

Chapter 2600 Optional Inter Partes Reexamination

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2601 Introduction [Added R-2]

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.

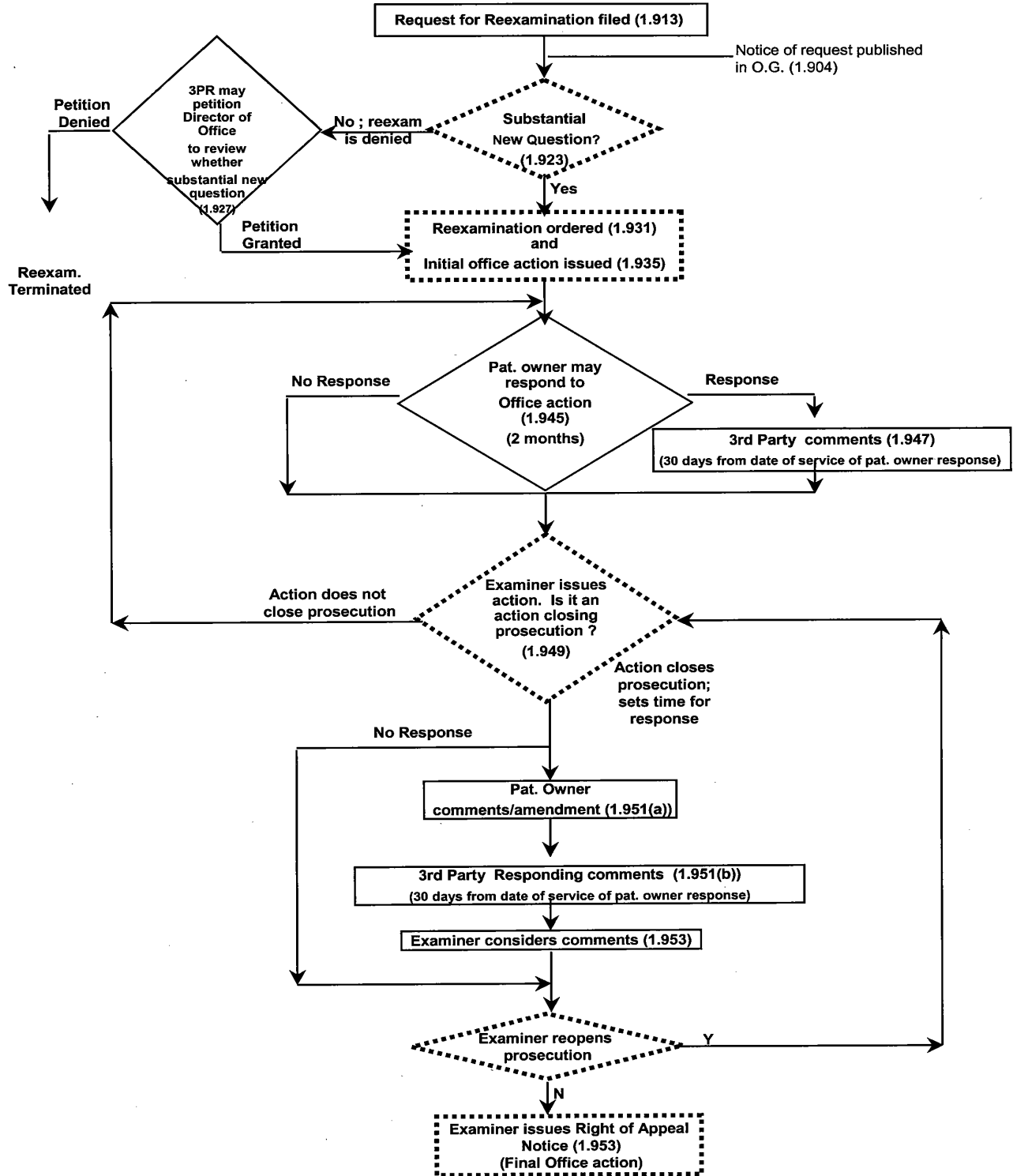
Both the statutory *inter partes* reexamination option, 35 U.S.C., Chapter 31, and the new *inter partes* reexamination rules, 37 CFR, Sub-part H, apply to all reexamination proceedings for patents issuing from applications filed on or after November 29, 1999. For a patent issued from an application 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.

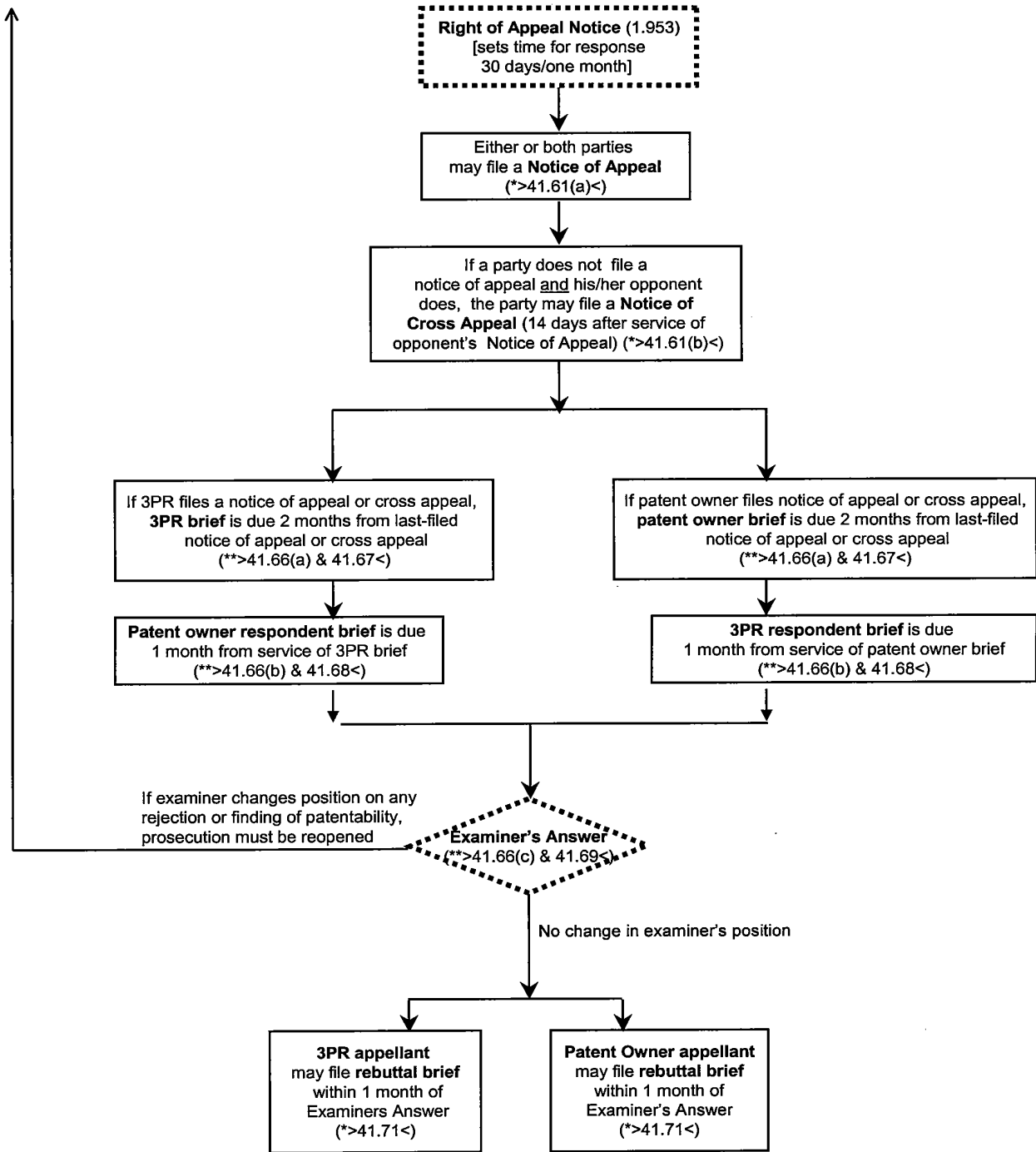
2601.01 Flowcharts [R-3]

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 3rd 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.

