

§ 1.943

§ 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination.

(a) The form of responses, written comments, briefs, appendices, and other papers must be in accordance with the requirements of § 1.52.

(b) Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

(c) Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

§ 1.945 Response to Office action by patent owner in *inter partes* reexamination.

(a) The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

(b) Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

(1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;

(2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and

(3) A compelling reason to enter the supplemental response.

[72 FR 18906, Apr. 16, 2007]

§ 1.947 Comments by third party requester to patent owner's response in *inter partes* reexamination.

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written com-

37 CFR Ch. I (7-1-14 Edition)

ments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

§ 1.948 Limitations on submission of prior art by third party requester following the order for *inter partes* reexamination.

(a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

(b) [Reserved]

§ 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination.

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the