

America Invents Act, Patent Law Treaty	Referenced Items (226 , 227 , 228 , 229 , 230 , 231 , 232 , 233 , 234)
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(231)

DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 37 CFR Parts 1, 5, 10, 11, and 41
 [Docket No. PTO-P-2011-0072]
 RIN 0651-AC66

Changes To Implement Miscellaneous
 Post Patent Provisions of the
 Leahy-Smith America Invents Act

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The Leahy-Smith America Invents Act (AIA) expands the scope of information that any party may cite in a patent file to include written statements of a patent owner filed in a proceeding before a Federal court or the United States Patent and Trademark Office (Office) regarding the scope of any claim of the patent, and provides for how such information may be considered in ex parte reexamination, inter partes review, and post grant review. The AIA also provides for an estoppel that may attach with respect to the filing of an ex parte reexamination request subsequent to a final written decision in an inter partes review or post grant review proceeding. The Office is revising the rules of practice to implement these post-patent provisions, as well as other miscellaneous provisions, of the AIA.

DATES: Effective date: The changes in this final rule are effective on September 16, 2012.

FOR FURTHER INFORMATION CONTACT: Joseph F. Weiss, Jr. ((571) 272-7759), Legal Advisor, or Pinchus M. Laufer ((571) 272-7726), Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy.

SUPPLEMENTARY INFORMATION:

Executive Summary: Purpose: Section 6 of the AIA amends the patent laws to create new post-grant review proceedings and replace inter partes reexamination proceedings with inter partes review proceedings. Section 6 of the AIA also provides for an estoppel that may attach with respect to the filing of an ex parte reexamination request subsequent to a final written decision in a post grant review or inter partes review proceeding, expands the scope of information that any person may cite in the file of a patent to include written statements of a patent owner filed in a proceeding before a Federal court or the Office regarding the scope of any claim of the patent, and provide for how such patent owner statements may be considered in ex parte reexamination, inter partes review, and post grant review. Section 3(i) of the AIA replaces interference proceedings with derivation proceedings; section 7 redesignates the Board of Patent Appeals and

Interferences as the Patent Trial and Appeal Board; section 3(j) replaces the title "Board of Patent Appeals and Interferences" with "Patent Trial and Appeal Board" in 35 U.S.C. 134, 145, 146, 154, and 305; and section 4(c) inserts alphabetical references to the subsections of 35 U.S.C. 112.

Summary of Major Provisions: This final rule primarily implements the provisions in section 6 of the AIA to provide for an estoppel that may attach to the filing of an ex parte reexamination request subsequent to a final written decision in a post grant review or inter partes review proceeding, and expands the scope of information that any person may cite in the file of a patent to include written statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of the patent.

[Top of Notices](#) (231) December 29, 2015

US PATENT AND TRADEMARK
OFFICE

1421 CNOG 1264

This final rule revises the ex parte reexamination rules to require that a third party request for ex parte reexamination contain a certification by the third party requester that the statutory estoppel provisions of inter partes review and post grant review do not bar the third party from requesting ex parte reexamination.

This final rule revises the rules of practice pertaining to submissions to the file of a patent to provide for the submission of written statements of the patent owner filed by the patent owner in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of the patent. This final rule requires that such submissions must: (1) Identify the forum and proceeding in which patent owner filed each statement, and the specific papers and portions of the papers submitted that contain the statements; (2) explain how each statement is a statement in which patent owner took a position on the scope of any claim in the patent; (3) explain the pertinency and manner of applying the statement to at least one patent claim; and (4) reflect that a copy of the submission has been served on the patent owner, if submitted by a party other than the patent owner.

This final rule also revises the nomenclature in the rules of practice for consistency with the changes in sections 3(i), 3(j), 4(c), and 7 of the AIA.

Costs and Benefits: This rulemaking is not economically significant as that term is defined in Executive Order 12866 (Sept. 30, 1993).

Background: Sections 3(i) and (j) and section 4(c) of the AIA enact miscellaneous nomenclature and title changes. Section 3(i) of the AIA replaces interference proceedings with derivation proceedings; section 3(j) replaces the title "Board of Patent Appeals and Interferences" with "Patent Trial and Appeal Board" in 35 U.S.C. 134, 145, 146, 154, and 305; and section 4(c) inserts alphabetical designations to the subsections of 35 U.S.C. 112.

Section 6(g) of the AIA amends 35 U.S.C. 301 to expand the information that may be submitted in the file of an issued patent to include written statements of a patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of the patent. This amendment limits the Office's use of such written statements to determining the meaning of a patent claim in ex parte reexamination proceedings that have already been ordered and in inter partes review and post grant review proceedings that have already been instituted.

