

under current § 1.951(a). Thus, a new provision is not needed to implement the suggestion.

As a final point, it is noted that (contrary to a statement made in one of the comments) under the current practice, an Action Closing Prosecution will not be issued in all cases where a request for *inter partes* reexamination is granted. Where all claims are rejected in a first Office action (for example) and the patent owner fails to respond, a Notice of Intent to Issue a Reexamination Certificate will issue canceling all the patent claims, and there is no need for an Action Closing Prosecution. Also, if the ordered reexamination is vacated, where appropriate, prior to the issuance of an Action Closing Prosecution, there will be no Action Closing Prosecution issued in the proceeding.

*Comment 2:* One comment points out that the effective date language in section 4608 of the AIPA changes to 35 U.S.C. 134 and 35 U.S.C. 145 was to be “phased in only years after enactment,” *i.e.*, only for an *ex parte* reexamination that was based upon an original application filed on or after November 29, 1999. This would have taken many years to become effective, thus providing a gradual transition. Instead, the comment notes, Public Law 107–273 accelerates the effective date provision to apply to any reexamination filed on or after November 29, 1999 (*i.e.*, nearly three years ago). The comment urges that this change has accelerated the existence of a situation where an examiner can “suppress a case from appellate review ‘forever’ simply by refraining from making a rejection final.” The comment requests relief from this situation.

*Response:* If a patent owner believes that a reexamination proceeding is being “suppressed” from appellate review by the examiner’s refraining from making a rejection final, the patent owner may file a petition under § 1.181(a) requesting that the most recent Office action by the examiner be designated as a final rejection so as to permit an appeal. Such a petition should be accompanied by a showing as to why the most recent Office action should have been designated as a final rejection. If such a petition is denied by the Technology Center Director, the patent owner could seek further review by way of a petition under § 1.181(a)(3) requesting higher level review of the decision of the Technology Center Director. Since a petition under § 1.181 does not operate to stay the reexamination proceeding (§ 1.181(f)), it is advisable that the petition under § 1.181(a) be accompanied by a notice of

appeal and appeal fee set forth in § 1.17(b) (which will be refunded as unnecessary if the petition is denied) and a request for an extension of time under § 1.550(c) to respond to the most recent Office action (since an appeal is not a proper response to a non-final Office action and the period for response to the Office action continues to run if the petition is denied). However, it must be remembered that in no case can the period for response be extended so as to expire later than six months from the date of the most recent Office action.

*Comment 3:* Two comments have suggested that the Office permit *inter partes* reexamination of patents issuing from original applications filed in the United States prior to November 29, 1999. One of the comments argues that the Office’s statement that the effective date language in section 4608 of the AIPA limited the applicability of *inter partes* reexamination (and conforming amendments) to patents issuing from original applications filed in the United States on or after November 29, 1999, is “bad law, bad policy for the patent system and bad policy for the Patent and Trademark Office.” The commenter then presents a constitutional argument to support this. The same comment further argues that the *inter partes* reexamination effective date provision of the AIPA has been repealed by implication, based upon the legislative expansion of third party requester appeal rights provided by Public Law 107–273. The comment further urges that, if its proposal is not adopted, then third party requester participation in *ex parte* reexamination which would be analogous to that provided by statute for *inter partes* reexamination should be permitted by rule for patents issuing from an original application filed in the United States prior to November 29, 1999.

*Response:* Section 4608 (effective date) of the AIPA provides: “this subtitle and the amendments made by this subtitle shall take effect on the date of the enactment of this Act [November 29, 1999] and shall apply to any patent that issues from an original application filed in the United States on or after that date [November 29, 1999].” See Pub. L. 106–113, 113 Stat. at 1501A–572. The plain language of the statute is clear and is not ambiguous. The enacted *inter partes* provisions of the AIPA are clearly stated (in Section 4608) to apply “to any patent that issues from an original application filed in the United States on or after” the date of enactment (November 29, 1999).

To the extent that it is argued that this provision is unwise and should not be

adhered to, and that Art. I, § 8, cl. 8 of the U.S. Constitution (Congress shall have the power \* \* \* “[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries”) provides a basis for the Office to ignore the limitations in the AIPA on the applicability of *inter partes* reexamination, it is noted that the Federal courts have generally held that the power of Congress to legislate on the subject of patents is plenary by the terms of the Constitution. See *e.g.*, *McClurg v. Kingsland*, 42 U.S. (1 How.) 202, 206 (1843); see also *Owen v. Heimann*, 12 F.2d 173, 174 (D.C. Cir.), cert. denied, 271 U.S. 685 (1926) (“Congress has full power to prescribe to whom and upon what terms and conditions a patent shall issue”); *Kling v. Haring*, 11 F.2d 202, 204–05 (D.C. Cir.), cert. denied, 271 U.S. 671 (1926) (same). In any event, administrative agencies do not have the authority to declare unconstitutional the laws they are charged with administering. See, *e.g.*, *Oestereich v. Selective Service Board*, 393 U.S. 233, 242 (1968); *McGowan v. Marshall*, 604 F.2d 885, 892 (5th Cir. 1979); and *Buckeye Industries, Inc. v. Secretary of Labor*, 587 F.2d 231 (5th Cir. 1979).

As to the argument that the *inter partes* reexamination effective date provision of the AIPA has been repealed by implication, based upon the legislative expansion of third party requester appeal rights provided by Public Law 107–273, Congress is well versed in the mechanism for changing an effective date of prior legislation (as it did for the eighteen-month publication provisions of the AIPA), and Congress did not do so for the *inter partes* reexamination effective date provisions of the AIPA. It is noted that a proposed revision to the *inter partes* reexamination eligibility effective date was explicitly placed before Congress by way of Section 3(a) of H.R. 2231 introduced on June 19, 2001, and referred to the House committee. See H.R. 2231, 107th Cong., 1st Sess. (2001). Thus, an explicit provision to revise the *inter partes* reexamination effective date was before Congress; yet, it was not carried forward into Public Law 107–273.

As to the suggestion that third party requester participation rights (analogous to those provided by statute for *inter partes* reexamination) should be provided by rule for *ex parte* for patents issuing from an original application filed in the United States prior to November 29, 1999, the statute does not provide authority for a third party