the Small Business and Agriculture Regulatory Enforcement Ombudsman and the Regional Small Business Regulatory Fairness Boards. The Ombudsman evaluates these actions annually and rates each agency's responsiveness to small business. If you wish to comment on actions by employees of the Coast Guard, call 1–888–REG–FAIR (1–888–743–3247).

Collection of Information

This rule calls for no new collection of information under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501–3520).

Federalism

A rule has implications for federalism under Executive Order 13132, Federalism, if it has a substantial direct effect on State or local governments and would either preempt State law or impose a substantial direct cost of compliance on them. We have analyzed this rule under that Order and have determined that this rule does not have implications for federalism.

Unfunded Mandates Reform Act

The Unfunded Mandates Reform Act of 1995 (2 U.S.C. 1531–1538) requires Federal agencies to assess the effects of their discretionary regulatory actions. In particular, the Act addresses actions that may result in the expenditure by a State, local or tribal government, in the aggregate, or by the private sector of $100,000,000 or more in any one year. Though this rule will not result in such expenditure, we do discuss the effects of this rule elsewhere in this preamble.

Taking of Private Property

This rule will not affect a taking of private property or otherwise have taking implications under Executive Order 12630, Governmental Actions and Interference with Constitutionally Protected Property Rights.

Civil Justice Reform

This rule meets applicable standards in sections 3(a) and 3(b)(2) of Executive Order 12988, Civil Justice Reform, to minimize litigation, eliminate ambiguity, and reduce burden.

Protection of Children

We have analyzed this rule under Executive Order 13045, Protection of Children from Environmental Health Risks and Safety Risks. This rule is not an economically significant rule and does not concern an environmental risk to health or risk to safety that may disproportionately affect children.

Indian Tribal Governments

This rule does not have tribal implications under Executive Order 13175, Consultation and Coordination with Indian Tribal Governments, because it does not have a substantial direct effect on one or more Indian tribes, on the relationship between the Federal Government and Indian tribes, or on the distribution of power and responsibilities between the Federal Government and Indian tribes.

Energy Effects

We have analyzed this rule under Executive Order 13211, Actions Concerning Regulations That Significantly Affect Energy Supply, Distribution, or Use. We have determined that it is not a ''significant energy action'' under that order because it is not a ''significant regulatory action'' under Executive Order 12866 and is not likely to have a significant adverse effect on the supply, distribution, or use of energy. It has not been designated by the Administrator of the Office of Information and Regulatory Affairs as a significant energy action. Therefore, it does not require a Statement of Energy Effects under Executive Order 13211.

Environment

We have considered the environmental impact of temporarily restricting the usage of Anchorage 5 and concluded under figure 2–1, paragraph (34)(f), of Commandant Instruction M16475.lD, that this rule is categorically excluded from further environmental documentation.

List of Subjects in 33 CFR Part 110

Anchorage grounds.

■ For the reasons discussed in the preamble, the Coast Guard amends 33 CFR part 110 as follows:

PART 110—ANCHORAGE REGULATIONS

■ 1. The authority citation for part 110 continues to read as follows:

Authority: 33 U.S.C. 471, 1221 through 1236, 2030, 2035 and 2071; 33 CFR 1.05–1(g). Department of Homeland Security Delegation No. 0170.1.

■ 2. From December 9, 2003, until December 31, 2003, add temporary § 110.157(b)(12) to read:

§ 110.157 Delaware Bay and River.

* * * * *

(b) * * *

(12) All vessels desiring to use Anchorage 5 southeast of Pea Patch Island must obtain permission from the Captain of the Port 24 hours prior to anchoring. The Captain of the Port means the Commanding Officer of the Coast Guard Marine Safety Office/Group Philadelphia or any Coast Guard commissioned, warrant or petty officer who has been authorized by the Captain of the Port to act on his behalf. The Captain of the Port may be contacted by telephone at (215) 271–4807 or via channels 13 and 16 on VHF marine band radio.

* * * * *

Dated: December 9, 2003.

Sally Brice-O'Hara,

Rear Admiral, Coast Guard, Commander, Fifth Coast Guard District.

[FR Doc. 03–31391 Filed 12–19–03; 8:45 am]

BILLING CODE 4910–15–P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No.: 2003–P–001]

RIN 0651–AB57

Changes to Implement the 2002 *Inter Partes* Reexamination and Other Technical Amendments to the Patent Statute

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The 21st Century Department of Justice Appropriations Authorization Act contains a title relating to intellectual property. The patent-related provisions in the intellectual property title of the 21st Century Department of Justice Appropriations Authorization Act include provisions permitting a third party requester in an *inter partes* reexamination proceeding to appeal a final decision by the Board of Patent Appeals and Interferences (BPAI) to the U.S. Court of Appeals for the Federal Circuit (Federal Circuit), and to participate in the patent owner's appeal of a final decision by the BPAI to the Federal Circuit. The patent-related provisions of the 21st Century Department of Justice Appropriations Authorization Act also include technical amendments to the provisions directed to *inter partes* reexamination, 18-month publication of patent applications and provisional rights, and issuance of patents. The United States Patent and Trademark Office (Office) is revising the rules of practice to implement the patent-related provisions of the 21st Century Department of Justice Appropriations Authorization Act, and other miscellaneous changes

related to appeals in reexamination proceedings.

EFFECTIVE DATE: January 21, 2004.

FOR FURTHER INFORMATION CONTACT: Kenneth M. Schor or Gerald A. Dost, Senior Legal Advisors. Kenneth M. Schor may be contacted by telephone at (703) 308–6710; 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 (703) 872–9408, marked to the attention of Kenneth M. Schor; or by electronic mail message over the Internet addressed to *kenneth.schor@uspto.gov.* Gerald A. Dost may be contacted by telephone at (703) 305–8610; 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 Gerald A. Dost; by facsimile transmission to (703) 308–6916, marked to the attention of Gerald A. Dost; or by electronic mail message over the Internet addressed to *gerald.dost@uspto.gov.*

SUPPLEMENTARY INFORMATION: The American Inventors Protection Act of 1999 (AIPA), enacted on November 29, 1999, contained a number of changes to title 35, United States Code (U.S.C.). *See* Pub. L. 106–113, 113 Stat. 1501, 1501A–552 through 1501A–591 (1999). The 21st Century Department of Justice Appropriations Authorization Act, enacted on November 2, 2002, contained technical corrections to the AIPA, as well as other technical amendments to title 35, U.S.C. *See* Pub. L. 107–273, 116 Stat. 1758, 1899–1906 (2002). This final rule revises the rules of practice in title 37 CFR to implement the patent-related provisions of the 21st Century Department of Justice Appropriations Authorization Act (and other related miscellaneous changes).

I. *Third Party Requester Appeal Rights to United States Court of Appeals for the Federal Circuit:* Optional *inter partes* reexamination was newly enacted in the AIPA. The AIPA provided that the patent owner in an *inter partes* reexamination could appeal a decision of the BPAI (adverse to patent owner) to the Federal Circuit. The third party requester of the *inter partes* reexamination, however, was specifically precluded from appealing a decision of the BPAI to the Federal Circuit. *See* 35 U.S.C. 134(c) as amended by the AIPA, 113 Stat. at 1501A–571. In addition, the AIPA did not permit the third party requester to be a party to (*i.e.*, participate in) an appeal taken by the patent owner to the Federal Circuit.

The Office published a final rule in December of 2000 revising the rules of practice in patent cases to implement the optional *inter partes* reexamination provisions of the AIPA. *See Rules to Implement Optional Inter Partes Reexamination Proceedings,* 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule). Section 1.983 is promulgated to codify in the rules of practice the patent owner's statutory right, under 35 U.S.C. 141, to appeal to the Federal Circuit in *inter partes* reexamination proceedings. Because the third-party requester of an *inter partes* reexamination was previously expressly precluded under 35 U.S.C. 134(c) (as amended by the AIPA) from appealing the decision of the BPAI to the Federal Circuit, the rules of practice did not previously provide for such an appeal. Likewise, because there was no authority in the statute for the third party requester to participate in an appeal taken by the patent owner to the Federal Circuit, no such provision of the rules was provided. Finally, because the third-party requester of an *inter partes* reexamination was precluded under 35 U.S.C. 134(c) (as amended by the AIPA) from appealing the decision of the BPAI to the Federal Circuit, no provision in the rules concerning patent owner participation in a third-party requester appeal was provided.

Section 13106 of Public Law 107–273 now grants the *inter partes* reexamination third party requester the right to appeal an adverse decision of the BPAI to the Federal Circuit. *See* 35 U.S.C. 315(b)(1). It further authorizes the third party requester to be a party to any appeal taken by the patent owner to the Federal Circuit. *See* 35 U.S.C. 315(b)(2). Moreover, section 13106 of Public Law 107–273 also permits the patent owner to be a party to an appeal taken by the third party requester to the Federal Circuit. This is so because 35 U.S.C. 315(a)(2) as enacted by the AIPA states that the patent owner involved in an *inter partes* reexamination proceeding ''may be a party to any appeal taken by a third-party requester under subsection (b).'' Therefore, the Office is revising § 1.983 to implement this statutory revision, and making conforming or ancillary amendments to §§ 1.301, 1.304, and 1.979.