Section 6(a) and (d) of the Leahy-Smith American Invents Act also

contains provisions (35 U.S.C. 315(e) (1) and 35 U.S.C. 325(e) (1)) estopping a third party requester from filing a request for ex parte reexamination, in certain instances, where the third party requester filed a petition for inter partes review or post grant review and a final written decision under 35 U.S.C. 318(a) or 35 U.S.C. 328(a) has been issued. The estoppel provisions apply to the real party in interest of the inter partes review or post grant review petitioner and any privy of such a petitioner.

Section 6(h) (1) of the AIA amends 35 U.S.C. 303 to expressly identify the authority of the Director to initiate reexamination based on patents and publications cited in a prior reexamination request under 35 U.S.C. 302.

Discussion of Specific Rules: The following is a discussion of the amendments to Title 37 of the Code of Federal Regulations, parts 1, 5, 10, 11, and 41, which are being implemented in this final rule:

Changes in nomenclature: The phrase "Board of Patent Appeals and Interferences" is changed to "Patent Trial and Appeal Board" in §§ 1.1(a) (1) (ii), 1.4(a) (2), 1.6(d) (9), 1.9(g), 1.17(b), 1.36(b), 1.136(a) (1) (iv), 1.136(a) (2), 1.136(b), 1.181(a) (1), 1.181(a) (3), 1.191, 1.198, 1.248(c), 1.701(a) (3), 1.701(c) (3), 1.702(a) (3), 1.702(b) (4), 1.702(e), 1.703(a) (5), 1.704(c) (9), 1.937(a), 1.959, 1.979(a), 1.979(b), 1.981, 1.983(a), 1.983(c), 1.983(d), 1.983(f), 11.5(b) (1), 11.6(d), 41.1(a), 41.2, 41.10(a) through (c), and 41.77(a), and in the title of 37 CFR part 41. Specific references are added to trial proceedings before the Patent Trial and Appeal Board to



US PATENT AND TRADEMARK
OFFICE

1421 CNOG 1265

§§ 1.5(c), 1.6(d), 1.6(d) (9), 1.11(e), 1.136(a) (2), 1.136(b), 1.178(b), 1.248(c), 1.322(a) (3), 1.323, 1.985(a), 1.985(b), 1.993, 10.1(s), 11.10(b) (3) (iii), 11.58(b) (1) (i), 41.30, 41.37(c) (1) (ii), 41.67(c) (1) (ii), and 41.68(c) (1) (ii).

The phrase "Board of Patent Appeals and Interferences" in §§ 1.703(b) (4) and 1.703(e) will be changed to "Patent Trial and Appeal Board" in a separate rulemaking (RIN 0651-AC63).

Specific references are added to derivation proceedings before the Patent Trial and Appeal Board to §§ 1.136(a) (1) (v), 1.313(b) (4), 1.701(a) (1), 1.701(c) (1) (i) and (c) (1) (ii), 1.701(c) (2) (iii), 1.702(b) (2), 1.702(c), 1.703(b) (2), 1.703(b) (3) (iii), 1.703(c) (1) and (c) (2), 1.703(d) (3), and 5.3(b).

Sections 1.51, 1.57, 1.78, 41.37, 41.67, 41.110 and 41.201 are revised to substitute the current references to 35 U.S.C. 112, of first, second, and sixth paragraphs with references to 35 U.S.C. 112 subsections (a), (b), and (f). Section 1.78 is also revised to add "other than the requirement to disclose the best mode" following the references to 35 U.S.C. 112(a) for consistency with the changes to 35 U.S.C. 119(e) and 120 in section 15(b) of the AIA.

Section 1.59 is revised to refer to § 42.7.

Changes to ex parte reexamination procedure:

The undesignated center heading before § 1.501: The undesignated center heading is revised to read "Citation of prior art and written statements."

Section 1.501: Section 1.501 implements the amendment to 35 U.S.C. 301 by section 6(g) (1) of the AIA. New 35 U.S.C. 301(a) (2) provides for any person to submit in the patent file written "statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent." Section 1.501, implementing 35 U.S.C. 301(a) (2),

provides that a submission may include prior art and written patent owner claim scope statements. The term "Federal court" in 35 U.S.C. 301(a)(2) includes the United States Court of International Trade, which is a Federal court, but does not include the International Trade Commission, which is a Federal agency and not a Federal court.

Section 1.501(a): In light of the comments, the scope of what may be submitted has been expanded relative to the proposed rule because the final rule does not prohibit the submission of written statements "made outside of a Federal court or Office proceeding and later filed for inclusion in a Federal court or Office proceeding." Section 1.501(a)(1) provides for the submission to the Office of prior art patents or printed publications that a person making the submission believes to have a bearing on the patentability of any claim of a particular patent. Section 1.501(a)(2) permits any person to submit to the Office statements of the patent owner that were filed by the patent owner in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of the patent. As long as the statement was filed by the patent owner in the proceeding, the statement is eligible for submission under § 1.501(a)(2) even if originally made outside the proceeding. Permitting submission of these claim scope statements is intended to limit a patent owner's ability to put forward different positions with respect to the prior art in different proceedings on the same patent. See H.R. Rep. No. 112-98, Part 1, at page 46 (2011) ("[t]his addition will counteract the ability of patent owners to offer differing interpretations of prior art in different proceedings."). Any papers or portions of papers that contain the patent owner claim scope statement submitted under this paragraph must be accompanied by any other documents, pleadings, or evidence from the proceeding in which the statement was filed that address the statement. Where appropriate, the papers or portions of papers that contain the statement and accompanying information must be submitted in redacted form to exclude information subject to an applicable protective order.