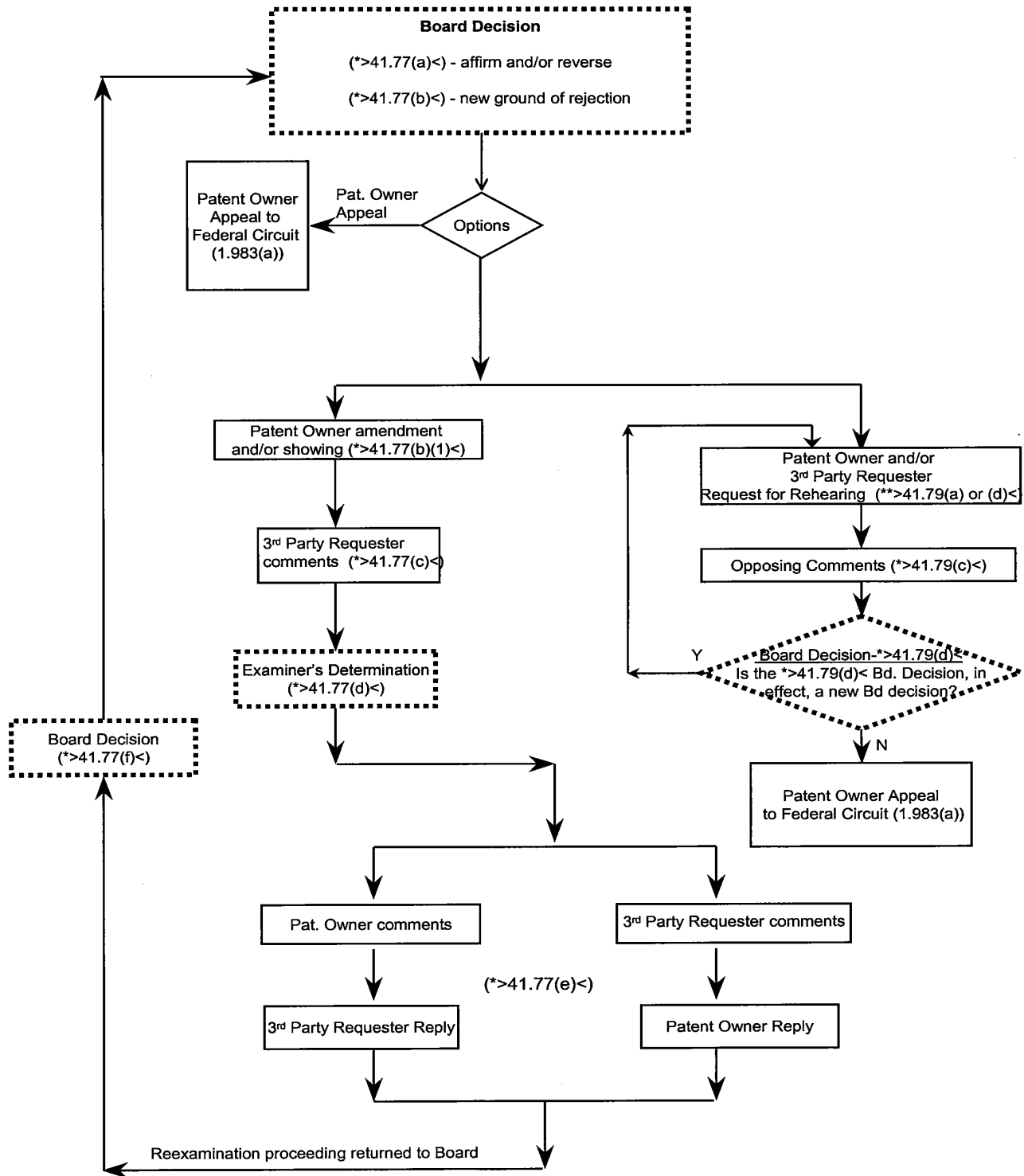
**Inter Partes Reexamination (applicable rule section)
PROCEDURE BEFORE APPEAL**



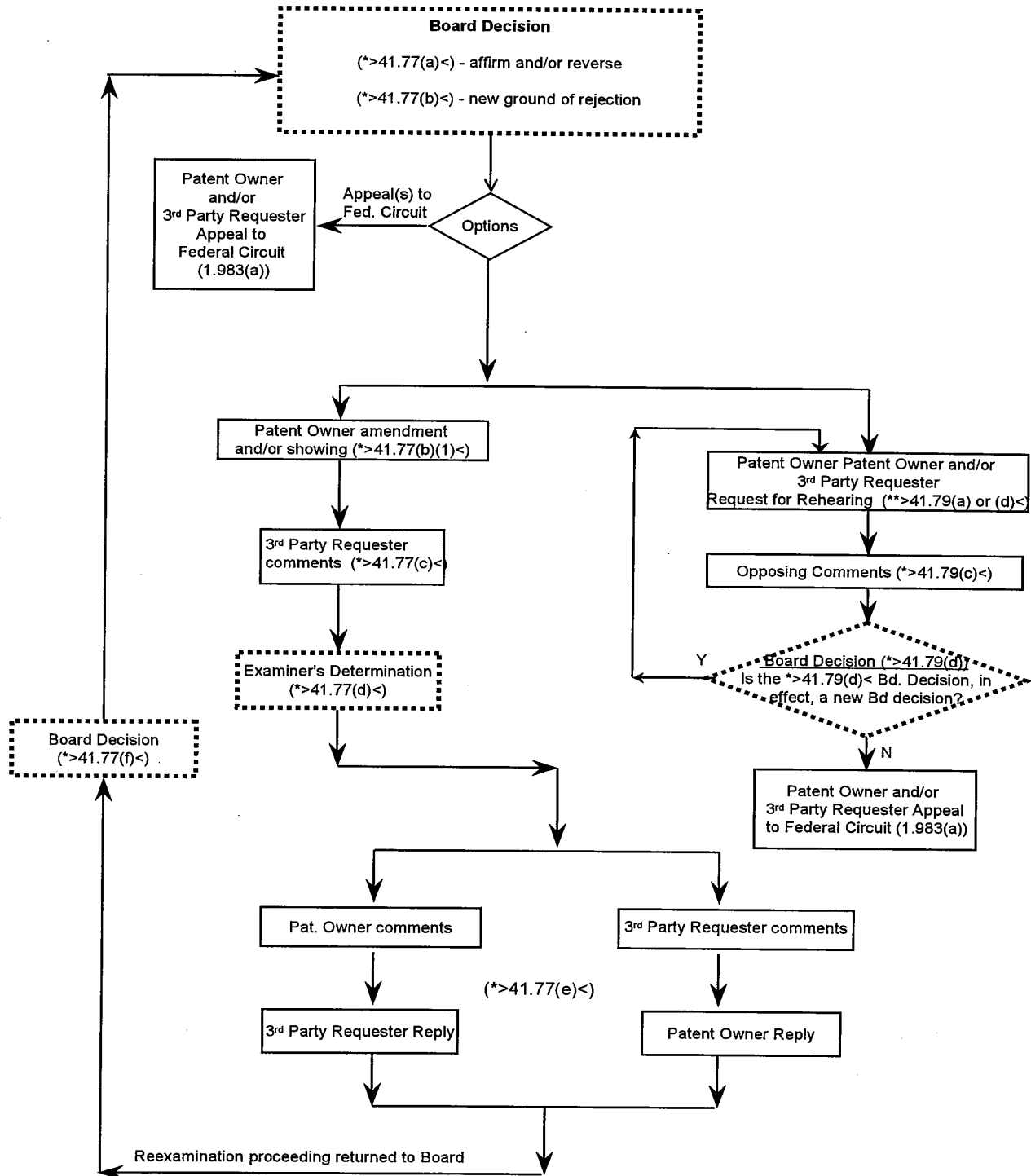
Inter Partes Reexamination (applicable rule section)
APPEAL PROCEDURE
Single Third Party Requester



