- 1.991 Merger of concurrent reissue application and reexamination proceeding.
- 1.993 Stay of concurrent interference and reexamination proceeding.
- 1.995 Third party requester's participation rights preserved in merged proceedings.

Certificate

1.997 Issuance of reexamination certificate after reexamination proceedings.

§1.901 Citation of prior art in patent files.

(a) At any time during the period of enforceability of a patent, any person may cite to the Patent and Trademark Office in writing prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of a particular patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an expansion of how the claims differ from the prior art.

(b) If the person making the citation wishes his or her identity to be excluded from the patent file and kept confidential, the citation papers must be submitted without any identification of the person making the submission.

(c) Citations of patent or printed publications by the public in patent files should either:

(1) reflect that a copy of the same has been mailed to the patent owner at the address as provided in $\S 1.33(c)$; or in the event service is not possible,

(2) be filed with the Office in duplicate.

(d) Except as provided in § 1.902, citations submitted in accordance with this section will be placed and made of record in the patent file.

§1.902 Processing of prior art citations in patent files during a reexamination proceeding.

Citations by the patent owner in accordance with § 1.933 and by a reexamination third party requester under § 1.915 will be entered in the patent file. The entry in the patent file of other citations submitted after the date of an order to reexamine pursuant to § 1.931 will be delayed until the reexamination proceeding has been terminated.

Reexamination Proceedings

§1.903 Service of papers on parties.

The patent owner and any third party requester will be sent copies of Office actions issued during the reexamination proceeding. After filing of a request for reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the third party requester, if any, to timely file or serve documents may result in their being refused consideration.

§1.904 Notice of reexamination in Official Gazette.

A notice of the filing of a reexamination request or initiation of a Commissioner-ordered reexamination will be published in the Official Gazette. The notice in the Official Gazette under § 1.11(c) will be considered to be constructive notice of the reexamination proceeding and reexamination will proceed.

§1.905 Submission of papers by public.

Unless specifically provided for, no submissions on behalf of any third parties other than third party requesters as defined in 35 U.S.C. 100(e) will be considered unless such submissions are in accordance with § 1.915 or entered in the patent file prior to the date of the order to reexamine pursuant to § 1.931. Submissions by third parties, other than third party requesters, filed after the date of the order to reexamine pursuant to § 1.931, must meet the requirements of § 1.901 (a) through (c) and will be treated in accordance with § 1.902.

§1.906 Scope of reexamination in reexamination proceeding.

(a) Claims in a reexamination proceeding will be examined on the basis of patents or printed publications and on the basis of the requirements of 35 U.S.C. 112 except for the best mode requirement.

(b) Claims in a reexamination proceeding must not enlarge the scope of the claims of the patent.

(c) Questions other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such questions are raised by the patent owner or third party requester during a reexamination proceeding, the existence of such questions will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such questions considered and resolved.

§1.907 Reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the patent owner nor the third party requester, if any, nor privies of either, may file a subsequent request for reexamination of the patent until a reexamination certificate is issued under \S 1.997, unless authorized by the Commissioner.

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim in suit, then neither that party nor its privies may thereafter request reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action, and a reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

§1.909 Estoppel of third party requester from previous reexamination proceedings.

A third party requester, or its privy, who, 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 serving, 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's electing to participate.

§1.911 Privies and persons bound.

(a) For the purposes of § 1.907, a determination of whether a 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.

(b) 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