.C. 112 and/or broadening of the claims under 35 U.S.C. 314. The patent under reexamination will be reconsidered until the proceeding is ready for closing prosecution, at which point the examiner will issue an Action Closing Prosecution (ACP). See MPEP § 2671.02.

### II. CASE IS TAKEN UP FOR ACTION

The case should be acted on promptly, in accordance with the statutory requirement for "special dispatch within the Office" (35 U.S.C. 314(c)).

After the examiner receives the case file (having the patent owner's response to the Office action and any third party requester comments on that response), he/she will prepare for a pre-action consultation conference with a Reexamination Legal Adviser (RLA). At the consultation conference, the RLA will provide instructions as to preparation of the Office action addressing the patent owner's response and any third party requester comments on that response. The consultation should be completed within two (2) weeks of when the case was initially forwarded to the examiner.

After the consultation conference, the examiner will promptly take up the case for action. The examiner will prepare an Office action no later than two weeks from the date of the consultation conference (unless otherwise authorized by the Central Reexamination Unit (CRU) Director or a RLA of the Office of

the Patent Legal Administration (OPLA)). The case, with the completed action, will be forwarded to the \*->CRU Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS)< for review. If the \*->CRU SPE/TC QAS< returns the case to the examiner for correction/revision, the correction/revision must be handled expeditiously and returned to the \*->CRU SPE/TC QAS< within the time set for such by the \*->CRU SPE/TC QAS<.

### III. OPTIONS AS TO OFFICE ACTION TO ISSUE

*At this point in the proceeding, the examiner will have the following options as to the next Office action to issue:*

(A) There is **no** timely response by the patent owner (since the patent owner did not respond, no third party requester comments may be filed):

(1) If **all** claims are under rejection, the examiner will issue a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC). See MPEP § 2687. All claims will be canceled by formal examiner's amendment (attached as part of the NIRC).

(2) If at least one claim is free of rejection and objection, the examiner will issue an Action Closing Prosecution (ACP). In the ACP, it will be stated that any claims under rejection or objection are withdrawn from consideration and will be canceled upon issuance of a NIRC. It will further be stated that the proceeding will be limited to the claims found patentable at the time of the failure to respond, and to claims (added or amended) which do not expand the scope of the claims found patentable at that time. See MPEP § 2666.10.

It should be noted that even in a situation where there has been no patent owner response, the examiner is always free to issue a supplemental Office action providing a new rejection of claims **previously found patentable**, where new information comes to the attention of the examiner warranting the new rejection. Of course, such an action would ordinarily not be made an ACP.

(B) There is a timely response by the patent owner, and the third party requester does **not** timely provide comments:

(1) If the response by the patent owner is incomplete, the examiner may issue an incomplete-response action. See MPEP § 2666.30.

(2) If there is a formality defect in the response by the patent owner, the examiner will issue a Notice of Defective Paper in Reexam. See MPEP § 2666.50.

(3) If the patent owner's response is complete and defect-free, and the proceeding is ready for closing prosecution, the examiner will issue an ACP. See MPEP § 2671.02. This is true if all claims are determined to be patentable, all claims are determined to be rejected, or if some claims are determined to be patentable and some claims are determined to be rejected. After the ACP has been issued, the patent owner can submit comments with or without a proposed amendment in accordance with MPEP § 2672, and the third party requester can then file comments responsive to the patent owner's submission.

(4) If the patent owner's response is complete and defect-free, and the proceeding is **not** ready for closing prosecution, the examiner will issue a new office action that does not close prosecution. See MPEP § 2671.01.

(C) There is a timely response by the patent owner, and the third party requester does provide timely comments:

(1) If the response by the patent owner is incomplete, the examiner may issue an incomplete-response action. See MPEP § 2666.30.

(2) If the comments by third party requester go beyond the scope of what is permitted for the third party comments, the examiner will follow the procedures set forth in MPEP § 2666.05 for improper comments.

(3) If there is a formality defect in the response by the patent owner, the examiner will issue a Notice of Defective Paper in Reexam. See MPEP § 2666.50.

(4) If there is a formality defect in the comments by the third party requester, the examiner will issue a Notice of Defective Paper in Reexam. See MPEP § 2666.50.

(5) If the response and comments are in order, and the proceeding is ready for closing prosecution, the examiner will issue an ACP. See MPEP § 2671.02. This is true if all claims are determined to be patentable, all claims are determined to be rejected, or if some claims are determined to be patentable and

some claims are determined to be rejected. After the ACP has been issued, the patent owner can submit comments with or without a proposed amendment in accordance with MPEP § 2672 and the third party requester can then file comments responsive to the patent owner's submission.

(6) If the response and comments are in order and the proceeding is **not** ready for closing prosecution, the examiner will issue a new office action that does not close prosecution. See MPEP § 2671.01.

(D) There is a timely request for issuance of an Expedited Right of Appeal Notice:

37 CFR 1.953(b) provides for the issuance of an expedited Right of Appeal Notice (RAN), where the criteria for the same is satisfied. At any time after the patent owner's response to the first Office action on the merits in an *inter partes* reexamination, the patent owner and third party requester(s) may request the immediate issuance of a RAN. Where such a request is presented in the proceeding, see MPEP § 2673.02 for guidance as to whether an expedited Right of Appeal Notice will be issued.

## **2671.01 Examiner Issues Action on Merits That Does Not Close Prosecution [R-7]**

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

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

### **I. WHEN A NON-ACP ACTION IS ISSUED**

After reviewing the patent owner's response and third party requester comments (if such comments are filed), the examiner may determine that the proceeding is not ready for issuing an Action Closing Prosecution (ACP). Such a determination would be based upon the following:

(A) In accordance with 37 CFR 1.949, 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. The examiner will not close prosecution where a new ground of rejection not necessitated by an amendment is made, because the patent owner's right to amend the claims becomes limited after prosecution is closed.

(B) Where an ACP would be proper, but the examiner feels that the issues are not yet clearly defined, it is always within the discretion of the examiner to issue an Office action that does not close prosecution (rather than an ACP).

## II. OVERALL CONTENT

Where the examiner determines that the proceeding is not ready for issuing an ACP, the examiner will issue an Office action that will be similar in form to a first Office action, but will differ in that it addresses the positions and argument set forth in the patent owner's response and the third party requester comments (if such comments are filed). This Office action will be a statement of the examiner's position, so complete that the next Office action can properly be made an action closing prosecution.

The action should be comprehensive. It should address all issues as to the patents or printed publications. The action will clearly set forth each ground of rejection and/or ground of objection, and the reasons supporting the ground(s). The action will also clearly set forth each rejection proposed by the third party requester that the examiner refuses to adopt. Reasons why the rejection proposed by the third party is not appropriate (i.e., why the claim cannot be rejected under the ground proposed by the third party requester) must be clearly stated for each rejection proposed by the third party requester that the examiner refuses to adopt. Comprehensive reasons for patentability must be given for each determination favorable to patentability of claims. See MPEP § 1302.14 for examples of suitable statements of reasons for allowance.

## III. REVIEW OF AMENDATORY MATTER UNDER 35 U.S.C. 112

Where an amendment has been submitted in the patent owner's response, the amendatory matter (i.e.,

matter revised or newly added) should be reviewed for compliance with 35 U.S.C. 112. As to the content of the patent that has not been revised, a review based upon 35 U.S.C. 112 is not proper in reexamination, and no such review should be made.

## IV. WITHDRAWAL OF REJECTION

Where the examiner withdraws a ground of rejection originally initiated by the examiner, such withdrawal should be clearly stated in the Office action as a decision favorable to patentability with respect to the withdrawn rejection. The third party requester's next set of comments that may be filed (after a patent owner response to an action) may propose the withdrawn rejection as a "rejection proposed by the third party requester." In the event the patent owner fails to respond to all actions leading to the Right of Appeal Notice (RAN), including the ACP, and a RAN is then issued, the third party requester may appeal this withdrawal of rejection as a final decision favorable to patentability - see 37 CFR 41.61(a)(2).

Where the claims have not been amended and the examiner withdraws a ground of rejection previously proposed by the third party requester (e.g., based on the patent owner's argument or evidence submitted), the examiner should treat the issue as a rejection proposed by the third party requester that the examiner refuses to adopt.

Generally (subject to the below-stated exception), where the claims have been amended and the examiner withdraws a ground of rejection previously proposed by the third party requester, this is not a refusal of the examiner to adopt the rejection that was proposed by the requester, since the rejection was never proposed as to the amended claims. The third party requester's next set of comments that may be filed (after a patent owner response to an action) may propose the withdrawn rejection as a "rejection proposed by the third party requester" as to the amended claims. In the event the patent owner fails to respond to all actions leading to the RAN, including the ACP, and a RAN is then issued, the third party requester may appeal this withdrawal of rejection as a final decision favorable to patentability. See 37 CFR 41.61(a)(2).

If a claim is amended merely to include a dependent claim that was previously subjected to a proposed requester rejection, and the examiner withdraws that ground of rejection as to the newly



amended claim, such would be a refusal to adopt the third party requester's previously proposed rejection of the dependent claim. Thus, the examiner would treat the issue as a rejection proposed by the third party requester that the examiner refuses to adopt.

## V. ISSUES NOT WITHIN SCOPE OF REEXAMINATION

If questions not within the scope of reexamination proceedings (for example, questions of patentability based on public use or on sale, \*conduct issues<, abandonment under 35 U.S.C. 102(c)) have been **newly** raised by the **patent owner response** or the **third party requester comments** being addressed by the present Office action, the existence of such questions will be noted by the examiner in the Office action, using form paragraph 26.03.

\*\*>

### ¶ 26.03 Issue Not Within Scope of Inter Partes Reexamination

It is noted that an issue not within the scope of reexamination proceedings has been raised. [1].The issue will not be considered in a reexamination proceeding. 37 CFR 1.906(c). While this issue is not within the scope of reexamination, the patentee is advised that it may be desirable to consider filing a reissue application provided that the patentee believes one or more claims to be partially or wholly inoperative or invalid.

#### Examiner Note:

1. In bracket 1, identify the issues.
2. This paragraph may be used either when the patent owner or the third party requester raises issues such as (but not limited to) public use or on sale, conduct, or abandonment of the invention. Such issues should not be raised independently by the patent examiner.

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Note that if questions of patentability based on public use or on sale, \*conduct issues<, abandonment under 35 U.S.C. 102(c), etc., have been independently discovered by the examiner during a reexamination proceeding but were not raised by the third party requester or the patent owner, the existence of such questions will not be noted by the examiner in any Office action, because 37 CFR 1.906(c) is only directed to such questions "raised by the patent owner or the third party requester."

## VI. COVER SHEET

Form PTOL-2064 should be used as the Office action cover sheet. Since the Office action is responsive to a patent owner response, and possibly the third party requester comments, the space on the PTOL-2064 for the date of the communication(s) to which the Office action is responsive to should be filled in. Generally, the patent owner is given two months to respond to the action, and thus "Two" should be inserted in the appropriate space.

## VII. SIGNATORY AUTHORITY

As with all other Office correspondence on the merits in a reexamination proceeding, the action must be signed by a primary examiner.

## VIII. CONCLUDING PARAGRAPHS

In view of the requirement for "special dispatch" in *inter partes* reexamination proceedings (35 U.S.C. 314(c)), it is intended that the examiner be able to close prosecution at the earliest possible time. Accordingly, the Office action should include a statement cautioning the patent owner that a complete response should be made to the action, since the next action is expected to be an ACP. The action should further caution the patent owner that the requirements of 37 CFR 1.116(b) will be strictly enforced after an ACP and that any amendment after an ACP must include "a showing of good and sufficient reasons why they are necessary and were not earlier presented" in order to be considered. Form paragraph 26.05 should be inserted at the end of the Office action followed by form paragraph 26.73.

### ¶ 26.05 Papers To Be Submitted in Response to Action

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be an Action Closing Prosecution (ACP), will be governed by 37 CFR 1.116(b) and (d), which will be strictly enforced.

### ¶ 26.73 Correspondence and Inquiry as to Office Actions

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

## IX. PANEL REVIEW CONFERENCE

After an examiner has determined that the reexamination proceeding is ready for the Office action, the examiner will formulate a draft preliminary Office action. The examiner will then inform his/her Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS) of his/her intent to issue the Office action. The CRU SPE/TC QAS will convene a panel review conference, and the conference members will review the patentability of the claim(s) pursuant to MPEP § 2671.03. If the conference confirms the examiner's preliminary decision to reject and/or allow the claims, the proposed Office action shall be issued and signed by the examiner, with the two other conferees initialing the action (as "conferee") to indicate their presence in the conference. If the conference does not confirm the examiner's treatment of the claims, the examiner will reevaluate and issue an appropriate Office action.

## X. NO RESPONSE BY PATENT OWNER

Where the patent owner fails to timely respond to an action requiring a response and there are no patentable claims, a Notice of Intent to Issue *Inter Parte* Reexamination Certificate (NIRC) will be issued as the action that does not close prosecution. No panel review conference is needed in this instance, as the issuance of the NIRC is essentially ministerial.

### 2671.02 Examiner Issues Action Closing Prosecution (ACP) [R-7]

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

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the exam-

iner 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.

Although an Action Closing Prosecution (ACP) has many attributes similar to a "final rejection" made in an *ex parte* reexamination proceeding or in a non-provisional application, it is not a final action, and, as such, **it cannot be appealed from**. An appeal can only be taken after the examiner issues a Right of Appeal Notice (RAN). See MPEP § 2673.02.

Before an ACP is in order, a clear issue should be developed. When all claims are found patentable in the first action, the examiner will, at that point, issue an ACP, since the patent owner has nothing to respond to. Otherwise, it is intended that the second Office action in the reexamination proceeding will ordinarily be an ACP. The criteria for issuing an ACP is analogous to that set forth in MPEP § 706.07(a) for making a rejection final in an application.

All parties to the reexamination should recognize that a reexamination proceeding may result in the final cancellation of claims from the patent **and** that the patent owner does not have the right to continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114, and the patent owner cannot file an *inter partes* reexamination request (see MPEP § 2612). Complete and thorough actions by the examiner, coupled with complete responses by the patent owner and complete comments by the third party requester (including early presentation of evidence under 37 CFR 1.131 or 1.132) will go far in reaching a desirable early termination of the prosecution of the reexamination proceeding.

In making an ACP (A) all outstanding grounds of rejection of record should be carefully reviewed, (B) all outstanding determinations of patentability (decisions to not make a proposed rejection) of record should be carefully reviewed, and (C) any grounds of rejection relied upon and any determinations of patentability relied upon should be reiterated.

## I. CONTENT

The grounds of rejection and determinations of patentability must (in the ACP) be clearly developed to such an extent that the patent owner and the third party requester may readily judge the advisability of filing comments after an ACP pursuant to 37 CFR 1.951(a) and (b), respectively.

The ACP should address all issues as to the patents or printed publications. The ACP will clearly set forth each rejection proposed by the third party requester that the examiner refuses to adopt. Reasons why the rejection proposed by the third party requester is not appropriate (i.e., why the claim cannot be rejected under the ground proposed by the third party requester) must be clearly stated for each rejection proposed by the third party requester that the examiner refuses to adopt. Comprehensive reasons for patentability must be given for each determination favorable to patentability of claims. See MPEP § 1302.14 for examples of suitable statements of reasons for allowance.

Where a single previous Office action contains a complete statement of a ground of rejection or of reasons for not making a proposed rejection, the ACP may incorporate by reference that statement. In any event, the ACP must also include a rebuttal of any arguments raised in the patent owner's response and must reflect consideration of any comments made by the third party requester.

## II. REVIEW OF AMENDATORY MATTER UNDER 35 U.S.C. 112

Where an amendment has been submitted in the patent owner's response, the amendatory matter (i.e., matter revised or newly added) should be reviewed for compliance with 35 U.S.C. 112. As to the content of the patent that has not been revised, a review based upon 35 U.S.C. 112 is not proper in reexamination, and no such review should be made.

## III. WITHDRAWAL OF REJECTION

Where the examiner withdraws a ground of rejection originally initiated by the examiner, such withdrawal should be clearly stated in the ACP as a decision favorable to patentability with respect to the withdrawn rejection. The third party requester's next set of comments that may be filed (after a patent

owner response to an action) may propose the withdrawn rejection as a "rejection proposed by the third party requester." In the event the patent owner fails to respond to the ACP and a Right of Appeal Notice (RAN) is then issued, the third party requester may appeal this withdrawal of rejection as a final decision favorable to patentability - see 37 CFR 41.61(a)(2). Where the examiner withdraws a ground of rejection previously proposed by the third party requester, the examiner should treat the issue as rejection proposed by the third party requester that the examiner refuses to adopt.

## IV. ISSUES NOT WITHIN SCOPE OF REEXAMINATION

If questions not within the scope of reexamination proceedings (for example, questions of patentability based on public use or on sale, *>conduct issues<*, abandonment under 35 U.S.C. 102(c)) have been **newly** raised by the **patent owner** response or the **third party requester** comments being addressed by the ACP, the existence of such questions will be noted by the examiner in the ACP, using form paragraph 26.03.

\*\*>

### *¶ 26.03 Issue Not Within Scope of Inter Partes Reexamination*

It is noted that an issue not within the scope of reexamination proceedings has been raised. [1]. The issue will not be considered in a reexamination proceeding. 37 CFR 1.906(c). While this issue is not within the scope of reexamination, the patentee is advised that it may be desirable to consider filing a reissue application provided that the patentee believes one or more claims to be partially or wholly inoperative or invalid.

#### **Examiner Note:**

1. In bracket 1, identify the issues.
2. This paragraph may be used either when the patent owner or the third party requester raises issues such as (but not limited to) public use or on sale, conduct, or abandonment of the invention. Such issues should not be raised independently by the patent examiner.

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## V. COVER SHEET

Form PTOL-2065 should be used as the cover sheet for the ACP. Since the Office action is responsive to a patent owner response, and possibly the third party requester comments, the space on the PTOL-2065 for

the date of the communication(s) to which the Office action is responsive to should be filled in. Generally, the patent owner is given one month to respond to the action, and thus “One” should be inserted in the appropriate space for such.

## VI. SIGNATORY AUTHORITY

As with all other Office correspondence on the merits in a reexamination proceeding, the ACP must be signed by a primary examiner.

## VII. CONCLUDING PARAGRAPHS

The ACP should conclude with the following form paragraphs:

### ¶ 26.07 Action Closing Prosecution

**This is an ACTION CLOSING PROSECUTION (ACP);** see MPEP § 2671.02.

(1) Pursuant to 37 CFR 1.951(a), 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 37 CFR 1.116 as to whether it shall be entered and considered. Such comments and/or proposed amendments must be filed within a time period of 30 days or one month (whichever is longer) from the mailing date of this action. Where the patent owner files such comments and/or a proposed amendment, the third party requester may once file comments under 37 CFR 1.951(b) responding to the patent owner's submission within 30 days from the date of service of the patent owner's submission on the third party requester

(2) If the patent owner does not timely file comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), then the third party requester is precluded from filing comments under 37 CFR 1.951(b).

(3) Appeal **cannot** be taken from this action, since it is not a final Office action.

### ¶ 26.73 Correspondence and Inquiry as to Office Actions

**All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

## VIII. PANEL REVIEW CONFERENCE

After an examiner has determined that the reexamination proceeding is ready for the ACP action, the examiner will formulate a draft preliminary ACP action. The examiner will then inform his/her **>**Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS) **<** of his/her intent to issue the action. The CRU **>**SPE/TC QAS **<** will convene a panel review conference, and the conference members will review the patentability of the claim(s) pursuant to MPEP § 2671.03. If the conference confirms the examiner's preliminary decision to reject and/or allow the claims, the proposed ACP action shall be issued and signed by the examiner, with the two other conferees initialing the action (as “conferee”) to indicate their presence in the conference. If the conference does not confirm the examiner's treatment of the claims, the examiner will reevaluate and issue an appropriate Office action.

## IX. WHERE PATENT OWNER FAILS TO RESPOND AND CLAIMS HAVE BEEN FOUND PATENTABLE

Where the patent owner fails to respond to the first Office action (or any subsequent Office action which is prior to ACP) and any claims have been found patentable in the first action (or a subsequent action), the examiner will issue an ACP (see MPEP § 2671). The ACP should repeat all determinations of patentability (decisions to not make a proposed rejection) applicable to the patentable claims and incorporate by reference the reasons for each determination (the reasons for not making each proposed rejection). If the examiner realizes that more explanation would be helpful, the examiner should include it. Since the patent owner failed to respond to the first Office action, the proceeding will be limited to the claims found patentable and to new claims which do not expand the scope of the claims found patentable (if the new claims have an entry right or are otherwise entered at the option of the examiner). See MPEP § 2666.10. A panel review conference pursuant to MPEP § 2671.03 will be held.

### 2671.03 **\*>Panel< Review \* [R-5]**

**\*\*>**A panel review will be conducted at each stage of the examiner's examination in an *inter partes* reexamination proceeding, other than for actions such as notices of informality or incomplete response. Matters requiring decision outside of the examiner's jurisdiction (e.g., decisions on petitions or extensions of time, or Central Reexamination Unit (CRU) support staff notices) will not be reviewed by a panel.

The panel review is carried out for each Office action. The panel reviews the examiner's preliminary decision to reject and/or allow the claims in the reexamination proceeding, prior to the issuance of each Office action.

#### I. MAKE-UP OF THE PANEL

The panel will consist of three members, one of whom will be a manager. The second member will be the examiner in charge of the proceeding. The manager will select the third member. The examiner-conferees will be primary examiners, or examiners who are knowledgeable in the technology of the invention claimed in the patent being reexamined and/or who are experienced in reexamination practice. The majority of those present at the conference will be examiners who were not involved in the examination or issuance of the patent. An "original" examiner (see MPEP § 2636) should be chosen as a conferee only if that examiner is the most knowledgeable in the art, or there is some other specific and justifiable reason to choose an original examiner as a participant in the conference.<

#### II. **\*\*>PANEL< PROCESS**

The examiner must inform his/her **\*>manager<** of his/her intent to issue an **\*\*>**Office action. The manager< will then convene a **\*\*>**panel and the members will confer and< review the patentability of the claim(s). If the conference confirms the examiner's preliminary decision to reject and/or allow the claims, the Office action **\*\*** shall be issued and signed by the examiner, with the two other conferees initialing the action (as "conferee") to indicate their **\*>**participation< in the conference. Both conferees will initial, even though one of them may have dissented from the

3-party conference decision as to the patentability of claims. If the conference does not confirm the examiner's preliminary decision, **\*\*** the examiner **\*\*>**will reevaluate and issue an< appropriate Office action **\*\***.

Where the examiner in charge of the proceeding is not in agreement with the conference decision, the **\*>**manager< will generally assign the proceeding to another examiner**\*\***.

**\*\***

#### III. WHAT THE CONFERENCES SHOULD ACCOMPLISH

Each conference will provide a forum to consider all issues of patentability as well as procedural issues having an impact on patentability. Review of the patentability of the claims by more than one primary examiner should diminish any perception that the patent owner can disproportionately influence the examiner in charge of the proceeding. The conferences will also provide greater assurance that all matters will be addressed appropriately. All issues in the proceeding will be viewed from the perspectives of three examiners. What the examiner in charge of the proceeding might have missed, one of the other two conference members would likely detect. The conference will provide for a comprehensive discussion of, and finding for, each issue.

#### IV. CONSEQUENCES OF FAILURE TO HOLD CONFERENCE

Should the examiner issue **\*\*>**Office action without panel review<, the patent owner or the third party requester who wishes to object must promptly file a paper alerting the Office of this fact. (The failure to hold a **\*>**panel< review conference would be noted by the parties where there are no conferees' initials at the end of the **\*\*** Office action.) Any challenge of the failure to hold a **\*>**panel< review conference must be made within two **\*>**weeks of receipt< of the Office action issued, or the challenge will not be considered. **\*\*** In no event will the failure to hold a patentability review conference, by itself, be grounds for vacating any Office decision(s) or action(s) and "restarting" the reexamination proceeding.

## 2672 Patent Owner Comments/Amendment After ACP and Third Party Requester Responsive Comments [R-7]

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

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

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

### I. ONE OPPORTUNITY TO MAKE SUBMISSIONS UNDER 37 CFR 1.951(a) AND (b)

After an Action Closing Prosecution (ACP), the patent owner may once file (pursuant to 37 CFR 1.951(a)) written comments limited to the issues raised in the reexamination proceeding and/or present a proposed amendment to the claims. Where the patent owner does so, the third party requester may once file (pursuant to 37 CFR 1.951(b)) comments responsive to the patent owner's comments. Any second or supplemental submission after ACP by either the patent owner or the third party requester will thus be returned.

### II. TIME FOR MAKING PATENT OWNER SUBMISSION UNDER 37 CFR 1.951(a)

The patent owner submission under 37 CFR 1.951(a) of comments and/or proposed amendment must be filed within the time period set for response to the ACP. Normally, the ACP will set a period of 30 days or one month (whichever is longer) from the mailing date of the ACP.

An extension of the time period for filing the patent owner's submission under 37 CFR 1.951(a) may be requested under 37 CFR 1.956. The time period may not, however, be extended to run past 6 months from the date of the ACP.

The examiner and all other parties to the reexamination should recognize that a reexamination proceeding may result in the final cancellation of claims from the patent **and** that the patent owner does not have the right to continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d), nor by filing a Request for Continued Examination under 37 CFR 1.114, and the patent owner cannot file an *inter partes* reexamination request (see MPEP § 2612). Accordingly, the examiner and other parties should identify and develop all issues prior to the ACP, including the presentation of evidence under 37 CFR 1.131 and 1.132.

### III. PATENT OWNER MAKES SUBMISSION AFTER ACP; LIMITATION ON PATENT OWNER'S SUBMISSION

Once an ACP that is not premature has been entered in a reexamination proceeding, the patent owner no longer has a right to unrestricted further prosecution. Consideration of the proposed amendments submitted after ACP (pursuant to 37 CFR 1.951(a)) will be governed by the strict standards of 37 CFR 1.116. The patent owner's submission of comments under 37 CFR 1.951(a) must be limited to the issues raised in the ACP. If the submission addresses issues not already raised in the ACP, then the comments will be returned >as improper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the party that submitted the comments<. No additional opportunity will be given for the patent owner to correct the defect unless a petition under 37 CFR 1.183 is granted to waive 37 CFR 1.951 as to its one opportunity limitation for the patent owner comment. If such a petition under 37 CFR 1.183 is granted and the patent owner submits corrected comments under 37 CFR 1.951(a), the third party requester may then once file supplemental comments responding to the patent owner's corrected comments within one month from the **date of service** of the patent owner's corrected comments on the third party requester. >Any replacement patent owner comments under 37 CFR 1.951(a) that are submitted in the rare instance where a petition is granted must be strictly limited to (i.e., must not go beyond) the content of the original comments submission.<

#### **IV. PATENT OWNER MAKES SUBMISSION AFTER ACP; THIRD PARTY REQUESTER COMMENTS ARE LIMITED \*\***

Where the patent owner files comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), the third party requester may once file comments (pursuant to 37 CFR 1.951(b)) responding to the patent owner's comments, and/or proposed amendment, and/or the issues raised in the ACP. See 35 U.S.C. 314(b)(2). Such third party requester comments must be filed within 30 days from the **date of service** of the patent owner's comments, and/or proposed amendment, and/or the issues raised in the ACP on the third party requester. If the third party requester's comments go beyond the scope of responding to the patent owner's comments, and/or proposed amendments, and/or the issues raised in the ACP, then the third party requester's comments will be returned as improper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the party that submitted the comments. No additional opportunity will be given for the third party requester to correct the defect unless a petition under 37 CFR 1.183 is granted to waive 37 CFR 1.951 as to its one opportunity limitation. Any replacement third party requester comments under 37 CFR 1.951 (that are submitted in the rare instance where a petition is granted must be strictly limited to (i.e., must not go beyond) the content of the original comments submission.

#### **V. PATENT OWNER DOES NOT MAKE SUBMISSION AFTER ACP**

If the patent owner does not timely file comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), then the third party requester is precluded from filing comments under 37 CFR 1.951(b). Accordingly, a Right of Appeal Notice (RAN) will be issued where the time for filing the patent owner comments and/or amendment has expired and no patent owner paper containing comments and/or amendment has been received. It should be noted that where the patent owner chooses not to file a submission pursuant to 37 CFR 1.951(a), no rights of appeal are lost.

#### **VI. ACTION CLOSING PROSECUTION - PREMATURE**

If the patent owner is of the opinion that the Office action closing prosecution in the *inter partes* reexamination proceeding is premature, the patent owner may, in addition to the comments submitted under 37 CFR 1.951(a), file a petition under 37 CFR 1.181 within the time period for filing the comments under 37 CFR 1.951(a). The third party requester may then once file, as a paper separate from any submission under 37 CFR 1.951(b), comments responsive to the patent owner's petition under 37 CFR 1.181 within 30 days from the date of service of the patent owner's petition under 37 CFR 1.181 on the third party requester.

#### **2673 Examiner Consideration of Submissions After ACP and Further Action [Added R-2]**

##### **I. WHEN THE CASE IS TAKEN UP FOR ACTION**

The patent owner is given 30 days or one month, whichever is longer, to make the 37 CFR 1.951(a) submission after Action Closing Prosecution (ACP). If no patent owner submission under 37 CFR 1.951(a) is received after two months from the ACP, the examiner will take up the case for action. The case should be acted on promptly, in accordance with the statutory requirement for "special dispatch within the Office" (35 U.S.C. 314(c)). Where a patent owner obtained an extension of time under 37 CFR 1.956, the examiner will wait until the extended time plus one month expires before taking up the case for action.

If the patent owner submission under 37 CFR 1.951(a) is received, the third party requester will then have 30 days from service of the patent owner's submission to file the third party requester's 37 CFR 1.951(b) submission. If no third party requester submission under 37 CFR 1.951(b) is received after two months from the date of service of the patent owner's 37 CFR 1.951(a) submission, the examiner will take up the case for action.

Where both the 37 CFR 1.951(a) and (b) submissions have been received, the case should be taken up for action as soon as possible.

