

filing a cross-appeal expires: (1) 14 days after service of the notice of appeal; or (2) two months after the date of decision of the BPAI, whichever is later.

The proposed revision to § 1.304(a)(1) 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 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 * * *" (which appears in the sentence which precedes the added sentence).

The proposed revision to § 1.304(a)(1) also conforms to the change proposed for § 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 pointed out in the discussion above of the proposed 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, it is proposed that § 1.417 be 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: It is proposed that § 1.495(c) be 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), it is proposed to delete ", except for a copy of the international publication or translation of the international application that is identified as provided in § 1.417," because the phrase is unnecessary, since it merely repeats a provision of § 1.417.

Section 1.913: It is proposed that § 1.913 be amended to add "other than the patent owner or its privies" after "any person," as section 13202 of Public Law 107-273 now clarifies that there is statutory basis only for the third party requester to file a request for *inter partes* reexamination, and there is no such basis for a patent owner to do so. This position 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).

Sections 1.949 and 1.953: It is proposed that the clause "or upon a determination of patentability of all claims" be deleted from the first sentence of § 1.949, and the clause "or upon a determination of patentability of all claims in the proceeding" be added to § 1.953(a), so that § 1.953(a) would read as follows: "Upon considering the comments of the patent owner and the third party requester subsequent to the Office action closing prosecution in an *inter partes* reexamination, or upon expiration of the time for submitting such comments, or upon a determination of patentability of all claims in the proceeding, the examiner shall issue a Right of Appeal Notice (RAN), unless the examiner reopens prosecution and issues another Office action on the merits" (emphasis added in bold). This proposed change would be directed to streamlining prosecution in an *inter partes* reexamination by issuing a RAN under § 1.953 as soon as all claims in the proceeding are found patentable. This would be in contrast to the current procedure where an Action Closing Prosecution (ACP) under § 1.949 is issued upon a determination of patentability of all claims, and later a RAN must be issued. Thus, an extra Office action would be avoided by the current proposal.

Currently, where the examiner finds all claims to be patentable, an ACP would be issued even though the Office action being issued is the first action on the merits. The purpose in going

directly to an ACP even in a first Office action is that the patent owner has nothing to respond to, upon learning that the claims are all patentable. Further, since the patent owner will not respond, the third party requester has nothing to comment upon, and is barred from filing a paper as to the merits. Statutory provision for requester's participation in the proceeding (prior to appeal) is only made for requester comments on a patent owner response. 35 U.S.C. 314(b)(3). Therefore, no reason exists to delay the closing of prosecution where all claims are found patentable, and the examiner thus issues an ACP directly. In implementing the optional *inter partes* reexamination proceedings provisions of the AIPA, the Office proposed that the examiner should not go directly to the RAN where all claims are found patentable, because that would deprive the third party requester of the right of filing comments on the examiner's Office actions prior to appeal (§ 1.951(a) as proposed provided that "(a) After an action closing prosecution in an *inter partes* reexamination, a third-party requester may once file comments limited to the issues raised in the Office action closing prosecution"). *See Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR at 18180, 1234 *Off. Gaz. Pat. Office* at 117.

This third party requester's right to file original comments on the examiner's ACP pursuant to § 1.951(a), however, was not adopted in the final rule to implement optional *inter partes* reexamination proceedings. The requester's right to file original comments on the examiner's ACP was deleted in response to a comment on § 1.951(a) which pointed out that "such 'direct' requester comments are not consistent with the statute as the statute makes it clear that the third party requester's right to comment only matures with the filing of a patent owner response to an Office action on the merits, and nowhere in the statute does it permit third party requester comments without there first being a patent owner response." *See Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR at 76768, 1242 *Off. Gaz. Pat. Office* at 22-23.

Given that the third party requester does not have a right to file original comments on the examiner's ACP, the above-discussed reason for issuing an ACP prior to a RAN where all claims are found patentable (*i.e.*, to give the requester at least one chance for input prior to appeal) no longer exists. There is no reason to issue an unnecessary ACP in this instance, since the patent