Clarification on the Procedure for Seeking Review of a Finding of a Substantial New Question of Patentability in Ex Parte Reexamination Proceedings


ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is clarifying the procedure for seeking review of a determination that a substantial new question of patentability (SNQ) has been raised in an ex parte reexamination proceeding. This notice clarifies that while issues related to a SNQ determination are procedural, the Chief Judge of the Board of Patent Appeals and Interferences (BPAI) has been delegated the authority to review issues related to the examiner’s determination that a reference raises a SNQ in an ex parte reexamination proceeding. The Chief Judge of the BPAI may further delegate this SNQ review authority to the panel of Administrative Patent Judges who are deciding the appeal in the ex parte reexamination proceeding. This clarification of procedure will facilitate more efficient resolution of SNQ issues.

DATES: Effective Date: June 25, 2010. The procedure set forth in this notice applies to ex parte reexamination proceedings in which an appeal to the BPAI is decided on or after June 25, 2010. The procedure set forth in this notice does not apply to inter partes reexamination proceedings.

FOR FURTHER INFORMATION CONTACT: James T. Moore, Vice Chief Administrative Patent Judge, Board of Patent Appeals and Interferences, by telephone at (571) 272–9797 or by electronic mail at JamesT.Moore@USPTO.gov.

SUPPLEMENTARY INFORMATION: The USPTO will order a reexamination of a patent only if it determines that a SNQ affecting a claim of the patent has been raised. See 35 U.S.C. 304. A determination by the USPTO that no SNQ has been raised is “final and nonappealable.” See 35 U.S.C. 303(c).

However, a determination by the USPTO that a reference raises a SNQ is not subject to judicial review until a final agency decision has been entered in the ex parte reexamination proceeding. See Heinl v. Godici, 143 F. Supp. 2d 593, 597 n.9 (E.D. Va. 2001) (“The decision to grant reexamination of a patent only begins an administrative process and, as such, is * * * not [a] final agency action subject to judicial review * * * ”); see also Patlex Corp. v. Quigg, 680 F. Supp. 33, 36 (D.D.C. 1986) (“[T]he legislative scheme leaves the [Director’s 35 U.S.C.] section 303 determination entirely to his discretion and not subject to judicial review.”). The USPTO is clarifying that the Director of the USPTO has delegated to the Chief Judge of the BPAI the authority to review issues related to the examiner’s determination that a reference raises a SNQ in an ex parte reexamination proceeding. The Chief Judge of the BPAI may further delegate this SNQ review authority to the panel of Administrative Patent Judges who are deciding the appeal in the ex parte reexamination proceeding.

Request for Reconsideration of Examiner’s Finding of Substantial New Question

A patent owner challenging the correctness of the decision to grant an order for ex parte reexamination on the basis that there is no SNQ may request reconsideration of the examiner’s SNQ determination. The patent owner may present this challenge prior to the issuance of an Office action in the ex parte reexamination proceeding by filing a statement under 37 CFR 1.530 discussing the SNQ raised in the reexamination order for the examiner’s consideration. See 35 U.S.C. 304. When the examiner makes a rejection based in whole or in part on a reference (patent or printed publication) in an Office action, the patent owner may present a challenge to the examiner’s SNQ determination by requesting reconsideration of the examiner’s determination that the reference raises a SNQ and presenting appropriate arguments in the response to the Office action. See 37 CFR 1.111(b) (the patent owner’s reply to an Office action must point out the supposed errors in the examiner’s action and must reply to every ground of objection and rejection in the Office action). By presenting arguments regarding the SNQ to the examiner in the early stages of the proceeding, the patent owner helps the USPTO to resolve the issues quickly. For example, if the patent owner timely files a statement or reply, and the examiner agrees with the patent owner that no SNQ has been raised in the ex parte reexamination proceeding, then the proceeding will be terminated or the reexamination order will be vacated (if appropriate). However, if the examiner determines that the SNQ is proper, further review can be obtained by exhausting the patent owner’s rights through the reexamination proceeding and ultimately seeking review before the BPAI along with an appeal of any rejections.