**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**



2602 Citation of Prior Art [R-3]

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 § 1.915 or § 1.948, will be delayed until the *inter partes* reexamination proceeding has been terminated. See § 1.502 for processing of prior art citations in patent and reexamination files during an *ex parte* reexamination proceeding filed under § 1.510.

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 considered 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 Technology Center (in which the reexamination proceeding is being examined) until the reexamination is *>concluded<*, 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-3]

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.

2610 Request for *Inter Partes* Reexamination [Added R-2]

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(a).

(d) If the *inter partes* request does not meet all the requirements of subsection 1.915(b), the person identified as requesting *inter partes* reexamination may be so notified and given an opportunity to complete the formal requirements of the request within a specified time. Failure to comply with the notice may result in the *inter partes* reexamination proceeding being vacated.

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 [Added R-2]

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, 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-3]

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. 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.

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 [Added R-2]

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

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

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(a). 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.

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 should be 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-3]

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(a).

(d) If the *inter partes* request does not meet all the requirements of subsection 1.915(b), the person identified as requesting *inter partes* reexamination may be so notified and given an opportunity to complete the formal requirements of the request within a specified time. Failure to comply with the notice may result in the *inter partes* reexamination proceeding being vacated.

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-1449, **>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 which would warrant a reexamination should be included. The statement should apply the cited art (patents and printed publications) to each claim that requester wants reexamined based on prior patents and printed publications. 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.

“(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, a duplicate copy of the request must be supplied to the Office.

“(7) A certification by the third party requester that the stoppel 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).

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.

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.

Following the Form PTO/SB/58, is a sample of a statement on which the request for *inter partes* reexamination is based, which statement would be attached to the Form PTO/SB/58 cover sheet (that would be filled out by requester).

**>

PTO/SB/58 (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 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.

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.

<

Attachment to Request for
Inter Partes Reexamination Transmittal Form,
providing information
as to Patent No. 9,999,999

Sir:

Inter Partes reexamination under 35 U.S.C. 311-318 and 37 CFR 1.913 is requested of United States patent number 9,999,999 which issued on July 7, 2001, to Joseph Smith from an application filed November 29, 1999. This patent is still enforceable.

A: 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 594,225 to Berridge which is listed on the attached Information Disclosure 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.

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

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

Smith, claim 3:

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

“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 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).)

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 magazine publication on page 169 of the October 16, 1950, issue of American Machinist magazine.

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.)

“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.)

C: 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 the prosecution of the Smith patent.

(Signed)
Kenneth M. Schor
Attorney for Requester
Reg. No. 29760

2615 Fee for Requesting *Inter Partes* Reexamination [Added R-2]

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).

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 the fee requirement of § 1.915(a).

(b) If the request is not granted a filing date, the request will be placed in the patent file as a citation of prior art if it complies with the requirements of § 1.501.

In order for a request to be accepted, given a filing date, and published in the *Official Gazette*, it is necessary to have paid the fee required under 37 CFR 1.20(c)(2) for filing a request for *inter partes* reexamination. 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 reexamination is denied or vacated, a refund in accordance with 37 CFR 1.26(c) will be made to the identified requester. See 37 CFR 1.925.

See MPEP § 2634 for processing of the filing fee.

2616 Substantial New Question of Patentability [Added R-2]

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 considers the “substantial new question of patentability” to

be. 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 reexamination process. See also MPEP § 2642.

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, fraud, 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 [Added R-2]

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

(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.

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 Ruschetta*, 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 1.915(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.

Affidavits or declarations 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.

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. Such a submission would be outside the scope of reexamination.

2618 Copies of Prior Art (Patents and Printed Publications) [Added R-2]

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 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.

Copies of parent applications should also be submitted if the parent applications relate to the alleged substantial new question of patentability. For example, a parent application relates to the alleged substantial new question where the patent is a continuation-in-part and the question of patentability relates to support in the parent application for the claims.

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 [Added R-2]

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 should be made to the correspondence address 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.

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 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.

2622 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 proceeding 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 reexamination has been filed and a reexamination proceeding is accordingly pending as to a patent.

Mail Stop *Inter Partes* Reexam
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

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

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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.

**2623 Withdrawal of Attorney or Agent
[R-3]**

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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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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2624 Correspondence [R-3]

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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
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 *inter partes* reexamination may not be sent by facsimile transmission (FAX). See 37 CFR 1.6(d)(5). All subsequent *inter partes* reexamination correspondence, however, may be FAXed to:

Central Reexamination Unit
(571) 272-0100.<

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 or transmission procedures (37 CFR 1.8) and "Express Mail" procedure (37 CFR 1.10) may be used to file any paper in the existing *inter partes* reexamination proceeding.

Communications from the 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 cur-

rent 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).

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.

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

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2625 Untimely Paper Filed Prior to First Office Action [R-3]

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 § 1.915 or § 1.948, will be delayed until the *inter partes* reexamination proceeding has been terminated. See § 1.502 for processing of prior art citations in patent and reexamination files during an *ex parte* reexamination proceeding filed under § 1.510.

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. 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 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 [Added R-2]

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).

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 the fee requirement of § 1.915(a).

If the required fee under 37 CFR 1.20(c)(2) is not paid in full, the request for *inter partes* reexamination is incomplete and will not be considered on its merits nor have a notice of its filing announced in the *Offi-*

cial Gazette. The request is considered to have a “filing date” under 37 CFR 1.919(a) 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 proceeding exists.

