

required might not render the notice untimely, and the paper might be an "appropriate" paper, *i.e.*, the type of paper that is entitled to entry in an *inter partes* reexamination, but is not a complete paper. However, to cover the possibility that failure to comply with the signature or identification of claims requirements of § 1.959(c) could permanently bar the requester's appeal, new § 1.959(f) has been phrased to explicitly encompass these potential defects in a notice of appeal (or cross appeal).

Sections 1.965 and 1.967: Section 1.965(d) is amended by inserting "paragraphs (a) and (c)" in place of "paragraph (c)." Section 1.967(c) is amended by inserting "paragraphs (a) and (b)" in place of "paragraph (b)."

Under former § 1.965, an inadvertent failure to comply with a requirement of § 1.965(a) permanently barred the requester's appeal from going forward. Under former § 1.967, an inadvertent failure to comply with a § 1.967(a) requirement also barred the requester's participation via respondent brief in the patent owner's appeal. Sections 1.965 and 1.967 are revised to provide the appellant and respondent, respectively, with a non-extendable one-month period for correcting an inadvertent failure to comply with a requirement of §§ 1.965(a) and 1.967(a), respectively. This revision of §§ 1.965 and 1.967 is for reasons analogous to those set forth above for the revision of § 1.959. Again, the loss of requester's appeal rights because of a § 1.965(a) inadvertency, and the loss of requester's participation rights because of a § 1.967(a) inadvertency, are considered to be unduly harsh and extreme measures.

It is noted that § 1.965(b) states: "A party's appeal shall stand dismissed upon failure of that party to file an appellant's brief, accompanied by the requisite fee, within the time allowed." Under § 1.965(d), as it has now been revised, the phrase "within the time allowed" in § 1.965(b) includes the filing of an "appellant's brief, accompanied by the requisite fee" within the one-month period for correcting an inadvertency (in failure to comply with a requirement of § 1.965(a) and/or (c)) set forth in § 1.965(d).

Section 1.971: Section 1.971 is amended by designating the sole current paragraph of the section as paragraph (a), and adding new paragraph (b). New paragraph (b) provides a non-extendable one-month period for correcting an inadvertent failure to comply with any requirement of paragraph (a) of § 1.971, when a rebuttal brief is submitted. Existing §§ 1.965(d) and 1.967(c) provide relief for certain non-

compliance inadvertencies in appellant and respondent briefs, respectively. However, prior to the present amendment of § 1.971, there was no relief of this nature provided for rebuttal briefs. Section 1.971 is amended (in a new paragraph (b)) to provide similar relief for inadvertencies in the rebuttal brief. In addition, the phrase "[n]o new ground of rejection can be proposed by a third party requester" is being changed to "[n]o new ground of rejection may be proposed by a third party requester" to more correctly state the limitation.

Section 1.977: Section 1.977(g) is amended by inserting the phrase "when the patent owner is responding under paragraph (b)(1) of this section" at the end of the first sentence of the paragraph, and by adding the following new sentence as the second sentence: "The time period set forth in paragraph (b) of this section may not be extended when the patent owner is responding under paragraph (b)(2) of this section."

Prior § 1.977(g) provided that "[t]he time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956." Thus, an extension of time could be obtained for the filing of a patent owner amendment or showing of facts under § 1.977(b)(1), or the filing of a patent owner request for rehearing of the decision of the BPAI made under § 1.977(b)(2). However, § 1.979(g) stated, and continues to state, that the times for requesting rehearing under § 1.979(a) may not be extended, and a patent owner request for rehearing of the decision of the BPAI made under § 1.977(b)(2) is included as § 1.979(a)(2). Thus, the time for filing a patent owner request for rehearing under § 1.977(b)(2) could not be extended. The present amendment to § 1.977(g) makes it consistent with the language of § 1.979(g). Note further that this revision is consistent with the policy for a streamlined appeal procedure, which is reflected, for example, in § 1.959 (no extension of the time for filing the notice of appeal or cross appeal), § 1.963 (no extension of the time for filing appellant, respondent, and rebuttal briefs), and § 1.979(g) (no extension of the time for filing *any* rehearing request). Thus, it is appropriate that an extension of time cannot be obtained for the filing of a patent owner request for rehearing of the decision of the BPAI made under § 1.977(b)(2), while an extension can be obtained for the filing of a patent owner amendment or showing of facts presented under § 1.977(b)(1), which may be considered a reopening of the examination process, as opposed to the appeal process.

Section 1.979: Section 1.979 is amended by revising its paragraphs (e) and (f) to replace "patent owner" (and its possessive) with "parties to an appeal to the Board of Patent Appeals and Interferences," "party," "any party," or "party's," as applicable. Section 1.979 is also amended by deleting the first and second sentences of paragraph (f). The third sentence of § 1.979(f) is amended to add "to the Board of Patent Appeals and Interferences" after "An appeal" to provide additional clarity. Section 1.979 was formerly drafted to address the situation where an appeal to the Federal Circuit is possible only for the patent owner. The first revision modifies the language of § 1.979 to make it applicable to all parties to the *inter partes* reexamination proceeding, *i.e.*, the patent owner and any *inter partes* reexamination third party requester, who are the parties to the appeal to the BPAI. The second revision deletes the provision for termination of the third party requester's appeal, which was (before the enactment of Public Law 107-273) under criteria different than that for the patent owner (since a third party requester could not appeal to the courts under the statute prior to Public Law 107-273). The first revision to the text of § 1.979(f) makes the criteria for termination the same for all parties to the appeal. Finally, § 1.979(f) is amended to provide that an appeal to the Federal Circuit is terminated when the mandate is issued by the Federal Circuit, which is consistent with a 1998 amendment to Rule 41 of the Federal Rules of Appellate Procedure. *See* the discussion of § 1.197 above.

Undesignated center heading immediately preceding § 1.983: The undesignated center heading immediately preceding § 1.983 is revised by deleting "PATENT OWNER" before "APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT." The undesignated center heading immediately preceding § 1.983 was formerly drafted to address the situation where appeal to the Federal Circuit was possible only by the patent owner. This revision modifies the language to make it applicable to all parties to the *inter partes* reexamination proceeding who are the parties to the appeal to the BPAI.

Section 1.983: Section 13106 of Public Law 107-273 grants the *inter partes* reexamination third party requester the right to appeal an adverse decision of the BPAI to the Federal Circuit. 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.