For the reasons discussed in the preamble, the Coast Guard proposes to amend 33 CFR part 165 as follows:

PART 165—REGULATED NAVIGATION AREAS AND LIMITED ACCESS AREAS

1. The authority citation for part 165 continues to read as follows:

Authority: 33 U.S.C. 1226, 1231; 46 U.S.C. Chapter 701; 50 U.S.C. 191, 195; 33 CFR 1.05–1(g), 6.04–1, 6.04–6 and 160.5; Pub. L. 107–295, 116 Stat. 2064; Department of Homeland Security Delegation No. 0170.1.

2. Add Temporary § 165.T06–019, to read as follows:

§ 165.T06–019 Safety Zone: Broad Bay, Virginia Beach, VA.

(a) Location: The following area is a safety zone: All waters within 420 feet of the fireworks display at Cavalier Golf and Yacht Club on Broad Bay, Virginia beach, VA in the Captain of the Port, Hampton Roads zone as defined in 33 CFR § 3.25–10.

(b) Definition: Captain of the Port: means any U.S. Coast Guard commissioned, warrant or petty officer who has been authorized by the Captain of the Port, Hampton Roads, Virginia to act on his behalf.

(c) Regulation: (1) In accordance with the general regulations in § 165.23 of this part, entry into this zone is prohibited unless authorized by the Captain of the Port, Hampton Roads, VA, or his designated representatives.

(2) The operator of any vessel in the immediate vicinity of this safety zone shall:

(i) Stop the vessel immediately upon being directed to do so by any commissioned, warrant or petty officer on shore or on board a vessel that is displaying a U.S. Coast Guard Ensign.

(ii) Proceed as directed by any commissioned, warrant or petty officer on shore or on board a vessel that is displaying a U.S. Coast Guard Ensign.

(3) The Captain of the Port, Hampton Roads and the Sector Duty Officer at Sector Hampton Roads, Portsmouth, Virginia can be contacted at telephone Number (757) 668–5555 or (757) 484–8192.

(4) The Coast Guard Representatives enforcing the safety zone can be contacted on VHF–FM 13 and 16.

(d) Effective date: This regulation is effective from 9 p.m. to 10:30 p.m. on July 4, 2006.

Dated: March 10, 2006.

John S. Kenyon,

Commander, U.S. Coast Guard, Alternate Captain of the Port, Hampton Roads.

[FR Doc. E6–4610 Filed 3–29–06; 8:45 am]

BILLING CODE 4910–15–P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 1 and 41

[Docket No.: PTO–P–2005–0016]

RIN 0651–AB77

Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rule making.

SUMMARY: The United States Patent and Trademark Office (Office) is proposing changes to the rules of practice relating to *ex parte* and *inter partes* reexamination. The Office is proposing to provide for a patent owner reply to a request for an *ex parte* reexamination or an *inter partes* reexamination prior to the examiner's decision on the request. The Office is also proposing to prohibit supplemental patent owner responses to an Office action in an *inter partes* reexamination without a showing of sufficient cause. The Office additionally proposes to designate the correspondence address for the patent as the correct address for all communications for patent owners in an *ex parte* reexamination or an *inter partes* reexamination, and to simplify the filing of reexamination papers by providing for the use of a single ''mail stop'' address for the filing of substantially all *ex parte* reexamination papers (such is already the case for *inter partes* reexamination papers). The Office is further proposing to make miscellaneous clarifying changes as to terminology and applicability of the reexamination rules.

Comment Deadline Date: To be ensured of consideration, written comments must be received on or before May 30, 2006. No public hearing will be held.

ADDRESSES: Comments should be sent by electronic mail over the Internet addressed to: *AB77.comments@uspto.gov.* Comments may also be submitted by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313–1450; or by facsimile to (571) 273–7710, marked to the attention of Kenneth M. Schor, Senior Legal Advisor. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. If comments are submitted by mail, the Office prefers that the comments be submitted on a DOS formatted 3½ inch disk accompanied by a paper copy.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (*http://www.regulations.gov*) for additional instructions on providing comments via the Federal eRulemaking Portal.

The comments will be available for public inspection at the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, currently located at Room MDW 07D74 of Madison West, 600 Dulany Street, Alexandria, Virginia 22313–1450, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: *http://www.uspto.gov*). Since comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: By telephone—Kenneth M. Schor, at (571) 272–7710 or Robert J. Spar at (571) 272–7700; by mail addressed to U.S. Patent and Trademark Office, Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450, marked to the attention of Kenneth M. Schor; by facsimile transmission to (571) 273–7710 marked to the attention of Kenneth M. Schor; or by electronic mail message over the Internet addressed to *kenneth.schor@uspto.gov.*

SUPPLEMENTARY INFORMATION: The Office is proposing changes to the rules of practice relating to *ex parte* and *inter partes* as follows:

Proposal I: To provide for a patent owner reply to a request for an *ex parte* reexamination or an *inter partes* reexamination prior to the examiner's decision on the request.

Proposal II: To prohibit supplemental patent owner responses to an Office action in an *inter partes* reexamination without a showing of sufficient cause.

Proposal III: To designate the correspondence address for the patent as the correct address for all notices, official letters, and other communications for patent owners in an *ex parte* reexamination or an *inter partes* reexamination. Also, to simplify the filing of reexamination papers by providing for the use of ''Mail Stop *Ex Parte* Reexam'' for the filing of all *ex parte* reexamination papers (not just *ex parte* reexamination requests), other than certain correspondence to the Office of the General Counsel.

Proposal IV: To make miscellaneous clarifying changes as to the terminology and applicability of the reexamination rules, and to correct inadvertent errors in the text of certain reexamination rules.

Discussion of Proposals I through IV

Proposal I. To Provide for a Patent Owner Reply to a Request for Reexamination Prior to Decision on the Request: Since the inception of reexamination, a patent owner whose patent is challenged by a third party request for reexamination has not been afforded an opportunity to comment on the request prior to the examiner's decision on the request. This is equally so for both *ex parte* reexamination and *inter partes* reexamination. Under § 1.530(a), ''[e]xcept as provided in § 1.510(e), no statement or other response by the patent owner in an *ex parte* reexamination proceeding 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.'' Under § 1.540, ''[n]o submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.'' Under § 1.939(b), [u]nless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

The rule making history for § 1.530(a) addressed the Office's rationale for the regulatory prohibition of a patent owner response to a request (prior to the examiner's decision on the request) in a hearing report issued by the Office, which stated that ''several persons felt that the patent owner should be allowed to comment before the decision [on the request] under § 1.515 is made. Providing for such a comment would delay the decision under § 1.515 which must be made within three months * * *.'' *See Rules of Practice in Patent Cases; Reexamination Proceedings*, 46 FR 29176, 29179 (May 29, 1981) (final rule). In *Patlex Corp.* v. *Mossinghoff*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985), the propriety of the Office's regulatory prohibition of a patent owner response to a request prior to the decision on the request was upheld by the U.S. Court of Appeals for the Federal Circuit (hereinafter—the Federal Circuit). The Office argued in *Patlex* that this regulatory prohibition was adopted in the interest of efficiency, in view of the three-month deadline set by Congress in 35 U.S.C. 303. The Office pointed out that the only purpose of the decision on the request is to decide whether reexamination should go forward at all, not to decide how any new question of patentability ultimately will be answered. The *Patlex* court supported the Office in this matter based upon the agency's (Office's) expression of a need for administrative convenience.

Recently, however, the Office initiated a program to process and examine all new reexamination proceedings in one Central Reexamination Unit (the CRU). This is expected to permit increased efficiency in deciding new requests for reexamination to the point where a patent owner response to a request (prior to the examiner's decision on the request) can be accommodated, while continuing to comply with the statutory mandate to decide requests for reexamination within three months. Accordingly, the Office is proposing to provide for a patent owner reply to a request for an *ex parte* reexamination or an *inter partes* reexamination prior to the examiner's decision on the request. Such a patent owner reply would address patentee concerns as to their current inability to address a request prior to an order. Further, the patent owner's input could improve the information/evidence and understanding of the issues before the examiner deciding the request. That input should serve the purpose of reducing improper/unnecessary orders and providing more timely patent owner responses on the record to third party allegations. This proposal should enable the Office to be better able to weed out those requests that do not raise a substantial question of patentability, prior to instituting a full-blown proceeding. Bringing the issues to light earlier via such a patent owner response to the request should facilitate the reexamination process pursuant to special dispatch.

As a final point, in order to address the statutory mandate to decide all requests for reexamination within three months, the content and time for filing the patent owner's response (to the request) will be strictly limited. This should enable the Office to comply with the statute, while obtaining the benefits of the patent owner's comments prior to deciding the request.

This proposal involves providing new sections § 1.512 and § 1.921, and revising § 1.510(b), § 1.515(a), § 1.530(a), § 1.915(b) and § 1.923.

Proposal II. To Prohibit Supplemental Patent Owner Responses to an Office Action Without a Showing of Sufficient Cause: The Office is proposing to amend § 1.945 to provide that a patent owner supplemental response (which can be filed to address a third party requester's comments on patent owner's initial response to an Office action) will be entered only where the patent owner has made a showing of sufficient cause as to why the supplemental response should be entered.

