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Part IV

Department of Commerce

Patent and Trademark Office

**Rules of Practice in Patent Cases;
Reexamination Proceedings**

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

Rules of Practice in Patent Cases;
Reexamination Proceedings

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The Patent and Trademark Office is amending its rules of practice in patent cases to provide procedures for the reexamination of patents. Public Law 96-517 amended the patent act to authorize reexamination proceedings as a means for improving the quality of United States patents. The Patent and Trademark Office intends, through this amendment of its rules, to provide patent owners and the public with guidance on the procedures the Office will follow in conducting reexamination proceedings.

DATE: Effective date: July 1, 1981.

FOR FURTHER INFORMATION CONTACT: Mr. R. Franklin Burnett by telephone at (703) 557-3054 or by mail marked to his attention and addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

SUPPLEMENTARY INFORMATION: This rule change relates to a procedure for reexamination of patents as provided for in Public Law 96-517, section 1 of which relates to reexamination and becomes effective on July 1, 1981.

Background

A notice of proposed rulemaking was published in the Federal Register on January 13, 1981 at 46 FR 3162-3175 and in the *Official Gazette* on February 17, 1981 at 1003 O.G. 36-47.

The proposed rulemaking set forth two somewhat distinct procedures directed towards determining and improving the quality and reliability of United States patents. The procedures were (1) provisions for reexamination of patents as provided for in Pub. L. 96-517, section 1 of which relates to reexamination and becomes effective on July 1, 1981, and (2) provisions for inter partes protest proceedings in a patent application between the patent applicant and a member (or members) of the public who has (have) access to the application file.

An oral hearing was held on April 16, 1981. Fifty-nine written letters and statements were submitted. Nineteen persons testified at the oral hearing which resulted in 107 pages of testimony.

Discussion of General Issues Involved

After careful consideration of the comments which have been received, the part of the proposed rulemaking relating to reexamination of patents as set forth in new Chapter 30 which Pub. L. 96-517 added to Title 35 of the United States Code (35 U.S.C. 301-307) is being adopted with certain changes. The remainder of the proposal relating to inter partes protest proceedings is not being adopted.

The comments relating to the proposed rules for inter partes protest proceedings were generally mixed, with a majority of persons and associations submitting comments either opposed to these proposed rules or indicating that adoption of the proposed rules should be delayed or deferred for further study and consideration.

A number of comments were received requesting some further changes to the rules be made. The thrust of some of the suggested changes would be to remove public access to reissue applications and to limit public participation in the examination of reissue applications. The changes suggested included restoring the rules in these areas to essentially their pre-1977 form. In particular, it was suggested that § 1.175 be amended to eliminate paragraph (a)(4). These changes were not a part of the published proposal and are not being adopted at this time. Their consideration and adoption would require a new notice of proposed rulemaking.

Further, since the subject matter of reissue applications is already known to the public the necessity for maintaining them in confidence is not compelling. The elimination of paragraph (a)(4) of § 1.175 would not have a significant effect since less than one-fourth of the currently filed reissue applications are based solely upon the 1977 change to § 1.175. Under the present circumstances, it is more appropriate to defer any consideration of such changes until this issue has been reviewed further and possibly until some experience is gained under the rules adopted herein relating to reexamination. Such experience may indicate the desirability of either retaining the 1977 change to § 1.175, deleting the 1977 change, or making different changes in the rules.

The comments relating to reexamination were generally favorable with most of the comments indicating general approval of the proposed rules. Among the more often mentioned specific comments were suggestions relating to public notice of reexamination requests and/or orders. A number of comments also related to

requester and/or third party participation in the reexamination proceeding and also to the scope of the proceeding.

After careful review of the comments and suggestions it has been decided to adopt the suggestions relating to the publication in the *Official Gazette* of requests for reexamination for which the fee has been paid. In addition, any reexaminations ordered at the initiative of the Commissioner will also be announced in the *Official Gazette*. The announcement will include at least the date of the request or any Commissioner initiated order, a reexamination request or order control number, the 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.

The suggestions and comments relating to more participation in the reexamination proceeding by the requester and third parties have been adopted only to a limited degree. The requester will in general have only that participation provided by the rules as proposed. However, any citations under § 1.501 by any person will be entered in the patent file up until the date of an order to reexamine. The essentially ex parte nature of the proceeding is believed to be in keeping with the spirit and intent of the statute even though the statute does not require ex parte proceedings. Ex parte proceedings will minimize the costs and other effects of reexamination requests on patentees, especially individuals and small businesses.

The scope of the reexamination proceeding which was originally proposed has been essentially adopted in the final rules. The suggestions that the rules be broadened to include other issues have not been adopted since the other issues would unduly complicate the proceedings, raise the expense of the proceedings and raise questions whether such issues can be considered under Pub. L. 96-517.

Discussion of the Major Specific Issues Involved

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

termination of the reexamination proceedings.

Present §§ 1.1, 1.5, 1.11, 1.33, 1.34, 1.36, 1.104, 1.107, 1.109, 1.111, 1.112, 1.113, 1.115, 1.116, 1.121, 1.191, 1.192, 1.196, 1.197, 1.231, 1.248, 1.301, and 1.303 are amended to provide for reexamination procedures. A new "Subpart D—Reexamination of Patents" includes new §§ 1.501, 1.510, 1.515, 1.520, 1.525, 1.530, 1.535, 1.540, 1.550, 1.552, 1.555, 1.560, 1.565, and 1.570. Paragraph (b) of § 1.291, relating to prior art citations in patents, is deleted, since provisions therefor appear in § 1.501.

Section 1.1, as amended, provides for communications relating to reexamination proceedings to be marked "Box Reexam" to speed internal Office mail processing. No comments were received concerning this section. The proposal has been modified to indicate that only requests should be marked "Box Reexam".

Section 1.5, as amended, provides for all letters relating to a reexamination proceeding to be identified by patent number and a reexamination request control number. No comments were received concerning this section. Section 1.5 has been modified to also include reference to the Group Art Unit and the examiner, if known.

Section 1.11, as amended, provides for all papers made of record in reexamination proceedings to be open to inspection and copying by the public. Eighteen comments were received relating to publication of a notice in the *Official Gazette*. A new paragraph (c) has been added which provides for the publication of requests with sufficient fees paid and orders initiated by the Commissioner. Proposed paragraph "c" has been adopted as paragraph "d".

