

104TH CONGRESS
1ST SESSION

S. 1070

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

IN THE SENATE OF THE UNITED STATES

JULY 25 (legislative day, JULY 10), 1995

Mr. HATCH 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 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 1995”.

1 **SEC. 2. DEFINITIONS.**

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

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
11 follows:

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 3 months following the filing of a request
8 for reexamination under the provisions of section 302 of
9 this title, the Commissioner shall determine whether a
10 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 any time, the Com-
14 missioner may determine whether a substantial new ques-
15 tion of patentability is raised by patents and publications
16 or by the failure of the patent specification or claims to
17 comply with the requirements of section 112 of this title
18 except for the best mode requirement.

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

24 “(c) A determination by the Commissioner pursuant
25 to subsection (a) of this section will be final and

1 nonappealable. Upon a determination that no substantial
2 new question of patentability has been raised, the Com-
3 missioner may refund a portion of the reexamination fee
4 required under section 302 of this title.”.

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

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

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

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

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

21 “(a) Subject to subsection (b) of this section, reexam-
22 ination will be conducted according to the procedures es-
23 tablished for initial examination under the provisions of
24 sections 132 and 133 of this title. In any reexamination
25 proceeding under this chapter, the patent owner will be

1 permitted to propose any amendment to the patent and
2 a new claim or claims thereto. No proposed amended or
3 new claim enlarging the scope of the claims of the patent
4 will be permitted in a reexamination proceeding under this
5 chapter.

6 “(b)(1) This subsection shall apply to any reexamina-
7 tion proceeding in which the order for reexamination is
8 based upon a request by a third-party requester.

9 “(2) With the exception of the reexamination request,
10 any document filed by either the patent owner or the
11 third-party requester shall be served on the other party.

12 “(3) If the patent owner files a response to any Office
13 action on the merits, the third-party requester may once
14 file written comments within a reasonable period not less
15 than 1 month from the date of service of the patent own-
16 er’s response. Written comments provided under this para-
17 graph shall be limited to issues covered by the Office ac-
18 tion or the patent owner’s response.

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

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

1 **“§ 306. Appeal**

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

4 “(1) appeal under the provisions of section 134
5 of this title, and may appeal under the provisions of
6 sections 141 to 144 of this title, with respect to any
7 decision adverse to the patentability of any original
8 or proposed amended or new claim of the patent, or

9 “(2) be a party to any appeal taken by a third-
10 party requester pursuant to subsection (b) of this
11 section.

12 “(b) A third-party requester may—

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

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

21 “(c) A third-party requester who, under the provi-
22 sions of sections 141 to 144 of this title, files a notice
23 of appeal or who participates as a party to an appeal by
24 the patent owner is estopped from later asserting, in any
25 forum, the invalidity of any claim determined to be patent-
26 able on appeal on any ground which the third-party re-

1 requester raised or could have raised during the reexamina-
2 tion proceedings. A third-party requester is deemed not
3 to have participated as a party to an appeal by the patent
4 owner unless, within 20 days after the patent owner has
5 filed notice of appeal, the third-party requester files notice
6 with the Commissioner electing to participate.”.

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

10 **“§ 308. Reexamination prohibited**

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

19 “(b) Once a final decision has been entered against
20 a party in a civil action arising in whole or in part under
21 section 1338 of title 28 that the party has not sustained
22 its burden of proving the invalidity of any patent claim
23 in suit, then neither that party nor its privies may there-
24 after request reexamination of any such patent claim on
25 the basis of issues which that party or its privies raised

1 or could have raised in such civil action, and a reexamina-
2 tion requested by that party or its privies on the basis
3 of such issues may not thereafter be maintained by the
4 Office, notwithstanding any provision of this chapter.”.

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

“308. Reexamination prohibited.”.

8 **SEC. 4. CONFORMING AMENDMENTS.**

9 (a) BOARD OF PATENT APPEALS AND INTER-
10 FERENCES.—The first sentence of section 7(b) of title 35,
11 United States Code, is amended to read as follows: “The
12 Board of Patent Appeals and Interferences shall, on writ-
13 ten appeal of an applicant, or a patent owner or a third-
14 party requester in a reexamination proceeding, review ad-
15 verse decisions of examiners upon applications for patents
16 and decisions of examiners in reexamination proceedings,
17 and shall determine priority and patentability of invention
18 in interferences declared under section 135(a) of this
19 title.”.

20 (b) PATENT FEES; PATENT AND TRADEMARK
21 SEARCH SYSTEMS.—Section 41(a)(7) of title 35, United
22 States Code, is amended to read as follows:

23 “(7) On filing each petition for the revival of an
24 unintentionally abandoned application for a patent,
25 for the unintentionally delayed payment of the fee

1 for issuing each patent, or for an unintentionally de-
2 layed response by the patent owner in a reexamina-
3 tion proceeding, \$1,210 unless the petition is filed
4 under sections 133 or 151 of this title, in which case
5 the fee shall be \$110.”.

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

9 **“§ 134. Appeal to the Board of Patent Appeals and**
10 **Interferences**

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

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

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

24 (d) APPEAL TO COURT OF APPEALS FOR THE FED-
25 ERAL CIRCUIT.—Section 141 of title 35, United States

1 Code, is amended by amending the first sentence to read
2 as follows: “An applicant, a patent owner, or a third-party
3 requester, dissatisfied with the final decision in an appeal
4 to the Board of Patent Appeals and Interferences under
5 section 134 of this title, may appeal the decision to the
6 United States Court of Appeals for the Federal Circuit.”.

7 (e) PROCEEDINGS ON APPEAL.—Section 143 of title
8 35, United States Code, is amended by amending the third
9 sentence to read as follows: “In ex parte and reexamina-
10 tion cases, the Commissioner shall submit to the court in
11 writing the grounds for the decision of the Patent and
12 Trademark Office, addressing all the issues involved in the
13 appeal.”.

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

17 **SEC. 5. EFFECTIVE DATE.**

18 This Act shall take effect on the date that is 6
19 months after the date of the enactment of this Act and
20 shall apply to all reexamination requests filed on or after
21 that effective date.

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