Pursuant to § 1.937(b), an *inter partes* reexamination proceeding is ''conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process * * * except as otherwise provided * * * '' Thus, a patent owner's response to an Office action is governed by § 1.111. Prior to the revision of § 1.111(a)(2) implemented via the final rule, *Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan*, 69 FR 56482 (Sept. 21, 2004), 1287 *Off. Gaz. Pat. Office* 67 (Oct. 12, 2004) (final rule), a patent owner could, in effect, file an unlimited number of supplemental responses to an Office action for an *inter partes* reexamination proceeding, thereby delaying prosecution. The changes to § 1.111(a)(2) made in the Strategic Plan final rule, in effect, addressed this undesirable consequence of the rules in *inter partes* reexamination by providing that a reply (or response, in reexamination) which is supplemental to a § 1.111(b) compliant reply will not be entered as a matter of right (with the exception of a supplemental reply filed while action by the Office is suspended under § 1.103(a) or (c)). Section 1.111(a)(2)(i), as implemented in the Strategic Plan final rule, however, also provides that ''the Office may enter'' a supplemental response to an Office action under certain conditions. Thus, a patent owner's supplemental response that provides additional information, or one that further amends the claims, could be argued to ''simplify the issues for appeal'' and thereby satisfy § 1.111(a)(2)(i)(F), or the supplemental response might be limited to ''cancellation of claims'' (to satisfy § 1.111(a)(2)(i)(A)), or ''adoption of the examiner suggestions'' (to satisfy § 1.111(a)(2)(i)(B)). Even a supplemental response that answers the third party requester comments might, in some instances, be argued to ''simplify the issues for appeal.'' Whether or not the supplemental response should be entered is then a question to be decided by the Office. In order to fully inform both the Office and the requester (so that the requester can provide rebuttal in its comments) as to why patent owner deems a supplemental response to be

worthy of entry, it is proposed that the rules be revised to require a patent owner showing of sufficient cause why entry should be permitted to accompany any supplemental response by the patent owner. The showing of sufficient cause would be required to provide: (1) A detailed explanation of how the criteria of § 1.111(a)(2)(i) is satisfied; (2) an explanation of why the supplemental response could not have been presented together with the original response to the Office action; and (3) a compelling reason to enter the supplemental response.

This proposal would permit the entry of a supplemental response to an Office action where there is a valid reason for it, and a showing to that effect is made by the patent owner. At the same time, it would provide the Office and the requester with notice of patent owner's reasons for desiring entry and permit the requester to rebut patent owner's stated position.

This proposal involves § 1.945.

Proposal III. Reexamination Correspondence: 1. The Patent Owner's Address of Record: Currently, all notices, official letters, and other communications for patent owners in a reexamination proceeding must be directed to the attorney or agent of record (see § 1.33(c)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to § 11.5 and § 11.11 (unless there is no attorney or agent of record, in which case the patent owner(s) address(es) of record are used). The Office has been receiving reexamination filings where the request has been served on the patent owner at the correspondence address under § 1.33(a) that is a correct address for the patent, rather than at the patent owner address prescribed in § 1.33(c) for use in reexamination. This has been occurring because the § 1.33(a) address is the address used for correspondence during the pendency of applications, as well as post-grant correspondence in patents maturing from such applications. Further, even if a potential reexamination requester realizes that the address indicated by § 1.33(c) is the proper patent owner address to use, patent practitioners occasionally move from one firm to another, and the potential reexamination requester is then faced with two (or more) § 1.33(c) addresses for the practitioners of record; the requester must decide which practitioner address to serve. Finally, the § 1.33(c) address might not be kept up-to-date, while a practitioner or patent owner is likely to be inclined to keep the § 1.33(a) address up-to-date for prompt receipt of notices as to the patent. The Office of Enrollment and Discipline regularly has mail returned because the register of patent attorneys and agents maintained pursuant to § 11.5 and § 11.11 is not up-to-date. Thus, the § 1.33(a) correspondence address for the patent provides a better or more reliable option for the patent owner's address than does the register of patent attorneys and agents maintained pursuant to § 11.5 and § 11.11 (the reexamination address for the patent owner presently called for by § 1.33(c)).

It is to be noted that a change to the correspondence address may be filed with the Office during the enforceable life of the patent, and the correspondence address will be used in any correspondence relating to maintenance fees unless a separate fee address has been specified. *See* § 1.33(d). A review of randomly selected recent listings of *inter partes* reexamination filings reflected that all had an attorney or agent of record for the related patents. There were an average of 18.6 attorneys or agents of record for the patents, and for those attorneys, an average of 3.8 addresses (according to the register of patent attorneys and agents maintained pursuant to § 11.5 and § 11.11). Although for half of the patents, all of the attorneys or agents had the same address, one patent had 77 attorneys and agents of record, and the register reflects 18 different addresses for these practitioners. In such a patent with many different attorneys and agents of record, and many of the practitioners being in different states, mailing a notice related to a reexamination proceeding for the patent to an attorney or agent of record in the patented file, even the attorney or agent most recently made of record (*e.g.*, the attorney with the highest registration number), is likely to result in correspondence not being received by the appropriate party. Since the correspondence address of the patent file is used for maintenance fee correspondence, if a fee address is not specified, patent owners already have an incentive to keep the correspondence address for a patented file up-to-date.

Given the choice of relying on either the correspondence address for the patent or the address for the attorney/agent of record per the register of patent attorneys and agents (as is presently the case), it is more reasonable to rely on the correspondence address for the patent. The patentee should be responsible for updating the correspondence address for the patent, and if the patentee does not, then the patentee should bear the risk of a terminated reexamination prosecution due to the failure to respond to an Office action sent to an obsolete address. Further, use of the correspondence address for the patent will provide a potential reexamination requester and the Office with one simple address to work with, and the requester and the Office will not be confused in the situations where attorneys move from firm to firm (as that has become more common). The correspondence address for the patents is available in public PAIR (Patent Application Information Retrieval), so that a requester need only click on the address button for the patent, and he/she will know what address to use.

The present proposal would accordingly revise § 1.33(c) to designate the correspondence address for the patent as the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings.

If the present proposal is implemented, the correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent file will automatically be changed, by rule, to that of the patent file. For any such proceeding, it would be strongly encouraged (at that point) that the patent owner should affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding to conform the address of the proceeding with that of the patent. While the correspondence address change would automatically be effected (by rule) even if the patent owner notification is not filed, such a patent owner notification would clarify the record, and would address the possibility that, absent such a patent owner notification, correspondence may inadvertently be mailed to an incorrect address causing a delay in the prosecution.

This aspect of the proposal involves § 1.33.

2. Reexamination correspondence addressed to the Office: In the final rule *Changes to Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute,* 68 FR 70996 (Dec. 22, 2003), 1278 *Off. Gaz. Pat. Office* 218 (Jan. 20, 2004), § 1.1(c) was amended to provide separate mail stops for *ex parte* reexamination proceedings and *inter partes* reexamination proceedings. *See* § 1.1(c). As per that rule making, the mail stop for *ex parte* reexamination proceedings can only be used for the original request papers for *ex parte* reexamination. The new mail stop for *inter partes* reexamination, on the other hand, includes both original request papers and all subsequent

correspondence filed in the Office (other than correspondence to the Office of the General Counsel pursuant to § 1.1(a)(3) and § 1.302(c)), because the Central Reexamination Unit (CRU) was, and is, the central receiving area for all *inter partes* reexamination proceeding papers. The CRU has now also become the central receiving area for all *ex parte* reexamination proceeding papers. Accordingly, it is proposed to simplify the filing of reexamination papers by permitting the use of ''Mail Stop *Ex Parte* Reexam'' for the filing of all *ex parte* reexamination follow-on papers (not just *ex parte* reexamination requests), other than correspondence to the Office of the General Counsel pursuant to §§ 1.1(a)(3) and 1.302(c)).

This aspect of the proposal involves § 1.1(c).

Correspondence relating to all reexamination proceedings is best handled at one central location where Office personnel have specific expertise in reexamination because of the unique nature of reexamination proceedings. That central location is the CRU.

Proposal IV. Clarifying Changes as to Reexamination Rule Terminology and Applicability, and Correction of Inadvertent Errors in the Text of Certain Reexamination Rules: The Office is proposing miscellaneous clarifying changes as to the terminology and applicability of the reexamination rules. The rule changes of sub-parts 1 and 2 below were proposed in the *Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan,* 68 FR 53816 (Sept. 12, 2003), 1275 *Off. Gaz. Pat. Office* 23 (Oct. 7, 2003) (notice of proposed rule making) (hereinafter the Strategic Plan Proposed Rule). The Office did not proceed with those changes in the final rule *Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan,* 69 FR 56482 (Sept. 21, 2004), 1287 *Off. Gaz. Pat. Office* 67 (Oct. 12, 2004) (final rule) (hereinafter the Strategic Plan Final Rule). The Office is re-presenting those proposals after further consideration and in view of the changes somewhat more recently made by the final rule *Rules of Practice Before the Board of Patent Appeals and Interferences* 69 FR 49960 (Aug. 12, 2004), 1286 *Off. Gaz. Pat. Office* 21 (Sept. 7, 2004) (final rule) (hereinafter, the Appeals final rule). The essential substance of all change proposals set forth in Proposal IV, sub-parts 1 and 2, remains as it was in the Strategic Plan Proposed Rule. The four revisions proposed in Proposal IV are set forth as follows:

1. It is proposed that the rules be amended to clarify that the patent owner's failure to file a timely response in an *ex parte* or *inter partes* reexamination proceeding will terminate the prosecution of the reexamination proceeding, but will not terminate or conclude the reexamination proceeding itself. It is the issuance and publication of a reexamination certificate that concludes the reexamination proceeding. This distinction is important, because a reexamination prosecution which is terminated may be reopened at the option of the Director where appropriate. For example, a rejection that was withdrawn during the proceeding may be reinstated after the prosecution has terminated where the propriety of that rejection has been reconsidered. In contrast, a reexamination proceeding which has been concluded is not subject to being reopened. After the reexamination proceeding has been concluded, the Office is not permitted to reinstate the exact same ground of rejection in a reexamination proceeding, where the same question of patentability is raised by the prior art that is the basis of the rejection. See § 13105, part (a), of the Patent and Trademark Office Authorization Act of 2002, enacted in Public Law 107–273, 21st Century Department of Justice Appropriations Authorization Act, 116 Stat. 1758 (2002).

