

include information for persons wishing to observe the round table meeting.

FOR FURTHER INFORMATION CONTACT:

Angie Reilly by telephone at (703) 305-9300 or by electronic mail at interpartesreexam@uspto.gov.

SUPPLEMENTARY INFORMATION:

Background

Ex parte reexamination of patents, and the procedures for same, were enacted by Congress in 1980 to serve as expedited, low-cost alternatives to patent litigation in reviewing certain aspects of patent validity. Subsequent Congressional review indicated that *ex parte* reexamination of patents was being used infrequently, primarily because a third party who requested reexamination was unable to participate after initiating the reexamination proceeding. Interested parties suggested that the volume of lawsuits in district courts would be reduced if third parties were encouraged and able to use reexamination procedures that provided an opportunity to argue their case for patent invalidity at the USPTO. To address those concerns and provide such an opportunity, Congress enacted the "Optional *Inter Partes* Reexamination Procedure Act of 1999" as Subtitle F of the "American Inventors Protection Act of 1999" (Pub. L. 106-113). While the existing *ex parte* reexamination procedures remain intact, the separate optional *inter partes* reexamination procedures enacted in 1999 permit third party requesters to submit a written comment each time the patent owner files a response to the USPTO, to appeal an adverse decision of the patent examiner to the Board of Patent Appeals and Interferences (BPAI), and to participate in a patent owner's appeal to the BPAI in support of the patent examiner's rejection of claims. Third party requesters did not, however, have the ability to appeal further to the Court of Appeals for the Federal Circuit, nor to participate in the patent owner's appeal to the Court. In addition, an estoppel adverse to a third party requester (which does not exist in *ex parte* reexamination) attaches, if the requester is unsuccessful in the *inter partes* reexamination proceeding. The 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. (35 U.S.C. 315(c).) Also, the requester is estopped from later challenging in a civil action any "fact" determined in the

inter partes reexamination. (Section 4607 of the Optional *Inter Partes* Reexamination Procedure Act of 1999.)

In order to make the optional *inter partes* procedures a more attractive alternative to litigation, Congress enacted, in 2002, sections 13105 and 13106 of subtitle A of the 21st Century Department of Justice Appropriations Authorization Act (Pub. L. 107-273). Those sections (1) provide third party *inter partes* reexamination requesters with the right to appeal to the Court of Appeals for the Federal Circuit and to participate in the patent owner's appeal to the Court and (2) clarify that reexamination (both *ex parte* and *inter partes* reexamination) may be based on a patent or printed publication previously cited by or to USPTO, or considered by USPTO, as long as a substantial new question of patentability is raised. The estoppel provisions of the Optional *Inter Partes* Reexamination Procedure Act of 1999 were not, however, deleted by the Justice Appropriations Authorization Act.

To assist Congress in its continuing oversight of patent operations, Section 4606 of the "Optional *Inter Partes* Reexamination Procedure Act of 1999" includes the requirement that the USPTO submit to the Congress, within five years of the 1999 enactment, a report evaluating whether the *inter partes* reexamination proceedings established by the Act are "inequitable to any of the parties in interest." If inequity is determined to exist, the USPTO's report must then contain "recommendations for changes * * * to remove such inequity."

Request for Comments

To aid the USPTO in compiling the required report to Congress, the USPTO requests that interested parties having comments and/or recommendations on promoting equity in *inter partes* reexamination proceedings submit same to the USPTO. It is suggested that any such input to the USPTO include responses to the following questions:

- (1) Do you qualify as, or do you represent, a small entity?
- (2) Have you been a participant, *i.e.*, a third party requester or a patent owner party, in one or more *inter partes* reexamination proceedings?
- (3) Are *inter partes* reexamination proceedings inequitable to any of the parties in interest?
- (4) What particular procedures or lack of procedures do you feel are inequitable?
- (5) What administrative action(s) should USPTO take to remove the identified inequities?

(6) What legislative/statutory action(s) should Congress take to remove the identified inequities?

Comments must be received by February 20, 2004, to ensure consideration. Such comments should be addressed as indicated above, and clearly identified as Comments in response to the **Federal Register** Notice titled "Request for comments and notice of round table meeting regarding The Equities of *Inter Partes* Reexamination Proceedings."

Round Table Meeting

In addition, the USPTO will conduct a round table meeting to hear views on the effectiveness and possible improvement of *inter partes* reexamination proceedings. The round table meeting is tentatively scheduled for February 17, 2004, in USPTO offices in Arlington, Virginia.

Requests to participate in the round table meeting must be received by January 28, 2004. Such requests should be addressed as indicated above, and clearly identified as requests to participate in the round table meeting. The USPTO will make reasonable efforts to balance the interests represented at the round table meeting tentatively scheduled for February 17, 2004. If it becomes necessary to limit the number of participants, preference will be given to first-in-time requests. Notice of the specific time and location for the round table meeting will be communicated to participants and posted on USPTO's Web site at www.uspto.gov. That notice also will include information for persons wishing to observe the round table meeting.

Dated: December 19, 2003.

Jon W. Dudas,

Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office.

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DEPARTMENT OF DEFENSE

Office of the Secretary

**Submission for OMB Review;
Comment Request**

ACTION: Notice.

The Department of Defense has submitted to OMB for clearance, the following proposal for collection of information under the provisions of the Paperwork Reduction Act (44 U.S.C. Chapter 35).