reexamination proceedings. In circumstances where the response by the patent owner is not required by the examiner and is merely discretionary, such as when all claims are allowed or their patentability is confirmed and the patent owner is merely given the opportunity for comment, such a failure to comment is not type of lack of response contemplated by paragraphs (b) and (c) and, therefore, not grounds for termination or limiting prosecution.

Proposed § 1.958 relates to revival of

terminated proceedings.

Proposed § 1.959 relates to appeals and cross appeals to the Board of Patent Appeals and Interferences. Both patent owners and third party requesters are given appeal rights in accordance with 35 U.S.C. 306.

Proposed § 1.961 relates to time of transfer of the jurisdiction of the appeal over to the Board of Patent Appeals and Interferences.

Proposed § 1.962 relates to the definition of appellant and respondent.

Proposed § 1.963 relates to the time periods for filing briefs.

Proposed § 1.965 relates to the appellant brief.

Proposed § 1.967 relates to the respondent brief.

Proposed § 1.969 relates to the examiner's answer.

Proposed § 1.971 relates to the reply brief.

Proposed § 1.973 relates to the oral hearing.

Proposed § 1.975 relates to affidavits or declarations after appeal.

Proposed § 1.977 relates to the decision by the Board of Patent Appeals and Interferences.

Proposed § 1.979 relates to the procedures following the decision by the Board of Patent Appeals and Interferences.

Proposed § 1.981 relates to the procedure for reopening prosecution following the decision by the Board of Patent Appeals and Interferences.

Proposed § 1.983 relates to appeals to the United States Court of Appeals for the Federal Circuit, in accordance with 35 U.S.C. 306. Under H.R. 1732, civil actions under 35 U.S.C. 145 are not permitted in reexamination proceedings filed on or after January 1, 1996.

Proposed § 1.985 relates to notification or prior or concurrent proceedings.

Proposed § 1.987 relates to the stay of concurrent proceedings. Decisions as to whether to delay or combine cases will be made on a case-by-case basis to minimize delays and to protect the interests of all parties concerned.

Proposed § 1.989 relates to the merger of concurrent proceedings.

Proposed § 1.991 relates to the merger of a concurrent reissue application and a reexamination proceeding.

Proposed § 1.993 relates to the stay of a concurrent interference and reexamination proceeding.

Proposed § 1.995 relates to a third party requester's participation rights being preserved in merged proceeding.

Proposed § 1.997 concerns the issuance of the reexamination certificate under 35 U.S.C. 307 after the conclusion of reexamination proceedings. The certificate will cancel any patent claims determined to be unpatentable, confirm any patent claims determined to be patentable, and incorporate into the patent any amended or new claim determined to be patentable. Once all of the claims have been canceled from the patent, the patent ceases to be enforceable for any purpose. Accordingly, any pending reissue or other Office proceeding relating to a patent in which such a certificate has been issued will be terminated.

This provides a degree of assurance to the public that patents with all the claims canceled via reexamination proceedings will not again be asserted. It is intended that copies of the certificate will continue to be part of subsequently sold copies of the patent.

Other Considerations

The proposed rule changes are in conformity with the requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*), Executive Order 12612, and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.* It has been determined that this rulemaking is not significant for the purposes of Executive Order 12866.

The Assistant General Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that these proposed rule changes will not have a significant economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The principal impacts of these proposed changes are to expand the grounds for requesting a reexamination and to permit the third party to participate more extensively during the reexamination proceeding as well as having appeal rights.

The Office has also determined that this notice has no Federalism implications affecting the relationship between the National Government and the States as outlined in Executive Order 12612.

These rule changes contain collection of information requirements subject to the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 et seq., which is currently approved by the Office of Management and Budget under Control No. 0651–0033. The public reporting burden for the collection of information for requests for reexamination is estimated to average 2.0 hours each including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information. Send comments regarding this burden estimate or any other aspect of this collection of information, including suggestions for reducing this burden to the Office of System Quality and **Enhancement, Patent and Trademark** Office, Washington, D.C. 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Washington, DC 20503 (ATTN: Paperwork Reduction Act Project 0651-0033).

Notice is hereby given that pursuant to the authority granted to the Commissioner of Patents and Trademarks by 35 U.S.C. 6, the Patent and Trademark Office proposed to amend Title 37 of the Code of Federal Regulations as set forth below.

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.

For the reasons set out in the preamble and under the authority given to the Commissioner of Patents and Trademarks by 35 U.S.C. 6, Part I of Title 37 CFR is proposed to be amended as set forth below.

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 would continue to read as follows:

Authority: 35 U.S.C. 6, unless otherwise noted.

2. Section 1.4(a)(2) is proposed to be revised to read as follows:

§1.4 Nature of correspondence and signature requirements.

(a) * * *

(2) Correspondence in and relating to a particular application or other proceeding in the Office. See particularly the rules relating to the filing, processing, or other proceedings of national applications in Subpart B, §§ 1.31 to 1.378; of international applications in Subpart C, §§ 1.401 to 1.499; or reexamination of patents filed before January 1, 1996, in Subpart D,