This distinction between terminating the prosecution of the reexamination proceeding, and the conclusion of the reexamination proceeding, was highlighted by the Federal Circuit decision of *In re Bass,* 314 F.3d 575, 577, 65 USPQ2d 1156, 1157 (Fed. Cir. 2003), wherein the Court indicated that:

> Until a matter has been completed, however, the PTO may reconsider an earlier action. *See In re Borkowski,* 505 F.2d 713, 718, 184 USPQ 29, 32–33 (CCPA 1974). A reexamination is complete upon the statutorily mandated issuance of a reexamination certificate, 35 U.S.C. 307(a); the NIRC merely notifies the applicant of the PTO's intent to issue a certificate. A NIRC does not wrest jurisdiction from the PTO precluding further review of the matter.

It is to be noted that both Notice of Intent to Issue Reexamination Certificate (NIRC) cover sheet forms, *i.e.*, *ex parte* reexamination Form PTOL 469 and *inter partes* reexamination Form PTOL 2068, specifically state (in their opening sentences) that ''[p]rosecution on the merits is (or remains) closed in this * * * reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office, or upon petition.'' This statement in both forms makes the point that the NIRC terminates the *prosecution* in the reexamination proceeding (if prosecution has not already been terminated, e.g., via failure to respond), but does not terminate or conclude the reexamination *proceeding* itself. Rather, it is the issuance and publication of the reexamination certificate that concludes the reexamination proceeding. The rules would be revised accordingly.

Definitional Consideration: In the Strategic Plan Proposed Rule, the terminology used was that a patent owner's failure to file a timely response in a reexamination proceeding (and the issuance of the NIRC) would ''conclude'' the prosecution of the reexamination proceeding, but would not terminate the reexamination proceeding, and the issuance and publication of a reexamination certificate would ''terminate'' the reexamination proceeding. This usage of ''conclude'' and ''terminate'' has been reconsidered, however, and the usage of the terms has been reversed to be consistent with the way the Office defines ''termination,'' as can be observed in the recent Appeals final rule (*supra.*). It is to be noted that the patent statute, in 35 U.S.C. 307(a), states for *ex parte* reexamination (35 U.S.C. 316 contains an analogous statement for *inter partes* reexamination): ''In a reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.'' (Emphasis added).

Thus, after the appeal proceeding in the reexamination is terminated (which terminates the prosecution in the reexamination), the reexamination proceeding is concluded by the issuance and publication of the reexamination certificate.

It is further observed that in the Appeals final rule, § 1.116(c) states that ''[t]he admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the * * * reexamination prosecution from termination under § 1.550(d) or § 1.957(b) * * *.'' The use of ''termination of the prosecution'' where the reexamination proceeding has not concluded is consistent with the presentation in § 1.116(c) in the Appeals final rule. As a further indication in the

Appeals final rule, § 1.197(a) discusses the passing of jurisdiction over an application or patent under *ex parte* reexamination proceeding to the examiner after a decision by the Board of Patent Appeals and Interferences, and § 1.197(b) then states that ''[p]roceedings on an application 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 * * *.'' Thus, the termination (of the appeal) does not signify the completion of an application or reexamination proceeding. Rather, the application then continues until patenting or abandonment, and the reexamination continues until issuance of the reexamination certificate; at that point these proceedings are concluded.

The above changes would be directed to §§ 1.502, 1.550, 1.565(d), 1.570, 1.902, 1.953, 1.957, 1.958, 1.979, 1.991, 1.997, and 41.4.

2. Pursuant to 35 U.S.C. 307(a), ''when the time for appeal has expired or any appeal proceeding has terminated, the Director will issue and publish a certificate * * *'' (emphasis added) for an *ex parte* reexamination proceeding. Likewise, for an *inter partes* reexamination, 35 U.S.C. 316(a) states that ''when the time for appeal has expired or any appeal proceeding has terminated, the Director shall issue and publish a certificate'' (emphasis added). Accordingly, any reexamination proceeding is concluded when the reexamination certificate has been issued and published. It is at that point in time that the Office no longer has jurisdiction over the patent which has been reexamined.

Sections 1.570 and 1.997 are the sections that implement the statutory *ex parte* and *inter partes* reexamination certificates, respectively. The titles of §§ 1.570 and 1.997, as well as paragraphs (b) and (d) in both sections, currently refer to the issuance of the reexamination certificate, but fail to refer to the publication of the certificate. The titles of §§ 1.570 and 1.997, as well as paragraphs (b) and (d), are proposed to be revised to track the language of 35 U.S.C. 307 and 35 U.S.C. 316, and refer to both issuance and publication, to thereby make it clear in the rules when the reexamination proceeding is concluded. The other reexamination rules containing language referring to the issuance of the reexamination certificate would likewise be revised.

The above changes would be directed to §§ 1.502, 1.530, 1.550, 1.565(c), 1.570, 1.902, 1.953, 1.957, 1.979, and 1.997.

3. In § 1.137, the introductory text of paragraphs (a) and (b) states ''a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c).'' [Emphasis added]. As pointed out in the discussion of the first sub-proposal, when the patent owner fails to timely respond, it is actually the prosecution of the reexamination that is terminated under § 1.550(d) for *ex parte* reexamination, or is terminated under § 1.957(b) for *inter partes* reexamination. For the § 1.957(c) scenario, however, the prosecution of the *inter partes* reexamination proceeding is not terminated when the patent owner fails to timely respond pursuant to § 1.957(c). Rather, an Office action is issued to permit the third party requester to challenge the claims found patentable (as to any matter where the requester has preserved the right of such a challenge), and the prosecution is ''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.'' Section 1.957(c).

It is proposed that the introductory text of § 1.137(a) and § 1.137(b) be revised to also provide for the situation where the prosecution is ''limited'' pursuant to § 1.957(c) (and the prosecution of the reexamination is not ''terminated''). It is also proposed that § 1.137(e) be revised consistent with § 1.137(a) and § 1.137(b).

It is noted that § 1.957(c) does, in fact, result in the ''terminating'' of reexamination prosecution as to the non-patentable claims (under § 1.957(b), on the other hand, prosecution is terminated *in toto*). It would be confusing, however, to refer to a termination of reexamination prosecution in the § 1.957(c) scenario, since the limited termination as to the non-patentable claims could easily be confused with the termination of the entirety of the prosecution of § 1.957(b). Accordingly, the § 1.957(c) ''limitation'' of the scope of the remaining claims is the language deemed better suited for use in the rules.

The above changes would be directed to §§ 1.8, 1.137 and 41.4 (§§ 1.8 and 41.4 contain language which tracks that of § 1.137(a) and § 1.137(b), and would thus be revised accordingly).

4. Pursuant to § 1.8(b), a remedy is provided for having correspondence considered to be timely filed, where correspondence was mailed or transmitted in accordance with paragraph § 1.8(a) but not timely received in the Office, and ''the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice.'' Such a remedy is not, however, explicitly provided for in an *inter partes* reexamination proceeding where correspondence was mailed or transmitted in accordance with paragraph § 1.8(a), but not timely received in the Office. In that case, pursuant to § 1.957(c), the reexamination prosecution is not terminated, but is rather ''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.'' Therefore, it could appear that § 1.8(b) does not apply to the § 1.957(c) scenario. Therefore, § 1.8(b) is proposed to be revised to explicitly provide the § 1.8(b) remedy for the § 1.957(c) scenario as well.

In addition, the certificate of mailing and transmission is available to an *inter partes* reexamination third party requester filing papers. *See* MPEP §§ 2624 and 2666.05. Just as a § 1.8(b) remedy would be provided for the patent owner in the § 1.957(b) and (c) scenarios, it would also be provided for the requester in the § 1.957(a) scenario.

The above change would be directed to § 1.8.

5. The final rule *Rules of Practice Before the Board of Patent Appeals and Interferences* 69 FR 49960 (Aug. 12, 2004), 1286 *Off. Gaz. Pat. Office* 21 (Sept. 7, 2004) (final rule) revised the reexamination appeal rules to remove and reserve §§ 1.961 to 1.977. In addition, §§ 1.959, 1.979, 1.993 were revised and new §§ 41.60 through 41.81 were added. Revision of some of the reexamination rules referring to these sections was inadvertently not made. It is proposed to make those changes. Further, it is proposed that §§ 1.510(f) and 1.915(c) be revised to change § 1.34(a) to § 1.34, to update the sections to conform with the revision of § 1.34 made in final rule *Revision of Power of Attorney and Assignment Practice* 69 FR 29865 (May 26, 2004) (final rule).

It is further proposed that § 1.33(c) be revised to add ''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.'' These two sentences were inadvertently deleted from § 1.33(c) via the final rule *Changes to Representation*

of Others Before the United States Patent and Trademark Office, 69 FR 35428, 35452 (June 24, 2004) (final rule).

This aspect of the proposal involves §§ 1.33(c), 1.510(f), 1.915(c), 1.953(b), 1.983(a), and 1.991.