II. *Technical amendments to the inter partes reexamination provisions of the American Inventors Protection Act of 1999:* Section 13202 of Public Law 107–273 made technical corrections to statutory provisions directed to *inter partes* and *ex parte* reexamination. The Office is revising §§ 1.191, 1.303, and 1.913 to address the *inter partes* and *ex parte* reexamination technical corrections.

III. *Other miscellaneous changes made to reexamination proceedings:* Additionally, the Office is revising the *inter partes* reexamination rules to avoid the loss of appeal rights during appeals to the BPAI due to certain inadvertent errors on the part of the patent owner or third party requester. Further, the Office is revising the *inter partes* and *ex parte* reexamination appeal rules generally for clarity. These revisions are made in §§ 1.302, 1.959, 1.965, 1.967, 1.971, and 1.977.

IV. Patent and Trademark Efficiency Act Amendments: Section 13203 of Public Law 107–273 is directed to efficiency amendments to the statute. The Office is revising § 1.13(b) to eliminate its requirement for an attestation for certified copies of documents, similar to the elimination of the attestation requirement in 35 U.S.C. 153 as provided in section 13203(c) of Public Law 107–273.

V. Technical amendment related to eighteen-month publication of applications and provisional rights: Sections 13204 and 13205 of Public Law 107–273 made technical corrections to provisions directed to the eighteen-month publication of patent applications and provisional rights, and the issuance of patents. The Office is revising §§ 1.14, 1.78, 1.417, and 1.495 to implement the statutory revisions made by these sections of Public Law 107–273.

Section-by-Section Discussion

Section 1.1: Section 1.1(c) is amended to provide separate mail stops for *ex parte* reexamination proceedings and *inter partes* reexamination proceedings. Section 1.1(c) is amended to clarify that 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 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)). Correspondence relating to *inter partes* reexamination proceedings is best handled at one central location where Office personnel have specific expertise in *inter partes* reexamination because of the unique nature of *inter partes* reexamination proceedings.

Section 1.13: Section 1.13(b) is amended to delete ''attested by an officer of the United States Patent and

Trademark Office authorized by the Director.'' Section 13203(c) of Public Law 107–273 eliminated the requirement in 35 U.S.C. 153 that the signature of the Director for issued patents be attested to by an officer of the Office. To achieve further efficiencies, certified copies of documents will no longer include an attestation for the Director's signature. Accordingly, § 1.13(b) is amended to eliminate the requirement for an attestation for certified copies of documents.

Section 1.14: Section 1.14(g)(2) is amended to correct the reference to ''35 U.S.C. 154(d)(4)''.

Section 1.78: Section 1.78(a)(3) is amended by deleting the phrase ''in a nonprovisional application.'' Section 4508 of the AIPA as originally enacted did not make the eighteen-month publication amendments to 35 U.S.C. 119 and 120 applicable to an international application unless and until it enters the national stage under 35 U.S.C. 371. *See* Public Law 106–113, 113 Stat. at 1501A–566 through 1501A–567. Section 13205 of Public Law 107–273 amended section 4508 of the AIPA to make the eighteen-month publication amendments to 35 U.S.C. 119 and 120 also applicable during the international stage of an international application. With regard to international applications, § 1.78(a)(2)(ii) requires that the reference required by § 1.78(a)(2)(i) be submitted: (1) during the pendency of the later-filed application; and (2) within the later of (A) four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application, or (B) sixteen months from the filing date of the prior-filed application. Since an abandoned international application is not a nonprovisional application, the petition procedure set forth in former § 1.78(a)(3) was not applicable to a delayed priority claim in an abandoned international application. Section 1.78(a)(3) as amended now makes the petition procedure set forth in § 1.78(a)(3) applicable to submitting a delayed priority claim in an abandoned international application including an international application that has not entered the national stage under 35 U.S.C. 371. Therefore, when filing a ''bypass'' continuation application under 35 U.S.C. 111(a) that claims the benefit of the international application with a filing date on or after November 29, 2000, that could have but did not claim the benefit of an earlier U.S. nonprovisional application or international application designating the United States and the benefit claim is to be added, a petition under § 1.78(a)(3) will be required in the abandoned international application. A ''bypass'' continuation application is an application for patent filed under 35 U.S.C. 111(a) that claims the benefit of the filing date of an earlier international application designating the United States that did not enter the national stage under 35 U.S.C. 371. *See* H.R. Rep. No. 107–685, at 222 (2002). The Office previously indicated that to amend a later-filed abandoned international application to add a claim to the benefit of a prior-filed nonprovisional application, or a prior-filed international application designating the United States, an applicant need only file a petition under § 1.182 to amend an abandoned application (the later-filed international application) with the claim to the benefit of a prior-filed application. *See Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications,* 66 FR 67087, 67092 (Dec. 28, 2001), 1254 *Off. Gaz. Pat. Office* 121, 125 (Jan. 22, 2002) (final rule) (response to comment 6). In view of this change to § 1.78(a), applicants should no longer rely upon that advice.

Section 1.191: Section 1.191(a) is amended to delete each appearance of the phrase ''for a patent that issued from an original application filed in the United States.'' Section 13202(d) of Public Law 107–273 provides a technical correction for the effective date set forth in the AIPA for appeals to the BPAI as follows:

> *Effective Date*—The amendments made by Section 4605(b), (c), and (e) of the Intellectual Property and Communications Omnibus Reform Act, as enacted by Section 1000(a)(9) of Public Law 106–113, shall apply to any reexamination filed in the United States Patent and Trademark Office on or after the date of enactment of Public Law 106–113.

The effective date language in section 4608 of the AIPA limited the applicability of the conforming amendments to 35 U.S.C. 134 to a reexamination of a patent that issued from an original application which was filed on or after November 29, 1999. Thus, the conforming amendments to 35 U.S.C. 134 applied only to those *ex parte* reexamination proceedings filed under § 1.510 for patents that issued from an original application which was filed on or after November 29, 1999. Public Law 107–273 revised the applicability of the conforming amendments to 35 U.S.C. 134 such that the conforming amendments are applicable to a reexamination of a patent where the request for *ex parte* reexamination was filed on or after November 29, 1999. Accordingly, § 1.191 is amended to track the statutory revision of the effective date.

Section 1.191(a) is also subdivided into paragraphs (a)(1) (for applications and *ex parte* reexamination proceedings filed before November 29, 1999), (a)(2) (for *ex parte* reexamination proceedings filed on or after November 29, 1999), and (a)(3) (for *inter partes* reexamination proceedings).

Section 1.197: Section 1.197(c) is amended to provide that an appeal to the Federal Circuit is terminated when the mandate is issued by the Court, rather than when the mandate is received by the Office. This change to § 1.197(c) is for consistency with a 1998 amendment to Rule 41 of the Federal Rules of Appellate Procedure. The commentary on the addition of subdivision (c) to Rule 41 of the Federal Rules of Appellate Procedure indicates that this provision is intended to make clear that the Court's mandate is effective upon issuance, and that its effectiveness is not delayed until receipt of the mandate by the trial court or agency.

Section 1.301: Section 1.301 (last sentence) is amended by inserting the phrase ''appeals by patent owners and third party requesters in'' before ''*inter partes* reexamination proceedings.'' The revision makes it clear that appeals by third party requesters of *inter partes* reexamination proceedings are controlled by § 1.983.

Section 1.302: Section 1.302 is amended by adding new paragraphs (c) and (d), and redesignating existing paragraph (c) as paragraph (e). New paragraph (c) points out that when an appeal is taken to the Federal Circuit in an *ex parte* reexamination proceeding, the appellant must serve notice as provided in § 1.550(f). New paragraph (d) points out that when an appeal is taken to the Federal Circuit in an *inter partes* reexamination proceeding, the appellant must serve notice as provided in § 1.903. These revisions are intended to focus parties on the unique service requirements in *ex parte* and *inter partes* reexamination proceedings, when appealing to the Federal Circuit.

Section 1.303: Section 1.303 is amended by revising paragraphs (a), (b) and (d) to delete the appearance of ''for a patent that issued from an original application filed in the United States'' in each paragraph. This revision is made for the reasons stated in the discussion of § 1.191.

Section 1.304: Section 1.304 is amended by revising paragraph (a)(1) to add after the second sentence, the following sentence: ''If a request for rehearing or reconsideration of the decision is filed within the time period

provided under § 1.979(a), the time for filing an appeal shall expire two months after action on the last such request.'' In addition, reference to § 1.979(a) in the second sentence is deleted. Further, § 1.304 is amended to include all of the current provisions relating to interferences in § 1.304(i), and to include a new § 1.304(ii) which provides that in *inter partes* reexaminations the time for filing a cross-appeal expires: (1) fourteen days after service of the notice of appeal to the Federal Circuit; or (2) two months after the date of decision of the BPAI, whichever is later.

