

Patents, and the Commissioner for Trademarks are ex officio members of the Board.

The phrase “contested case” would include patent interferences (35 U.S.C. 135(a)) and proceedings with interference-based procedures (42 U.S.C. 2182 and 2457(d)). The existence of a contested case is a predicate for authorizing a subpoena under 35 U.S.C. 24. Although both appeals in inter partes reexaminations under 35 U.S.C. 134(c) and some petitions to the Chief Administrative Patent Judge, such as a petition for access under 35 U.S.C. 135(c), may involve more than one party, they are not considered contested cases for the purposes of proposed part 41.

Finality is required for judicial review. *Barton v. Adang*, 162 F.3d 1140, 1143, 49 USPQ2d 1128, 1131 (Fed. Cir. 1998). The term “final” would be defined pursuant to 5 U.S.C. 704 to assist parties in determining when a Board action is ripe for judicial review. In *Barton*, 162 F.3d at 1143, 49 USPQ2d at 1131, the Court of Appeals for the Federal Circuit held that an adverse judgment against a single party in a multi-party patent interference was a final agency action with respect to that party for the purposes of review under 35 U.S.C. 141. The proposed definition of “final” would follow *Barton* in linking the question of finality to whether an agency action on the merits is operative against the party seeking judicial review. Under 35 U.S.C. 6(b), a decision on the merits in an appeal or a contested case by any entity other than three Board members cannot be a final agency action. Affirming or reversing disposes of an issue on appeal on the merits; vacating or remanding does not. Entry of a new ground of rejection, by definition, does not dispose of an issue on the merits. A petition decision might not be final if, for instance, the decision is rendered without prejudice to take some further action. An issue in a non-final decision may usually be preserved for review in a final decision. See, e.g., proposed § 41.125(c)(5) under which a party may request reconsideration by a panel.

The definition of “hearing” would reflect the holding of *In re Bose Corp.*, 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985) that a party is entitled to judicial consideration of properly raised issues, but is not entitled to an oral argument or consideration of improperly raised issues.

The definitions of “panel” and “panel proceeding” would reflect the minimum quorum established in 35 U.S.C. 6(b), which reserves action on patentability and priority to panels. 35 U.S.C. 6(b).

The term “party” would set forth a generic term for entities acting in a Board proceeding.

The delegation of petition authority to the Chief Administrative Patent Judge in proposed § 41.3(a) would be new as a rule, but follows a delegation already published in the Manual of Patent Examining Procedure (MPEP) at § 1002.02(f). This delegation by rule would not prejudice the Director’s prerogative to decide a petition or to delegate authority to decide a petition to another subordinate. The Chief Administrative Patent Judge could also delegate petition-deciding authority to an official, provided the delegation is stated in writing. Note that under proposed § 41.3(b)(1) decisions committed by statute to the Board would not be subject to petitions for supervisory review. Such decisions would include merits decisions in appeals and contested cases, and decisions on requests for rehearing. 35 U.S.C. 6(b). Review of such decisions would come through a request for rehearing or through judicial review. Proposed § 41.3(b)(2), which would provide for petitions in contested cases to be decided by other officials, would reflect the MPEP’s designation of other actions typical in the ordinary course of Board proceedings as “petitions”. See MPEP § 1002.02(g) (various procedural decisions in interferences). These actions would be considered routine motions or requests.

Proposed § 41.3(c) would reflect current practice in requiring payment of a standard petition fee. Matters that would be excluded from the scope of petitions in § 41.3(a)(2) would not be petitions and so would not require payment of a fee. Petitions seeking supervisory review of a discretionary matter would also not require payment of a petition fee. Compare Rule 181(a)(3) with Rules 182 and 183.

Proposed § 41.3(d) would reflect the current practice of not staying any action for a petition for supervisory review in Rule 181(f). Note that the Court of Appeals for the Federal Circuit has held that a request for rehearing may toll the time for seeking judicial review. *In re Graves*, 69 F.3d 1147, 1151, 36 USPQ2d 1697, 1700 (Fed. Cir. 1995).

Proposed § 41.3(e) would set times for filing petitions. As with Rule 181(f), failure to file a timely petition would be sufficient basis for dismissing or denying a motion.

Proposed § 41.4(a) and (b) would follow the requirements of Rules 136(b) and 645 in providing rules for extensions of time and for acceptance of untimely papers. Congress has

authorized patent term adjustments for time spent in proceedings before the Board. 35 U.S.C. 154(b)(1)(C). Consequently, the Board must be mindful to avoid delays in its administration of its proceedings, including delays requested or caused by a party. The Board might set conditions on extensions to minimize the effects of any delay, including restriction under 35 U.S.C. 121 of claims directed to subject matter not involved in the Board proceeding. Proposed § 41.4(c) would point parties to timeliness rules that are related to Board proceedings, but not within the scope of the Board rules.

Proposed § 41.5 would set forth a limited delegation to the Board under 35 U.S.C. 2(b)(2) and 32 to regulate the conduct of counsel in Board proceedings. It would generally be more efficient to have a Board official familiar with the specific proceeding decide questions of representation limited to the specific proceeding. Disqualification would be a case-specific suspension or exclusion from practice within the meaning of 35 U.S.C. 32. Under the terms of section 32, the official conducting the disqualification hearing would have to be an attorney.

Proposed § 41.5(b) would delegate to the Board the authority to conduct counsel disqualification proceedings while the Board has jurisdiction over a proceeding. It also would clarify counsel disqualification practice under Rule 613(c) by making explicit the fact that a final decision to disqualify is an exercise of the powers of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office under § 32, not the Board. The rule would delegate to the Chief Administrative Patent Judge the authority to make final a decision to disqualify counsel in a proceeding before the Board for the purposes of judicial review. This delegation would not derogate from the Director the prerogative to make such decisions, nor would it prevent the Chief Administrative Patent Judge from further delegating authority to an administrative patent judge, provided the delegation was stated in writing.

Proposed § 41.6(a) would relocate into part 41 the portions of Rule 14(e) that apply to the Board. Proposed § 41.6(a)(1) would continue to state that publicly available materials are publicly available. Such materials may be published without notification to or permission from the applicant. Proposed § 41.6(a)(2) would set forth the basis for making a determination under 35 U.S.C. 122(a) that the publication of a Board action constitutes a special