

first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

\* \* \* \* \*

(d) \* \* \*

(2) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order was removed;

\* \* \* \* \*

(e) The period of adjustment under § 1.702(e) is the sum of the number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

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39. In § 1.704, revise paragraph (c)(9) to read as follows:

**§ 1.704 Reduction of period of adjustment of patent term.**

\* \* \* \* \*

(c) \* \* \*

(9) Submission of an amendment or other paper after a decision by the Board of Patent Appeals and Interferences, other than a decision designated as containing a new ground of rejection under § 41.50(b) of this title or statement under § 41.50(c) of this title, or a decision by a Federal court, less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or supplemental notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the mailing date of the supplemental Office action or notice of allowance; or

(ii) Four months;

\* \* \* \* \*

40. Revise § 1.959 to read as follows:

**§ 1.959 Appeal in inter partes reexamination.**

Appeals to the Board of Patent Appeals and Interferences under 35 U.S.C. 134(c) are conducted according to part 41, subpart C, of this title.

**§§ 1.961–1.977 [Removed and reserved]**

41. Remove and reserve §§ 1.961–1.977.

42. Revise § 1.979 to read as follows:

**§ 1.979 Return of Jurisdiction from the Board of Patent Appeals and Interferences; termination of proceedings.**

(a) 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.

(b) Upon termination of the appeal before the Board of Patent Appeals and Interferences (§ 41.83), if no further appeal has been taken (§ 1.983), the *inter partes* reexamination proceeding will be terminated and the Director will issue a certificate under § 1.997 terminating the proceeding. 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 issued by the Court.

43. Revise § 1.981 to read as follows:

**§ 1.981 Reopening after a final decision of the Board of Patent Appeals and Interferences.**

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the *inter partes* reexamination proceeding will not be reopened or reconsidered by the primary examiner except under the provisions of § 41.77 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

44. Revise § 1.993 to read as follows:

**§ 1.993 Suspension of concurrent interference and inter partes reexamination proceeding.**

If a patent in the process of inter partes reexamination is or becomes involved in an interference, the Director may suspend the *inter partes* reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion under § 41.121(a)(3) of this title to suspend the interference has been presented to, and denied by, an administrative patent judge and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set.

**PART 5—SECURITY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES**

45. The authority citation for Part 5 continues to read as follows:

**Authority:** 35 U.S.C.2(b)(2), 41, 181–188, as amended by the patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100–418, 102 Stat. 1567; the Arms Export Control Act, as amended, 22 U.S.C. 2751 *et seq.*; the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 *et seq.*; the Nuclear Non Proliferation Act of 1978, 22 U.S.C. 3201 *et seq.*; and the delegations in the regulations under these Acts of the Commissioner (15 CFR 3701.10(j), 22 CFR 125.04, and 10 CFR 810.7).

45a. In § 5.3, revise paragraph (b) to read as follows:

**§ 5.3 Prosecution of application under secrecy orders; withholding patent.**

\* \* \* \* \*

(b) An interference will not be declared involving a national application under secrecy order. An applicant whose application is under secrecy order may suggest an interference (§ 41.202(a)), but the Office will not act on the request while the application remains under a secrecy order.

\* \* \* \* \*

**PART 10—REPRESENTATION OF OTHERS BEFORE THE PATENT AND TRADEMARK OFFICE**

46. The authority citation for Part 10 continues to read as follows:

**Authority:** 5 U.S.C. 500, 15 U.S.C. 1123; 35 U.S.C. 2(b)(2), 31, 32, 41.

46a. In § 10.23, revise paragraph (c)(7) to read as follows:

**§ 10.23 Misconduct.**

\* \* \* \* \*

(c) \* \* \*

(7) Knowingly withholding from the Office information identifying a patent or patent application of another from which one or more claims have been copied. See § 41.202(a)(1) of this title.

\* \* \* \* \*

47. Add part 41 to read as follows:

**PART 41—PRACTICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**Subpart A—General Provisions**

Sec.

41.1 Policy.

41.2 Definitions.

41.3 Petitions.

41.4 Timeliness.

41.5 Counsel.

41.6 Public availability of Board records.