If no fee is received, or only a portion of the fee is received, the reexamination preprocessing staff of the Central Reexamination Unit (CRU) will notify the requester of the defect in writing and give the requester a specified time, normally one month, to complete the request. This notice is not entered in 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. The request itself will be treated as a citation under 37 CFR 1.501 if it complies therewith. If the request does not comply with 37 CFR 1.501, the request papers will also be returned to the requester by the CRU.

2628 Informal Request for *Inter Partes* Reexamination [Added R-2]

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

(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.

(d) If the *inter partes* request does not meet all the requirements of subsection 1.915(b), the person identified as requesting *inter partes* reexamination may be so notified and given an opportunity to complete the formal requirements of the request within a specified time. Failure to comply with the notice may result in the *inter partes* reexamination proceeding being vacated.

All requests for *inter partes* reexamination which are accompanied with the entire fee under 37 CFR 1.20(c)(2) will be assigned a filing date. If the fee under 37 CFR 1.20(c)(2) has been paid, but the request for *inter partes* reexamination does not contain all the elements required by 37 CFR 1.915(b), the request is considered to be informal. 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 timely respond and correct the informality, the decision on the request will be made on the information presented. The decision on the request will either:

(A) Vacate the reexamination proceeding based upon the informality of the request; or

(B) Decide the request as to whether the information which is presented raises “a substantial new question of patentability.” If yes, the request for reexamination will be granted, if not the request will be denied.

The choice as to which of the above options to exercise will be made at the Office’s sole discretion. In making the decision, the Office will take into account the nature of the informality, and how it affects or impacts the reexamination proceeding.

In the event the certification required by 37 CFR 1.915(b)(7) has not been included with the request for reexamination, and is not later provided even after request by the Office for same; the Office may (at its option) construe the filing of the reexamination

request as a constructive certification under 37 CFR 1.915(b)(7), absent evidence to the contrary. If so, the requester and patent owner shall be so-notified in the decision on the request.

2629 Notice of Request for *Inter Partes* Reexamination in *Official Gazette* [Added R-2]

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

Under 37 CFR 1.11(c), reexamination requests 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 Publications 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 [Added R-2]

Any payment of the balance of the *inter partes* reexamination request fee should be marked "Mail Stop *Inter Partes* Reexam," so that the fee may be promptly forwarded to the reexamination preprocessing staff of the Central Reexamination Unit (CRU). If the fee payment completes the payment of the required fee, the reexamination 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.

A correction of a defect other than the fee (see 37 CFR 1.915(b)(1)-(8)) should likewise be marked "Mail Stop *Inter Partes* Reexam." The CRU, upon receipt of the correction submission, will process it and direct it to a CRU Legal Instruments Examiner (LIE). The LIE will check the correction submission for timeliness and then perform the appropriate clerical processing, including entering the submission in the file of the reexamination.

2632 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 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, 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 Was Filed for a Patent [R-3]

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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 "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 (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 Processing in Technology Center [R-3]

The processing and handling of an *inter partes* reexamination in the Technology Center (TC) will include:

- (A) Initial Supervisory Patent Examiner (SPE) assignment of the *>reexamination< to a primary examiner;
- (B) Examination of the *>reexamination< by the patent examiner;
- (C) Clerical activity needed to support that examination;
- (D) The *inter partes* reexamination functions of the Special Program Examiners (SPREs) who are supported in these functions by the Paralegal Specialists;
- (E) The administrative functions of reexamination performed by the TC Directors and SPEs; and
- (F) Other instances that the Central Reexamination Unit (CRU) Reexamination Legal Advisor (RLA)

deems it appropriate for the TC to have possession of the *>reexamination file<.

The working groups in the TCs have designated the legal instrument examiners (LIEs) to act as reexamination clerks, as part of their assigned duties, and thus to perform those clerical duties and responsibilities in the TCs which are unique to reexamination.

Inter Partes reexamination PALM processing in the TC will be limited to charging the *>reexamination< to the examiner, PALM transactions to indicate receipt of the *>reexamination< in the TC, case flagging as needed by the SPREs, and return of the case to the CRU.

I. CRU INTERFACE WITH TECHNOLOGY CENTER OPERATION

The CRU will administer, oversee, and monitor *inter partes* reexamination. Additionally, in conjunction with and in support of TC handling of *inter partes* reexaminations, the CRU will perform, in *inter partes* reexamination proceedings, (A) all processing of papers filed by parties and entry of amendments, (B) all mailing of Office actions and other correspondence, and (C) all processing of fees. CRU personnel will be available to respond to inquiries by TC personnel as to TC handling of *inter partes* reexaminations. Such inquiries to the CRU should be forwarded via the TC SPREs, so that they will be aware of all reexamination practice in the TC and thus serve as a focal point for the TC in reexamination.

II. TECHNOLOGY CENTER HANDLING OF INTER PARTES REEXAMINATION

After the *>reexamination< file has been reviewed in the CRU to ensure it is ready for examination, the CRU will forward the *>reexamination< to the TC for docketing of the *>reexamination< to the examiner assigned to the reexamination proceeding.

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

After the examiner receives the new *inter partes* reexamination * file from his/her SPE, the examiner will, no later than one week after receipt of the *inter partes* reexamination file, prepare for an initial consultation conference with the RLA and notify the

SPRE that he/she is ready for the conference and specify the days and times that he/she is available. The SPRE will schedule the consultation conference >with the RLA through the CRU<. At the scheduled conference, the consultation will be conducted with the examiner, a TC SPRE, and the RLA being present. The SPE may also attend the conference but the SPEs attendance is not mandatory. 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. In the rare circumstances where a first action is not to be provided with the grant of 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 TC SPRE by the CRU.

After the consultation conference, the examiner will prepare a decision on the request for reexamination, and, where reexamination is granted, a first Office action to accompany the decision no later than two weeks from the date of the consultation conference. The decision and the Office action are typed in the TC on a “special” basis and the typed decision and Office action are forwarded to a **primary examiner** for signature. Although a non-primary examiner may be assigned a reexamination to examine (where that examiner is the only examiner who did not examine the application for the patent being reexamined and yet is familiar with the art), a primary examiner must review and sign every action in the reexamination proceeding. After the primary examiner signs the decision and/or action, the appropriate materials will be compiled and any needed copying will be performed by the TC support staff. Thereafter, the >reexamination< file will be forwarded to the TC SPRE for review. The TC SPRE will then arrange for the file to be PALMed out and >the decision and/or action to be< **hand-carried** directly to the CRU.

The SPRE will have one (1) week from the SPRE’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 CRU. **At the very latest**, the decision and action prepared by the examiner must be forwarded to the CRU within nine (9) weeks of the filing date of the request. After the SPRE approves the Office action, ** the

examiner’s decision and action **>are< **hand-carried** directly to the CRU for a final review and mailing. In the CRU, the RLA performs a general review of the decision and action, and then the decision and action are mailed from the CRU. In conjunction with the mailing, any appropriate processing (e.g., PALM work, update scanning) is carried out by the staff of the CRU.

