

requester of a reexamination proceeding requested under 35 U.S.C. 302 to file a paper directed to the issues during the examination of the reexamination proceeding. The statute and its intent are clear that the reexamination proceeding under 35 U.S.C. 302 must be *ex parte* and third party requester participation is barred by statute. See *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 882 F.2d 1570, 1573, 11 USPQ2d 1866, 1868–69 (Fed. Cir. 1989) (third parties do not participate before the Office). While the third party requester is permitted by statute pursuant to 35 U.S.C. 304 to file a “reply” prior to the examination stage if the patent owner files a statement under 35 U.S.C. 304, that is the only paper directed to the merits of the proceeding authorized to a requester that files an *ex parte* reexamination.

Comment 4: One comment points out that a reexamination requester may “piggyback” a second or subsequent reexamination onto an ongoing reexamination proceeding with the possibility of merged proceedings and thus thwart a final rejection being made as the second action in the ongoing reexamination, with a first Office action then being issued for the merged proceeding. The commenter further notes that a requester could “hamstring a reexamination proceeding to keep a case bottled up in the examining corps forever” by filing multiple requests for reexamination based on the same patent.

Response: Section 2283 of the Manual of Patent Examining Procedure states that:

Once the files are returned to the examiner for issuance of an Office action, the examiner should prepare an Office action at the most advanced point possible for the first proceeding. Thus, if the first proceeding is ready for a final rejection and the second proceeding does not provide any new information which would call for a new ground of rejection, the examiner should issue a final rejection for the merged proceeding using the guidelines for the prosecution stage set forth below.

See Manual of Patent Examining Procedure § 2283 (8th. ed. 2001) (Rev. 1, Feb. 2003) (MPEP).

Thus, the examiner is directed to, where possible, prepare an Office action at the most advanced point possible for the ongoing (first) proceeding, which in the commenter’s scenario is the final rejection stage. If, however, a new issue (e.g., new art, combining the old art a new way, or new evidence) that precludes a final rejection is raised by the later request, a final rejection would not be issued. In that instance, public policy dictates that the substance of the

later request be considered and applied in order that only valid patent claims result from the reexamination proceeding, *i.e.*, to prevent the public from being barred from using claimed subject matter for which protection is not warranted. It is noted that even in this situation, the patent owner would be free to file a petition under § 1.181 requesting that the Office action be designated as a final rejection (see response to comment 2).

A patent owner faced with the filing of multiple reexamination requests on a patent may obtain relief if it can be shown that the newly filed reexamination request was filed: (1) by the same real party in interest who filed a previous request (rather than another party who wishes to approach the issue in its own way), and (2) without providing a new issue in the form of new art or viewing art previously applied in the reexamination proceeding in a new light. If a *bona fide* new issue is, however, raised by the later request, public policy dictates that the substance of the later request be considered and applied in order to resolve the new issue such that only valid patent claims result from the reexamination proceeding.

Comment 5: One comment raises a concern that there is no express requirement in § 1.953 for an examiner to set forth grounds for not making any third party proposed rejections (as is required in existing § 1.949) upon a determination of patentability of all claims.

Response: Initially, it is noted that § 1.953 (c) states “The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim”. Thus, the commenter’s concern is in fact addressed in the rule.

It is also noted that in any Office action (in an *inter partes* reexamination) where an examiner declines to adopt a rejection proposed by a third party requester, the examiner must explicitly identify the proposed rejection, state that the proposed rejection is not adopted, and set forth grounds for not adopting the proposed rejection. This will be covered in a new chapter of the MPEP which will be directed to *inter partes* reexamination. It is noted, however, that if the third party requester then fails to address and contest the refusal to adopt the proposed rejection

at the first opportunity to do so, such will be taken as an acquiescence to the examiner’s position. In such a case, the proposed ground of rejection will be withdrawn from further consideration in the proceeding, will not be addressed in future Office actions, and will not serve as a basis for appeal in any subsequent appeal that may be taken by the requester in the proceeding.

Comment 6: Two comments suggested that an inconsistency was raised by the statement in the notice of proposed rule making that an Action Closing Prosecution (or Right of Appeal Notice) can be issued “even though the Office action being issued is the first action on the merits.” It is argued that if a request for reexamination does not present prior art printed publications and patents that provide a *prima facie* case of unpatentability (or come “exceedingly close” to it), then the Office should not have issued an order for reexamination in the first place, but rather should have denied the request (and thus the first Office action stage should not be reached). Stated another way, it is argued that finding all the claims patentable over the art at the first action stage should be inconsistent with ordering reexamination based on such art.

Response: A finding that all of the claims are patentable over the art at the first action stage is not inconsistent with the prior order of reexamination based on such art. See MPEP 2240. The initial decision on a request for reexamination is based upon whether or not a “substantial new question of patentability” is raised by the art (the patents and/or printed publications). See *id.* Where a finding is made that a substantial new question of patentability has been raised, the examiner has only determined that there is a “substantial likelihood” that a reasonable examiner would consider the art of record important in deciding whether or not the claims are patentable. See MPEP 2242. After reexamination has been ordered, it is then determined, in the examination stage of the proceeding, whether or not the claims are patentable over the art. See MPEP 2240. At the time when the first Office action is issued, if one or more claims are not patentable over the art, the claims will be rejected based on that art. If claims are found patentable over the art, the action will state that finding (and supporting reasons). A decision that all the claims are patentable at this point does not negate the initial finding that a substantial new question of patentability was raised by the art, because reexamination will be ordered as long as a reasonable