

2213 Representative of Requester [R-2]

37 CFR 1.510. Request for *ex parte* reexamination.

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

Where an attorney or agent files a request for an identified client (the requester), he or she may act under either a power of attorney >from the client<, or act in a representative capacity under 37 CFR 1.34(a), >see< 37 CFR 1.510(f). While the filing of the power of attorney is desirable, processing of the reexamination request will not be delayed due to its absence.

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

All correspondence for a requester that is not the patent owner should be addressed to the representative of the requester, unless a specific indication is made to forward correspondence to another address.

If the request is filed by a person on behalf of the patent owner, correspondence will be directed to the patent owner at the address as indicated in 37 CFR 1.33(c), regardless of the address of the person filing the request. See MPEP § 2222 for a discussion of who receives correspondence on behalf of a patent owner and how changes in the correspondence address are to be made.

A patent owner may not be represented during a reexamination proceeding by an attorney or other person who is not registered to practice before the Office, since those individuals are prohibited by 37 CFR 1.33(c) from signing amendments and other papers filed in a reexamination proceeding on behalf of the patent owner.

2214 Content of Request for *Ex Parte* Reexamination [R-3]

37 CFR 1.510. Request for *ex parte* reexamination.

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

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

(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.

(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how claims distinguish over cited prior art.

(3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.

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

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

37 CFR 1.510(a) requires the payment of the fee specified in 37 CFR 1.20(c)(1) for a request for reexamination. See MPEP § 2215. >If a request filed by the patent owner includes a proposed amendment in accordance with 37 CFR 1.530, excess claims fees under 37 CFR 1.20(c)(3) and (c)(4) may also apply; see MPEP § 2250.03.<

37 CFR 1.510(b) sets forth the required elements of a request for *ex parte* reexamination. The elements are as follows:

“(1) a statement pointing out each substantial new question of patentability based on prior patents and printed publications.”

This statement should clearly point out what the requester considers to be the substantial new question of patentability which would warrant a reexamination. The cited prior art should be listed on a form PTO-1449>, PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having a format equivalent to one of these forms)< by the requester. See also MPEP § 2217.

A request for reexamination must assert a substantial new question of patentability. A requester may

not, in a request for reexamination, argue that the submitted references do not raise a substantial new question of patentability, and that no order for reexamination should be issued.

“(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how claims distinguish over cited prior art.”

The request should apply the cited prior art to every claim for which reexamination is requested. If the request is filed by the patent owner, he or she may also indicate how the claims distinguish from the cited prior art patents and printed publications.

“(3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.”

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 § 2218.

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

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 are 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.

Any disclaimer, certificate of correction, or reexamination certificate issued in the patent becomes a part of the patent. Thus, a copy of each must be supplied in order to provide the complete patent. The copy must have each page plainly written on only one side of a sheet of paper.

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

If the request is filed by a person other than the patent owner, a certification that a copy of the request papers has been served on the patent owner must be included. The certification must set forth the name and address employed in serving the patent owner. If service was not possible, a duplicate copy of the request must be supplied to the Office. The request should be as complete as possible, since there is no guarantee that the examiner will consider other prior art when making the decision on the request. Also, if no statement under 37 CFR 1.530(b) is filed by the patent owner, no later reply under 37 CFR 1.535 or other submission may be filed by the requester in the *ex parte* reexamination proceeding. See also MPEP § 2220.

Form PTO/SB/57 should be helpful to persons filing requests for reexamination. The use of this form as the transmittal form and cover sheet of a request for reexamination is encouraged, but its use is not a requirement of the law nor the rules. Following form PTO/SB/57, is a sample of a statement (on which the request is based) that should be attached to the form PTO/SB/57 cover sheet.

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PTO/SB/57 (04-05)

Approved for use through 04/30/2007. 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.

(Also referred to as FORM PTO-1465)

REQUEST FOR EX PARTE REEXAMINATION TRANSMITTAL FORM

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

Attorney Docket No.:

Date:

1. This is a request for *ex parte* reexamination pursuant to 37 CFR 1.510 of patent number _____ issued _____. The request is made by:
 - patent owner.
 - third party requester.
2. The name and address of the person requesting reexamination is:

3. a. A check in the amount of \$_____ is enclosed to cover the reexamination fee, 37 CFR 1.20(c)(1);

 b. The Director is hereby authorized to charge the fee as set forth in 37 CFR 1.20(c)(1) 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 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 1.510(b)(4)
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 1.510. 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 Ex Parte 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.