After the mailing of the decision and the first action, the **>CRU will retain jurisdiction over the reexamination proceeding<. 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 SPE and the examiner will be notified and the >reexamination< file is forwarded to the TC. The examiner will review the response and comments, decide on a proposed course of action, consult with the RLA (with the SPRE 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 handling of patentability review conferences prior to Action Closing Prosecution (ACP) and prior to Right of Appeal Notice (RAN). See MPEP § 2676 for appeal conferences and MPEP § 2677 >for< Examiner’s Answers. **

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 reissue counting will be done by the TC.

III. TECHNOLOGY CENTER PREPARATION OF THE ACTION FOR MAILING PRIOR TO FORWARDING TO THE CRU

After an action by the examiner is completed, the TC clerical staff will make copies of references >as needed< and a copy of the Office action for the patent owner and the third party requester. Copying of the Office action and any references will be performed in the TC to ensure that copies are provided **>to< all parties entitled to receive copies.

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.

2634 Fee Processing and Procedure [R-3]

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), prior to sending the case to the Technology Center (TC). 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 1.20(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-3]

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 patent files related to requests for reexamination throughout the Office is monitored by the PALM system in the normal fashion. The reexamination file and patent file will be kept together, from initial receipt until the reexamination is assigned to an examiner for determination. At this point, the patent file will be charged to the examiner assigned the reexamination file, and the patent file will be kept in the examiner's room until the proceeding is concluded. After the reexamination proceeding has been concluded, the patent file should be forwarded by the examiner, via the SPRE, with the reexamination file to the Central Reexamination Unit (CRU). After review and processing in the CRU and by the Office of Patent Legal Administration as appropriate, the patent and reexamination files will be forwarded to the Office of Publications. The Office of Publications will forward the patent file and the reexamination 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, and the Technology Center (TC) reexamination clerks and paralegals, are 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".

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2636 Assignment of Reexamination [R-3]

I. EXAMINER ASSIGNMENT OF THE RE-EXAMINATION PROCEEDING

Reexamination requests will normally be assigned to the art unit which examines the class and subclass 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. Where no such knowledgeable primary examiner is available, the reexamination may be assigned to an assis-

tant examiner. In such an instance the SPE must sign all actions and take responsibility for all actions taken.

(A) *Examiner Assignment Policy*

It is the policy of the Office that the 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 SPE, 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 patentability 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 SPE is the only primary examiner in the art unit, or 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 *>Technology Center (TC)< Director, and the fact that such approval was given by the TC 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 generally is assigned to a different examiner 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 the examiner assigned the reexamination proceeding. Thus, the reissue application would be transferred (reassigned) from the original examiner to the examiner who ordered reexamination

(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 by e-mail, 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 e-mail notification to OPLA (see MPEP § 2686.03). If the reissue and reexamination proceedings are merged by OPLA, the reissue will be assigned in the TC (upon return of the files from OPLA) to the examiner handling the reexamination proceeding. 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, the Office of the TC Special Program Examiner (SPRE) 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 TC SPRE) promptly forwarded to the OPLA for mailing. At the same time, the OPLA should be notified by e-mail 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 will be

assigned in the TC (upon return of the files from OPLA) to the examiner handling the reexamination proceeding. 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 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 Central Reexamination Unit (CRU) support staff. After the case file has been reviewed in the CRU to ensure it is ready for examination in the TC, the CRU will forward the case

to the TC for docketing of the case to the examiner assigned to the reexamination proceeding.

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

2637 Transfer Procedure [R-3]

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 (in the Central Reexamination (CRU) of the Office of Patent Legal Administration (OPLA)) to the art unit which examines the class and subclass in which the patent to be reexamined is currently classified as an original. If the supervisory patent examiner (SPE) believes that the reexamination should be assigned to another art unit, he or she must obtain the consent of the 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 SPE to whose art unit the reexamination has been assigned should expeditiously make any request for transfer of a reexamination proceeding by e-mailing the request for transfer to the SPE of the art unit to which a transfer is desired (the “new” art unit). A “cc” of the e-mail is to be provided to the Special Program Examiner (SPREs) of the Technology Centers (TCs) involved in the transfer request and to the CRU of OPLA. The SPE to whose art unit the reexamination has been assigned should, further 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 TC Directors involved.

If the “new” art unit accepts assignment of the reexamination request, the “new” SPE assigns the request

to an examiner, and the “new” TC’s reexamination clerk PALMs in the request. In addition, the CRU and the Offices of TC SPRE involved in the transfer request must be notified of the transfer by the respective SPEs.<

2638 Time Reporting [Added R-2]

I. CLERICAL TIME REPORTING

Both the Program Management System (PMS) and Payroll systems now used to monitor clerical time have been modified to report reexamination activities. Time devoted to processing actual reexamination files in the Technology Centers (TCs) should be reported using the appropriate PMS Code and Project Code. It should be noted that all clerical time consumed by reexamination activities must be reported in the above manner. Activities such as supervision, copying, typing, and docketing should be included.

II. CENTRAL REEXAMINATION UNIT (CRU) TIME REPORTING

CRU personnel will use 1190-55 as the code to report their time for reexamination activities on the Biweekly Time Worksheet.

III. PROFESSIONAL TIME REPORTING

Reexamination fees are based on full cost recovery, and it is essential that all time expended on reexamination activities be reported accurately. Thus, examiners, supervisory patent examiners (SPEs), special program examiners (SPREs), and paralegals should report all time spent on reexamination on their individual Time and Attendance Report.

Examiners, SPEs, SPREs and paralegals will use the following Project Codes to report their time for reexamination activities on their Biweekly Time Worksheets (PTO-690 forms) by making appropriate entries in the space for reexamination:

Person	Activity	Charge Code
<u>Examiner</u> (prior to order denial)	Examination activity prior to the <i>inter partes</i> reexamination order or denial.	1121-01
<u>Examiner</u> (after reexam order)	All examination activity after the <i>inter partes</i> reexamination order (including all conference times).	1121-02
<u>Examiner Conferee</u> in Patentability Review Conference	Conferee examiner's patentability review conference time in the <i>inter partes</i> reexamination.	1121-08
<u>Examiner Conferee</u> in Appeal Conference	Conferee-examiner's appeal conference time in the <i>inter partes</i> reexamination.	1121-06
<u>Supervisory Patent Examiner</u> (SPE)	<u>All time</u> applied to the <i>inter partes</i> reexamination, including training and review of examiner activity, and participation in any conferences.	1121-03
<u>Special Program Examiner</u> (SPRE) and Paralegal Specialist	All time applied to the <i>inter partes</i> reexamination, including participation in any conferences.	1121-04

Where the first Office action accompanies the decision on the request granting reexamination, the examiner will estimate how much time was devoted to the preparation of each of the Office action and the decision on the request, and thereby allocate the time entered for codes 1121-01 and 1121-02 accordingly.

Note that TC SPREs and paralegals will use 1121-04 as the code to report all their time (including participation in appeal and patentability review conferences) for *inter partes* reexamination activities on the Biweekly Time Worksheet Paralegal/Special Program Examiner, PTO-690 P/S.