## II. OPTIONS AS TO WHICH ACTION TO ISSUE

(A) Right of Appeal Notice - Where no 37 CFR 1.951(a) submission has been filed by the patent owner, or where a submission under 37 CFR 1.951(a) (and 37 CFR 1.951(b)) has been filed and the examiner will not modify his/her position; the examiner should issue a Right of Appeal Notice (RAN). See MPEP § 2673.02. If the patent owner's submission included a proposed amendment, the RAN will indicate whether or not it was entered.

Where a submission has been filed under 37 CFR 1.951(a) (or 37 CFR 1.951(b)) and that submission is incomplete or is defective, the examiner should notify the parties, in the RAN, that the submission has not been considered, and that no additional opportunity is available to correct the defect(s) in the submission, because 37 CFR 1.951(a) and (b) provide that comments may only be filed "once."

(B) Office action reopening of prosecution - See MPEP § 2673.01 for a discussion of when the examiner should issue an action reopening prosecution.

## III. ACTION TAKEN BY EXAMINER

It should be kept in mind that a patent owner cannot, as a matter of right, amend claims rejected in the ACP, add new claims after an ACP, nor reinstate previously canceled claims. A showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after the ACP, except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner.

Where the entry of the proposed amendment (after the ACP) would result in any ground of rejection being withdrawn or any additional claim indicated as patentable, the proposed amendment generally raises new issues requiring more than cursory review by the examiner. The examiner would need to indicate new grounds for patentability for any claim newly found patentable and/or the reason why the rejection was withdrawn and would also need to deal with any third party requester's comments on the proposed amendment (made pursuant to 37 CFR 1.951(b) in response to owner's proposed amendment). Thus, the examiner is not required to enter the proposed amendment.

In view of the fact that the patent owner cannot continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114 and the patent owner cannot file an *inter partes* reexamination request (see MPEP § 2612), the examiner should consider the feasibility of entering a proposed amendment paper, where the entirety of the amendment would result *only* in an additional claim (or claims) being indicated as patentable. The examiner is encouraged to enter such an amendment unless the entry would cause an "undue burden" on the examiner. Where the examiner does not enter the amendment, the examiner should explain the "undue burden." Where the examiner does enter the amendment, see MPEP § 2673.01 as to whether a Right of Appeal Notice (RAN) can be issued or whether there is a need to reopen prosecution.

Where multiple amendments are submitted after the ACP, all amendments except for the first one will be returned without consideration, since they are improper submissions. Thus, if prosecution is reopened, only the first amendment will be present for entry.

An amendment filed at any time after the ACP and prior to the RAN may be entered (where appropriate for entry). An amendment filed *after* the RAN will not be entered at all, in the absence of a grantable petition under 37 CFR 1.183 because 37 CFR 1.953(c) prohibits an amendment after the RAN in *inter partes* reexamination. If the examiner wishes to have the patent owner provide an amendment after the RAN, the examiner can reopen prosecution, enter the amendment, and issue a new ACP.

Where a proposed amendment is not entered, the examiner will provide a detailed explanation of the reasons for not entering the proposed amendment. For example, if the claims as amended would present a new issue requiring further consideration or search, the new issue should be identified, and an explanation provided as to why a new search is necessary and/or why more than nominal consideration is necessary.

The parties to the reexamination will be notified in the RAN, or the Office action issued in lieu of the RAN (e.g., action reopening prosecution), as to whether the proposed amendment will be entered or will not be entered.



## 2673.01 Reopening Prosecution After ACP [Added R-2]

### I. MANDATORY REOPENING

Where a submission after Action Closing Prosecution (ACP) has been filed pursuant 37 CFR 1.951(a) (and 37 CFR 1.951(b)) and the examiner decides to modify his/her position, the examiner should ordinarily reopen prosecution, in accordance with the following guidelines.

The patent owner must be given an opportunity to adequately address any change in position adverse to the patent owner's position. A Right of Appeal Notice (RAN) cannot be issued until the patent owner has had the opportunity to address each and every rejection prior to the appeal stage. Thus, the examiner should reopen prosecution where any new ground of rejection is made or any additional claim is rejected.

Prosecution is ordinarily reopened in this situation by issuing a non-ACP action, i.e., an Office action prior to the ACP stage. If prosecution were reopened at the ACP stage, the patent owner loses rights as to amending the claims in response to the change in the examiner's position, because the patent owner's amendment rights are limited after ACP, - see MPEP § 2673.

As opposed to the examiner making a new ground of rejection, if a new finding of patentability is made (i.e., a ground of rejection is withdrawn or an additional claim is indicated as patentable), prosecution need not be reopened. The third party requester has no right to comment on and address a finding of patentability made during the reexamination proceeding *until the appeal stage*, unless the patent owner responds (after which the third party requester may file comments). Thus, the third party requester may address any new finding of patentability at the appeal stage in the same manner that it would address a finding of patentability made during the reexamination proceeding where the patent owner does not respond (e.g., all claims are allowed on the first Office action and the patent owner sees no reason to respond).

### II. DISCRETIONARY REOPENING

In addition to the above situation which *requires* reopening of prosecution, the examiner should be liberal in reopening prosecution where the equities of the

situation make such appropriate, because patent owner cannot continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d), nor by filing a Request for Continued Examination under 37 CFR 1.114.

An example of this would be as follows. Patent owner might submit an amendment after the ACP which would make at least one claim patentable, except for one or two minor changes needed to obviate a rejection. The examiner **cannot** telephone the owner to obtain the minor change(s) and then issue a RAN because interviews are not permitted in an *inter partes* reexamination proceeding. Also, the examiner **cannot** make the changes by issuing an examiner's amendment coupled with a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) because of the presence of the third party requester, i.e., the third party requester is entitled to a RAN so that the claims found patentable can be appealed. Yet, in this situation, it would be inequitable to send the claims to appeal based on the minor points that could be easily corrected. Accordingly, the examiner would reopen prosecution (since 37 CFR 1.953 requires reopening where a RAN is not issued) and issue a new ACP suggesting the amendment which will make the claims patentable. The third party requester would then have an opportunity to comment on the newly-found-patentable claims after the patent owner submits the suggested amendment pursuant to 37 CFR 1.951(a).

See MPEP § 2673 for a discussion of the examiner not exercising his/her discretion to reopen prosecution in those situations where an "undue burden" on the Office would result if prosecution were reopened.

## 2673.02 Examiner Issues Right of Appeal Notice (RAN) [R-7]

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

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

(b) **\*\*>**Expedited Right of Appeal Notice: At any time after the patent owner's response to the initial Office action on the merits in an *inter partes* reexamination, the patent owner and all third party requesters may stipulate that the issues are appropriate for a final action, which would include a final rejection and/or a final

determination favorable to patentability, and may request the issuance of a Right of Appeal Notice. The request must have the concurrence of the patent owner and all third party requesters present in the proceeding and must identify all of the appealable issues and the positions of the patent owner and all third party requesters on those issues. If the examiner determines that no other issues are present or should be raised, a Right of Appeal Notice limited to the identified issues shall be issued.

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

A Right of Appeal Notice (RAN) is a final Office action which presents a final decision to reject the claims (i.e., a final decision that the claims are rejected) and/or a final decision favorable to patentability as to the claims (i.e., a final decision not to make a proposed rejection).

The RAN will identify the status of each claim. It will set forth:

(A) the grounds of rejection for all claims rejected in the RAN;

(B) the reasons why a proposed rejection is not made for all decisions favorable to patentability as to claims that were contested by the third party requester; and

(C) the reasons for patentability for all claims “allowed” and not contested by the third party requester.

The RAN will also advise parties of their rights of appeal at this stage in the reexamination proceeding, and the consequences of failure to appeal.

See MPEP § 2673 as to matters that should be taken into account by the examiner before deciding to issue a RAN. Before the examiner actually issues a RAN, all outstanding grounds of rejection of record and findings of patentability that are of record should be carefully reviewed, after consideration of all submissions of record by the parties. Where it is appropriate to retain the grounds of rejection and findings of patentability, and the examiner’s position will not be

changed, the examiner is permitted to issue a RAN. Any grounds of rejection and findings of patentability relied upon should be restated in the RAN. The reasons for each rejection and finding should be set forth in detail. The grounds of rejection and findings of patentability should, at this point, be clearly developed to such an extent that the patent owner and the third party requester may readily judge the advisability of filing an appeal. The examiner’s position as to any arguments and comments raised by the patent owner and the third party requester should be clearly set forth, so that any appeal taken can address the examiner’s position as to the arguments and comments.

In the RAN, it should also be point out which submissions after the Action Closing Prosecution (ACP) have been entered and considered, and which have not. At this point, the examiner should check the record to ensure that parties have been made aware of which amendments, evidence (affidavits, declarations, exhibits, etc.), references and argument are before the examiner for consideration. The case should be ready for appeal after the RAN issues.

In the event that an amendment submitted by the patent owner after the ACP has not been entered because the amendment does not comply with the requirements of 37 CFR 1.116 (see 37 CFR 1.951(a)), the patent owner may file a petition under 37 CFR 1.181 requesting entry of the amendment. The petition under 37 CFR 1.181 must be filed within the time period for filing a notice of appeal or cross appeal, if appropriate (see 37 CFR 1.953(c)). Note that the filing of a petition under 37 CFR 1.181 does **not** toll the time period for filing a notice of appeal or cross appeal, if appropriate. Thus, in addition to the petition under 37 CFR 1.181, the patent owner is encouraged to file (1) a petition under 37 CFR 1.183 requesting waiver of the prohibition of an extension of time for filing an appeal brief (37 CFR 41.66(a)), and (2) a request for an extension of the period to file the appeal brief until after a decision on the petition under 37 CFR 1.181. The third party requester may once file comments responsive to the patent owner’s petition under 37 CFR 1.181 within 30 days from the date of service of the patent owner’s petition under 37 CFR 1.181 on the third party requester. When rendering a decision on the petition under 37 CFR 1.181, the deciding official should be mindful that a patent owner in an *inter partes* reexamination proceeding

may not be able to proceed effectively if the amendment submitted after the ACP is not entered since the patent owner in an *inter partes* reexamination proceeding does not have the right to continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114, and the patent owner cannot file an *inter partes* reexamination.

Form PTOL-2066 should be used as the cover sheet for the RAN. The RAN should conclude with form paragraph 26.08 advising the parties of their right to appeal and correspondence and inquiry form paragraph 26.73:

¶ 26.08 *Right of Appeal Notice*

**This is a RIGHT OF APPEAL NOTICE (RAN);** see MPEP § 2673.02 and § 2674. The decision in this Office action as to the patentability or unpatentability of any original patent claim, any proposed amended claim and any new claim in this proceeding is a FINAL DECISION.

No amendment can be made in response to the Right of Appeal Notice in an *inter partes* reexamination. 37 CFR 1.953(c). Further, no affidavit or other evidence can be submitted in an *inter partes* reexamination proceeding after the right of appeal notice, except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1), 37 CFR 1.116(f).

Each party has a **thirty-day or one-month time period, whichever is longer**, to file a notice of appeal. 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 by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1). The third party requester may appeal to the Board of Patent Appeals and Interferences with respect to any decision favorable to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1).

In addition, a patent owner who has not filed a notice of appeal may file a notice of cross appeal within **fourteen days of service** of a third party requester's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1). A third party requester who has not filed a notice of appeal may file a **notice of cross appeal within fourteen days of service** of a patent owner's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1).

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

Any party that does not file a timely notice of appeal or a timely notice of cross appeal will lose the right to appeal from any decision adverse to that party, but will not lose the right to file a respondent brief and fee where it is appropriate for that party to do so. If no party files a timely appeal, the reexamination prosecution will be terminated, and the Director will proceed to issue and pub-

lish a certificate under 37 CFR 1.997 in accordance with this Office action.

¶ 26.73 *Correspondence and Inquiry as to Office Actions*

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

An amendment filed *after* the RAN will not be entered at all, in the absence of a grantable petition under 37 CFR 1.183, because 37 CFR 1.953(c) prohibits an amendment after the RAN in an *inter partes* reexamination. If the examiner wishes to have the patent owner provide an amendment after the RAN, the examiner can reopen prosecution, accept the amendment (for entry), and issue a new Action Closing Prosecution (ACP). See MPEP § 2673.01 for discussion as to discretionary reopening of prosecution.

Note that 37 CFR 1.116(d)(1) states that no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claims in the proceeding, can be made in an *inter partes* reexamination proceeding after the RAN except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1). Furthermore, no affidavit or other evidence can be submitted in an *inter partes* reexamination proceeding after the RAN except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1). See 37 CFR 1.116(f).

## I. EXAMINER NEVER ISSUES A NIRC AFTER ACP

Once an ACP has been issued, there is no requirement for the patent owner to respond; where the patent owner does not respond to the rejection of the

patent claims, a RAN will still be issued and the patent owner can appeal at that point to the Board of Patent Appeals and Interferences. Because there is no requirement for the patent owner to respond, there is no situation in which a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) can be issued after an ACP and prior to the RAN. Even if (after an ACP has been issued) the examiner finds the patent owner's subsequent argument to be persuasive as to all of the claims, a NIRC would still not be issued, but rather, a RAN would be issued to provide the third party requester with an opportunity to appeal the "allowed" claims to the Board of Patent Appeals and Interferences.

## II. EXPEDITED RIGHT OF APPEAL NOTICE

37 CFR 1.953(b) provides for an expedited RAN. At any time after the patent owner's response to the first Office action on the merits in an *inter partes* reexamination, the patent owner and the third party requester (all third party requesters, if there is more than one due to a merged proceeding) may request the immediate issuance of a RAN.

The request for an expedited RAN must:

(A) stipulate that the issues are appropriate for a final action, which would include a final rejection and/or a final determination favorable to patentability;

(B) state that the patent owner and the third party requester (all third party requesters, if there is more than one) join in making the request;

(C) identify all of the appealable issues; and

(D) identify and discuss the positions of the patent owner and the third party requester(s) on the identified issues.

If the examiner determines that no other issues are present or should be raised in the proceeding, a RAN limited to the identified issues will be issued.

If the examiner determines that other issues are in fact present, or that other issues need to be raised in the proceeding, the examiner should deny the request, and examination and prosecution will continue as if the request had not been submitted.

In no event will the request for an expedited RAN be construed to extend the time for any response/comments due at the time the request is made.

## III. PANEL REVIEW CONFERENCE

After an examiner has determined that the reexamination proceeding is ready for the RAN action, the examiner will formulate a draft preliminary RAN action. The examiner will then inform his/her *>*Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS) *<* of his/her intent to issue the action. The *>*CRU SPE/TC QAS *<* will convene a panel review conference, and the conference members will review the patentability of the claim(s) pursuant to MPEP § 2671.03. If the conference confirms the examiner's preliminary decision to reject and/or allow the claims, the proposed RAN action shall be issued and signed by the examiner, with the two other conferees initialing the action (as "conferee") to indicate their presence in the conference. If the conference does not confirm the examiner's treatment of the claims, the examiner will reevaluate and issue an appropriate Office action.

### 2674 Appeal in Reexamination [R-3]

35 U.S.C. 315. *Appeal.*

(a) PATENT OWNER.— The patent owner involved in an *inter partes* reexamination proceeding under this chapter—

(1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent; and

(2) may be a party to any appeal taken by a third-party requester under subsection (b).

(b) THIRD-PARTY REQUESTER.— A third-party requester—

(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and

(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

(c) CIVIL ACTION.— A third-party requester whose request for an *inter partes* reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the *inter partes* reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.

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*37 CFR 1.959. Appeal in inter partes reexamination.*

Appeals to the Board of Patent Appeals and Interferences under 35 U.S.C. 134(c) are conducted according to part 41 of this title.

*37 CFR 41.61. Notice of appeal and cross appeal to Board.*

(a)(1) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the owner may appeal to the Board with respect to the final rejection of any claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

(2) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

(b)(1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20(b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(c) The notice of appeal or cross appeal in the proceeding must identify the appealed claim(s) and must be signed by the owner, the requester, or a duly authorized attorney or agent.

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

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

(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 given a non-extendable time period 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 set time 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.<

An appeal cannot be taken by parties to the reexamination until a Right of Appeal Notice (RAN) has been issued. Once a RAN has been issued, the patent owner and any third party requester will have, in accordance with 37 CFR 1.953, a time period of one month or thirty days (whichever is longer) to file a notice of appeal (with the fee set forth in 37 CFR \*>41.20(b)(1)<. Pursuant to 37 CFR \*>41.61(e)<, the time for filing a notice of appeal may not be extended.

In the event that no party to the reexamination files a timely notice of appeal, the >prosecution of the reexamination< proceeding will be terminated, with the examiner issuing a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC); see MPEP § 2687. However, if **one** of the parties does file a notice of appeal within the one month/thirty day period, an **opposing party** can enter into the appeal by filing a notice of cross appeal pursuant to 37 CFR \*>41.61(b)< within fourteen (14) days from service of the first party's notice of appeal, see MPEP § 2674.01. Pursuant to 37 CFR \*>41.61(e)<, the time for filing a notice of cross appeal may not be extended.

The procedure for taking appeal is \*\*>referenced< in 37 CFR 1.959 >and set forth in 37 CFR 41.61<.

(A) The notice of appeal must identify the appealed claim(s).

(B) The appeal must be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) which the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN which the *third party requester* proposes to contest. Therefore:

- A notice of appeal by the patent owner must identify each claim rejected by the examiner that the patent owner intends to contest;

- A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

(C) The notice of appeal must be signed by the patent owner or the third party requester, or their duly authorized attorney or agent.

“Appellant” and “respondent” are defined in 37 CFR \*>41.60<. Where the patent owner appeals from the rejection of the claims, a third party requester responding to the patent owner’s appeal is termed the respondent as to the rejected claims. Where a third party requester appeals from a favorable determination with respect to the claims, the patent owner responding to the third party requester’s appeal is termed the respondent as to the favorable determination.

Where a party fails to file a timely notice of appeal or notice of cross appeal, that party may no longer file an appellant brief to appeal a claim determination adverse to that party; however, that party *is permitted to file a respondent brief* in accordance with 37 CFR \*>41.66(b) and 41.68< (with the fee as required by 37 CFR \*>41.68(a)<), to respond to issues raised by an opposing party’s appellant brief.

Where a notice of appeal or notice of cross appeal is timely filed but is defective, e.g., missing fee or missing portion of the fee, no proof of service is included, it is signed by an inappropriate party or is unsigned, failure to identify the appealed claims; 37 CFR \*>41.61(f)< provides the appropriate party one opportunity to file, within a nonextendable period of one month, an amended notice of appeal or cross appeal that corrects the defect(s). Form PTOL-2067 should be used to provide the notification.

Where a notice of appeal or notice of cross appeal is filed before a RAN has been issued, the appropriate party will be notified in writing that the appeal is not acceptable. The paper will be placed in the file \*\* but it will not be considered at all in the proceeding, other than to inform the party that the appeal is not acceptable.

It should be noted that under 37 CFR \*\*>41.63(a), amendments filed after the date of filing an appeal (under 37 CFR 41.61) canceling claims may be admitted, where such cancellation does not affect the scope of any other pending claim in the proceeding. However, as to all other amendments filed after the date of filing an appeal, 37 CFR 41.63(b) states that such amendments will not be admitted except as permitted where the patent owner takes action for reopening prosecution under 37 CFR 41.77(b)(1). Also, under

37 CFR 41.63(c), affidavits, declarations, or exhibits submitted after the date of filing an appeal will not be admitted except as permitted by reopening prosecution under 37 CFR 41.77(b)(1).<

## 2674.01 Cross Appeal After Original Appeal [R-3]

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37 CFR 41.61. Notice of appeal and cross appeal to Board.

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(b)(1) Within fourteen days of service of a requester’s notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of an owner’s notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

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The cross appeal provision of 37 CFR \*>41.61(b)< permits a party to the reexamination to wait and see if an opposing party will appeal, before committing to the appeal process.

Within fourteen days of service of a third party requester’s notice of appeal, a patent owner who has not filed a notice of appeal, may file a notice of cross appeal, the cross appeal being with respect to any final decision (i.e., decision in the RAN) **adverse** to the patentability of any claim of the patent. Pursuant to 37 CFR \*>41.61(e)<, the time for filing the patent owner’s notice of cross appeal may not be extended.

Within fourteen days of service of a patent owner’s notice of appeal, a third party requester who has not filed a notice of appeal may file a notice of cross appeal, the cross appeal being with respect to any final decision (i.e., decision in the RAN) **favorable** to the patentability of any claim of the patent. Pursuant to 37 CFR \*>41.61(e)<, the time for filing the requester’s notice of cross appeal may not be extended.

Where the notice of cross appeal is timely filed but is defective, e.g., missing fee or missing portion of the

fee, no proof of service, signed by an inappropriate party or unsigned, failure to identify the appealed claims; 37 CFR \*>41.61(f)< provides the appropriate party one opportunity to file, within a non-extendable period of one month, an amended cross appeal that corrects the defect(s).

Where there are more than two parties to the proceeding, i.e., the patent owner and more than one *inter partes* third party requester in a merged proceeding, then a third party cross appeal must be filed within fourteen days of service of a patent owner's notice of appeal. If a first third party requester filed an appeal later than the patent owner's appeal, then the second third party requester's time for cross appeal runs from the earlier-in-time patent owner appeal, **not** from the later-in-time first requester appeal.

In addition, 37 CFR \*>41.61(b)< only provides for a cross appeal from a "notice of appeal," not from a "notice of cross appeal." Thus, if the patent owner files a notice of cross appeal after the original one month/thirty days period for appeal has expired, but within the fourteen days of a first requester's appeal (which was filed within the original period); a second third party requester does **not** have fourteen days from the patent owner's cross appeal. In such a situation, the time for the second requester to appeal (the original one month/thirty days) has expired and the second requester cannot appeal.

The content of a notice of cross appeal is the same as that for a notice of appeal, except that the notice of cross appeal is titled as such and identifies the original appeal from which the cross appeal is taken. Where a party inadvertently fails to title or identify a notice of cross appeal as such (i.e., the format for an *original* appeal is used), in an appeal filed after the original one month/thirty days has expired but before the "fourteen days" have expired, the examiner will construe the notice of appeal as the filing of a notice of cross appeal timely filed within the fourteen days.

## 2675 Appellant Brief [R-5]

37 CFR 41.66. *Time for filing briefs.*

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The

time for filing an appellant's brief or an amended appellant's brief may not be extended.

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37 CFR 41.67. *Appellant's brief.*

(a)(1) Appellant(s) may once, within time limits for filing set forth in § 41.66, file a brief and serve the brief on all other parties to the proceeding in accordance with § 1.903 of this title.

(2) The brief must be signed by the appellant, or the appellant's duly authorized attorney or agent and must be accompanied by the requisite fee set forth in § 41.20(b)(2).

(b) An appellant's appeal shall stand dismissed upon failure of that appellant to file an appellant's brief, accompanied by the requisite fee, within the time allowed under § 41.66(a).

(c)(1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(xi) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled). If the appellant is the owner, the appellant must also identify the rejected claims whose rejection is being appealed. If the appellant is a requester, the appellant must identify the claims that the examiner has made a determination favorable to patentability, which determination is being appealed.

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

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by column and line number, and to the drawing(s), if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Issues to be reviewed on appeal.* A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an

opportunity to propose it as a third party requester proposed ground of rejection.

(vii) *Argument*. The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief permitted under this section or §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown. Each issue must be treated under a separate heading. If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix*. An appendix containing a copy of the claims to be reviewed on appeal.

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

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

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an

amended brief. If appellant does not file an amended brief within the set time 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.

In order to file an appellant brief, it is necessary to have first filed a timely and proper notice of appeal or notice of cross appeal; see MPEP § 2674 and § 2674.01. Each party that filed a timely and proper notice of appeal or notice of cross appeal must then file its appellant brief with fee (set forth in 37 CFR 41.20(b)(2)) by the later of:

(A) within two months from the date of the last-filed notice of appeal or cross appeal; or

(B) if a patent owner or third party requester is entitled to file an appeal or cross appeal but fails to timely do so, until the expiration of time for filing (by the last party entitled to do so) such notice of appeal or cross appeal.

The time for filing an appellant brief may not be extended. 37 CFR 41.66(a).

Pursuant to 37 CFR 41.67(d), if a brief is filed which does not comply with all the requirements of 37 CFR 41.67(a) and (c), appellant will be notified and given a nonextendable period of one month within which to file an amended brief to correct the defect(s). Failure to timely file the appellant brief and fee within the time allowed will result in dismissal of the appeal of the party that failed to take the timely action. Note that if an appellant brief is late, or if an amended appellant brief is not submitted after a requirement to correct the defect(s), the respondent brief will be placed in the file; however, it will be marked as "not entered" since it is not formally received into the record, and it will not be considered. The same is true for an amended appellant brief which is late.

Where all parties who filed an appeal or cross appeal fail to timely file an appellant brief and fee within the time allowed, the prosecution of the reexamination proceeding is terminated by a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC), and a certificate is issued indicating the status of the claims at the time of appeal.

The appellant brief, as well as every other paper relating to an appeal, should indicate the number of the \*\*>Central Reexamination Unit (CRU)< Art Unit to which the reexamination is assigned and the



reexamination control number. When an appellant brief is received, it is scanned and then entered into the file by the \*\*>CRU support staff< and then forwarded to the \*>examiner<.

A fee as set forth in 37 CFR 41.20(b)(2) is required when the appellant brief is filed for the first time in a particular reexamination proceeding, 35 U.S.C. 41(a). 37 CFR 41.67(c)(1) requires that the appellant shall provide, in the appellant brief, the authorities and arguments on which the appellant will rely to maintain the appeal, a concise explanation of subject matter defined in each of the independent claims involved in the appeal which explanation must refer to the specification by column and line number (and to the drawing, if any, by reference characters), an evidence appendix, a related proceedings appendix, and a copy of the claims involved. The copy of the claims (involved in the appeal) required in the claim appendix by 37 CFR 41.67(c)(1)(viii) should be a clean copy. The clean copy *must include* all brackets and underlining as required by 37 CFR 1.530(d) *et seq.*; thus, the copy of the claims on appeal must include all underlining and bracketing necessary to reflect the changes made to the original patent claims throughout the prosecution of the reexamination. In addition, any new claims added in the reexamination must be completely underlined.< For the sake of convenience, the copy of the claims involved should start on a new page, and it should be double spaced.

The provisions of 37 CFR 41.67(c) should be carefully reviewed to ensure that a complete appellant brief is provided. Patent owners are reminded that their briefs in appeal cases must be responsive to every ground of rejection stated by the examiner which the patent owner-appellant contests. Third party requesters are reminded that their briefs in appeal cases must be responsive to each examiner determination of patentability (determination of inapplicability of a proposed rejection) which the third party requester-appellant contests. Oral argument at the hearing will not remedy such a deficiency in the appellant brief.

Where the appellant brief is not complete as to the provisions of 37 CFR 41.67(a) and (c), appellant will be notified (in accordance with 37 CFR 41.67(d) by the examiner that he/she is given one (1) month to correct the defect(s) by filing a supplemental appellant brief. Where this procedure has not been fol-

lowed, the Board of Patent Appeals and Interferences should remand the reexamination file to the examiner for appropriate action.

When the record clearly indicates an *intentional* failure to respond by appellant brief to any ground of rejection or determination of patentability, the examiner should so inform the Board of Patent Appeals and Interferences in his/her answer and specify the claim(s) affected. Where the failure to respond by appellant brief appears to be intentional, the Board of Patent Appeals and Interferences may dismiss the appeal (of the appropriate party) as to the claims involved. Oral argument at a hearing will not remedy such a deficiency in a brief.

It is essential that the Board of Patent Appeals and Interferences should be provided with a brief fully stating the position of the appellant with respect to each issue involved in the appeal so that no search of the record is required in order to determine that position. The fact that appellant may consider a ground or determination to be clearly improper does not justify a failure on the part of the appellant to point out to the Board the argument, i.e., reasons, for that view. A distinction must be made between the lack of any argument and the presentation of arguments which carry no conviction. In the former case, dismissal is in order, while in the latter case a decision on the merits is made, although it may well be merely an affirmance based on the grounds or determination relied upon by the examiner.

Ignoring or acquiescing in any rejection or determination, even one based upon formal matters which could be corrected by subsequent amendments, will invite a dismissal of the appeal as to the appropriate party. The prosecution of the reexamination proceedings will be considered terminated as of the date of the dismissal of the appeal of all parties who filed an appeal or cross appeal.

#### **AMENDMENTS, AFFIDAVITS, DECLARATIONS, OR EXHIBITS**

Pursuant to 37 CFR 41.67(c)(2), the brief is not to include any (A) new or non-admitted (non-entered) amendment, or (B) new or non-admitted (non-entered) affidavit or other evidence.

Pursuant to 37 CFR 41.63:

(A) Amendments filed after the date of filing an appeal (under 37 CFR 41.61) canceling claims may be

admitted, where such cancellation does not affect the scope of any other pending claim in the proceeding;

(B) All other amendments filed after the date of filing an appeal will not be admitted, except as permitted where the patent owner takes action for reopening prosecution under 37 CFR 41.77(b)(1);

(C) Affidavits or other evidence filed after the date of filing an appeal will not be admitted, except as permitted where the patent owner takes action for reopening prosecution under 37 CFR 41.77(b)(1).

If the examiner wishes to have the patent owner provide an amendment (other than cancellation of claims as discussed above) or evidence during the appeal stage, the examiner must (A) reopen prosecution, (B) accept the amendment or evidence for entry, (C) permit timely comment on the new amendment or evidence by the third party requester, and (D) then issue a new Action Closing Prosecution (ACP). See MPEP § 2673.01.

## 2675.01 Respondent Brief [R-5]

37 CFR 41.66. *Time for filing briefs.*

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

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37 CFR 41.68. *Respondent's brief.*

(a)(1) Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

(2) The brief must be signed by the party, or the party's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 41.20(b)(2).

(3) The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

(4) A requester's respondent brief may not address any brief of any other requester.

(b)(1) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

(i) *Real Party in Interest.* A statement identifying by name the real party in interest.

(ii) *Related Appeals and Interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to respondent, the respondent's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (b)(1)(ix) of this section.