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 1.510(b)(1)

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 1.510(b)(2)

13. A proposed amendment is included (only where the patent owner is the requester). 37 CFR 1.510(e)

14. a. It is certified that a copy of this request (if filed by other than the patent owner) 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 communication about the reexamination 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

Date

Typed/Printed Name

Registration No.

For Patent Owner Requester

For Third Party Requester

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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Attachment to Form PTO-1465
 providing information of
 Pat. No. 9, 999, 999

Sir:

Reexamination under 35 U.S.C. 302 - 307 and 37 CFR 1.510 is requested of United States patent number 9,999,999 which issued on July 7, 1987, to Joseph Smith. This patent is still enforceable.

I. Claims for which reexamination is requested:

- Reexamination is requested of claims 1- 3 of the Smith patent in view of the earlier United States Patent number 594,225 to Berridge which is listed on attached Information Disclosure Statement form and of which a copy is enclosed.

- Reexamination is also requested of claim 4 of the Smith patent in view of the earlier Swiss Patent 80,555 to Hotopp in view of the disclosure in "American Machinist" magazine, October 16, 1950, issue, on page 169. An English translation of the German language Swiss document is enclosed. Copies of the Hotopp and "American Machinist" documents are also enclosed.

II. Explanation of pertinency and manner of applying cited prior art to every claim for which reexamination is requested based on prior art:

Claims 1- 3 of the Smith patent are considered to be fully anticipated under 35 U.S.C. 102 by the prior art patent document to Berridge.

Claim 3 of the Smith patent, which is more specific than claims 1 and 2 in all features, is set forth below with an explanation as to how the prior art patent document to Berridge meets all the recited features.

Smith, claim 3:

"In a cutting and crimping tool"	(Berridge page 1, lines 10-13 states his invention is "an improved tool for crimping metal which in its preferred form of embodiment is combined with a cutting-tool or shears, forming therewith a combination-tool".)
"the combination with the cutting blades"	(elements 4 and 5 in Berridge)
"and their pivoted handles"	(elements 1 and 2 in Berridge)

- 2 -

Pat. No. 9,999,999

"of bosses arranged at an angle to and offset from the plane of the shear blades"

("bosses" as used in the Smith claim is used to mean a projection. The dies 6 and 7 of the Berridge prior art patent document are arranged at the same angle to the plane of the shear blades and are arranged at an angle in the same manner as shown in the drawing figures of the Smith patent.)

"and crimping dies formed on the meeting faces of said bosses"

(The dies 6 and 7 (bosses) of Berridge have meeting die-faces 12 and 13 (page 1, line 63) for performing crimping operations (page 1, lines 70 - 74.1))

Claim 4 of the Smith patent is considered to be unpatentable under 35 U.S.C. 103 in view of the prior art Swiss patent document to Hotopp and further in view of the prior art American Machinist magazine publication, page 169 of the October 16, 1950 issue.

Claim 4 of Smith reads as quoted below:

"In a cutting and crimping tool,"

(The prior art Swiss patent document to Hotopp discloses cutting jaws (column 1, line 8) and dies "b" and "c" which may be used for crimping.)

"the combination of a pair of pivoted handles"

(elements "a" and "e" in the prior art document to Hotopp).

"with cutting jaws at one end and crimping dies on the opposite side of the pivot"

(The prior art document to Hotopp discloses cutting jaws (column 1 line 8) and crimping dies "b" and "c" on the opposite side of pivot "d" from the cutting jaws.)

- 3 -

Pat. No. 9,999,999

"and rounded prongs projecting
from said cutting jaws"

(Rounded prongs are not specifically disclosed by Hotopp but are shown to be old in the art by the illustration in "American Machinist" magazine under the title "Double-Purpose Pliers Don't Break Insulation". To provide the cutting jaws of Hotopp with rounded prongs as shown in the "American Machinist" magazine is considered to be a matter which would have been obvious to a person having ordinary skill in the art at the time the invention was made.)

