

the application that she did not examine in the interference since her participation was by way of recommendation in a particular matter affecting a specific party or parties.

(B) Relationship of personal participation to specificity. In certain cases, whether a patent or patent application should be treated as a “particular patent or patent application matter involving specific parties” depends on the employee’s own participation in events. Participation may result in particularity and specificity to the patent or patent application.

*Example 1:* A patent examiner without any signatory authority drafts the first Office action in an application filed by Company X. After drafting the Office action containing rejections of several claims over prior art, and a rejection of other claims under 35 U.S.C. 112, she submits it to her supervisor for review. The supervisor reviews the draft and suggests changes. On her last day of employment at the Office, the examiner does not have an opportunity to make the changes. The application and drafted action are later assigned to another examiner, who is taking over her art. After she separates from the Office, the other examiner prepares the Office action, including the rejections she had urged, and signs the Office action. Thereafter, the Office action is duly mailed. The former patent examiner is then registered as a patent agent, and is asked by Company X to represent it before the Office on the same patent application. She may not do so.

(C) The particular patent or patent application includes related patents and applications. The requirement of a “particular patent or patent application involving a specific party” applies both at the time that the Office employee acts in an official capacity and at the time in question after service in the Office. The same particular patent or application may continue in another form or in part. In determining whether two particular patents or applications are related, the Department of Commerce considers the extent to which the matters involve the same basic facts, related issues, the same or related parties, time elapsed, the same confidential information, and the continuing existence of an important Federal interest.

*Example 1:* A patent examiner was substantially involved in the granting of a patent to Z Company for the development of alternative energy sources. Six years after he terminates Office employment, the patent is still in effect, but much of the technology has changed as have many of the personnel. An employee of the Q Company has invented an improvement on the original patent. The former patent examiner, now a registered patent attorney, may represent Q Company in its patent application for the improvement, since Q Company’s patent application is a different matter from the patent granted to Z Company. The former employee should first

consult the Office and request a written determination before undertaking any representation in the matter.

*Example 2:* A patent examiner reviewed the claims in an initial patent application, and allowed the claims in the application. The prosecution in a divisional application of claims directed to subject matter disclosed but not originally sought to be claimed in the initial application must be regarded as part of the same particular matter as the initial application. The reason is that the validity of the patent may be put in issue, and many of the facts, e.g., benefit of priority to antedate any intervening prior art, giving rise to the patent would be involved.

*Example 3:* An attorney in the Solicitor’s Office personally works on an appeal in the Court of Appeals for the Federal Circuit of a patent application owned by Company X. A patent is later granted on the application. After leaving the Office, he is registered as a patent attorney, and asked by Company X to represent it in an infringement suit against an alleged infringer. He may not do so.

*Example 4:* A member of the Board of Patent Appeals and Interferences personally works on an appeal of a patent application of Company X. After leaving the Office, he is registered as a patent attorney, and asked by Company X to represent it in an interference proceeding before the Office between the patent granted on the application, and an application of another party. He may not do so. Other examples: See paragraph (b)(3)(i)(A) of this section, Example 1, and paragraph (b)(3)(ii)(A) of this section, Examples 1 and 2.

(D) United States must be a party or have an interest. The particular patent or patent application must be one in which the United States is a party, such as in a judicial or administrative proceeding or a contract, or in which it has a direct and substantial interest. The importance of the Federal interest in a matter can play a role in determining whether two matters are the same particular matter. All patent issues, including the filing and prosecution of a patent application, are matters in which the United States is directly or indirectly interested. The United States is not only interested in the grant of a patent. Its interest continues. The United States may bring suit to cancel patents obtained by fraud.

*Example 1:* A patent examiner participated in examining a patent application filed by the Z Company. After leaving the Office and becoming a registered patent attorney, she may not represent Z Company in a request for reexamination of the patent granted on the application, or assist other attorneys in drafting the request. The interest of the United States in preventing both inconsistent results and the appearance of impropriety in the same factual matter involving the same party, Z Company, is direct and substantial.

(iii) “Participate personally and substantially.” (A) Basic requirements. The restrictions of section 207(a) apply

only to those patents and applications in which a former patent examiner had “personal and substantial participation,” exercised “through decision, approval, disapproval, recommendation, the rendering of advice, investigation or otherwise.” To participate *personally* means directly, and includes the participation of a subordinate when actually directed by the former Office employee in the matter. *Substantially* means that the examiner’s involvement must be of significance to the matter, or form a basis for a reasonable appearance of such significance. It requires more than official responsibility, knowledge, perfunctory involvement, or involvement on an administrative or peripheral issue. A finding of substantiality should be based not only on the effort devoted to a matter, but also on the importance of the effort. While a series of peripheral involvements may be insubstantial, the single act of approving or participation in a critical step may be substantial. It is essential that the participation be related to a “particular patent or patent application involving a specific party.” (See paragraph (b)(3)(ii)(A) of this section.)

*Example 1:* A primary examiner is not in charge of patent applications assigned to another examiner having partial signatory authority. The primary examiner is asked by the supervisory patent examiner to be the acting supervisory patent examiner while the latter is on vacation. The primary examiner reviews and approves the second action final rejection in an Office action in a patent application (belonging to the Z Company) of the other examiner having partial signatory authority. Later, the other examiner, with the approval of the supervisory patent examiner, allows the application, and a patent is granted to the Z Company on the application. After retiring and being registered as a patent agent, the former primary examiner is asked by the Z Company to represent the patent owner in filing a reissue application to correct an error in the patent. The primary examiner, having personally and substantially participated by decision, or approval in the particular matter, may not do so.

*Example 2:* A primary examiner is not in charge of, nor has official responsibility for the patent applications of new patent examiners she is training. However, she is frequently consulted as to searches, interpreting the scope of the claims, and drafting Office actions for the applications. Such an individual, as well as the new patent examiners, has personally and substantially participated in the matters.

*Example 3:* A supervisory primary examiner signs a restriction requirement in an Office action prepared by a patent examiner having no signatory authority. The supervisory primary examiner and the patent examiner having no signatory authority have