

agreement among all parties (inventors and existing assignees), or that a court has issued an order so directing the inventorship change. The current reference in § 1.324 to a petition is being eliminated in order to conform the rule language to earlier changes made to § 1.20(a).

Section 1.377: Section 1.377 is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17. Section 1.377 will retain the provision that the petition fee may be refunded if an Office error created the need for the petition.

Section 1.378: Section 1.378(e) is proposed to be amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.

Section 1.502: Section 1.502 is proposed to be amended to make it clear that it is the issuance and publication of the *ex parte* reexamination certificate that terminates the reexamination proceeding. The failure to timely respond, or the issuance of a Notice of Intent to Issue Reexamination Certificate (NIRC), does not terminate the reexamination proceeding. See the discussion below as to the amendment of § 1.550. See also §§ 1.116, 1.570, 1.902, 1.953, 1.957, 1.958, 1.979, and 1.997.

Section 1.530: Section 1.530 is proposed to be amended to state that proposed amendments in *ex parte* or *inter partes* reexamination are not effective until the reexamination certificate is both “issued and published” (emphasis added) to conform § 1.530 for consistency with the language of 35 U.S.C. 307 and 316.

Section 1.550: Section 1.550(c) is proposed to be amended to add a \$200 fee requirement pursuant to § 1.17(g) in *ex parte* reexamination proceedings for requests for extensions of time, which requests are based upon sufficient cause. Extensions of time under § 1.136(a) are not permitted in *ex parte* reexamination proceedings because the provisions of 35 U.S.C. 41(a)(8) and § 1.136(a) apply only to an “application” and not to a reexamination proceeding (*ex parte* or *inter partes*). Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings “will be conducted with special dispatch.” Accordingly, extensions of time in *inter partes* reexamination proceedings are provided for in § 1.550(c) only “for sufficient cause and for a reasonable time specified.” To evaluate whether a showing of “sufficient cause” exists and whether a “reasonable time” is specified, decisions on § 1.550(c)

requests require a thorough evaluation of facts and circumstances on a case-by-case basis. Furthermore, requests under § 1.550(c) are generally treated expeditiously by the deciding official, especially so in reexamination since the statute requires “special dispatch.” To reflect the Office’s cost of deciding requests under § 1.550(c), *i.e.*, the cost of evaluating whether a showing of “sufficient cause” exists and whether a “reasonable time” is specified, it is proposed that a requirement for a fee be added to § 1.550(c).

The present proposal tracks the above discussed proposals to require a fee for the decision on § 1.136(b) and § 1.956 extension of time requests, and the criteria for granting of an extension of time under § 1.550(c) is analogous to that for § 1.136(b) and § 1.956.

Section 1.550(d) is proposed to be amended to state that patent owner’s failure to file a timely response will result in the concluding of prosecution of the reexamination proceeding, but will not conclude or terminate the reexamination proceeding.

The patent owner’s failure to file a timely response, and the issuance of the Notice of intent to Issue Reexamination Certificate (NIRC) concludes the prosecution in the reexamination proceeding. On the other hand, the issuance and publication of a certificate terminates the reexamination proceeding itself. This distinction is important because prosecution which is concluded may be reopened at the option of the Office where appropriate, and a rejection that was withdrawn during the proceeding may be reinstated where the propriety of that rejection has been reconsidered. In contrast, a reexamination proceeding which has been terminated is not subject to being reopened. After the reexamination proceeding has been terminated, it is not permitted to reinstate the same ground of rejection in a reexamination proceeding in accordance with *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) (holding that a “substantial new question of patentability” is not raised by prior art presented in a reexamination request, if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications.). But see Pub. L. 107–273, § 13105, 116 Stat. 1758, 1900 (2002) (overruling *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), by amending 35 U.S.C. 303(a) and 312(a) to provide that “[t]he existence of a

substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office, or considered by the Office”).

This distinction between concluding the prosecution of the reexamination proceeding, and termination of the reexamination proceeding was highlighted by the Federal Circuit decision of *In re Bass*, 314 F.3d 575, 65 USPQ2d 1156 (Fed. Cir. 2003), wherein the Court opined that:

Until a matter has been completed, however, the PTO may reconsider an earlier action. See *In re Borkowski*, 505 F.2d 713, 718, 184 USPQ 29, 32–33 (CCPA 1974). A reexamination is complete upon the statutorily mandated issuance of a reexamination certificate, 35 U.S.C. 307(a); the NIRC merely notifies the applicant of the PTO’s intent to issue a certificate. A NIRC does not wrest jurisdiction from the PTO precluding further review of the matter.

It is to be noted that both NIRC cover sheet forms, *ex parte* Form PTOL 469 and *inter partes* Form PTOL 2068, specifically state (in their opening sentences) that “[p]rosecution on the merits is (or remains) closed in this * * * reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office, or upon petition.” This statement addresses the point that the NIRC concludes the prosecution in the reexamination proceeding, but does not conclude or terminate the reexamination proceeding itself. In this notice of proposed rule making, it is proposed to amend the rules of practice to also address the point. See also §§ 1.116, 1.502, 1.570, 1.902, 1.953, 1.957, 1.958, 1.979, and 1.997.

Section 1.570: The heading of § 1.570, and § 1.570(a), are proposed to be amended to make it clear that the grant of the *ex parte* reexamination certificate terminates the reexamination proceeding. The failure to timely respond, or the issuance of the NIRC does not terminate the reexamination proceeding. See the discussion as to the amendment of § 1.550. See also §§ 1.116, 1.502, 1.902, 1.953, 1.957, 1.958, 1.979, and 1.997.

Section 1.570 is also proposed to be amended in its heading and paragraphs (b) and (d) to recite that the reexamination certificate is both issued and published for consistency with the language of 35 U.S.C. 307.

Section 1.644: Section 1.644, paragraphs (e) and (f), are proposed to be amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.