

Calendar No. 682

103D CONGRESS
2D SESSION

S. 2341

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.

SEPTEMBER 28 (legislative day, SEPTEMBER 12), 1994

Reported with an amendment

Calendar No. 682103^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

SEPTEMBER 28 (legislative day, SEPTEMBER 12), 1994

Reported by Mr. BIDEN, with an amendment

[Strike out all after the enacting clause and insert the part printed in italic]

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,*

1 **SECTION 1. SHORT TITLE.**

2 This Act may be cited as the “Patent Reexamination
3 Reform Act of 1994”.

4 **SEC. 2. DEFINITIONS.**

5 Section 100 of title 35, United States Code, is
6 amended by adding at the end thereof the following new
7 subsection:

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

11 **SEC. 3. REEXAMINATION PROCEDURES.**

12 (a) **REQUEST FOR REEXAMINATION.**—Section 302 of
13 title 35, United States Code, is amended to read as fol-
14 lows:

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

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

1 or the manner in which the patent specification or claims
2 fail to comply with the requirements of section 112 of this
3 title. Unless the requesting person is the owner of the pat-
4 ent, the Commissioner promptly will send a copy of the
5 request to the owner of record of the patent.”.

6 (b) DETERMINATION OF ISSUE BY COMMISSIONER.—

7 Section 303 of title 35, United States Code, is amended
8 to read as follows:

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

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

24 “(b) A record of the Commissioner’s determination
25 under subsection (a) of this section will be placed in the

1 official file of the patent, and a copy promptly will be given
2 or mailed to the owner of record of the patent and to the
3 third-party requester, if any.

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

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

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

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

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

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

2 ~~“(a) Subject to subsection (b) of this section, reexam-~~
3 ~~ination will be conducted according to the procedures es-~~
4 ~~tablished for initial examination under the provisions of~~
5 ~~sections 132 and 133 of this title. In any reexamination~~
6 ~~proceeding under this chapter, the patent owner will be~~
7 ~~permitted to propose any amendment to the patent and~~
8 ~~a new claim or claims thereto in response to a decision~~
9 ~~adverse to the patentability of a claim of a patent. No~~
10 ~~proposed amended or new claim enlarging the scope of the~~
11 ~~claims of the patent will be permitted in a reexamination~~
12 ~~proceeding under this chapter.~~

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

16 ~~“(2) Any document (other than the reexamination re-~~
17 ~~quest) filed in a reexamination proceeding by either the~~
18 ~~patent owner or the third-party requester shall be served~~
19 ~~on any other party.~~

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

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

4 “(c) Unless otherwise provided by the Commissioner
5 for good cause, all reexamination proceedings under this
6 section, including any appeal to the Board of Patent Ap-
7 peals and Interferences, will be conducted with special dis-
8 patch within the Office.”.

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

11 **“§ 306. Appeal**

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

14 “(1) appeal under the provisions of section 134
15 of this title, and may appeal under the provisions of
16 sections 141 through 144 of this title, with respect
17 to any decision adverse to the patentability of any
18 original or proposed amended or new claim of the
19 patent; or

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

22 “(b) A third-party requester may—

23 “(1) appeal under the provisions of section 134
24 of this title, and may appeal under the provisions of
25 sections 141 through 144 of this title, with respect

1 to any final decision favorable to the patentability of
 2 any original or proposed amended or new claim of
 3 the patent; or

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

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

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

21 “§ 308. **Reexamination prohibited**

22 “(a) Notwithstanding any provision of this chapter,
 23 once an order for reexamination of a patent has been is-
 24 sued under section 304 of this title, neither the patent
 25 owner nor the third-party requester, if any, nor privies of

1 either, may file a subsequent request for reexamination
 2 of the patent until a reexamination certificate is issued
 3 and published under section 307 of this title, unless au-
 4 thorized by the Commissioner.

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

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

“308. Reexamination prohibited.”.

19 **SEC. 4. CONFORMING AMENDMENTS.**

20 (a) BOARD OF PATENT APPEALS AND INTER-
 21 FERENCES.—The first sentence of section 7(b) of title 35,
 22 United States Code, is amended to read as follows: “The
 23 Board of Patent Appeals and Interferences shall, on writ-
 24 ten appeal of an applicant, or a patent owner or a third-
 25 party requester in a reexamination proceeding, review ad-

1 verse decisions of examiners upon applications for patents
2 and decisions of examiners in reexamination proceedings,
3 and shall determine priority and patentability of invention
4 in interferences declared under section 135(a) of this
5 title.”.

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

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

14 **“§134. Appeal to the Board of Patent Appeals and**
15 **Interferences**

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

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

24 “(c) A third-party requester may appeal to the Board
25 of Patent Appeals and Interferences from the final deci-

1 sion of the primary examiner favorable to the patentability
2 of any original or proposed amended or new claim of a
3 patent, having once paid the fee for such appeal.”.

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

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

19 **SEC. 5. EFFECTIVE DATES.**

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

1 (b) ~~REEXAMINATION PROHIBITION PROVISION.—~~
2 Section 4 and subsections (f) and (g) of section 3 of this
3 Act shall take effect on the date of enactment of this Act.

4 **SECTION 1. SHORT TITLE.**

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

7 **SEC. 2. DEFINITIONS.**

8 Section 100 of title 35, United States Code, is amended
9 by adding at the end thereof the following new subsection:
10 “(e) The term ‘third-party requester’ means a person
11 requesting reexamination under section 302 of this title who
12 is not the patent owner.”.