(iii) *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.

(iv) *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.

(v) *Summary of claimed subject matter.* A statement accepting or disputing appellant's summary of the subject matter defined in each of the independent claims involved in the appeal. If appellant's summary of the subject matter is disputed, the errors in appellant's summary must be specified.

(vi) *Issues to be reviewed on appeal.* A statement accepting or disputing appellant's statement of the issues presented for review. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified. A counter statement of the issues for review may be made. No new ground of rejection can be proposed by a requester respondent.

(vii) *Argument.* A statement accepting or disputing the contentions of appellant with each of the issues presented by the appellant for review. If a contention of the appellant is disputed, the errors in appellant's argument must be specified, stating the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Each issue must be treated under a separate heading. An argument may be made with each of the issues stated in the counter statement of the issues, with each counter-stated issue being treated under a separate heading.

(viii) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by respondent in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the respondent's brief. See § 41.63 for treatment of evidence submitted after appeal.

(ix) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (b)(1)(ii) of this section.

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

(2) A respondent brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or

other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

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

After an appellant brief has been properly filed, a party opposing the appellant may file a respondent brief in support of the claim determination(s) made in the Right of Appeal Notice (RAN) which are in favor of the opposing party. The respondent brief must, however, be limited to issues raised in the appellant brief to which the respondent brief is directed. 37 CFR 41.68(a)(3).

The respondent brief must be accompanied by the requisite fee set forth in 37 CFR 41.20(b)(2), and it must be filed within one month from the date of service of the appellant brief on the opposing party.

Pursuant to 37 CFR 41.66(b), the time for filing a respondent brief may not be extended. If a respondent brief is filed which does not comply with all the requirements of 37 CFR 41.68(a) and (b), respondent will be notified and given a nonextendable period of one month within which to file an amended brief to correct the defect(s). See 37 CFR 41.68(c). Failure to timely file a respondent brief and fee (or failure to timely complete the respondent brief, where it is noted by the examiner as being incomplete under 37 CFR 41.68(c)) will result in the respondent brief not being considered. Note that if the respondent brief is late, or if an amended respondent brief is not submitted after a requirement to correct the defect(s) (following a timely respondent brief), the respondent brief will be placed in the file; however, it will be marked as “not entered” since it is not formally received into the record, and it will not be considered. The same is true for an amended respondent brief which is late.

It should be noted that where a party fails to file a timely notice of appeal or notice of cross appeal, that party may no longer file *an appellant brief* to appeal a claim determination adverse to that party; **however**,

that party is permitted to file a *respondent brief* in accordance with 37 CFR 41.66(b).

A fee as set forth in 37 CFR 41.20(b)(2) is required when the respondent brief is filed for the first time in a particular reexamination proceeding, 35 U.S.C. 41(a). The respondent brief should indicate the number of the **\*\*>Central Reexamination Unit (CRU)<** Art Unit to which the reexamination is assigned and the reexamination control number. A statement of what in the appellant brief is accepted and what is disputed must be provided in the respondent brief. Respondent must set forth the authorities and arguments upon which he/she will rely to dispute the contentions of the appellant with respect to the issues.

The provisions of 37 CFR 41.68(a) and (b) should be carefully reviewed to ensure that a complete respondent brief is provided. Where the respondent brief is not complete as to the provisions of 37 CFR 41.68(a) and (b), respondent will be notified (in accordance with 37 CFR 41.68(c)) by the examiner that respondent is given a non-extendable period of one month to correct the defect(s) by filing an amended respondent brief. Where this procedure has not been followed, the Board of Patent Appeals and Interferences should remand the reexamination file to the examiner for appropriate action.

## 2675.02 Informalities in One or More of the Briefs [R-3]

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*37 CFR 41.67. Appellant's brief.*

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(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time 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.

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*37 CFR 41.68. Respondent's brief.*

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(c) If a respondent brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (b) of this section, respondent will be notified of the reasons for non-compliance and given a non-extendable time period within which to file

an amended brief. If respondent does not file an amended respondent brief within the set time period, or files an amended respondent brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief and any amended respondent brief by that respondent will not be considered.

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Where an appellant or respondent brief does not comply with all the requirements of 37 CFR \*>41.67(a)< and (c) or 37 CFR \*>41.68(a)< and (b), respectively, such as missing fee or missing portion of the fee, a missing signature, inappropriate signature, less than three copies of the brief, no proof of service on a party; the appropriate party should be notified of the reasons for non-compliance and provided with a nonextendable period of one month within which to file an amended brief. The reasons for non-compliance and/or the defect(s) will be pointed out to the appropriate party in *one comprehensive action* (notification). Form PTOL-2067 will be used as the cover sheet for the notification action. A separate PTOL-2067 with notification action will be sent to each party, where the brief(s) of more than one party are non-compliant and/or defective. Where the same party's appellant and respondent briefs are both informal, the examiner may combine the notifications for both into one notification action with PTOL-2067.

If an appellant does not file an *amended* appellant brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance or does not correct all defects stated in the notification, the appeal will stand dismissed **as to that party**.

If a respondent does not file an amended respondent brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance or does not correct all defects stated in the notification, the respondent brief will not be formally received into the record and will not be considered (though it will be placed in the file \*\*).

Where a party does timely file an amended brief and overcomes all the reasons for non-compliance and corrects all defects stated in the notification, the amended brief will be entered and will be considered along with the original appellant or respondent brief, when the case is taken up by the examiner.

The following form paragraphs should be used in drafting the notification:

\*\*>

¶ 26.09 *Brief is Defective and/or is Not Complete*

The [1] brief filed [2] by [3] is defective and/or is not complete as to the provisions of 37 CFR 41.67(a) and (c) (for appellant brief) or 37 CFR 41.68(a) and (b) (for respondent brief) for the following reasons:

**Examiner Note:**

1. In bracket 1, fill in either "appellant" or "respondent".
2. In bracket 2, fill in the date the brief was filed.
3. In bracket 3, fill in either "the patent owner" or "the third party requester".
4. This form paragraph should be followed by a statement of all instances of non-compliance and all defects, and an explanation detailed enough for the party to understand how to deal with each non-compliance and defect noted in the letter.
5. One of form paragraphs 26.10 or 26.11 should be used at the end of this action.

¶ 26.10 *Informal Appellant Brief-Period for Response Under 37 CFR 41.67(d)*

Appellant, [1] is required to comply with the provisions of 37 CFR 41.67(a) and (c) and to correct all defects noted in this letter as to the appellant brief. Appellant, [2] is given a period of ONE MONTH from the date of this letter or the time remaining in the original two month period (whichever is the longer) for filing an amended complete appellant brief. If an amended complete brief that fully complies with the requirements of this letter is not timely submitted, the appellant's appeal will be dismissed as of the date of expiration of the presently set time period. THE PERIOD FOR RESPONSE SET IN THIS LETTER CANNOT BE EXTENDED. 37 CFR 41.67(d).

**Examiner Note:**

In brackets 1 and 2, fill in either "the patent owner" or "the third party requester".

¶ 26.11 *Informal Respondent Brief-Period for Response Under 37 CFR 41.68(c)*

Respondent, [1] is required to comply with the provisions of 37 CFR 41.68(a) and (b) and to correct all defects noted in this letter as to the respondent brief. Respondent [2] is given a period of ONE MONTH from the date of this letter for filing an amended complete respondent brief. If an amended complete brief that fully complies with the requirements of this letter is not timely submitted, the respondent brief will not be formally received into the record and will not be considered. THE PERIOD FOR RESPONSE SET IN THIS LETTER CANNOT BE EXTENDED. 37 CFR 41.68(c).

**Examiner Note:**

1. In brackets 1 and 2, fill in either "the patent owner" or "the third party requester".
2. In the case of the respondent brief, the new one month period will always extend longer than the original one month period, thus

the longer of the two need not be given, as was done in form paragraph 26.10 where the original period for the appellant brief is two months.

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## 2676 Appeal Conference [R-7]

All appellant and respondent briefs will be processed in the Central Reexamination Unit (CRU). The CRU will forward the reexamination file to the examiner after all appellant and respondent briefs have been filed or after the time for filing them has expired.

As long as one timely appellant brief has been filed, the case must be considered for appeal by the examiner. The examiner will consult with the Reexamination Legal Advisor (RLA) as to the procedural considerations and should then formulate an initial opinion as to whether an examiner's answer should be prepared, or prosecution should be reopened and a non-final Office action issued.

If the examiner reaches the conclusion that the appeal should **go forward** and an examiner's answer should be prepared, the examiner will arrange (via the \*\*>CRU Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS)< for an appeal conference to be conducted pursuant to the procedures set forth in MPEP § 1208. The \*>CRU SPE/TC QAS< will notify the RLA of the appeal conference, which the RLA will attend to ensure that all issues are properly addressed in the examiner's answer. In preparing for the appeal conference, the examiner should review the case so that he/she will be prepared to discuss the issues raised in all the briefs. The examiner should be prepared to propose to the conferees how he/she will address each issue raised in the appellant and respondent briefs. The appeal conference will be held in accordance with the procedures as set forth in MPEP § 1208 \*\*. The examiner will have two weeks following the appeal conference to prepare the examiner's answer.

If the examiner reaches the conclusion that the appeal should **not go forward**, no appeal conference is held. Prosecution is reopened, and the examiner issues of a new non-final Office action. The examiner should, at this point, consult with the RLA to discuss at what point in the prosecution the prosecution should be reopened, and then the examiner will prepare an appropriate Office action.

See MPEP § 2638 for the appropriate code to use for reporting time spent with respect to the appeal conference.

## 2677 Examiner's Answer [R-7]

37 CFR 41.69. Examiner's answer.

(a) The primary examiner may, within such time as directed by the Director, furnish a written answer to the owner's and/or requester's appellant brief or respondent brief including, as may be necessary, such explanation of the invention claimed and of the references relied upon, the grounds of rejection, and the reasons for patentability, including grounds for not adopting any proposed rejection. A copy of the answer shall be supplied to the owner and all requesters. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.61, 41.66, 41.67 and 41.68 or does not relate to an appealable action, the primary examiner shall make such determination of record.

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

(c) An examiner's answer may not include a new determination not to make a proposed rejection of a claim.

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

Where the term "brief" is used in this section, it shall refer to any appellant briefs and/or respondent briefs in the reexamination proceeding, unless specific identification of an "appellant brief" or a "respondent brief" is made.

Before preparing an examiner's answer, the examiner should make certain that all amendments approved for entry have in fact been physically entered by the Central Reexamination Unit (CRU). The clerk of the Board will return to the CRU any reexamination proceeding in which approved amendments have not been entered.

The examiner should furnish each party to the reexamination (even a party that has not filed an appellant nor respondent brief) with a comprehensive examiner's answer that provides a written statement in answer to each appellant brief and each respondent brief. The examiner's answer is to be completed by the examiner within two weeks after the appeal conference. After the answer is completed (and signed), the examiner obtains the initials of the appeal conference participants (the conferees) and then forwards the reexamination file with the answer to the \*\*>CRU Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS)<. The \*>CRU SPE/TC QAS< reviews the answer, and

if the answer is in order, forwards the reexamination file with the answer to the CRU support staff.

The examiner's answer may incorporate from any of the briefs the most accurate and most comprehensive information. It should contain a response to the allegations or arguments made in all of the briefs and should call attention to any errors in an appellant's copy of the claims. If a ground of rejection or reason for patentability is not addressed in the examiner's answer, the proceeding will be remanded by the Board of Appeals and Patent Interferences (Board) to the examiner.

The examiner should report his/her conclusions on any affidavits, declarations, or exhibits that were admitted to the record. Any affidavits or declarations in the file swearing behind a patent should be clearly identified by the examiner as being considered under either 37 CFR 1.131 or 37 CFR 41.154(a). The distinction is important since the Board will usually consider holdings on 37 CFR 1.131 affidavits or declarations but not holdings on 37 CFR 41.154(a) affidavits or declarations in appeal cases.

If the appellant brief fails to respond (in the patent owner's brief) to any or all grounds of rejection or (in the third party requester's brief) to any or all determinations of patentability made by the examiner, or otherwise fails to comply with 37 CFR 41.67(c), the procedure for handling such briefs set forth in MPEP § 2675.02 should be followed. If the respondent brief fails to give reasons for disputing any or all contentions of an appellant that are disputed in the respondent brief, or otherwise fails to comply with 37 CFR 41.68(b), the procedure for handling such briefs is also set forth in MPEP § 2675.02.

It sometimes happens that an examiner will state a position (e.g., reasoning) in the answer in a manner that represents a shift from the position stated in the Right of Appeal Notice (RAN). In such a case, the answer must indicate that the last stated position supersedes the former. Failure to do this confuses the issue since it is not clear exactly what the examiner's ultimate position is.

If there is a complete and thorough development of the issues at the time of the RAN, it is possible to save time in preparing the examiner's answer. Examiners may incorporate in the answer their statement of the grounds of rejection or determinations of patentability

merely by reference to the RAN. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action. Thus, if a statement of the ground of rejection or a determination of patentability set forth in the RAN refers back to a prior action it cannot be incorporated by reference. The page(s) and paragraph(s) of the RAN which it is desired to incorporate by reference should be explicitly identified. If the examiner feels that further explanation is necessary, he/she should include it in the answer. The examiner's answer should also include rebuttal of any and all arguments presented in all of the briefs.

All correspondence with the Board, whether by the examiner or an appellant or respondent, must be on the record. No unpublished decisions which are unavailable to the general public by reason of 35 U.S.C. 122 can be cited by the examiner or the parties.

The examiner should reevaluate his/her position in the light of the arguments presented in the briefs, and should expressly withdraw any rejections or determinations of patentability not adhered to. Such a withdrawal would be a new finding of patentability (determination not to make a rejection) or new ground of rejection, respectively. Pursuant to 37 CFR 41.69(b), an examiner's answer "may not include a new ground of rejection." Pursuant to 37 CFR 41.69(c), an examiner's answer "may not include a new determination not to make a proposed rejection of a claim." Accordingly, prosecution must be reopened for any withdrawal of a rejection or of a determination of patentability. Before issuing the action reopening prosecution, the examiner will consult with the Reexamination Legal Advisor (RLA) to discuss at what point in the prosecution the prosecution should be reopened, and then the examiner will prepare an appropriate Office action. Note that the examiner may withdraw the Action Closing Prosecution (ACP) and reopen prosecution at any time prior to the mailing of the examiner's answer.

If the examiner requests to be present at the oral hearing, the request must be set forth in a separate letter as noted in MPEP § 1209.

MPEP § 1207 - § 1207.05 relate to preparation of examiner's answers on appeal in patent applications and *ex parte* reexamination proceedings.

All examiner's answers in *inter partes* reexamination proceedings must comply with the guidelines set forth below.

## I. REQUIREMENTS FOR EXAMINER'S ANSWER

The examiner may incorporate from any of the briefs information required for the examiner's answer, as needed to provide accurate and comprehensive information. The examiner's answer must include, in the order indicated, the following items. Again, the term "brief" or "briefs" shall refer to any appellant briefs and/or respondent briefs in the reexamination proceeding, unless specific identification of an "appellant brief" or a "respondent brief" is made.

(A) *Real Party in Interest*. For each appellant and respondent brief, a statement by the examiner acknowledging the identification by name of the real party in interest.

(B) *Related Appeals and Interferences*. A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph should be included in the "*Related Proceedings Appendix*" section.

(C) *Status of Claims*. A statement of whether the examiner agrees or disagrees with the statement of the status of claims contained in the briefs. If the examiner disagrees with the statement of the status of claims contained in the briefs, the examiner must set forth a correct statement of the status of all the claims in the proceeding.

(D) *Status of Amendments*. A statement of whether the examiner agrees or disagrees with the statement of the status of amendments contained in any of the briefs, and an explanation of any disagreement with any of the briefs. If there are no amendments, the examiner shall so state.

(E) *Summary of Claimed Subject Matter*. A statement of whether the examiner agrees or disagrees with the summary of claimed subject matter contained in the briefs and an explanation of any disagreement.

(F)(1) *Grounds of Rejection to be Reviewed on Appeal*. A statement of whether the examiner agrees or disagrees with the statement of the grounds of rejection to be reviewed set forth in the briefs and an explanation of any disagreement. In addition, the examiner must include the following subheadings (\*>and state "None" where< appropriate):

(a) "Grounds of Rejection Not On Review" - a listing of all grounds of rejection that have not been withdrawn and have not been presented by an appellant for review in the brief; and

(b) "Non-Appealable Issues" - a listing of any non-appealable issues in the briefs.

(2) *Findings of Patentability to be Reviewed on Appeal*. A statement of whether the examiner agrees or disagrees with the statement of the findings of patentability to be reviewed set forth in the briefs and an explanation of any disagreement. In addition, the examiner must include the following subheadings (\*>and state "None" where< appropriate):

(a) "Findings of Patentability Not On Review" - a listing of all \*\*>findings of patentability< that \*\* have not been presented by an appellant for review in the brief; and

(b) "Non-Appealable Issues" - a listing of any non-appealable issues >raised by the requester< in the briefs.

(G) *Claims Appendix*. A statement of whether the copy of the appealed claims contained in the appendix to the appellant briefs is correct, and if any claim is not correct in any of the briefs, a copy of the correct claim.

(H) *Evidence Relied Upon*. A listing of the evidence relied on (e.g., patents, publications, Official Notice, admitted prior art), and, in the case of non-patent references, the relevant page or pages. Note that new references cannot be applied in an examiner's answer. 37 CFR 41.69(b). If new references are to be applied, prosecution must be reopened. Also note that both the art relied upon by the examiner in making rejections, and the art relied upon by the third party requester in the proposed rejections, will be listed by the examiner.

(I) *Grounds of Rejection*. For each ground of rejection maintained by the examiner applicable to the appealed claims, an explanation of the ground of rejection.

(1) For each rejection under 35 U.S.C. 112, first paragraph, the examiner's answer must explain how the first paragraph of 35 U.S.C. 112 is not complied with, including, as appropriate, how the specification and drawings, if any,

(a) do not describe the subject matter defined by each of the rejected claims, and

(b) would not enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims without undue experimentation including a consideration of the undue experimentation factors set forth in MPEP § 2164.01(a).

(2) For each rejection under 35 U.S.C. 112, second paragraph, the examiner's answer must explain how the claims do not particularly point out and distinctly claim the subject matter which "applicant" regards as the invention.

(3) For each rejection under 35 U.S.C. 102, the examiner's answer must explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.

(4) For each rejection under 35 U.S.C. 103, the examiner's answer must:

(a) state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on in the rejection,

(b) identify the differences between the rejected claims and the prior art relied on (i.e., the primary reference), and

(c) explain why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the primary reference to arrive at the claimed subject matter.

(5) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the art even after the examiner complies with the requirements of paragraphs (I)(3) and (4) above, the examiner must compare at least one of the rejected claims feature-by-feature with the art relied upon in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page or column, line number, drawing reference number, and quotation from the reference, as appropriate.

(6) For each rejection, other than those referred to in paragraphs (I)(1) to (I)(5), the examiner's answer must specifically explain the basis for the particular rejection.

(J) *Determinations of Patentability.* For each determination of patentability, **i.e., each determination of inapplicability of a proposed rejection to the appealed claims**, a clear explanation of the determination.

(1) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. 112, first paragraph; the examiner's answer must explain how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any, do *describe* the subject matter defined by each of the proposed-for-rejection claims, and/or would in fact enable a person skilled in the art to make and use the subject matter defined by each of the proposed-for-rejection claims without undue experimentation.

(2) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. 112, second paragraph; the examiner's answer must explain how the claims do particularly point out and distinctly claim the subject matter which "applicant" regards as the invention.

(3) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. 102; the examiner's answer must explain why the proposed-for-rejection claims are not anticipated and why they are patentable under 35 U.S.C. 102, pointing out which limitations recited in the patentable claims are not found in the art relied upon by the third party requester for the proposed rejection.

(4) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. 103; the examiner's answer must point out which limitations recited in the proposed-for-rejection claims are not found in the art relied upon by the third party requester for the proposed rejection, shall identify the difference between the claims and the art relied upon by the third party requester and must explain why the claimed subject matter is patentable over the art relied on by the third party requester. If the third party requester's proposed rejection is based upon a combination of references, the examiner's answer must explain the rationale for not making the combination.



(5) For each rejection proposed under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims define over features in the art even after the examiner complies with the requirements of paragraphs (J)(3) and (J)(4) above, the examiner must compare at least one of the proposed-for-rejection claims feature-by-feature with the art relied on in the proposed rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page or column, line number, drawing reference number, and quotation from the reference, as appropriate.

(6) For each determination of inapplicability of a proposed rejection, other than those referred to in paragraphs (J)(1) to (J)(5), the examiner's answer must specifically explain why there is insufficient basis for making that particular proposed rejection.

(K) *No New Ground of Rejection or New Finding of Patentability.* The examiner's answer must provide an explicit statement that it does not contain any new ground of rejection, and it does not contain any new finding of patentability (i.e., no new determination of inapplicability of a proposed rejection). This statement will serve as a reminder to the examiner that if a new ground of rejection or new finding of patentability is made, prosecution must be reopened. It will also provide appropriate notification to parties that no new ground of rejection or new finding of patentability was made.

(L) *Response to Argument.* A statement of whether the examiner disagrees with each of the contentions of appellants and respondents in their briefs with respect to the issues presented, and an explanation of the reasons for disagreement with any such contentions. If any ground of rejection or inapplicability of proposed rejection is not argued and responded to by the appropriate party, the examiner must point out each claim affected.

(M) *Related Proceedings Appendix.* Copies of any decisions rendered by a court or the Board in any proceeding identified by the examiner in the Related Appeals and Interferences section of the answer.

(N) *Period for Providing a Rebuttal Brief.* The examiner will set forth the period for the appropriate appellant party, or appellant parties, to file a rebuttal brief after the examiner's answer, and that no further papers will be permitted subsequent to the rebuttal brief.

## II. PROCESSING OF COMPLETED ANSWER

When the examiner's answer is complete, the examiner will sign it. On the examiner's answer, each conferee who was present at the appeal conference will place his/her initials below the signature of the examiner who prepared the answer. Thus: "John Smith (conferee)" should be typed, and "JS" should be initialed. (The initialing by the conferee does not necessarily indicate concurrence with the position taken in the examiner's answer.)

The clerical staff will make a copy of the examiner's answer for the patent owner and for the third party requester(s). The clerical staff should attach form PTOL-2070 to the copy of the answer to be mailed to the third party requester by the CRU.

The examiner must prepare the examiner's answer, ensure that the clerical processing is done, and forward the case to the *\*>CRU SPE/TC QAS<* no later than two weeks from the date of the appeal conference (unless otherwise authorized by the CRU Director or a Reexamination Legal Advisor (RLA) of the Office of Patent Legal Administration (OPLA)). The examiner's answer is reviewed by the *\*>CRU SPE/TC QAS<* and the case is forwarded to the RLA within three days of the *\*>CRU SPE's/TC QAS's<* receipt of the case from the examiner.

If an examiner's answer is believed to contain a new interpretation or application of the existing patent law, the examiner's answer, the case file, and an explanatory memorandum should be forwarded to the CRU Director for consideration. See MPEP § 1003 which applies to the CRU Director as it does to TC Directors. If approved by the CRU Director, the examiner's answer should be forwarded by the *\*>CRU SPE/TC QAS<* to the RLA for final approval, prior to mailing the examiner's answer.

## III. FORM PARAGRAPHS

The following form paragraphs may be used to prepare an examiner's answer in an *inter partes* reexamination proceeding:

### ¶ 26.50 Heading for Examiner's Answer EXAMINER'S ANSWER

This is in response to the following appellant (and respondent) brief(s) on appeal: [1]

**Examiner Note:**

In bracket 1, identify for each brief (a) the party (patent owner or third party requester), (b) the type of brief (appellant or respondent), and (c) the date it was filed. Where there is one third party requester (the usual situation), indicate “third party requester”; where there are two or more third party requesters (a merged proceeding), indicate “third party requester” followed by the name of the third party requester (e.g., “third party requester Smith” or “third party requester XYZ Corporation”).

¶ 26.50.01 *Real Party in Interest*(1) *Real Party in Interest***Examiner Note:**

Follow this paragraph with one or more of form paragraphs 26.50.02 and/or 26.50.03.

¶ 26.50.02 *Acknowledgment of Identification of a Real Party in Interest in a Brief*

A statement identifying the real party in interest is contained in [1] brief(s).

**Examiner Note:**

In bracket 1, identify the brief or briefs containing a statement identifying the real party in interest. For example, “the appellant third party requester Jones” or “the appellant patent owner and the respondent third party requester Smith” or “all of the” can be used where appropriate.

¶ 26.50.03 *No Identification of a Real Party in Interest in the Briefs*

In the present appeal, [1] brief(s) does/do not contain a statement identifying the real party in interest. It is presumed that the party named in the caption of the brief(s) is the real party in interest at the time the brief was filed. The Board of Patent Appeals and Interferences, however, may subsequently exercise its discretion to require an explicit statement as to the real party in interest.

**Examiner Note:**

In bracket 1, identify the brief or briefs not containing a statement identifying the real party in interest. For example, “the appellant third party requester Jones” or “the appellant patent owner and the respondent third party requester Smith” or “all of the” can be used where appropriate.

¶ 26.50.04 *Related Appeals and Interferences*(2) *Related appeals and interferences***Examiner Note:**

Follow this paragraph with form paragraph 26.50.05 or 26.50.06.

¶ 26.50.05 *Identification of the Related Appeals and Interferences*

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal:

**Examiner Note:**

1. Follow this form paragraph with an identification by application, patent, appeal or interference number of all other prior and pending appeals, interferences or judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.

2. Include a copy of all court and Board decisions identified in this section in a related proceeding(s) appendix using form paragraphs 26.61.01 and 26.61.03.

¶ 26.50.06 *No Related Appeals and Interferences Identified*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.

¶ 26.51 *Status of Claims*(3) *Status of claims***Examiner Note:**

Follow form paragraph 26.51 with one or more of form paragraphs 26.51.01 and/or 26.51.02.

¶ 26.51.01 *Agreement With Statement of Status of Claims*

The statement of the status of claims contained in the [1] brief(s) is correct.

**Examiner Note:**

1. In bracket 1, identify the brief or briefs containing the correct status of the claims. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.

2. Use form paragraph 26.51.02 where there is a disagreement with the statement of status of the claims stated in the brief(s).

¶ 26.51.02 *Disagreement With Statement of Status of Claims Stated in Briefs*

The statement of the status of claims contained in the [1] briefs is incorrect. [2].

A correct statement of the status of the claims is as follows: [3]

**Examiner Note:**

1. In bracket 1, identify the brief or briefs containing the incorrect statement of the status of the claims. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.

2. In bracket 2, identify the area of disagreement with each brief and the reasons for the disagreement.

3. For bracket 3, see form paragraphs 12.151.03 - 12.151.10 for the type of material that should be included. Remember that a “final rejection” is not made in a reexamination. Thus, use “Action Closing Prosecution” and “Right of Appeal Notice” where each is appropriate.

¶ 26.52 *Status of Amendments*(4) *Status of Amendments After Action Closing Prosecution***Examiner Note:**

Identify status of all amendments submitted after Action Closing Prosecution. Use one or more of form paragraphs 26.52.01 - 26.52.05, if appropriate.

¶ 26.52.01 *Agreement With Statement of the Status of Amendments After Action Closing Prosecution*

The statement of the status of amendments after Action Closing Prosecution contained in the [1] brief(s) is correct.

**Examiner Note:**

1. In bracket 1, identify the brief or briefs containing the correct statement of the status of amendments after Action Closing Prosecution. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.
2. Use form paragraph 26.52.02 where there is a disagreement with the statement of the status of the amendments after ACP stated in the brief(s).

¶ 26.52.02 *Disagreement With Statement of the Status of Amendments After Action Closing Prosecution Stated in Briefs*

The statement of the status of amendments after Action Closing Prosecution contained in the [1] brief(s) is incorrect. [2]

**Examiner Note:**

1. In bracket 1, identify the brief or briefs containing the incorrect statement of the status of amendments after Action Closing Prosecution. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.
2. In bracket 2, identify the area of disagreement with each brief and the reasons for the disagreement.

¶ 26.52.03 *Amendment After Action Closing Prosecution Entered*

The amendment after Action Closing Prosecution filed on [1] has been entered.

**Examiner Note:**

In bracket 1, insert the date of any entered amendment.

¶ 26.52.04 *Amendment After Action Closing Prosecution Not Entered*

The amendment after Action Closing Prosecution filed on [1] has not been entered.

**Examiner Note:**

In bracket 1, insert the date of any amendment denied entry.

¶ 26.52.05 *No Amendment After Action Closing Prosecution*

No amendment after Action Closing Prosecution has been filed.

¶ 26.53 *Summary of Claimed Subject Matter*(5) *Summary of Claimed Subject Matter***Examiner Note:**

Follow form paragraph 26.53 with either form paragraphs 26.53.01 or 26.53.02.

¶ 26.53.01 *Agreement With the Summary of Claimed Subject Matter in Brief(s)*

The summary of claimed subject matter contained in the [1] brief(s) is correct.

**Examiner Note:**

1. In bracket 1, identify the brief or briefs containing the incorrect summary of claimed subject matter. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.
2. Use form paragraph 26.53.02 where there is disagreement as to the summary.

¶ 26.53.02 *Disagreement With the Summary of Claimed Subject Matter in Brief(s)*

The summary of claimed subject matter contained in the [1] brief(s) is deficient because [2].

**Examiner Note:**

1. In bracket 1, identify the brief or briefs containing the incorrect summary of invention. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.
2. In bracket 2, explain the deficiency of the summary of claimed subject matter. Include a correct summary of the invention if necessary for a clear understanding of the claimed invention.

¶ 26.54 *Grounds of Rejection to be Reviewed on Appeal*(6) *Grounds of Rejection to be Reviewed on Appeal***Examiner Note:**

Follow form paragraph 26.54 with form paragraph 26.54.01 or 26.54.02.

¶ 26.54.01 *Agreement With Statement of the Grounds of Rejection on Appeal*

The statement of the grounds of rejection contained in the [1] brief(s) is correct.

