

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 notice proposes changes to 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. 35 U.S.C. 134(c). In addition, no provision was made in the statute for 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). In this final rule, § 1.983 was promulgated to track 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 explicitly precluded under 35 U.S.C. 134(c) from appealing the decision of the BPAI to the Federal Circuit, no such provision of the rules was provided. 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) 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 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. 35 U.S.C. 315(b)(1). Moreover, section 13106 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).”

It is being proposed that § 1.983 be amended to implement this statutory revision, and conforming/ancillary amendments be made 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. Amendments to §§ 1.191, 1.303, and 1.913 are being proposed to address the *inter partes* and *ex parte* reexamination technical corrections.

*III. Other miscellaneous changes made as to reexamination:* Additionally, revision of the *inter partes* reexamination rules is being proposed 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. Revision of the *inter partes* reexamination rules is also being proposed to expedite the prosecution leading to the appeal stage. Finally, revision is proposed for clarifying the *inter partes* and *ex parte* reexamination appeal rules. Amendments to these ends are proposed below for §§ 1.302, 1.949, 1.953, 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. It is proposed that § 1.13(b) be amended 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 13203(c), 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 proposed changes to §§ 1.14, 1.78, 1.417, and 1.495 are directed to implementation of the statutory revisions made by these sections of Public Law 107–273.

### Section-by-Section Discussion

*Section 1.1:* It is proposed that § 1.1(c) be amended to provide separate mail stops for *ex parte* reexamination proceedings and for *inter partes* reexamination proceedings. It is also proposed that § 1.1(c) be amended to make it clear that the mail stop for *ex parte* reexamination proceedings is only for the original request papers for *ex parte* reexamination. The new mail stop for *inter partes* reexamination would be for original request papers and all subsequent correspondence filed in the Office (other than correspondence to the Office of the Solicitor pursuant to § 1.1(a)(3) and § 1.302(c)), since the nature of such proceedings is complex and correspondence is best handled at a central location, where the personnel have specific expertise in *inter partes* reexamination.

*Section 1.13:* It is proposed that § 1.13(b) be 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, it is proposed that certified copies of documents would no longer include an attestation for the Director's signature. Accordingly, it is proposed that § 1.13(b) be amended to eliminate the requirement for an attestation for certified copies of documents.

*Section 1.14:* It is proposed that § 1.14(i)(2) be amended by inserting “of the publication” after “English language translation” in the sole sentence of the paragraph. Section 13204 of Public Law 107–273 made a technical change to the provisional rights provisions of the patent statute as to international applications to clarify that a translation of the international publication, as opposed to the international application, is required to be filed in order for a patent owner to obtain provisional rights pursuant to 35 U.S.C. 154(d). In view of this change to the statute, the corresponding reference to the translation in § 1.14 is proposed to be changed to add “the publication of an international application” after “English language translation of.” In addition, it is proposed that the