Section 1.33, as amended, has a new paragraph (c) relating to which address communications for the patent owner will be sent and who may sign papers filed. Four comments were received on this section relating to whom the mail should be addressed. One proposal, which suggested use of the current address of the attorney or agent of record, was adopted.

Section 1.34, as amended, provides for the appointment of an attorney or agent in a reexamination proceeding. Only one comment was received on this section which proposed a rule specifically allowing attorneys to file requests without identifying their clients. Since any person may request reexamination, such a rule is not felt necessary.

Section 1.36, as amended, provides for the revocation and withdrawal of powers of attorney in a reexamination proceeding. No comment was received. Section 1.36 is adopted as proposed with

an additional change which added "or her" near the end.

Section 1.104, as amended, broadens the present section to also include reexamination. Three comments were received on § 1.104. All comments indicated that the examiner should not make a prior art search. Although no complete new search by the examiner is required, the use of patents and printed publications in addition to those submitted by the requester is clearly indicated in 35 U.S.C. 303(a). Accordingly, § 1.104 is adopted as proposed.

Section 1.107, as amended, provides for the citation of prior art by the examiner in a reexamination proceeding. The amended rule also refers to foreign published applications, as well as patents. No comments were received on this section. It is adopted as proposed.

Section 1.109, as amended, provides for the examiner to supply reasons for allowance in a reexamination proceeding if the examiner believes that the record does not make clear the reasons for allowing a claim or claims. No comments were received on this section. Except for a clarifying change in language, it is adopted as proposed.

Section 1.111, as amended, provides for replies by the patent owner in a reexamination proceeding. One comment was received which suggested a clarification. The suggestion was adopted. Other non-substantive changes have been made in the proposed section to shorten the sentences for clarity.

Section 1.112, as amended, provides for reexamination and reconsideration of the patent under reexamination after responses by the patent owner. Three comments were received on this section.

The wording has been changed as suggested to avoid any confusion between "reexamination" and "re-examine". The sentences have also been shortened for clarity.

Section 1.113, as amended, provides for a final rejection or action in a reexamination proceeding. One comment was received which pointed out a possible conflict between the amendment rights of section 305 and the final rejection of section 1.113. No problem is seen in this regard because of the provision of section 305 which states that "reexamination will be conducted according to the procedures established for initial examination." The section is adopted as proposed with the last sentence being divided into two sentences for clarity.

Section 1.115, as amended, provides for amendments by the patent owner in a reexamination proceeding. No comments were received concerning this

section. The section is adopted as proposed with minor changes for clarity.

Section 1.116, as amended, provides for amendments after final action in reexamination proceedings. One comment was received which was the same as that mentioned and responded to in Section 1.113 above. The sentences have been shortened for clarity.

Section 1.121, as amended, contains a new paragraph (f) which requires a complete copy of any new or amended claim when presented during reexamination proceedings. Two persons commented on this section. One proposed side-by-side presentation of amended and original claims. The other proposed that exactly the same procedure be used as is now in effect for amending reissue claims. Neither suggestion was adopted since neither lends itself to printing only the amended claims in a certificate as easily as the procedure set forth in § 1.121(f). The proposed section was revised to also provide for the amendment of the description. In addition, the last three sentences of § 1.510(e) have been inserted as the last three sentences of § 1.121(f) in order to provide a more complete description therein of the manner of making amendments, including the numbering of claims, the restriction on scope of the claims and the prohibition against the introduction of new matter.

Section 1.191, as amended, provides for appeal to the Board of Appeals by the patent owner from any decision adverse to patentability, in accordance with 35 U.S.C. 306. One comment was received on proposed § 1.191 which urged that the requester should also be entitled to appeal. This proposal was not adopted because it is not provided for in the law and could result in harassment if permitted. The section is adopted as proposed except that "primary" contained in the existing rule is retained.

Section 1.192, as amended, provides two months from the date of the Notice of Appeal for the patent owner to file an appeal brief in a reexamination proceeding. Five comments were received relating to § 1.192 which proposed that the period for filing an appeal brief in a reexamination appeal be two months as in other appeals. The proposed rule has been adopted with the suggested two month period. The sentences have been shortened for clarity.

Section 1.196 and § 1.197 are being amended to refer to "appellants", which is a term which includes both applicants and patent owners.

These two sections were not published for comment, however, the issues involved were presented in proposed §§ 1.191 and 1.192. Paragraph (c) of § 1.197 has also been rewritten for clarity.

Section 1.231(a)(1), as amended, provides for a motion that a patent claim is unpatentable in an interference proceeding where reexamination thereof has also been requested.

Three comments were received concerning § 1.231. All comments related to when interference or reexamination proceedings would be suspended. Section 1.565 provides basis for such suspensions. Decisions will be made on a case by case basis, depending on the particular fact situation. The sentences in § 1.231(a)(1) have been shortened and rearranged for clarity.

An amendment was proposed to delete the last two sentences of § 1.247 relating to proof of service. No comments were received concerning this section but, on reconsideration, no need for such deletion is felt necessary and no change is being adopted.

Section 1.248, as amended, includes a new paragraph (b) relating to methods of serving papers and proof of service. No comments were received concerning this section. The section is adopted as proposed with minor changes for clarity and to conform to the Federal Rules of Civil Procedure.

Section 1.291, as amended, deletes paragraph (b). Former paragraph (b) dealt with the citation of prior art provisions. It was deleted since the provisions are now covered by § 1.501. Five persons commented on § 1.291. One comment relating to filing protests in reexamination proceedings was not adopted since such proceedings are ex parte in nature and are limited to consideration of prior art patents and printed publications cited by the public prior to the order. Two persons mentioned providing a procedure for citation of prior art by patentees. Citation of prior art by patentees is included in § 1.501. The two other comments related to the content of protest proceedings, which are not part of this final rule. Section 1.291 is adopted as proposed except that the paragraph designation of (c) is not being changed.

Section 1.301, as amended, provides for appeal by the owner of a patent in reexamination proceedings to the U.S. Court of Customs and Patent Appeals. Four comments were received relating to § 1.301. One person suggested the insertion of "any" as the fourth word in the section. This suggestion was adopted. The other three comments

related to appeals in inter partes protest proceedings which are not a part of this promulgation. Section 1.301 is adopted as proposed with only the above mentioned change.

Section 1.303, as amended, provides for remedy by civil action under 35 U.S.C. 145 for the owner of a patent in reexamination proceedings. No comments were received concerning this section. The changes from the proposal are the insertion of "any" as the fourth word in the section as suggested in § 1.301 and the addition of ", 306" to the title.