Section 1.304(a)(1) now provides that an *inter partes* third party requester can appeal to the Federal Circuit and can participate in the patent owner's appeal to the Federal Circuit. The time for filing an appeal to the Federal Circuit will expire two months after ''action on the last such request made by the parties,'' as opposed to the sentence which precedes the added sentence where time for filing an appeal to the Federal Circuit is stated to expire two months after ''action on the request.'' Thus, the potential for rehearing or reconsideration by more than one party is now factored into the time for appeal to the Federal Circuit. Since a party may not challenge a BPAI decision in an *inter partes* reexamination in a civil action under 35 U.S.C. 145, § 1.304(a)(1) provides that ''the time for filing an appeal shall expire * * *'' and not ''the time for filing an appeal or commencing a civil action shall expire * * *'' (which appears in the sentence which precedes the added sentence).

The revision to § 1.304(a)(1) also conforms to the change to § 1.983, by addressing the potential for cross appeal to the Federal Circuit in an *inter partes* reexamination (in addition to that in an interference).

Section 1.417: As discussed with regard to the revision to § 1.14, the statute has been revised to clarify that a translation of the international publication, as opposed to the international application, must be filed in order for a patent owner to obtain the provisional right of a reasonable royalty under 35 U.S.C. 154(d). Accordingly, § 1.417 is amended: (1) To delete ''the international publication or''; (2) to add ''of the publication'' after ''English language translation''; and (3) to delete '', unless it is being submitted pursuant to § 1.495,''.

Section 1.495: Section 1.495(c) is amended to change ''if it was originally filed in another language (35 U.S.C. 371(c)(2)'' to ''if the international application was originally filed in another language and if any English language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2)).'' The purpose of this revision is to clarify that if an English language translation of the publication has already been filed and the publication was also a translation of the international application, a second translation is not required. Instead, the translation required by 35 U.S.C. 154(d) will satisfy the requirement for a translation under 35 U.S.C. 371(c)(2). In § 1.495(g), the phrase '', except for a copy of the international publication or translation of the international application that is identified as provided in § 1.417,'' is deleted because the phrase is unnecessary, since it merely repeats a provision of § 1.417.

Section 1.913: Section 1.913 is amended to add the phrase ''other than the patent owner or its privies'' after ''any person,'' because section 13202 of Pub. L. 107–273 now clarifies that only the third party requester may file a request for *inter partes* reexamination; a patent owner may not file a request for *inter partes* reexamination. This is consistent with the initial position taken by the Office during the implementation of optional *inter partes* reexamination. *See Rules to Implement Optional Inter partes Reexamination Proceedings,* 65 FR 18153, 18178 (Apr. 6, 2000), 1234 *Off. Gaz. Pat. Office* 93, 116 (May 23, 2000) (proposed rule).

Section 1.959: Section 1.959 is amended by adding a new paragraph (f), which provides a non-extendable one-month period for correcting an inadvertent failure to comply with any requirement of § 1.959, when a notice of appeal or cross appeal is submitted. The revision of § 1.959 will permit a remedy of inadvertent defects in a notice of appeal or cross appeal.

Section 1.959 relates to appeals and cross appeals to the BPAI in *inter partes* reexamination proceedings. The requirements for acceptance by the Office of a notice of appeal and cross appeal to the BPAI are: (1) Payment of the appeal fee set forth in § 1.17(b) (§§ 1.959(a) and (b)); (2) identification of the appealed claim(s) (§ 1.959(c)); and (3) signature by the patent owner, the third party requester, or their duly authorized attorney or agent (§ 1.959(c)).

Section 1.959 is amended to provide the third party requester (as well as the patent owner) one opportunity to supply, within one month, the missing fee or missing portion of the fee that was inadvertently not supplied. Section 1.957(a) provides that if ''the third party requester files an untimely or inappropriate comment [or] notice of appeal * * * in an *inter partes* reexamination, the paper will be refused consideration.'' Thus, if the third party requester inadvertently fails to pay the appeal fee, or makes a payment which is deficient as to the amount specified in § 1.17(b), the requester's notice of appeal (or cross appeal) will not be considered, and requester's appeal will otherwise be barred. The failure to submit the complete appeal fee is not a ''*bona fide* attempt to respond and to advance the prosecution'' where ''some requirement has been inadvertently omitted'' under § 1.957(d) (with requester then given a chance to rectify the inadvertency), since § 1.957(d) applies only to a patent owner and not to a third party requester. In addition, the third party requester does not have the opportunity to ''revive'' the appeal, as does the patent owner under § 1.137 (further, an extension of the time for filing the notice of appeal (or cross appeal) is not provided for by § 1.956, even if the requester becomes aware of the inadvertency on the last day to remedy it). Thus, the third party requester would be barred from appealing the case when a sufficient payment of the fee is inadvertently not made, in the absence of the present revision to § 1.959. Yet, estoppel attaches to the third party requester which precludes further resolution of the issues that the requester wishes to appeal. Under the statute, requester is estopped from later asserting in any civil action, or in a subsequent *inter partes* reexamination, the invalidity/unpatentability of any claim finally determined to be valid and patentable on any ground the third party requester raised or could have raised in the *inter partes* reexamination. Requester is further estopped from later challenging in a civil action any fact determined in the *inter partes* reexamination. Accordingly, a requester's loss of appeal rights because of an inadvertent payment would be an unduly harsh and extreme measure. Thus, the Office is revising § 1.959 to provide the third party requester one opportunity to supply, within one month, the missing fee or missing portion of the fee. As to the requirements that the notice of appeal (or cross appeal) identify the appealed claim(s) and be signed by the appellant, it may be that an opportunity to remedy the inadvertent failure to comply with same is not precluded by § 1.957(a). The refusal of consideration mandated by that section is directed only to ''untimely or inappropriate'' notices of appeal (and cross appeal). If so, the failure to sign or identify as

required might not render the notice untimely, and the paper might be an ''appropriate'' paper, *i.e.*, the type of paper that is entitled to entry in an *inter partes* reexamination, but is not a complete paper. However, to cover the possibility that failure to comply with the signature or identification of claims requirements of § 1.959(c) could permanently bar the requester's appeal, new § 1.959(f) has been phrased to explicitly encompass these potential defects in a notice of appeal (or cross appeal).

Sections 1.965 and 1.967: Section 1.965(d) is amended by inserting ''paragraphs (a) and (c)'' in place of ''paragraph (c).'' Section 1.967(c) is amended by inserting ''paragraphs (a) and (b)'' in place of ''paragraph (b).''

Under former § 1.965, an inadvertent failure to comply with a requirement of § 1.965(a) permanently barred the requester's appeal from going forward. Under former § 1.967, an inadvertent failure to comply with a § 1.967(a) requirement also barred the requester's participation via respondent brief in the patent owner's appeal. Sections 1.965 and 1.967 are revised to provide the appellant and respondent, respectively, with a non-extendable one-month period for correcting an inadvertent failure to comply with a requirement of §§ 1.965(a) and 1.967(a), respectively. This revision of §§ 1.965 and 1.967 is for reasons analogous to those set forth above for the revision of § 1.959. Again, the loss of requester's appeal rights because of a § 1.965(a) inadvertency, and the loss of requester's participation rights because of a § 1.967(a) inadvertency, are considered to be unduly harsh and extreme measures.

It is noted that § 1.965(b) states: ''A party's appeal shall stand dismissed upon failure of that party to file an appellant's brief, accompanied by the requisite fee, within the time allowed.'' Under § 1.965(d), as it has now been revised, the phrase 'within the time allowed'' in § 1.965(b) includes the filing of an ''appellant's brief, accompanied by the requisite fee'' within the one-month period for correcting an inadvertency (in failure to comply with a requirement of § 1.965(a) and/or (c)) set forth in § 1.965(d).

Section 1.971: Section 1.971 is amended by designating the sole current paragraph of the section as paragraph (a), and adding new paragraph (b). New paragraph (b) provides a non-extendable one-month period for correcting an inadvertent failure to comply with any requirement of paragraph (a) of § 1.971, when a rebuttal brief is submitted. Existing §§ 1.965(d) and 1.967(c) provide relief for certain non-compliance inadvertencies in appellant and respondent briefs, respectively. However, prior to the present amendment of § 1.971, there was no relief of this nature provided for rebuttal briefs. Section 1.971 is amended (in a new paragraph (b)) to provide similar relief for inadvertencies in the rebuttal brief. In addition, the phrase ''[n]o new ground of rejection can be proposed by a third party requester'' is being changed to ''[n]o new ground of rejection may be proposed by a third party requester'' to more correctly state the limitation.

Section 1.977: Section 1.977(g) is amended by inserting the phrase '', when the patent owner is responding under paragraph (b)(1) of this section'' at the end of the first sentence of the paragraph, and by adding the following new sentence as the second sentence: ''The time period set forth in paragraph (b) of this section may not be extended when the patent owner is responding under paragraph (b)(2) of this section.''