Section-by-Section Discussion

Section 1.1: It is proposed, pursuant to Proposal III, to amend § 1.1(c)(1) to provide for use of ''Mail Stop *Ex Parte* Reexam'' for the filing of all *ex parte* reexamination follow-on papers (not just *ex parte* reexamination requests), other than certain correspondence to the Office of the General Counsel. Section 1.1 would be amended by revising paragraph (c)(1) from its current reading ''Requests for *ex parte* reexamination (original request papers only) should be additionally marked 'Mail Stop *Ex Parte* Reexam' '' to read ''Requests for *ex parte* reexamination (original request papers) and all subsequent *ex parte* reexamination correspondence filed in the Office, other than correspondence to the Office of the General Counsel pursuant to § 1.1(a)(3) and § 1.302(c), should be additionally marked 'Mail Stop *Ex Parte* Reexam.' ''

Section 1.8: Section 1.8(b) is proposed to be amended, pursuant to Proposal IV, to recite ''In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the * * * Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence * * * or the prosecution of a reexamination proceeding is terminated pursuant to § 1.550(d) or § 1.957(b) or limited pursuant to § 1.957(c), or a requester paper is refused consideration pursuant to § 1.957(a), the correspondence will be considered timely if the party who forwarded such correspondence * * *.''

The language ''the prosecution of a reexamination proceeding is terminated'' (for §§ 1.550(d) and 1.957(b)) clarifies that the reexamination proceeding is not concluded under §§ 1.550(d) or 1.957(b), but rather, the prosecution of the reexamination is terminated.

The language ''or the prosecution of a reexamination proceeding is * * * limited pursuant to § 1.957(c)'' more appropriately sets forth that the § 1.8(b) remedy is applied to avoid the § 1.957(c) consequences of a patent owner failure to respond in an *inter partes* reexamination.

The language ''or a requester paper is refused consideration pursuant to § 1.957(a)'' more appropriately sets forth that the § 1.8(b) remedy is applied to avoid the § 1.957(a) consequences of a failure to file a requester paper in an *inter partes* reexamination.

Section 1.17: Sections 1.17(l) and (m) are proposed to be revised, pursuant to Proposal IV, to clarify that a reexamination proceeding is not concluded under §§ 1.550(d) or 1.957(b), but rather, the prosecution of a reexamination is terminated under §§ 1.550(d) or 1.957(b), or reexamination prosecution is limited under § 1.957(c). No change is being proposed as to the fee amounts.

Section 1.33: It is proposed that § 1.33(c) be revised, pursuant to Proposal III, to replace ''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 §§ 11.5 and 11.11 or, if no attorney or agent is of record, to the patent owner or owners at the address or addresses of record'' with ''correspondence address.'' As proposed to be revised, all notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the correspondence address for the patent. As previously discussed, a change to the correspondence address may be filed with the Office during the enforceable life of the patent. It is further proposed, pursuant to Proposal IV, that § 1.33(c) be revised to add ''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.''

Section 1.137: Sections 1.137(a), (b), and (e) are proposed to be amended, pursuant to Proposal IV, to more appropriately set forth the §§ 1.550(d) and 1.957(b) consequences of the patent owner's failure to make a required response. To do so, the introductory text of § 1.137(a) and § 1.137(b) is proposed to be revised to recite ''a reexamination prosecution becoming terminated under §§ 1.550(d) or 1.957(b)'' (emphasis added), rather than ''a reexamination proceeding becoming terminated under §§ 1.550(d) or 1.957(b)'' (emphasis added). In § 1.137(e), ''a concluded *ex parte* reexamination prosecution'' and ''a concluded *inter partes* reexamination prosecution'' is proposed to be inserted in place of ''a terminated *ex parte* reexamination proceeding'' and ''a terminated *inter partes* reexamination proceeding'', respectively.

Sections 1.137(a), (b) and (e) are proposed to be amended to clarify that the reexamination proceedings under § 1.957(c) referred to in §§ 1.137(b) and (c) are limited as to further prosecution; the prosecution is not terminated. To make this clarification, the introductory text portions of § 1.137(a) and § 1.137(b) are proposed to be revised to recite that the prosecution is ''limited under § 1.957(c),'' rather than ''terminated.'' Section 1.137(e) is proposed to be revised to also refer to ''revival'' of ''an *inter partes* reexamination limited as to further prosecution.''

Section 1.502: Section 1.502 is proposed to be amended, pursuant to Proposal IV, to state that the ''reexamination proceeding'' is ''concluded by the issuance and publication of a reexamination certificate.'' That is the point at which citations (having an entry right in the patent) which were filed after the order of *ex parte* reexamination will be placed in the patent file.

Section 1.510: It is proposed that § 1.510(b)(5) be revised, pursuant to Proposal I, as a conformatory change with respect to new § 1.512 discussed below. In order to provide the patent owner with a maximized amount of time to file a reply under § 1.512 to a third party request, the request must be served on the patent owner by facsimile transmission, personal service (courier) or overnight delivery, as opposed to first class mail. Accordingly, § 1.510(b)(5) would be revised to require that the request include a certification in accordance with § 1.248(b) by the third party requester that a copy of the request was served in its entirety on the patent owner at the address as provided for in § 1.33(c) by facsimile transmission, personal service (courier) or overnight. The name and address of the party served must be indicated. If service on the patent owner was not possible, then a duplicate copy must be supplied to the Office. A filing date will not be granted to the request until either the certification by the requester is received, or the Office serves the supplied duplicate copy on the patent owner.

It is further proposed that § 1.510(f) be revised, pursuant to Proposal IV, to change § 1.34(a) to § 1.34. This change would update the section to conform with the revision of § 1.34 made in *Revision of Power of Attorney and Assignment Practice* 69 FR 29865 (May 26, 2004) (final rule).

Section 1.512: Pursuant to Proposal I, it is proposed to provide new § 1.512 to provide for a patent owner reply to a request for an *ex parte* reexamination prior to the examiner's decision on the request.

Section 1.512(a) would permit a reply to a third party *ex parte* reexamination request under § 1.510 to be filed by the patent owner within thirty days from the date of service of the request on the patent owner. Since the statute requires that the decision on the request be issued within three months following the filing of a request for reexamination, this thirty-day period is not extendable. It is strongly encouraged that any patent owner reply to a request be faxed directly to the CRU to ensure receipt and matching with the reexamination proceeding prior to the examiner's decision on the request.

It is to be noted that this provision for patent owner reply to a request does not apply to Director ordered reexaminations and patent owner requested reexaminations. It does not apply to Director ordered reexaminations, since there is no request for reexamination. It does not apply to patent owner requested reexaminations, since the patent owner can place all of its comments in its request.

Section 1.512(a) would also require that any reply to a request by the patent owner must be served upon the third party requester in accordance with § 1.248. Service on the requester of all patent owner papers is required in a third party requested reexamination.

Section 1.512(b) would require (1) that the total reply to the request not exceed fifty total pages in length excluding evidence and reference materials such as prior art references, (2) that the form of the reply must be in accordance with the requirements of § 1.52, and (3) that the reply must not include any proposed amendment of the claims. Fifty pages is deemed a sufficient upper limit for the patent owner's rebuttal of the requester's case, and an excessive length would only delay the process. Section 1.512(b) would also require that the reply not include any proposed amendment of the claims. The determination on whether to order reexamination is made on the patent claims as they exist at the filing of the request; thus there is no need for an amendment at this point in the process, and again, an amendment would only delay the process.

Section 1.512(c) would provide that the reply will be considered only to the extent that it relates to the issues raised in the request for reexamination. Although a reply that does not solely relate to the issues raised in the request will not be returned to the patent owner, any portion of the reply that does not relate to the issues raised in the request will not be considered, and comments will not be provided by the Office as to what was not considered.

Section 1.512(c) would further provide for the returning or discarding of the reply papers, if the reply to the request: is not timely filed, fails to comply with § 1.512(b), or fails to include a certification that the reply was served upon the requester in accordance with § 1.248. In these instances, the reply will be returned to the patent owner or discarded (at the Office's option) without consideration. Further, there will be no opportunity to file a supplemental reply, given the time constraints discussed above.

Section 1.512(d) would provide that the third party requester may not file a paper responsive to the patent owner reply to the request, and that any such paper will be returned to the requester or discarded (at the Office's option) without consideration. There is no need for a further requester paper at this point, since, if reexamination is denied, third party requester will continue to have (pursuant to § 1.515(c)) the right to seek review by a petition under § 1.181 within one month of the mailing date of the examiner's determination refusing reexamination. At that point, the requester can address the patent owner reply to the request.

Section 1.515(a): Section 1.515(a) is proposed to be amended, pursuant to Proposal IV, as a conformatory change with respect to new § 1.512. Section 1.515(a) would be revised to state that the examiner will consider any patent owner reply under § 1.512 together with the request for reexamination, in determining whether to grant reexamination. The first sentence of § 1.515(a) would read: ''Within three months following the filing date of a request for an *ex parte* reexamination under § 1.510, an examiner will consider the request and any patent owner reply under § 1.512 and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised * * *.'' The bold shows the added text.

Section 1.530: Section 1.530(a) is proposed to be amended, pursuant to Proposal I as a conformatory change with respect to new § 1.512. Currently, § 1.530(a) provides: ''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.'' Since the patent owner would be permitted to file, prior to the determination made in accordance with § 1.515, a reply to a third party *ex parte* reexamination request under § 1.510 if proposed new § 1.512 is adopted, § 1.530(a) would be revised to provide: ''Unless otherwise authorized, no statement or other response by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515 or § 1.520.'' This ''unless otherwise authorized'' language is the same as is used in the *inter partes* reexamination analogous provision § 1.939. In addition, the disposition of the unauthorized paper would be explicitly set forth in the § 1.530(a), i.e., the paper will be returned or discarded at the Office's option.

Section 1.530(k) is proposed to be amended, pursuant to Proposal IV, to state that proposed amendments in *ex parte* or *inter partes* reexamination are not effective until the reexamination certificate is both ''issued and published'' (emphasis added) to conform § 1.530(k) with the language of 35 U.S.C. 307.

Section 1.550: Section 1.550(d) is proposed to be amended, pursuant to Proposal IV, to recite that ''[i]f the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 * * *'' (emphasis added.). This makes it clear that the patent owner's failure to timely file a required response (or interview statement) will result in the terminating of prosecution of the reexamination proceeding, but will not conclude the reexamination proceeding. It is to be noted that the prosecution will be a terminated prosecution as of the day after the response was due and not timely filed. In this instance, the NIRC will be subsequently issued; however, it will not be the instrument that operates to terminate the prosecution, since that will have already automatically occurred upon the failure to respond. Further, ''issued and published'' is used to conform § 1.550(d) with the language of 35 U.S.C. 307.

Section 1.565: Pursuant to Proposal IV, it is proposed that § 1.565(c) be amended to set forth that consolidated *ex parte* reexamination proceedings will result in the issuance and publication of a single certificate under § 1.570. As pointed out above, this tracks the

statutory language. It is further proposed that § 1.565(d) be amended to make it clear that the issuance of a reissue patent for a merged reissue-reexamination proceeding effects the conclusion of the reexamination proceeding. This is distinguished from the termination of the reexamination prosecution, as pointed out above. As a further technical change, it is proposed to change ''consolidated'' in § 1.565(c) to ''merged,'' for consistency with the terminology used in § 1.565(d). There is no difference in the meaning of the two terms, and the use of different terms in the two subsections is confusing. In addition, in § 1.565(d), it is proposed to replace ''normally'' with ''usually,'' as ''normally'' is deemed an inadvertent inappropriate choice of terminology. The same term (''usually'') would be added to § 1.565(c). It is to be noted that there are instances where the Office does not consolidate or merge an ongoing *ex parte* reexamination proceeding with a subsequent reexamination or reissue proceeding, which are addressed on a case-by-case basis. The following are examples. If the prosecution in an ongoing *ex parte* reexamination proceeding has terminated (*e.g.*, by the issuance of a Notice of Intent to Issue Reexamination Certificate), the *ex parte* reexamination proceedings will generally not be consolidated or merged with a subsequent reexamination or reissue proceeding. If an ongoing *ex parte* reexamination proceeding is ready for decision by the Board of Patent Appeals and Interferences, or is on appeal to the U.S. Court of Appeals for the Federal Circuit, it would be inefficient (and contrary to the statutory mandate for special dispatch) to ''pull back'' the ongoing *ex parte* reexamination proceeding for merger with a subsequent reexamination or reissue proceeding. As a final example, an ongoing *ex parte* reexamination proceeding might be directed to one set of claims for which a first accused infringer (with respect to the second set) has filed the ongoing request for reexamination. A later reexamination request might then be directed to a different set of claims for which a second accused infringer (with respect to the second set) has filed the request. In this instance, where there are simply no issues in common, merger would serve only to delay the resolution of the first proceeding, representing a harm to the reexamination system. If reexamination is to act as an effective alternative to litigation, the ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be reserved to the Office.

Section 1.570: Pursuant to Proposal IV, it is proposed that the heading of § 1.570 and § 1.570(a) be amended to make it clear that the issuance and publication of the *ex parte* reexamination certificate effects the conclusion of the reexamination proceeding. The failure to timely respond, or the issuance of the NIRC, do not conclude the reexamination proceeding. Section 1.570, paragraphs (b) and (d), would be amended to recite that the reexamination certificate is both issued and published for consistency with the language of 35 U.S.C. 307.

Section 1.902: Pursuant to Proposal IV, it is proposed to amend § 1.902 to state that the ''reexamination proceeding'' is ''concluded by the issuance and publication of a reexamination certificate.'' That is the point at which citations (having a right to entry in the patent) which were filed after the order of *inter partes* reexamination will be placed in the patent file.

Section 1.915: It is proposed that § 1.915(b)(6) be revised, pursuant to Proposal I, as a conformatory change with respect to new § 1.921 discussed below. In order to provide the patent owner with a maximized amount of time to file a reply under § 1.921 to the third party's request, the request must be served on the patent owner by facsimile transmission, personal service (courier) or overnight delivery, as opposed to first class mail. Accordingly, § 1.915(b)(6) would be revised to require that the request include a certification in accordance with § 1.248(b) by the third party requester that a copy of the request was served in its entirety on the patent owner at the address as provided for in § 1.33(c) by facsimile transmission, personal service (courier) or overnight. The name and address of the party served must be indicated. If service on the patent owner was not possible, then a duplicate copy must be supplied to the Office. A filing date will not be granted to the request until either the certification by the requester is received, or the Office serves the supplied duplicate copy on the patent owner.

Pursuant to Proposal IV, it is proposed that § 1.915(c) be revised to change § 1.34(a) to § 1.34. This change would update the section to conform with the revision of § 1.34 made in *Revision of Power of Attorney and Assignment Practice* 69 FR 29865 (May 26, 2004) (final rule).

Section 1.921: Pursuant to Proposal I, it is proposed to provide new § 1.921 to provide for a patent owner reply to a request for an *inter partes* reexamination prior to the examiner's decision on the request.

Section 1.921(a) would permit a reply to a third party *inter partes* reexamination request under § 1.915 to be filed by the patent owner within thirty days from the date of service of the request on the patent owner. Since the statute requires that the decision on the request be issued within three months following the filing of a request for reexamination, this thirty-day period is not extendable. It is strongly encouraged that any patent owner reply to a request be faxed directly to the CRU or hand-carried to the CRU, to ensure receipt and matching with the reexamination proceeding prior to the examiner's decision on the request.

It is to be noted that this provision for a patent owner reply to a request does not apply to Director ordered reexaminations and patent owner requested reexaminations, since there cannot be a Director ordered *inter partes* reexamination or a patent owner requested inter partes reexamination.

Section 1.921(a) would also require that any reply to a request by the patent owner must be served upon the third party requester in accordance with § 1.248. Service on the requester of all patent owner papers is required in any *inter partes* reexamination.

Section 1.921(b) would require (1) that the entire reply to the request not exceed 50 total pages in length excluding evidence and reference materials such as prior art references, (2) that the form of the reply must be in accordance with the requirements of § 1.52, and (3) that the reply must not include any proposed amendment of the claims. Fifty pages is deemed a sufficient upper limit for the patent owner's rebuttal of the requester's case, and an excessive length would only delay the process. Section 1.921(b) would also require that the reply not include any proposed amendment of the claims. The determination on whether to order reexamination is made on the patent claims as they exist at the filing of the request; thus there is no need for an amendment at this point in the process, and again, an amendment would only delay the process.

Section 1.921(c) would provide that the reply will be considered only to the extent that it relates to the issues raised in the request for reexamination. Although a reply that does not solely relate to the issues raised in the request will not be returned to the patent owner, any portion of the reply that does not relate to the issues raised in the request will not be considered, and comments

will not be provided by the Office as to what was not considered.

Section 1.921(c) would further provide for the returning or discarding of the reply papers if the reply to the request: Is not timely filed, fails to comply with § 1.921(b), or fails to include a certification that the reply was served upon the requester in accordance with § 1.248. In these instances, the reply will be returned to the patent owner or discarded (at the Office's option) without consideration. Further, there will be no opportunity to file a supplemental reply, given the time constraints discussed above.

Section 1.921(d) would provide that the third party requester may not file a paper responsive to the patent owner reply to the request, and that any such paper will be returned to the requester or discarded (at the Office's option) without consideration. There is no need for a further requester paper at this point, since, if reexamination is denied, the third party requester will continue to have (pursuant to § 1.927) the right to seek review by a petition under § 1.181 within one month of the mailing date of the examiner's determination refusing reexamination. At that point, the requester can address the patent owner reply to the request.

Section 1.923: Section 1.923 is proposed to be amended, pursuant to Proposal I, as a conformatory change with respect to new § 1.921. Section 1.923 would be revised to state that the examiner will consider any patent owner reply under § 1.921 together with the request for reexamination, in determining whether to grant reexamination. In addition, in the first sentence, ''§ 1.919'' would be changed to ''§ 1.915,'' since it is § 1.915 that provides for the request; § 1.919 provides for the filing date of the request.

Section 1.945: Currently, § 1.945 provides that ''[t]he 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.'' Pursuant to Proposal II, it is proposed that § 1.945 be revised to address the filing of a supplemental response to an Office action. As it is proposed to revise § 1.945, any supplemental response to an Office action would be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause would be required to provide: (1) A detailed explanation of how the requirements of § 1.111(a)(2)(i) are satisfied; (2) an explanation of why the supplemental response could not have been presented together with the original response to the Office action; and (3) a compelling reason to enter the supplemental response.

The decision on the sufficiency of the showing will not be issued until after receipt of requester comments under § 1.947 on the supplemental response, or the expiration of the 30-day period for requester comments (whichever comes first). The decision would be communicated to the parties either prior to, or with, the next Office action on the merits, as is deemed appropriate for the handling of the case.

A showing of sufficient cause will not be established by an explanation that the supplemental response is needed to address the requester's comments (on patent owner's response), and could not have been presented together with the original response because it was not known that requester would raise a particular point. The *inter partes* reexamination statute (35 U.S.C. 314) provides for the patent owner to respond to an Office action, and the requester to comment on that response. There is no intent in the statute to provide the patent owner with a chance to file a supplemental response to address the requester's comments.

It is pointed out that no corresponding rule revision is needed in *ex parte* reexamination, since there is no third party requester comment on a patent owner response (that a patent owner will wish to address), and § 1.111(a)(2) will adequately deal with patent owner supplemental responses.

Section 1.953: Revision is proposed pursuant to Proposal IV. Section 1.953(b) states ''Any appeal by the parties shall be conducted in accordance with §§ 1.959–1.983.'' This reference to §§ 1.959–1.983 is not correct, as some of the referenced rules have been deleted and others added. Instead of revising the incorrect reference, the entire sentence is proposed to be deleted as being out of place in § 1.953, which is not directed to the appeal process, but rather an Office action notifying parties of the right to appeal.

Section 1.953(c) is proposed to be amended, pursuant to Proposal IV, to state that if a notice of appeal is not timely filed after a Right of Appeal Notice, then ''prosecution in the *inter partes* reexamination proceeding will be terminated.'' This will not, however, conclude the reexamination proceeding.

The subheading preceding § 1.956 is proposed to be amended, pursuant to Proposal IV, to refer to termination of the prosecution of the reexamination, rather than the termination or conclusion of the reexamination proceeding, since that is what the sections which follow address. It is § 1.997 (Issuance of *Inter Partes* Reexamination Certificate) that deals with conclusion of the reexamination proceeding.

Section 1.957: Section 1.957(b) is proposed to be amended, pursuant to Proposal IV, to recite that ''[i]f no claims are found patentable, and the patent owner fails to file a timely and appropriate response * * *, the prosecution in the reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.997 * * *'' (Emphasis added). This makes it clear that the patent owner's failure to timely file a required response, where no claim has been found patentable, will result in the terminating of prosecution of the reexamination proceeding, but will not conclude the reexamination proceeding. As previously discussed for *ex parte* reexamination, the prosecution will be a terminated prosecution as of the day after the response was due and not timely filed. In this instance, the NIRC will be subsequently issued; however, it will not be the instrument that operates to terminate the prosecution, since that will have already automatically occurred upon the failure to respond. Also, ''issued and published'' is used to conform § 1.550(d) with the language of 35 U.S.C. 316.

Section 1.958: The heading of § 1.958 is proposed to be amended, pursuant to Proposal IV, to refer to the termination of prosecution of the reexamination, rather than the termination or conclusion of the reexamination proceeding, since that is what the rule addresses.

Section 1.979: Section 1.979(b) is proposed to be amended, pursuant to Proposal IV, to recite that ''[u]pon judgment in the appeal before the Board of Patent Appeals and Interferences, if no further appeal has been taken (§ 1.983), the prosecution in the *inter partes* reexamination proceeding will be terminated and the Director will issue and publish a certificate under § 1.997 concluding the proceeding.'' [Emphasis added]. This makes it clear that the termination of an appeal for an *inter partes* reexamination proceeding will result in a terminating of prosecution of the reexamination proceeding if no other appeal is present, but will not conclude the reexamination proceeding. Rather, it is the reexamination certificate under § 1.997 that concludes the reexamination proceeding.

In addition, the title of § 1.979 is proposed to be amended to add

''appeal'' before proceedings, and thus recite ''Return of Jurisdiction from the Board of Patent Appeals and Interferences; termination of appeal proceedings.'' This would make it clear that it is the appeal proceedings that are terminated; the reexamination proceeding is not terminated or concluded.

Section 1.983: In § 1.983(a), it is proposed, pursuant to Proposal IV, to change the incorrect reference to § 1.979(e) to the correct reference,— § 41.81.

Section 1.989: Pursuant to Proposal IV, it is proposed that § 1.989(a) be amended to set forth that consolidated (merged) reexamination proceedings containing an *inter partes* reexamination proceeding will result in the issuance and publication of a single certificate under § 1.570. As pointed out above, this tracks the statutory language.

Section 1.991: In § 1.991, it is proposed, pursuant to Proposal IV, to add ''and 41.60–41.81'' to ''§§ 1.902 through 1.997,'' since §§ 41.60–41.81 provide the requester with participation rights. It is further proposed that § 1.991 be amended to make it clear that the issuance of a reissue patent for a merged reissue-reexamination proceeding effects the conclusion of the reexamination proceeding. This is distinguished from the termination of the reexamination prosecution, as pointed out above.

Section 1.997: Both the heading of § 1.997 and § 1.997(a) are proposed to be amended, pursuant to Proposal IV, to make it clear that the issuance and publication of the *inter partes* reexamination certificate effects the conclusion of the reexamination proceeding. The failure to timely respond, or the issuance of the NIRC, does not conclude the reexamination proceeding. Section 1.997(a) is also proposed to be revised to make its language consistent with that of § 1.570(a). Section 1.997, paragraphs (b) and (d), are proposed to be amended to recite that the reexamination certificate is both issued and published, for consistency with the language of 35 U.S.C. 316.

Section 41.4: Paragraph (b) of § 41.4 is proposed to be amended, pursuant to Proposal IV, to (1) recite to ''a reexamination prosecution becoming terminated under §§ 1.550(d) or 1.957(b)'' rather than ''a reexamination proceeding becoming terminated under §§ 1.550(d) or 1.957(b),'' and (2) refer to the prosecution as being ''limited'' under § 1.957(c) rather than ''terminated'' under § 1.957(c). These changes track those made in § 1.137; see the discussion of § 1.137.

Rule Making Considerations

Regulatory Flexibility Act: For the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that the changes proposed in this notice will not have a significant economic impact on a substantial number of small entities. *See* 5 U.S.C. 605(b). The Office has issued between about 150,000 and 190,000 patents each year during the last five fiscal years. The Office receives fewer than 500 requests for *ex parte* reexamination each year, and fewer than 100 requests for *inter partes* reexamination each year. The principal impact of the changes in this proposed rule is to prohibit supplemental patent owner responses to an Office action in an *inter partes* reexamination without a showing of sufficient cause.

The change in this proposed rule to prohibit supplemental patent owner responses to an Office action in an *inter partes* reexamination without a showing of sufficient cause will not have a significant economic impact on a substantial number of small entities for two reasons. First, assuming that all patentees in an *inter partes* reexamination are small entities and that all would have submitted a supplemental response without sufficient cause, the proposed change would impact fewer than 100 small entity patentees each year. Second, there is no petition or other fee for the showing of sufficient cause that would be necessary under the proposed change for a supplemental patent owner's response to an Office action in an *inter partes* reexamination.

Therefore, the changes proposed in this notice will not have a significant economic impact on a substantial number of small entities.

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

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

Paperwork Reduction Act: This notice involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this notice have been reviewed and previously approved by OMB under OMB control numbers: 0651–0027, 0651–0031, 0651–0033, and 0651–0035. The United States Patent and Trademark Office is not resubmitting the other information collections listed above to OMB for its review and approval because the changes in this notice do not affect the information collection requirements associated with the information collections under these OMB control numbers. The principal impacts of the changes in this proposed rule are to: (1) Provide for a patent owner reply to a request for an *ex parte* reexamination or an *inter partes* reexamination prior to the examiner's decision on the request, (2) prohibit supplemental patent owner responses to an Office action in an *inter partes* reexamination without a showing of sufficient cause, (3) to designate the correspondence address for the patent as the correspondence address for all communications for patent owners in *ex parte* and *inter partes* reexaminations, and (4) to provide for the use of a single ''mail stop'' address for the filing of substantially all *ex parte* reexamination papers (as is already the case for *inter partes* reexamination papers).

Interested persons are requested to send comments to the Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10202, 725 17th Street, NW., Washington, DC 20503, Attention: Desk Officer for the Patent and Trademark Office; and (2) Robert J. Spar, Director, Office of Patent Legal Administration, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313–1450.

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

List of Subjects

37 CFR Part 1

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

37 CFR Part 41

Administrative practice and procedure, Inventions and patents, Lawyers.

For the reasons set forth in the preamble, 37 CFR parts 1 and 41 are proposed to be amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

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

Authority: 35 U.S.C. 2(b)(2), unless otherwise noted.

2. Section 1.1 is amended by revising paragraph (c)(1) to read as follows:

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

* * * * *

(c) * * *

(1) Requests for *ex parte* reexamination (original request papers) and all subsequent *ex parte* reexamination correspondence filed in the Office, other than correspondence to the Office of the General Counsel pursuant to § 1.1(a)(3) and § 1.302(c), should be additionally marked ''Mail Stop *Ex Parte* Reexam.''

* * * * *

3. Section 1.8 is amended by revising the introductory text of paragraph (b) to read as follows:

§ 1.8 Certificate of mailing or transmission.

* * * * *

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed or decided with prejudice, or the prosecution of a reexamination proceeding is terminated pursuant to § 1.550(d) or § 1.957(b) or limited pursuant to § 1.957(c), or a requester paper is refused consideration pursuant to § 1.957(a), the correspondence will be considered timely if the party who forwarded such correspondence:

* * * * *

4. Section 1.17 is amended by revising paragraphs (l) and (m) to read as follows:

§ 1.17 Patent application and reexamination processing fees.