2640 Decision on Request [R-3]

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

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 computer 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 final finding as to unpatentability of the claims is **not** made in the decision; rather, it is made later, during the examination stage of the reexamination proceeding. Accordingly, no *prima facie* case of unpatentability need be found to grant an order for reexamination. It should be noted that a decision to deny the request for reexamination is equivalent to a final holding (subject to a petition pursuant to 37 CFR 1.927 for review of the denial), that the patent claims are patentable over 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 order reexamination. In the examination stage of the reexamination, usually **all** patent claims will be examined, even though the order found a substantial new question of patentability only as to (for example) one of the patent claims. Where, however, there has been a prior Federal Court decision as to some claims, see MPEP § 2642 as to whether those claims are examined.

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found a substantial new question of patentability only as to (for example) one of the patent claims. Where, however, there has been a prior Federal Court decision as to some claims, see MPEP § 2642 as to whether those claims are examined.

The decision on the request for reexamination should discuss all the patent claims. The examiner should limit the discussion of the claims to whether or not 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 in those cases which raise 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 than 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. 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 raise 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. The substantial new question may be directed to any proposed new or amended claim in the pending reexamination, to permit examination of the entire patent package. 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.<

In an aggravated situation, 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 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).

2641 Time for Deciding Request [R-3]

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 Technology Center (TC) Special Program Examiner (SPRE) within two (2) weeks of the filing date of the request. The SPRE processes the *>reexamination<*

as needed and forwards it to the appropriate Supervisory Patent Examiner (SPE) for docketing of the reexamination to an appropriate examiner.

(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 TC SPRE.

The decision and the action will be reviewed by the SPRE and the reexamination file along with the decision and action will be forwarded (hand carried) to the CRU.

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

(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-3]

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 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).

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).

It should be 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 request for reexamination of a patent is made before the conclusion of an earlier filed reexamination proceeding pending (ongoing) for that patent, the substantial new question of patentability may be raised with respect to any new or amended claim which has been proposed in the pending reexamination proceeding. The substantial new question may be directed to any proposed new or amended claim in the pending reexamination, to permit examination of the entire patent package. 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 concluded Office examination of the patent (e.g., in the examination of the application for the patent). 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 (SNQ) 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 SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a SNQ 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 concluded examination(s), in view of a material new argument or interpretation presented in the request.

When it is determined that a SNQ 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 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. 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.

IV. 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 Dis-

strict 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 [Added R-2]

The claims 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. 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 (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). If a substantial new question of patentability is found as to any claim, reexamination will be ordered and will normally cover all claims except for claims that have been finally held invalid in a Federal Court decision on the

merits. The decision on the request should discuss all patent claims in order to inform the patent owner of the examiner's position. See MPEP § 2642 for 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 be considered nor commented upon when deciding a request for reexamination. Accordingly, a request is decided on the wording of the claims without any amendment. 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-3]

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-1449, 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 end 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).

Upon determination that a substantial new question of patentability is present pursuant to a request under 35 U.S.C. 311, an order to reexamine is issued pursuant to 35 U.S.C. 313 >(first sentence)< which provides:

[T]he determination [that a substantial new question of patentability is raised] shall include an order for *inter partes* reexamination of the patent for resolution of the question.**

I. 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 decisions.

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 >both the Central Reexamination Unit of the Office of Patent Legal Administration and< the Special Program Examiner (SPRE) in the Technology Center (TC) in which the reexamination proceeding is pending 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.

II. 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 TC (usually the TC SPRE) 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-3]

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.<

2647.01 Examples of Decisions on Requests [R-3]

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 indicates that the third party requester considers claims 1-3 of the Key patent to be unpatentable over Smith taken with Jones.

The request further indicates 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. Claim 4 will, however, be reexamined along with claims 1-3 of the Key patent.

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

By Mail to: 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

By FAX to: *(571) 273-0100<
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<.

_____/s/_____
Kenneth M. Schor
Primary Examiner
Technology Center 3700



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
 UNITED STATES PATENT AND TRADEMARK OFFICE
 P.O. Box 1450
 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 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
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: **>(571) 273-0100<**
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.<

_____/s/_____
Kenneth M. Schor
Primary Examiner
Technology Center 3700

2647.02 Processing of Decision [R-3]

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 Technology Center (TC) clerical staff. The TC 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 \geq copies of any prior art documents not already supplied by the third party requester, \leq one for the patent owner, and one for the third party requester.

After the case is prepared for mailing, the \ast file will be forwarded to the TC Special Program Examiner (SPRE) for review. Thereafter, the TC SPRE will arrange for the file to be PALMed $\ast\ast\ast$ and forwarded to the Central Reexamination Unit (CRU). $\ast\ast\ast$ A signed copy of the decision and any Office action is **hand-carried** directly to the CRU. The file and the decision and Office action are forwarded to the CRU for review and mailing within nine (9) weeks of the filing date of the request. The decision (and any Office action) is given a general review by a Reexamination Legal Advisor (RLA) and (if proper) mailed by the CRU support staff. The CRU 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 $\ast\ast\ast$ 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. $\ast\ast$

2648 Petition From Denial of Request [R-3]

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, $\ast\ast\ast$ 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 $\ast\ast\ast$ 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 Technology Center (TC) Director for decision. The TC Director will then review the examiner's determination that a substantial new question of patentability has not been raised. The TC Director's review will be *de novo*. Each decision by the TC Director will conclude with the following paragraph:

This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

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

The TC Director will sign the decision granting the petition, and then forward the reexamination file, together with the decision, to the CRU for mailing of the decision, update scanning and PALM processing. The reexamination file will then be returned to the supervisory patent examiner (SPE) of the art unit that will handle the reexamination. The SPE will ordinarily reassign the reexamination to another examiner pursuant to 37 CFR 1.931(b), notify the CRU 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. If the denial of the request was signed by the SPE, the reexamination ordered by the TC Director will be assigned to a primary examiner.

Under normal circumstances, the reexamination proceeding will not be reassigned to a SPE, 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 TC 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 TC Director may permit reassignment of the reexamination proceeding to an examiner that originally examined the patent.

It should be noted that the requester may seek review of a denial of a request for reexamination only by petitioning the Director of the Office 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 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 for reasons other than those advanced by the third party requester or as to claims other than those for which the third party requester sought reexamination. No right to review exists if reexamination is ordered in such a case, because all claims 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 [Added R-2]

The examination will ordinarily be conducted by the same patent examiner in the Technology Center (TC) 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 [Added R-2]

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

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.

The reexamination file must clearly indicate which prior art patents and printed publications the examiner has considered during the examination of the *inter partes* reexamination proceeding.

2657 Listing of Prior Art [Added R-2]

The examiner must list on a form PTO-892, if not already listed on a form PTO-1449, PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having format equivalent to one of these forms), all prior art patents or printed publications which have been properly cited and relied upon by the reexamination requester in the request under 37 CFR 1.915.

The examiner must also list on a form PTO-892, if not already 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), 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 reexamination 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-1449, 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 [Added R-2]

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

Rejections on art in reexamination proceedings may only be made on the basis of prior art patents or printed publications. 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.

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 pending 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). All claims under reexamination should, however, be reexamined on the basis of prior patents and printed publications.