New § 1.501 provides a system for citation of patents and printed publications to the Patent and Trademark Office for placement in the patent file by any person during the period of enforceability of the patent in accordance with 35 U.S.C. 301. Seventeen persons commented on § 1.501. Nine comments indicated that citations should be limited to patents or printed publications. Six comments indicated that persons citing art should be required to apply it to at least one claim. Three persons held the opposite view. The final rule wording provides for citations limited to patents and printed publications where the person making the citation states the pertinency and applicability of the citation to the patent and the bearing the citation has on the patentability of at least one claim of the patent. The final rule provides that a citation made by the patent owner may include an explanation of how the claims differ from the prior art cited. Any citations which include items other than patents and printed publications will not be entered in the patent file. This does not, of course, limit in any manner the kinds and types of information which can be relied upon in protests against pending patent applications, whether such be original applications or reissue applications. Four persons stated that a separate letter requesting confidentiality should be required in cases desiring confidentiality. This provision was not considered to be necessary. One comment requested clarification of the term "period of enforceability of a patent." The meaning of this term appears to be clear since it includes any period for which recovery can be had for infringement. Under usual circumstances, this would be the term of the patent plus the six years provided by 35 U.S.C. 286. Five comments were received relating to paragraph (c) concerning service of citations on the patent owner. The wording has been clarified. A suggestion was made that prior art copies and translations of non-

English documents be required. This suggestion was not adopted since such documents are not absolutely essential until a request for reexamination has been filed. However, if the person citing the patents or printed publications desires that they be considered in any subsequent reexamination proceedings, copies and any necessary English translation should be included with the citation. A proposal was also made to charge a fee to prevent harassment. This proposal was not adopted since the mere citation of prior art is not considered to constitute harassment. A suggestion was made to change the title of the section. This suggestion was adopted in slightly modified form.

New § 1.510 sets forth procedures for any person to request reexamination in accordance with 35 U.S.C. 302. Paragraph (a) of new § 1.510 limits the period for such request to the period of enforceability of the patent for which the request is filed and requires payment of the fee for requesting reexamination. Paragraph (b) of new § 1.510 indicates what each request for reexamination must include. Paragraph (c) of new § 1.510 indicates under which conditions a request for reexamination will be considered. Paragraph (d) of new § 1.510 indicates the date on which the entire fee is received will be considered to be the date of the request for reexamination. Upon reconsideration of the paragraph as proposed, it was considered more appropriate to base the filing date of the request for reexamination on the receipt of the fee for requesting reexamination rather than include other matters. Proposed paragraph (d) has been amended accordingly and is adopted. Paragraph (e) of new § 1.510 covers amendments which a patent owner can propose. Such amendments can accompany a request for reexamination by the patent owner. The paragraph, with changes in wording for clarity, is adopted as proposed. A new paragraph (f) was added to clarify that requests for reexamination may be filed by attorneys or agents on behalf of a requester. Nineteen persons commented on § 1.510. One person inquired as to whether confidential requests would be accepted. In response thereto, § 1.510 provides that any person may file a request for reexamination. That person's name will not be maintained in confidence. One suggestion was made to permit comment and rebuttal before the decision under § 1.515. No need for such a procedure is seen since the only question to be considered is whether or not a substantial new question of patentability has been raised. An

opportunity for comment and rebuttal is provided after the issuance of the order. One comment was received which desired provision for supplemental requests at a reduced fee. This proposal was not adopted since it is felt that all requesters should share equally in the cost. One comment was received which proposed that duplicate copies of the request be filed in the Office so that one copy would be available for public inspection at all times. This proposal was not adopted since it would appear to create more problems than it would solve. One comment was received that only "readily available" translations should be required. It is felt that if a document is considered to be sufficiently pertinent to request reexamination, that an English translation should be provided to insure complete and proper consideration. A suggestion was made relating to paragraph (b)(5) that direct service be limited to registered patent attorneys. No need for such a restriction is seen. Various other comments relating to procedures were considered but were not adopted.

New § 1.515 relates to a determination as to whether the request has presented a substantial new question of patentability under 35 U.S.C. 303. Paragraph (a) of new § 1.515 requires that the determination be made within 3 months of the filing date of the request. Paragraph (b) of new § 1.515 refers to the refund provisions. Paragraph (c) of new § 1.515 provides for review by petition to the Commissioner of any decision refusing reexamination. Seven persons commented on § 1.515. Several comments were received suggesting that the term "reexamination" should be dropped before "examiner". This proposal was adopted. Several persons requested that all art cited in the patent file at the time of the order under § 1.525 be considered when deciding whether a substantial new question of patentability is presented in the request. This is possible under the provision of § 1.515(a) which permits "consideration of other patents or printed publications", but is not required insofar as prior art not relied upon in the request is concerned. One person suggested that "is" be changed to—affirms—in paragraph (c). This proposal has been adopted. One commentor questioned whether a right to review was available under paragraph (c) if reexamination was ordered. No right to review exists in such a case because all claims will be reviewed in view of all prior art during the reexamination under § 1.550.

New § 1.520 provides for reexamination at the initiative of the

Commissioner under the provisions of the last sentence of paragraph (a) of 35 U.S.C. 303. Six persons commented on § 1.520. One comment was received that indicated that the section did not include a reference to patents "discovered by the Commissioner" which is contained in 35 U.S.C. 303(a). This phrase has been added to the rule. A request was made that the sentence "Normally requests from outside—will not be considered." be deleted from the rule. The sentence is being retained since the rule wording provides an easy reference for Office policy. Two comments were received that indicated a desire to have any decisions not to reexamine in Commissioner initiated situations be made part of the patent file. This proposal was not adopted since the basis for not reexamining may involve many policy issues in addition to whether a substantial new question of patentability exists in the case. If all papers in such a case would be made part of a file, it may lead to conclusions that there are no new questions of patentability when this question may not have been addressed because the reexamination was not ordered for other reasons such as little or no interest in a patent about to expire. One comment stated that the section safeguards the rights of the patentee. The language referring to the designation and delegation of authority to appropriate Patent and Trademark Office officials is deleted as unnecessary since the Commissioner's authority to designate and delegate is implicit and understood.

