during a reexamination proceeding, has filed a notice of appeal to the Court of Appeals for the Federal Circuit, or who has participated as a party to an appeal by the patent owner, under the provisions of 35 U.S.C. 141 to 144, is estopped from later asserting, in a subsequent reexamination proceeding, the invalidity of any claim determined to be patentable on appeal on any ground which the third party requester, or its privy, raised or could have raised during the prior reexamination proceeding. A third party requester, or its privy, is deemed not to have participated as a party to an appeal by the patent owner unless, within twenty days after the patent owner has filed notice of appeal, the third party (or its privy) files notice with the

Commissioner electing to participate. Proposed § 1.911 provides factors for consideration of privies and persons bound. For the purposes of § 1.907, a determination of whether person is a privy with respect to the patent owner shall include consideration of whether there is: (1) a mutual, concurrent or successive relationship to the same property rights in the patent involved in the reexamination proceeding; or (2) representation of the interests of the patent owner concerning the patent. For the purposes of §§ 1.907 and 1.909, a determination of whether a person is a privy with respect to a third party requester shall include consideration of whether there is: (1) a mutual, concurrent or successive relationship to the same property rights which are or may be affected by and/or infringe the patent involved in the reexamination proceeding; or (2) representation of the interests of the other party which are or may be affected by and/or potentially infringe the patent. For the purposes of §§ 1.907 and 1.909, a person who is not a party to the reexamination proceeding but who controls or substantially participates in the control of the presentation of the reexamination proceeding on behalf of a party is bound by the determination of issues decided as though he or she were a named party. To have control of the presentation requires that person to have effective choice as to the legal theories and/or grounds of rejection or defenses to be advanced on behalf of the party to the reexamination proceeding. Under this section a party would be precluded from hiring another law firm and having that firm file a subsequent reexamination request in order to avoid the

prohibitions of 35 U.S.C. 307(c) or 308.

Proposed § 1.913 sets forth procedures for any person to request reexamination in accordance with 35 U.S.C. 302 and limits the period for such request to the

period of enforceability of the patent for which the request is filed.

Proposed § 1.915(a) requires payment of the fee for requesting reexamination. Paragraph (b) of new § 1.915 indicates what each request for reexamination must include. Paragraph (c) of new § 1.915 covers amendments which a patent owner can propose. Such amendments can accompany a request for reexamination by the patent owner. Paragraph (d) indicates that requests for reexamination may be filed by attorneys or agents on behalf of a requester, but it is noted that the real party in interest must be identified in accordance with § 1.915(b)(10).

Proposed § 1.917 indicates what will be done if the request is incomplete.

Proposed § 1.919 indicates the date on which the entire fee is received will be considered to be the date of the request for reexamination.

Proposed § 1.921 provides that prior art submissions by the third party requester filed after the reexamination order shall be limited solely to prior art which is used to rebut a finding a fact by the examiner or a response of the patent owner.

Proposed § 1.923 relates to a determination as to whether the request has presented a substantial new question of patentability under 35 U.S.C. 303 and requires that the determination be made within 3 months of the filing date of the request.

Proposed § 1.925 refers to the refund provisions.

Proposed § 1.927 provides for review by petition to the Commissioner of any decision refusing reexamination.

Proposed § 1.929 provides for reexamination at the initiative of the Commissioner under the provisions of the last sentence of paragraph (a) of 35 U.S.C. 303.

Proposed § 1.931 provides for ordering reexamination where a substantial new question of patentability has been found pursuant to §§ 1.923 or 1.929. Under paragraph (b), the only limitation placed on the selection of the examiner by the Office is that the same examiner whose decision was reversed on petition ordinarily will not conduct the reexamination.

Proposed § 1.933 covers the duty of disclosure by a patent owner in a reexamination proceeding involving the owner's patent.

Proposed § 1.935 indicates that the initial Office action normally accompanies the reexamination order.

Proposed § 1.937 provides that in accordance with 35 U.S.C. 305(c), unless otherwise provided by the Commissioner for good cause, all

reexamination proceedings will be conducted with special dispatch. Paragraph (b) covers the basic items relating to the conduct of reexamination proceedings.

Proposed § 1.939 provides that no paper shall be filed before the first Office action.

Proposed § 1.941 provides for proposed amendments provided for the second sentence of 35 U.S.C. 305.

Amendments submitted by the patent owner cannot enlarge the scope of a claim in the patent. Amendments will not be effectively entered into the patent until the certificate under § 1.997 and 35 U.S.C. 307 is issued.

Proposed § 1.943 provides a page limit for responses and briefs of 50 pages. Prior art references and Appendix of claims would not be included in this total.

Proposed § 1.945 provides that a patent owner will be given at least thirty days to respond to any Office action. Although problems may arise in certain cases and extensions of time may be granted, it is felt that relatively short response times are necessary in order to process reexaminations with "special dispatch."

Proposed § 1.9347 provides that in accordance with 35 U.S.C. 305(b)(3), if a patent owner files a response to any Office action on the merits, the third party requester may once file written comments.

Proposed § 1.949 provides when prosecution may be closed.

Proposed § 1.951 provides for responses by the parties after an Office action closing prosecution. The responses and time periods provided for by paragraphs (a) and (b) may run concurrently.

Proposed § 1.953 provides that, following the responses or expiration of the time for response in § 1.951, the examiner may issue a right of appeal notice which shall include a final rejection or final decision favorable to patentability in accordance with 35 U.S.C. 134. The intent of limiting the appeal rights until after the examiner issues a "Right of Appeal Notice" is to specifically preclude the possibility of one party attempting to appeal prematurely while prosecution before the examiner is being continued by the other party.

Proposed § 1.955 relates to the conduct of interviews in reexamination proceedings. The third party requested is permitted to attend all interviews. Interviews are permitted before the first Office action only when initiated by the examiner.

Proposed § 1.957 relates to extensions of time and termination of