

provided under § 1.979(a), the time for filing an appeal shall expire two months after action on the last such request.” In addition, reference to § 1.979(a) in the second sentence is deleted. Further, § 1.304 is amended to include all of the current provisions relating to interferences in § 1.304(i), and to include a new § 1.304(ii) which provides that in *inter partes* reexaminations the time for filing a cross-appeal expires: (1) fourteen days after service of the notice of appeal to the Federal Circuit; or (2) two months after the date of decision of the BPAI, whichever is later.

Section 1.304(a)(1) now provides that an *inter partes* third party requester can appeal to the Federal Circuit and can participate in the patent owner's appeal to the Federal Circuit. The time for filing an appeal to the Federal Circuit will expire two months after “action on the last such request made by the parties,” as opposed to the sentence which precedes the added sentence where time for filing an appeal to the Federal Circuit is stated to expire two months after “action on the request.” Thus, the potential for rehearing or reconsideration by more than one party is now factored into the time for appeal to the Federal Circuit. Since a party may not challenge a BPAI decision in an *inter partes* reexamination in a civil action under 35 U.S.C. 145, § 1.304(a)(1) provides that “the time for filing an appeal shall expire \* \* \*” and not “the time for filing an appeal or commencing a civil action shall expire \* \* \*” (which appears in the sentence which precedes the added sentence).

The revision to § 1.304(a)(1) also conforms to the change to § 1.983, by addressing the potential for cross appeal to the Federal Circuit in an *inter partes* reexamination (in addition to that in an interference).

**Section 1.417:** As discussed with regard to the revision to § 1.14, the statute has been revised to clarify that a translation of the international publication, as opposed to the international application, must be filed in order for a patent owner to obtain the provisional right of a reasonable royalty under 35 U.S.C. 154(d). Accordingly, § 1.417 is amended: (1) To delete “the international publication or”; (2) to add “of the publication” after “English language translation”; and (3) to delete “, unless it is being submitted pursuant to § 1.495,”.

**Section 1.495:** Section 1.495(c) is amended to change “if it was originally filed in another language (35 U.S.C. 371(c)(2))” to “if the international application was originally filed in another language and if any English

language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2)).” The purpose of this revision is to clarify that if an English language translation of the publication has already been filed and the publication was also a translation of the international application, a second translation is not required. Instead, the translation required by 35 U.S.C. 154(d) will satisfy the requirement for a translation under 35 U.S.C. 371(c)(2). In § 1.495(g), the phrase “, except for a copy of the international publication or translation of the international application that is identified as provided in § 1.417,” is deleted because the phrase is unnecessary, since it merely repeats a provision of § 1.417.

**Section 1.913:** Section 1.913 is amended to add the phrase “other than the patent owner or its privies” after “any person,” because section 13202 of Pub. L. 107–273 now clarifies that only the third party requester may file a request for *inter partes* reexamination; a patent owner may not file a request for *inter partes* reexamination. This is consistent with the initial position taken by the Office during the implementation of optional *inter partes* reexamination. See *Rules to Implement Optional Inter partes Reexamination Proceedings*, 65 FR 18153, 18178 (Apr. 6, 2000), 1234 *Off. Gaz. Pat. Office* 93, 116 (May 23, 2000) (proposed rule).

**Section 1.959:** Section 1.959 is amended by adding a new paragraph (f), which provides a non-extendable one-month period for correcting an inadvertent failure to comply with any requirement of § 1.959, when a notice of appeal or cross appeal is submitted. The revision of § 1.959 will permit a remedy of inadvertent defects in a notice of appeal or cross appeal.

Section 1.959 relates to appeals and cross appeals to the BPAI in *inter partes* reexamination proceedings. The requirements for acceptance by the Office of a notice of appeal and cross appeal to the BPAI are: (1) Payment of the appeal fee set forth in § 1.17(b) (§§ 1.959(a) and (b)); (2) identification of the appealed claim(s) (§ 1.959(c)); and (3) signature by the patent owner, the third party requester, or their duly authorized attorney or agent (§ 1.959(c)).

Section 1.959 is amended to provide the third party requester (as well as the patent owner) one opportunity to supply, within one month, the missing fee or missing portion of the fee that was inadvertently not supplied. Section 1.957(a) provides that if “the third party requester files an untimely or

inappropriate comment [or] notice of appeal \* \* \* in an *inter partes* reexamination, the paper will be refused consideration.” Thus, if the third party requester inadvertently fails to pay the appeal fee, or makes a payment which is deficient as to the amount specified in § 1.17(b), the requester's notice of appeal (or cross appeal) will not be considered, and requester's appeal will otherwise be barred. The failure to submit the complete appeal fee is not a “*bona fide* attempt to respond and to advance the prosecution” where “some requirement has been inadvertently omitted” under § 1.957(d) (with requester then given a chance to rectify the inadvertency), since § 1.957(d) applies only to a patent owner and not to a third party requester. In addition, the third party requester does not have the opportunity to “revive” the appeal, as does the patent owner under § 1.137 (further, an extension of the time for filing the notice of appeal (or cross appeal) is not provided for by § 1.956, even if the requester becomes aware of the inadvertency on the last day to remedy it). Thus, the third party requester would be barred from appealing the case when a sufficient payment of the fee is inadvertently not made, in the absence of the present revision to § 1.959. Yet, estoppel attaches to the third party requester which precludes further resolution of the issues that the requester wishes to appeal. Under the statute, requester is estopped from later asserting in any civil action, or in a subsequent *inter partes* reexamination, the invalidity/unpatentability of any claim finally determined to be valid and patentable on any ground the third party requester raised or could have raised in the *inter partes* reexamination. Requester is further estopped from later challenging in a civil action any fact determined in the *inter partes* reexamination. Accordingly, a requester's loss of appeal rights because of an inadvertent payment would be an unduly harsh and extreme measure. Thus, the Office is revising § 1.959 to provide the third party requester one opportunity to supply, within one month, the missing fee or missing portion of the fee. As to the requirements that the notice of appeal (or cross appeal) identify the appealed claim(s) and be signed by the appellant, it may be that an opportunity to remedy the inadvertent failure to comply with same is not precluded by § 1.957(a). The refusal of consideration mandated by that section is directed only to “untimely or inappropriate” notices of appeal (and cross appeal). If so, the failure to sign or identify as