New § 1.525 provides for ordering reexamination where a substantial new question of patentability has been found pursuant to §§ 1.515 or 1.520. Six comments were received relating to § 1.525. One comment was made that the attorney should be able to return notices to the sender if he is unable to contact the patent owner. This topic has not been added to the rules but will be handled on a case by case basis. One comment requested that the patent owner have the option to request that the reexamination be performed by an examiner (1) other than the original examiner, or (2) other than the examiner who issued the order. Comments were also received on both sides of the question as to whether the original examiner should conduct the reexamination. In response, it would appear to be inappropriate to allow an interested party to select the examiner. Under the section, the only limitation placed on the selection of the examiner by the Office is that the same examiner whose decision was reversed on petition ordinarily will not conduct the

reexamination. Paragraph (b) has been changed to provide that the notices published in the *Official Gazette* will be considered to be constructive notice.

New § 1.530 relates to the statement and proposed amendments provided for in the second sentence of 35 U.S.C. 304. Amendments submitted by the patent owner cannot enlarge the scope of a claim in the patent. Amendments will not be effectively entered into the patent until the certificate under § 1.570 and 35 U.S.C. 307 is issued. Nine comments were received on § 1.530. Several persons felt that the patent owner should be allowed to comment before the decision under § 1.515 is made. Providing for such a comment would delay the decision under § 1.515 which must be made within three months following the filing date of the request. Further, no need is seen for a statement relating to whether a new question of patentability is present since the patent owner has the opportunity to address any issues of patentability only after the first Office action. One comment questioned whether paragraph (d) also related to the description. This paragraph has been amended to clarify the matter. One person questioned whether an amendment could be filed with a statement. Paragraph (b) clearly answers this question in the affirmative. Several comments requested more time than two months for the patent owner to file a statement. In reply, the law in section 304 indicates that a reasonable period of not less than two months be provided for the patent owner's statement. If the period is too short in particular situations, extensions of time can be requested. It is felt that two months should be retained in the rule in view of the "Special Dispatch" required in reexamination cases. The proposed second sentence of paragraph (b) has not been adopted since § 1.525(b) now provides for the publication of notices of the filing of all requests which are accompanied by the proper fee.

New § 1.535 provides for reply by the reexamination requester to the statement under § 1.530 of the patent owner and for service on the patent owner of any such reply. The last sentence of proposed § 1.540 has been added as the last sentence of § 1.535. Five persons commented on § 1.535. Four persons indicated that the requester should be given additional opportunity to comment. The reasons for the limited participation are that it is all that is required under the law, it prevents to a great degree, harassment of a patent owner, it results in a less expensive proceeding for all parties, and

it results in an earlier conclusion of the proceedings.

New § 1.540 relates to the consideration of statements under § 1.530 and replies under § 1.535. One comment was received that the phrase "may result in their being refused" was worded too loosely. In the absence of any specific suggestion, the proposed wording is considered to be adequate and is adopted as proposed. In addition, it is appropriate that the Office retain discretion as to consideration in such cases.

New § 1.550 covers the basic items relating to the conduct of reexamination proceedings. These proceedings basically follow the same procedures used for examining patent applications. The patent owner will be required to serve the reexamination requester with any response by the patent owner to the Office, in order to remove the necessity of the requester having to continuously monitor the file wrapper. Fourteen persons commented on § 1.550.

Several persons commented that they felt that at least some input by third parties should be permitted. Paragraph (e) has been revised to permit third party input up until the time of the order. Several comments were received that the periods for response should be extended to be similar to those in regular application Office actions. Although problems may arise in certain cases and extensions of time may be granted, it is felt that relatively short response times are necessary in order to process reexaminations with "special dispatch". A question was raised as to the effect of failure to respond to an Office action. Paragraph (d) has been amended to clarify this matter.

New § 1.552 covers the scope of reexamination in a reexamination proceeding. While it is not intended that the examiners will routinely complete a new search when conducting reexamination, the examiners will be free to, and will, very likely, conduct additional searches and cite and apply additional prior patents and publications when they consider it is appropriate and beneficial to do so. Insofar as the actual reexamination is concerned, the examination as to original patent claims is only on the basis of patents or printed publications. However, narrowed amended claims or new claims limited to the original disclosure will also be examined for compliance with other sections of the statute (35 U.S.C. 112 and 132) which are necessary in order to ensure that any amended or new claims are supported, valid, and do not introduce new matter. New § 1.552 also provides that questions relating to matters other than those

identified in paragraphs (a) and (b) of the section would merely be noted by the examiner as being an open question in the record. Patent owners could then file a reissue application if they wish such questions to be resolved. Ten persons commented on § 1.552. Several persons commented that the question of fraud should be considered in reexamination proceedings. Comments were also received that the proceedings should be limited to patents and printed publications. The rules have been written to follow the statute which speaks only to reexamination based on patents and printed publications. Mixed comments were also received concerning the retention of the second sentence of paragraph (c). The paragraph is being adopted as proposed with the addition of a reference to the fact that the examiner will note the existence of unresolved questions in an Office action. In addition, the phrase "raised or" has been deleted from paragraph (c) as unnecessary.

New § 1.555 covers the duty of disclosure by a patent owner in a reexamination proceeding involving the owner's patent. Nine persons commented on § 1.555. Four persons supported placing a duty of disclosure on the patent owner. One comment was received that an oath or declaration be required of the patent owner in a reexamination so as to minimize the appearance and occurrence of any fraudulent acts and to emphasize the patentee's obligation of candor. While the suggestion for an oath or declaration has not been adopted, § 1.555 does place an obligation of candor on the patent owner insofar as bringing patents or printed publications to the attention of the Office is concerned. The necessity for an oath or declaration in addition to the obligation placed on the patent owner by § 1.555 is not apparent at this time. Accordingly, the suggestion has not been adopted. Two persons felt the duty of disclosure should apply to both the patent owner and requester. This proposal was not adopted since no sanction could be easily applied against the requester who violated such a rule. One person suggested broadening the duty requirements to include information in addition to patents and printed publications. Although such a practice may be desirable, no need is seen to require information under the reexamination rules which cannot be used during the reexamination. One person felt that there should be no duty of disclosure requirement in reexamination proceedings since the Office will be considering specific prior art and the presence or absence of other

prior art does not seem terribly relevant. This suggestion was not adopted since the issue of patentability is not limited to the specific prior art presented and the duty to disclose is consistent with current practice under § 1.56. The section is adopted as proposed except for the indication that prior art statements should be filed in accordance with § 1.98. Also, the section has been divided into two sentences for clarity.