B. All “Live” Claims Are Reexamined During Reexamination

Although a request for reexamination may not specify all claims as presenting a substantial new question, each “live” claim (i.e., each existing claim not held invalid by a final decision, after all appeals) of the patent will be reexamined. The resulting reexamination certificate will indicate the status of all of the patent claims and any added patentable claims.

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.

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, fraud, 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.

¶ 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, fraud, or abandonment of the invention.

Such issues should not be raised independently by the patent examiner.

If questions of patentability based on public use or on sale, fraud, 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-3]

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 organization or subject to an obligation of assignment to the same person or organization 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 organization, or subject to an obligation of assignment to the same person or organization in any application and in any patent granted on or after December 10, 2004, if:

(A) The claimed invention 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.<

(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.

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.

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

Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-0100
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. 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<.

OPTIONAL INTER PARTES REEXAMINATION

2660



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
			EXAMINER
John Able 2400 Any Street Road Anytown, VA 22202			Kenneth M. Schor
		ART UNIT	PAPER
		1713	

DATE MAILED:

OFFICE ACTION IN INTER PARTES REEXAMINATION

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:

Two 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)(3).

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.
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 and 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 _____

PTOL-2064 (12/03)

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.

While Bupkes and Gornisht do in fact teach the use of an octagonal extrusion die to provide smooth unified extrusion product, Bupkes teaches such for glass making and Gornisht teaches such for a food product. Despite the argument presented at pages 12-13 of the request and the demonstration of exhibit A, the skilled artisan would not equate the advantages obtained by Bupkes and Gornisht for glass and food, respectively, to the removal of imperfections in a polymer melt being extruded to a solid plastic product. Thus, Bupkes and Gornisht are not deemed to be combinable with Berridge and McGee for purposes of rejecting claim 5.

Issue not within the scope of reexamination proceedings:

It is noted that an issue not within the scope of reexamination proceedings has been raised. In the above-cited final Court decision, a question is raised as to the possible public use of the invention of Claim 4. This was pointed out by the third party requester in the request for reexamination. 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 based upon the issue.

Other art made of record:

Swiss Patent 80555 and the American Machinist article are cited to show cutting and forming extruder apparatus somewhat similar to that claimed in the Smith patent.

Conclusion:

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, which will be strictly enforced.

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

By Mail to: 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

By FAX to: *(571) 273-0100<
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<.

_____/s/_____
Kenneth M. Schor
Primary Examiner,
Technology Center *(571) 272-7705<

V. ACTIVITY AFTER THE DRAFT (TEXT) OF THE FIRST OFFICE ACTION HAS BEEN PREPARED

The examiner will prepare the action, ensure that Technology Center (TC) clerical processing is done, and forward the *>reexamination<* to the TC Special Program Examiner (SPRE) no later than two (2) weeks from the date of the consultation conference. The action is reviewed by the SPRE (see MPEP § *>2633<*), who then arranges for the *>reexamination<* to be PALMed out and hand-carried directly to the Central Reexamination Unit (CRU). The *>reexamination<* is forwarded to the Central Reexamination Unit by the SPRE within three (3) days of the SPRE'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 proceed-

ing, 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*

(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 prior-

ity over all other cases except for reexaminations or reissues involved in litigation.

2662 Time for Response and Comments [R-3]

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.

2664 Mailing of Office Action [R-3]

The Technology Center (TC) does not mail the Office action for an *inter partes* reexamination *file. After an Office Action is completed and processed in a TC, the TC's Special Program Examiner (SPRE) arranges for the *reexamination to be PALMed out of the TC and the action hand-carried directly to the Central Reexamination Unit (CRU). In the CRU, the Office action is given a general review by a Reexamination Legal Advisor (RLA) and (if proper) 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-3]

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

Technology Center (TC) Director of the TC conducting the reexamination. 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 should include a statement of what action the patent owner has taken, and why in spite of the action taken thus far, the additional time is needed. All requests must be submitted as a separate paper, not directed to any matter other than the request for the extension.

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-3]

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.

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(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.*

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.

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.

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III. SUPPLEMENTAL RESPONSE TO OFFICE ACTION

Pursuant to 37 CFR 1.111(a)(2), a response that is supplemental to a response that is in compliance with 37 CFR 1.111(b) will not be entered as a matter of right. The Office may enter a supplemental response if the supplemental response is clearly limited to: (A) cancellation of a claim(s); (B) adoption of the exam-

iner suggestion(s); (C) placement of the proceeding in condition for Notice of Intent to Issue Reexamination Certificate (NIRC); (D) a response to an Office requirement made after the first response was filed; (E) correction of informalities (e.g., typographical errors); or (F) simplification of issues for appeal. When a supplemental response is filed in sufficient time to be entered into the reexamination proceeding before the examiner considers the prior response, the examiner may approve the entry of a supplemental response if, after a cursory review, the examiner determines that the supplemental response is limited to meeting one or more of the conditions set forth in 37 CFR 1.111(a)(2)(i).

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 there is a specific request for its entry 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)).<

2666.01 Amendment by Patent Owner [R-3]

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.

(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.

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.

(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 preserved.* 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.

(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.

(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 § 1.977 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding and must satisfy the requirements of § 1.324.

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

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 ordi-

narily 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.

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, Part I, Subpart 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.

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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.

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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 reexamination 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.*

(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.

(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.”

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 draftspersons. 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.

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2666.04 Fees for Adding Claims [R-3]

37 CFR 1.20. *Post issuance fees*

- (c) In reexamination proceedings
 - (1) For filing a request for *ex parte* reexamination (§ 1.510(a)).....\$2,520.00
 - (2) For filing a request for *inter partes* reexamination (§ 1.915(a)).....\$8,800.00
 - (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)).....\$100.00
 - By other than a small entity\$200.00
 - (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
 - (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.

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-3]

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).

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 (A) set forth the point or issue, (B) state the page of the Office action and/or the patent owner response where the point or issue is recited, and (C) 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. Prior art submitted under (C) 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.

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, and should provide

a time period of 30 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 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.

The practice of giving the third party requester a time period of 30 days to rectify and refile comments that are “responsive but informal” 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).

(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).

(D) If a claim is amended merely to include a dependent claim that was previously subjected to a proposed requester rejection, and the examiner with-

draws 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-3]

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

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

(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.

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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.

Papers filed in which no proof of service is included (where proof of service is required) may be denied consideration. Where no proof of service is included, the Central Reexamination Unit (CRU) will contact the party making the submission by telephone to see whether the indication of proof of service was inadvertently omitted from the party's submission (however, there was actual service).

-If service was in fact made, the party making the submission should be advised to submit a supplemental paper indicating the manner and date of service. The CRU should enter the submission for consideration, and annotate the paper with: "Service confirmed by [name of person] on [date]".

-If service was not made, or the party making the submission cannot be contacted, the submission is placed in the reexamination file and normally would not be considered. **>The submission is added to the IFW file history as an unentered paper with a "N/E" notation, along with a brief annotation as to why the paper is not entered.< The submission * shall be annotated with "no service" which also can be crossed through if service is later made.

If the party making the submission cannot be contacted, 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.