BPAI Review of Examiner’s Finding of Substantial New Question

The patent owner may seek review on the examiner’s SNQ determination before the BPAI along with any appeal of the examiner’s rejections. A patent owner must include the SNQ issue and the appropriate arguments in its appeal brief to the BPAI.

In order to preserve the right to have the BPAI review of the SNQ issue, a patent owner must first request reconsideration of the SNQ issue by the examiner. Accordingly, for ex parte reexamination proceedings ordered on or after June 25, 2010, the patent owner may seek a final agency decision from the BPAI on the SNQ issue only if the patent owner first requests reconsideration before the examiner (e.g., in a patent owner’s statement under 37 CFR 1.530 or in a patent owner’s response under 37 CFR 1.111) and then seeks review of the examiner’s SNQ determination before the BPAI. In its appeal brief, the patent owner is encouraged to clearly present the issue and arguments regarding the examiner’s SNQ determination under a separate heading and identify the communication in which the patent owner first requested reconsideration before the examiner.

The USPTO recognizes that, without the benefit of the clarification in this notice, some patent owners who wish to seek a final agency decision on the determination of a SNQ may have failed to request reconsideration from the examiner. Thus, for ex parte reexamination proceedings ordered prior to June 25, 2010, if the patent owner presents the SNQ issue in its appeal brief, the BPAI panel will review the procedural SNQ issue along with its review of any rejections in an appeal and will enter a final agency decision accordingly.

The final decision by the BPAI panel in an ex parte reexamination proceeding
DEPARTMENT OF COMMERCE

International Trade Administration


This is a decision consolidated pursuant to Section 6(c) of the Educational, Scientific, and Cultural Materials Importation Act of 1966 (Pub. L. 89–651, as amended by Pub. L. 106–36; 80 Stat. 897; 15 CFR part 301). Related records can be viewed between 8:30 a.m. and 5 p.m. in Room 3720, U.S. Department of Commerce, 14th and Constitution Avenue., NW., Washington, DC.

Docket Number: 10–010.

Applicant: University of Maine System.


Manufacturer: Gatan, UK.


Docket Number: 10–011.

Applicant: Washington University in St. Louis, St. Louis, MO.


Docket Number: 10–012.

Applicant: California Institute of Technology, Pasadena, CA 91125.


Manufacturer: FEI Company, Czech Republic.


Docket Number: 10–013.

Applicant: Howard Hughes Medical Institute, Chevy Chase, MD 20815.


Manufacturer: FEI Company, Czech Republic.


Docket Number: 10–014.

Applicant: Howard Hughes Medical Institute, Chevy Chase, MD 20815.


Manufacturer: FEI Company, Czech Republic.


Docket Number: 10–016.


Manufacturer: FEI Company, Czech Republic.


Docket Number: 10–017.

Applicant: University of Massachusetts Medical School, Worcester, MA 01655.


Manufacturer: FEI Company, Czech Republic.

Intended Use: See notice at 75 FR 29974.

Docket Number: 10–018.

Applicant: Texas Tech University, Lubbock, TX 79409–1021.


Comments: None received.

Decision: Approved. No instrument of equivalent scientific value to the foreign instrument, for such purposes as these instruments are intended to be used, was being manufactured in the United States at the time the instruments were ordered.

Reasons: Each foreign instrument is an electron microscope or accessory thereto and is intended for research or scientific educational uses requiring an electron microscope. We know of no electron microscope or accessories thereto which were being manufactured in the United States at the time of order of each instrument.


Christopher Cassel,
Director, Subsidies Enforcement Office, Import Administration.

[FR Doc. 2010–15498 Filed 6–24–10; 8:45 am]

BILLING CODE 3510–05–P

DEPARTMENT OF COMMERCE

International Trade Administration

Notice of Establishment of the United States-Turkey Business Council and Request for Applicants for Appointment to the United States Section

AGENCY: International Trade Administration, Department of Commerce.

ACTION: Notice.

SUMMARY: In December 2009, the Governments of the United States and