affected by and/or potentially infringe

the patent.

(c) 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.

# **Determining if Reexamination Will Be Ordered**

#### §1.913 Persons eligible.

Except as otherwise provided, any person may, at any time during the period of enforceability of a patent, file a request for reexamination by the Patent and Trademark Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.901 or on the basis of the requirements of 35 U.S.C. 112 except for the best mode requirement.

#### §1.915 Content of request.

- (a) The request must be accompanied by the fee for requesting reexamination set in § 1.20(c).
- (b) Any request for reexamination must include the following parts:
- (1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications or based on the manner in which the patent specification or claims fail to comply with the requirements of 35 U.S.C. 112 except for the best mode requirement.

(2) An identification of every claim for which reexamination is requested.

(3) A detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested or a detailed explanation of the manner in which the specification or claim(s) fail to comply with 35 U.S.C. 112 except for the best mode requirement. If appropriate, the party requesting reexamination may also point out how claims distinguish over cited prior art or how 35 U.S.C. 112 requirements are complied with except for the best mode requirement.

(4) A copy of every patent or printed publication relied upon or referred to in paragraphs (b) (1) and (3) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document.

 $(\bar{5})$  The entire patent for which reexamination is requested must be

furnished in the form of cut-up copies of the original patent with only a single column of the printed patent securely mounted or reproduced in permanent form on one side of a separate paper. A copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent must also be included.

(6) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.

(7) If the patent is currently involved in a reexamination proceeding for which a reexamination certificate has not been issued, a certification that the person making the request is not a privy of the patent owner or third party requester, unless otherwise authorized by the Commissioner.

(8) In a request filed by a third party

requester, a certification that

(i) no final decision has been entered against that party or its privies in a civil action arising in whole or in part under 28 U.S.C. 1338 in which that party or its privies did not sustain its burden of proving the invalidity of any patent claim in suit, and

(ii) neither that party nor its privies are requesting 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.

- (9) In a request filed by a third party requester, a certification that the request does not assert 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 a prior reexamination proceeding in which that party or its privies filed a notice of appeal to the Court of Appeals for the Federal Circuit and/or participated as a party to an appeal by the patent owner, under the provisions of 35 U.S.C. 141 to 144.
- (10) A statement identifying the real party in interest to the extent necessary for a subsequent person filing a reexamination request to determine whether that person is a privy.

(c) A request filed by the patent owner may include a proposed amendment in accordance with § 1.121(f).

(d) If a request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34(a).

## §1.917 Omission of a requirement in the request for reexamination.

If the request is not accompanied by the fee for requesting reexamination or all of the other parts required by § 1.915, the person identified as requesting reexamination will be so notified and given an opportunity to complete the request within a specified time. If the fee for requesting reexamination has been paid but the defect in the request is not corrected within the specified time, the determination whether or not to institute reexamination will be made on the request as it then exists. If the fee for requesting reexamination has not been paid, no determination will be made and the request will be placed in the patent file as a citation if it complies with the requirements of § 1.901 and/or § 1.902.

# § 1.919 Filing date for request for reexamination.

The filing date of the request is the date on which the request including the entire fee for requesting reexamination is received; or, if the request is not initially accompanied by the entire fee, the date on which the last portion of the fee is received in the Patent and Trademark Office.

## §1.921 Submission of prior art by third party following the order for reexamination.

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 of fact by the examiner or a response of the patent owner.

#### §1.923 Examiner's consideration of the request for reexamination.

Within three months following the filing date of a request for reexamination, an examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art cited therein, with or without consideration of other patents or printed publications, or by the failure of the patent specification or claim(s) to comply with the requirements of 35 U.S.C. 112 except for the best mode requirement. The examiner's determination will be used on the claims in effect at the time of the determination and will become a part of the official file of the patent and will be mailed to the patent owner at the address as provided for in § 1.33(c) and to the person requesting reexamination.

#### §1.925 Partial refund if request is denied.

Where no substantial new question of patentability has been found, a refund of a portion of the fee for requesting