**Examiner Note:**

1. In bracket 1, identify the brief or briefs containing the correct statement of the grounds of rejection on appeal. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.
2. Follow this form paragraph with form paragraph 26.54.011 if there are grounds of rejection that have not been withdrawn and that have not been presented by an appellant for review.

3. Follow this form paragraph with form paragraph 26.54.012 to list any non-appealable issues in the brief(s).
4. Use form paragraph 26.54.02 where there is disagreement as to the statement of the grounds of rejection on appeal.

¶ 26.54.011 *Grounds of Rejection Not on Review*

**GROUND(S) OF REJECTION NOT ON REVIEW**

The following grounds of rejection have not been withdrawn by the examiner, and they have not been presented by an appellant for review. [1].

**Examiner Note:**

In bracket 1, identify each ground of rejection that has not been withdrawn and has not been presented by an appellant for review.

¶ 26.54.012 *Nonappealable Issue in Brief*

**NON-APPEALABLE ISSUE(S)**

The [1] brief presents arguments relating to [2]. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

**Examiner Note:**

1. In bracket 1, identify the brief containing the petitionable issues. For example, “appellant third party requester Jones” or “appellant patent owner” can be used where appropriate.
2. When more than one brief has a petitionable issue, this form paragraph should be used for each of these briefs.

¶ 26.54.02 *Disagreement With Statement of the Grounds of Rejection on Appeal*

The [1] brief(s) does/do not provide a correct statement of the grounds of rejection to be reviewed on appeal. [2] The grounds of rejection to be reviewed on appeal are as follows: [3].

**Examiner Note:**

1. In bracket 1, identify the brief or briefs containing the incorrect statement of the grounds of rejection on appeal.
2. In bracket 2, indicate the area of disagreement and the reasons for the disagreement.
3. In bracket 3 set forth the correct statement of the grounds of rejection on appeal.

¶ 26.55 *Findings of Patentability to be Reviewed on Appeal*

**(7) Findings of Patentability to be Reviewed on Appeal**

**Examiner Note:**

Follow form paragraph 26.55 with form paragraph 26.55.01 or 26.55.02.

¶ 26.55.01 *Agreement With Statement of the Findings of Patentability on Appeal*

The statement of the findings of patentability contained in the [1] brief(s) is correct.

**Examiner Note:**

1. In bracket 1, identify the brief or briefs containing the correct statement of the findings of patentability on appeal. For example “appellant third party requester Jones” or “appellant patent owner

and respondent third party requester Smith” can be used where appropriate.

2. Follow this form paragraph with form paragraph 26.55.011 if there are findings of patentability that have not been withdrawn and that have not been presented by an appellant for review.

3. Form paragraph 26.54.012 may be used to list any non-appealable issues in the brief(s).

4. Use form paragraph 26.55.02 where there is disagreement as to the statement of the findings of patentability on appeal.

¶ 26.55.011 *Findings of Patentability Not on Review*

**FINDINGS OF PATENTABILITY NOT ON REVIEW**

The following grounds of rejection have not been withdrawn by the examiner, and they have not been presented by an appellant for review. [1].

**Examiner Note:**

1. In bracket 1, identify each ground of rejection that has not been withdrawn and has not been presented by an appellant for review.

¶ 26.55.02 *Disagreement With Statement of the Findings of Patentability on Appeal*

The [1] brief(s) does/do not provide a correct statement of the findings of patentability to be reviewed on appeal. [2] The findings of patentability to be reviewed on appeal are as follows: [3].

**Examiner Note:**

1. In bracket 1, identify the brief or briefs containing the incorrect statement of the findings patentability on appeal.
2. In bracket 2, indicate the area of disagreement and reasons for the disagreement.
3. In bracket 3, set forth the correct statement of the patentability to be reviewed on appeal.

¶ 26.56 *Claims Appendix*

**(8) Claims Appendix**

**Examiner Note:**

Follow form paragraph 26.56 with form paragraphs 26.56.01, 26.56.02, and/or 26.56.03, as is appropriate.

¶ 26.56.01 *Copy of the Appealed Claims in the Appendix of Appellant Brief is Correct*

The copy of the appealed claims [1] is contained in the Appendix to the appellant brief of [2] is correct.

**Examiner Note:**

1. In bracket 1, identify the claims appealed found in the appellant brief.
2. In bracket 2, identify the appellant brief containing the claims appealed. For example, “third party requester,” “third party requester Smith” or “patent owner” can be used where appropriate.
3. This paragraph is for appellant briefs; not for respondent briefs.
4. Where there is more than one appellant brief, the patent examiner may choose any appellant brief that has a correct copy of claims appealed. The examiner may use this form paragraph

more than once, as needed to set forth each claim or group of claims appealed by the appellants. Where a claim is correct in one appellant brief but is incorrect in another appellant brief, the examiner will draw a diagonal line in pencil through the incorrect claim in the Appendix of the incorrect appellant brief, and place the date, the word “Incorrect,” and the examiner’s initials in the margin.

**¶ 26.56.02 Copy of the Appealed Claims in the Appendix of Appellant Brief is Substantially Correct**

A substantially correct copy of the appealed claim(s) is contained in the Appendix of the appellant brief of [1]. Claim(s) [2] appear on pages [3] of the appendix contain minor errors. The minor errors are as follows: [4]

**Examiner Note:**

1. Use this paragraph where all appellant briefs contain errors in the claim(s) but at least one appellant brief is substantially correct and contains only minor errors.
2. In bracket 1, identify the appellant brief containing the substantially correct copy of the appealed claims. For example, “third party requester Smith” or “patent owner” can be used where appropriate.
3. In bracket 2, indicate the claim or claims with the minor errors.
4. In bracket 3, identify the page(s) in the Appendix where the substantially correct appealed claims appear.
5. In bracket 4, indicate the nature of the errors.
6. This paragraph is for appellant briefs; not for respondent briefs.
7. Where there is more than one appellant brief having the same claim recited incorrectly but at least one appellant brief is substantially correct and contains only minor errors, the examiner can apply the present form paragraph to the brief that has only minor errors in the appealed claim. If the application is still a paper file, the examiner should draw a diagonal line in pencil through the incorrect claim in any other (incorrect) appellant brief, and place the date, the word “Incorrect,” and the examiner’s initials in the margin.

**¶ 26.56.03 Copy of the Appealed Claims in the Appendix Contains Substantial Errors**

Claim(s) [1] contain(s) substantial errors as presented in the Appendix to all the appellant briefs. Accordingly, claim(s) [2] is/are correctly written in the Appendix to the examiner’s answer.

**Examiner Note:**

1. This form paragraph is used where all appellants fail to include a correct copy of an appealed claim or claims in the Appendix to the brief.
2. Attach a correct copy of the claims incorrect in all the appellant briefs as an Appendix to the examiner’s answer; and if the application is still a paper file, draw a diagonal line in pencil through the incorrect claim in the Appendix of each appellant’s appeal brief, and place the date, the word “Incorrect,” and the examiner’s initials in the margin.
3. In brackets 1 and 2, identify the claims that contain substantial errors.

4. Rather than using this form paragraph, if the errors in the claim(s) are significant, appellant(s) should be required to submit a corrected brief (amended brief). Where the brief includes arguments based upon the incorrect version of the claims (i.e., argument directed toward the errors in the claims), a corrected brief should always be required.

**¶ 26.57 Evidence Relied Upon - Heading (9) Evidence Relied Upon**

**Examiner Note:**

Follow form paragraph 26.57 with one or more of form paragraphs 26.57.01 - 26.57.03.

**¶ 26.57.01 No Evidence Relied Upon in the Examiner’s Answer**

No evidence is relied upon by the examiner in this appeal.

**¶ 26.57.02 Listing of the Evidence Relied Upon by Examiner**

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon by the examiner in the rejection of claims under appeal.

**Examiner Note:**

1. Use the following format for providing information on each reference cited:

Number	Name	Date
--------	------	------

2. The following are example formats for listing reference citations:

2,717,847	VARIAN	9-1955
1,345,890	MUTHER (Fed. Rep. of Germany)	7-1963

(Figure 2 labeled as Prior Art in this document)

3. See MPEP § 707.05(e) for additional examples.

**¶ 26.57.03 Listing of the Art of Record Relied Upon by Requester**

The following is a listing of the evidence relied upon by the third party requester(s) in the proposed rejection of claims which were not made by the examiner, and are now under appeal.

**Examiner Note:**

1. Use the following format for providing information on each reference cited:

Number	Name	Date
--------	------	------

2. The following are example formats for listing reference citations:

2,717,847	VARIAN	9-1955
1,345,890	MUTHER (Fed. Rep. of Germany)	7-1963

(Figure 2 labeled as Prior Art in this document)

3. See MPEP § 707.05(e) for additional examples.

**¶ 26.59 Grounds of Rejection (10) Grounds of rejection**

The following ground(s) of rejection are applicable to the appealed claims. [1].

**Examiner Note:**

In bracket 1, explain each ground of rejection clearly and completely as set forth in the appropriate paragraphs i-vi below:

(i) For each rejection under 35 U.S.C. 112, first paragraph, the examiner's answer shall explain why the first paragraph of 35 U.S.C. 112 is not complied with, including, as appropriate, how the specification and drawings, if any, (a) do not describe the subject matter defined by each of the rejected claims, and/or (b) would not enable a person skilled in the art to make and use the subject matter defined by each of the rejected claims without undue experimentation including a consideration of the undue experimentation factors set forth in MPEP § 2164.01(a).

(ii) For each rejection under 35 U.S.C. 112, second paragraph, the examiner's answer shall explain why the claims do not particularly point out and distinctly claim the subject matter which "applicant" regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the examiner's answer shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the examiner's answer shall state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on in the rejection, shall identify any difference between the rejected claims and the prior art relied on (i.e., the primary reference) and shall explain why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the primary reference to arrive at the claimed subject matter.

(v) For each rejection under 35 U.S.C. 102 or 103 where there may be questions as to how limitations in the claims correspond to features in the prior art, the examiner, in addition to the requirements of (iii) and (iv) above, shall compare at least one of the rejected claims feature-by-feature with the prior art relied upon in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page or column, line number, drawing reference number and quotation from the reference, as appropriate.

(vi) For each rejection, other than those referred to in paragraphs (i) to (v) of this section, the examiner's answer shall specifically explain the basis for the particular rejection.

#### ¶ 26.59.01 Findings of Patentability

##### (II) Findings of Patentability

The following findings of patentability, i.e., determinations of inapplicability of a proposed rejection, are applicable to the appealed claims.

[1]

#### **Examiner Note:**

In bracket 1, explain each determination of inapplicability of a proposed rejection, or refer to the RAN if it clearly and completely sets forth the determination of inapplicability of a proposed rejection and complies with appropriate paragraphs i-vi below:

(i) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. 112, first paragraph; the examiner's answer shall explain how the first para-

graph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any, (a) do describe the subject matter defined by each of the claims proposed for rejection, and/or (b) would in fact enable any person skilled in the art to make and use the subject matter defined by each of the claims proposed for rejection without undue experimentation.

(ii) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. 112, second paragraph; the examiner's answer shall explain how the claims do particularly point out and distinctly claim the subject matter which "applicant" regards as the invention.

(iii) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. 102; the examiner's answer shall explain why the claims proposed for rejection are not anticipated and patentable under 35 U.S.C. 102, pointing out which limitations recited in the claims proposed for rejection are not found in the prior art relied upon in the proposed rejection.

(iv) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. 103; the examiner's answer shall point out which limitations recited in the patentable claims are not found in the prior art relied upon in the proposed rejection, shall identify the difference between the patentable claims and the prior art relied upon by the third party requester and shall explain why the claimed subject matter is patentable over the prior art relied on by the third party requester. If the third party requester's proposed rejection is based upon a combination of references, the examiner's answer shall explain the rationale for not making the combination.

(v) For each third party requester proposed rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims define over features in the prior art even after the examiner complies with the requirements of (iii) and (iv) above, the examiner shall compare at least one of the claims proposed for rejection feature-by-feature with the prior art relied on in the proposed rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page or column, line number, drawing reference number, and quotation from the reference, as appropriate.

(vi) For each determination of inapplicability of a proposed rejection, other than those referred to in paragraphs (i) to (v) of this section, the examiner's answer shall specifically explain why there is insufficient basis for making the particular proposed rejection.

#### ¶ 26.60 No New Ground of Rejection; No New Finding of Patentability

##### (12) No new ground of rejection; no new finding of patentability

This examiner's answer does not contain any new ground of rejection. This examiner's answer does not contain any new finding of patentability (i.e., no new determination of inapplicability of a proposed rejection).

#### **Examiner Note:**

An examiner's answer may not include a new ground of rejection. See 37 CFR 41.69(b). An examiner's answer also may not include a new determination not to make a proposed rejection. See 37 CFR 41.69(c). If a new ground of rejection or new determina-

tion not to make a proposed rejection is made, prosecution must be reopened. See 37 CFR 41.69(d). See also MPEP § 2677.

¶ 26.61 *Response to Argument*  
(13) *Response to argument*

**Examiner Note:**

A statement of whether the examiner disagrees with each of the contentions of appellants and respondents in their briefs with respect to the issues presented, and an explanation of the reasons for disagreement with any such contentions. If any ground of rejection or inapplicability of proposed rejection is not argued and responded to by the appropriate party, the examiner shall point out each claim affected.

¶ 26.61.01 *Related Proceeding(s) Appendix*  
(14) *Related Proceeding(s) Appendix*

**Examiner Note:**

Follow form paragraph with either form paragraph 26.62.01 or 26.62.02.

¶ 26.61.02 *No Related Proceeding Identified*

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

¶ 26.61.03 *Copies Related to Proceeding*

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

¶ 26.62 *Notification Regarding Rebuttal Brief*  
(15) *Period for providing a Rebuttal Brief*

Appellant(s) is/are given a period of ONE MONTH from the mailing date of this examiner's answer within which to file a rebuttal brief in response to the examiner's answer. Prosecution otherwise remains closed.

The rebuttal brief of the patent owner may be directed to the examiner's answer and/or any respondent brief. The rebuttal brief of the third party requester(s) may be directed to the examiner's answer and/or the respondent brief of the patent owner. The rebuttal brief must (1) clearly identify each issue, and (2) point out *where* the issue was raised in the examiner's answer and/or in the respondent brief. In addition, the rebuttal brief must be limited to issues raised in the examiner's answer or in the respondent brief.

The time for filing the rebuttal brief may not be extended. No further submission (other than the rebuttal brief(s)) will be considered, and any such submission will be treated in accordance with 37 CFR 1.939.

¶ 26.63 *Request to Present Oral Arguments*

The examiner requests the opportunity to present arguments at the oral hearing.

**Examiner Note:**

1. Use this form paragraph only if:
  - a. an oral hearing has been requested by a party to the appeal; and
  - b. the primary examiner intends to present an oral argument.

2. This form paragraph must be included as a separate letter on a form PTOL-90. See MPEP § 1209.

¶ 26.64 *Examiner's Answer, Conclusion*  
(16) *Conclusion*

For the above reasons, it is believed that the rejections and/or findings of patentability discussed above should be sustained.

Respectfully submitted,

**2678 Rebuttal Briefs [R-3]**

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37 CFR 41.66. *Time for filing briefs.*

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(d) Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

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

\*\*>

37 CFR 41.71. *Rebuttal brief.*

(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.

(b)(1)The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.

(2) The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(c)(1)The rebuttal brief of any requester may be directed to the examiner's answer and/or the respondent brief of the owner.

(2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.

(3) No new ground of rejection can be proposed by a requester.

(4) The rebuttal brief of a requester shall not include any new or non-admitted affidavit or other evidence. See § 1.116(d) of this title for affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63(c) for affidavits or other evidence filed after the date of filing the appeal.

(d) 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 proceeding. The names and addresses of the parties served must be indicated.

(e) If a rebuttal brief is timely filed under paragraph (a) of this section but does not comply with all the requirements of paragraphs (a) through (d) 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 and any amended rebuttal brief by that appellant will not be considered.<

In the examiner's answer, each appellant is given a period of one month from the mailing date of the examiner's answer within which to file a rebuttal brief in response to the issues raised in the examiner's answer and/or in the respondent brief of an opposing party. The one month period may not be extended. 37 CFR 41.66(d)<

The rebuttal brief must (A) clearly identify each issue, and (B) point out where the issue was raised in the examiner's answer and/or in the respondent brief. In addition, the rebuttal brief must be limited to issues raised in the examiner's answer or in any respondent brief. A rebuttal brief will not be entered if it does not clearly identify each issue and/or is not limited to issues raised in the examiner's answer or in any respondent brief. Such a rebuttal brief will remain in the file, but it will not be addressed nor considered, except to inform the appropriate party that it was not entered and why.

The rebuttal brief of a third party requester may not be directed to the respondent brief or any other third party requester. No new ground of rejection may be proposed by a third party requester.

After the examiner's answer, only a rebuttal brief (or an amended rebuttal brief, where appellant is given one opportunity to correct a defective original rebuttal brief (MPEP § 2679)) will be received into the reexamination proceeding. No other submission will be considered, and any such other submission will be returned as an improper paper. 37 CFR 1.939.

If no rebuttal brief is received within the one month period set in the examiner's answer, the Central Reexamination Unit (CRU) will issue a notification letter to parties using form paragraph 26.67, and will then forward the reexamination proceeding to the Board of Patent Appeals and Interferences for decision on the appeal(s).

#### ¶ 26.67 No Receipt of Rebuttal Brief(s)

Appellant(s) was given a period of one month from the mailing date of the examiner's answer within which to file a rebuttal brief in response to the examiner's answer. No rebuttal brief has been received within that time period. Accordingly, the reexamination proceeding is being forwarded to the Board of Patent Appeals and Interferences for decision on the appeal(s).

Prosecution remains closed. Any further reply/comments by any party will not be considered, and may be returned to the party that submitted it.

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Central Reexamination Unit

If one or more rebuttal briefs is/are timely received, see MPEP § 2679 for treatment of the rebuttal brief(s).

## 2679 Office Treatment of Rebuttal Brief [R-5]

When a rebuttal brief is received in response to an examiner's answer, it is entered by the Central Reexamination Unit (CRU). The reexamination case file is retained in the CRU until all potential rebuttal briefs are submitted and entered, or the time for filing a rebuttal brief has expired. The case file is then forwarded to the examiner, who will then review the submission(s) and consult with the Reexamination Legal Advisor (RLA) of the CRU. If the examiner determines that the rebuttal brief (A) does not clearly identify each issue raised in the examiner's answer or in the respondent brief of an opposing party (and point out *where* the issue was raised in those papers), or (B) is not limited to the issues raised in the examiner's answer or the respondent brief; the examiner may *refuse* entry of the rebuttal brief. If entry is approved, the examiner will issue a notification letter to that effect. If entry is refused, the examiner will issue a notification letter that appellant is given a non-extendable period of one month to correct the defect in the rebuttal brief by filing an amended rebuttal brief. If the amended rebuttal brief filed in response to the examiner's letter does not overcome all the reasons for noncompliance with 37 CFR 41.71(a)-(d) stated in the examiner's letter, appellant will be so notified, but will not be given a second opportunity to file an amended rebuttal brief. That appellant's amended rebuttal brief will not be considered. 37 CFR 41.71(e). The examiner's notification letter will be mailed from the CRU.

After all rebuttal briefs and amended rebuttal briefs (where appellant is given an opportunity to correct a defective original rebuttal brief) have been received and the appropriate notification letters mailed, or the time for filing such briefs has expired, the proceeding



will be forwarded by the CRU to the Board of Patent Appeals and Interferences.

In a very rare situation, where the examiner finds that it is essential to address a rebuttal brief, the examiner must reopen prosecution. In order to reopen prosecution after an examiner's answer, the **CRU** Director must approve the same in writing, at the end of the action that reopens prosecution.

Form paragraphs 26.65 and 26.65.01 may be used to notify the parties of receipt and entry of the rebuttal brief(s).

¶ *26.65 Acknowledgment of Rebuttal Brief*

The rebuttal brief filed [1] by [2] has been entered.

**Examiner Note:**

1. Use a separate form paragraph 26.65 for each rebuttal brief that is received.
2. In bracket 1, insert the date the rebuttal brief was filed.
3. In bracket 2, insert the party that filed the rebuttal brief.

¶ *26.65.01 No Further Response*

No further response by the examiner is appropriate. Any further reply/comments by any party will be not be considered, and may be returned to the party that submitted it. The reexamination proceeding is being forwarded to the Board of Patent Appeals and Interferences for decision on the appeal(s).

Form paragraph 26.66 may be used to notify the parties of receipt of the rebuttal brief(s) that are defective.

¶ *26.66 Defective Rebuttal Brief-Opportunity to Correct*

A rebuttal brief must (1) clearly identify each issue and (2) point out *where* the issue was raised in the examiner's answer and/or in the respondent brief. In addition, the rebuttal brief must be limited to issues raised in the examiner's answer or in the respondent brief. The rebuttal brief of Appellant [1] is defective because [2].

Appellant [3] is given a period of ONE MONTH from the mailing date of this examiner's answer within which to file an amended rebuttal brief in response to this letter. Prosecution otherwise remains closed. The time for filing the amended rebuttal brief may not be extended.

If the amended rebuttal brief filed in response to the this letter does not remedy the defect or raises a new one, appellant will be so notified, but will not be given a second opportunity to file an amended rebuttal brief.

**Examiner Note:**

1. In brackets 1 and 3, insert the "patent owner" or the appropriate third party requester. Where there is one third party requester (the usual situation) insert "third party requester"; where there are two or more third party requesters (a merged proceeding), insert "third party requester" followed by the name of the third party requester (e.g., "third party requester Smith" or "third party requester XYZ Corporation").
2. This form paragraph is to be used once for each appellant filing a defective **original** rebuttal brief, to provide notification thereof.
3. For an appellant filing a defective **amended** rebuttal brief, use form paragraph 26.66.01.

Form paragraph 26.66.01 may be used to notify the appellant that the amended rebuttal brief is defective.

¶ *26.66.01 Defective Amended Rebuttal Brief-No Opportunity to Correct*

A rebuttal brief must (1) clearly identify each issue and (2) point out *where* the issue was raised in the examiner's answer and/or in the respondent brief. In addition, the rebuttal brief must be limited to issues raised in the examiner's answer or in the respondent brief. The amended rebuttal brief of Appellant [1] is defective because [2].

The original and amended rebuttal briefs have been placed in the file but will not be considered. There is **no** opportunity to file a second amended rebuttal brief, and any such submission will be returned.

**Examiner Note:**

1. In bracket 1, insert the "patent owner" or the appropriate third party requester. Where there is one third party requester (the usual situation) insert "third party requester"; where there are two or more third party requesters (a merged proceeding), insert "third party requester" followed by the name of the requester (e.g., "third party requester Smith" or "third party requester XYZ Corporation").
2. This form paragraph is to be used once for each defective **amended** rebuttal brief, to provide notification thereof. The notification letter should conclude with form paragraph 26.66.02, unless such is inappropriate for some reason.
3. For an appellant filing a defective **original** rebuttal brief, use form paragraph 26.66.

Form paragraph 26.66.02 may be used to notify the parties that the proceeding is being forwarded to the Board of Appeals and Interferences for decision on the appeal(s).

¶ *26.66.02 Forward to the Board for Decision*

The reexamination proceeding is being forwarded to the Board of Patent Appeals and Interferences for decision on the appeal(s).

## 2680 Oral Hearing [R-3]

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### 37 CFR 41.73. Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which an appellant or a respondent considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as an appeal decided after an oral hearing.

(b) If an appellant or a respondent desires an oral hearing, he or she must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months after the date of the examiner's answer. The time for requesting an oral hearing may not be extended. The request must include a certification that a copy of the request has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.

(c) If no request and fee for oral hearing have been timely filed by appellant or respondent as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant or respondent has complied with all the requirements of paragraph (b) of this section, a hearing date will be set, and notice given to the owner and all requesters. If an oral hearing is held, 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. The notice shall set a non-extendable period within which all requests for oral hearing shall be submitted by any other party to the appeal desiring to participate in the oral hearing. A hearing will be held as stated in the notice, and oral argument will be limited to thirty minutes for each appellant or respondent who has requested an oral hearing, and twenty minutes for the primary examiner unless otherwise ordered. No appellant or respondent will be permitted to participate in an oral hearing unless he or she has requested an oral hearing and submitted the fee set forth in § 41.20(b)(3).

(e)(1) At the oral hearing, each appellant and respondent may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the briefs except as permitted by paragraph (e)(2) of this section. The primary examiner may only rely on argument and evidence relied upon in an answer except as permitted by paragraph (e)(2) of this section. The Board will determine the order of the arguments presented at the oral hearing.

(2) Upon a showing of good cause, appellant, respondent and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(f) Notwithstanding the submission of a request for oral hearing complying with this rule, if the Board decides that a hearing is not necessary, the Board will so notify the owner and all requesters.<

If an appellant or a respondent desires an oral hearing in an appeal of an *inter partes* reexamination proceeding, he/she must file a written request for such hearing, accompanied by the fee set forth in 37 CFR \*>41.20(b)(3)<, within two months after the date of the examiner's answer. There is no extension of the time for requesting a hearing. 37 CFR \*>41.73(b)<. No appellant or respondent will be permitted to participate in an oral hearing, unless he or she has requested an oral hearing and submitted the fee set forth in 37 CFR \*>41.20(b)(3)<.

\*\*>Where the appeal involves reexamination proceedings, oral hearings are open to the public as observers (subject to the admittance procedures established by the Board), unless one of the appellants and/or the respondents (A) petitions under 37 CFR 41.3 that the hearing not be open to the public, (B) presents sufficient reasons for such a request, (C) pays the petition fee set forth in 37 CFR 41.20(a), and (D) the petition is granted.<

## 2681 Board of Patent Appeals and Interferences Decision [R-3]

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### 37 CFR 41.77. Decisions and other actions by the Board.

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

(b) Should the Board reverse the examiner's determination not to make a rejection proposed by a requester, the Board shall set forth in the opinion in support of its decision a new ground of rejection; or should the Board have knowledge of any grounds not raised in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement shall constitute a new ground of rejection of the claim. Any decision which includes a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the owner, within one month from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal proceeding as to the rejected claim:

(1) *Reopen prosecution.* The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

(c) Where the owner has filed a response requesting reopening of prosecution under paragraph (b)(1) of this section, any requester, within one month of the date of service of the owner's response, may once file comments on the response. Such written comments must be limited to the issues raised by the Board's opinion reflecting its decision and the owner's response. Any requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 41.20 (b)(1) and (2), respectively, which must accompany the comments or reply.

(d) Following any response by the owner under paragraph (b)(1) of this section and any written comments from a requester under paragraph (c) of this section, the proceeding will be remanded to the examiner. The statement of the Board shall be binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. The examiner will consider any owner response under paragraph (b)(1) of this section and any written comments by a requester under paragraph (c) of this section and issue a determination that the rejection is maintained or has been overcome.

(e) Within one month of the examiner's determination pursuant to paragraph (d) of this section, the owner or any requester may once submit comments in response to the examiner's determination. Within one month of the date of service of comments in response to the examiner's determination, the owner and any requesters may file a reply to the comments. No requester reply may address the comments of any other requester reply. Any requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 41.20 (b)(1) and (2), respectively, which must accompany the comments or reply.

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

(g) The time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956 of this title 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 para-

graph (b)(2) of this section. The time periods set forth in paragraphs (c) and (e) of this section may not be extended.<

After consideration of the record of the *inter partes* reexamination proceeding, including all briefs and the examiner's answer, the Board of Patent Appeals and Interferences (Board) issues its decision, affirming the examiner in whole or in part, or reversing the examiner's decision, sometimes also setting forth a new ground of rejection. Where there is reason to do so, the Board will sometimes remand the reexamination proceeding to the examiner for further consideration, prior to rendering a decision.

On occasion, the Board has refused to consider an appeal until after the conclusion of a pending civil action or appeal to the United States Court of Appeals for the Federal Circuit involving issues identical with, or similar to, those presented in the later appeal. Such suspension of action, postponing consideration of the appeal until the Board has the benefit of a court decision which may be determinative of the issues involved, has been recognized as sound practice.

## I. BOARD DECISION MAY CONTAIN NEW GROUND OF REJECTION

37 CFR \*>41.77(b)< provides express authority for the Board to include, in its decision, a recommendation for rejecting any claim found patentable by the examiner that the Board believes should be again considered by the examiner. 37 CFR \*>41.77(b)< is not intended as an instruction to the Board to revisit every patentable claim in every appealed proceeding. It is, rather, intended to give the Board express authority to act when it becomes apparent, during the consideration of the claims, that one or more patentable claims may be subject to rejection on either the same grounds or on different grounds from those applied against the rejected claims.

It should be noted that, pursuant to 37 CFR \*>41.77(a)<, the reversal of the examiner's determination not to make a rejection proposed by the requester constitutes a decision adverse to the patentability of the claims which are subject to that proposed rejection. Accordingly, such reversal will be set forth in the Board's decision as a new ground of rejection under 37 CFR \*>41.77(b)<.

## II. NON-FINAL BOARD DECISIONS

A decision of the Board which includes a new ground of rejection or a remand will not be considered as a final decision in the case. The Board, following conclusion of the proceedings before the examiner, will either adopt its earlier decision as final or will render a new decision based on all appealed claims, as it considers appropriate. In either case, final action by the Board will give rise to the alternatives available to a party to the appeal following a decision by the Board.

## III. NO BOARD RECOMMENDATION OF AMENDMENT TO MAKE CLAIM PATENTABLE

It should be noted that, unlike the practice for applications and *ex parte* reexaminations, the decision of the Board of Patent Appeals and Interferences **cannot** include an explicit statement that a claim may be allowed in amended form, whereby the patent owner would have the right to amend in conformity with that statement and it would be binding on the examiner in the absence of new references or grounds of rejection. The reason that the Board decision cannot make such a recommendation is that to permit the patent owner and the third party comment on a Board determination of the patentability of a hypothetical amended claim would be unduly complicated so late in the proceedings.