III. Statement pointing out substantial new question of patentability:

The prior art documents referred to above were not of record in the file of the Smith patent. Since claims 1-4 in the Smith patent are not patentable over these prior art documents, a substantial new question of patentability is raised. Further, these prior art documents are closer to the subject matter of Smith than any prior art which was cited during the prosecution of the Smith patent. These prior art documents provide teachings not provided during prosecution of the Smith patent.

(Signed)

John Doe
Attorney for requester

2215 Fee for Requesting *Ex Parte* Reexamination [R-3]

37 CFR 1.510. Request for *ex parte* reexamination.

(c) If the request does not include the fee for requesting reexamination or all of the parts required by paragraph (b) of this section, the person identified as requesting reexamination will be so notified and given an opportunity to complete the request within a specified time. If the fee for requesting reexamination has been paid but the defect in the request is not corrected within the specified time, the determination whether or not to institute reexamination will be made on the request as it then exists. If the fee for requesting reexamination has not been paid, no determination will be made and the request will be placed in the patent file as a citation if it complies with the requirements of § 1.501(a).

(d) The filing date of the request is:

(1) The date on which the request including the entire fee for requesting reexamination is received in the Patent and Trademark Office; or

(2) The date on which the last portion of the fee for requesting reexamination is received.

In order for a request to be accepted, be given a filing date, and be published in the *Official Gazette*, the entire fee required under 37 CFR 1.20(c)(1) for filing a request for reexamination must be paid. >If the request was filed by the patent owner and includes a proposed amendment in accordance with 37 CFR 1.530, excess claims fees under 37 CFR 1.20(c)(3) and (c)(4) may also apply; see MPEP § 2250.03.<

If the request for *ex parte* reexamination is subsequently denied or vacated, a refund in accordance with 37 CFR 1.26(c) will be made to the identified requester.

If the entire fee for *ex parte* reexamination is not paid, the request will be considered to be incomplete. See 37 CFR 1.510 (c) and (d).

Where the entire filing fee is not paid after the 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 for a citation of prior art under 37 CFR 1.501. See MPEP § 2206 for handling of prior art citations.

2216 Substantial New Question of Patentability [R-2]

Under 35 U.S.C. 304, the Office must determine whether “a substantial new question of patentability” affecting any claim of the patent has been raised. 37 CFR 1.510(b)(1) requires that a request for >*ex parte*< reexamination include “a statement pointing out each substantial new question of patentability based on prior patents and printed publications.” If such a new question is found, an order for >*ex parte*< reexamination of the patent is issued. It is therefore important that the request clearly set forth in detail what the requester considers the “substantial new question of patentability” to be in view of prior patents and printed publications. The request should point out how any questions of patentability raised are substantially different from those raised in the previous examination of the patent before the Office. If a substantial new question of patentability is found as to one claim, all claims will be reexamined during the *ex parte* reexamination process. See also MPEP § 2242.

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 public use, on sale, and fraud.

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.

2217 Statement in the Request Applying Prior Art [R-3]

The third sentence of 35 U.S.C. 302 indicates that the “request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.” 37 CFR 1.510(b)(2) requires that the request include “[a]n identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested.” If the request is filed by the patent owner, the request for reexamination may also point out how claims distinguish over cited prior art.

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:

“(a)...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... more than one year prior to the date of the application for patent in the United States, or”

“(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”

“(f) he did not himself invent the subject matter sought to be patented, or”

“(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person’s invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (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.”

** Substantial new questions of patentability may also be presented under 35 U.S.C. 103 which are based on the above indicated portions of 35 U.S.C. 102. ** See MPEP § 706.02(1)(1) for information per-

taining to references which qualify as prior art under 35 U.S.C. 102(e)/103.

Substantial new questions of patentability must be based on patents or printed publications. Other matters, such as public use or on 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, insufficiency of disclosure, etc. 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 the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, the effective date of some of the claims in a patent which resulted from a continuing application under 35 U.S.C. 120 could be the filing date of the continuing application since those claims were not supported in the parent application. Therefore, intervening patents or printed publications are 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.

Double patenting is normally proper for consideration in reexamination. See *In re Lonardo*, 119 F.3d 960, 43 USPQ2d 1262 (Fed. Cir. 1997). See also the discussion as to double patenting in MPEP § 2258.