New § 1.560 relates to the conduct of interviews in reexamination proceedings. Seven comments were received directed to § 1.560. One comment requested elimination of interviews. This suggestion was not adopted since interviews have been found to be very helpful in resolving issues. Five comments were received which indicated that the requester should be permitted to attend all interviews. This suggestion was not adopted because of the otherwise expert nature of the examination. Two comments were received which indicated that interviews should be permitted before the first Office action. This suggestion was not adopted since such interviews would be held at a time when the Office has not yet taken a position on the allowability of the claims under reexamination. Section 1.560 is adopted as proposed.

New § 1.565 provides for the Commissioner to determine which, if any, proceedings should be stayed, consolidated, or suspended, if concurrent proceedings involving the patent under reexamination are instituted or in progress. Four comments were received concerning § 1.565. One comment pointed out the desirability of combining copending reexamination proceedings. This concept has been accepted and a new paragraph (c) has been added to cover this matter. Two comments voiced concern over the possibility of delay resulting from stayed, suspended or combined cases. Although some delay may result, it is felt that a resolution of all issues should occur at an earlier date. Decisions as to whether to delay or combine cases will be made on a case by case basis to minimize delays and to protect the interests of all parties concerned. One comment was made to allow the patent owner to comment prior to any decision to stay proceedings by the Commissioner. The desirability of such comment will be decided on a case by case basis and is not considered desirable for placement in the rules. The addition of paragraph (c) and the insertion of "is or" before "becomes" in

the first sentence of paragraph (b) are the only changes from the proposed rule.

New § 1.570 concerns the issuance of the reexamination certificate under 35 U.S.C. 307 after conclusion of reexamination proceedings. The certificate will cancel any patent claims determined to be unpatentable, confirm any patent claims determined to be patentable, and incorporate into the patent any amended or new claim determined to be patentable. Three commentators mentioned § 1.570. Two persons questioned the statutory authority for paragraph (d). In response to the concern for statutory authority, it is the position of the Office that once all of the claims have been canceled from the patent, the patent ceases to be enforceable for any purpose.

Accordingly, any pending reissue or other Office proceeding relating to a patent in which such a certificate has been issued will be terminated. This provides a degree of assurance to the public that patents with all the claims canceled via reexamination proceedings will not again be asserted. One commentator indicated that copies of the certificate should be part of subsequently sold copies of the patent. Such a practice is intended but is not being made part of the regulations.

Environmental, energy, and other consideration: The rule change will not have a significant impact on the quality of the human environment or the conservation of energy resources.

The rule change will not have a significant adverse economic impact on a substantial number of small entities (Regulatory Flexibility Act, Pub. L. 96-354).

The Patent and Trademark Office has determined that this rule change is not a major rule under Executive Order 12291.

Amendment of Regulations

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

1. Section 1.1 is revised to read as follows:

§ 1.1 All communications to be addressed to Commissioner of Patents and Trademarks.

(a) All letters and other communications intended for the Patent and Trademark Office must be addressed to "Commissioner of Patents and Trademarks," Washington, D.C. 20231. When appropriate, a letter should also be marked for the attention of a particular officer or individual.

(b) Letters and other communications relating to international applications during the international stage and prior to the assignment of a national serial number should be additionally marked "Box PCT."

(c) Requests for reexamination should be additionally marked "Box Reexam."

Note.— §§ 1.1 to 1.28 are applicable to trademark cases as well as to national and international patent cases except for provisions specifically directed to patent cases. See § 1.9 for definitions of "national application" and "international application." (Pub. L. 94-131, 89 Stat. 685)

2. Section 1.5 is amended by adding a new paragraph (d) to read as follows:

§ 1.5 Identification of application, patent or registration.

(d) A letter relating to a reexamination proceeding should identify it as such by the number of the patent undergoing reexamination, the reexamination request control number assigned to such proceeding and, if known, the group art unit and name of the examiner to which it has been assigned.

3. Section 1.11 is amended by adding new paragraphs (c) and (d) to read as follows:

§ 1.11 Files open to the public.

(c) All requests for reexamination for which the fee under § 1.21 (x) has been paid, will be announced in the *Official Gazette*. Any reexaminations at the initiative of the Commissioner 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 Commissioner initiated order control number, patent number, title, class and subclass, name of the inventor, name of the patent owner of record, and the examining group to which the reexamination is assigned.

(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.

4. Section 1.33 is amended by revising the heading and adding a new paragraph (c) to read as follows:

§ 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 § 1.34(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to §§ 1.341 and 1.347 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(a). 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.

5. Section 1.34 is revised to read as follows:

§ 1.34 Recognition for representation.

(a) When a registered attorney or agent acting in a representative capacity appears in person or signs a paper in practice before the Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the Patent and Trademark Office that under the provisions of this part and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. In filing such a paper, the attorney or agent should specify his or her registration number with his or her signature. Further proof of authority to act in a representative capacity may be required.

(b) When an attorney or agent shall have filed his or her power of attorney, or authorization, duly executed by the person or persons entitled to prosecute an application or a patent involved in a reexamination proceeding, he or she is a principal attorney of record in the case. A principal attorney or agent, so appointed, may appoint an associate attorney or agent who shall also then be of record.

6. Section 1.36 is revised to read as follows:

§ 1.36 Revocation of power of attorney or authorization; withdrawal of attorney or agent.

A power of attorney or authorization of agent may be revoked at any stage in the proceedings of a case, and an attorney or agent may withdraw, upon application to and approval by the Commissioner. An attorney or agent, except an associate attorney or agent whose address is the same as that of the principal attorney or agent, will be notified of the revocation of his or her power of attorney or authorization, and the applicant or patent owner will be notified of the withdrawal of the attorney or agent. An assignment will not of itself operate as a revocation of a power or authorization previously given, but the assignee of the entire interest may revoke previous powers and be represented by an attorney or agent of his or her own selection.

7. In § 1.104, paragraphs (a) and (b) are revised to read as follows:

§ 1.104 Nature of examination; examiner's action.

(a) 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.

(b) 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 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.

8. Section 1.107 is revised to read as follows:

§ 1.107 Citation of references.

(a) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees, and the classes of inventions must be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees must be stated,

and such other data must 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 must 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, shall be given.

(b) 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.

9. Section 1.109 is revised to read as follows:

§ 1.109 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 to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

10. Section 1.111 is revised to read as follows:

§ 1.111 Reply by applicant or patent owner.