Prior § 1.977(g) provided that ''[t]he time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956.'' Thus, an extension of time could be obtained for the filing of a patent owner amendment or showing of facts under § 1.977(b)(1), or the filing of a patent owner request for rehearing of the decision of the BPAI made under § 1.977(b)(2). However, § 1.979(g) stated, and continues to state, that the times for requesting rehearing under § 1.979(a) may not be extended, and a patent owner request for rehearing of the decision of the BPAI made under § 1.977(b)(2) is included as § 1.979(a)(2). Thus, the time for filing a patent owner request for rehearing under § 1.977(b)(2) could not be extended. The present amendment to § 1.977(g) makes it consistent with the language of § 1.979(g). Note further that this revision is consistent with the policy for a streamlined appeal procedure, which is reflected, for example, in § 1.959 (no extension of the time for filing the notice of appeal or cross appeal), § 1.963 (no extension of the time for filing appellant, respondent, and rebuttal briefs), and § 1.979(g) (no extension of the time for filing *any* rehearing request). Thus, it is appropriate that an extension of time cannot be obtained for the filing of a patent owner request for rehearing of the decision of the BPAI made under § 1.977(b)(2), while an extension can be obtained for the filing of a patent owner amendment or showing of facts presented under § 1.977(b)(1), which may be considered a reopening of the examination process, as opposed to the appeal process.

Section 1.979: Section 1.979 is amended by revising its paragraphs (e) and (f) to replace ''patent owner'' (and its possessive) with ''parties to an appeal to the Board of Patent Appeals and Interferences,'' ''party,'' ''any party,'' or ''party's,'' as applicable. Section 1.979 is also amended by deleting the first and second sentences of paragraph (f). The third sentence of § 1.979(f) is amended to add ''to the Board of Patent Appeals and Interferences'' after ''An appeal'' to provide additional clarity. Section 1.979 was formerly drafted to address the situation where an appeal to the Federal Circuit is possible only for the patent owner. The first revision modifies the language of § 1.979 to make it applicable to all parties to the *inter partes* reexamination proceeding, *i.e.*, the patent owner and any *inter partes* reexamination third party requester, who are the parties to the appeal to the BPAI. The second revision deletes the provision for termination of the third party requester's appeal, which was (before the enactment of Public Law 107–273) under criteria different than that for the patent owner (since a third party requester could not appeal to the courts under the statute prior to Public Law 107–273). The first revision to the text of § 1.979(f) makes the criteria for termination the same for all parties to the appeal. Finally, § 1.979(f) is amended to provide that an appeal to the Federal Circuit is terminated when the mandate is issued by the Federal Circuit, which is consistent with a 1998 amendment to Rule 41 of the Federal Rules of Appellate Procedure. *See* the discussion of § 1.197 above.

Undesignated center heading immediately preceding § 1.983: The undesignated center heading immediately preceding § 1.983 is revised by deleting ''PATENT OWNER'' before ''APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT.'' The undesignated center heading immediately preceding § 1.983 was formerly drafted to address the situation where appeal to the Federal Circuit was possible only by the patent owner. This revision modifies the language to make it applicable to all parties to the *inter partes* reexamination proceeding who are the parties to the appeal to the BPAI.

Section 1.983: Section 13106 of Public Law 107–273 grants the *inter partes* reexamination third party requester the right to appeal an adverse decision of the BPAI to the Federal Circuit. 35 U.S.C. 315(b)(1). It further authorizes the third party requester to be a party to any appeal taken by the patent owner to the Federal Circuit. *See* 35 U.S.C.

315(b)(1). Also, as pointed out above, section 13106 of Public Law 107–273 implicitly permits the patent owner to be a party to the newly provided appeal taken by the third party requester to the Federal Circuit. Section 1.983 is amended to track this newly enacted legislation by revising its heading, dividing the existing text into paragraphs (a) and (b), revising the text of newly designated paragraphs (a) and (b), and adding new paragraphs (c) through (f).

The heading of § 1.983 is amended by changing ''Patent owner appeal'' to ''Appeal.''

Section 1.983(a) is amended to permit the patent owner and any third party requester who is a party to an appeal to the BPAI to: (1) appeal the BPAI's decision to the Federal Circuit; and (2) be a party to any appeal to the Federal Circuit taken from the BPAI's decision.

Section 1.983(b) is amended to clarify that service of the notice of appeal or cross appeal must be made on every other party to the reexamination proceeding as required in § 1.903. The explicit statement of requirement for service on other parties also provides antecedent for the fourteen-day period recited in paragraph (e) of § 1.983 that follows.

Section 1.983 is amended to add paragraphs (c) and (d) to provide for a cross appeal to the Federal Circuit within fourteen days of service of an opposing party's notice of appeal to the Federal Circuit. This is analogous to the cross appeal (within fourteen days of service of the notice of appeal) provided for in § 1.304(a)(1) for interferences. The interferences model is used, because an interference is the only other *inter partes* proceeding appealed to the Court from the decision of the BPAI. It is noted that if the two-month time period from the BPAI's decision will expire after the fourteen-day period set for a cross appeal, then the later-expiring two-month period will control. Thus, where a first party files an appeal to the court (the Federal Circuit) fourteen days after the BPAI's decision, an opposing party need not file a cross appeal fifteen days later (twenty-nine days after the BPAI's decision), but rather has the remainder of the two-month period to do so.

A new paragraph (e) is added to § 1.983, to set forth the action a party must take in order to participate in an appellant's appeal (including cross appeal). Participation in the appellant's appeal is directed to providing argument supporting the decision of the BPAI. Such participation is in contrast to the cross appeal which is provided for in paragraphs (c) and (d) of § 1.983, where a party challenges a decision of the BPAI adverse to that party. New paragraph (f): Section 13106(d) of Public Law 107–273 provides the effective date for the revision to the statute made in section 13106 as follows: ''[t]he amendments made by this Section apply with respect to any reexamination proceeding commenced on or after the date of enactment of this Act.''

Accordingly, § 1.983 is amended to add a new paragraph (f) stating: ''[n]otwithstanding any provision of the rules, in any reexamination proceeding commenced prior to November 2, 2002, the third party requester is precluded from appealing and cross appealing any decision of the BPAI to the Federal Circuit, and the third party requester is precluded from participating in any appeal taken by the patent owner to the Court.''

Response to comments: The Office published a notice proposing changes to the rules of practice to implement the patent-related provisions in the intellectual property title of the 21st Century Department of Justice Appropriations Authorization Act. *See Changes to Implement the 2002 Inter Partes Reexamination and other Technical Amendments to the Patent Statute,* 68 FR 22343 (Apr. 28, 2003), 1270 *Off. Gaz. Pat. Office* 106 (May 20, 2003) (proposed rule). The Office received six written comments (from intellectual property organizations, patent practitioners, and the general public) in response to this notice. While the comments were for the most part favorable to the changes proposed, a number of issues were raised. The comments which raise issues, and the Office's responses to these comments, now follow:

Comment 1: The comments of all three intellectual property associations which provided comments focused on the revision that was proposed for §§ 1.949 and 1.953, to issue a Right of Appeal Notice (under § 1.953) after all claims are found patentable, without first issuing an Action Closing Prosecution (under § 1.949). The comments noted that the revision was proposed in an effort to streamline *inter partes* reexamination prosecution, based on the assumption that a patent owner ''presumably'' would not file any further comments after receiving a notice that all claims are patentable. The comments then pointed out that while it is possible that this assumption should cover most situations, the proposed revision would eliminate an important safeguard for the patent owner in circumstances where the assumption is not correct. An example was given where a patent owner would wish to respond after all claims are allowed, but would be precluded from doing so under the proposal. A patent owner receiving notice that all claims are found patentable might very well decide to propose an amendment at that point, if the patent owner disagrees with the examiner's statement of reasons for allowance or statement of claim interpretation. If, as proposed, a Right of Appeal Notice would be the paper that first informs a patent owner that all claims have been found patentable, then the patent owner would be precluded from submitting such an amendment in the proceeding. One comment asserted that in the instance of a first action indication of patentability of all claims and simultaneous issuance of a Right of Appeal Notice, the proposed revision could deny the patent owner its statutory right to propose amendments during reexamination pursuant to 35 U.S.C. 314(a), since amendments to claims are expressly barred once the Right of Appeal Notice is issued.

Based on the above, the comments urge that the Office retain the current practice of issuing an Action Closing Prosecution in all cases where the request for *inter partes* reexamination is granted, even after all claims in the proceeding have been found patentable.

Response: In view of the comments, the proposed revision of §§ 1.949 and 1.953 will not be adopted. The public response expresses a view that the need to always provide the patent owner with an opportunity to comment after all claims are found patentable outweighs the pendency reduction benefit that would result from bypassing the issuance of an Action Closing Prosecution and directly issuing a Right of Appeal Notice. In view of the preference stated in the comments that the patent owner should always be given an opportunity to comment after all claims are found patentable (by issuing an Action Closing Prosecution under § 1.949, after which patent owner can comment under § 1.951(a)), the proposal to revise §§ 1.949 and 1.953 has been withdrawn.

One of the comments suggested that the Office's objective of streamlining prosecution (after a determination of patentability of all claims) could be achieved by providing patent owner with an opportunity to expressly waive its right to submit comments/amendments under current § 1.951(a) upon notice that all claims have been found patentable. It is noted, however, that such a right already exists, because the patent owner is free to file, after an Action Closing Prosecution under § 1.949, a paper stating that no comments/amendments will be filed

under current § 1.951(a). Thus, a new provision is not needed to implement the suggestion.