Section 1.501(a)(3) requires that submissions under § 1.501(a)(2) must identify: (1) The forum and proceeding in which patent owner filed each statement; (2) the specific papers and portions of the

 [Top of Notices](#) (231) December 29, 2015

US PATENT AND TRADEMARK
OFFICE

1421 CNOG 1266

papers submitted that contain the statement; and (3) how each statement submitted is a statement in which patent owner took a position on the scope of any claim in the patent. Identification of the portions of the papers required by § 1.501(a)(3)(ii) can be satisfied, for example, by citing to the documents and specific pages of those documents where the patent owner claim scope statements are found. The requirement of § 1.501(a)(3)(iii) ensures that the statement is one in which a patent owner has taken a position on claim scope in a proceeding and not merely a restatement of a position asserted by another party. Other information can, but is not required to, be provided by the submitter to assist the Office in readily identifying the patent owner claim scope statement, such as (1) information regarding the status of the proceeding; and (2) the relationship of the proceeding to the patent.

Section 1.501(b): Section 1.501(b)(1) implements the 35 U.S.C. 301(b) requirement that the submission include an explanation in writing of the pertinency and manner of applying the prior art or written statements to at least one patent claim. Section 1.501(b)(1) requires a submitter to explain in writing the pertinence and manner of applying any prior art submitted under § 1.501(a)(1) and any

written statement and accompanying information submitted under § 1.501(a)(2) to at least one claim of the patent in order for the submission to become a part of the official file of the patent. Where a patent owner claim scope statement and accompanying information are submitted along with prior art, an explanation as to how each patent owner claim scope statement and each prior art reference applies to at least one claim must be included with the submission in order for the submission to become part of the patent file. Section 1.501(b)(1) requires an explanation of the additional information required by 35 U.S.C. 301(c) to show how the additional information addresses and provides context to the patent owner claim scope statement, thereby providing a full understanding as to how the cited information is pertinent to the claim(s).

Section 1.501(b)(2) incorporates the second sentence of former § 1.501(a), which permits a patent owner submitter to provide an explanation to distinguish the claims of the patent from the submitted prior art. Section 1.501(b)(2) also provides a patent owner submitter with the opportunity to explain how the claims of the patent are patentable in view of any patent owner claim scope statement and additional information filed under § 1.501(a)(2), along with any prior art filed under § 1.501(a)(1).

Section 1.501(c): Section 1.501(c) restates the last sentence of prior § 1.501(a) directed to the timing for a submission under §§ 1.502 and 1.902 when there is a reexamination proceeding pending for the patent in which the submission is made.

Section 1.501(d): Section 1.501(d) restates former § 1.501(b) that permits the person making the submission to exclude his or her identity from the patent file by anonymously filing the submission.

Section 1.501(e): Section 1.501(e) requires that a submission made under § 1.501 must reflect that a copy of the submission by a party other than the patent owner has been served upon patent owner at the correspondence address of record in the patent, and that service was carried out in accordance with § 1.248. Service is required to provide notice to the patent owner of the submission. The presence of a certificate of service that is compliant with § 1.248(b) is prima facie evidence of compliance with § 1.501(e). A submission will not be entered into the patent's Image File Wrapper (IFW) if it does not include proof of service compliant with § 1.248(b).

Section 1.501(f): The provisions of proposed § 1.501(f) have been incorporated with specificity in §§ 1.515(a) and 1.552(d) rather than adopted as a separate paragraph of § 1.501. The proposed codification in § 1.501(f) of the limitation set forth in 35 U.S.C. 301(d) on the use of a patent owner claim scope statement by the Office was unnecessary in view of the language of § 1.515(a) and § 1.552(d).

Section 1.510: This final rule revises § 1.510(a) and (b)(2), and adds § 1.510(b)(6) to implement provisions of the AIA.

[Top of Notices](#)

(231) December 29, 2015

US PATENT AND TRADEMARK
OFFICE

1421 CNOG 1267

Section 1.510(a) is revised to reflect the estoppel limitations placed upon the filing of a request for ex parte reexamination by 35 U.S.C. 315(e)(1) and 325(e)(1). In light of the comments, the scope of the estoppel provisions is interpreted to only prohibit the filing of a subsequent request for ex parte reexamination.

Section 1.510(b)(2) is revised to require that any statement of the patent owner submitted pursuant to § 1.501(a)(2), which is relied upon in the detailed explanation, explain how that statement is being used to

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