Additionally, in the absence of an express recommendation, a remark by the Board that a certain feature does not appear in a claim is **not** to be taken as a recommendation that the claim be allowed if the feature is supplied by amendment. *Ex parte Norlund*, 1913 C.D. 161, 192 O.G. 989 (Comm'r Pat. 1913).

## IV. REVIEW OF BOARD DECISION BY PETITION

Since review of the decisions of the Board is committed by statute to the Court of Appeals for the Federal Circuit, the Board's decisions are properly reviewable on petition **only to the extent of** determining whether they involve a convincing showing of error, abuse of discretion, or policy issue appropriate for higher level determination. Reasonable rulings made by the Board on matters resting in its discretion will not be disturbed upon petition. Thus,

for example, the Board's opinion as to whether it has employed a new ground of rejection will not be set aside on petition unless said opinion is found to be clearly unwarranted.

## V. PUBLICATION OF BOARD DECISIONS

Decisions of the Board may be published at the discretion of the \*\* Office. >See 37 CFR 41.6(a).< Requests by members of the public or parties to the reexamination proceeding to publish a decision of the Board should be referred to the Office of the Solicitor.

## 2682 Action Following Decision [R-5]

37 CFR 41.79. *Rehearing.*

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

- (1) The original decision of the Board under § 41.77(a),
- (2) The original § 41.77(b) decision under the provisions of § 41.77(b)(2),
- (3) The expiration of the time for the owner to take action under § 41.77(b)(2), or
- (4) The new decision of the Board under § 41.77(f).

(b)(1) The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the Board's opinion reflecting its decision. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs are not permitted in the request for rehearing except as permitted by paragraphs (b)(2) and (b)(3) of this section.

(2) Upon a showing of good cause, appellant and/or respondent may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(3) New arguments responding to a new ground of rejection made pursuant to § 41.77(b) are permitted.

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

(d) If a party to an appeal files a request for rehearing under paragraph (a) of this section, or a further request for rehearing under this section, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing. If the Board opinion reflecting its decision on rehearing becomes, in effect, a new decision, and the Board so indicates, then any party to the appeal may, within one month of the new decision, file a further request for rehearing of the new decision under this subsection. Such further

request for rehearing must comply with paragraph (b) of this section.

(e) The times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (c) of this section, and for submitting comments under paragraph (b) of this section may not be extended.

*37 CFR 41.81. Action following decision.*

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

*37 CFR 1.981. Reopening after a final decision of the Board of Patent Appeals and Interferences.*

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the *inter partes* reexamination proceeding will not be reopened or reconsidered by the primary examiner except under the provisions of § 41.77 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

The provisions of 37 CFR 41.77 through 41.79 and 37 CFR 1.979 through 1.983 deal with action by the parties and the examiner following a decision by the Board of Patent Appeals and Interferences (Board) in an *inter partes* reexamination proceeding.

After an appeal to the Board has been decided, a copy of the decision is mailed to all parties to the reexamination proceeding, and the original of the decision is placed in the file. The clerk of the Board notes the decision in the file history of the reexamination proceeding and in the record of appeals. The clerk then forwards the file to the Central Reexamination Unit (CRU), immediately, if the examiner is reversed, and after about 6 weeks if the examiner is affirmed or after a decision on a request for rehearing is rendered. The decision is processed *>*by*<* the CRU *>*support staff*<*, and the file is then forwarded to the examiner through the office of the *\*\*>*CRU*<* Director.

The Board, in its decision, may affirm or reverse the decision of the examiner, in whole or in part, on the grounds of rejection specified by the examiner and/or on the proposed grounds presented by a third party requester but not adopted by the examiner. A rejection of claims by the examiner may also be affirmed on the basis of the argument presented by the third party requester, and a finding of patentability may also be affirmed on the basis of the arguments presented by the patent owner. Further handling of the

reexamination proceeding will depend upon the nature of the Board's decision.

**I. THE BOARD AFFIRMS, REVERSES A REJECTION, OR AFFIRMS-IN-PART (AND REVERSES ONLY AS TO REJECTION(S))**

Where the Board decision (A) affirms the examiner in whole, (B) reverses the examiner in whole where only rejections were appealed, or (C) affirms in part and reverses in part, where the only examiner decision overturned is that of rejecting claims, in these situations, the case is forwarded to the CRU which processes the decision and then stores the case file. The CRU will retain the case file until the expiration of **both** the period for requesting rehearing of the decision by the Board (in accordance with 37 CFR 41.79), and the period for the patent owner seeking court review of the decision of the Board (in accordance with 37 CFR 1.983) - with no further action having been taken by any party to the appeal. The time period for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit is 2 months from the date of the decision of the Board plus any extension obtained under 37 CFR 1.304. See MPEP § 1216. The time period for requesting rehearing under 37 CFR 41.79 is one month and the one month period may not be extended. 37 CFR 41.79(e).

**A. No Action Taken by Parties to the Appeal**

Two weeks after the time for action by any party (to the appeal) has expired, the CRU *>*support staff*<* will forward the case (via the *\*>*CRU*<* Director) to the examiner. The two week delay is to permit any information as to requesting rehearing, or the filing of an appeal, to reach the CRU. Upon receipt of the reexamination, the examiner will take up the reexamination proceeding for action so that a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) can be issued in accordance with MPEP § 2687, to terminate the prosecution of the reexamination proceeding.

The following form paragraph should be used where the NIRC is issued:

*¶ 26.67.01 Periods for Seeking Court Review or Rehearing Have Lapsed*

The periods for seeking court review of, or a rehearing of, the decision of the Board of Patent Appeals and Interferences rendered [1] have expired and no further action has been taken by any

party to the appeal. Accordingly, the appeal in this reexamination proceeding is considered terminated; see 37 CFR 1.979(b). The present Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) is issued in accordance with MPEP § 2687 in order to terminate the present reexamination prosecution.

**Examiner Note:**

In bracket 1, enter the date of the Board decision.

The NIRC will indicate the status of all the claims in the case as a result of the Board decision. A red-ink line should be drawn by the examiner through any refused claims, and the notation “Board Decision” written in the margin in red ink. A statement will be included in the NIRC that “Claims \_\_\_\_ have been canceled as a result of the decision of the Board of Patent Appeals and Interferences dated \_\_\_\_\_.”

Claims indicated as patentable prior to appeal except for their dependency from rejected claims *not in the original patent* will be treated as if they were rejected. See MPEP § 1214.06. The following two examples should be noted:

- Claim 10 has been added to the patent during the reexamination, or claim 10 is a patent claim that was amended during the reexamination. Claim 11 depends on claim 10. If the Board affirms a rejection of claim 10 and claim 11 was objected to prior to appeal as being patentable except for its dependency from claim 10, the examiner should cancel both claims 10 and 11 by formal examiner’s amendment attached as part of the NIRC.

- On the other hand, if both claims 10 and 11 were rejected prior to the appeal, then the patent owner was never put on notice that claim 11 could be made allowable by placing it in independent form. Thus, where the Board affirms a rejection against claim 10 but reverses the rejections against dependent claim 11, the examiner should convert dependent claim 11 into independent form by formal examiner’s amendment and cancel claim 10 (for which the rejection was affirmed) in the NIRC. In this instance, the examiner could also set a time period of one month or 30 days (whichever is longer) in which the patent owner may rewrite dependent claim 11 in independent form. Extensions of time under 37 CFR 1.956 will be permitted. If no timely response is received, the examiner will cancel both claims 10 and 11 in the NIRC.

See MPEP § 2687 for further guidance in issuing the NIRC and terminating the prosecution of the reexamination proceeding.

**B. A Request for Rehearing of the Decision**

Any party to the appeal not satisfied with the Board decision may file a single request for rehearing of the decision. The request must be filed within one month from the date of the original decision under 37 CFR 41.77(a) or a new decision under 37 CFR 41.77(f). The one month period may not be extended. 37 CFR 41.79(e). The provisions of 37 CFR 41.79(b) require that any request must specifically state the points believed to have been misapprehended or overlooked in the Board’s decision, as well as all other grounds which rehearing is sought.

If a party does file a request for rehearing of the decision, any opposing party appellant or opposing party respondent may, within one month from the date of *service* of the request for rehearing, file responsive comments on the request for rehearing. 37 CFR 41.79(c). This one month period may not be extended. 37 CFR 41.79(e).

Where at least one request for rehearing of the decision is granted, the Board’s decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and the decision is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing. If the Board opinion reflecting its decision on rehearing indicates that the decision is a new decision, then any party to the appeal may, within one month of the new decision, file a further request for rehearing of the new decision. Such further request for rehearing must comply with 37 CFR 41.79(b). If the Board’s final decision on the request for rehearing is not timely appealed to the Court, the case is returned to the CRU for processing and subsequent forwarding to the examiner. When the examiner receives the reexamination from the CRU, the examiner will proceed to issue a NIRC and terminate the prosecution of the reexamination proceeding. 37 CFR 1.979(b).

**II. NEW GROUND OF REJECTION BY BOARD**

Pursuant to 37 CFR 41.77(b), the Board may, in its decision on appeal, make a new rejection of one or more appealed claims on grounds not raised in the appeal, in which case the patent owner has the option of:

(A) requesting rehearing under 37 CFR 41.79(a);  
or

(B) submitting an appropriate amendment of the rejected claims, and/or new evidence (e.g., a showing of facts) relating to the claim.

The parties do not have the option of an immediate appeal to the U.S. Court of Appeals for the Federal Circuit because the decision under 37 CFR 41.77(b) is not a final decision.

**A. A Request for Rehearing of the Decision Which Includes a New Ground of Rejection**

A patent owner's request for rehearing by the Board must be filed within a nonextendable one month period set by 37 CFR 41.79(a). By proceeding in this manner, the patent owner waives his or her right to further prosecution before the examiner. *In re Greenfield*, 40 F.2d 775, 5 USPQ 474 (CCPA 1930). If the patent owner does file a request for rehearing of the decision, any third party requester that is a party to the appeal may, within a non-extendable one month period from the date of service of the request for rehearing, file responsive comments on the request. 37 CFR 41.79(c).

**B. Submission of Amendment or Showing of Facts After Decision Which Includes a New Ground of Rejection**

If the patent owner elects to proceed before the examiner, the patent owner must take action within the one month period for response which will be set in the Board's decision. Extensions of time under 37 CFR 1.956 are available to extend the period. 37 CFR 41.77(g). The extension(s) may not, however exceed six months from the Board's decision.

When the patent owner submits a response pursuant to 37 CFR 41.77(b)(1), prosecution and examination will then be carried out under 37 CFR 41.77(c) through 37 CFR 41.77(f). Under 37 CFR 41.77(b)(1), the patent owner may amend the claims involved, or substitute new claims to avoid the art or reasons stated by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims, *Ex parte Comstock*, 317 O.G. 4, 1923 C.D. 82 (Comm'r Pat. 1923). The patent owner may also submit evidence or a showing of facts under

37 CFR 1.131 or 1.132, as may be appropriate. Argument without either amendment (of the claims so rejected) or the submission of evidence or a showing of facts (as to the claims so rejected) can result only in the examiner's determination to maintain the Board's rejection of the claims, since the examiner is without authority to find the claims patentable unless the claims are amended or unless the rejection is overcome by a showing of facts not before the Board. The new ground of rejection raised by the Board does not "reopen the prosecution" (under 37 CFR 41.77(b)(1) and 37 CFR 41.77(c) through 37 CFR 41.77(f) *except as to that subject matter to which the new rejection was applied*). Accordingly, any amendment or showing of facts **not** directed to that subject matter to which the new rejection was applied will be refused entry and will not be considered.

**III. BOARD DECISION REVERSES EXAMINER'S DETERMINATION NOT TO MAKE PROPOSED REJECTION**

Where the Board decision reverses the examiner in whole (or affirms in part and reverses in part, with at least one examiner decision overturned as to the proposed rejections the examiner refused to adopt) as to the proposed rejections the examiner refused to adopt, pursuant to 37 CFR 41.77(a), the Board's reversal of the examiner's determination not to adopt a rejection proposed by the third party requester constitutes a decision adverse to the patentability of the claims (which are subject to that proposed rejection). Accordingly, such reversal will be set forth in the Board's decision as a new ground of rejection under 37 CFR 41.77(b). See subsection II. above for the action taken after a new ground of rejection.

**IV. REMAND BY BOARD**

In accordance with 37 CFR 41.77(a), the Board, in its decision, may remand the reexamination proceeding to the examiner for further consideration. A Board decision which includes a remand in accordance with 37 CFR 41.77(a) will not be considered a "final decision" in the case.

The Board may remand the case to an examiner where appropriate procedure has not been followed, where further information is needed, or where the examiner is to consider something which the

examiner did not yet consider (or it is not clear that the examiner had considered it).

After the examiner has addressed the remand, the examiner will either return the case to the Board (via the CRU) or reopen prosecution as appropriate. The Board, following conclusion of the proceedings before the examiner, will either adopt its earlier decision as final (if the remand decision lends itself to same) or will render a new decision based on all appealed claims, as it considers appropriate. In either case, final action by the Board will give rise to the alternatives available following a decision by the Board.

#### A. *Reopening Prosecution of Case*

Reopening prosecution of a case after decision by the Board should be a rare occurrence. Cases which have been decided by the Board will not be reopened or reconsidered by the primary examiner, unless the provisions of 37 CFR 41.77 apply, or the written consent of the Director of the USPTO is obtained for the consideration of matters not already adjudicated, where sufficient cause has been shown. See 37 CFR 1.981.

A rejection under 37 CFR 41.77(b)(1) in effect nullifies the ACP and RAN and automatically reopens the prosecution of the subject matter of the claims so rejected by the Board. Accordingly, the written consent of the \*>CRU< Director is not required on the next Office action.

The written consent of the \*>CRU< Director is, however, required for an action reopening prosecution where the reexamination proceeding has been remanded to the examiner for a failure to follow appropriate procedure, to provide more information, or to consider something not yet considered, and the examiner then concludes after consideration of all the evidence and argument that a decision as to patentability made in the RAN should be changed. If so, the prosecution would be reopened with the written consent of the \*>CRU< Director and an ACP issued, so that any party adversely affected by the change in the examiner's position will have an opportunity to consider it and subsequently appeal the examiner's new decision.

The \*>CRU< Director will decide any petition to reopen prosecution of an *inter partes* reexamination proceeding after decision by the Board, where no

court action has been filed. MPEP § 1002.02(c), item 1. In addition, the Director of the USPTO entertains petitions to reopen certain cases in which an appellant has sought review by the court. This procedure is restricted to cases which have been decided by the Board and which are amenable to settlement without the need for going forward with the court proceeding. See MPEP § 1214.07.

### 2683 Appeal to Courts [R-3]

*35 U.S.C. 141. Appeal to the Court of Appeals for the Federal Circuit.*

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A patent owner, or a third-party requester in an inter partes reexamination proceeding, who is in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit.

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*37 CFR 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 U.S. Court of Appeals for the Federal Circuit, file a copy of the notice of appeal and pay the fee, as provided for in the rules of the U.S. Court of Appeals for the Federal Circuit; 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 requester 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 requester 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 fourteen 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 U.S. Court of Appeals for the Federal Circuit by mail to, or hand service on, the General Counsel as provided in § 104.2;

(2) In the U.S. Court of Appeals for the Federal Circuit, file a copy of the notice electing to participate in accordance with the rules of the U.S. Court of Appeals for the Federal Circuit; 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 U.S. Court of Appeals for the Federal Circuit.

## I. APPEAL TO UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT IS AVAILABLE

### A. For Any *Inter Partes* Reexamination Proceeding "Commenced" on or After November 2, 2002

Section 13106 of Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002), newly granted the *inter partes* reexamination **third party requester** the right to appeal an adverse decision of the Board of Patent Appeals and Interferences (Board) to the Court of Appeals for the Federal Circuit (Federal Circuit). 35 U.S.C. 315(b)(1). It further authorized 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)(2). Also, section 13106 of Public Law 107-273 implicitly permitted the patent owner to be a party to the newly provided for appeal taken by the third party requester to the Federal Circuit. This is because 35 U.S.C. 315(a)(2) 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)." The effective date for this revision to the statute is provided in sec-

tion 13106 of Public Law 107-273 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."

### 1. Appeal to the Federal Circuit

A patent owner and/or a third party requester in an *inter partes* reexamination proceeding who is a party to an appeal to the Board and who is dissatisfied with the decision of the Board may, subject to 37 CFR \*41.81<, appeal to the Federal Circuit. Pursuant to 37 CFR \*41.81<, the patent owner and/or third party requester may **not** appeal to the Federal Circuit until all parties' rights to request rehearing have been exhausted, at which time the decision of the Board is final and appealable to the Federal Circuit.

A patent owner or a third party requester appellant must take the following steps in such an appeal to the Federal Circuit (37 CFR 1.983(b)):

(A) In the Office, timely file a written notice of appeal directed to the Director of the USPTO in accordance with 37 CFR 1.302 and 1.304;

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

(C) Serve a copy of the notice of appeal on every other party in the reexamination proceeding in the manner provided in 37 CFR 1.248.

### 2. Cross Appeal

If the patent owner has filed a notice of appeal to the Federal Circuit, the third party requester may cross appeal to the Federal Circuit if also dissatisfied with the decision of the Board. 37 CFR 1.983(c).

If the third party requester has filed a notice of appeal to the Federal Circuit, the patent owner may cross appeal to the Federal Circuit if also dissatisfied with the decision of the Board. 37 CFR 1.983(d).

Such cross appeals would be taken under the rules of the Federal Circuit for cross appeals.

### 3. Participation in Other Party's Appeal

The patent owner and the third party requester may each be a party to, i.e., participate in, each other's appeal to the Federal Circuit from an *inter partes*

reexamination decision of the Board (37 CFR 1.983(e)).

A party electing to participate in an appellant's appeal must, within fourteen days of service of the appellant's notice of appeal (37 CFR 1.983(b)(3)) or notice of cross appeal (37 CFR 1.983(c) or (d)), take the following steps:

(A) In the Office, timely file a written notice directed to the Director of the USPTO electing to participate in the appellant's appeal to the Federal Circuit;

(B) In the Federal Circuit, file a copy of the notice electing to participate; and

(C) Serve a copy of the notice electing to participate on every other party in the reexamination proceeding in the manner provided in 37 CFR 1.248.

**B. For Any Inter Partes Reexamination Proceeding "Commenced" Prior to November 2, 2002**

In any reexamination proceeding commenced **prior** to November 2, 2002, only the patent owner can appeal to the U.S. Court of Appeals for the Federal Circuit. Pursuant to 35 U.S.C. 134(c), as it existed **prior** to its November 2, 2002 revision via Public Law 107-273, the third party requester is expressly precluded from appealing (and cross appealing) any decision of the Board in an *inter partes* reexamination proceeding commenced **prior** to November 2, 2002, to the Federal Circuit. The third party requester is also precluded from participating in any appeal taken by the patent owner to the Federal Circuit.

Pursuant to 37 CFR 1.983, a patent owner in a reexamination proceeding commenced **prior** to November 2, 2002, who is dissatisfied with the decision of the Board may, subject to 37 CFR 41.81, appeal to the Federal Circuit. Under 37 CFR 41.81, the patent owner may **not** appeal to the Federal Circuit until all parties' rights to request rehearing of the Board's decision have been exhausted, at which time the decision of the Board is final and appealable by the patent owner to the Federal Circuit.

The patent owner must take the following steps in such an appeal:

(A) In the Office, timely file a written notice of appeal directed to the Director of the USPTO in accordance with 37 CFR 1.302 and 1.304;

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

(C) Serve a copy of the notice of appeal on the third party requester(s) in the reexamination proceeding in the manner provided in 37 CFR 1.248.

**II. APPEAL TO U.S. DISTRICT COURT FOR THE DISTRICT OF COLUMBIA IS NOT AVAILABLE**

The remedy by civil action under 35 U.S.C. 145 is not available to the patent owner and the third party requester in an *inter partes* reexamination proceeding. Patent owners and third party requesters dissatisfied with a decision of the Board in an *inter partes* reexamination proceeding are not permitted to file a civil action against the Director of the USPTO in the U.S. District Court for the District of Columbia. Instead, they are limited to appealing decisions of the Office to the Federal Circuit.

When the optional *inter partes* reexamination alternative was added to the reexamination statute, the legislation did not provide the parties an avenue of judicial review by civil action under 35 U.S.C. 145 in *inter partes* reexamination proceedings (nor is this avenue available for *ex parte* reexamination of a patent that issued from an original application filed on or after November 29, 1999; see MPEP § 2279). Federal District Court proceedings are generally complicated and time consuming and, therefore, are contrary to the goal of expeditious resolution of reexamination proceedings. Accordingly, the first sentence of 35 U.S.C. 145 was amended to read: "An **applicant** dissatisfied with the decision of the Board of Patent Appeals and Interferences in an appeal under **134(a)** of this title may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Director appoints." (emphasis added). Note that 35 U.S.C. 134 part (a), which **is** included by 35 U.S.C. 145 is limited to applicants and applications, while 35 U.S.C. 134 parts (b) and (c) which **are not** included by 35 U.S.C. 145 are directed to reexamination and the patent owner and the third party requester, respectively.

## 2684 Information Material to Patentability in Reexamination Proceeding [Added R-2]

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

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

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

Duty of disclosure considerations as to *inter partes* reexamination proceedings parallel those of *ex parte* reexamination proceedings. In this regard, 37 CFR 1.933 incorporates the provisions of 37 CFR 1.555(a) and (b). See MPEP § 2280 for a discussion of the duty of disclosure in reexamination.

Any fraud practiced or attempted on the Office or any violation of the duty of disclosure through bad faith or intentional misconduct results in noncompliance with 37 CFR 1.555(a). This duty of disclosure is consistent with the duty placed on patent applicants by 37 CFR 1.56. Any such issues raised by the patent owner or the third party requester during an *inter partes* reexamination proceeding will merely be noted as unresolved questions under 37 CFR 1.906(c).

## 2685 No Interviews on Merits in *Inter Partes* Reexamination Proceedings [R-7]

37 CFR 1.955. *Interviews prohibited in inter partes reexamination proceedings.*

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Pursuant to 37 CFR 1.955, an interview which discusses the merits of a proceeding will not be permitted in *inter partes* reexamination proceedings. Thus, in an *inter partes* reexamination proceeding, there

will be no *inter partes* interview as to the substance of the proceeding. Also, there will be no separate *ex parte* interview as to the substance of the proceeding with either the patent owner or the third party requester. Accordingly, where a party requests any information as to the merits of a reexamination proceeding, the examiner will not conduct a personal or telephone interview with that party to provide the information. Further, an informal amendment by the patent owner will not be accepted, because that would be tantamount to an *ex parte* interview. All communications between the Office and the patent owner (and the third party requester) which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

Questions on strictly procedural matters may be discussed with the parties. The guidance to follow is that any information which a person could obtain *by reading the file* (which is open to the public) is procedural, and it *may be discussed*. Matters *not available from a reading of the file* are considered as relating to the merits of the proceeding, and *may not be discussed*. Thus, for example, a question relating to when the next Office action will be rendered is improper as it relates to the merits of the proceeding (because this information cannot be obtained from a reading of the file).

>The Office may, **in its sole discretion**, telephone a party as to matters of completing or correcting the record of a file, where the subject matter discussed does not go to the merits of the reexamination proceeding. This informal telephone call may take the form of inquiring as to whether a timely response, timely appeal, etc., was filed with the Office, so as to make certain that a timely response, timely appeal, etc. has not been misdirected within the Office. This may also take the form of telephoning to obtain a paper stated to have been attached to, or included in, a filing, but not found to be present in the record. Likewise, calls to obtain a certificate of service, or to have a party re-submit a paper (e.g., where it was submitted via an improper means), may be made by the Office. Any such telephone call IS NOT TO BE MADE by the examiner, or any other Office employee who addresses the proceeding on its merits. Thus, a paralegal or Legal Instruments Examiner (or support staff in general), may make such a telephone call. If the

party is reached by telephone and the matter is resolved, then the next Office communication as may be appropriate (e.g., Office action, NIRC) \*>should< will make the telephone call of record. Any statement of the telephone call in the next communication must provide that “the content of the telephone call was limited solely to” the non-merits matter discussed, and “nothing else was discussed.” Such a telephone call is not to be recorded on an interview summary record form.

It is also permitted for a paralegal or Legal Instruments Examiner (or support staff in general) to call a requester to discuss a request that fails to comply with the filing date requirements for filing a reexamination request, because there is no reexamination proceeding yet, and 37 CFR 1.955 proscribes interviews in “*inter partes* reexamination proceedings.”<

## **2686 Notification of Existence of Prior or Concurrent Proceedings and Decisions Thereon [R-7]**

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

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

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

It is important for the Office to be aware of any prior or concurrent proceedings in which a patent undergoing *inter partes* reexamination is or was involved, such as interferences, reissues, reexaminations or litigations, and any results of such proceedings. In accordance with 37 CFR 1.985, the patent owner is required to provide the Office with information regarding the existence of any such proceedings, and the results thereof, if known. Ordinarily, while an *inter partes* reexamination proceeding is pending, third party submissions filed after the date of the order are not entered into the reexamination file or the

patent file, unless the third party is a third party reexamination requester. However, in order to ensure a complete file, with updated status information regarding prior or concurrent proceedings regarding the patent under reexamination, the Office will, at any time, accept from any parties, for entry into the reexamination file, copies of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent. >Such decisions include final court decisions (even if the decision is still appealable), decisions to vacate, decisions to remand, and decisions as to the merits of the patent claims. Non-merit decisions on motions such as for a new venue, a new trial/discovery date, or sanctions will not be entered into the patent file, and will be expunged from the patent file by closing the appropriate paper if they were entered before discovery of their nature. Further, papers filed in the court from litigations or other proceedings involving the patent will not be entered into the record (and will be expunged if already entered) if they provide a party’s arguments, such as a memorandum in support of summary judgment. If the argument has an entry right in the reexamination proceeding, it must be submitted via the vehicle (provision(s) of the rules) that provides for that entry right. It is not required nor is it permitted that parties submit copies of copending reexamination proceedings and applications (which copies can be mistaken for a new request/filing); rather, submitters may provide a notice identifying the application/proceeding number and its status. Any submission that is not permitted entry will be returned, expunged, or discarded, at the sole discretion of the Office.<

It is to be noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return>, expunge or discard, at its sole discretion,< all or part of the submission. In such an instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers. Persons making such submissions must limit the submissions to the notification, and must not include further arguments or information. Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office. It is to

be understood that highlighting of certain text by underlining, fluorescent marker, etc., goes beyond bare notice of the prior or concurrent proceedings. Any proper submission pursuant to 37 CFR 1.985 will be promptly entered into the record of the reexamination file. See MPEP § 2686.04 for Office investigation for prior or concurrent litigation.

## 2686.01 Multiple Copending Reexamination Proceedings [R-7]

37 CFR 1.989. *Merger of concurrent reexamination proceedings.*

(a) *\*\*>*If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.<

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

This section discusses multiple copending reexamination requests which are filed on the same patent, where at least one of the multiple copending reexamination requests is an *inter partes* request. If all of the multiple copending reexamination requests are *ex parte* requests, see MPEP § 2283.

Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.

Case (1) - The earlier (pending) reexamination is an *inter partes* reexamination:

(1)(a) The subsequent request is an *inter partes* reexamination request. Pursuant to 35 U.S.C. 317(a), once an order for *inter partes* reexamination has been issued in a first reexamination proceeding, neither the third party requester, nor its privy, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director of the USPTO. In addition, the patent owner is not entitled to file any *inter partes* reexamination request (see MPEP § 2612). Thus, only a third party who is not a party to the earlier pending *inter partes* reexamination pro-

ceeding (nor a privy) can file the subsequent *inter partes* reexamination request.

(1)(b) The subsequent request is an *ex parte* reexamination request. Any party (including the patent owner) can file the subsequent *ex parte* reexamination request.

Case (2) - The earlier (pending) reexamination is an *ex parte* reexamination:

(2)(a) The subsequent request is an *inter partes* reexamination request. Any party other than the patent owner can file the subsequent *inter partes* reexamination request.

(2)(b) The subsequent (later) request is an *ex parte* reexamination request. Any party (including the patent owner) can file the subsequent *ex parte* reexamination request.

In order for the second or subsequent request to be granted, a substantial new question of patentability must be raised by the art (patents and/or printed publications) cited in the second or subsequent request for reexamination. See MPEP § 2640 regarding whether a substantial new question of patentability is raised by the art cited in a second or subsequent request filed while a first reexamination proceeding is pending.

If the second or subsequent request is granted, the decision on whether or not to merge the proceedings will be made by the Office of Patent Legal Administration. (OPLA). No decision on merging the reexaminations should be made until such time as reexamination *\*\*>*has been ordered for both proceedings, and there is no longer an opportunity for filing a patent owner's statement and/or requester's reply (if an *ex parte* reexamination is one of the proceedings).<

### I. WHEN PROCEEDINGS ARE MERGED

*\*\*>*Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

Where a second request for reexamination is filed while a first reexamination proceeding is pending, the second request is decided based on the claims in effect

at the time of the determination (see 37 CFR 1.923), and if reexamination is ordered (and the statement-reply period expires for any *ex parte* reexamination proceeding), the question of merger will then be considered. If the proceedings are merged, the prosecution will be conducted at the most advanced point possible for the first proceeding. Thus, if a final rejection (a Right of Appeal Notice) has been issued in the first proceeding, prosecution will ordinarily be reopened to consider the substantial new question of patentability presented in the second request unless the examiner concludes that no new rejection or change of position is warranted. Also, the patent owner will be provided with an opportunity to respond to any new rejection in a merged reexamination proceeding prior to an Action Closing Prosecution (ACP) being issued. See MPEP § 2671.02.

Where the reexamination proceedings are merged, a single certificate will be issued and published based upon the merged proceedings, 37 CFR 1.989(a).

