DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. 980605147–8147–01]

Request for Comments on Interim Guidelines for Reexamination of Cases in View of In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997)

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Notice and request for public comments.

SUMMARY: The Patent and Trademark Office (PTO) requests comments from the public on interim guidelines that will be used by PTO personnel in their review of requests for reexaminations and ongoing reexaminations for compliance with the decision in In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997).

DATES: To be ensured consideration, written comments on the interim guidelines must be received by the PTO by September 14, 1998.

ADDRESSES: Written comments should be addressed to Commissioner of Patents and Trademarks, Attention: Kevin T. Kramer or John M. Whealan, Box 8, Washington, DC 20231. Comments may be submitted by facsimile at (703) 305–9373. Comments may also be submitted by electronic mail addressed to ''kevin.kramer@uspto.gov'' or ''john.whealan@uspto.gov''.

FOR FURTHER INFORMATION CONTACT: John M. Whealan or Kevin T. Kramer by telephone at (703) 305–9035; by facsimile at (703) 305–9373; by mail addressed to Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231; or by electronic mail at ''john.whealan@uspto.gov'' or ''kevin.kramer@uspto.gov.''

SUPPLEMENTARY INFORMATION: The PTO requests comments from the public on the following interim guidelines. These guidelines will be used by PTO personnel in their review of requests for reexaminations and ongoing reexaminations for compliance with the decision in In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). Because these guidelines govern internal practices, they are exempt from notice and comment rulemaking under 5 U.S.C. 553(b)(A).

Written comments should include the following information: (1) Name and affiliation of the individual responding; and (2) an indication of whether the comments offered represent views of the respondent's organization or are the respondent's personal views. Where possible, parties presenting written comments are requested to provide their comments in machine-readable format. Such submissions may be provided by electronic mail sent over the Internet, or on a 3.5″ floppy disk formatted for use in a Windows® based computer. Preferably, machine-readable submissions should be provided in WordPerfect® 6.1 format.

Written comments will be available for public inspection in Suite 918, Crystal Park 2, 2121 Crystal Drive, Arlington, Virginia. In addition, comments provided in machine-readable format will be available through anonymous file transfer protocol (ftp) via the Internet (address: comments.uspto.gov) and through the World Wide Web (address: www.uspto.gov).

I. Interim Guidelines for Reexamination of Cases in View of In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997)

The following guidelines have been developed to assist Patent and Trademark Office (PTO) personnel in determining whether to order a reexamination or terminate an ongoing reexamination in view of the United States Court of Appeals for the Federal Circuit's decision in In re Portola Packaging, Inc.[1] These guidelines supersede and supplement any previous guidelines issued by the PTO with respect to reexamination. These guidelines apply to all reexaminations regardless of whether they are initiated by the Commissioner, requested by the patentee, or requested by a third party. When made final, these guidelines will be incorporated into Chapter 2200 of the Manual of Patent Examining Procedure.

A. Explanation of Portola Packaging

In order for the PTO to conduct reexamination, prior art must raise a ''substantial new question of patentability.''[2] In Portola Packaging, the Federal Circuit held that a combination of two references that were expressly relied upon individually to reject claims during the original examination does not raise a substantial new question of patentability.[3] The Federal Circuit also held that an amendment of the claims during reexamination does not raise a substantial new question of patentability.[4] The court explained that ''a rejection made during reexamination does not raise a substantial new question of patentability if it is supported only by prior art previously considered by the PTO.''[5]

B. General Principles Governing Compliance With Portola Packaging

If prior art was previously expressly relied upon to reject a claim in a prior related PTO proceeding,[6] the PTO will *not* order or conduct reexamination based *only* on such prior art, regardless of whether that prior art is to be relied upon to reject the same or different claims in the reexamination.

If prior art was *not* expressly relied upon to reject a claim, but was cited in the record of a prior related PTO proceeding and *its relevance to the patentability of any claim was actually discussed on the record,*[7] the PTO will *not* order or conduct reexamination based *only* on such prior art.

In contrast, the PTO *will* order and conduct reexamination based on prior art that was cited but whose relevance to patentability of the claims was *not discussed* in any prior related PTO proceeding.

C. Procedures for Determining Whether a Reexamination May Be Ordered in Compliance With Portola Packaging

PTO personnel must adhere to the following procedures when determining whether a reexamination may be ordered in compliance with the Federal Circuit's decision in Portola Packaging:

1. Read the reexamination request to identify the prior art on which the request is based.
2. Conduct any necessary search of the prior art relevant to the subject matter of the patent for which reexamination was requested.[8]
3. Read the prosecution histories of prior related PTO proceedings.
4. Determine if the prior art in the reexamination request and the prior art uncovered in any search was:

(a) expressly relied upon to reject any claim in a prior related PTO proceeding; or

(b) cited *and* its relevance to patentability of any claim discussed in a prior related PTO proceeding.