(a) After the Office action, if 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 thereto and may request reconsideration or further examination, with or without amendment.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's

action and must respond to every ground of objection and rejection in the prior Office action. 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 case 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 response to a rejection of claims in an application or patent undergoing 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. He or she must also show how the amendments avoid such references or objections. (See §§ 1.135 and 1.136 for time for reply.)

11. Section 1.112 is revised to read as follows:

§ 1.112 Reconsideration.

After response by applicant or patent owner (§ 1.111), the application or patent under reexamination will be reconsidered and again examined. The applicant or patent owner will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination. Applicant or patent owner may respond to such Office action in the same manner provided in § 1.111, with or without amendment. Any amendments after the second Office action must ordinarily be restricted to the rejection or to the objections or requirements made. The application or patent under reexamination will be again considered, and so on repeatedly, unless the examiner has indicated that the action is final.

12. Section 1.113 is amended by revising paragraph (a) to read as follows:

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116. Petition may be taken to the Commissioner in the case of objections

or requirements not involved in the rejection of any claim (§ 1.181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the response to a final rejection or action must comply with any requirements or objection as to form.

13. Section 1.115 is revised to read as follows:

§ 1.115 Amendment.

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

14. Section 1.116 is amended by revising paragraphs (a) and (b) to read as follows:

§ 1.116 Amendments after final action.

(a) After final rejection or action (§ 1.113) amendments may be made cancelling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.

(b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

15. Section 1.121 is amended by adding a new paragraph (f) to read as follows:

§ 1.121 Manner of making amendments.

(f) Proposed amendments presented in patents involved in reexamination proceedings must be presented in the form of a full copy of the text of (1) each claim which is amended and (2) each paragraph of the description which is amended. Matter deleted from the

patent shall be placed between brackets and matter added shall be underlined. Copies of the printed claims from the patent may be used with any additions being indicated by carets and deleted material being placed between brackets. Claims must not be renumbered and the numbering of the claims added for reexamination must follow the number of the highest numbered patent claim. No amendment may enlarge the scope of the claims of the patent. No new matter may be introduced into the patent.

16. Section 1.191 is revised to read as follows:

§ 1.191 Appeal to Board of Appeals.

(a) Every applicant for a patent or for reissue of a patent, or every owner of a patent under reexamination, any of the claims of which have been twice rejected, or who has been given a final rejection (§ 1.113), may, upon the payment of the fee required by law, appeal from the decision of the primary examiner to the Board of Appeals within the time allowed for response.

(b) The appeal in an application must identify the rejected claim or claims appealed, and must be signed by the applicant or duly authorized attorney or agent. An appeal in a reexamination proceeding must identify the rejected claim or claims appealed, and must be signed by the patent owner or duly authorized attorney or agent.

(c) Except as otherwise provided by § 1.206, an appeal when taken must be taken from the rejection of all claims under rejection which the applicant or patent owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

17. Section 1.192 is amended by revising paragraph (a) to read as follows:

§ 1.192 Appellant's brief.

(a) The appellant shall, within 2 months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate. The brief must be accompanied by the requisite fee and must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. The brief must include a concise explanation of the invention which should refer to the drawing by reference characters, and a copy of the claims involved. Appellant must also indicate at the time of filing the brief if an oral hearing is desired. Upon a showing of sufficient cause, the

commissioner may grant extensions of time for filing the brief. The determination of such requests may be delegated by the Commissioner to appropriate Patent and Trademark Office officials. All requests for extensions must be filed prior to the expiration of the period sought to be extended. The filing of a request for extension of time does not stay any period unless and until granted.

18. Section 1.196 is amended by revising paragraphs (b), (c) and (d) to read as follows:

§ 1.196 Decision by the Board of Appeals.

(b) Should the Board of Appeals have knowledge of any grounds not involved in the appeal for rejecting any appealed claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement shall constitute a rejection of the claims. The appellant may submit an appropriate amendment of the claims so rejected or a showing of facts, or both, and have the matter reconsidered by the primary examiner. The statement shall be binding upon the primary examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the primary examiner, avoids the additional ground for rejection stated in the decision. The appellant may waive such reconsideration before the primary examiner and have the case reconsidered by the Board of Appeals upon the same record before them. Where request for such reconsideration is made the Board of Appeals shall, if necessary, render a new decision which shall include all grounds upon which a patent is refused. The appellant may waive reconsideration by the Board of Appeals and treat the decision, including the added grounds for rejection given by the Board of Appeals, as a final decision in the case.

(c) Should the decision of the Board of Appeals include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such statement, which shall be binding on the primary examiner in the absence of new references or grounds of rejection.

(d) Although the Board of Appeals normally will confine its decision to a review of rejections made by the primary examiner, should it have knowledge of any grounds for rejecting any allowed claim that it believes should be considered, it may include in its decision a statement to that effect and remand the case to the primary

examiner for consideration thereof. In such event, the Board shall set a period, not less than one month, within which the appellant may submit to the primary examiner an appropriate amendment, or a showing of facts or reasons, or both, in order to avoid the grounds set forth in the statement of the Board of Appeals. If the primary examiner rejects the previously allowed claim or claims on the basis of such statement, the appellant may appeal to the Board of Appeals from the rejection. Whenever a decision of the Board of Appeals includes a remand, that decision shall not be considered as a final decision in the case, but the Board of Appeals shall, upon conclusion of the proceedings before the primary examiner on remand, either adopt its decision as final or render a new decision on all of the claims on appeal, as it may deem appropriate.

19. Section 1.197 is amended by revising paragraphs (a) and (c) to read as follows:

§ 1.197 Action following decision.

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

(c) Proceedings are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except (1) where claims stand allowed in an application or (2) where the nature of the decision requires further action by the examiner. In such cases, the date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the court or review by civil action (§ 1.304) expires. If an appeal to the court or a civil action has been filed, proceedings are similarly considered terminated when the appeal or civil action is terminated.

20. Section 1.231 is amended by revising paragraph (a)(1) to read as follows:

§ 1.231 Motions before the primary examiner.