## II. WHEN PROCEEDING IS SUSPENDED

It may also be desirable in certain situations to suspend one of the proceedings for a short and specified period of time. For example, a suspension of a first reexamination proceeding may be issued to allow time for the decision on the second request. Further, after the second proceeding has been ordered, it may be desirable to suspend the second proceeding prior to merging, where the first proceeding is presently on appeal before a Federal court to await the court's decision prior to merging. A suspension will only be granted in exceptional (extraordinary) instances because of the statutory requirements that examination proceed with "special dispatch", and the express written approval by the OPLA must be obtained. Suspension will not be granted when there is an outstanding Office action.

## III. MERGER OF REEXAMINATIONS

The following guidelines should be observed when two requests for reexamination directed to a single patent have been filed:

The second request (i.e., Request 2) should be processed as quickly as possible, and assigned to the same examiner to whom the first request (i.e., Request 1) is assigned. Request 2 should be decided immedi-

ately after consultation with the Reexamination Legal Advisor (RLA). If Request 2 is denied, prosecution of Request 1 should continue. If Request 2 is granted, a first Office action on the merits will not be sent with the order granting reexamination in the second proceeding. Instead, the order will indicate that an Office action will follow in due course. MPEP § 2660. The order granting the second proceeding will be prepared, reviewed by the Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) and then **hand-carried** directly to the CRU support staff. The order will be mailed specially, and the two proceedings will be forwarded to OPLA for preparation of a decision whether to merge the two proceedings.

A decision to merge the reexamination proceedings should include a requirement that the patent owner maintain identical claims in both files. It will further require that responses/comments by the patent owner and the third party requester(s) must consist of a single response/comment paper, addressed to both files, filed in duplicate each bearing a signature, for entry in both files. The same applies to any other paper filed in the merged proceeding. The decision will point out that both files will be maintained as separate complete files. Where the claims are already the same in both reexamination files, the decision on merger will indicate at its conclusion that an Office action will be mailed in due course, and that the patent owner need not take any action at present. Where the claims are not the same in both files, the decision will state at its conclusion that patent owner is given one month to provide an amendment to make the claims the same in each file. After the decision of merger is prepared and signed, the decision will be hand-carried directly to the CRU, where the decision will be mailed specially.

Where the merger decision indicates that an Office action will follow, the merged proceeding is immediately returned to the examiner, to issue an Office action, after the CRU mailing and processing of the decision. Where the merger decision indicates that the patent owner is given one month to provide an amendment to make the claims the same in each file (identical amendments to be placed in all files), the CRU will retain jurisdiction over the merged reexamination proceeding to await submission of the amendment or the expiration of the time to submit the amendment. After the amendment is received and

processed by the CRU, or the time for submitting the amendment expires, the merged proceeding will be returned to the examiner, to issue an Office action.

Once the merged proceeding is returned to the examiner for issuance of an Office action, the examiner should after consultation with the RLA, prepare the action at the most advanced point possible for the first proceeding. Thus, if the first proceeding is ready for an Action Closing Prosecution (ACP) and the second proceeding does not provide any new information which would call for a new ground of rejection, the examiner should issue an ACP for the merged proceeding using the guidance for the prosecution stage set forth below.

If the decision on the reexamination request has not yet been made in Request 1 and Request 1 is grantable, it should be processed to the point where an order granting reexamination is mailed. *An Office action should not be mailed with the order.* Then, Request 1 is normally held until Request 2 is ready for the prosecution stage following an order granting reexamination, or until Request 2 is denied. Request 2 should be determined on its own merits *without reference* in the decision to Request 1. As before, an Office action should not be mailed with the order in Request 2.

#### A. *The Prosecution Stage, After Merger*

>Where merger is ordered, the patent owner is required to maintain identical amendments in the merged reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in the files is required as long as the reexamination proceedings remain merged. Where identical amendments are not present in the reexamination files at the time merger is ordered, the patent owner will be required to submit an appropriate “housekeeping” amendment placing the same amendments in the proceedings. This may be accomplished by amending one or more of the proceedings, as appropriate. The patent owner must not address any issue of patentability in the housekeeping amendment. In the event that an amendment to make the claims the same in each file is required by the merger decision (identical amendments to be placed in all files) but is not timely submitted, any claim that does not contain identical text in all of the merged proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being

indefinite as to the content of the claim, and thus failing to particularly point out the invention.<

When prosecution is appropriate in merged proceedings, a single combined examiner’s action will be prepared. Each action will contain the control number of the two proceedings on every page. A single action cover form (having both control numbers penned in at the top) will be provided by the examiner to the clerical staff. The clerical staff will copy the action cover form, and then use the PALM printer to print the appropriate data on the original for the first request, and on the copy for the second request. Each requester will receive a copy of the action and both action cover forms, with the transmission form PTOL-2070 placed on top of the package. The patent owner will get a copy of both action cover forms and the action itself.

When a “Notice of Intent To Issue *Inter Partes* Reexamination Certificate” (NIRC) is appropriate, plural notices will be printed. Both reexamination files will then be processed. The CRU should prepare the file of the concurrent proceedings in the manner specified in MPEP § 2687, before release to Office of \*>Data Management< (via the CRU).

The above guidance should be extended to situations where more than two requests for reexamination are filed for a single patent. The guidance should also be extended to situations where one of the requests is a request for *ex parte* reexamination. However, where an *ex parte* reexamination is to be included in the merger, allowance must be made for the statement and reply periods provided for in an *ex parte* reexamination after the order granting reexamination is issued. If all the reexamination proceedings to be merged are *ex parte* reexaminations, the present section does not apply, but rather see MPEP § 2283.

#### IV. PROCEEDINGS NOT MERGED

Pursuant to 35 U.S.C. 314(c), “[u]nless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section...shall be conducted with special dispatch within the Office.” This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination \*\*>will unduly delay< the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first

reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory “special dispatch” requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster “special dispatch.” The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis.

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For processing of the second reexamination proceeding, see MPEP § 2295 and § 2695.

## V. FEES IN MERGED PROCEEDINGS

Where the proceedings have been merged and a paper is filed which requires payment of a fee (e.g., excess claims fee, extension of time fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for the patent owner’s appellant brief (or that of the third party requester), even though the brief relates to merged multiple proceedings and copies must be filed for each file in the merged proceeding.

## VI. PETITION TO MERGE MULTIPLE COPENDING REEXAMINATION PROCEEDINGS

No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings. If any petition to merge the proceedings is filed prior to the order to reexamine the second request, it will not be considered but will be returned to the party submitting the same by the OPLA. The decision returning such a premature petition will be

made of record in both reexamination files, but no copy of the petition will be retained by the Office. See MPEP § 2667.

The patent owner can file a petition to merge the proceedings at any time after the order to reexamine the second request. A requester of any of the multiple reexamination proceedings may also petition to merge the proceedings at any time after the order to reexamine the second request. A petition to merge the multiple proceedings which is filed by a party other than the patent owner or one of the third party requesters of the reexaminations will not be considered but will be returned to that party by the OPLA. Note that the acceptance of a petition to merge the multiple proceedings at any time after the order to reexamine the second request is contrary to 37 CFR 1.939 since such acceptance can be prior to the issuance of the first Office action. Accordingly, the requirement of 37 CFR 1.939 is hereby waived to the extent that a petition for merger of a reexamination proceeding with a reexamination proceeding or with a reissue (see MPEP § 2686.03) can be submitted after the order to reexamine has been issued in all the reexamination proceedings to be merged. This waiver is made to assure merger at the earliest possible stage.

All decisions on the merits of petitions to merge multiple reexamination proceedings, where at least one of the proceedings is an *inter partes* reexamination, will be made by the OPLA.

Decisions on the merits of petitions to merge multiple reexamination proceedings, where none of the proceedings is an *inter partes* reexamination, will be made by the CRU Director (or by the CRU SPE, if the CRU Director delegates such to the CRU SPE); see MPEP § 2283.

## 2686.02 Copending Reexamination and Interference Proceedings [R-3]

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

If a patent in the process of *inter partes* reexamination is or becomes involved in an interference, the Director may suspend the *inter partes* reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion under § 41.121(a)(3) of this title to suspend the interference has been presented to, and denied by, an administrative patent judge and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion



for suspension or such other time as the administrative patent judge may set.

*37 CFR 41.8. Mandatory notices.*

(a) In an appeal brief (§§ 41.37, 41.67, or 41.68) or at the initiation of a contested case (§ 41.101), and within 20 days of any change during the proceeding, a party must identify:

- (1) Its real party-in-interest, and
- (2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

(b) For contested cases, a party seeking judicial review of a Board proceeding must file a notice with the Board of the judicial review within 20 days of the filing of the complaint or the notice of appeal. The notice to the Board must include a copy of the complaint or notice of appeal. See also §§ 1.301 to 1.304 of this title.

*37 CFR 41.102. Completion of examination.*

Before a contested case is initiated, except as the Board may otherwise authorize, for each involved application and patent:

- (a) Examination or reexamination must be completed, and
- (b) There must be at least one claim that:
  - (1) Is patentable but for a judgment in the contested case, and
  - (2) Would be involved in the contested case.

*37 CFR 41.103. Jurisdiction over involved files.*

The Board acquires jurisdiction over any involved file when the Board initiates a contested case. Other proceedings for the involved file within the Office are suspended except as the Board may order.

A patent being reexamined in an *inter partes* reexamination proceeding may be involved in an interference proceeding with at least one application, where the patent and the application are claiming the same patentable invention, and at least one of the application's claims to that invention are patentable to the applicant. See MPEP \*Chapter 2300\*.

The general policy of the Office is that a reexamination proceeding will not be delayed, or stayed, because of an interference or the possibility of an interference. The \*reason\* for this policy \*is\* the requirement of 35 U.S.C. 314(c) that all reexamination proceedings be conducted with "special dispatch" within the Office. \*\*

In general, the Office will follow the practice of making the required and necessary decisions in the *inter partes* reexamination proceeding and, at the same time, going forward with the interference to the extent desirable. (See *Shaked v. Taniguchi*, 21 USPQ2d 1289 (Bd. Pat. App. & Inter. 1991), where it was pointed out that neither the reexamination nor the interference will ordinarily be stayed where both pro-

ceedings are before the Office.) It is to be noted that 37 CFR 41.103 provides the Board with the flexibility to tailor a specific solution to occurrences where reexamination and interference proceedings for the same patent are copending, as such occurrences may arise. Decisions in the interference will take into consideration the status of the reexamination proceeding and what is occurring therein. The decision as to what actions are taken in the interference will, in general, be taken in accordance with normal interference practice.

\*\*>Although< a patent being reexamined via a reexamination proceeding may become involved in an interference proceeding, the reexamination proceeding itself can never be involved in an interference proceeding. See 35 U.S.C. 135(a) which states that "[w]henever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent, an interference may be declared" (emphasis added). The reexamination proceeding is neither an application nor a patent.

**I. ATTEMPTING TO PROVOKE AN INTERFERENCE WITH A PATENT INVOLVED IN A REEXAMINATION PROCEEDING**

See MPEP § 2284 for a discussion of the situation where an amendment seeking to provoke an interference with a patent involved in a reexamination proceeding is filed in a pending application. The practice and procedure in this area as to *inter partes* reexamination proceedings parallels that of *ex parte* reexamination proceedings.

**II. MOTION TO SUSPEND INTERFERENCE UNDER 37 CFR \*41.121(a)(3)\* PENDING THE OUTCOME OF A REEXAMINATION PROCEEDING**

A >miscellaneous< motion under 37 CFR \*41.121(a)(3)\* to suspend an interference pending the outcome of a reexamination proceeding may be made at any time during the interference by any party thereto. >See 37 CFR 41.123(b) for the proper procedure.< The motion must be presented to the Administrative Patent Judge (APJ) who will decide the motion based on the particular fact situation. However, >suspension is not favored. Normally,< no consideration will be given such a motion unless and

until a reexamination order is issued, nor will suspension of the interference normally be permitted until after any motions have been disposed of in the interference proceeding. If the motion under 37 CFR 41.121(a)(3) is denied by the APJ, a request to stay the interference may be made to the Director of the USPTO under 37 CFR 1.993. A request to stay an interference under 37 CFR 1.993 will be decided by the Chief Administrative Patent Judge of the Board.

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### III. < REQUEST FOR REEXAMINATION FILED DURING INTERFERENCE

In view of the provisions of 37 CFR 1.913, “[a]ny person may, at any time during the period of enforceability of a patent” file a request for *inter partes* reexamination. Under 37 CFR 41.8(a), the patent owner must notify the Board that a request for reexamination was filed within twenty days of receiving notice of the request having been filed. Such requests for reexamination will be processed in the normal manner. No delay, or stay, of the reexamination will occur where the third party requester is not a party to the interference, or where the requester is a party to the interference but does not timely petition for a stay or delay. If the examiner orders reexamination pursuant to 37 CFR 1.931 and subsequently, in the reexamination proceeding, rejects a patent claim corresponding to a count in the interference, the attention of the Board shall be called to the rejection.

\*\*>

### IV. < PETITION TO STAY REEXAMINATION PROCEEDING BECAUSE OF INTERFERENCE

Any petition to stay an *inter partes* reexamination proceeding, because of an interference, which is filed prior to the first Office action in the reexamination proceeding will not be considered, but will be returned to the party submitting the petition. See 37 CFR 1.939 and MPEP § 2625. The decision returning such a premature petition will be made of record in the reexamination file, but no copy of the petition will be retained by the Office. A petition to stay the reexamination proceeding because of the interference may be filed by the patent owner after the first Office

action in the reexamination proceeding. If a party to the interference, other than the patent owner, is also a requester of the reexamination, that party may also petition to stay the reexamination proceeding after the first Office action. If the party to the interference other than patent owner is not the reexamination requester, any petition by that party is improper under 37 CFR 1.905 and will not be considered. Any such improper petitions will be returned to the party submitting the same. Premature petitions to stay the reexamination proceedings, i.e., those filed prior to the first Office action in the reexamination proceeding, will be returned by a Legal Advisor of the Office of Patent Legal Administration (OPLA) as premature. Petitions to stay filed subsequent to the date of the first Office action in the reexamination proceeding will be referred to the OPLA for decision by a Senior Legal Advisor of that Office. All decisions on the merits of petitions to stay a reexamination proceeding because of an interference will be made in the OPLA.

\*>

### V. < ACTION IN INTERFERENCE FOLLOWING REEXAMINATION

If one or more claims of a patent which is involved in an interference are canceled or amended by the issuance and publication of a reexamination certificate, the Board must be promptly notified.

Upon issuance and publication of the reexamination certificate, the patent owner must notify the Board of such issuance.

## 2686.03 Copending Reexamination and Reissue Proceedings [R-7]

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

\*\*>If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 through 1.997 and 41.60 through 41.81, except that such participation shall be limited to

issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files. Any *inter partes* reexamination proceeding merged with a reissue application shall be concluded by the grant of the reissued patent. <

**37 CFR 1.937. Conduct of *inter partes* reexamination.**

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

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**37 CFR 1.995. Third party requester's participation rights preserved in merged proceeding.**

When a third party requester is involved in one or more proceedings, including an *inter partes* reexamination proceeding, the merger of such proceedings will be accomplished so as to preserve the third party requester's right to participate to the extent specifically provided for in these regulations. In merged proceedings involving different requesters, any paper filed by one party in the merged proceeding shall be served on all other parties of the merged proceeding.

**37 CFR 1.997. Issuance and publication of *inter partes* reexamination certificate concludes *inter partes* reexamination proceeding.<**

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

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

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

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**37 CFR 1.176. Examination of reissue.**

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

\*\*\*\*\*

The general policy of the Office is that the examination of a reissue application and an *inter partes* reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to permit timely resolution of both the reissue and the reexamination to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two files on behalf of the patent owner. If both a reissue application and a reexamination proceeding are pending concurrently on a patent, a decision will normally be made to merge the reissue application examination and the reexamination or to stay one of the two. See *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985). The decision as to whether the reissue application examination and the reexamination proceeding are to be merged, or which of the two (if any) is to be stayed, is made in the Office of Patent Legal Administration (OPLA).

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, the patent owner, i.e., the reissue applicant, has a responsibility to notify the Office of such. 37 CFR 1.178(b), 1.565(a), and 1.985. The patent owner should file in the reissue application, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.178(b) in order to notify the Office in the reissue application of the existence of the reexamination proceeding on the same patent. See MPEP § 1418. In addition, the patent owner should file in the reexamination proceeding, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.565(a) or 1.985 (depending on whether the reexamination proceeding is an *ex parte* reexamination proceeding or an *inter partes* reexamination proceeding) to notify the Office in the reexamination proceeding of the existence of the two concurrent proceedings.

**I. TIME FOR MAKING DECISION ON MERGING OR STAYING THE PROCEEDINGS**

A decision whether or not to merge the examination of a reissue application and an *inter partes* reexamination proceeding, or to stay one of the two, will not be made prior to the mailing of the order to reexamine the patent pursuant to 37 CFR 1.931. Until such time as the reexamination is ordered, the examination of the reissue application will proceed. A determination

on the request for reexamination should not be delayed despite the existence of a copending reissue application, since 35 U.S.C. 312(a) requires a determination within 3 months following the filing date of the request. See MPEP § 2641. If the decision on the request denies reexamination (MPEP § 2647), the examination of the reissue application should be continued. If reexamination is to be ordered (MPEP § 2646), the signed order should be (after review by the **>Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE)<** promptly forwarded to the **>CRU<** support staff for mailing; no first Office action will accompany the decision ordering reexamination. At the same time that the signed order is forwarded to OPLA, (A) OPLA should be notified that the proceedings are ready for consideration of merger, and (B) if any of the reexamination file, the reissue application, and the patent file are paper files, they should be hand delivered to the OPLA.

If a reissue application is filed during the pendency of a reexamination proceeding, the OPLA should be notified, as promptly as possible after the reissue application reaches the **>Technology Center (TC)<**, that the proceedings are ready for consideration of merger. If any of the reexamination file, the reissue application, and the patent file are paper files, they should be hand delivered to the OPLA at the time of the notification to OPLA.

The decision on whether or not to merge the reissue application examination and the reexamination proceeding or which (if any) is to be stayed (suspended), will generally be made as promptly as possible after receipt of the notification to OPLA, and delivery of all the paper files to the OPLA.

Until a decision is mailed merging the reissue application examination and the reexamination proceeding, or staying one of them, prosecution in the reissue application and the reexamination proceeding will continue and be conducted simultaneously, but separately.

The Office may in certain situations issue a certificate at the termination of the prosecution of a reexamination proceeding, even if a copending reissue application or another reexamination request has already been filed.

## II. CONSIDERATIONS IN DECIDING WHETHER TO MERGE THE REISSUE AND REEXAMINATION OR WHETHER TO STAY ONE OF THEM

The decision on whether to merge the reissue application examination and reexamination proceeding, or stay one of them, will be made on a case-by-case basis. **>**The decision to merge, or not to merge, is within the sole discretion of the Office to facilitate/carry out the orderly operation of the Office in addressing the proceedings. The status of the reissue application and the reexamination proceeding will be taken into account in the decision as to whether merger will be ordered, or one of the two proceedings stayed. **<** Where there is “good cause” to stay the reexamination proceeding, the Director may do so pursuant to 35 U.S.C. 314(c). **\*\***

### A. *Reissue About To Issue, Reexamination Requested*

If the reissue patent will issue before the determination on the reexamination request must be made, the determination on the request should normally be made after the granting of the reissue patent; and then the determination should be made on the basis of the claims in the reissue patent. The reexamination, if ordered, would then be based on the reissue patent claims rather than the original patent claims. Since the reissue application would no longer be pending, the reexamination would be processed in a normal manner.

Where a reissue patent has been issued, the determination on the request for reexamination should specifically point out that the determination has been made on the claims of the reissue patent and not on the claims of the original patent. Any amendment made in the reexamination proceeding should treat the changes made by the reissue as the text of the patent, and all bracketing and underlining made with respect to the patent **as changed by the reissue**. Note that the reissue claims used as the starting point in the reexamination proceeding must be presented in the reexamination proceeding as a “clean copy.” Thus, words bracketed in the reissue patent claim(s) would not appear at all in the reexamination clean copy of the claim(s). Also, words that were added via the reissue patent will appear in italics in the reissue patent, but

must appear in plain format in the reexamination clean copy of the claim(s).

If a reissue patent issues on the patent under reexamination after reexamination is ordered, the next action from the examiner in the reexamination should point out that further proceedings in the reexamination will be based on the claims of the reissue patent and not on the patent surrendered. Form paragraph 22.05 may be used in the Office action.

¶ 22.05 *Reexamination (Ex Parte or Inter Partes) Based on Reissue Claims*

In view of the surrender of original Patent No. [1] and the granting of Reissue Patent No. [2] which issued on [3], all subsequent proceedings in this reexamination will be based on the reissue patent claims.

Where the reissue patent has issued prior to the filing of a request for reexamination of the original patent, see MPEP § 2640.

**B. Reissue Pending, Reexamination Request Filed**

Where a reissue patent will not be granted prior to the expiration of the 3-month period for making the determination on the reexamination request, a decision will be made *after an order to reexamine is issued* as to whether the reissue application examination and the reexamination proceeding are to be merged, or which of the two (if any) is to be stayed. In this situation, no first Office action will have accompanied the order for reexamination.

In making a decision on whether or not to merge the reissue application examination and the reexamination proceeding, consideration will be given as to whether issues are raised in the reissue application that would not be proper for consideration in reexamination and/or not be proper for comment by the reexamination third party requester. If such issues are raised, merger would ordinarily **not** be ordered, and one of the two proceedings stayed. Consideration will also be given to the status of the reissue application examination at the time the order to reexamine the patent pursuant to 37 CFR 1.931 is mailed. For example, if the reissue application is on appeal to the Board of Patent Appeals and Interferences (Board) or to the courts, that fact would be considered in making a decision whether to merge the reissue application examination and the reexamination proceeding or stay one of them. See *In re Scragg*, 215 USPQ 715

(Comm'r Pat. 1982), *In re Stoddard*, 213 USPQ 386 (Comm'r Pat. 1982).

If merger of the reissue application examination and the reexamination proceeding is ordered, the order merging them will also require that the patent owner place the same claims in the reissue application and in the reexamination proceeding for purposes of the merger. The decision to merge may require an amendment to be filed by the patent owner to provide identical sets of claims, within a specified time set in the decision to merge.

If merger would be appropriate, but the examination of the reissue application has progressed to a point where a merger is not desirable at that time, then the reexamination proceeding will generally be stayed until the reissue application examination is complete on the issues then pending. After completion of the examination on the issues then pending in the reissue application examination, the stay of the reexamination proceeding will be removed. The proceedings would be merged if the reissue application is pending, or the reexamination proceeding will be conducted separately if the reissue application has become abandoned. The reissue application examination would be reopened, if necessary, for merger of the reexamination proceeding therewith. If a stay of a reexamination proceeding has been removed following a reissue application examination, the first Office action will set a shortened statutory period for response of one month or thirty days (whichever is longer) unless a longer period for response clearly is warranted by the nature of the examiner's action. The second Office action will normally be final and will also set a one month or thirty days period for response. These shortened periods are considered necessary to prevent undue delay in concluding the proceedings and also to proceed with "special dispatch" in view of the earlier stay.

If the reissue application examination and reexamination proceedings are merged, the issuance of the reissue patent will also serve as the *inter partes* reexamination certificate under 37 CFR 1.997, and the reissue patent will so indicate.

**C. Reexamination Proceedings Underway, Reissue Application Filed**

When a reissue application is filed after an *inter partes* reexamination request has been filed, the

OPLA should be notified, as promptly as possible after the reissue application reaches the TC. A determination will be made as to whether reexamination should be ordered. If reexamination is ordered, no first Office action will accompany the decision ordering reexamination. The order and any of the files that are paper files should then be hand delivered to the OPLA.

Where reexamination has already been ordered prior to the filing of a reissue application, the OPLA should be notified, as promptly as possible after the reissue application reaches the TC, that the proceedings are ready for consideration of merger. If any of the reexamination file, the reissue application, and the patent file are paper files, they should be hand delivered to the OPLA at the time of the e-mail notification to OPLA.

In making a decision on whether or not to merge the reissue application examination and the reexamination proceeding, consideration will be given as to whether issues are raised in the reissue application that would not be proper for consideration in reexamination and/or not be proper for comment by the reexamination third party requester. If such issues are raised, merger would ordinarily **not** be ordered, and one of the two proceedings stayed. In addition, consideration will also be given to the status of the reexamination proceeding. For example, if the reexamination proceeding is on appeal to the Board or to the Court of Appeals for the Federal Circuit, or a Notice of Intent to Issue a Reexamination Certificate was issued for the reexamination proceeding, that fact would be considered in making a decision whether to merge the reissue application examination and the reexamination proceeding or stay one of them.

#### **D. Examiner Assignment**

With respect to the appropriate examiner assignment of the merged reexamination proceeding and the reissue application examination, see MPEP § 2636.

### **III. CONDUCT OF MERGED REISSUE AND REEXAMINATION PROCEEDING**

The decision ordering merger will set forth the practice and procedure to be followed in the examination and prosecution of the merged reissue and *inter partes* reexamination proceeding. Any questions as to the practice and procedure set forth should be referred

to the OPLA Reexamination Legal Advisor (RLA) assigned to the *inter partes* reexamination proceeding that is merged with the reissue application. In addition, the examiner will consult with the RLA assigned to the *inter partes* reexamination prior to issuing any Office action in the merged proceeding, in the same manner as he or she would consult with the RLA in an *inter partes* reexamination proceeding that has not been merged.

>Where merger is ordered, the patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the reissue and reexamination proceedings remain merged. Where identical amendments are not present in both files at the time merger is ordered, the patent owner will be required to submit an appropriate “housekeeping” amendment placing the same amendments in both proceedings. This may be accomplished by amending either of the two proceedings (the reissue application or the reexamination) or both of them, as appropriate. The patent owner must not address any issue of patentability in the housekeeping amendment. Amendments in a merged reexamination/reissue proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice. In the event that an amendment to make the claims the same in each file is required by the merger decision (identical amendments to be placed in all files) but is not timely submitted, any claim that does not contain identical text in all of the merged proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.<

### **IV. INTER PARTES REEXAMINATION, EX PARTE REEXAMINATION, AND REISSUE APPLICATION FOR THE SAME PATENT**

It will sometimes happen that an *inter partes* reexamination, an *ex parte* reexamination and a reissue application will all be copending. In these situations, the OPLA should be notified by, as promptly as possible after the reissue application reaches the TC, that the proceedings are ready for consideration of merger. If any of the reexamination files, the reissue application, and the patent file are paper files, they should be

hand delivered to the OPLA at the time of the notification to OPLA. The three most common examples of this are as follows:

(A) A reissue application was previously merged with an *ex parte* reexamination, and then an *inter partes* reexamination is filed. An order to reexamine is prepared, and the signed order and any paper files should be promptly hand delivered to the CRU for mailing of the order, and then consideration by the OPLA as to whether or not to merge the proceedings. The OPLA should be notified of the hand delivery, and the potential merger consideration.

(B) A reissue application was previously merged with an *inter partes* reexamination, and then a request for *ex parte* reexamination is filed. After an order to reexamine has been issued, the \*\*>TC Quality Assurance Specialist (QAS)< will retain jurisdiction over the merged reexamination proceeding until the patent owner's statement and any reply by the *ex parte* third party requester have been received for the *ex parte* reexamination request, or until the time for filing the same expires. OPLA should then be notified that the proceedings are ready for consideration of merger. If any of the reexamination files, the reissue application, and the patent file are paper files, they should be hand delivered to the OPLA at the time of the notification to OPLA.

(C) An *inter partes* reexamination was merged with an *ex parte* reexamination, and then a reissue application is filed. Once the reissue application is received, OPLA should be promptly notified that the proceedings are ready for consideration of merger. If any of the reexamination files, the reissue application, and the patent file are paper files, they should be hand delivered to the OPLA at the time of the notification to OPLA.

The decision to merge the three proceedings by the OPLA will provide the guidance for conducting the merged proceeding. It is to be noted that the merger will **not** be carried out pursuant to MPEP Chapter 2200. Prosecution prior to the point of merger will remain as-is, in the files.

In the event the *inter partes* reexamination prosecution is terminated and only the *ex parte* reexamination and the reissue application remain, the prosecution will no longer be governed by the present section.

Any further prosecution will be governed by MPEP Chapter 2200; specifically see MPEP § 2285.

#### V. **PETITION TO MERGE REISSUE APPLICATION AND *INTER PARTES* REEXAMINATION PROCEEDING OR TO STAY EITHER OF THE TWO BECAUSE OF THE EXISTENCE OF THE OTHER**

No petition to merge the reexamination proceeding and the reissue application examination, or stay one of them, is necessary, since the Office will generally, *sua sponte*, make a decision to merge the reexamination proceeding and the reissue application examination or to stay one of them. If any petition to merge the reexamination proceeding and the reissue application examination, or to stay one of them because of the other, is filed prior to the determination (37 CFR 1.923) and the order to reexamine (37 CFR 1.931), it will not be considered, but will be returned to the party submitting the same by the OPLA, regardless of whether the petition is filed in the reexamination proceeding, the reissue application, or both. This is necessary in order to prevent premature papers relating to the reexamination proceeding from being filed. The decision returning such a premature petition will be made of record in both the reexamination file and the reissue application file, but no copy of the petition will be retained by the Office. See MPEP § 2667.

The patent owner \*\* may file a petition under 37 CFR 1.182 to merge a reexamination proceeding and a reissue application examination, or stay one of them because of the other, after the order to reexamine (37 CFR 1.931), in the event the Office has not acted prior to that date to merge or stay. >The third party requester may file a petition under 37 CFR 1.182 to merge a reexamination proceeding and a reissue application examination, or stay the reexamination proceeding, after the order to reexamine (37 CFR 1.931), in the event the Office has not acted prior to that date to merge or stay. Any such petition under 37 CFR 1.182 filed prior to the initial Office action on the merits must also be filed under 37 CFR 1.183 to waive the requirement of 37 CFR 1.933(b) that no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination proceeding.< Any petition to merge or stay which is filed by a party **other than** the patent owner or the third party

requester of the reexamination will not be considered, but will be returned to that party by the OPLA.

All petitions to merge or stay which are filed by the patent owner or the third party requester subsequent to the date of the order for reexamination will be referred to the OPLA for decision.

