

103^D CONGRESS
2^D SESSION

S. 2341

To amend chapter 30 of title 35, United States Code, to afford third parties an opportunity for greater participation in reexamination proceedings before the United States Patent and Trademark Office, and for other purposes.

IN THE SENATE OF THE UNITED STATES

JULY 29 (legislative day, JULY 20), 1994

Mr. DECONCINI introduced the following bill; which was read twice and referred to the Committee on the Judiciary

A BILL

To amend chapter 30 of title 35, United States Code, to afford third parties an opportunity for greater participation in reexamination proceedings before the United States Patent and Trademark Office, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Patent Reexamination
5 Reform Act of 1994”.

1 **SEC. 2. DEFINITIONS.**

2 Section 100 of title 35, United States Code, is
3 amended by adding at the end thereof the following new
4 subsection:

5 “(e) The term ‘third-party requester’ means a person
6 requesting reexamination under section 302 of this title
7 who is not the patent owner.”.

8 **SEC. 3. REEXAMINATION PROCEDURES.**

9 (a) REQUEST FOR REEXAMINATION.—Section 302 of
10 title 35, United States Code, is amended to read as fol-
11 lows:

12 **“§ 302. Request for reexamination**

13 “Any person at any time may file a request for reex-
14 amination by the Office of a patent on the basis of any
15 prior art cited under the provisions of section 301 of this
16 title or on the basis of the requirements of section 112
17 of this title except for the best mode requirement. The
18 request must be in writing and must be accompanied by
19 payment of a reexamination fee established by the Com-
20 missioner of Patents and Trademarks pursuant to the pro-
21 visions of section 41 of this title. The request must set
22 forth the pertinency and manner of applying cited prior
23 art to every claim for which reexamination is requested
24 or the manner in which the patent specification or claims
25 fail to comply with the requirements of section 112 of this
26 title. Unless the requesting person is the owner of the pat-

1 ent, the Commissioner promptly will send a copy of the
2 request to the owner of record of the patent.”.

3 (b) DETERMINATION OF ISSUE BY COMMISSIONER.—
4 Section 303 of title 35, United States Code, is amended
5 to read as follows:

6 **“§ 303. Determination of issue by Commissioner**

7 “(a) Within three months following the filing of a re-
8 quest for reexamination under the provisions of section
9 302 of this title, the Commissioner will determine whether
10 a substantial new question of patentability affecting any
11 claim of the patent concerned is raised by the request,
12 with or without consideration of other patents or printed
13 publications. On his own initiative, and at any time, the
14 Commissioner may determine whether a substantial new
15 question of patentability is raised by patents and publica-
16 tions discovered by him or cited under the provisions of
17 section 301 of this title or by the failure of the patent
18 specification or claims to comply with the requirements of
19 section 112 of this title except for the best mode require-
20 ment.

21 “(b) A record of the Commissioner’s determination
22 under subsection (a) of this section will be placed in the
23 official file of the patent, and a copy promptly will be given
24 or mailed to the owner of record of the patent and to the
25 third-party requester, if any.

1 “(c) A determination by the Commissioner pursuant
2 to subsection (a) of this section will be final and
3 nonappealable. Upon a determination that no substantial
4 new question of patentability has been raised, the Com-
5 missioner may refund a portion of the reexamination fee
6 required under section 302 of this title.”.

7 (c) REEXAMINATION ORDER BY COMMISSIONER.—
8 Section 304 of title 35, United States Code, is amended
9 to read as follows:

10 **“§ 304. Reexamination order by Commissioner**

11 “If, in a determination made under the provisions of
12 section 303(a) of this title, the Commissioner finds that
13 a substantial new question of patentability affecting any
14 claim of a patent is raised, the determination will include
15 an order for reexamination of the patent for resolution of
16 the question. The order may be accompanied by the initial
17 Office action on the merits of the reexamination conducted
18 in accordance with section 305 of this title.”.