13 **SEC. 3. REEXAMINATION PROCEDURES.**

14 (a) *REQUEST FOR REEXAMINATION.*—Section 302 of
15 title 35, United States Code, is amended to read as follows:

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

17 “Any person at any time may file a request for reex-
18 amination by the Office of a patent on the basis of any
19 prior art cited under the provisions of section 301 of this
20 title or on the basis of the requirements of section 112 of
21 this title except for the best mode requirement. The request
22 must be in writing and must be accompanied by payment
23 of a reexamination fee established by the Commissioner of
24 Patents and Trademarks pursuant to the provisions of sec-
25 tion 41 of this title. The request must set forth the

1 *pertinency and manner of applying cited prior art to every*
2 *claim for which reexamination is requested or the manner*
3 *in which the patent specification or claims fail to comply*
4 *with the requirements of section 112 of this title. Unless*
5 *the requesting person is the owner of the patent, the Com-*
6 *missioner promptly will send a copy of the request to the*
7 *owner of record of the patent.”.*

8 (b) *DETERMINATION OF ISSUE BY COMMISSIONER.—*
9 *Section 303 of title 35, United States Code, is amended to*
10 *read as follows:*

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

12 “(a) *Within three months following the filing of a re-*
13 *quest for reexamination under the provisions of section 302*
14 *of this title, the Commissioner will determine whether a sub-*
15 *stantial new question of patentability affecting any claim*
16 *of the patent concerned is raised by the request, with or*
17 *without consideration of other patents or printed publica-*
18 *tions. On his own initiative, and at any time, the Commis-*
19 *sioner may determine whether a substantial new question*
20 *of patentability is raised by patent or printed publications*
21 *or by the failure of the patent specification or claims to*
22 *comply with the requirements of section 112 of this title*
23 *except for the best mode requirement.*

24 “(b) *A record of the Commissioner’s determination*
25 *under subsection (a) of this section will be placed in the*

1 *official file of the patent, and a copy promptly will be given*
2 *or mailed to the owner of record of the patent and to the*
3 *third-party requester, if any.*

4 “(c) A determination by the Commissioner pursuant
5 to subsection (a) of this section will be final and
6 nonappealable. Upon a determination that no substantial
7 new question of patentability has been raised, the Commis-
8 sioner may refund a portion of the reexamination fee re-
9 quired under section 302 of this title.”.

10 (c) REEXAMINATION ORDER BY COMMISSIONER.—Sec-
11 tion 304 of title 35, United States Code, is amended to read
12 as follows:

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

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

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

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

2 “(a) Subject to subsection (b) of this section, reexam-
3 ination will be conducted according to the procedures estab-
4 lished for initial examination under the provisions of sec-
5 tions 132 and 133 of this title. In any reexamination pro-
6 ceeding under this chapter, the patent owner will be per-
7 mitted to propose any amendment to the patent and a new
8 claim or claims thereto. No proposed amended or new claim
9 enlarging the scope of the claims of the patent will be per-
10 mitted in a reexamination proceeding under this chapter.

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

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

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

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

1 “(c) Unless otherwise provided by the Commissioner
2 for good cause, all reexamination proceedings under this
3 section, including any appeal to the Board of Patent Ap-
4 peals and Interferences, will be conducted with special dis-
5 patch within the Office.”

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

8 **“§ 306. Appeal**

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

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

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

19 “(b) A third-party requester may—

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

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

3 “(c) A third-party requester who files a notice of ap-
4 peal or who participates as a party to an appeal by the
5 patent owner under the provisions of sections 141 through
6 144 of this title is estopped from later asserting, in any
7 forum, the invalidity of any claim determined to be patent-
8 able on appeal on any ground which the third-party re-
9 quester raised or could have raised during the reexamina-
10 tion proceedings. A third-party requester is deemed not to
11 have participated as a party to an appeal by the patent
12 owner unless, within twenty days after the patent owner
13 has filed notice of appeal, the third-party requester files no-
14 tice with the Commissioner electing to participate.”.

15 (f) REEXAMINATION PROHIBITED.—(1) Chapter 30 of
16 title 35, United States Code, is amended by adding the fol-
17 lowing section at the end thereof:

18 **“§ 308. Reexamination prohibited**

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

1 *under section 307 of this title, unless authorized by the*
2 *Commissioner.*

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

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

“308. Reexamination prohibited.”.

17 **SEC. 4. CONFORMING AMENDMENTS.**

18 (a) *BOARD OF PATENT APPEALS AND INTER-*
19 *FERENCES.*—*The first sentence of section 7(b) of title 35,*
20 *United States Code, is amended to read as follows: “The*
21 *Board of Patent Appeals and Interferences shall, on written*
22 *appeal of an applicant, or a patent owner or a third-party*
23 *requester in a reexamination proceeding, review adverse de-*
24 *cisions of examiners upon applications for patents and de-*
25 *cisions of examiners in reexamination proceedings, and*

1 *shall determine priority and patentability of invention in*
2 *interferences declared under section 135(a) of this title.”.*

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

8 (c) *APPEAL TO THE BOARD OF PATENT APPEALS AND*
9 *INTERFERENCES.—Section 134 of title 35, United States*
10 *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 decision*
23 *of the primary examiner favorable to the patentability of*
24 *any original or proposed amended or new claim of a patent,*
25 *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 sec-
7 tion 134 of this title, may appeal the decision to the United
8 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 reexamination
12 cases, the Commissioner shall submit to the court in writing
13 the grounds for the decision of the Patent and Trademark
14 Office, addressing all the issues involved in the appeal.”.

15 (f) *CIVIL ACTION TO OBTAIN PATENT.*—Section 145
16 of title 35, United States Code, is amended in the first sen-
17 tence by inserting “(a)” after “section 134”.

18 **SEC. 5. EFFECTIVE DATES.**

19 This Act shall take effect six months after the date of
20 enactment of this Act and shall apply to all reexamination
21 requests filed on or after such date.

S 2341 RS—2