## VI. FEES IN MERGED PROCEEDINGS

Where the proceedings have been merged and a paper is filed which requires payment of a fee (e.g., excess claims fee, extension of time fee, petition fees, appeal fees, brief fees, oral hearing fees), only a single fee need be paid. For example, only one fee need be paid for an appellant brief, even though the brief relates to merged multiple examinations and copies of the brief are filed for each file in the merger (as is required). As to excess claim fees, reissue practice will control.

## VII. INTERVIEWS IN MERGED PROCEEDINGS

Pursuant to 37 CFR 1.955, an interview which discusses the merits of a proceeding is not permitted in an *inter partes* reexamination proceeding. Thus, in a merged proceeding of an *inter partes* reexamination and a reissue application, there will be no *inter partes* interview as to the substance of the proceeding. Also, there will be no separate *ex parte* interview as to the substance of the proceeding with either the patent owner (the reissue applicant) or the third party requester (of the reexamination). Accordingly, where a party requests any information as to the merits of the merged proceeding, the examiner will not conduct a personal or telephone interview with that party to provide the information. Further, an informal amendment by the patent owner (the reissue applicant) will not be accepted, because that would be tantamount to an *ex parte* interview. All communications between the Office and the patent owner (and the third party requester) which are directed to the merits of the merged proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

## VIII. EXAMINER'S AMENDMENT TO PLACE PROCEEDING IN CONDITION FOR ALLOWANCE

As pointed out immediately above, interviews, both personal and telephone are **not** permitted in a merged

reissue/*inter partes* reexamination proceeding. Thus, the examiner is not permitted to telephone the patent owner/reissue applicant and obtain authorization to make an amendment. Accordingly, the only times that an examiner's amendment can be made in conjunction with a Notice of Allowability are where the patent owner authorization need not be obtained. Such amendments include:

(A) An examiner's amendment to deal with formal matters such as grammar, incorrect spelling, or incorrect number; i.e., matters that do not involve a rejection, do not go to the merits, and do not require the examiner to obtain approval.

(B) An examiner's amendment to change the title.

See also MPEP § 1302.04 *et seq.* as to examiner's amendments not needing authorization by an applicant or a patent owner. Note, however, that in a merged reissue/*inter partes* reexamination proceeding (as opposed to an application *per se*) all such examiner's amendments must be made by **formal examiner's amendment accompanying the Notice of Allowability**, in order to provide notice of the changes made in the patent being reexamined to both the patent owner/reissue applicant and the third party requester.

Note that any change going to the merits of the case (i.e., more than a formal matter) could not be made by examiner's amendment accompanying the Notice of Allowability. Rather, a change going to the merits would require (A) reopening of prosecution with the approval of the CRU Director, (B) an Office action suggesting the change to the patent owner/reissue applicant, (C) a formal amendment submitted by patent owner/reissue applicant, and (D) an opportunity for the third party requester to comment on the patent owner/applicant's submission.

## 2686.04 Reexamination and Litigation Proceedings [R-7]

35 U.S.C. 314. *Conduct of inter partes reexamination proceedings.*

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(c) SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.



*35 U.S.C. 317. Inter partes reexamination prohibited.*

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(b) FINAL DECISION.— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

*35 U.S.C. 318. Stay of litigation.*

Once an order for inter partes reexamination of a patent has been issued under section 313, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the inter partes reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.

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

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

*37 CFR 1.907. Inter partes reexamination prohibited.*

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

35 U.S.C. 311 permits a request for *inter partes* reexamination to be filed “at any time.” Thus, requests for *inter partes* reexamination can be filed where the patent (for which reexamination is requested) is involved in concurrent litigation. The

guidelines set forth below will generally govern Office handling of *inter partes* reexamination requests where there is concurrent litigation.

**I. \*\*>COURT-ORDERED/SANCTIONED< REEXAMINATION PROCEEDING, LITIGATION STAYED FOR REEXAMINATION, OR EXTENDED PENDING OF REEXAMINATION PROCEEDING CONCURRENT WITH LITIGATION**

Where a request for reexamination indicates >(A)< that it is filed as a result of an order by a court \*\*>or an agreement by parties to litigation which agreement is sanctioned by a court, or (B)< that litigation is stayed for the purpose of reexamination, >the request will be taken up by the examiner for decision 6 weeks after the request is filed, and< all aspects of the proceeding will be expedited to the extent possible. Cases will be taken up for action at the earliest time possible, and \*\*>Office actions in these reexamination proceedings will normally set a 1-month shortened statutory period for response rather than the 2 months usually set in reexamination proceedings. Response periods< may be extended only upon a strong showing of sufficient cause (see MPEP § 2665). Action on such a proceeding will >generally< take precedence to any other action taken by the examiner in the Office. See generally *In re Vamco Machine and Tool, Inc.*, 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985); *Gould v. Control Laser Corp.*, 705 F.2d 1340, 217 USPQ 985 (Fed. Cir. 1983); *Loffland Bros. Co. v. Mid-Western Energy Corp.*, 225 USPQ 886 (W.D. Okla. 1985); *The Toro Co. v. R.L. Nelson Corp.*, 223 USPQ 636 (C.D. Ill. 1984); *Digital Magnetic Systems, Inc. v. Ansley*, 213 USPQ 290 (W.D. Okla. 1982); *Raytek, Inc. v. Solfan Systems Inc.*, 211 USPQ 405 (N.D. Cal. 1981); and *Dresser Industries, Inc. v. Ford Motor Co.*, 211 USPQ 1114 (N.D. Texas 1981).

In addition, if (A) there is litigation concurrent with an *inter partes* reexamination proceeding and (B) the reexamination proceeding has been pending for more than one year, the Director or Deputy Director of the Office of Patent Legal Administration (OPLA), Director of the Central Reexamination Unit (CRU), or a Senior Legal Advisor of the OPLA, may approve Office actions in such reexamination proceeding setting a one-month or thirty days, whichever is longer, shortened statutory period for response rather than the

two months usually set in reexamination proceedings. A statement at the end of the Office action – “One month or thirty days, whichever is longer, shortened statutory period approved,” followed by the signature of one of these officials, will designate such approval. It is to be noted that the statutory requirement for “special dispatch” in reexamination often becomes important, and sometimes critical, in coordinating the concurrent litigation and reexamination proceedings.

## II. FEDERAL COURT DECISION KNOWN TO EXAMINER AT THE TIME THE DETERMINATION ON THE REQUEST FOR REEXAMINATION IS MADE

If a Federal Court decision *on the merits* of a patent is known to the examiner at the time the determination on the request for *inter partes* reexamination is made, the following guidelines will be followed by the examiner:

(A) The Third Party Requester Was Not a Party to the Litigation.

When the initial question as to whether the art raises a substantial new question of patentability as to a patent claim is under consideration, the existence of a final court decision of claim validity in view of the same or different art does not necessarily preclude the presence of a new question. This is true because of the different standards of proof and claim interpretation employed by the District Courts and the Office. See for example *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (manner of claim interpretation that is used by courts in litigation is not the manner of claim interpretation that is applicable during prosecution of a pending application before the PTO) and *In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) (the 35 U.S.C. 282 presumption of patent validity has no application in reexamination proceedings). Thus, while the Office may accord deference to factual findings made by the court, the determination of whether a substantial new question of patentability exists will be made independently of the court’s decision on *validity*, since the decision is not controlling on the Office.

A *non-final* holding of claim *invalidity* or *unenforceability* will also not be controlling on the question of whether a substantial new question of patentability is present.

*Only a final holding of claim invalidity or unenforceability (after all appeals) is controlling on the Office.* In such cases, a substantial new question of patentability would not be present as to the claims held invalid or unenforceable. See *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).

(B) The Third Party Requester Was a Party to the Litigation.

Final Holding of validity: The provisions of 37 CFR 1.907(b) apply. Where a final decision was entered against a party in a Federal Court civil action (arising in whole or in part under 28 U.S.C. 1338) that the party did not sustain its burden of proving invalidity of a patent claim in suit, that party and its privies may **not** request *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in the civil action >(as to those asserted by the patent owner, and/or challenged by the third party requester, and resolved in favor of the patent owner in the civil action)<. Further, an *inter partes* reexamination already requested by that party, or its privies, on the basis of such issues will not be maintained by the Office, i.e., the proceeding will be concluded. Note, however, that the statute does not preclude an *ex parte* reexamination by the same third party requester.

In view of the above, when the examiner is aware that the third party requester was a party to previous Federal Court litigation as to the patent for which *inter partes* reexamination has been requested, the examiner must determine:

(1) Was the Federal Court decision adverse to the third party requester as to at least one claim of the patent?

(2) Was the Federal Court decision a final decision, after all appeals?

(3) Is the issue being raised in the reexamination request the same issue as was raised in the Federal Court during the civil action, or an issue that the third party requester could have raised in the Federal Court during the civil action?

- If the answer to each of questions (1)-(3) is “yes” for all claims for which reexamination was requested in the proceeding, then the *inter partes* reexamination prosecution must be terminated. In such a case, the Central Reexamination Unit (CRU) Director will prepare a decision discussing the above

considerations (1)-(3) and vacating the reexamination proceeding.

- If the answer to all of questions (1)-(3) is “yes” for one or more (but not all) of the claims for which reexamination was requested in the proceeding; those claims will not be treated. The examiner’s action will point out the claims not treated and the reason why, i.e., a discussion of the above considerations (1)-(3). The guidelines set forth above in subsection II.(A) will be used for the claims remaining.

- If the answer to question (1) or to question (3) is “no” for all claims for which reexamination was requested, then the examination of the reexamination proceeding will proceed without any discussion on the record of considerations (1)-(3), using the guidelines set forth above in subsection II.(A).

- If, for any claim for which reexamination was requested, the answer to both of questions (1) and (3) is “yes”, but the answer to question (2) is “no”, then examination of the reexamination proceeding will proceed using the guidelines set forth above in subsection II.(A). The examiner’s action will contain a discussion of considerations (1)-(3). If the examiner subsequently becomes aware that the Federal Court decision has become final, reexamination of the affected claims must be discontinued. If all claims being examined are affected, the reexamination will be vacated by the CRU Director as discussed above. See also subsection V. below.

Final Holding of invalidity: A *final holding of claim invalidity or unenforceability* (after all appeals) is controlling on the Office. In such cases, a substantial new question of patentability would not be present as to the claims held invalid or unenforceable. See *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). Where all claims for which reexamination was requested are affected, the reexamination will be vacated by the CRU Director. A non-final holding of claim invalidity or unenforceability, however, will not be controlling on the question of whether a substantial new question of patentability is present.

#### (C) Specific Situations.

For a discussion of the policy in specific situations where a Federal Court decision has been issued, see MPEP § 2642 and subsection V. below.

>Note the following two Federal Circuit decisions involving reexamination proceedings where the court affirmed the Office’s rejections even though parallel district court proceeding upheld the claims as valid and infringed. *In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 83 USPQ2d 1835 (Fed. Cir. 2007) and *In re Translogic Technology, Inc.*, 504 F.3d 1249, 84 USPQ2d 1929 (Fed. Cir. 2007).

In *Trans Texas*, the patent being reexamined was subject to an infringement suit, in which the district court had issued its claim construction ruling (in a district court opinion) as to the definition of a term. The parties ultimately reached a settlement before trial, and the district court issued an “Order of Dismissal with Prejudice.” The patent owner relied on that district court claim construction ruling in a reexamination proceeding, and argued that the Office was bound by that district court claim construction ruling, under the doctrine of issue preclusion. The Federal Circuit stated that issue preclusion could not be applied against the Office based on a district court holding in an infringement proceeding, since the Office was not a party to that earlier infringement proceeding.

In *Translogic*, a district court infringement suit proceeded in parallel with a reexamination proceeding. The district court upheld the validity of the patent in the infringement suit, while the reexamination examiner found the claim combination to be obvious. The examiner’s rejection was affirmed by the Board of Patent Appeals and Interferences (Board). The defendant (the alleged infringer) of the infringement suit appealed the district court decision to the Federal Circuit, while the patent owner appealed the Board’s decision to the Federal Circuit. The Federal Circuit consolidated the appeals, and then addressed only the patent owner’s reexamination appeal from the Board. The Federal Circuit affirmed the examiner’s conclusion of obviousness by relying upon and providing an extensive discussion of *KSR International Co. v. Teleflex Inc.*, 550 U.S.\_\_\_\_, 82 USPQ2d 1385 (2007).<

### III. REEXAMINATION WITH CONCURRENT LITIGATION BUT ORDERED PRIOR TO FEDERAL COURT DECISION

In view of the statutory mandate to make the determination on a request for reexamination within 3 months, the determination on the request based on the record before the examiner will be made without

awaiting a decision by the Federal Court. It is not realistic to attempt to determine what issues will be treated by the Federal Court prior to the Court's decision. Accordingly, the determination on the request will be made without considering the issues allegedly before the Court. If reexamination is ordered, the reexamination generally (see discussion immediately below) will continue until the Office becomes aware that a court decision has issued. At such time, the request will be reviewed in accordance with the guidelines set forth below.

In *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Court of Appeals for the Federal Circuit stated the following as to the Office's authority to stay a reexamination process pending the outcome of a Federal District Court case where invalidity is an issue:

"Whatever else special dispatch means, it does not admit of an indefinite suspension of reexamination proceedings pending conclusion of litigation. If it did, one would expect to find some intimation to that effect in the statute, for it would suggest the opposite of the ordinary meaning. But there is none."

"The Commissioner... has no inherent authority, only that which Congress gives. It did not give him authority to stay reexaminations; it told him to conduct them with special dispatch. Its silence about stays cannot be used to countermand that instruction."

The *Ethicon* case was decided as to *ex parte* reexamination, for which 35 U.S.C. 305 dictates in its last sentence:

"All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office."

For *inter partes* reexamination, however, 35 U.S.C. 314 states:

**"Unless otherwise provided by the Director for good cause,** all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office."

35 U.S.C. 314 provides for *inter partes* reexamination the clause "[u]nless otherwise provided by the Director for good cause" \*, this clause is not present in 35 U.S.C. 305 for *ex parte* reexamination. Accordingly, where there is good cause for the Direc-

tor of the USPTO to suspend (stay) reexamination proceedings pending the conclusion of litigation, a suspension will be effected. \*\*>This matter will be approached on a case-by-case basis. See< subsection V. below for the situation where there \*>was< pending litigation having the potential to terminate a reexamination prosecution under 35 U.S.C. 317(b)>, and a suspension was granted<. If the examiner believes there is "good cause" to suspend (stay) reexamination proceedings, the case should be brought to the Office of Patent Legal Administration (OPLA) for consideration of such by a Reexamination Legal Advisor (RLA). \*\*

>It should be noted that a suspension will not be considered on its merits prior to ordering of reexamination. Until that point, there is no proceeding to suspend, and the Office must issue its decision on the request within the statutorily mandated 3 months. Also, suspension will not be considered on its merits when there is an outstanding Office action. In order to ensure consideration on the merits of a petition to suspend where there is an outstanding Office action, the patent owner must (1) provide a complete response to the outstanding Office action, (2) include a petition to suspend under 37 CFR 1.182, and (3) include a petition under 37 CFR 1.182 for OPLA to take jurisdiction of the proceeding prior to issuing an Office action on the submitted response and retain such jurisdiction until OPLA issues its decision on the petition to suspend.<

It should >also< be noted that if, pursuant to 35 U.S.C. 318, a court stays litigation as to the patent being reexamined, action in the reexamination proceeding would not be suspended. This is so because action in the reexamination proceeding would be needed to resolve the "issue of patentability of any claims of the patent which are the subject of the *inter partes* reexamination order" set forth in 35 U.S.C. 318.

#### **IV. FEDERAL COURT DECISION ISSUES AFTER *INTER PARTES* REEXAMINATION ORDERED**

Pursuant to 37 CFR 1.985(a), the patent owner in an *inter partes* reexamination proceeding must promptly notify the Office of any Federal Court decision involving the patent.

Upon the issuance of a holding of claim invalidity or unenforceability by a Federal Court, reexamination of those claims will continue in the Office until the decision becomes final. A *non-final* Court decision concerning a patent under reexamination shall have no binding effect on a reexamination proceeding.

Where an *inter partes* reexamination proceeding is currently pending and a **final** Federal Court decision issues after all appeals, the reexamination proceeding is reviewed to see if no substantial new question of patentability remains (as to one or more claims) due to holding of claims invalid, and to determine whether the provisions of 37 CFR 1.907(b) apply as a result of a decision in a civil action arising in whole or in part under 28 U.S.C. 1338.

A *final Court holding of invalidity/unenforceability* is binding on the Office. Upon the issuance of a final holding of invalidity or unenforceability, the claims held invalid or unenforceable will be withdrawn from consideration in the reexamination. The reexamination will continue as to any remaining claims. If all of the claims being examined are finally held invalid or unenforceable, the reexamination will be vacated by the CRU Director as no longer containing a substantial new question of patentability and the reexamination prosecution will be terminated. If not all claims being examined were held invalid, a substantial new question of patentability may still exist as to the remaining claims. In such a situation, the remaining claims would be examined; and, as to the claims held invalid, form paragraph 26.80 should be used at the beginning of the Office action.

¶ 26.80 *Claims Held Invalid by Court, No Longer Being Reexamined*

Claims [1] of the [2] patent are not being reexamined in view of the final decision of [3]. Claims [1] were held invalid by the [4].

**Examiner Note:**

1. In bracket 1, insert the claims held invalid.
2. In bracket 2, insert the patentee (e.g., Rosenthal, Schor et al).
3. In bracket 3, insert the decision (e.g., *ABC Corp. v. Kery Fries*, 999 USPQ2d 99 (Fed. Cir. 1999) or *XYZ Corp. v. Jones*, 999 USPQ2d 1024 (N.D. Cal. 1999)).
4. In bracket 4, insert the name of the court (e.g., the Court of Appeals for the Federal Circuit, or the Federal District Court).

The issuance of a *final* Court decision >after all appeals< (in a civil action arising in whole or in part

under 28 U.S.C. 1338) upholding validity during an *inter partes* reexamination, where the person who filed the request **was a party to the litigation**, will have the effect that the Office will discontinue examination of all claims affected by the holding of validity >(for issues raised or could have been raised as to those claims asserted by the patent owner, and/or challenged by the third party requester)<. If the provisions of 37 CFR 1.907(b) apply such that all of the claims in the reexamination proceeding cannot be maintained, the order to reexamine is vacated by the CRU Director, and reexamination is terminated. If the provisions of 37 CFR 1.907(b) apply to some of the claims, but not all of the claims in the proceeding; those claims to which 37 CFR 1.907(b) applies will not be treated. The examiner's action will point out the claims not treated, and the reason why those claims cannot be maintained in the reexamination under 37 CFR 1.907(b). Action will be given on the remaining claims. Note that the provisions of 37 CFR 1.907(b) cannot be waived since they track the statute, 35 U.S.C. 317. See also subsection V. below.

The issuance of a final Court decision **upholding validity** during an *inter partes* reexamination, where the person who filed the request **was not a party to the litigation**, will have no binding effect on the examination of the reexamination. This is because the Court stated in *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988) that the Office is not bound by a court's holding of patent validity and should continue the reexamination. The Court noted that District Courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to different conclusions. Specifically, invalidity in a District Court must be shown by "clear and convincing" evidence, whereas in the Office it is sufficient to show non-patentability by a "preponderance" of the evidence. Since the "clear and convincing" standard is harder to satisfy than the "preponderance standard," a court's holding of patent validity is not controlling. Deference will, however, ordinarily be accorded to the factual findings of the court, where the evidence before the Office and the court is the same. If sufficient reasons are present, claims held valid by the court may be rejected in reexamination.

## V. DISCUSSION OF AFFECT OF LITIGATION WHERE REQUESTER WAS A PARTY TO THE LITIGATION

For *inter partes* reexamination, 35 U.S.C. 317(b) provides:

“Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit..., then neither that party nor its privies may thereafter request an *inter partes* reexamination of **any such patent claim** on the basis of issues which that party or its privies **raised or could have raised** in such civil action..., and an *inter partes* reexamination requested by that party or its privies **on the basis of such issues** may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection **does not prevent** the assertion of invalidity based on **newly discovered** prior art **unavailable** to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.” [Emphasis added]

Where a final decision was entered against a party in a Federal Court civil action (arising in whole or in part under 28 U.S.C. 1338) that the party did not sustain its burden of proving invalidity of a patent claim in suit, then that party and its privies may not request *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in the civil action. Further, an *inter partes* reexamination already requested by that party, or its privies, on the basis of such issues will not be maintained by the Office; in such an instance, the prosecution will be terminated and the proceeding will be concluded. This is a statutory estoppel which can attach to an *inter partes* reexamination third party requester that is also a party to litigation concerning the patent for which reexamination has been requested.

35 U.S.C. 314(c) states:

“**Unless otherwise provided by the Director for good cause**, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.” [Emphasis added]

The statute thus authorizes the Director of the USPTO to suspend (stay) reexamination proceedings, where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C.

317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.

In any *inter partes* reexamination where the requester (or its privies) is also a party to ongoing or concluded litigation as to the patent for which reexamination has been requested, the potential for this statutory estoppel to attach must be considered. The following provides a discussion of the interaction of 35 U.S.C. 317(b), 35 U.S.C. 314, and the *inter partes* reexamination process.

Congress, in creating the *inter partes* reexamination statutory framework in 2002, borrowed heavily from the existing *ex parte* reexamination regime. For example, *inter partes* reexamination proceedings, like *ex parte* reexaminations, must be conducted with “special dispatch.” 35 U.S.C. 314(c). Unlike *ex parte* reexamination, however, Congress provided the Office with the statutory authority and discretion to suspend *inter partes* reexamination proceedings for “good cause.” See 35 U.S.C. 314(c).

Another difference between the two regimes is that Congress specifically provided estoppel provisions to shut down an *inter partes* reexamination of a patent claim when a “final decision” upholding the validity of that claim has been reached in a civil action or in a prior *inter partes* reexamination proceeding. See 35 U.S.C. 317(b); 35 U.S.C. 315(c). Thus, if a party’s challenge to the validity of certain patent claims has been finally resolved, either through civil litigation or the *inter partes* reexamination process, then (A) that party is barred from making a subsequent request for *inter partes* reexamination (or filing a new civil action) challenging the validity of those same claims, and (B) “an *inter partes* reexamination previously requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office.” *Id.*

The statute and legislative history of the estoppel provisions make it clear that the *inter partes* reexamination of a claim (requested by a party) must be terminated once a final decision upholding the validity of that claim (challenged by the same party) has issued

“after any appeals,” not simply just after a district court decision which is still pending on appeal. While Congress desired that the creation of an *inter partes* reexamination option would lead to a reduction in expensive patent litigation, it nonetheless also provided in the statute that a court validity challenge and *inter partes* reexamination of a patent may occur simultaneously; but once one proceeding finally ends in a manner adverse to a third party, then the issues raised (or that could have been raised) with respect to the validity of a claim in that proceeding would have estoppel effect on the same issues in the other proceeding.

Taking the above into account, the following factors are to be considered in determining whether it is appropriate to refuse to order an *inter partes* reexamination, terminate the reexamination, or suspend action in the reexamination, based on litigation in which the reexamination requester is a party to the litigation.

(A) The 35 U.S.C. 317(b) estoppel applies only to patent claims that were litigated in the suit, i.e., litigated claims. The estoppel does not apply to non-litigated patent claims.

Where there are non-litigated claims for which reexamination had been requested in the *inter partes* reexamination request, the reexamination proceeding is to go forward based on those non-litigated claims. If, however, during the reexamination proceeding, the patent owner disclaimed all the non-litigated claims, leaving only litigated claims, the proceeding is to be referred to the Office of Patent Legal Administration (OPLA).

(B) The 35 U.S.C. 317(b) estoppel applies only to issues which the requester or its privies raised or could have raised in the civil action. The estoppel does not apply where new issues are raised in the request.

If the request provides new art/issues not raised in the litigation (civil action), and which could not have been so raised, then estoppel does not attach. The patent owner has the burden of showing that the art and issues applied in the request was available to the third-party requester and could have been placed in the litigation.

(C) The 35 U.S.C. 317(b) estoppel applies only in a situation where a final decision adverse to the requester has already been issued.

If there remains any time for an appeal, or a request for reconsideration, from a court (e.g., District Court or Federal Circuit) decision, or such action has already been taken, then the decision is not final, and the estoppel does not attach. A stay/suspension of action may be appropriate for the reexamination proceeding if the litigation has advanced to a late enough stage and there is sufficient probability that a final decision will be adverse to the requester; however, that is a matter to be discussed with the OPLA in any such instance.

(D) Is there a concurrent *ex parte* reexamination proceeding for the patent?

As stated in MPEP § 2286: “The issuance of a final Federal Court decision upholding validity during an *ex parte* reexamination also will have no binding effect on the examination of the reexamination. This is because the court states in *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988) that the Office is not bound by a court’s holding of patent validity and should continue the reexamination.” If there is a concurrent *ex parte* reexamination proceeding having overlapping issues with an *inter partes* reexamination proceeding where the estoppel has the potential to attach, but no final decision has been issued, then the Office may in some instances (depending on the individual facts and circumstances), to go forward with statutorily required “special dispatch” as per *Ethicon* in a merged proceeding containing both the *inter partes* reexamination and the *ex parte* reexamination. This is a matter of administrative convenience to avoid rework and make the process more efficient. Again, OPLA should be consulted.

(E) Some examples of where this estoppel issue was actually addressed by the Office.

In reexamination control numbers 95/000,093 and 95/000,094 (the ‘093 and ‘094 proceedings), action was suspended based on ongoing litigation. After a District Court decision adverse to requester, it was determined that “good cause” existed to wait for the outcome of the Federal Circuit appeal, because the reexamination proceedings were only at their beginning stages, while the concurrent litigation was potentially near its final resolution. It was noted that requester had chosen to permit the District Court litigation to proceed for three years before filing its requests for reexamination, the filing taking place

only after judgment was entered in patent owner's favor in the litigation. Had requester filed its requests for reexamination earlier, the reexamination proceedings would have been much farther along in the process, and may likely have been completed at the Office before the District Court issued its decision. Moreover, had requester filed its reexamination requests earlier in the litigation, the District Court might have stayed the litigation to await the Office's decisions in the two reexamination proceedings. After choosing to go years through the entire District Court litigation proceeding without asking for the Office's input, requester was not in a position to complain that a suspension of the '093 and '094 reexamination proceedings would deprive requester of a chance to obtain the Office's decision, when there was a strong possibility that the Federal Circuit's decision would estop the Office from issuing any decision at all. In short, requester could not have it both ways. Requester waited three years after the district court case began, and waited until after the District Court issued a final decision, such that its District Court litigation could in no way be affected by any decision on its reexamination requests. Requester's delay was the reason that the '093 and '094 reexaminations could very well be mooted before any reexamination decision issued and the USPTO Director found "good cause" to suspend the proceedings. >On May 22, 2006, the U.S. District Court, Eastern District of Virginia, in *Sony Computer Entertainment America Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va 2006), issued a decision upholding the Office's finding of "good cause" to suspend the '093 and '094 *inter partes* reexamination proceedings.< Requester chose its route >(litigation)< and had to deal with the consequences of its decision, i.e., a suspension of the reexamination proceedings.

On the other hand, see reexamination control numbers 95/000,020, 95/000,071 and 95/000,072, for decisions in which action was not suspended, because the specific facts dictated otherwise.

## VI. LITIGATION REVIEW AND CRU APPROVAL

In order to ensure that the Office is aware of prior or concurrent litigation, the examiner is responsible for conducting a reasonable investigation for evidence as to whether the patent for which reexamination is

requested has been, or is, involved in litigation. The investigation will include a review of the reexamination file, the patent file, and the results of the litigation computer search by the Scientific and Technical Information Center (STIC). If the examiner discovers, at any time during the reexamination proceeding, that there is litigation or that there has been a Federal Court decision on the patent, the fact will be brought to the attention of a Reexamination Legal Advisor (RLA) of the OPLA prior to *any* further action by the examiner. The RLA will provide the examiner with guidance as to compliance with Office policy where there is concurrent litigation.

### 2687 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) and Conclusion of Reexamination Proceeding [R-7]

Upon conclusion of the *inter partes* reexamination proceeding, the examiner must complete a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) by filling out Form PTOL-2068. If appropriate, an examiner's amendment will also be prepared. Where the claims are found patentable, reasons must be given for each claim found patentable. See the discussion as to preparation of an examiner's amendment and reasons for allowance found at the end of this section. In addition, the examiner must prepare the reexamination file so that the Office of \*>Data Management< can prepare and issue a certificate in accordance with 35 U.S.C. 316 and 37 CFR 1.997 and setting forth the results of the reexamination proceeding and the content of the patent following the proceeding. See MPEP § 2688.

#### I. INSTANCES WHERE A NIRC WOULD BE APPROPRIATE

The following are the only instances when issuance of a NIRC action would be proper in an *inter partes* reexamination proceeding:

(A) There is **no** timely response by the patent owner to an Office action requiring a response. If **all** claims are under rejection, the examiner will issue a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC). All claims will be canceled by formal examiner's amendment.



(B) After a Right of Appeal Notice (RAN) where no party to the reexamination timely files a notice of appeal.

(C) After filing of a notice of appeal, where all parties who filed a notice of appeal or notice of cross appeal fail to timely file an appellant brief (or fail to timely complete the brief, where the appellant brief is noted by the examiner as being incomplete).

(D) After a final decision by the Board of Patent Appeals and Interferences (Board), where there is no further timely appeal to the Court of Appeals for the Federal Circuit nor is there a timely request for rehearing by the Board.

(E) After the Federal Court appeal process has been completed and the case is returned to the examiner.

## II. PREPARATION OF THE NIRC ACTION

### A. *No Allowed Claims*

Where **all** claims are rejected or objected to in the prior Office action, the examiner will issue a NIRC indicating that all claims have been canceled and terminating the prosecution. The cover sheet to be used is Notice of Intent to Issue Reexamination Certificate Form PTOL-2068. As an attachment to the NIRC cover sheet, the examiner will draft an examiner's amendment canceling all live claims in the reexamination proceeding. Check the appropriate box on PTOL-2068. In the remarks of the examiner's amendment, the examiner should point out why the claims have been canceled. Since all claims are being canceled in the proceeding, no reasons for patentability are attached. No panel review conference is needed in this instance, as the issuance of the NIRC is essentially ministerial.

