

§ 1.971 to provide relief granted for inadvertencies in the rebuttal brief that would parallel the relief granted for inadvertencies in appellant and respondent briefs. This would be effected by providing, in § 1.971, a new paragraph (b), which is analogous to §§ 1.965(d) and 1.967(c).

*Section 1.977:* It is proposed that § 1.977, paragraph (g), be amended by inserting “, when the 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 owner is responding under paragraph (b)(2) of this section.”

Current § 1.977(g) provides 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 presented 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) states 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) cannot be extended. The proposed revision would revise § 1.977(g) to make 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:* It is first proposed that § 1.979 be amended by revising its paragraphs (e) and (f) to replace “patent owner” with “parties to an appeal to the Board of Patent Appeals and Interferences,” “party,” “any party,” and “party’s,” where each replacement

is applicable, and to delete “patent owner’s” where it appears. It is also proposed that § 1.979 be amended by deleting the first and second sentences of paragraph (f). It is also proposed that the third sentence of § 1.979(f) be amended to add “to the Board of Patent Appeals and Interferences” after “An appeal” to provide additional clarity. Section 1.979 is currently drafted to address the situation where appeal to the Federal Circuit is possible only for the patent owner. The first proposed revision would modify 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 proposed revision would delete the current 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 of 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 proposed revision to the text of § 1.979(f) make the criteria for termination the same for all parties to the appeal. Finally, it is proposed that § 1.979(f) be amended to provide that an appeal to the Federal Circuit is terminated when the mandate is issued by the Court for consistency with a 1998 amendment to rule 41 of the Federal Rules of Appellate Procedure.

*Undesignated center heading immediately preceding § 1.983:* It is proposed that the undesignated center heading immediately preceding § 1.983 be revised to delete “PATENT OWNER” before “APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT.” The undesignated center heading immediately preceding § 1.983 is currently drafted to address the situation where appeal to the Federal Circuit is possible only for the patent owner. The proposed revision would modify 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. 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-for appeal taken

by the third party requester to the Federal Circuit. It is proposed that § 1.983 be 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).

It is proposed that the title of § 1.983 be revised by changing “Patent owner appeal” to “Appeal.”

It is proposed that § 1.983(a) be revised 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) to be a party to any appeal to the Federal Circuit taken from the Board’s decision.

It is proposed that § 1.983(b) be revised to clarify that service of the notice of appeal or cross appeal must be made on every other party in the reexamination proceeding as required in § 1.903. The explicit statement of requirement for service on other parties also provides antecedent for the 14-day period recited in paragraph (e) of § 1.983 that follows.

It is proposed that paragraphs (c) and (d) be added to § 1.983 to provide for a cross appeal within 14 days of service of an opposing party’s notice of appeal. This is analogous to the cross appeal (within 14 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 to be noted that if the two-month time period from the BPAI’s decision will expire after the 14-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) 14 days after the BPAI’s decision, an opposing party need not file a cross appeal 15 days later (29 days after the BPAI’s decision), but rather has the remainder of the two-month period to do so.

A new paragraph (e) is proposed to be added to § 1.983, to prescribe 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 would be 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