The mere citation of new patents or printed publications without an explanation does not comply with 37 CFR 1.510(b)(2). Requester must present an explanation of how the cited patents or printed publications are applied to all claims which requester considers to merit reexamination. This not only sets forth the requester’s position to the Office, but also to the patent owner (where the patent owner is not the requester).

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.

ADMISSIONS

The consideration under 35 U.S.C. 303 of a request for *ex parte* reexamination is limited to prior art patents and printed publications. See *Ex parte McGaughey*, 6 USPQ2d 1334, 1337 (Bd. Pat. App. & Inter. 1988). Thus an admission, *per se*, may not be the basis for establishing a substantial new question of patentability. However, 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 handling of admissions during the examination stage of a 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** in a prior art rejection, whether such admissions result from patents or printed publications or from some other source. An admission relating to *any* prior art established in the record or in court may be used by the examiner in combination with patents or printed publications in a reexamination proceeding. The admission must stand on its own. 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 the court record. Such a submission would be outside the scope of reexamination.

2218 Copies of Prior Art [R-2]

It is required that a copy of each patent or printed publication relied on or referred to in the request, < be filed with the request (37 CFR 1.510(b)(3)). If any of the documents are not in the English language, an English language translation of all necessary and pertinent parts is also required. An English language

summary or abstract of a non-English language document is usually not sufficient.

It is also helpful to include copies of the prior art considered 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. See MPEP § 2242.

Copies of parent applications should be submitted if the content of the parent application has a bearing on the alleged substantial new question of patentability; for example, if the patent is a continuation-in-part and the question of patentability relates to a rejection based on intervening prior art where support in the parent application is relevant. *In re Russetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958).

2219 Copy of Printed Patent [R-3]

The U.S. Patent and Trademark Office will prepare a separate file * for each reexamination request, which will become part of the patent file. **>In order to provide a format which can be amended and used for printing, requesters are required under 37 CFR 1.510(b)(4) to include a copy of the patent for which reexamination is requested, to serve as the specification for the reexamination proceeding. A copy of the patent for which reexamination is requested should be provided in a double column format. Thus, a full copy of the printed patent (including the front page) would be used to provide the abstract, drawings, specification, and claims of the patent for the reexamination request and the resulting reexamination proceeding. A copy of any disclaimer, certificate of correction, or reexamination certificate issued for the patent must also be included, so that a complete history of the patent 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.

2220 Certificate of Service [R-2]

If the requester is a person other than the patent owner, the owner of the patent must be served with a copy of the request in its entirety. The service should be made to the correspondence address as indicated in 37 CFR 1.33(c). The third party requester must set forth on the certificate of service the name and

address of the party served and the method of service. The certificate of service must be attached to the request submitted to the Office. Further, the copy of the request served on the patent owner must also include a copy of the certificate of service.

The most recent address of the attorney or agent of record can be determined by checking the Office's register >(roster)< of patent attorneys and agents maintained by the Office of Enrollment and Discipline pursuant to 37 CFR 10.5 and 10.11(a). See MPEP § 2266.03 regarding service on the requester and on the patent owner.

2221 Amendments Included in Request by Patent Owner [R-3]

Under 37 CFR 1.510(e), a patent owner may include a proposed amendment with his or her request. Any such amendment must be in accordance with 37 CFR 1.530(d) through (j). See MPEP § 2250 >as to the format and requirements of an amendment in a reexamination proceeding. If an amendment is submitted to add claims to the patent being reexamined, 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 the discussion of excess claim fees in MPEP § 2250.03<. Amendments may also be proposed by patent owners in a statement under 37 CFR 1.530(b) and (c) or during the actual *ex parte* reexamination prosecution (37 CFR 1.550(b)). See also MPEP § 2234 and § 2250.

The request should be decided on the wording of the patent claims in effect at that time (without any proposed amendments). The decision on the request will be made on the basis of the patent claims as though the proposed amendment had not been presented. However, if the request for reexamination is granted, all subsequent reexamination prosecution and examination should be on the basis of the claims as amended.

