

Patent Law.
It's what we do
everyday.

New Rules Proposed: Third Party Appeals in *Inter Parte* Reexaminations

In 1999, Congress authorized the *inter parte* reexamination of an issued patent, granting third parties the right to request, and fully participate in, the Patent and Trademark Office's reexamination proceedings. See 35 U.S.C. § 311, *et. seq.* This alternative to litigation in the federal courts received very little interest, in part, due to the subsequent constraints on the third party requestors. Only the patent owner could appeal the PTO's reexamination decision to the Federal Circuit, and a successful reexamination barred the third parties from ever again raising grounds for invalidating the patent that were or "could have been" raised in the *inter parte* reexamination.
35 U.S.C. § 315(c).

Last year, Congress amended the *inter parte* reexamination law to give third parties the right to appeal the PTO's decisions to the Federal Circuit. See 35 U.S.C. § 315 (b). On April 28, 2003, the PTO issued proposed amendments to its regulations, 37 C.F.R. §1.903, *et. seq.*, to implement this change in the law. The proposed amendments also include rule changes permitting patent owners and third parties to correct inadvertent errors in their appeal filings, and measures to streamline the *inter parte* reexamination process so that they can be carried out with "special dispatch."

The rule changes cover, among other issues, the time periods and service requirements for notices of appeals; a definition of final appealable decisions from the PTO Board of Appeals; and the time periods for joining and/or cross-appealing an appeal by other parties to the reexamination. The proposed regulations also limit third party Federal Circuit appeals to those from *inter parte* proceedings commenced after November 2, 2002, the date the changes to the reexamination law went into effect.

By providing third parties the same right to appeal as the patent owner, these rule changes implement a much needed improvement to the *inter parte* reexamination law. The *inter parte* reexamination option now offers a realistic and cost efficient alternative to expensive federal court litigation, when a patent is

wholly or partially invalid in view of prior art patents and printed publications. Moreover, other changes to the reexamination law expressly permit the PTO to commence an *inter parte* reexamination based on prior art considered during the patent's original prosecution, allowing third parties to address issues that the PTO missed or misapprehended in allowing the original patent to issue.

The proposed rule changes can be found at the PTO's web site at www.uspto.gov/web/offices/com/sol/notices/68fr22343.pdf. The PTO will be taking public comments on the proposed changes until June 27, 2003.

For further information, please contact the author [Philip T. Petti](#), of [Fitch, Even, Tabin and Flannery](#).

The information contained in this email is provided for informational purposes only and does not represent legal advice. Neither the APLF nor the author intends to create an attorney client relationship by providing this information to you through this message.