As a final point, it is noted that (contrary to a statement made in one of the comments) under the current practice, an Action Closing Prosecution will not be issued in all cases where a request for *inter partes* reexamination is granted. Where all claims are rejected in a first Office action (for example) and the patent owner fails to respond, a Notice of Intent to Issue a Reexamination Certificate will issue canceling all the patent claims, and there is no need for an Action Closing Prosecution. Also, if the ordered reexamination is vacated, where appropriate, prior to the issuance of an Action Closing Prosecution, there will be no Action Closing Prosecution issued in the proceeding.

Comment 2: One comment points out that the effective date language in section 4608 of the AIPA changes to 35 U.S.C. 134 and 35 U.S.C. 145 was to be ''phased in only years after enactment,'' *i.e.*, only for an *ex parte* reexamination that was based upon an original application filed on or after November 29, 1999. This would have taken many years to become effective, thus providing a gradual transition. Instead, the comment notes, Public Law 107–273 accelerates the effective date provision to apply to any reexamination filed on or after November 29, 1999 (*i.e.*, nearly three years ago). The comment urges that this change has accelerated the existence of a situation where an examiner can ''suppress a case from appellate review 'forever' simply by refraining from making a rejection final.'' The comment requests relief from this situation.

Response: If a patent owner believes that a reexamination proceeding is being ''suppressed'' from appellate review by the examiner's refraining from making a rejection final, the patent owner may file a petition under § 1.181(a) requesting that the most recent Office action by the examiner be designated as a final rejection so as to permit an appeal. Such a petition should be accompanied by a showing as to why the most recent Office action should have been designated as a final rejection. If such a petition is denied by the Technology Center Director, the patent owner could seek further review by way of a petition under § 1.181(a)(3) requesting higher level review of the decision of the Technology Center Director. Since a petition under § 1.181 does not operate to stay the reexamination proceeding (§ 1.181(f)), it is advisable that the petition under § 1.181(a) be accompanied by a notice of appeal and appeal fee set forth in § 1.17(b) (which will be refunded as unnecessary if the petition is denied) and a request for an extension of time under § 1.550(c) to respond to the most recent Office action (since an appeal is not a proper response to a non-final Office action and the period for response to the Office action continues to run if the petition is denied). However, it must be remembered that in no case can the period for response be extended so as to expire later than six months from the date of the most recent Office action.

Comment 3: Two comments have suggested that the Office permit *inter partes* reexamination of patents issuing from original applications filed in the United States prior to November 29, 1999. One of the comments argues that the Office's statement that the effective date language in section 4608 of the AIPA limited the applicability of *inter partes* reexamination (and conforming amendments) to patents issuing from original applications filed in the United States on or after November 29, 1999, is ''bad law, bad policy for the patent system and bad policy for the Patent and Trademark Office.'' The commenter then presents a constitutional argument to support this. The same comment further argues that the *inter partes* reexamination effective date provision of the AIPA has been repealed by implication, based upon the legislative expansion of third party requester appeal rights provided by Public Law 107–273. The comment further urges that, if its proposal is not adopted, then third party requester participation in *ex parte* reexamination which would be analogous to that provided by statute for *inter partes* reexamination should be permitted by rule for patents issuing from an original application filed in the United States prior to November 29, 1999.

Response: Section 4608 (effective date) of the AIPA provides: ''this subtitle and the amendments made by this subtitle shall take effect on the date of the enactment of this Act [November 29, 1999] and shall apply to any patent that issues from an original application filed in the United States on or after that date [November 29, 1999].'' *See* Pub. L. 106–113, 113 Stat. at 1501A–572. The plain language of the statute is clear and is not ambiguous. The enacted *inter partes* provisions of the AIPA are clearly stated (in Section 4608) to apply ''to any patent that issues from an original application filed in the United States on or after'' the date of enactment (November 29, 1999).

To the extent that it is argued that this provision is unwise and should not be adhered to, and that Art. I, § 8, cl. 8 of the U.S. Constitution (Congress shall have the power * * * ''[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries'') provides a basis for the Office to ignore the limitations in the AIPA on the applicability of *inter partes* reexamination, it is noted that the Federal courts have generally held that the power of Congress to legislate on the subject of patents is plenary by the terms of the Constitution. *See e.g., McClurg* v. *Kingsland,* 42 U.S. (1 How.) 202, 206 (1843); *see also Owen* v. *Heimann,* 12 F.2d 173, 174 (D.C. Cir.), cert. denied, 271 U.S. 685 (1926) (''Congress has full power to prescribe to whom and upon what terms and conditions a patent shall issue''); *Kling* v. *Haring,* 11 F.2d 202, 204–05 (D.C. Cir.), *cert. denied,* 271 U.S. 671 (1926) (same). In any event, administrative agencies do not have the authority to declare unconstitutional the laws they are charged with administering. *See, e.g., Oestereich* v. *Selective Service Board,* 393 U.S. 233, 242 (1968); *McGowan* v. *Marshall,* 604 F.2d 885, 892 (5th Cir. 1979); and *Buckeye Industries, Inc.* v. *Secretary of Labor,* 587 F.2d 231 (5th Cir. 1979).

As to the argument that the *inter partes* reexamination effective date provision of the AIPA has been repealed by implication, based upon the legislative expansion of third party requester appeal rights provided by Public Law 107–273, Congress is well versed in the mechanism for changing an effective date of prior legislation (as it did for the eighteen-month publication provisions of the AIPA), and Congress did not do so for the *inter partes* reexamination effective date provisions of the AIPA. It is noted that a proposed revision to the *inter partes* reexamination eligibility effective date was explicitly placed before Congress by way of Section 3(a) of H.R. 2231 introduced on June 19, 2001, and referred to the House committee. *See* H.R. 2231, 107th Cong., 1st Sess. (2001). Thus, an explicit provision to revise the *inter partes* reexamination effective date was before Congress; yet, it was not carried forward into Public Law 107–273.

As to the suggestion that third party requester participation rights (analogous to those provided by statute for *inter partes* reexamination) should be provided by rule for *ex parte* for patents issuing from an original application filed in the United States prior to November 29, 1999, the statute does not provide authority for a third party

requester of a reexamination proceeding requested under 35 U.S.C. 302 to file a paper directed to the issues during the examination of the reexamination proceeding. The statute and its intent are clear that the reexamination proceeding under 35 U.S.C. 302 must be *ex parte* and third party requester participation is barred by statute. *See Syntex (U.S.A.) Inc.* v. *U.S. Patent and Trademark Office,* 882 F.2d 1570, 1573, 11 USPQ2d 1866, 1868–69 (Fed. Cir. 1989) (third parties do not participate before the Office). While the third party requester is permitted by statute pursuant to 35 U.S.C. 304 to file a ''reply'' prior to the examination stage if the patent owner files a statement under 35 U.S.C. 304, that is the only paper directed to the merits of the proceeding authorized to a requester that files an *ex parte* reexamination.

Comment 4: One comment points out that a reexamination requester may ''piggyback'' a second or subsequent reexamination onto an ongoing reexamination proceeding with the possibility of merged proceedings and thus thwart a final rejection being made as the second action in the ongoing reexamination, with a first Office action then being issued for the merged proceeding. The commenter further notes that a requester could ''hamstring a reexamination proceeding to keep a case bottled up in the examining corps forever'' by filing multiple requests for reexamination based on the same patent.

Response: Section 2283 of the Manual of Patent Examining Procedure states that:

> Once the files are returned to the examiner for issuance of an Office action, the examiner should prepare an Office action at the most advanced point possible for the first proceeding. Thus, if the first proceeding is ready for a final rejection and the second proceeding does not provide any new information which would call for a new ground of rejection, the examiner should issue a final rejection for the merged proceeding using the guidelines for the prosecution stage set forth below.

See Manual of Patent Examining Procedure § 2283 (8th. ed. 2001) (Rev. 1, Feb. 2003) (MPEP).

Thus, the examiner is directed to, where possible, prepare an Office action at the most advanced point possible for the ongoing (first) proceeding, which in the commenter's scenario is the final rejection stage. If, however, a new issue (*e.g.*, new art, combining the old art a new way, or new evidence) that precludes a final rejection is raised by the later request, a final rejection would not be issued. In that instance, public policy dictates that the substance of the later request be considered and applied in order that only valid patent claims result from the reexamination proceeding, *i.e.*, to prevent the public from being barred from using claimed subject matter for which protection is not warranted. It is noted that even in this situation, the patent owner would be free to file a petition under § 1.181 requesting that the Office action be designated as a final rejection (see response to comment 2).

A patent owner faced with the filing of multiple reexamination requests on a patent may obtain relief if it can be shown that the newly filed reexamination request was filed: (1) by the same real party in interest who filed a previous request (rather than another party who wishes to approach the issue in its own way), and (2) without providing a new issue in the form of new art or viewing art previously applied in the reexamination proceeding in a new light. If a *bona fide* new issue is, however, raised by the later request, public policy dictates that the substance of the later request be considered and applied in order to resolve the new issue such that only valid patent claims result from the reexamination proceeding.

Comment 5: One comment raises a concern that there is no express requirement in § 1.953 for an examiner to set forth grounds for not making any third party proposed rejections (as is required in existing § 1.949) upon a determination of patentability of all claims.

Response: Initially, it is noted that § 1.953 (c) states ''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''. Thus, the commenter's concern is in fact addressed in the rule.