19 (d) CONDUCT OF REEXAMINATION PROCEEDINGS.—
20 Section 305 of title 35, United States Code, is amended
21 to read as follows:

22 **“§ 305. Conduct of reexamination proceedings**

23 “(a) Subject to subsection (b) of this section, reexam-
24 ination will be conducted according to the procedures es-
25 tablished for initial examination under the provisions of

1 sections 132 and 133 of this title. In any reexamination
2 proceeding under this chapter, the patent owner will be
3 permitted to propose any amendment to the patent and
4 a new claim or claims thereto in response to a decision
5 adverse to the patentability of a claim of a patent. No
6 proposed amended or new claim enlarging the scope of the
7 claims of the patent will be permitted in a reexamination
8 proceeding under this chapter.

9 “(b)(1) This subsection shall apply to any reexamina-
10 tion proceeding in which the order for reexamination is
11 based upon a third-party reexamination request.

12 “(2) Any document (other than the reexamination re-
13 quest) filed in a reexamination proceeding by either the
14 patent owner or the third-party requester shall be served
15 on any other party.

16 “(3)(A) If the patent owner files a response to any
17 Office action on the merits, the third-party requester may
18 once file written comments within a reasonable period. At
19 a minimum, such comments may be filed within 1 month
20 after the date of service of the patent owner’s response.

21 “(B) Comments filed under this paragraph shall be
22 limited to issues covered by the Office action or the patent
23 owner’s response.

24 “(c) Unless otherwise provided by the Commissioner
25 for good cause, all reexamination proceedings under this

1 section, including any appeal to the Board of Patent Ap-
2 peals and Interferences, will be conducted with special dis-
3 patch within the Office.”.

4 (e) APPEAL.—Section 306 of title 35, United States
5 Code, is amended to read as follows:

6 **“§ 306. Appeal**

7 “(a) The patent owner involved in a reexamination
8 proceeding under this chapter may—

9 “(1) appeal under the provisions of section 134
10 of this title, and may appeal under the provisions of
11 sections 141 through 144 of this title, with respect
12 to any decision adverse to the patentability of any
13 original or proposed amended or new claim of the
14 patent; or

15 “(2) be a party to any appeal taken by a third-
16 party requester under subsection (b) of this section.

17 “(b) A third-party requester may—

18 “(1) appeal under the provisions of section 134
19 of this title, and may appeal under the provisions of
20 sections 141 through 144 of this title, with respect
21 to any final decision favorable to the patentability of
22 any original or proposed amended or new claim of
23 the patent; or

24 “(2) be a party to any appeal taken by the pat-
25 ent owner, subject to subsection (c) of this section.

1 “(c) A third-party requester who files a notice of ap-
2 peal or who participates as a party to an appeal by the
3 patent owner under the provisions of sections 141 through
4 144 of this title is estopped from later asserting, in any
5 forum, the invalidity of any claim determined to be patent-
6 able on appeal on any ground which the third-party re-
7 quester raised or could have raised during the reexamina-
8 tion proceedings. A third-party requester is deemed not
9 to have participated as a party to an appeal by the patent
10 owner unless, within twenty days after the patent owner
11 has filed notice of appeal, the third-party requester files
12 notice with the Commissioner electing to participate.”.

13 (f) REEXAMINATION PROHIBITED.—(1) Chapter 30
14 of title 35, United States Code, is amended by adding the
15 following section at the end thereof:

16 **“§ 308. Reexamination prohibited**

17 “(a) Notwithstanding any provision of this chapter,
18 once an order for reexamination of a patent has been is-
19 sued under section 304 of this title, neither the patent
20 owner nor the third-party requester, if any, nor privies of
21 either, may file a subsequent request for reexamination
22 of the patent until a reexamination certificate is issued
23 and published under section 307 of this title, unless au-
24 thorized by the Commissioner.