### B. *At Least One Allowed Claim*

If at least one claim is free of rejection and objection, the examiner will issue a NIRC, in which all patentable claims and canceled claims will be identified. All rejected or objected claims will be canceled by formal examiner's amendment (attached as part of the NIRC). Check the appropriate box on Form PTOL-2068. In the remarks section of the examiner's amendment, the examiner should point out why the claims have been canceled. As to the patentable claims, reasons for patentability must be provided for

all such claims. After the examiner has determined that the reexamination proceeding is ready for the NIRC, the examiner will formulate a draft preliminary NIRC with attachments as needed. The examiner will then inform his/her **>Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS)<** of his/her intent to issue the NIRC. The **>CRU SPE/TC QAS<** will convene a panel review conference, and the conference members will review the patentability of the remaining patentable claim(s) pursuant to MPEP § 2671.03. If the conference confirms the examiner's preliminary decision, the proposed NIRC shall be issued and signed by the examiner, with the two other conferees initialing the action (as "conferee") to indicate their presence in the conference. If the conference does not confirm the examiner's decision (e.g., it is determined that one or more of the remaining claims should be rejected), then the examiner will reevaluate and issue an appropriate Office action. A panel review conference is not to be held as to any claim that was in the case (proceeding) at the time the case was reviewed by the Board of Patent Appeals and Interferences (Board) or a federal court.

## III. EXAMINER'S AMENDMENT TO PLACE PROCEEDING IN CONDITION FOR NOTICE OF INTENT TO ISSUE *INTER PARTES* REEXAMINATION CERTIFICATE

Interviews, both personal and telephone are not permitted in an *inter partes* reexamination proceeding (see MPEP § 2685). Thus, the examiner is not permitted to telephone the patent owner to obtain authorization to make an amendment. Accordingly, the only times that an examiner's amendment can be made in conjunction with a NIRC are where the patent owner authorization need not be obtained. Such amendments include:

(A) An examiner's amendment to deal with formal matters such as grammar, incorrect spelling, or incorrect number; i.e., matters that do not involve a rejection, do not go to the merits, and do not require the examiner to obtain approval.

(B) An examiner's amendment to change the title.

(C) An examiner's amendment to cancel all rejected and objected claims in the proceeding, when

the patent owner fails (1) to timely respond (where a response is required), (2) to timely appeal, or (3) to take further action to maintain an appeal.

>

(D) If a patent expires during the pendency of a reexamination proceeding for that patent, all amendments to the patent claims and all claims added during the proceeding must be withdrawn. The examiner's amendment is to include a statement such as:

“As the patent being reexamined has expired during the pendency of the present reexamination proceeding, all amendments made during the proceeding are improper, and are hereby expressly withdrawn.”

If it has not previously been done in the proceeding, a diagonal line should be drawn across a copy of all amended and new claims (and text added to the specification) residing in the amendment papers, and scanned into the Image File Wrapper (IFW).<

See also MPEP § 1302.04 *et. seq.* as to examiner's amendments not needing authorization by an applicant or a patent owner. Note, however, that in an *inter partes* reexamination proceeding (as opposed to an application) all such examiner's amendments must be made by **formal examiner's amendment accompanying the NIRC**, in order to provide notice of the changes made in the patent being reexamined to both the patent owner and the third party requester.

Note that any change going to the merits of the case (i.e., more than a formal matter) could not be made by examiner's amendment accompanying the NIRC. Rather, a change going to the merits would require (1) reopening of prosecution with the approval of the **\*->CRU<** Director, (2) an Office action suggesting the change to patent owner, (3) a formal amendment submitted by the patent owner, and (4) an opportunity for the third party requester to comment on the patent owner's submission.

Where an examiner's amendment is to be prepared, Box 9 of Form PTOL-2068 (Notice of Intent to Issue a Reexamination Certificate) is checked, and form paragraph 26.69 is used to provide the appropriate attachment:

¶ 26.69 *Examiner's Amendment Accompanying Notice of Intent to Issue Reexamination Certificate*

An examiner's amendment to the record appears below. The changes made by this examiner's amendment will be reflected in the reexamination certificate to issue in due course.

[1]

The examiner's amendment must comply with the requirements of 37 CFR 1.530(d)-(j) in amending the patent.

Thus, if a portion of the text is amended more than once, the examiner's amendment should indicate all changes (insertions and deletions) in relation to the current text in the patent under reexamination, **not** in relation to a prior amendment made during the proceeding.

In addition, the examiner's amendment requires presentation of the **full text** of any paragraph or claim to be changed, with 37 CFR 1.530(f) markings. Examiners' amendments in reexamination are not subject to the exceptions to this requirement which are provided for applications in 37 CFR 1.121(g) and which do not apply to reexamination proceedings. See MPEP § 2250. The only **exception** to the full text presentation requirement is that an entire claim or an entire paragraph of specification may be deleted from the patent by a statement deleting the claim or paragraph without the presentation of the text of the claim or paragraph.

#### IV. REASONS FOR PATENTABILITY AND/OR CONFIRMATION

Reasons for patentability must be provided, unless all claims are canceled in the proceeding. Check the appropriate box on Form PTOL-2068 and provide the reasons as an attachment. In the attachment to the NIRC, the examiner should indicate why the claims found patentable in the reexamination proceeding are clearly patentable over the cited patents or printed publications. This is done in a manner similar to that used to indicate reasons for allowance in an application. See MPEP § 1302.14. Where the record is clear as to why a claim is patentable (which should be the usual situation, in view of the *inter partes* nature of the proceeding), the examiner may simply refer to the particular portions of the record which clearly establish the patentability of that claim. **In any event, reasons for patentability must be provided for every claim identified as patentable in the NIRC, and the patent owner must be notified in the NIRC that it has an opportunity to provide comments on the statement of the reasons for patentability.**

The reasons for patentability may be set forth on Form PTOL-476, entitled “REASONS FOR PATENTABILITY AND/OR CONFIRMATION.” However, as a preferred alternative to using Form PTOL-476, the examiner may instead use form paragraph 26.70.

¶ 26.70 *Reasons for Patentability and/or Confirmation in Inter Partes Reexamination*

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

The following is an examiner’s statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding: [1]

Any comments considered necessary by the PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: “Comments on Statement of Reasons for Patentability and/or Confirmation” and will be placed in the reexamination file.

**Examiner Note:**

This form paragraph may be used as an attachment to the Notice of Intent to Issue *Inter Partes* Reexamination Certificate, PTOL-2068 (item number 3).

Original patent claims that are found patentable in a reexamination proceeding are generally to be designated as “confirmed” claims, while new claims and amended patent claims are generally to be designated as “patentable” claims. However, for purposes of the examiner setting forth reasons for patentability or confirmation, the examiner may use “patentable” to refer to any claim that defines over the cited patents or printed publications. There is no need to separate the claims into “confirmed” and “patentable” categories when setting forth the reasons.

Where all claims are canceled in the proceeding, no reasons for patentability are provided.

**V. PREPARATION OF THE CASE FOR PUBLICATION**

As to preparing the *inter partes* reexamination file for publication of the certificate, see MPEP § 2287 for guidance. The preparation of an *inter partes* reexamination proceeding for publication is carried out in the same manner that an *ex parte* reexamination proceeding is prepared for publication.

The examiner must complete the examiner preparation of the case for reexamination certificate by completing an Examiner Checklist Reexamination form, PTOL-1516. The Legal Instrument Examiner (LIE)

(the reexamination clerk) must complete a Reexamination Clerk Checklist form, PTOL-1517. The case is reviewed by the \*>CRU SPE/TC QAS< and if all is in order, the case will be forwarded by the \*>CRU SPE/TC QAS< to the Reexamination Legal Advisor (RLA).

After the reexamination file and its contents are reviewed, the NIRC will be mailed, and appropriate PALM work and update scanning will be carried out. The reexamination proceeding will then be forwarded, via the appropriate Office, to the Office of \*>Data Management< for printing.

If the RLA returns the case to the \*>CRU/TC< for correction/revision, the correction/revision must be handled specially and returned to the RLA within the time set for such by the RLA.

**VI. REEXAMINATION REMINDERS**

The following items deserve special attention. The examiner should ensure they have been correctly completed or followed before forwarding the case to the \*>CRU SPE or TC QAS< for review.

(A) All patent claims for which a substantial new question of patentability had been found must have been examined. See MPEP § 2643.

(B) No renumbering of patent claims is permitted. New claims may require renumbering. See MPEP § 2666.01 and § 2250.

(C) Amendments to the description and claims must conform to requirements of 37 CFR 1.530(d)-(k). This includes any changes made by examiner’s amendment. If a portion of the text is amended more than once, each amendment should indicate all of the changes (insertions and deletions) in relation to the current text in the patent under reexamination. See MPEP § 2666.01 and § 2250.

(D) The prior art must be listed on a form PTO-892, PTO-1449, PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having format equivalent to one of these forms). These forms must be properly completed. See MPEP § 2657.

(E) The examiner and clerk checklists PTO-1516 and PTO-1517 must be *entirely and properly* completed. A careful reading of the instructions contained in these checklists is essential. The clerk checklist is designed as a check and review of the examiner’s responses on the examiner checklist. Accordingly, the clerk should personally review the file before

completing an item. The clerk should check to make certain that the responses to all related items on both checklists are in agreement.

(F) Multiple copending reexamination proceedings are often merged. See MPEP § 2686.01.

(G) Where the reexamination proceeding is copending with an application for reissue of the patent being reexamined, the files must have been forwarded to the Office of Patent Legal Administration (OPLA) for a consideration of potential merger, with a decision on the question being present in the reexamination file. See MPEP § 2686.03.

(H) Reasons for patentability and/or confirmation are required for each claim found patentable.

(I) There is no issue fee in reexamination. See MPEP § 2634.

(J) The patent claims may not be amended nor new claims added after expiration of the patent. See MPEP § 2666.01 and § 2250.

(K) Original drawings cannot be physically changed. All drawing amendments must be presented on new sheets. The examiner may have the draftsman review the new sheets of drawings if the examiner would like the draftsman's assistance in identifying errors in the drawings. A draftsman's "stamp" to indicate approval is no longer required on patent drawings, and these stamps are no longer to be used by draftspersons. See MPEP § 2666.02.

(L) An amended or new claim may not enlarge the scope of the patent claims. See MPEP § 2658, § 2666.01, and § 2250.

(M) If the patent has expired, all amendments to the patent claims and all claims added during the proceeding must be withdrawn. Further, all presently rejected and objected claims are canceled by examiner's amendment. See MPEP § 2250, subsection on "Amendment After the Patent Has Expired."

#### **A. Handling of Multiple Dependent Claims**

For treatment of multiple dependent claims when preparing a reexamination proceeding for publication of the reexamination certificate, see the discussion in MPEP § 2287.

#### **B. The Title of the Patent**

Normally, the title will not need to be changed during reexamination. If a change of the title is necessary,

it should have been pointed out as early as possible in the prosecution, as a part of an Office Action. An informal examiner's amendment (i.e., changing the title and merely initialing the change) is **not** permitted in reexamination.

### **VII. REEXAMINATION PROCEEDINGS IN WHICH ALL THE CLAIMS ARE CANCELED**

There will be instances where all claims in the reexamination proceeding are to be canceled. This would occur where the patent owner fails to timely respond to an Office action, and all live claims in the reexamination proceeding are under rejection. This would also occur where all live claims in the reexamination proceeding are to be canceled as a result of a decision of the Board affirming the examiner, and the time for appeal to the court and for requesting rehearing has expired. In these instances the examiner will issue a NIRC indicating that all claims have been canceled and terminating the prosecution. As an attachment to the NIRC, the examiner will draft an examiner's amendment canceling all live claims in the reexamination proceeding. In the examiner's amendment, the examiner should point out why the claims have been canceled. For example, the examiner might state one of the two following examples, as is appropriate:

"Claims 1-8 (all live claims in the proceeding) were subject to rejection in the last Office action mailed 9/9/99. Patent owner failed to timely respond to that Office action. Accordingly, claims 1-8 have been canceled. See 37 CFR 1.957(b) and MPEP § 2666.10."

"The rejection of claims 1-8 (all live claims in the proceeding) has been affirmed in the Board decision of 9/9/99, and no timely appeal to the court has been filed. Accordingly claims 1-8 have been canceled."

In order to physically cancel the live claims in the reexamination file history, brackets should be placed around all the live claims on a copy of the claims printed from the file history, and the copy then scanned into the file history. All other claims in the proceeding should have previously been either replaced or canceled.

The examiner will designate a canceled original patent claim, to be printed in the *Official Gazette*, on the Issue Classification IFW form in the appropriate place for the claim chosen.

A panel review conference is not to be held because the proceeding is to be concluded by the cancellation of all claims.

### **2687.01 Examiner Consideration of Submissions After NIRC [R-7]**

The rules do not provide for an amendment to be filed in an *inter partes* reexamination proceeding after a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) has been issued. Note that 37 CFR 1.312 does not apply in reexamination. Any amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding filed after the NIRC (except as indicated immediately below) must be accompanied by a petition under 37 CFR 1.182. The petition must be granted, in order to have the amendment, information disclosure statement, or other paper related to the merits considered. Where an amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding is filed after the NIRC, and the accompanying petition under 37 CFR 1.182 is granted, the examiner will reconsider the case in view of the new information, and if appropriate, will reopen prosecution. >See MPEP § 2656 for a detailed discussion of the criteria for obtaining entry and consideration of information disclosure statement filed after the NIRC.<

Interviews, both personal and telephone, are **not** permitted in an *inter partes* reexamination proceeding (see MPEP § 2685). Thus, the examiner is not permitted to telephone the patent owner and obtain authorization to make an amendment. The only time an examiner's amendment can be made in an *inter partes* reexamination after the NIRC has been issued is where an examiner's amendment is needed to address matters that do not require the patent owner's approval. However, matters that do not require the patent owner's approval are generally minor formal matters. Thus, it would be rare for an examiner to need to withdraw the issued NIRC for issuance of a new NIRC with an examiner's amendment, since withdrawal of the NIRC should not be done for minor formal matters. In view of this, any examiner's amendment in an *inter partes* reexamination proceeding to be made after a NIRC (has been issued) requires the **\*\*>**Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) or Technology

Center (TC) Quality Assurance Specialist (QAS)< to approve the examiner's amendment.

Any "Comments on Statement of Reasons for Patentability and/or Confirmation" which are received will be placed in the reexamination file, without comment. This will be done even where the reexamination certificate has already issued.

### **2688 Issuance of *Inter Partes* Reexamination Certificate [R-7]**

35 U.S.C. 316. *Certificate of patentability, unpatentability and claim cancellation.*

(a) IN GENERAL.— In an *inter partes* reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

\*\*\*\*\*

37 CFR 1.997. **\*\*>***Issuance and publication of inter partes reexamination certificate concludes inter partes reexamination proceeding.<*

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

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

(c) The certificate will be sent to the patent owner at the address as provided for in § 1.33(c). A copy of the certificate will also be sent to the third party requester of the *inter partes* reexamination proceeding.

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

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

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

Since abandonment is not possible in a reexamination proceeding, an *inter partes* reexamination certificate will be issued at the conclusion of the proceeding

for each patent in which a reexamination proceeding has been ordered under 37 CFR 1.931, except where the reexamination has been concluded by vacating the reexamination proceeding, or by the grant of a reissue patent on the same patent in which case the reissue patent also serves as the reexamination certificate.

The *inter partes* reexamination certificate will set forth the results of the proceeding and the content of the patent following the reexamination proceeding. The certificate will:

(A) cancel any patent claims determined to be unpatentable;

(B) confirm any patent claims determined to be patentable;

(C) incorporate into the patent any amended or new claims determined to be patentable;

(D) make any changes in the description approved during reexamination;

(E) include any statutory disclaimer or terminal disclaimer filed by the patent owner;

(F) identify unamended claims which were held invalid on final holding by another forum on any grounds;

(G) identify any patent claims not reexamined;

(H) be mailed on the day of its date to the patent owner at the address provided for in 37 CFR 1.33(c), and a copy will be mailed to the requester; and

(I) refer to patent claims, dependent on amended claims, determined to be patentable.

If a certificate issues which cancels all of the claims of the patent, no further Office proceedings will be conducted with regard to that patent or any reissue application or reexamination request directed thereto. However, in an extremely rare situation in which a reissue application is copending with a reexamination proceeding in which a reexamination certificate subsequently issues cancelling all claims of the patent, the patent owner may file a petition under 37 CFR 1.183 requesting waiver of the provisions of 37 CFR 1.997(d), to address claims that were pending in the reissue application prior to the issuance of the certificate. Any such petition must be accompanied by a paper cancelling any claim within the scope of the claims canceled by the certificate and pointing out why the claims remaining in the reissue application can be patentable, despite the cancellation of all the patent claims by certificate, i.e., why the remaining

claims are patentable over the cancelled claims. Such a paper will be available to the examiner, should the petition be granted.<

If a reexamination proceeding is concluded by the grant of a reissue patent as provided for in 37 CFR 1.991, the reissue patent will constitute the reexamination certificate required by 35 U.S.C. 316.

If all of the claims are disclaimed in a patent under reexamination, a certificate under 37 CFR 1.997 will be issued indicating that fact.

A notice of the issuance of each reexamination certificate will be published in the *Official Gazette* on its date of issuance in a format similar to that used for reissue patents. See MPEP § 2691.

## 2689 Reexamination Review [R-7]

After a reexamination case is acted on by the examiner and all premailing clerical processing is completed, the case is forwarded to the >Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS)<. The >CRU SPE/TC QAS< (with the aid of the paralegals or other technical support who might be assigned as backup) will then (A) procedurally review the examiner's action for compliance with the applicable provisions of the reexamination statute and regulations, and with reexamination policy, practice and procedure, (B) do a completeness review of the action to ensure that all issues and arguments raised by all parties are appropriately developed, considered and addressed, and that all materials of the action (e.g., references, forms and cover sheets) are present and appropriately completed and (C) hand carry any paper parts of the file directly to the Reexamination Legal Advisor (RLA). The RLA will do a general review of the examiner's action for correct application of reexamination law, rules, procedure and policy.

In addition to the >CRU SPE/TC QAS< review of the reexamination cases, a panel review is made prior to issuing Office actions as set forth in MPEP § 2671.03.

After a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) has been issued and prosecution has been terminated, the reexamination case is screened by the Office of Patent Legal Administration for obvious errors and proper preparation, in order to issue a reexamination certificate. The above

identified review processes are appropriate vehicles for providing information on the uniformity of practice, identifying problem areas and providing feedback to the Office personnel that process and examine reexamination cases.

### 2690 Format of *Inter Partes* Reexamination Certificate [R-3]

An *inter partes* reexamination certificate is issued at the close of each *inter partes* reexamination proceeding in which reexamination has been ordered under 37 CFR 1.931, unless the *inter partes* reexamination proceeding is merged with a reissue application pursuant to 37 CFR 1.991. In that situation, the *inter partes* reexamination proceeding is concluded by the grant of a reissue patent, the reissue patent will constitute the reexamination certificate. It should be noted that where an *ex parte* reexamination is merged with an *inter partes* reexamination proceeding, an *inter partes* reexamination certificate will issue for the merged proceeding.

The *inter partes* reexamination certificate is formatted much the same as the title page of current U.S. patents.

The certificate is titled “*INTER PARTES REEXAMINATION CERTIFICATE*.” The title is followed by an “ordinal” number in parentheses, such as “(5<sup>th</sup>)”, which indicates that it is the fifth *inter partes* reexamination certificate that has issued. The *inter partes* reexamination certificates will be numbered in a separate and new ordinal sequence, beginning with “(1<sup>st</sup>)”. The *ex parte* reexamination certificates will continue the ordinal numbering sequence that has already been established for *ex parte* reexamination certificates.

The certificate number will always be the patent number of the original patent followed by a two-character “kind code” suffix. The “kind code” suffix is **C1** for a first reexamination certificate, **C2** for a second reexamination certificate for the same patent, etc.

For example, “1” is provided in the certificate for the first reexamination certificate and “2” for the second reexamination certificate. Thus, a second reexamination certificate for the same patent would be designated as “C2” preceded by the patent number. The next higher number will be given to the reexamination proceeding for which the reexamination certifi-

cate is issued, regardless of whether the proceeding is an *ex parte* reexamination or an *inter partes* reexamination proceeding.

Note that “B1” *ex parte* reexamination certificates that were issued prior to January 1, 2001, included the patent number of the original patent followed by the letter “B.” Where the first reexamination certificate was a “B1” certificate and an *inter partes* reexamination certificate then issues, the *inter partes* reexamination certificate will be designated “C2” and NOT “C1.” Thus, by looking at the number following the “C,” one will be able to ascertain the number of reexamination certificates that preceded the certificate being viewed, i.e., how many prior reexamination certificates have been issued for the patent. (If this were not the practice and C1 were used, one would not be able to ascertain from the number on the certificate how many B certificates came before.)

The certificate denotes the date the certificate was issued at INID code [45] (see MPEP § 901.04). The title, name of inventor, international and U.S. classification, the abstract, and the list of prior art documents appear at their respective INID code designations, much the same as is presently done in utility patents.

The primary differences, other than as indicated above, are:

(A) The filing date and number of the request is preceded by “Reexamination Request;”

(B) The patent for which the certificate is now issued is identified under the heading “Reexamination Certificate for”; and

(C) The prior art documents cited at INID code [56] will be only those which are part of the reexamination file and cited on forms PTO-1449 \*->, PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having a format equivalent to one of these forms) (and the documents have not been crossed out because they were not considered) and PTO-892.

Finally, the certificate will identify the patent claims which were confirmed as patentable, canceled, disclaimed, and those claims not examined. Only the status of the confirmed, canceled, disclaimed, and not examined claims will be indicated in the certificate. The text of the new and amended claims will be printed in the certificate. Any new claims will be printed in the certificate completely in italics, and any amended claims will be printed in the certificate with

italics and bracketing indicating the amendments thereto. Any prior court decisions will be identified, as well as the citation of the court decisions.

### 2691 Notice of *Inter Partes* Reexamination Certificate Issuance in *Official Gazette* [R-3]

The *Official Gazette* notice will include bibliographic information, and an indication of the status of each claim after the \*>conclusion< of the reexamination proceeding. Additionally, a representative claim will be published along with an indication of any changes to the specification or drawing.

The notice of reexamination certificate will clearly state that it is a certificate for a concluded *inter partes* reexamination proceeding (as opposed to an *ex parte* reexamination proceeding).

### 2692 Distribution of Certificate [R-3]

\*\*>An e-copy< of the *inter partes* reexamination certificate \*\*>will be associated with the e-copy< of the patent in the search files. A copy of the certificate will also be made a part of any patent copies prepared by the Office subsequent to the issuance of the certificate.

A copy of the *inter partes* reexamination certificate will also be forwarded to all depository libraries and to those foreign offices which have an exchange agreement with the Office.

### 2693 Intervening Rights [Added R-2]

35 U.S.C. 316. *Certificate of patentability, unpatentability and claim cancellation.*

\*\*\*\*\*

(b) AMENDED OR NEW CLAIM.— Any proposed amended or new claim determined to be patentable and incorporated into a patent following an *inter partes* reexamination proceeding shall have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, prior to issuance of a certificate under the provisions of subsection (a) of this section.

The situation of intervening rights resulting from *inter partes* reexamination proceedings parallels the intervening rights situation resulting from reissue pat-

ents or from *ex parte* reexamination proceedings. The rights detailed in 35 U.S.C. 252 for reissue apply equally in reexamination and reissue situations. See *Fortel Corp. v. Phone-Mate, Inc.*, 825 F.2d 1577, 3 USPQ2d 1771 (Fed. Cir. 1987); *Kaufman Co., Inc. v. Lantech, Inc.*, 807 F.2d 970, 1 USPQ2d 1202 (Fed. Cir. 1986); *Tennant Co. v. Hako Minuteman, Inc.*, 4 USPQ2d 1167 (N.D. Ill. 1987); and *Key Mfg. Group, Inc. v. Microdot, Inc.*, 679 F.Supp. 648, 4 USPQ2d 1687 (E.D. Mich. 1987).

### 2694 Concluded Reexamination Proceedings [R-7]

*Inter partes* reexamination proceedings may be concluded in one of three ways:

(A) The prosecution of the reexamination proceeding may be \*>brought to an end,< and the proceeding itself concluded, by a denial of reexamination>,< or vacating the reexamination proceeding\*\*>, or terminating the reexamination proceeding. (In these instances, no reexamination certificate is issued).<

>

(1) < A \* reexamination file (IFW or paper) in which reexamination has been denied or vacated should be forwarded to the Central Reexamination Unit (CRU) if the file is not already there. The CRU will process the file to provide the partial refund set forth in 37 CFR 1.26(c). The reexamination file will then be given \*\*>an 820< status (reexamination denied) or \*\*>an 822< status (reexamination vacated). A copy of the PALM “Application Number Information” screen and the “Contents” screen is printed, the printed copy is annotated by adding the comment “PROCEEDING CONCLUDED,” and the annotated copy is then scanned into IFW using the miscellaneous letter document code.

>

(2) A reexamination file (IFW or paper) in which reexamination has been terminated should be forwarded to the CRU if the file is not already there. The reexamination file will then be given an 820 status (reexamination terminated). A copy of the PALM “Application Number Information” screen and the “Contents” screen is printed, the printed copy is annotated by adding the comment “PROCEEDING CONCLUDED,” and the annotated copy is then scanned



into IFW using the miscellaneous letter document code. A partial refund is not made in this instance, since the reexamination was properly commenced and addressed, and was terminated later based upon a court decision, or the like.<

(B) The proceeding may be concluded under 37 CFR 1.997(b) with the issuance of a reexamination certificate.

A reexamination proceeding that is to be concluded in this manner should be processed as set forth in MPEP § 2687 and then forwarded to the CRU for review, mailing of the NIRC, and forwarding the file to the Office of \*>Data Management<.

(C) The proceeding may be concluded under 37 CFR 1.997(e) where the reexamination proceeding has been merged with a reissue proceeding and a reissue patent is granted; an individual reexamination certificate is not issued, but rather the reissue patent serves as the certificate.

A reexamination proceeding that is concluded in this manner should be processed, together with the reissue proceeding, as set forth in MPEP § 1455 and forwarded to the Office of Patent Legal Administration in accordance with MPEP § 1456.

**2695 Reexamination of a Reexamination [Added R-2]**

See MPEP § 2295 for guidance for the processing and examination of a reexamination request filed on a patent for which a reexamination certificate has already issued, or a reexamination certificate issues on a prior reexamination, while the new reexamination is pending. This reexamination request is generally referred to as a “reexamination of a reexamination.” A reexamination of a reexamination is processed in accordance with the guidelines set forth in MPEP § 2295 regardless of whether the reexamination certificate was issued for an *ex parte* reexamination or an *inter partes* reexamination, and regardless of whether the pending reexamination proceeding is an *ex parte* reexamination or an *inter partes* reexamination.

**2696 USPTO Forms To Be Used in *Inter Partes* Reexamination [R-3]**

The correct forms which are to be used by the Office in *inter partes* reexamination actions and processing are as follows (these forms are not reproduced below):

(A) NOTICE OF FAILURE TO COMPLY WITH <i>INTER PARTES</i> REEXAMINATION REQUEST FEE REQUIREMENTS.....	PTOL 2057
(B) NOTICE OF <i>INTER PARTES</i> REEXAMINATION REQUEST FILING DATE.....	PTOL 2058
(C) NOTICE OF INCOMPLETE REQUEST FOR <i>INTER PARTES</i> REEXAMINATION.....	PTOL 2059
(D) NOTICE OF ASSIGNMENT OF <i>INTER PARTES</i> REEXAMINATION REQUEST.....	PTOL 2060
(E) NOTE TO *>SPE</EXAMINER/TC PERSONNEL OF <i>INTER PARTES</i> REEXAMINATION DEADLINES.....	PTOL 2061
(F) NOTICE OF CONCURRENT PROCEEDING(S).....	PTOL 2062
(G) ORDER GRANTING/DENYING REQUEST FOR <i>INTER PARTES</i> REEXAMINATION.....	PTOL 2063
(H) OFFICE ACTION IN <i>INTER PARTES</i> REEXAMINATION.....	PTOL 2064
(I) ACTION CLOSING PROSECUTION (37 CFR 1.949).....	PTOL 2065

MANUAL OF PATENT EXAMINING PROCEDURE

(J) RIGHT OF APPEAL NOTICE (37 CFR 1.953).....	PTOL 2066
(K) <i>INTER PARTES</i> REEXAMINATION NOTIFICATION REAPPEAL.....	PTOL 2067
(L) NOTICE OF INTENT TO ISSUE <i>INTER PARTES</i> REEXAMINATION CERTIFICATE.....	PTOL 2068
(M) REEXAMINATION REASONS FOR PATENTABILITY/CONFIRMATION.....	PTOL 476
(N) NOTICE OF DEFECTIVE PAPER IN <i>INTER PARTES</i> REEXAMINATION.....	PTOL 2069
(O) TRANSMITTAL OF COMMUNICATION TO THIRD PARTY REQUESTER – <i>INTER PARTES</i> REEXAMINATION.....	PTOL 2070
(P) <i>INTER PARTES</i> REEXAMINATION COMMUNICATION (WITH SSP).....	PTOL 2071
(Q) <i>INTER PARTES</i> REEXAMINATION COMMUNICATION (NO SSP).....	PTOL 2072
(R) <i>INTER PARTES</i> REEXAMINATION NOTIFICATION RE BRIEF.....	PTOL 2073
(S) EXAMINER CHECKLIST – REEXAMINATION.....	PTOL 1516
(T) REEXAMINATION CLERK CHECKLIST.....	PTOL 1517

A user Request for Reexamination Transmittal Form, PTO/SB/58, is provided for public use in filing

a request for *inter partes* reexamination; its use, however, is not mandatory.