

Proposed Amended Rule 510: Request for Ex Parte Reexamination

§ 1.510 Request for *ex parte* reexamination.

- (a) Any person may, at any time during the period of enforceability of a patent, file a request for an *ex parte* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501. The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).
- (b) Any request for reexamination must include the following parts:
- (1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.
 - (2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. For each statement and accompanying information of the patent owner submitted pursuant to § 1.501(a)(2) which is relied upon in the detailed explanation, the request must explain how that statement is being used to determine the proper meaning of a patent claim in connection with the prior art applied to that claim and how each relevant claim is being interpreted. If appropriate the party requesting reexamination may also point out how claims distinguish over cited prior art.
 - (3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.
 - (4) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.
 - (5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.
 - (6) A certification that the statutory estoppel provisions of both *inter partes* review (35 U.S.C. 315(e)(1)) and post grant review (35 U.S.C. 325(e)(1)) do not prohibit the *ex parte* reexamination.
 - (7) A statement identifying the real party(ies) in interest to the extent necessary to determine whether any *inter partes* review or post grant review filed subsequent to an *ex parte* reexamination bars a pending *ex parte* reexamination filed by the real party(ies) in interest or its privy from being maintained.
- (c) If the request does not include the fee for requesting *ex parte* reexamination required by paragraph (a) of this section and meet all the requirements by paragraph (b) of this section, then the person identified as requesting reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *ex*

parte reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

- (d) The filing date of the request for *ex parte* reexamination is the date on which the request satisfies all the requirements of this section.
- (e) A request filed by the patent owner may include a proposed amendment in accordance with § 1.530.
- (f) If a request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34.