DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO–P–2010–0049]

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

AGENCY: United States Patent and Trademark Office, Commerce.

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 that authority to the panel of Administrative Patent Judges who are deciding the appeal in an *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. 1988) ("[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.[1] 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

[1] Separate from the BPAI's consideration of the SNQ issue, a patent owner may file a petition under 37 CFR 1.181(a)(3) to vacate an *ex parte* reexamination order as "*ultra vires*." Such petitions will be granted only in the extremely rare situation where the USPTO acted in "brazen defiance" of its statutory authorization in granting the order for *ex parte* reexamination. *See Heinl,* 143 F. Supp. 2d at 601–02. These types of petitions to vacate an *ex parte* reexamination order are not decided by the BPAI, but continue to be delegated to the Commissioner for Patents and are currently decided by the Director of Central Reexamination Unit (CRU).

may include: (1) Its review of the procedural SNQ issue in a separate section, and (2) its review of the merits of the rejections. *See, e.g., In re Searles,* 422 F.2d 431, 434–35 (C.C.P.A. 1970) (holding certain procedural matters that are "determinative of the rejection" are properly appealable to the Board); *see also In re Hengehold,* 440 F.2d 1395, 1404 (C.C.P.A. 1971) ("[T]he kind of adverse decisions of examiners which are reviewable by the board must be those which relate, at least indirectly, to matters involving the rejection of the claims."); *cf.* 37 CFR 41.121 (providing both "substantive" motions and "miscellaneous"—*i.e.,* procedural—motions, which may be decided together in a single decision).

The patent owner may file a single request for rehearing under 37 CFR 41.52 for both the decision on the SNQ issue and the merits decision on the examiner's rejections, resulting in a single final decision for purposes of judicial review. Judicial review of the BPAI's final decision issued pursuant to 35 U.S.C. 134, which will incorporate the decision on the finding of a SNQ, is directly to the United States Court of Appeals for the Federal Circuit under 35 U.S.C. 141. *See In re Hiniker Co.,* 150 F.3d 1362, 1367 (Fed. Cir. 1998) ("With direct review by this court of the Board's reexamination decisions, a patentee can be certain that it cannot be subjected to harassing duplicative examination."); *see also Heinl,* 143 F. Supp. 2d at 597–98.

Although this is an important issue, an appeal containing a request for reconsideration of the examiner's SNQ determination is not widespread. There were three ex parte reexamination appeals docketed in Fiscal Year 2008, only one in Fiscal Year 2009 and one so far this year.

The procedure set forth in this notice does not apply to *inter partes* reexamination proceedings. A determination by the USPTO in an *inter partes* reexamination either that no SNQ has been raised or that a reference raises a SNQ is final and non-appealable. *See* 35 U.S.C. 312(c).

Appropriate sections of the MPEP will be revised in accordance with this notice in due course.

Dated: June 18, 2010.

David J. Kappos,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

[FR Doc. 2010–15468 Filed 6–24–10; 8:45 am]

BILLING CODE 3510–16–P

DEPARTMENT OF COMMERCE

International Trade Administration

University of Maine System, et al.; Notice of Consolidated Decision on Applications for Duty-Free Entry of Electron Microscopes

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, St. Bangor, ME 04401.
Instrument: Live Color Cathodoluminescence detector accessory for Scanning Electron Microscope.
Manufacturer: Gatan, UK.
Intended Use: See notice at 75 FR 29974, May 28, 2010.

Docket Number: 10–011.
Applicant: Washington University in St. Louis, St. Louis, MO.
Instrument: Electron Microscope.
Manufacturer: Japanese Electron–Optics, Limited (JEOL), Japan.
Intended Use: See notice at 75 FR 29974, May 28, 2010.

Docket Number: 10–012.
Applicant: California Institute of Technology, Pasadena, CA 91125.
Instrument: Electron Microscope.
Manufacturer: FEI Company, Czech Republic.
Intended Use: See notice at 75 FR 29974, May 28, 2010.

Docket Number: 10–013.
Applicant: Howard Hughes Medical Institute, Chevy Chase, MD 20815.
Instrument: Electron Microscope.
Manufacturer: FEI Company, Czech Republic.
Intended Use: See notice at 75 FR 29974, May 28, 2010.

Docket Number: 10–014.
Applicant: Howard Hughes Medical Institute, Chevy Chase, MD 20815.
Instrument: Electron Microscope.
Manufacturer: FEI Company, Czech Republic.
Intended Use: See notice at 75 FR 29974, May 28, 2010.

Docket Number: 10–016.
Applicant: United States Geological Survey, Denver, CO 80225.
Instrument: Electron Microscope.
Manufacturer: FEI Company, Czech Republic.
Intended Use: See notice at 75 FR 29974, May 28, 2010.

Docket Number: 10–017.
Applicant: University of Massachusetts Medical School, Worcester, MA 01655.
Instrument: Electron Microscope.
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.
Instrument: Electron Microscope.
Manufacturer: Japanese Electron–Optics, Limited, (JEOL), Japan.
Intended Use: See notice at 75 FR 29974, May 28, 2010.

Docket Number: 10–020.
Applicant: Howard Hughes Medical Institute, Chevy Chase, MD 20815.
Instrument: Electron Microscope.
Manufacturer: FEI Company, Czech Republic.
Intended Use: See notice at 75 FR 29974, May 28, 2010.

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.

Dated: June 21, 2010.

Christopher Cassel,

Director, Subsidies Enforcement Office, Import Administration.

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

BILLING CODE 3510–DS–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