2222 Address of Patent Owner [R-3]

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

(c) **>All notices, official letters, and other communications for the patent owner or owners in a reexamination proceed-

ing will be directed to the attorney or agent of record (*see* § 1.32(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to §§ 11.5 and 11.11 of this subchapter, or, if no attorney or agent is of record, to the patent owner or owners at the address or addresses of record. 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. If more than one attorney or agent is of record and a correspondence address has not been specified, correspondence will be held with the last attorney or agent made of record.<

In 37 CFR 1.33(c), it is indicated which correspondence address is to be normally used to direct correspondence to the patent owner. In most instances, this will be the address of the first named, most recent attorney or agent of record in the patent file, at his or her current address. 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. Correspondence will continue to be sent to the attorney or agent of record in the patent file absent a revocation of the same by the patent owner. If the attorney or agent of record specifies a correspondence address to which correspondence is to be directed, such direction should be followed. However, since a change in the correspondence address does not withdraw a power of attorney, a change of the correspondence address by the patent owner does not prevent the correspondence from being directed to the attorney or agent of record in the patent file under 37 CFR 1.33(c).

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 *>ex parte<* reexamination has been filed ***>:<*

Mail Stop *Ex Parte* Reexam
***>*Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office<
P.O. Box 1450
Alexandria, VA 22313-1450

Where a request for *>inter partes<* reexamination has been filed ***>:<*

***>*Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office<
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

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

**>

PTO/SB/82 (04-05)

Approved for use through 11/30/2005. 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.

REVOCATION OF POWER OF ATTORNEY WITH NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	
Filing Date	
First Named Inventor	
Art Unit	
Examiner Name	
Attorney Docket Number	

I hereby revoke all previous powers of attorney given in the above-identified application.			
<input type="checkbox"/> A Power of Attorney is submitted herewith.			
OR			
<input type="checkbox"/> I hereby appoint the practitioners associated with the Customer Number:			
<input type="checkbox"/> Please change the correspondence address for the above-identified application to:			
<input type="checkbox"/> The address associated with Customer Number:			
OR			
<input type="checkbox"/> Firm or Individual Name			
Address			
City	State	Zip	
Country			
Telephone		Email	
I am the:			
<input type="checkbox"/> Applicant/Inventor.			
<input type="checkbox"/> Assignee of record of the entire interest. See 37 CFR 3.71. <i>Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</i>			
SIGNATURE of Applicant or Assignee of Record			
Signature			
Name			
Date	Telephone		
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*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

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 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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See MPEP § 324 for establishing assignee's right to take action when submitting a power of attorney.

**2223 Withdrawal of Attorney or Agent
[R-3]**

A 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.

**>

PTO/SB/83 (04-05)
 Approved for use through 11/30/2005. 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.

**REQUEST FOR WITHDRAWAL
 AS ATTORNEY OR AGENT
 AND CHANGE OF
 CORRESPONDENCE ADDRESS**

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 attorneys/agents of record.
- the attorneys/agents (with registration numbers) listed on the attached paper(s), or
- the attorneys/agents associated with Customer Number

NOTE: This box can only be checked when the power of attorney of record in the application is to all the practitioners associated with a customer number.

The reasons for this request are:

CORRESPONDENCE ADDRESS

- 1. The correspondence address is NOT affected by this withdrawal.
- 2. Change the correspondence address and direct all future correspondence to:
 The address associated with Customer Number:

OR

<input type="checkbox"/> Firm or Individual Name			
Address			
City	State	Zip	
Country			
Telephone			Email
Signature			
Name			Registration No.
Date			Telephone No.

NOTE: Withdrawal is effective when approved rather than when received. Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.

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.

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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2224 Correspondence [R-3]

**>All requests for *ex parte* reexamination (original request papers) and all subsequent *ex parte* 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 *Ex Parte* Reexam
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
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

A request for *ex parte* reexamination may not be sent by facsimile transmission (FAX). See 37 CFR 1.6(d)(5). All subsequent *ex parte* reexamination correspondence, however, may be FAXed to:

Central Reexamination Unit
(571) 272-0100.<

After the filing of the request for *ex parte* reexamination, any letters sent to the U.S. Patent and Trademark Office relating to the resulting *ex parte* reexamination proceeding should identify the proceeding by the number of the patent undergoing reexamination, the reexamination request control number assigned, TC art unit, and the name of the examiner. The certificate of mailing and transmission procedures (37 CFR 1.8) and “Express Mail” mailing procedure (37 CFR 1.10) may be used to file any paper in an *ex parte* reexamination proceeding.

