

filed on or after June 7, 1995, and before May 29, 2000. *See id.*

The Office is proposing to amend the rules of practice in patent cases to indicate that certain remands by the BPAI shall be considered “a decision in the review reversing an adverse determination of patentability” for patent term adjustment and patent term extension purposes. Specifically, if an application is remanded by a panel of the BPAI, and a notice of allowance under § 1.311 is mailed without further review by the BPAI, without further amendment of the application, and without other action by the applicant, the remand shall (if the proposed change is adopted) be considered a decision reversing an adverse determination of patentability for patent term adjustment and patent term extension purposes. The phrase “remanded by a panel” of the BPAI means that the application was remanded by a panel comprised of members of the BPAI as defined in 35 U.S.C. 6. The phrase “remanded by a panel” of the BPAI does not pertain to applications containing a remand or order returning an appeal to the examiner issued by a BPAI administrator. *See Revised Docketing Procedures for Appeals Arriving at the Board of Patent Appeals and Interferences*, 1260 *Off. Gaz. Pat. Office* 18 (July 2, 2002).

The Office initially took the position that a remand by a BPAI panel was not a “decision” within the meaning of 35 U.S.C. 154(b)(1)(A)(iii), much less “a decision reversing an adverse determination of patentability” as that phrase is used in 35 U.S.C. 154(b)(1)(C)(iii). *See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term*, 65 FR at 56369, 1239 *Off. Gaz. Pat. Office* at 16. The Office has subsequently determined that there are a number of BPAI panel remands that convey the weakness in the examiner’s adverse patentability determination in a manner tantamount to a decision reversing the adverse patentability determination. Such a BPAI panel remand generally results in the examiner *sua sponte* deciding to withdraw the rejections and allow the application without any intervening action by the applicant, rather than responding to the issues raised in the remand and returning the application to the BPAI for decisions reversing the adverse patentability determinations. The change being proposed in this notice addresses the situation in which an examiner responds to a remand by a BPAI panel by *sua sponte* withdrawing all the rejections and allowing the application,

rather than responding to the issues raised in the remand and returning the application to the BPAI for a decision on the appeal. In this situation, the BPAI panel remand shall (if the proposed change is adopted) be considered “a decision in the review reversing an adverse determination of patentability” for patent term extension and patent term adjustment purposes. If, however, the application is allowed as a result of a further amendment, or after any other action by the applicant (*e.g.*, the filing of a paper containing argument, an affidavit or declaration, or an information disclosure statement), without being returned to the BPAI for further review, then such remand shall not be considered “a decision in the review reversing an adverse determination of patentability” for patent term extension and patent term adjustment purposes.

If the patent issues after a remand that is considered “a decision in the review reversing an adverse determination of patentability,” the BPAI panel remand is the “final decision in favor of the applicant” for purposes of a patent term extension or adjustment calculation under § 1.701(c)(3) or § 1.703(e) (as applicable). The period of extension or adjustment calculated under § 1.701(c)(3) or § 1.703(e) (as applicable) would equal the number of days in the period beginning on the date on which a notice of appeal to the BPAI was filed under 35 U.S.C. 134 and § 1.191 and ending on the mailing date of the BPAI panel remand.

Discussion of Specific Rules

Section 1.701: Section 1.701(a)(3) is proposed to be amended by adding the following sentence: If an application is remanded by a panel of the Board of Patent Appeals and Interferences, and a notice of allowance under § 1.311 is mailed without further review by the Board of Patent Appeals and Interferences, without further amendment of the application, and without other action by the applicant, the remand shall be considered a decision reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(2) as amended by section 532(a) of the Uruguay Round Agreements Act, Public Law 103–465, 108 Stat. 4809, 4983–85 (1994). Section 1.701(a)(3) is also proposed to be amended to change “decision reversing an adverse determination of patentability” to “decision in the review reversing an adverse determination of patentability” for consistency with 35 U.S.C. 154(b)(2) as amended by section 532(a) of the URAA.

Section 1.702: Section 1.702(e) is proposed to be amended by adding the following sentence: If an application is remanded by a panel of the Board of Patent Appeals and Interferences, and a notice of allowance under § 1.311 is mailed without further review by the Board of Patent Appeals and Interferences, without further amendment of the application, and without other action by the applicant, the remand shall be considered a decision by the Board of Patent Appeals and Interferences as that phrase is used in 35 U.S.C. 154(b)(1)(A)(iii) and a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(1)(C)(iii). Section 1.702(e) is also proposed to be amended to change “decision reversing an adverse determination of patentability” to “decision in the review reversing an adverse determination of patentability” for consistency with 35 U.S.C. 154(b)(1)(C)(iii).

Rule Making Considerations

Regulatory Flexibility Act: The Deputy General Counsel for General Law, United States Patent and Trademark Office, has certified to the Chief Counsel for Advocacy, Small Business Administration, that the changes proposed in this notice (if adopted) would not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The provisions of the Regulatory Flexibility Act relating to the preparation of a flexibility analysis are not applicable to this rule making because the changes proposed in this notice will not have a significant economic impact on a substantial number of small entities. The changes proposed in this notice would (if adopted) only change the manner in which the Office makes its patent term adjustment determination in applications that have been allowed under certain circumstances following a remand by the BPAI. The changes proposed in this notice would impose no additional fees or requirements on patent applicants.

Executive Order 13132: This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Executive Order 12866: This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

Paperwork Reduction Act: This notice involves information collection requirements which are subject to