1 “(b) Once a final decision has been entered against
2 a party in a civil action arising in whole or in part under
3 section 1338 of title 28 that the party has not sustained
4 its burden of proving the invalidity of any patent claim
5 in suit, then neither that party nor its privies may there-
6 after request reexamination of any such patent claim on
7 the basis of issues which that party or its privies raised
8 or could have raised in such civil action, and a reexamina-
9 tion requested by that party or its privies on the basis
10 of such issues may not thereafter be maintained by the
11 Office, notwithstanding any provision of this chapter.”.

12 (2) The table of sections for chapter 30 of title 35,
13 United States Code, is amended by adding the following
14 at the end thereof:

“308. Reexamination prohibited.”.

15 **SEC. 4. CONFORMING AMENDMENTS.**

16 (a) BOARD OF PATENT APPEALS AND INTER-
17 FERENCES.—The first sentence of section 7(b) of title 35,
18 United States Code, is amended to read as follows: “The
19 Board of Patent Appeals and Interferences shall, on writ-
20 ten appeal of an applicant, or a patent owner or a third-
21 party requester in a reexamination proceeding, review ad-
22 verse decisions of examiners upon applications for patents
23 and decisions of examiners in reexamination proceedings,
24 and shall determine priority and patentability of invention

1 in interferences declared under section 135(a) of this
2 title.”.

3 (b) PATENT FEES; PATENT AND TRADEMARK
4 SEARCH SYSTEMS.—Section 41(a)(7) of title 35, United
5 States Code, is amended by inserting “or for an uninten-
6 tionally delayed response by the patent owner in a re-ex-
7 amination proceeding,” after “issuing each patent,”.

8 (c) APPEAL TO THE BOARD OF PATENT APPEALS
9 AND INTERFERENCES.—Section 134 of title 35, United
10 States Code, is amended to read as follows:

11 **“§ 134. Appeal to the Board of Patent Appeals and**
12 **Interferences**

13 “(a) An applicant for a patent, any of whose claims
14 has been twice rejected, may appeal from the decision of
15 the primary examiner to the Board of Patent Appeals and
16 Interferences, having once paid the fee for such appeal.

17 “(b) A patent owner in a reexamination proceeding
18 may appeal from the final rejection of any claim by the
19 primary examiner to the Board of Patent Appeals and
20 Interferences, having once paid the fee for such appeal.

21 “(c) A third-party requester may appeal to the Board
22 of Patent Appeals and Interferences from the final deci-
23 sion of the primary examiner favorable to the patentability
24 of any original or proposed amended or new claim of a
25 patent, having once paid the fee for such appeal.”.

1 (d) APPEAL TO COURT OF APPEALS FOR THE FED-
2 ERAL CIRCUIT.—Section 141 of title 35, United States
3 Code, is amended by amending the first sentence to read
4 as follows: “An applicant, a patent owner or a third-party
5 requester, dissatisfied with the final decision in an appeal
6 to the Board of Patent Appeals and Interferences under
7 section 134 of this title, may appeal the decision to the
8 United States Court of Appeals for the Federal Circuit.”.

9 (e) PROCEEDINGS ON APPEAL.—Section 143 of title
10 35, United States Code, is amended by amending the third
11 sentence to read as follows: “In ex parte and reexamina-
12 tion cases, the Commissioner shall submit to the court in
13 writing the grounds for the decision of the Patent and
14 Trademark Office, addressing all the issues involved in the
15 appeal.”.

16 **SEC. 5. EFFECTIVE DATES.**

17 (a) IN GENERAL.—Sections 2 and 4 and subsections
18 (a), (b), (c), (d), and (e) of section 3 of this Act shall
19 take effect six months after the date of enactment of this
20 Act and shall apply to all reexamination requests filed on
21 or after such effective date.

22 (b) REEXAMINATION PROHIBITION PROVISION.—
23 Section 1 and subsections (f) and (g) of section 3 of this
24 Act shall take effect on the date of enactment of this Act.

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