It is also noted that in any Office action (in an *inter partes* reexamination) where an examiner declines to adopt a rejection proposed by a third party requester, the examiner must explicitly identify the proposed rejection, state that the proposed rejection is not adopted, and set forth grounds for not adopting the proposed rejection. This will be covered in a new chapter of the MPEP which will be directed to *inter partes* reexamination. It is noted, however, that if the third party requester then fails to address and contest the refusal to adopt the proposed rejection at the first opportunity to do so, such will be taken as an acquiescence to the examiner's position. In such a case, the proposed ground of rejection will be withdrawn from further consideration in the proceeding, will not be addressed in future Office actions, and will not serve as a basis for appeal in any subsequent appeal that may be taken by the requester in the proceeding.

Comment 6: Two comments suggested that an inconsistency was raised by the statement in the notice of proposed rule making that an Action Closing Prosecution (or Right of Appeal Notice) can be issued ''even though the Office action being issued is the first action on the merits.'' It is argued that if a request for reexamination does not present prior art printed publications and patents that provide a *prima facie* case of unpatentability (or come ''exceedingly close'' to it), then the Office should not have issued an order for reexamination in the first place, but rather should have denied the request (and thus the first Office action stage should not be reached). Stated another way, it is argued that finding all the claims patentable over the art at the first action stage should be inconsistent with ordering reexamination based on such art.

Response: A finding that all of the claims are patentable over the art at the first action stage is not inconsistent with the prior order of reexamination based on such art. *See* MPEP 2240. The initial decision on a request for reexamination is based upon whether or not a ''substantial new question of patentability'' is raised by the art (the patents and/or printed publications). *See id.* Where a finding is made that a substantial new question of patentability has been raised, the examiner has only determined that there is a ''substantial likelihood'' that a reasonable examiner would consider the art of record important in deciding whether or not the claims are patentable. *See* MPEP 2242. After reexamination has been ordered, it is then determined, in the examination stage of the proceeding, whether or not the claims are patentable over the art. *See* MPEP 2240. At the time when the first Office action is issued, if one or more claims are not patentable over the art, the claims will be rejected based on that art. If claims are found patentable over the art, the action will state that finding (and supporting reasons). A decision that all the claims are patentable at this point does not negate the initial finding that a substantial new question of patentability was raised by the art, because reexamination will be ordered as long as a reasonable

examiner would consider the art of record important in deciding whether or not the claims are patentable; there is no requirement that the claims be prima facie obvious over the art. The Federal Circuit has specifically indicated that:

> The inquiry occasioned by a request for reexamination is solely whether a reexamination order should issue and is not directed toward resolution of validity. The requestor's burden is simply to show a basis for issuance of the order, a burden unrelated to that assigned in [35 U.S.C.] 282. A refusal of reexamination leaves untouched the [35 U.S.C.] 282 presumption to which the patent is entitled in the courtroom.

See In re Etter, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985).

It is also noted that the third party requester is not entitled (under 35 U.S.C. 315(b)) to appeal a finding of claim patentability in situations in which the Director does not issue a determination pursuant to 35 U.S.C. 312 and 313 that a substantial new question of patentability has been presented. *See* 35 U.S.C. 312(c) (a determination made under 35 U.S.C. 312(a) by the Director on the request for reexamination is ''final and non-appealable''). Refusing to order reexamination where a substantial new question has been found to be present, but all the claims are found to be patentable over the art, would deprive the requester of the right to appeal the finding of claim patentability (under 35 U.S.C. 315(b)).

Comment 7: One comment suggests that the policy of issuing an Action Closing Prosecution (or Right of Appeal Notice) as the first action on the merits where all claims are patentable may be ''contrary to the letter of the law.'' The comment notes that according to 35 U.S.C. 314(a), ''reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.'' These sections (35 U.S.C. 132 and 133) are directed to prosecution before the examiner and not proceedings on appeal to the BPAI. The comment urges that 35 U.S.C. 132(a) indicates that ''each interested party shall get two bites at the apple. By analogy to initial examination, 35 U.S.C. 132(a) should be construed, in the context of *inter partes* reexamination, to loosely read: ''Whenever, on reexamination, any claim in a patent is confirmed to be patentable, the Director shall notify the Third Party Requester thereof, stating the reasons for such confirmation, together with such information and references as may be useful in judging of the propriety of continuing the Reexamination of the patent; and if after receiving such notice, the Third Party Requester persists, the previously-confirmed patent claim shall be reassessed.'' Thus, the commenter believes that the statute provides the third party requester with a right to address the finding of claims patentable during the examination stage of the *inter partes* reexamination proceeding.

Response: 35 U.S.C. 132(a) reads in part: ''Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined''. 35 U.S.C. 132(a) provides for an applicant's opportunity to participate in an application, and by virtue of the incorporation of 35 U.S.C. 132(a) into 35 U.S.C. 314(a), it also provides for a patent owner's opportunity to participate during the examination stage of the *inter partes* reexamination proceeding. 35 U.S.C. 132(a), by virtue of its incorporation into 35 U.S.C. 314(a), does not confer any participation rights on a third party requester.

Further, 35 U.S.C. 314(b)(2) states: ''Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response''. The third party requester may file a paper during the examination stage of the *inter partes* reexamination proceeding if, and only if, the patent owner files a response to an Office action. Thus, the third party requester is precluded by statute from participation in the examination stage of the *inter partes* reexamination proceeding if the patent owner fails to respond to all Office actions issued. Thus, contrary to the commenter's argument, the third party requester certainly is not ensured of the opportunity to participate during the examination stage of the *inter partes* reexamination proceeding. It is only the requester's right to appeal any rejection proposed and not adopted that is ensured by the statute.

As a final point, issuance of an Action Closing Prosecution as the first action on the merits (where all claims are patentable) is entirely consistent with the statute, since it provides the requester with the rights provided by statute to comment if and only if the patent owner responds to the Action Closing Prosecution.

In conclusion, the *inter partes* third party requester of reexamination is permitted by statute only to comment pursuant to 35 U.S.C. 314(b)(2) if the patent owner responds to an Office action, and to appeal and participate in appeals pursuant to 35 U.S.C. 315(b). No further participation in an *inter partes* reexamination proceeding is authorized by 35 U.S.C. chapter 31.

Rule Making Considerations

Administrative Procedure Act: The changes in this notice conform the patent-related rules of practice in 37 CFR to the changes to title 35 U.S.C. contained in Public Law 107–273. Therefore, these changes involve interpretive rules or rules of agency practice and procedure under 5 U.S.C. 553(b)(A). *See Bachow Communications Inc.* v. *FCC,* 237 F.3d 683, 690 (D.C. Cir. 2001); *Paralyzed Veterans of America* v. *West* 138 F.3d 1434, 1436 (Fed. Cir. 1998); and *Komjathy* v. *National Transportation Safety Board,* 832 F.2d 1294, 1296–97 (D.C. Cir. 1987). Therefore, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law).

Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), an initial regulatory flexibility analysis under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is not required. See 5 U.S.C. 603.

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: 0651–0021, 0651–0031, 0651–0032, and 0651–0033. The United States Patent and Trademark Office is not resubmitting any information collection to OMB for its review and approval, because the changes in this notice do

not affect the information collection requirements associated with the information collection under these OMB control numbers.

The title, description and respondent description of each of the information collections are shown below with an estimate of each of the annual reporting burdens. Included in each estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The changes in this notice conform the patent-related rules of practice in 37 CFR to the changes to title 35 U.S.C. contained in Public Law 107–273.

OMB Number: 0651–0021.

Title: Patent Cooperation Treaty.

Form Numbers: PCT/RO/101, PCT/RO/134, PCT/RO/144, PTO–1382, PCT/IPEA/401, PCT/IB/328, PCT/SB/61/PCT, PCT/SB/64/PCT.

Type of Review: Approved through December of 2003.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions, Farms, Federal Government and State, Local and Tribal Governments.

Estimated Number of Respondents: 331,407.

Estimated Time Per Response: Between 15 minutes and 4 hours.

Estimated Total Annual Burden Hours: 401,202.

Needs and Uses: The information collected is required by the Patent Cooperation Treaty (PCT). The general purpose of the PCT is to simplify the filing of patent applications on the same invention in different countries. It provides for a centralized filing procedure and a standardized application format.

OMB Number: 0651–0031.

Title: Patent Processing (Updating).

Form Numbers: PTO/SB/08A, PTO/SB/08B, PTO/SB/21–27, PTO/SB/30–32, PTO/SB/35–37, PTO/SB/42–43, PTO/SB/61–64, PTO/SB/67–68, PTO/SB/91–92, PTO/SB/96–97, PTO–2053–A/B, PTO–2054–A/B, PTO–2055–A/B, PTOL–413A, eIDS, EFS form.

Type of Review: Approved through July of 2006.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions, Farms, Federal Government and State, Local and Tribal Governments.

Estimated Number of Respondents: 2,208,339.

Estimated Time Per Response: 1 minute 48 seconds to 8 hours.

Estimated Total Annual Burden Hours: 830,629 hours.