2666.10 Patent Owner Does Not Respond to Office Action [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.

(b) If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the reexamination proceeding will be terminated and the Director will proceed to issue a certificate under § 1.997 in accordance with the last action of the Office.

(c) If claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time.

(d) When action by the patent owner is a *bona fide* attempt to respond and to advance the prosecution and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

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.

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.

(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.

<

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-3]

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 addi-

tional 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 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.

**>

NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION	Control No.	Patent Under Reexamination	
	Examiner	Art Unit	

-- 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-3]

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 reexami-

nation 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 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 Technology Center (TC) Director (or in some instances, by the Office of Patent Legal Administration >(OPLA)<) and is forwarded to the Central Reexamination Unit (CRU) 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 ** TECHNOLOGY CENTER 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 TC Director or the Reexamination Legal Advisor 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.<

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 TC Director or the Reexamination Legal Advisor 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 TC Director or the Reexamination Legal Advisor 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.<

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 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 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.<

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 information. 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.

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-3]

35 U.S.C. 41. Patent fees; patent and trademark search systems.

(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.

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 proceeding terminated under §§ 1.550(d) or 1.957(b) or (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 proceeding terminated under §§ 1.550(d) or 1.957(b) or (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 Director 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.

(e) *Request for reconsideration*. Any request for reconsideration or review of a decision refusing to revive an abandoned application, a terminated reexamination proceeding, 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 proceeding filed under § 1.510; or

(3) The provisions of § 1.956 for a terminated *inter partes* reexamination proceeding filed under § 1.913.

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 Petition 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), part 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 [Added R-2]

I. CENTRAL REEXAMINATION UNIT PROCESSING

Central Reexamination Unit (CRU) support staff, will carry out clerical handling and processing of *inter partes* reexamination cases. When the case is in the Technology Center (TC), the TC support staff will do the clerical processing needed for the reexamination, and the Special Program Examiner (SPRE) and paralegal will oversee the clerical processing.

II. TECHNOLOGY CENTER PROCESSING

The TC clerical staff will provide support for the examiner's preparation of Office actions, and for handling the case as needed within the TC. The clerical staff will perform all PALM matters needed for the case in the TC, 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 TC 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 by the TC (if a copy for mailing is not already in the case file). The clerical staff will coordinate its activities with those of the examiner and the TC SPRE and paralegal.

III. AMENDMENT ENTRY

While amendments in an *ex parte* reexamination proceeding are entered by the TC clerical staff,

amendments in an *inter partes* reexamination proceeding (which comply with 37 CFR 1.941) are entered by the CRU. Otherwise, the entry of amendments in an *ex parte* reexamination proceeding is the same as entry of amendments in an *inter partes* reexamination proceeding. 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 [Added R-2]

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 TC by the Central Reexamination Unit (CRU).

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. The case, with the completed action, will be forwarded to the TC SPRE for review. If the SPRE returns the case to the examiner for correction/revision, the correction/revision must be handled expeditiously and returned to the SPRE within the time set for such by the SPRE.

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-3]

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.

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 pro-

posed 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, fraud, 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, fraud, or abandonment of the invention. Such issues should not be raised independently by the patent examiner.

Note that if questions of patentability based on public use or on sale, fraud, 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 patent-

ability, 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
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-0100
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.

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IX. 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.

2671.02 Examiner Issues Action Closing Prosecution (ACP) [R-3]

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.

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-pro-

visional 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.

The examiner should not prematurely cut off the prosecution with a patent owner who is seeking to define the invention in the claims that will offer the patent protection to which the patent owner is entitled. However, 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). 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, fraud, 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, fraud, or abandonment of the invention. Such issues should not be raised independently by the patent examiner.

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 PARAGRAPH

The ACP should conclude with the following form paragraph:

¶ 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.

VIII. 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.

2671.03 Patentability Review Conferences [Added R-2]

A "patentability review conference" will be convened at two stages of the examination in an *inter partes* reexamination proceeding:

(A) A patentability review conference must be convened just prior to issuing an action closing prosecution (ACP); and

(B) A patentability review conference must be convened just prior to issuing a right of appeal notice which includes a final rejection (RAN).

In the patentability review conference, the examiner's preliminary decision to reject and/or allow the claims in the reexamination proceeding will be reviewed, prior to the issuance of the Office action (ACP or RAN).

I. MAKE-UP OF THE PATENTABILITY REVIEW CONFERENCE

The patentability review conference will consist of three members, one of whom may be the Supervisory Patent Examiner (SPE). The first member will be the examiner in charge of the proceeding. The SPE will select the other two members, who will be examiner-conferees. 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.

The patentability review conference will be similar to the appeal conference carried out prior to the issuance of an examiner's answer following the filing of a Notice of Appeal and Brief. See MPEP § 1208. A patentability review conference **must** be held in each instance where an ACP is about to be issued in an *inter partes* reexamination proceeding, **and** in each instance where a RAN is about to be issued in the proceeding. When the patentability review conference results in the issuance of the ACP or the RAN, the two

conferees will place their initials, followed by the word “conferee,” below the signature of the examiner. The signature of the examiner and initials of the conferees on the resulting Office action will reflect that the patentability review conference has been conducted.

II. PATENTABILITY REVIEW CONFERENCE PROCESS

The examiner must inform his/her SPE of his/her intent to issue an ACP, or RAN. The SPE will then convene a patentability review conference and the conference members will 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 (ACP or RAN) 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. 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 proposed ACP or RAN will not be issued by the examiner; but rather, the examiner will issue the appropriate Office action reflecting the decision of the conference.

Where the examiner in charge of the proceeding is not in agreement with the conference decision, the SPE will generally assign the proceeding to another examiner, which would preferably be one of the other two conference members.

Patentability review conferees in *inter partes* reexamination proceedings will use 1121-08 to report time spent with respect to the conference. **The examiner in charge of the case will use the standard 1121-02 activity code to report time.** A SPE attending the conference should use 1121-03. See MPEP § 2638.

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 an ACP or RAN without holding a patentability review conference, 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 patentability review conference would be noted by the parties where there are no conferees’ initials at the end of the ACP or RAN Office action.) Any challenge of the failure to hold a patentability review conference must be made within two months of the Office action issued, or the challenge will not be considered. In such cases, convening a patentability review conference to reconsider the examiner’s decision will be addressed on a case-by-case basis. 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 [Added R-2]

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 refileing 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 amend-

ments 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. 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.

IV. PATENT OWNER MAKES SUBMISSION AFTER ACP; THIRD PARTY REQUESTER COMMENTS ARE LIMITED TO RESPONDING TO PATENT OWNER'S SUBMISSION

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. 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 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, then the third party requester's comments will be returned. 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.

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-3]

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 the appealable issues and the positions of the patent owner and all third party requesters on those issues. If the examiner determines that no other issues are present or should be raised, a Right of Appeal Notice limited to the identified issues shall be issued. Any appeal by the parties shall be conducted in accordance with §§ 1.959-1.983.

(c) The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, the *inter partes* reexamination proceeding will be terminated, and the Director will proceed to issue 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 the following form paragraph advising the parties of their right to appeal:

**>

¶ 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 publish a certificate under 37 CFR 1.997 in accordance with this Office action.

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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.

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 determi-

nation 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:

