

§ 1.501

37 CFR Ch. I (7–1–02 Edition)

**Subpart D—Ex Parte
Reexamination of Patents**

SOURCE: 46 FR 29185, May 29, 1981, unless otherwise noted.

CITATION OF PRIOR ART

§ 1.501 Citation of prior art in patent files.

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

(b) If the person making the citation wishes his or her identity to be excluded from the patent file and kept confidential, the citation papers must be submitted without any identification of the person making the submission.

(c) Citation of patents or printed publications by the public in patent files should either:

(1) Reflect that a copy of the same has been mailed to the patent owner at the address as provided for in § 1.33(c); or in the event service is not possible

(2) Be filed with the Office in duplicate.

[46 FR 29185, May 29, 1981, as amended at 65 FR 76774, Dec. 7, 2000]

§ 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 terminated. See § 1.902 for processing of prior art citations in patent and reexamination files during an *inter partes* reexamination proceeding filed under § 1.913.

[65 FR 76774, Dec. 7, 2000]

REQUEST FOR *Ex Parte* REEXAMINATION

§ 1.510 Request for *ex parte* reexamination.

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

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

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

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

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

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

(5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served

must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.

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

(d) The filing date of the request is:

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

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

(e) A request filed by the patent owner may include a proposed amendment in accordance with §1.530.

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

(35 U.S.C. 6; 15 U.S.C. 1113, 1123)

[46 FR 29185, May 29, 1981, as amended at 47 FR 41282, Sept. 17, 1982; 62 FR 53200, Oct. 10, 1997; 65 FR 54678, Sept. 8, 2000; 65 FR 76775, Dec 7, 2000]

§ 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, an examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art cited therein, with or without consideration of other patents or printed publications. The

examiner's determination will be based on the claims in effect at the time of the determination, 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.

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

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

[65 FR 76775, Dec. 7, 2000]

§ 1.520 *Ex parte* reexamination at the initiative of the Commissioner.

The Commissioner, at any time during the period of enforceability of a patent, may determine whether or not a substantial new question of patentability is raised by patents or printed publications which have been discovered by the Commissioner or which have been brought to the Commissioner's attention, even though no request for reexamination has been filed in accordance with §1.510 or §1.913. The Commissioner may initiate *ex parte* reexamination without a request for reexamination pursuant to §1.510 or §1.913. Normally requests from outside the Office that the Commissioner undertake reexamination on his own initiative will not be considered. Any determination to initiate *ex parte* reexamination under this section 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).

[65 FR 76775, Dec. 7, 2000]