

proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, the *inter partes* reexamination proceeding will be terminated, and the Commissioner will proceed to issue a certificate under §1.997 in accordance with the Right of Appeal Notice.

INTERVIEWS PROHIBITED IN *Inter Partes*  
REEXAMINATION

**§1.955 Interviews prohibited in *inter partes* reexamination proceedings.**

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

EXTENSIONS OF TIME, TERMINATION OF  
PROCEEDINGS, AND PETITIONS TO RE-  
VIVE IN *Inter Partes* REEXAMINATION

**§1.956 Patent owner extensions of time in *inter partes* reexamination.**

The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. See §1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.

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

(a) If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an *inter partes* reexamination, the paper will be refused consideration.

(b) If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the reexamination proceeding will be terminated and the Commissioner will

proceed to issue a certificate under §1.997 in accordance with the last action of the Office.

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

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

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

(a) If a response by the patent owner is not timely filed in the Office, the delay in filing such response may be excused if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A grantable petition to accept an unavoidably delayed response must be filed in compliance with §1.137(a).

(b) Any response by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed response must be filed in compliance with §1.137(b).

APPEAL TO THE BOARD OF PATENT AP-  
PEALS AND INTERFERENCES IN *Inter*  
*Partes* REEXAMINATION

**§1.959 Notice of appeal and cross appeal to Board of Patent Appeals and Interferences in *inter partes* reexamination.**

(a)(1) Upon the issuance of a Right of Appeal Notice under §1.953, the patent owner involved in an *inter partes* reexamination proceeding may appeal to

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the Board of Patent Appeals and Interferences with respect to the final rejection of any claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 1.17(b).

(2) Upon the issuance of a Right of Appeal Notice under § 1.953, a third party requester involved in an *inter partes* reexamination proceeding may appeal to the Board of Patent Appeals and Interferences with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 1.17(b).

(b)(1) Within fourteen days of service of a third party requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 1.17(b), a patent owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of a patent owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 1.17(b), a third party requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(c) The notice of appeal or cross appeal in an *inter partes* reexamination proceeding must identify the appealed claim(s) and must be signed by the patent owner, the third party requester, or their duly authorized attorney or agent.

(d) An appeal or cross appeal, when taken, must be taken from all the rejections of the claims in a Right of Appeal Notice which the patent owner proposes to contest or from all the determinations favorable to patentability, including any final determination not to make a proposed rejection, in a Right of Appeal Notice which a third party requester proposes to contest. Questions relating to matters not

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affecting the merits of the invention may be required to be settled before an appeal is decided.

(e) The times for filing a notice of appeal or cross appeal may not be extended.

### § 1.961 Jurisdiction over appeal in *inter partes* reexamination.

Jurisdiction over the *inter partes* reexamination proceeding passes to the Board of Patent Appeals and Interferences upon transmittal of the file, including all briefs and examiner's answers, to the Board of Patent Appeals and Interferences. Prior to the entry of a decision on the appeal, the Commissioner may *sua sponte* order the *inter partes* reexamination proceeding remanded to the examiner for action consistent with the Commissioner's order.

### § 1.962 Appellant and respondent in *inter partes* reexamination defined.

For the purposes of *inter partes* reexamination, appellant is any party, whether the patent owner or a third party requester, filing a notice of appeal or cross appeal. If more than one party appeals or cross appeals, each appealing or cross appealing party is an appellant with respect to the claims to which his or her appeal or cross appeal is directed. A respondent is any third party requester responding under § 1.967 to the appellant's brief of the patent owner, or the patent owner responding under § 1.967 to the appellant's brief of any third party requester. No third party requester may be a respondent to the appellant brief of any other third party requester.

### § 1.963 Time for filing briefs in *inter partes* reexamination.

(a) An appellant's brief in an *inter partes* reexamination must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the *inter partes* reexamination is entitled to file an appeal or cross appeal but fails to timely do so, the expiration of time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief may not be extended.

(b) Once an appellant's brief has been properly filed, any brief must be filed