Needs and Uses: During the processing of an application for a patent, the applicant/agent may be required or desire to submit additional information to the Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosure Statements; Terminal Disclaimers; Petitions to Revive; Express Abandonments; Appeal Notices; Petitions for Access; Powers to Inspect; Certificates of Mailing or Transmission; Statements under § 3.73(b); Amendments, Petitions and their Transmittal Letters; and Deposit Account Order Forms.

OMB Number: 0651–0032.

Title: Initial Patent Application.

Form Number: PTO/SB/01–07, PTO/SB/13PCT, PTO/SB/16–19, PTO/SB/29 and 29A, PTO/SB/101–110.

Type of Review: Approved through July of 2006.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions, Farms, Federal Government, and State, Local, or Tribal Governments.

Estimated Number of Respondents: 454,287.

Estimated Time Per Response: 22 minutes to 10 hours and 45 minutes.

Estimated Total Annual Burden Hours: 4,171,568 hours.

Needs and Uses: The purpose of this information collection is to permit the Office to determine whether an application meets the criteria set forth in the patent statute and regulations. The standard Fee Transmittal form, New Utility Patent Application Transmittal form, New Design Patent Application Transmittal form, New Plant Patent Application Transmittal form, Declaration, Provisional Application Cover Sheet, and Plant Patent Application Declaration will assist applicants in complying with the requirements of the patent statute and regulations, and will further assist the Office in processing and examination of the application.

OMB Number: 0651–0033.

Title: Post Allowance and Refiling.

Form Numbers: PTO/SB/44, PTO/SB/50–51, PTO/SB/51S, PTO/SB/52–53, PTO/SB/55–58, PTOL–85B.

Type of Review: Approved through January of 2004.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions, Farms, State, Local and Tribal Governments, and Federal Government.

Estimated Number of Respondents: 205,480.

Estimated Time Per Response: 1.8 minutes to 2 hours.

Estimated Total Annual Burden Hours: 63,640 hours.

Needs and Uses: This collection of information is required to administer the patent laws pursuant to Title 35, U.S.C., concerning the issuance of patents and related actions including correcting errors in printed patents, refiling of patent applications, requesting reexamination of a patent, and requesting a reissue patent to correct an error in a patent. The affected public includes any individual or institution whose application for a patent has been allowed or who takes action as covered by the applicable rules.

Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia, 22313–1450, or to the Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10235, 725 17th Street, NW., Washington, DC 20503, Attention: Desk Officer for the Patent and Trademark Office.

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.

■ For the reasons set forth in the preamble, 37 CFR part 1 is 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).

■ 2. Section 1.1 is amended by revising paragraph (c) to read:

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

* * * * *

(c) *For reexamination proceedings.* (1) Requests for *ex parte* reexamination (*original* request papers only) should be additionally marked ''Mail Stop *Ex parte* Reexam.''

(2) Requests for *inter partes* reexamination (original request papers) and all subsequent *inter partes* 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 *Inter partes* Reexam.''

* * * * *

■ 3. Section 1.13 is amended by revising paragraph (b) to read:

§ 1.13 Copies and certified copies.

* * * * *

(b) Certified copies of patents, patent application publications, and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public or persons entitled thereto will be authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his or her name, upon payment of the fee for the certified copy.

■ 4. Section 1.14 is amended by revising paragraph (g)(2) to read as follows:

§ 1.14 Patent applications preserved in confidence.

* * * * *

(g) * * *

(2) A copy of an English language translation of a publication of an international application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(4)).

* * * * *

■ 5. Section 1.78 is amended by revising paragraph (a)(3) to read as follows:

§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) * * *

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

(i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

* * * * *

■ 6. Section 1.191 is amended by revising paragraph (a) to read as follows:

§ 1.191 Appeal to Board of Patent Appeals and Interferences.

(a)(1) Every applicant for a patent or for reissue of a patent, and every owner of a patent involved in an *ex parte* reexamination proceeding filed under § 1.510 before November 29, 1999, any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period for reply provided under §§ 1.134 and 1.136 (for applications) or § 1.550(c) (for *ex parte* reexamination proceedings).

(2) Every owner of a patent involved in an *ex parte* reexamination proceeding filed under § 1.510 on or after November 29, 1999, any of whose claims has been finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period for reply provided under §§ 1.134 and 1.550(c).

(3) Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under § 1.913 are controlled by §§ 1.959 through 1.981. Sections 1.191 through 1.198 are not applicable to appeals in *inter partes* reexamination proceedings filed under § 1.913.

* * * * *

■ 7. Section 1.197 is amended by revising paragraph (c) to read as follows:

§ 1.197 Action following decision.

* * * * *

(c) Termination of proceedings. (1) Proceedings are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except:

(i) Where claims stand allowed in an application; or

(ii) Where the nature of the decision requires further action by the examiner.

(2) The date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the Court or review by civil action (§ 1.304) expires. If an appeal to the Court or a civil action has been filed, proceedings are considered terminated when the appeal or civil action is terminated. An appeal to the U.S. Court of Appeals for the Federal Circuit is terminated when the mandate is issued by the Court. A civil action is terminated when the time to appeal the judgment expires.

■ 8. Section 1.301 is revised to read as follows:

§ 1.301 Appeal to U.S. Court of Appeals for the Federal Circuit.

Any applicant, or any owner of a patent involved in any *ex parte* reexamination proceeding filed under § 1.510, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences, may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal: In the U. S. Patent and Trademark Office, file a written notice of appeal directed to the Director (*see* §§ 1.302 and 1.304); and in the Court, file a copy of the notice of appeal and pay the fee for appeal as provided by the rules of the Court. For appeals by patent owners and third party requesters in *inter partes* reexamination proceedings filed under § 1.913, § 1.983 is controlling.

■ 9. Section 1.302 is revised to read as follows:

§ 1.302 Notice of appeal.

(a) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof to the Director within the time specified in § 1.304.

(b) In interferences, the notice must be served as provided in § 1.646.

(c) In *ex parte* reexamination proceedings, the notice must be served as provided in § 1.550(f).

(d) In *inter partes* reexamination proceedings, the notice must be served as provided in § 1.903.

(e) Notices of appeal directed to the Director shall be mailed to or served by hand on the General Counsel as provided in § 104.2.

■ 10. Section 1.303 is amended by revising paragraphs (a), (b), and (d) to read as follows:

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

(a) Any applicant, or any owner of a patent involved in an *ex parte* reexamination proceeding filed before November 29, 1999, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in § 1.304.

(b) If an applicant in an *ex parte* case, or an owner of a patent involved in an *ex parte* reexamination proceeding filed before November 29, 1999, has taken an appeal to the U.S. Court of Appeals for the Federal Circuit, he or she thereby waives his or her right to proceed under 35 U.S.C. 145.

* * * * *

(d) For an *ex parte* reexamination proceeding filed on or after November 29, 1999, and for any *inter partes* reexamination proceeding, no remedy by civil action under 35 U.S.C. 145 is available.

■ 11. Section 1.304 is amended by revising paragraph (a)(1) to read as follows:

§ 1.304 Time for appeal or civil action.

(a)(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 1.197(b) or § 1.658(b), the time for filing an appeal or commencing a civil action shall expire two months after action on the request. If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 1.979(a), the time for filing an appeal shall expire two months after action on the last such request.

(i) In interferences, the time for filing a cross-appeal or cross-action expires:

(A) Fourteen days after service of the notice of appeal or the summons and complaint; or

(B) Two months after the date of decision of the Board of Patent Appeals and Interferences, whichever is later.

(ii) In *inter partes* reexaminations, the time for filing a cross-appeal expires:

(A) Fourteen days after service of the notice of appeal; or

(B) Two months after the date of decision of the Board of Patent Appeals and Interferences, whichever is later.

* * * * *

■ 12. Section 1.417 is revised to read as follows:

§ 1.417 Submission of translation of international publication.

The submission of an English language translation of the publication of an international application pursuant to 35 U.S.C. 154(d)(4) must clearly identify the international application to which it pertains (§ 1.5(a)) and be clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4). Otherwise, the submission will be treated as a filing under 35 U.S.C. 111(a). Such submissions should be marked ''Mail Stop PCT.''

■ 13. Section 1.495 is amended by revising paragraphs (c) and (g) to read as follows:

§ 1.495 Entering the national stage in the United States of America.

* * * * *

(c) If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date but omits either a translation of the international application, as filed, into the English language, if the international application was originally filed in another language and if any English language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2)), or the oath or declaration of the inventor (35 U.S.C. 371(c)(4) and § 1.497), if a declaration of inventorship in compliance with § 1.497 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26*ter*.1, applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of thirty months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of thirty months after the priority date. A ''Sequence Listing'' need not be translated if the ''Sequence Listing'' complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b).

* * * * *

(g) The documents and fees submitted under paragraphs (b) and (c) of this section must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371. Otherwise, the submission will be considered as being made under 35 U.S.C. 111(a).

* * * * *

■ 14. Section 1.913 is revised to read as follows:

§ 1.913 Persons eligible to file request for inter partes reexamination.

Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

■ 15. Section 1.959 is amended by adding a new paragraph (f) to read as follows:

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

* * * * *

(f) If a notice of appeal or cross appeal is timely filed but does not comply with any requirement of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended notice of appeal or cross appeal. If the appellant does not then file an amended notice of appeal or cross appeal within the one-month period, or files a notice which does not overcome all the reasons for non-compliance stated in the

notification of the reasons for non-compliance, that appellant's appeal or cross appeal will stand dismissed.

