

*Section 1.666:* Section 1.666(b) and (c) 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.

*Section 1.704(d):* Section 1.704(d) is proposed to be amended to change “cited in a communication” to “first cited in any communication” in order to clarify that the item must have been first cited in any communication from a foreign patent office in a counterpart application instead of merely being cited in such a communication.

An applicant who fails to cite an item, within thirty days of receipt by an individual designated in § 1.56(c) of a first communication from a foreign patent office in a counterpart application citing the item, and instead files an information disclosure statement, within thirty days of a subsequent communication citing the item, cannot be considered to have acted with reasonable efforts to conclude prosecution of the application. The provisions of § 1.704(d) do not apply if the applicant does not submit the IDS within the thirty-day window of a first communication including a citation of an item to a party designated in § 1.56(c). The proposed change to require the thirty-day time frame to run from a first communication parallels the requirement in § 1.97(e)(1).

*Section 1.705:* Section 1.705(d) is proposed to be amended to provide that a patentee may request reconsideration of the patent term adjustment within thirty days of the date the patent issued if the patent indicates a revised patent term adjustment. Currently, any request for reconsideration of the patent term adjustment indicated in the patent is limited to the situation where the patent issues on a date other than the projected date of issue. If the patent indicates a revised patent term adjustment due to the patent being issued on a date other than the projected date of issue, applicant must file a request for reconsideration within thirty days of the date the patent issued. Section 1.705(d) as proposed would allow a patentee to file the request for reconsideration for an event which occurs after the mailing of the notice of allowance so long as the patentee files the request for reconsideration within thirty days of the date the patent issues.

Events occurring after the mailing of the notice of allowance which may result in a reduction of any patent term adjustment include submissions of additional papers such as: (1) Request for refunds; (2) status letter; (3) amendments under § 1.312; (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7)

letters related to biological deposits; and (8) oaths or declarations. See § 1.704(c)(10). An additional event which may trigger the revision of the patent term adjustment is receipt of the payment of the issue fee more than 3 months after mailing of the notice of allowance. See § 1.704(b). Events occurring after the mailing of the notice of allowance which may trigger an increase in the amount of patent term adjustment include administrative delays caused by the Office's failure to issue the application within four months after the date the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied. See § 1.702(a)(4).

Section 1.705(d) is also proposed to be amended to provide that any request for reconsideration under § 1.705(d) that raises issues that were raised, or could have been raised, in an application for patent term adjustment under § 1.704(b) may be dismissed as untimely. The purpose of § 1.705(d) is to provide patentees with an avenue to obtain reconsideration of the patent term adjustment indicated in the patent when the patent term adjustment indicated in the patent differs from the patent term adjustment indicated in the notice of allowance due to events occurring after the mailing of the notice of allowance. Section 1.705(d) is not intended as an avenue for patentees to seek review of issues that were raised, or could have been raised, in an application for patent term adjustment under § 1.704(b). Any request for reconsideration of the patent term adjustment indicated in the patent on the basis of issues that were raised, or could have been raised, in an application for patent term adjustment under § 1.704(b) is considered untimely if not filed within the period specified in § 1.705(b).

*Section 1.741:* Section 1.741(b) is proposed to be amended to refer to the petition fee set forth in section 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.

*Section 1.902:* Section 1.902 is proposed to be amended to make it clear that it is the issuance and publication of the inter partes reexamination certificate that 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, 1.570, 1.953, 1.957, 1.958, 1.979, and 1.997.

*Section 1.953:* Section 1.953(c) is proposed to be amended to state that patent owner's failure to file a timely response will result in the concluding of the prosecution of the reexamination

proceeding, but will not terminate the reexamination proceeding. See the discussion as to the amendment of § 1.550 for the rationale for this change. See also §§ 1.116, 1.502, 1.570, 1.902, 1.957, 1.958, 1.979, and 1.997.

The subheading preceding § 1.956 is proposed to be amended to refer to concluding of prosecution of the reexamination proceeding, rather than conclusion or termination of the reexamination proceeding, since that is what the sections which follow deal with. It is § 1.997, Issuance of *Inter Partes* Reexamination Certificate, that deals with termination of the reexamination proceeding. See the discussion above as to the amendment of § 1.550 for the rationale for this change.

*Section 1.956:* Section 1.956 is proposed to be amended to add a \$200 fee requirement pursuant to § 1.17(g) in *inter partes* 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 *inter partes* 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. 314 requires that inter partes reexamination proceedings “will be conducted with special dispatch.” Accordingly, extensions of time in *inter partes* reexamination proceedings are provided for in § 1.956 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 § 1.956 requests require a thorough evaluation of facts and circumstances on a case-by-case basis. Furthermore, requests under § 1.956 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 § 1.956, *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 § 1.956.

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

*Section 1.957:* Section 1.957(b) is proposed to be amended to state that