(a) Within the period set in the notice of interference for filing motions any party to an interference may file a motion seeking:

(1) To dissolve as to one or more counts, except that such motion based on facts sought to be established by affidavits, declarations or evidence outside of official records and printed

publications will not normally be considered. A motion to dissolve an interference in which a patentee is a party on the ground that the claims corresponding to the counts are unpatentable to the patentee over patents or printed publications will be considered through reexamination if it complies with the requirements of § 1.510(b) and is accompanied by the fee for requesting reexamination set in § 1.21(x). Otherwise, a motion to dissolve an interference in which a patentee is a party will not be considered if it would necessarily result in the conclusion that the claims of the patent which correspond to the counts are unpatentable to the patentee on a ground which is not ancillary to priority. Where a motion to dissolve is based on prior art, service on opposing parties must include copies of such prior art. A motion to dissolve on the ground that there is no interference in fact will not be considered unless the interference involves a design or plant patent or application or unless it relates to a count which differs from the corresponding claim of an involved patent or of one or more of the involved applications as provided in §§ 1.203(a) and 1.205(a).

21. Section 1.248 is revised to read as follows:

§ 1.248 Service of papers; manner of service; proof of service.

(a) Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:

(1) By delivering a copy of the paper to the person served;

(2) By leaving a copy at the usual place of business of the person served with someone in his employment;

(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;

(4) Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service.

(5) Whenever it shall be satisfactorily shown to the Commissioner that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the *Official Gazette*.

(b) Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service,

proof of service shall also include the name of any person served, certified by the person who made service. Proof of service may be made by (1) an acknowledgement of service by or on behalf of the person served or (2) a statement signed by the attorney or agent containing the information required by this section.

22. Section 1.291 is amended by revising the title, removing and reserving paragraph (b) and revising paragraph (c) to read as follows:

§ 1.291 Protests by public.

(b) (Reserved)

(c) Protests by the public and any accompanying papers should either (1) reflect that a copy of the same has been served upon the applicant in accordance with § 1.248 or (2) be filed with the Office in duplicate in the event service is not possible.

23. Section 1.301 is revised to read as follows:

§ 1.301 Appeal to U.S. Court of Customs and Patent Appeals.

Any applicant or any owner of a patent involved in a reexamination proceeding dissatisfied with the decision of the Board of Appeals, and any party to an interference dissatisfied with the decision of the Board of Patent Interferences, may appeal to the U.S. Court of Customs and Patent Appeals. The appellant must take the following steps in such an appeal: (a) In the Patent and Trademark Office give notice to the Commissioner and file the reasons of appeal (see §§ 1.302 and 1.304); (b) in the court, file a petition of appeal and a certified transcript of the record within a specified time after filing the reasons of appeal, and pay the fee for appeal, as provided by the rules of the court. The transcript will be transmitted to the Court by the Patent and Trademark Office on order of and at the expense of the appellant. Such order should be filed with the notice of appeal, but in no case should it be filed later than 15 days thereafter.

24. Section 1.303 is revised to read as follows:

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

(a) Any applicant or any owner of a patent involved in a reexamination proceeding dissatisfied with the decision of the Board of Appeals, and any party dissatisfied with the decision of the Board of Patent Interferences, may, instead of appealing to the U.S. Court of Customs and Patent Appeals (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as

appropriate. Such civil action must be commenced within the time specified in § 1.304.

(b) If an applicant in an ex parte case or an owner of a patent involved in a reexamination proceeding has taken an appeal to the U.S. Court of Customs and Patent Appeals, he or she thereby waives his or her right to proceed under 35 U.S.C. 145.

(c) If a defeated party to an interference proceeding has taken an appeal to the U.S. Court of Customs and Patent Appeals, and any adverse party to the interference shall, within twenty days after the appellant shall have filed notice of the appeal to the court (§ 1.302), file notice with the Commissioner that he or she elects to have all further proceedings conducted as provided in 35 U.S.C. 146, certified copies of such notices will be transmitted to the U.S. Court of Customs and Patent Appeals for such action as may be necessary. The notice of election must be served as provided in § 1.248.

25. A new "Subpart D—Reexamination of Patents" is added to read as follows:

Subpart D—Reexamination of Patents

Citation of Prior Art

Sec.

1.501 Citation of prior art in patent files.

Request for Reexamination

1.510 Request for reexamination.

1.515 Determination of the request for reexamination.

1.520 Reexamination at the initiative of the Commissioner.

Reexamination

1.525 Order to reexamine.

1.530 Statement and amendment by patent owner.

1.535 Reply by requester.

1.540 Consideration of responses.

1.550 Conduct of reexamination proceedings.

1.552 Scope of reexamination in reexamination proceedings.

1.555 Duty of disclosure in reexamination proceedings.

1.560 Interviews in reexamination proceedings.

1.565 Concurrent Office proceedings.

Certificate

1.570 Issuance of reexamination certificate after reexamination proceedings.

Subpart D—Reexamination of Patents

Citation of Prior Art

§ 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 Patent and Trademark Office in writing prior art consisting of patents or printed publications which

that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of a particular patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Citations by the patent owner under § 1.555 and by a reexamination requester under either § 1.510 or § 1.535 will be entered in the patent file during a reexamination proceeding. The entry in the patent file of citations submitted after the date of an order to reexamine pursuant to § 1.525 by persons other than the patent owner, or a reexamination requester under either § 1.510 or § 1.535, will be delayed until the reexamination proceedings have been terminated.

(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.

Request for Reexamination

§ 1.510 Request for reexamination.

(a) Any person may, at any time during the period of enforceability of a patent, file a request for reexamination by the Patent and Trademark Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501. The request must be accompanied by the fee for requesting reexamination set in § 1.21(x).

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

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

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

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

pertinent parts of any non-English language patent or printed publication.

(4) The entire specification (including claims) and drawings of the patent for which reexamination is requested must be furnished in the form of cut-up copies of the original patent with only a single column of the printed patent securely mounted or reproduced in permanent form on one side of a separate paper. A copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent must also be included.

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

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

(d) The filing date of the request is: (1) the date on which the request including the entire fee for requesting reexamination is received in the Patent and Trademark Office; or (2) the date on which the last portion of the fee for requesting reexamination is received.

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

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

§ 1.515 Determination of the request for reexamination.

(a) Within three months following the filing date of a request for reexamination, an examiner will consider the request and determine whether or not a substantial new

question of patentability affecting any claim of the patent is raised by the request and the prior art cited therein, with or without consideration of other patents or printed publications. The examiner's determination will be based on the claims in effect at the time of the determination and will become a part of the official file of the patent and will be given or mailed to the patent owner at the address as provided for in § 1.33(c) and to the person requesting reexamination.