■ 16. Section 1.965 is amended by revising paragraph (d) to read as follows:

§ 1.965 Appellant's brief in inter partes reexamination.

* * * * *

(d) If a brief is filed which does not comply with all the requirements of paragraphs (a) and (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended brief. If the appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

■ 17. Section 1.967 is amended by revising paragraph (c) to read as follows:

§ 1.967 Respondent's brief in inter partes reexamination.

* * * * *

(c) If a respondent's brief is filed which does not comply with all the requirements of paragraphs (a) and (b) of this section, respondent will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended brief. If the respondent does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief will not be considered.

■ 18. Section 1.971 is revised to read as follows:

§ 1.971 Rebuttal brief in inter partes reexamination.

(a) Within one month of the examiner's answer in an *inter partes* reexamination appeal, any appellant may once file a rebuttal brief in triplicate. The rebuttal brief of the patent owner may be directed to the examiner's answer and/or any respondent brief. The rebuttal brief of any third party requester may be directed to the examiner's answer and/or the respondent brief of the patent owner. The rebuttal brief of a third party requester may not be directed to the respondent brief of any other third party requester. No new ground of rejection may be proposed by a third party requester. The time for filing a rebuttal brief may not be extended. The rebuttal brief must include a certification that a copy of the rebuttal brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(b) If a rebuttal brief is filed which does not comply with all the requirements of paragraph (a) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended rebuttal brief. If the appellant does not file an amended rebuttal brief during the one-month period, or files an amended rebuttal brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's rebuttal brief will not be considered.

■ 19. Section 1.977 is amended by revising paragraph (g) to read as follows:

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

* * * * *

(g) The time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956, when the patent owner is responding under paragraph (b)(1) of this section. The time period set forth in paragraph (b) of this section may not be extended when the patent owner is responding under paragraph (b)(2) of this section. The time periods set forth in paragraphs (c) and (e) of this section may not be extended.

■ 20. Section 1.979 is amended by revising paragraphs (e) and (f) to read as follows:

§ 1.979 Action following decision by the Board of Patent Appeals and Interferences or dismissal of appeal in inter partes reexamination.

* * * * *

(e) The parties to an appeal to the Board of Patent Appeals and Interferences may not appeal to the U.S. Court of Appeals for the Federal Circuit under § 1.983 until all parties' rights to request rehearing have been exhausted, at which time the decision of the Board of Patent Appeals and Interferences is final and appealable by any party to an appeal to the Board of Patent Appeals and Interferences who is dissatisfied with the final decision of the Board of Patent Appeals and Interferences.

(f) An appeal to the Board of Patent Appeals and Interferences by a party is considered terminated by the dismissal of that party's appeal, the failure of the party to timely request rehearing under § 1.979(a) or (c), or the failure of the party to timely file an appeal to the U.S. Court of Appeals for the Federal Circuit under § 1.983. The date of such termination is the date on which the appeal is dismissed, the date on which the time for rehearing expires, or the date on which the time for the appeal to the U.S. Court of Appeals for the Federal Circuit expires. If an appeal to the U.S. Court of Appeals for the Federal Circuit has been filed, the appeal is considered terminated when the mandate is issued by the U.S. Court of Appeals for the Federal Circuit. Upon termination of an appeal, if no other appeal is present, the reexamination proceeding will be terminated and the Director will issue a certificate under § 1.997.

* * * * *

■ 21. The undesignated center heading immediately preceding § 1.983 is revised to read as follows:

Appeal to the United States Court of Appeals for the Federal Circuit in Inter Partes Reexamination

■ 22. Section 1.983 is revised 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 § 1.979(e), 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.

(b) The appellant must take the following steps in such an appeal:

(1) In the U.S. Patent and Trademark Office, timely file a written notice of appeal directed to the Director in accordance with §§ 1.302 and 1.304;

(2) In the U.S. Court of Appeals for the Federal Circuit, file a copy of the notice of appeal and pay the fee, as provided for in the rules of the U.S. Court of Appeals for the Federal Circuit; and

(3) Serve a copy of the notice of appeal on every other party in the reexamination proceeding in the manner provided in § 1.248.

(c) If the patent owner has filed a notice of appeal to the U.S. Court of Appeals for the Federal Circuit, the third party requester may cross appeal to the U.S. Court of Appeals for the Federal Circuit if also dissatisfied with the decision of the Board of Patent Appeals and Interferences.

(d) If the third party requester has filed a notice of appeal to the U.S. Court of Appeals for the Federal Circuit, the

patent owner may cross appeal to the U.S. Court of Appeals for the Federal Circuit if also dissatisfied with the decision of the Board of Patent Appeals and Interferences.

(e) A party electing to participate in an appellant's appeal must, within fourteen days of service of the appellant's notice of appeal under paragraph (b) of this section, or notice of cross appeal under paragraphs (c) or (d) of this section, take the following steps:

(1) In the U.S. Patent and Trademark Office, timely file a written notice directed to the Director electing to participate in the appellant's appeal to the U.S. Court of Appeals for the Federal Circuit by mail to, or hand service on, the General Counsel as provided in § 104.2;

(2) In the U.S. Court of Appeals for the Federal Circuit, file a copy of the notice electing to participate in accordance with the rules of the U.S. Court of Appeals for the Federal Circuit; and

(3) Serve a copy of the notice electing to participate on every other party in the reexamination proceeding in the manner provided in § 1.248.

(f) Notwithstanding any provision of the rules, in any reexamination proceeding commenced prior to November 2, 2002, the third party requester is precluded from appealing and cross appealing any decision of the Board of Patent Appeals and Interferences to the U.S. Court of Appeals for the Federal Circuit, and the third party requester is precluded from participating in any appeal taken by the patent owner to the U.S. Court of Appeals for the Federal Circuit.

Dated: December 9, 2003.

James E. Rogan,

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

[FR Doc. 03–31398 Filed 12–19–03; 8:45 am]

BILLING CODE 3510–16–P

ENVIRONMENTAL PROTECTION AGENCY

40 CFR Part 51

[FRL–7601–4]

RIN 2060–AL80

Revisions to the Regional Haze Rule To Correct Mobile Source Provisions in Optional Program for Nine Western States and Eligible Indian Tribes Within That Geographic Area

AGENCY: Environmental Protection Agency (EPA).

ACTION: Final rule; amendments.

SUMMARY: The EPA is taking final action to approve a correction to the mobile source provisions of EPA's regional haze rule. This correction is consistent with recommendations of the Western Regional Air Partnership (WRAP). The amendments to the rule are intended to address an emissions projection scenario for mobile sources which was not addressed when EPA published the regional haze rule in 1999.

EFFECTIVE DATE: This final rule is effective February 20, 2004.

ADDRESSES: The EPA has established an official public docket for this action under Docket No. OAR–2002–0076. The official public docket consists of the documents specifically referenced in this action, any public comments received, and other information related to this action. Although a part of the official docket, the public docket does not include confidential business information or other information whose disclosure is restricted by statute. The official public docket is the collection of materials that is available for public viewing at the Air Docket in the EPA Docket Center, Room B102, 1301 Constitution Ave., NW., Washington, DC. The EPA Docket Center Public Reading Room is open from 8:30 a.m. to 4:30 p.m., Monday through Friday, excluding legal holidays. The telephone number for the Reading Room is (202) 566–1744, and the telephone number for the Air Docket is (202) 566–1742. A reasonable fee may be charged for copying.

Electronic Access. You may access this **Federal Register** document electronically through the EPA Internet under the ''**Federal Register**'' listings at *http://www.epa.gov/fedrgstr/*. An electronic version of the public docket is available through EPA's electronic public docket and comment system, EPA Dockets. You may use EPA Dockets at *http://www.epa.gov/edocket/* to view public comments, access the index listing of the contents of the official public docket, and to access those documents in the public docket that are available electronically. Although not all docket materials may be available electronically, you may still access any of the publicly available docket materials through the docket facility identified above. Once in the system, select ''search,'' then key in the docket identification number, OAR–2002–0076.

FOR FURTHER INFORMATION CONTACT: If you would like further information about this rule, contact Kathy Kaufman, Integrated Policies and Strategies Group, (919) 541–0102 or by e-mail *kaufman.kathy@epa.gov*.

SUPPLEMENTARY INFORMATION:

Regulated Entities

Entities potentially regulated by this action are nine States in the Western United States (Arizona, California, Colorado, Idaho, Nevada, New Mexico, Oregon, Utah and Wyoming) and Indian tribes within that same geographic area. This final action, and an earlier action taken by EPA in 1999, provides these States and tribes with an optional program to protect visibility in federally protected scenic areas. The portion of the program addressed by today's final rule is a program for tracking of mobile source emissions under the 1999 rule.

Outline

The contents of today's preamble are listed in the following outline.

I. Background

A. What Is the Regional Haze Rule?

Section 169(A) of the Clean Air Act (CAA) establishes a national goal for protecting visibility in federally-protected scenic areas. These ''Class I'' areas include national parks and