Communications from the U.S. Patent and Trademark Office to the patent owner will be directed to the first named, most recent attorney or agent of record in

the patent file at the current address on the Office’s register of patent attorneys and agents, or to the patent owner’s address if no attorney or agent is of record, 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(a). See MPEP § 2213.

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 § 2220 on certificate of service.

>See MPEP § 2624 for correspondence in *inter partes* reexamination proceedings.<

2225 Untimely Paper Filed Prior to Order [R-2]

After filing of a request >for *ex parte* reexamination<, no papers >directed to the merits of the reexamination< other than (*>A<) citations of patents or printed publications under 37 CFR 1.501>or 37 CFR 1.555<, (*>B<) another complete request under 37 CFR 1.510>or 37 CFR 1.915<, or (*>C<) notifications pursuant to MPEP § 2282, should be filed with the Office prior to the date of the decision on the request for reexamination. Any papers >directed to the merits of the reexamination< other than those under 37 CFR 1.501 ** >, 1.555 or 1.915,< or MPEP § 2282 >,< filed prior to the decision on the request will be returned to the sender by the Technology Center Director without consideration. A copy of the letter accompanying the returned papers will be made of record in the patent file. However, no copy of the returned papers will be retained by the Office. If the submission of the returned papers is appropriate later in the proceedings, they will be accepted by the Office at that time. See *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985, 989 (Fed. Cir. 1985); *In re Knight*, 217 USPQ 294 (Comm’r Pat. 1982) and *In re Amp* *, 212 USPQ 826 (Comm’r Pat. 1981).

2226 Initial Processing of Request >for Ex Parte Reexamination< [R-2]

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

2227 Incomplete Request >for Ex Parte Reexamination< [R-2]

37 CFR 1.510. Request for ex parte reexamination.

(c) If the request does not include the fee for requesting reexamination or all of the parts required by paragraph (b) of this section, the person identified as requesting reexamination will be so notified and given an opportunity to complete the request within a specified time. If the fee for requesting reexamination has been paid but the defect in the request is not corrected within the specified time, the determination whether or not to institute reexamination will be made on the request as it then exists. If the fee for requesting reexamination has not been paid, no determination will be made and the request will be placed in the patent file as a citation if it complies with the requirements of § 1.501(a).

(d) The filing date of the request is:

(1) The date on which the request including the entire fee for requesting reexamination is received in the Patent and Trademark Office; or

(2) The date on which the last portion of the fee for requesting reexamination is received.

If the required fee under 37 CFR 1.20(c)(1) is not paid in full, the request is incomplete, 37 CFR 1.510(c), and will not be considered on its merits or have a notice of its filing announced in the *Official Gazette*. The request is considered to have a “filing date” under 37 CFR 1.510(d) only when the entire fee is paid. Until the entire fee is received, no control number or filing date will be assigned and technically, no reexamination exists.

If no fee is received, or only a portion of the fee is received, the reexamination preprocessing staff of the Office of Patent Legal Administration, Central Reexamination Unit (CRU) will notify the requester of the defect and give the requester a specified time, normally 1 month, to complete the request. This notice does not enter the system. A telephone call may also be made to the requester indicating the amount of the

insufficient fee. If the request is not timely completed, any partial fee will be returned by the CRU to the requester along with a notice that the reexamination request has not been accepted and the process has been terminated. If the request otherwise complies with 37 CFR 1.501(a), it will be treated as a citation under 37 CFR 1.501(a). If the request does not comply with 37 CFR 1.501(a), the request papers will be returned to the requester by the CRU.

2228 Informal Request >for Ex Parte Reexamination< [R-2]

If the fee under 37 CFR 1.20(c)(1) has been paid, but the request >for ex parte reexamination< does not contain all the elements called for by 37 CFR 1.510(b), the request is considered to be informal. All requests >for ex parte reexamination< which are accompanied with the entire fee will be assigned a filing date from which the 3-month period for making a decision on the request will be computed. **

The reexamination preprocessing staff of the Central Reexamination Unit will attempt to notify the requester of any informality in the request in order to give the requester time to respond before a decision is made on the request. If the requester does not respond and correct the informality, the decision on the request will be made on the information presented >, i.e., all of the art presented with the request and any argument or evidence in support of that art<. If the information presented does not present “a substantial new question of patentability,” the request for reexamination will be denied.