* * * * *

(l) For filing a petition for the revival of an unavoidably abandoned application under 35 U.S.C. 111, 133, 364, or 371, for the unavoidably delayed payment of the issue fee under 35 U.S.C. 151, or for the revival of an unavoidably terminated or limited reexamination prosecution under 35 U.S.C. 133 (§ 1.137(a)):

By a small entity (§ 1.27(a))	$250.00
By other than a small entity	$500.00

(m) For filing a petition for the revival of an unintentionally abandoned application, for the unintentionally delayed payment of the fee for issuing a patent, or for the revival of an unintentionally terminated or limited reexamination prosecution under 35 U.S.C. 41(a)(7) (§ 1.137(b)):

By a small entity (§ 1.27(a))	$750.00
By other than a small entity	$1,500.00

* * * * *

5. Section 1.33 is amended by revising 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 correspondence address. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

* * * * *

6. Section 1.137 is amended by revising its heading, the introductory text of paragraph (a), the introductory text of paragraph (b), and paragraph (e) to read as follows:

§ 1.137 Revival of abandoned application, terminated reexamination prosecution, or lapsed patent.

(a) *Unavoidable.* If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

* * * * *

(b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

* * * * *

(e) *Request for reconsideration.* Any request for reconsideration or review of a decision refusing to revive an abandoned application, a terminated or limited reexamination prosecution, or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under:

(1) The provisions of § 1.136 for an abandoned application or lapsed patent;

(2) The provisions of § 1.550(c) for a terminated *ex parte* reexamination prosecution, where the *ex parte* reexamination was filed under § 1.510; or

(3) The provisions of § 1.956 for a terminated *inter partes* reexamination prosecution or an *inter partes* reexamination limited as to further prosecution, where the *inter partes* reexamination was filed under § 1.913.

* * * * *

7. Section 1.502 is revised to read as follows:

§ 1.502 Processing of prior art citations during an *ex parte* reexamination proceeding.

Citations by the patent owner under § 1.555 and by an ex parte reexamination requester under either § 1.510 or § 1.535 will be entered in the reexamination 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 an *ex parte* reexamination requester under either § 1.510 or § 1.535, will be delayed until the reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate. See § 1.902 for processing of prior art citations in patent and reexamination files during an *inter partes* reexamination proceeding filed under § 1.913.

8. Section 1.510 is amended by revising paragraphs (b)(5), and (f) to read as follows:

§ 1.510 Request for *ex parte* reexamination.

* * * * *

(b) * * *

(5) If the request was filed by a person other than the patent owner, a certification in accordance with § 1.248(b) by the requester that a copy

of the request has been served in its entirety on the patent owner at the address as provided for in § 1.33(c) by facsimile transmission, personal service (courier) or overnight delivery. 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. A filing date will not be granted to the request until the certification is received, or the Office serves the supplied duplicate copy on the patent owner.

* * * * *

(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.

9. A new § 1.512 is added to read as follows:

§ 1.512 Patent owner reply to third party request for *ex parte* reexamination.

(a) A reply to a third party *ex parte* reexamination request under § 1.510 may be filed by the patent owner within thirty days from the date of service of the request on the patent owner. This thirty-day period is not extendable. Any such reply to the request by the patent owner must be served upon the third party requester in accordance with § 1.248.

(b) The reply to the request must not exceed fifty pages in length excluding evidence and reference materials such as prior art references, must be in accordance with the requirements of § 1.52, and must not include any proposed amendment of the claims.

(c) The reply will be considered only to the extent that it relates to the issues raised in the request for reexamination. If a reply to the request is not timely filed, fails to comply with paragraph (b) of this section, or fails to include a certification that the reply was served upon the requester in accordance with § 1.248, the reply will be returned to the patent owner or discarded (at the Office's option) without consideration and without an opportunity to file a supplemental reply.

(d) The third party requester may not file a paper responsive to the patent owner reply to the request, and any such paper will be returned to the requester or discarded (at the Office's option) without consideration.

10. Section 1.515 is amended by revising paragraph (a) to read as follows:

§ 1.515 Determination of the request for *ex parte* reexamination.

(a) Within three months following the filing date of a request for an *ex parte* reexamination under § 1.510, an examiner will consider the request and any patent owner reply under § 1.512 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, 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 person requesting reexamination.

* * * * *

11. Section 1.530 is amended by revising paragraphs (a) and (k) to read as follows:

§ 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.

(a) Unless otherwise authorized, no statement or other response by the patent owner in an *ex parte* reexamination proceeding 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, and it will be returned or discarded (at the Office's option).

* * * * *

(k) *Amendments not effective until certificate.* Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued and published.

* * * * *

12. Section 1.550 is amended by revising paragraph (d) to read as follows:

§ 1.550 Conduct of *ex parte* reexamination proceedings.

* * * * *

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

* * * * *

13. Section 1.565 is amended by revising its paragraphs (c) and (d), to read as follows:

§ 1.565 Concurrent office proceedings which include an *ex parte* reexamination proceeding.

* * * * *

(c) If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will usually be merged and result in the issuance and publication of a single certificate under § 1.570. For merger of *inter partes* reexamination proceedings, see § 1.989(a). For merger of *ex parte* reexamination and *inter partes* reexamination proceedings, see § 1.989(b).

(d) If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will usually be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *ex parte* reexamination proceeding is ordered, the merged examination will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *ex parte* reexamination proceeding during the pendency of the merged proceeding. The examiner's actions and responses by the patent owner in a merged proceeding will apply to both the reissue application and the *ex parte* reexamination proceeding and will be physically entered into both files. Any *ex parte* reexamination proceeding merged with a reissue application shall be concluded by the grant of the reissued patent. For merger of a reissue application and an *inter partes* reexamination, see § 1.991.

* * * * *

14. Section 1.570 is amended by revising its heading and paragraphs (a), (b) and (d), to read as follows:

§ 1.570 Issuance and publication of *ex parte* reexamination certificate concludes *ex parte* reexamination proceeding.

(a) To conclude an *ex parte* reexamination proceeding, the Director will issue and publish an *ex parte* reexamination certificate in accordance with 35 U.S.C. 307 setting forth the results of the *ex parte* reexamination proceeding and the content of the patent following the *ex parte* reexamination proceeding.

(b) An *ex parte* reexamination certificate will be issued and published in each patent in which an *ex parte* reexamination proceeding has been ordered under § 1.525 and has not been merged with any *inter partes* reexamination proceeding pursuant to § 1.989(a). Any statutory disclaimer filed by the patent owner will be made part of the *ex parte* reexamination certificate.

* * * * *

(d) If an *ex parte* reexamination certificate has been issued and published which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

* * * * *

15. Section 1.902 is revised to read as follows:

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

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

16. Section 1.915 is amended by revising paragraphs (b)(6) and (c) as follows:

§ 1.915 Content of request for *inter partes* reexamination.

* * * * *

(b) * * *

(6) A certification in accordance with § 1.248(b) by the third party requester that a copy of the request has been served in its entirety on the patent owner at the address as provided for in § 1.33(c) by facsimile transmission, personal service (courier) or overnight delivery. 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. A filing date will not be granted to the request until the certification is received, or the Office serves the supplied duplicate copy on the patent owner.

* * * * *

(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.

* * * * *

17. A new § 1.921 is added to read as follows:

§ 1.921 Patent owner reply to third party request for *inter partes* reexamination.

(a) A reply to a third party *inter partes* reexamination request under § 1.915 may be filed by the patent owner within thirty days from the date of service of the request on the patent owner. This thirty-day period is not extendable. Any such reply to the request by the patent owner must be served upon the third party requester in accordance with § 1.248.

(b) The reply to the request must not exceed fifty pages in length excluding evidence and reference materials such as prior art references, must be in accordance with the requirements of § 1.52, and must not include any proposed amendment of the claims.

(c) The reply will be considered only to the extent that it relates to the issues raised in the request for reexamination. If a reply to the request is not timely filed, fails to comply with paragraph (b) of this section, or fails to include a certification that the reply was served upon the requester in accordance with § 1.248, the reply will be returned to the patent owner or discarded (at the Office's option) without consideration and without an opportunity to file a supplemental reply.

(d) The third party requester may not file a paper responsive to the patent owner reply to the request, and any such paper will be returned to the requester or discarded (at the Office's option) without consideration.

18. Section 1.923 is revised to read as follows:

§ 1.923 Examiner's determination on the request for *inter partes* reexamination.

Within three months following the filing date of a request for *inter partes* reexamination under § 1.915, the examiner will consider the request and any patent owner reply under § 1.921 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.

19. Section 1.945 is revised to read as follows:

§ 1.945 Response to Office action by patent owner in *inter partes* reexamination.

(a) The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

(b) Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

(1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;

(2) An explanation of why the supplemental response could not have been presented together with the original response to the Office action; and

(3) A compelling reason to enter the supplemental response.

20. Section 1.953 is amended by revising paragraphs (b) and (c) to read as follows:

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

* * * * *

(b) Expedited Right of Appeal Notice: At any time after the patent owner's response to the initial Office action on the merits in an *inter partes* reexamination, the patent owner and all third party requesters may stipulate that the issues are appropriate for a final action, which would include a final rejection and/or a final determination favorable to patentability, and may request the issuance of a Right of Appeal Notice. The request must have the concurrence of the patent owner and all third party requesters present in the proceeding and must identify all of the appealable issues and the positions of the patent owner and all third party requesters on those issues. If the examiner determines that no other issues are present or should be raised, a Right of Appeal Notice limited to the identified issues shall be issued.

