

315(b)(1). Also, as pointed out above, section 13106 of Public Law 107–273 implicitly permits the patent owner to be a party to the newly provided appeal taken by the third party requester to the Federal Circuit. Section 1.983 is amended to track this newly enacted legislation by revising its heading, dividing the existing text into paragraphs (a) and (b), revising the text of newly designated paragraphs (a) and (b), and adding new paragraphs (c) through (f).

The heading of § 1.983 is amended by changing “Patent owner appeal” to “Appeal.”

Section 1.983(a) is amended to permit the patent owner and any third party requester who is a party to an appeal to the BPAI to: (1) appeal the BPAI’s decision to the Federal Circuit; and (2) be a party to any appeal to the Federal Circuit taken from the BPAI’s decision.

Section 1.983(b) is amended to clarify that service of the notice of appeal or cross appeal must be made on every other party to the reexamination proceeding as required in § 1.903. The explicit statement of requirement for service on other parties also provides antecedent for the fourteen-day period recited in paragraph (e) of § 1.983 that follows.

Section 1.983 is amended to add paragraphs (c) and (d) to provide for a cross appeal to the Federal Circuit within fourteen days of service of an opposing party’s notice of appeal to the Federal Circuit. This is analogous to the cross appeal (within fourteen days of service of the notice of appeal) provided for in § 1.304(a)(1) for interferences. The interferences model is used, because an interference is the only other *inter partes* proceeding appealed to the Court from the decision of the BPAI. It is noted that if the two-month time period from the BPAI’s decision will expire after the fourteen-day period set for a cross appeal, then the later-expiring two-month period will control. Thus, where a first party files an appeal to the court (the Federal Circuit) fourteen days after the BPAI’s decision, an opposing party need not file a cross appeal fifteen days later (twenty-nine days after the BPAI’s decision), but rather has the remainder of the two-month period to do so.

A new paragraph (e) is added to § 1.983, to set forth the action a party must take in order to participate in an appellant’s appeal (including cross appeal). Participation in the appellant’s appeal is directed to providing argument supporting the decision of the BPAI. Such participation is in contrast to the cross appeal which is provided for in paragraphs (c) and (d) of § 1.983,

where a party challenges a decision of the BPAI adverse to that party. New paragraph (f): Section 13106(d) of Public Law 107–273 provides the effective date for the revision to the statute made in section 13106 as follows: “[t]he amendments made by this Section apply with respect to any reexamination proceeding commenced on or after the date of enactment of this Act.”

Accordingly, § 1.983 is amended to add a new paragraph (f) stating: “[n]otwithstanding any provision of the rules, in any reexamination proceeding commenced prior to November 2, 2002, the third party requester is precluded from appealing and cross appealing any decision of the BPAI to the Federal Circuit, and the third party requester is precluded from participating in any appeal taken by the patent owner to the Court.”

*Response to comments:* The Office published a notice proposing changes to the rules of practice to implement the patent-related provisions in the intellectual property title of the 21st Century Department of Justice Appropriations Authorization Act. See *Changes to Implement the 2002 Inter Partes Reexamination and other Technical Amendments to the Patent Statute*, 68 FR 22343 (Apr. 28, 2003), 1270 *Off. Gaz. Pat. Office* 106 (May 20, 2003) (proposed rule). The Office received six written comments (from intellectual property organizations, patent practitioners, and the general public) in response to this notice. While the comments were for the most part favorable to the changes proposed, a number of issues were raised. The comments which raise issues, and the Office’s responses to these comments, now follow:

*Comment 1:* The comments of all three intellectual property associations which provided comments focused on the revision that was proposed for §§ 1.949 and 1.953, to issue a Right of Appeal Notice (under § 1.953) after all claims are found patentable, without first issuing an Action Closing Prosecution (under § 1.949). The comments noted that the revision was proposed in an effort to streamline *inter partes* reexamination prosecution, based on the assumption that a patent owner “presumably” would not file any further comments after receiving a notice that all claims are patentable. The comments then pointed out that while it is possible that this assumption should cover most situations, the proposed revision would eliminate an important safeguard for the patent owner in circumstances where the assumption is not correct. An example was given where a patent owner would wish to respond after all

claims are allowed, but would be precluded from doing so under the proposal. A patent owner receiving notice that all claims are found patentable might very well decide to propose an amendment at that point, if the patent owner disagrees with the examiner’s statement of reasons for allowance or statement of claim interpretation. If, as proposed, a Right of Appeal Notice would be the paper that first informs a patent owner that all claims have been found patentable, then the patent owner would be precluded from submitting such an amendment in the proceeding. One comment asserted that in the instance of a first action indication of patentability of all claims and simultaneous issuance of a Right of Appeal Notice, the proposed revision could deny the patent owner its statutory right to propose amendments during reexamination pursuant to 35 U.S.C. 314(a), since amendments to claims are expressly barred once the Right of Appeal Notice is issued.

Based on the above, the comments urge that the Office retain the current practice of issuing an Action Closing Prosecution in all cases where the request for *inter partes* reexamination is granted, even after all claims in the proceeding have been found patentable.

*Response:* In view of the comments, the proposed revision of §§ 1.949 and 1.953 will not be adopted. The public response expresses a view that the need to always provide the patent owner with an opportunity to comment after all claims are found patentable outweighs the pendency reduction benefit that would result from bypassing the issuance of an Action Closing Prosecution and directly issuing a Right of Appeal Notice. In view of the preference stated in the comments that the patent owner should always be given an opportunity to comment after all claims are found patentable (by issuing an Action Closing Prosecution under § 1.949, after which patent owner can comment under § 1.951(a)), the proposal to revise §§ 1.949 and 1.953 has been withdrawn.

One of the comments suggested that the Office’s objective of streamlining prosecution (after a determination of patentability of all claims) could be achieved by providing patent owner with an opportunity to expressly waive its right to submit comments/amendments under current § 1.951(a) upon notice that all claims have been found patentable. It is noted, however, that such a right already exists, because the patent owner is free to file, after an Action Closing Prosecution under § 1.949, a paper stating that no comments/amendments will be filed