2229 Notice of Request for Ex Parte Reexamination in Official Gazette [R-3]

37 CFR 1.11. Files open to the public.

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

(d) All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public, and copies may be furnished upon paying the fee therefor.

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

Under 37 CFR 1.11(c), both reexamination requests with sufficient fees and Director-initiated orders >to reexamine< made without a request will be announced in the *Official Gazette*. The reexamination preprocessing staff of the 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 Publications for printing in the *Official Gazette*.

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. The *Official Gazette* notice will appear in the notice section of the *Official Gazette* under the heading of Requests for *Ex Parte* Reexamination Filed and will include the name of any requestor along with the other items set forth in 37 CFR 1.11(c).

2230 Constructive Notice to Patent Owner [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 actual notice to the patent owner. The publication in the *Official Gazette* of (* >A<) the notice of the filing of a request for reexamination, or (* >B<) the >notice of the< ordering of reexamination at the initiative of the *>Director of the Office<, will serve as constructive notice to the patent owner in such an instance.

2231 Processing of Request Corrections [R-3]

Any payment of insufficient request filing fee should be marked "Mail Stop *Ex Parte* Reexam" so

that the fee may be promptly forwarded to the reexamination preprocessing area of the Central Reexamination Unit (CRU). If the fee payment completes the payment of the required fee, the request will be processed, notice will be published in the *Official Gazette*, and the request will be forwarded to the appropriate Technology Center (TC) for determination.

Any correction of a defect other than the fee should be directed to the TC **>in which the reexamination is being examined<, after the reexamination has been assigned to a TC. The TC technical support staff will process any timely corrections and enter them in the file of the reexamination.

2232 Public Access [R-3]

**>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. 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 "Patents," (C) under "Check Status, View Papers..." click on "Status & IFW," and (D) under "Patent Application Information Retrieval" enter the control number of the reexamination proceeding.

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 & 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, 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.<

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2232.01 Determining if a Reexamination Was Filed for a Patent< [R-3]

* TO DETERMINE FROM PAIR OR 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 "Patents" located on the left side of the screen.
- **>Under "Check Status, View Papers..." click on "Status & IFW."
- On the next screen, under "Patent Application Information Retrieval" click "Patent Number" as the "Select Search Method."
- Enter the patent number (e.g., 5806063 – no commas are to be inserted) in "Enter Number" box.
- Click on "Submit."
- 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 (hyperlinked) 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.

2233 Processing in Technology Center [R-3]

The working groups in the Technology Centers (TCs) have designated the legal instrument examiners to act as reexamination clerks, as part of their assigned duties, and thus to perform those clerical duties and responsibilities in the groups which are unique to reexamination. The TC Special Program Examiners (SPREs) and Paralegal Specialists have the responsibility to oversee clerical processing and serve as a resource for questions.

I. FEES

Under reexamination, there are **>fees for the request (37 CFR 1.20(c)(1)), for addition of claims (excess claims fees under 37 CFR 1.20(c)(3) and (c)(4)), for an extension of time under 37 CFR 1.550(c), and for any appeal, brief, and oral hearing fees under 37 CFR 41.20(b). No fee is required for issue of the reexamination certificate<.

Any petitions filed under 37 CFR 1.137 or 37 CFR 1.182 or 1.183 relating to a reexamination proceeding require fees (37 CFR 1.17(*>f<), (l) and (m)).

Small entity reductions are available to the patent owner for the 37 CFR 1.137 petition fee, >excess claim fees,< appeal, brief, and oral hearing fees. Small entity reductions in fees are not available for the reexamination filing fee>, 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 (see MPEP § 2283 and § 2285), only a single fee is needed even though multiple copies of the submissions (one for each file) are required.

II. MAILING

A transmittal form with the requester's address will be used to forward copies of Office actions (and any references cited in the Office actions) to the 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

