

after appeal. Rule 116(f) would be added to prohibit affidavits and other evidence in an inter partes reexamination proceeding after the right of appeal notice under Rule 953, except as provided in Rule 981 or as permitted by proposed § 41.77(b)(1).

Rule 191 would be amended to direct appellants under 35 U.S.C. 134(a) or (b) to proposed part 41, subpart B. Rules 192–196 would be removed and reserved.

Rule 197 would be amended by changing its title to “Return of Jurisdiction from the Board of Patent Appeals and Interferences; termination of proceedings” to reflect the two remaining paragraphs of this section. The subject matter of current paragraph (b) would be moved to proposed § 41.52 and the subject matter of current paragraph (c) would be moved to proposed paragraph (b) of this section. In addition, paragraph (a) would be amended to return of jurisdiction of the involved application or patent under ex parte reexamination proceeding to the examiner.

Rule 198 would be amended by changing its title to “Reopening after a final decision of the Board of Patent Appeals and Interferences” to better reflect the substance of the section and to clarify that it applies when a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review.

Rule 324(a) and (c) would be revised, and Rule 324(d) added, to consolidate cross-references to correction of inventorship for patents in contested cases before the Board.

Rule 959 would be revised to direct inter partes reexamination participants to proposed part 41, subpart C, for information about appeals in such proceedings.

Rules 961–977 would be removed to consolidate inter partes reexamination appeal information in proposed part 41, subpart C.

Rule 979 would be amended by changing its title to “Return of Jurisdiction from the Board of Patent Appeals and Interferences; termination of proceedings” to reflect the two paragraphs of this section. Most of the subject matter of current paragraphs (a)–(g) would be moved to proposed §§ 41.79, 41.81 and 41.83. Paragraph (a) would be amended to recite that jurisdiction over an inter partes reexamination proceeding passes to the examiner after a decision by the Board of Patent Appeals and Interferences upon transmittal of the file to the examiner, subject to each appellant’s right of appeal or other review, for such further action as the condition of the

inter partes reexamination proceeding may require, to carry into effect the decision of the Board of Patent Appeals and Interferences. Paragraph (b) would be amended to state that upon termination of the appeal before the Board of Patent Appeals and Interferences (proposed § 41.83), if no further appeal has been taken (Rule 983), the inter partes reexamination proceeding will be terminated and the Director will issue a certificate under Rule 997. If an appeal to the U.S. Court of Appeals for the Federal Circuit has been filed, that appeal is considered terminated when the mandate is received by the Office.

Rule 981 would be amended by changing its title to “Reopening after a final decision of the Board of Patent Appeals and Interferences” to better reflect the substance of the section and to clarify that it applies when a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review.

Section 3 of part 5 provides that no interference will be declared with an application under a national secrecy order. In part, this is because the application cannot issue while the secrecy order is in place so the completion requirement of proposed § 41.102 is not met. Cf. *Case v. CPC Int’l, Inc.*, 730 F.2d 745, 750, 221 USPQ 196, 200 (Fed. Cir. 1984) (the Director declares an interference to determine whether the application may issue). The proposed revision to Rule 5.3 would remove the reference to a patent because an interference may be provoked with an application as well (proposed § 41.202(a)(1)). The proposed revision would also remove the requirement to place a notice in the file of the targeted patent. Since the Office will not act on the suggestion for an interference, the notice only serves to cast unexamined doubt on the claims of the patentee without providing any route of relief. An applicant intent on having an interference should take steps to have the secrecy order lifted.

Section 23(c)(7) of part 10 would be amended to change the cross-reference to the interference rules.

A new part 41 would permit consolidation of rules relating to Board practice and to simplify reference to such practices. The Board would continue the practice used in part 1 of this title of citing sections without the part number. In proceedings before the Board, a party could cite “§ 41.x” as “Board Rule x”.

Proposed part 41 would better state the existing practice and should not be read to change the existing practice except as explicitly provided.

Proposed subpart A would state policies, practices, and definitions common to all proceedings before the Board.

Proposed § 41.1 would set forth general principles for proposed part 41. Proposed § 41.1(a) would define the scope of rules. Proposed § 41.1(b) would mandate that the Board’s rules be construed to achieve just, speedy, and inexpensive resolutions of all Board proceedings, following the model of Rule 601 and Federal Rule of Civil Procedure 1. Proposed § 41.1(c) would explicitly extend the requirement for decorum under Rule 3 to Board proceedings, including dealings with opposing parties. Board officials are similarly expected to treat parties with courtesy and decorum.

Proposed § 41.2 would set forth definitions for Board proceedings under proposed part 41. The preamble to proposed § 41.2 is based on the preamble of Rule 601, which cautions that context may give a defined word a different meaning. For instance, although “final” would be defined for the purposes of identifying final agency actions of the Board, it would not change the meaning of “final rejection” in proposed § 41.37(c)(1)(iv), which refers to an action by an examiner.

The proposed definition of “Board” would cover three distinct situations. First, for the purposes of a final agency action committed to a panel of Board members, the definition would be identical in scope to 35 U.S.C. 6(b). Second, the definition would include action by the Chief Administrative Patent Judge in matters delegated in these proposed rules to the Chief Administrative Patent Judge. Third, the definition would recognize that non-final actions are often performed by officials other than a panel or the Chief Administrative Patent Judge. See Rule 610(a); cf. 37 CFR 2.127(c). This definition should not be read to authorize a final decision on patentability, priority, or United States Government ownership by anything other than a Board panel. Other than instances in which a panel is required by statute, the selection and authorization of an official to act on behalf of the Board would be entirely a matter of internal administration.

The definition of “Board member” would follow the definition in 35 U.S.C. 6(a), under which the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office, the Commissioner for