

oral hearing unless he or she has requested an oral hearing and submitted the fee set forth in § 1.17(d).

(e) If no request and fee for oral hearing have been timely filed by an appellant or a respondent, the appeal will be assigned for consideration and decision on the written record.

§ 1.975 Affidavits or declarations after appeal in *inter partes* reexamination.

Affidavits, declarations, or exhibits submitted after the *inter partes* reexamination has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.

§ 1.977 Decision by the Board of Patent Appeals and Interferences; remand to examiner in *inter partes* reexamination.

(a) The Board of Patent Appeals and Interferences, in its decision, may affirm or reverse each decision of the examiner on all issues raised on each appealed claim, or remand the reexamination proceeding to the examiner for further consideration. The reversal of the examiner's determination not to make a rejection proposed by the third party requester constitutes a decision adverse to the patentability of the claims which are subject to that proposed rejection which will be set forth in the decision of the Board of Patent Appeals and Interferences as a new ground of rejection under paragraph (b) of this section. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.

(b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds not raised in the appeal for rejecting any pending claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement shall constitute a new ground of rejection of the claim. A decision which includes a new ground of rejection shall not be considered final for purposes of judicial review. When the Board of Patent Appeals and Interferences makes a new ground of rejection, the patent owner, within one month from the date of the decision,

must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal proceeding as to the rejected claim:

(1) The patent owner may submit an appropriate amendment of the claim so rejected or a showing of facts relating to the claim, or both.

(2) The patent owner may file a request for rehearing of the decision of the Board of Patent Appeals and Interferences under § 1.979(a).

(c) Where the patent owner has responded under paragraph (b)(1) of this section, any third party requester, within one month of the date of service of the patent owner response, may once file comments on the response. Such written comments must be limited to the issues raised by the decision of the Board of Patent Appeals and Interferences and the patent owner's response. Any third party requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 1.17(b) and (c), respectively, which must accompany the comments or reply.

(d) Following any response by the patent owner under paragraph (b)(1) of this section and any written comments from a third party requester under paragraph (c) of this section, the reexamination proceeding will be remanded to the examiner. The statement of the Board of Patent Appeals and Interferences shall be binding upon the examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the examiner, overcomes the new ground of rejection. The examiner will consider any response under paragraph (b)(1) of this section and any written comments by a third party requester under paragraph (c) of this section and issue a determination that the rejection should be maintained or has been overcome.

(e) Within one month of the examiner's determination pursuant to paragraph (d) of this section, the patent owner or any third party requester may once submit comments in response to the examiner's determination. Within one month of the date of service of comments in response to the