

# Proposed USPTO Rules for Judicial Review of TTAB Decisions

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## PART 90—JUDICIAL REVIEW OF PATENT TRIAL AND APPEAL BOARD DECISIONS

§90.1 Scope

§90.2 Notice; service

§90.3 Time for appeal or civil action

**Authority:** 35 U.S.C. §2(b)(2)

### § 90.1 Scope

The provisions herein govern judicial review for Patent Trial and Appeal Board decisions under chapter 13 of title 35, United States Code. Judicial review of decisions arising out of *inter partes* reexamination proceedings that are requested under 35 U.S.C. 311, and where available, judicial review of decisions arising out of interferences declared pursuant to 35 U.S.C. 135 continue to be governed by the pertinent regulations in effect on July 1, 2012.

### § 90.2 Notice; service.

(a) *For an appeal under 35 U.S.C. 141.*

- (1) In all appeals, the notice of appeal required by 35 U.S.C. 142 must be filed with the Director of the United States Patent and Trademark Office as provided in § 104.2 of this title. A copy of the notice of appeal must also be filed with the Patent Trial and Appeal Board in the appropriate manner provided in § 41.10(a), 41.10(b), or 42.6(b).
- (2) In all appeals, the party initiating the appeal must comply with the requirements of the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for the Federal Circuit, including:
  - (i) Serving the requisite number of copies on the Court; and
  - (ii) Paying the requisite fee for the appeal.
- (3) *Additional requirements*
  - (i) In appeals arising out of an *ex parte* reexamination proceeding ordered pursuant to § 1.525, notice of the appeal must be served as provided in § 1.550(f) of this title.
  - (ii) In appeals arising out of an *inter partes* review, a post-grant review, a covered business method patent review, or a derivation proceeding, notice of the appeal must be served as provided in § 42.6(e) of this title.

(b) *For a notice of election under 35 U.S.C. 141(d) to proceed under 35 U.S.C. 146.*

- (1) Pursuant to 35 U.S.C. 141(d), if an adverse party elects to have all further review proceedings conducted under 35 U.S.C. 146 instead of under 35 U.S.C. 141, that party must file a notice of election with the United States Patent and Trademark Office as provided in § 104.2.
- (2) A copy of the notice of election must also be filed with the Patent Trial and Appeal Board in the manner provided in § 42.6(b).
- (3) A copy of the notice of election must also be served where necessary pursuant to § 42.6(e).

(c) *For a civil action under 35 U.S.C. 146.*

The party initiating an action under 35 U.S.C. 146 must file a copy of the complaint no later than five business days after filing the complaint in district court with the Patent Trial and Appeal Board in the manner provided in § 42.6(b), and the Office of the Solicitor pursuant to § 104.2. Failure to comply with this requirement can result in further action within the United States Patent and Trademark Office consistent with the final Board decision.

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## § 90.3 Time for appeal or civil action.

### (a) *Filing deadline*—

#### (1) *For an appeal under 35 U.S.C. 141.*

The notice of appeal filed pursuant to 35 U.S.C. 142 must be filed with the Director of the United States Patent and Trademark Office no later than sixty-three (63) days after the date of the final Board decision. Any notice of cross-appeal is controlled by Rule 4(a)(3) of the Federal Rules of Appellate Procedure, and any other requirement imposed by the Rules of the United States Court of Appeals for the Federal Circuit.

#### (2) *For a notice of election under 35 U.S.C. 141(d).*

The time for filing a notice of election under 35 U.S.C. 141(d) is governed by 35 U.S.C. 141(d).

#### (3) *For a civil action under 35 U.S.C. 145 or 146.*

(i) A civil action must be commenced no later than sixty-three (63) days after the date of the final Board decision.

(ii) The time for commencing a civil action pursuant to a notice of election under 35 U.S.C. 141(d) is governed by 35 U.S.C. 141(d).

### (b) *Time computation*—

(1) *Rehearing.* A timely request for rehearing will reset the time for appeal or civil action to no later than sixty-three (63) days after action on the request. Any subsequent request for rehearing from the same party in the same proceeding will not reset the time for seeking judicial review, unless the additional request is permitted by order of the Board.

(2) *Holidays.* If the last day for filing an appeal or civil action falls on a Federal holiday in the District of Columbia, the time is extended pursuant to 35 U.S.C. 21(b).

### (c) *Extension of time.*

(1) The Director, or his designee, may extend the time for filing an appeal, or commencing a civil action, upon written request if:

(i) Requested before the expiration of the period for filing an appeal or commencing a civil action, and upon a showing of good cause; or

(ii) Requested after the expiration of the period for filing an appeal or commencing a civil action, and upon a showing that the failure to act was the result of excusable neglect.

(2) The request must be filed as provided in § 104.2 of this title.