

related to appeals in reexamination proceedings.

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**SUPPLEMENTARY INFORMATION:** The American Inventors Protection Act of 1999 (AIPA), enacted on November 29, 1999, contained a number of changes to title 35, United States Code (U.S.C.). See Pub. L. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999). The 21st Century Department of Justice Appropriations Authorization Act, enacted on November 2, 2002, contained technical corrections to the AIPA, as well as other technical amendments to title 35, U.S.C. See Pub. L. 107-273, 116 Stat. 1758, 1899-1906 (2002). This final rule revises the rules of practice in title 37 CFR to implement the patent-related provisions of the 21st Century Department of Justice Appropriations Authorization Act (and other related miscellaneous changes).

**I. Third Party Requester Appeal Rights to United States Court of Appeals for the Federal Circuit:** Optional *inter partes* reexamination was newly enacted in the AIPA. The AIPA provided that the patent owner in an *inter partes* reexamination could appeal a decision of the BPAI (adverse to patent owner) to the Federal Circuit. The third party requester of the *inter partes* reexamination, however, was specifically precluded from appealing a decision of the BPAI to the Federal Circuit. See 35 U.S.C. 134(c) as amended by the AIPA, 113 Stat. at 1501A-571. In addition, the AIPA did not permit the third party requester to

be a party to (i.e., participate in) an appeal taken by the patent owner to the Federal Circuit.

The Office published a final rule in December of 2000 revising the rules of practice in patent cases to implement the optional *inter partes* reexamination provisions of the AIPA. See *Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule). Section 1.983 is promulgated to codify in the rules of practice the patent owner's statutory right, under 35 U.S.C. 141, to appeal to the Federal Circuit in *inter partes* reexamination proceedings. Because the third-party requester of an *inter partes* reexamination was previously expressly precluded under 35 U.S.C. 134(c) (as amended by the AIPA) from appealing the decision of the BPAI to the Federal Circuit, the rules of practice did not previously provide for such an appeal. Likewise, because there was no authority in the statute for the third party requester to participate in an appeal taken by the patent owner to the Federal Circuit, no such provision of the rules was provided. Finally, because the third-party requester of an *inter partes* reexamination was precluded under 35 U.S.C. 134(c) (as amended by the AIPA) from appealing the decision of the BPAI to the Federal Circuit, no provision in the rules concerning patent owner participation in a third-party requester appeal was provided.

Section 13106 of Public Law 107-273 now grants the *inter partes* reexamination third party requester the right to appeal an adverse decision of the BPAI to the Federal Circuit. See 35 U.S.C. 315(b)(1). It further authorizes the third party requester to be a party to any appeal taken by the patent owner to the Federal Circuit. See 35 U.S.C. 315(b)(2). Moreover, section 13106 of Public Law 107-273 also permits the patent owner to be a party to an appeal taken by the third party requester to the Federal Circuit. This is so because 35 U.S.C. 315(a)(2) as enacted by the AIPA states that the patent owner involved in an *inter partes* reexamination proceeding "may be a party to any appeal taken by a third-party requester under subsection (b)." Therefore, the Office is revising § 1.983 to implement this statutory revision, and making conforming or ancillary amendments to §§ 1.301, 1.304, and 1.979.

**II. Technical amendments to the inter partes reexamination provisions of the American Inventors Protection Act of 1999:** Section 13202 of Public Law 107-273 made technical corrections to statutory provisions directed to *inter*

*partes* and *ex parte* reexamination. The Office is revising §§ 1.191, 1.303, and 1.913 to address the *inter partes* and *ex parte* reexamination technical corrections.

**III. Other miscellaneous changes made to reexamination proceedings:** Additionally, the Office is revising the *inter partes* reexamination rules to avoid the loss of appeal rights during appeals to the BPAI due to certain inadvertent errors on the part of the patent owner or third party requester. Further, the Office is revising the *inter partes* and *ex parte* reexamination appeal rules generally for clarity. These revisions are made in §§ 1.302, 1.959, 1.965, 1.967, 1.971, and 1.977.

**IV. Patent and Trademark Efficiency Act Amendments:** Section 13203 of Public Law 107-273 is directed to efficiency amendments to the statute. The Office is revising § 1.13(b) to eliminate its requirement for an attestation for certified copies of documents, similar to the elimination of the attestation requirement in 35 U.S.C. 153 as provided in section 13203(c) of Public Law 107-273.

**V. Technical amendment related to eighteen-month publication of applications and provisional rights:** Sections 13204 and 13205 of Public Law 107-273 made technical corrections to provisions directed to the eighteen-month publication of patent applications and provisional rights, and the issuance of patents. The Office is revising §§ 1.14, 1.78, 1.417, and 1.495 to implement the statutory revisions made by these sections of Public Law 107-273.

## Section-by-Section Discussion

**Section 1.1:** Section 1.1(c) is amended to provide separate mail stops for *ex parte* reexamination proceedings and *inter partes* reexamination proceedings. Section 1.1(c) is amended to clarify that the mail stop for *ex parte* reexamination proceedings can only be used for the original request papers for *ex parte* reexamination. The new mail stop for *inter partes* reexamination includes both original request papers and all subsequent correspondence filed in the Office (other than correspondence to the Office of the General Counsel pursuant to § 1.1(a)(3) and § 1.302(c)). Correspondence relating to *inter partes* reexamination proceedings is best handled at one central location where Office personnel have specific expertise in *inter partes* reexamination because of the unique nature of *inter partes* reexamination proceedings.

**Section 1.13:** Section 1.13(b) is amended to delete "attested by an officer of the United States Patent and