(b) Where no substantial new question of patentability has been found, a refund of a portion of the fee for requesting reexamination will be made to the requester in accordance with § 1.26(c).

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

§ 1.520 Reexamination at the initiative of the commissioner.

The Commissioner, at any time during the period of enforceability of a patent, may determine whether or not a substantial new question of patentability is raised by patents or printed publications which have been discovered by the Commissioner or which have been brought to the Commissioner's attention even though no request for reexamination has been filed in accordance with § 1.510. The Commissioner may initiate reexamination without a request for reexamination pursuant to § 1.510. Normally requests from outside the Patent and Trademark Office that the Commissioner undertake reexamination on his own initiative will not be considered. Any determination to initiate reexamination under this section will become a part of the official file of the patent and will be given or mailed to the patent owner at the address as provided for in § 1.33(c).

Reexamination

§ 1.525 Order to reexamine.

(a) If a substantial new question of patentability is found pursuant to §§ 1.515 or 1.520, the determination will include an order for reexamination of the patent for resolution of the question. If the order for reexamination resulted from a petition pursuant to § 1.515(c), the reexamination will ordinarily be

conducted by an examiner other than the examiner responsible for the initial determination under § 1.515(a).

(b) If the order for reexamination of the patent mailed to the patent owner at the address as provided for in § 1.33(c) is returned to the Office undelivered, the notice published in the *Official Gazette* under § 1.11(c) will be considered to be constructive notice and reexamination will proceed.

§ 1.530 Statement and amendment by patent owner.

(a) Except as provided in § 1.510(e), no statement or other response by the patent owner shall be filed prior to the determinations made in accordance with §§ 1.515 or 1.520. If a premature statement or other response is filed by the patent owner it will not be acknowledged or considered in making the determination.

(b) The order for reexamination will set a period of not less than two months from the date of the order within which the patent owner may file a statement on the new question of patentability including any proposed amendments the patent owner wishes to make.

(c) Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Any statement filed must be served upon the reexamination requester in accordance with § 1.248.

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

(e) 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.

§ 1.535 Reply by requester.

A reply to the patent owner's statement under § 1.530 may be filed by the reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the reexamination requester will be considered.

§ 1.540 Consideration of responses.

The failure to timely file or serve the documents set forth in § 1.530 or in § 1.535 may result in their being refused consideration. No submissions other than the statement pursuant to § 1.530 and the reply by the requester pursuant to § 1.535 will be considered prior to examination.

§ 1.550 Conduct of reexamination proceedings.

(a) All reexamination proceedings, including any appeals to the Board of Appeals, will be conducted with special dispatch within the Office. After issuance of the reexamination order and expiration of the time for submitting any responses thereto, the examination will be conducted in accordance with §§ 1.104-1.119 and will result in the issuance of a reexamination certificate under § 1.570.

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

(c) The time for reply set in paragraph (b) of this section 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 the request effect any extension.

(d) If the patent owner fails to file a timely and appropriate response to any Office action, the reexamination proceeding will be terminated and the Commissioner will proceed to issue a certificate under § 1.570 in accordance with the last action of the Office.

(e) The reexamination requester will be sent copies of Office actions issued during the reexamination proceeding. Any document filed by the patent owner must be served on the requester in the manner provided in § 1.248. The document must reflect service or the document may be refused consideration by the Office. The active participation of the reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are (1) in accordance with § 1.510 or (2) entered in the patent file prior to the date of the order to reexamine pursuant

to § 1.525. Submissions by third parties, filed after the date of the order to reexamine pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a).

§ 1.552 Scope of reexamination in reexamination proceedings.

(a) Patent claims will be reexamined on the basis of patents or printed publications.

(b) Amended or new claims presented during a reexamination proceeding must not enlarge the scope of the claims of the patent and will be examined on the basis of patents or printed publications and also for compliance with the requirements of 35 U.S.C. 112 and the new matter prohibition of 35 U.S.C. 132.

(c) Questions other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such questions are discovered during a reexamination proceeding, the existence of such questions will be noted by the examiner in an Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such questions considered and resolved.

§ 1.555 Duty of disclosure in reexamination proceedings.

The owner of a patent involved in a reexamination proceeding who is aware, or becomes aware, of patents or printed publications material to the reexamination which have not been previously made of record in the patent file must bring such patents or printed publications to the attention of the Office. A prior art statement, preferably in accordance with § 1.98, should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible in order to bring such patents or printed publications to the attention of the Office.

§ 1.560 Interviews in reexamination proceedings.

(a) Interviews in reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents

of record must be had in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner. Interviews for the discussion of the patentability of claims in patents involved in reexamination proceedings will not be had prior to the first official action thereon. Interviews should be arranged for in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111.

§ 1.565 Concurrent office proceedings.

(a) In any reexamination proceeding before the Office, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissue, reexaminations, or litigation and the results of such proceedings.

(b) If a patent in the process of reexamination is or becomes involved in interference proceedings or a reissue application is filed for the patent, or litigation is instituted, the Commissioner shall determine whether or not to stay the reexamination, reissue or interference proceeding. If reexamination is stayed for the conduct of a reissue proceeding, the reissue proceeding shall take into account prior art provided by the requester for reexamination and the reexamination requester will be granted at least the same degree of participation in the reissue proceeding which the requester would have had in the reexamination proceeding. Any reexamination proceeding stayed for the conduct of a reissue proceeding shall be terminated by the grant of the reissued patent.

(c) If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings

will be consolidated and result in the issuance of a single certificate under § 1.570.

Certificate

§ 1.570 Issuance of reexamination certificate after reexamination proceedings.

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

(b) A certificate will be issued in each patent in which a reexamination proceeding has been ordered under § 1.525. Any statutory disclaimer filed by the patent owner will be made part of the certificate.

(c) The certificate will be mailed on the day of its date to the patent owner at the address as provided for in § 1.33(c). A copy of the certificate will also be mailed to the requester of the reexamination proceeding.

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

(e) If the reexamination proceeding is terminated by the grant of a reissued patent as provided in § 1.565(b), the reissued patent will constitute the reexamination certificate required by this section and 35 U.S.C. 307.

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

Dated: May 12, 1981.

René D. Tegtmeyer,
Acting Commissioner of Patents and Trademarks.

Dated: May 15, 1981.

Robert B. Ellert,
Acting Assistant Secretary for Productivity, Technology and Innovation.

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