

owner has no incentive to reply to the finding of all claims patentable, and thus, presumably will not file a response to the ACP. The patent owner would not argue against the allowance of all the claims, and the patent owner would not be expected to comment on any stated reasons for allowance at this point, since he or she may do so after a Notice of Intent to Issue a Reexamination Certificate is issued, while a comment at this stage would give requester an extra opportunity to participate in the proceeding. Accordingly, the present proposal would eliminate the need for an ACP where all claims are found patentable by going directly to the issuance of a RAN, and thus streamline and expedite the *inter partes* reexamination process.

**Section 1.959:** It is proposed that § 1.959 be revised by adding a new paragraph (f). New paragraph (f) would provide 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 proposed revision of § 1.959 would 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)); 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)).

It is proposed to revise § 1.959 by providing the third party requester 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 would otherwise be barred. The failure to submit the complete appeal fee cannot be considered 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 proposed 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, requester's loss of appeal rights because of an inadvertency is considered an unduly harsh and extreme measure.

Accordingly, it is proposed to revise § 1.959 by providing the third party requester one opportunity to supply, within one month, the missing fee or missing portion of the fee that was inadvertently not supplied. 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 requirement of § 1.959(c) could permanently bar the requester's appeal, the proposed new § 1.959(f) has been made broad enough to explicitly encompass these potential defects in a notice of appeal (or cross appeal). Further, the proposed new § 1.959(f) is drafted to encompass patent owner

inadvertencies as well as those of the third party requester.

**Sections 1.965 and 1.967:** It is proposed that § 1.965, paragraph (d), be revised to insert "paragraphs (a) and (c)" in place of "paragraph (c)." It is proposed that § 1.967, paragraph (c), be revised to insert "paragraphs (a) and (b)" in place of "paragraph (b)."

As § 1.965 currently reads, an inadvertent failure to comply with a § 1.965(a) requirement would permanently bar the requester's appeal from going forward. As § 1.967 currently reads, an inadvertent failure to comply with a § 1.967(a) requirement would bar the requester's participation via respondent brief in the patent owner's appeal. It is proposed to revise §§ 1.965 and 1.967 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 proposed for reasons analogous to those set forth above for the proposed 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." If the proposed revision to § 1.965(d) is made, the phrase "within the time allowed" in § 1.965(b) would be interpreted to include 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:** It is proposed that § 1.971 be amended by designating the sole current paragraph of the section as paragraph (a), and adding new paragraph (b). New paragraph (b) would provide 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. Sections 1.965(d) and 1.967(c) currently provide relief for certain non-compliance inadvertencies in appellant and respondent briefs, respectively. There is no such relief provided for rebuttal briefs; yet, no reason exists as to why the relief is provided for both appellant and respondent briefs, but not for rebuttal briefs. It is proposed to revise