(c) The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision

favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, prosecution in the *inter partes* reexamination proceeding will be terminated, and the Director will proceed to issue and publish a certificate under § 1.997 in accordance with the Right of Appeal Notice.

21. The undesignated center heading immediately preceding § 1.956 is revised to read as follows:

Extensions of Time, Terminating of Reexamination Prosecution, and Petitions to Revive in *Inter Partes* Reexamination

22. Section 1.957 is amended by revising paragraph (b) to read as follows:

§ 1.957 Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.

* * * * *

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

* * * * *

23. Section 1.958 is amended by revising its heading to read as follows:

§ 1.958 Petition to revive *inter partes* reexamination prosecution terminated for lack of patent owner response.

* * * * *

24. Section 1.979 is amended by revising its heading and paragraph (b) to read as follows:

§ 1.979 Return of Jurisdiction from the Board of Patent Appeals and Interferences; termination of appeal proceedings.

* * * * *

(b) Upon judgment in the appeal before the Board of Patent Appeals and Interferences, if no further appeal has been taken (§ 1.983), the prosecution in the *inter partes* reexamination proceeding will be terminated and the Director will issue and publish a certificate under § 1.997 concluding the proceeding. If an appeal to the U.S. Court of Appeals for the Federal Circuit has been filed, that appeal is considered terminated when the mandate is issued by the Court.

25. Section 1.983 is amended by revising paragraph (a) to read as follows:

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

(a) The patent owner or third party requester in an *inter partes* reexamination proceeding who is a party to an appeal to the Board of Patent Appeals and Interferences and who is dissatisfied with the decision of the Board of Patent Appeals and Interferences may, subject to § 41.81, appeal to the U.S. Court of Appeals for the Federal Circuit and may be a party to any appeal thereto taken from a reexamination decision of the Board of Patent Appeals and Interferences.

* * * * *

26. Section 1.989 is amended by revising paragraph (a) to read as follows:

§ 1.989 Merger of concurrent reexamination proceedings.

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

* * * * *

27. Section 1.991 is revised to read as follows:

§ 1.991 Merger of concurrent reissue application and *inter partes* reexamination proceeding.

If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 through 1.997 and 41.60–41.81, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files. Any *inter partes* reexamination proceeding merged with a reissue application shall be concluded by the grant of the reissued patent.

28. Section 1.997 is amended by revising its heading and paragraphs (a), (b), and (d) to read as follows:

§ 1.997 Issuance and publication of *inter partes* reexamination certificate concludes inter partes reexamination proceeding.

(a) To conclude an *inter partes* reexamination proceeding, the Director will issue and publish an *inter partes* reexamination certificate in accordance with 35 U.S.C. 316 setting forth the results of the *inter partes* reexamination proceeding and the content of the patent following the *inter partes* reexamination proceeding.

(b) A certificate will be issued and published in each patent in which an *inter partes* reexamination proceeding has been ordered under § 1.931. Any statutory disclaimer filed by the patent owner will be made part of the certificate.

* * * * *

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

* * * * *

PART 41—PRACTICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

29. The authority citation for 37 CFR part 41 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), 3(a)(2)(A), 21, 23, 32, 41, 134, 135.

30. Section 41.4 is amended by revising paragraph (b) to read as follows:

§ 41.4 Timeliness.

* * * * *

(b) *Late filings.*

(1) A late filing that results in either an application becoming abandoned or a reexamination prosecution becoming terminated under §§ 1.550(d) or 1.957(b) of this title or limited under § 1.957(c) of this title may be revived as set forth in § 1.137 of this title.

(2) A late filing that does not result in either an application becoming abandoned or a reexamination prosecution becoming terminated under §§ 1.550(d) or 1.957(b) of this title or

limited under § 1.957(c) of this title will be excused upon a showing of excusable neglect or a Board determination that consideration on the merits would be in the interest of justice.

* * * * *

Dated: March 22, 2006.

Jon W. Dudas,

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

[FR Doc. 06–2962 Filed 3–29–06; 8:45 am]

BILLING CODE 3510–16–P

ENVIRONMENTAL PROTECTION AGENCY

40 CFR Part 52

[EPA–R07–OAR–2005–0482; FRL–8050–1]

Approval and Promulgation of Implementation Plans; State of Iowa

AGENCY: Environmental Protection Agency (EPA).

ACTION: Proposed rule.

SUMMARY: EPA proposes to approve a revision to the State Implementation Plan (SIP) submitted by the state of Iowa. The purpose of this revision is to approve the 2005 update to the Polk County Board of Health Rules and Regulations, Chapter V, Air Pollution. These revisions will help to ensure consistency between the applicable local agency rules and Federally-approved rules, and ensure Federal enforceability of the applicable parts of the local agency air programs.

DATES: Comments on this proposed action must be received in writing by May 1, 2006.

ADDRESSES: Submit your comments, identified by Docket ID No. EPA–R07–OAR–2005–0482 by one of the following methods:

1. *http://www.regulations.gov:* Follow the on-line instructions for submitting comments.

2. *E-mail: Hamilton.heather@epa.gov*.

3. *Mail:* Heather Hamilton, Environmental Protection Agency, Air Planning and Development Branch, 901 North 5th Street, Kansas City, Kansas 66101.

4. *Hand Delivery or Courier:* Deliver your comments to: Heather Hamilton, Environmental Protection Agency, Air Planning and Development Branch, 901 North 5th Street, Kansas City, Kansas 66101. Such deliveries are only accepted during the Regional Office's normal hours of operation. The Regional Office's official hours of business are Monday through Friday, 8 a.m. to 4:30 p.m., excluding legal holidays.

Please see the direct final rule that is located in the Rules section of this **Federal Register** for detailed instructions on how to submit comments.

FOR FURTHER INFORMATION CONTACT: Heather Hamilton at (913) 551–7039, or by e-mail at *hamilton.heather@epa.gov*.

SUPPLEMENTARY INFORMATION: In the final rules section of the **Federal Register**, EPA is approving the state's SIP revision as a direct final rule without prior proposal because the Agency views this as a noncontroversial revision amendment and anticipates no relevant adverse comments to this action. A detailed rationale for the approval is set forth in the direct final rule. If no relevant adverse comments are received in response to this action, no further activity is contemplated in relation to this action. If EPA receives relevant adverse comments, the direct final rule will be withdrawn and all public comments received will be addressed in a subsequent final rule based on this proposed action. EPA will not institute a second comment period on this action. Any parties interested in commenting on this action should do so at this time. Please note that if EPA receives adverse comment on part of this rule and if that part can be severed from the remainder of the rule, EPA may adopt as final those parts of the rule that are not the subject of an adverse comment. For additional information, see the direct final rule that is located in the rules section of this **Federal Register**.

Dated: March 13, 2006.

James B. Gulliford,

Regional Administrator, Region 7.

[FR Doc. 06–3033 Filed 3–29–06; 8:45 am]

BILLING CODE 6560–50–P

ENVIRONMENTAL PROTECTION AGENCY

40 CFR Part 52

[EPA–R07–OAR–2006–0122; FRL–8050–3]

Approval and Promulgation of Implementation Plans; Iowa; Prevention of Significant Deterioration (PSD)

AGENCY: Environmental Protection Agency (EPA).

ACTION: Proposed rule.

SUMMARY: EPA proposes to approve a revision to the Code of Federal Regulations (CFR) for the purpose of giving the Iowa Department of Natural Resources (IDNR) full regulatory responsibility for EPA-issued Prevention of Significant Deterioration (PSD) permits. IDNR demonstrated state legislative authority to take responsibility for the permits, and demonstrated that resources are available to accomplish full regulatory responsibility.

DATES: Comments on this proposed action must be received in writing by May 1, 2006.

ADDRESSES: Submit your comments, identified by Docket ID No. EPA–R07–OAR–2006–0122 by one of the following methods:

1. *http://www.regulations.gov:* Follow the on-line instructions for submitting comments.

2. E-mail: *Hamilton.heather@epa.gov.*

3. Mail: Heather Hamilton, Environmental Protection Agency, Air Planning and Development Branch, 901 North 5th Street, Kansas City, Kansas 66101.

4. Hand Delivery or Courier: Deliver your comments to: Heather Hamilton, Environmental Protection Agency, Air Planning and Development Branch, 901 North 5th Street, Kansas City, Kansas 66101. Such deliveries are only accepted during the Regional Office's normal hours of operation. The Regional Office's official hours of business are Monday through Friday, 8 a.m. to 4:30 p.m., excluding legal holidays.

Please see the direct final rule which is located in the Rules section of this **Federal Register** for detailed instructions on how to submit comments.

FOR FURTHER INFORMATION CONTACT: Heather Hamilton at (913) 551–7039, or by e-mail at *Hamilton.heather@epa.gov.*

SUPPLEMENTARY INFORMATION: In the final rules section of the **Federal Register**, EPA is approving the state's submittal as a direct final rule without prior proposal because the Agency views this as a noncontroversial revision amendment and anticipates no relevant adverse comments to this action. A detailed rationale for the approval is set forth in the direct final rule. If no relevant adverse comments are received in response to this action, no further activity is contemplated in relation to this action. If EPA receives relevant adverse comments, the direct final rule will be withdrawn and all public comments received will be addressed in a subsequent final rule based on this proposed action. EPA will not institute a second comment period on this action. Any parties interested in commenting on this action should do so at this time. Please note that if EPA receives adverse comment on part of this rule and if that part can be severed