5. *Deny* the reexamination request if the decision to order reexamination would be based *only* on prior art that was (a) expressly relied upon to reject any claim and/or (b) cited and its relevance to patentability of any claim discussed in a prior related PTO proceeding.[9]
6. *Order* reexamination if the decision to order reexamination would be based *at least in part* on prior art that was neither (a) expressly relied upon to reject any claim nor (b) cited and its relevance to patentability of any claim discussed in a prior related PTO proceeding, and a substantial new question of patentability is raised with respect to any claim of the patent.[10]

D. Procedures for Determining Whether an Ongoing Reexamination Must be Terminated in Compliance With Portola Packaging

PTO personnel must adhere to the following procedures when determining whether any current or future ongoing reexamination should be terminated in compliance with the Federal Circuit's decision in Portola Packaging:

1. Prior to making any rejection in an ongoing reexamination, determine for any prior related PTO proceeding what prior art was (a) expressly relied upon to reject any claim or (b) cited *and* discussed.

2. Base any and all rejections of the patent claims under reexamination *at least in part* on prior art that was neither (a) expressly relied upon to reject any claim nor (b) cited and its relevance to patentability of any claim discussed in any prior related PTO proceeding.

3. Withdraw any rejections based only on prior art that was previously either (a) expressly relied upon to reject any claim or (b) cited and its relevance to patentability of any claim discussed in any prior related PTO proceeding.

4. Terminate reexaminations in which the *only* remaining rejections are *entirely* based on prior art that was previously (a) expressly relied upon to reject any claim and/or (b) cited and its relevance to patentability of a claim discussed in any prior related PTO proceeding.[11]

E. Application of Portola Packaging to Unusual Fact Patterns

The PTO recognizes that each case must be decided on its particular facts and that cases with unusual fact patterns will occur. In such a case, the reexamination should be brought to the attention of the Group Director who will then determine the appropriate action to be taken.

Unusual fact patterns may appear in cases in which prior art was expressly relied upon to reject any claim or cited and discussed with respect to the patentability of a claim in a prior related PTO proceeding, but other evidence clearly shows that the examiner did not appreciate the issues raised in the reexamination request or the ongoing reexamination with respect to that art. Such other evidence may appear in the reexamination request, in the nature of the prior art, in the prosecution history of the prior examination, or in an admission by the patent owner, applicant, or inventor.[12]

For example, if a textbook was cited during original examination, the record of that examination may show that only select information from the textbook was discussed with respect to the patentability of the claims.[13] If the reexamination request relied upon other information in the textbook that actually teaches what is required by the claims, it may be appropriate to rely on this other information in the textbook to conduct reexamination.[14]

Another example involves the situation where an examiner discussed a reference in a prior PTO proceeding, but did not either expressly reject a claim based upon the reference or maintain the rejection based on the mistaken belief that the reference did not qualify as prior art.[15] If the reexamination request were to explain how and why the reference actually does qualify as prior art, it may be appropriate to conduct reexamination.[16]

Another example involves foreign language prior art references. If a foreign language prior art reference was cited and discussed in any prior PTO proceeding, Portola Packaging may not prohibit reexamination over a complete and accurate translation of that foreign language prior art reference. Specifically, if a reexamination request were to explain why a more complete and accurate translation of that same foreign language prior art reference actually teaches what is required by the patent claims, it may be appropriate to conduct reexamination.

Another example of an unusual fact pattern involves cumulative references. To the extent that a cumulative reference is repetitive of a prior art reference that was previously expressly applied or discussed, Portola Packaging may prohibit reexamination of the patent claims based only on the repetitive reference.[17] However, it is expected that a repetitive reference which cannot be considered by the PTO during reexamination will be a rare occurrence since most references teach additional information or present information in a different way than other references, even though the references might address the same general subject matter.

F. Notices Regarding Compliance With Portola Packaging

1. If a request for reexamination is denied under C.5. above in order to comply with the Federal Circuit's decision in Portola Packaging, the notice of denial should state: ''This reexamination request is denied based on In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). No final patentability determination has been made.''

2. If an ongoing reexamination is terminated under D.4. above in order to comply with the Federal Circuit's decision in Portola Packaging, the termination notice should state: ''This reexamination is terminated based on In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). No final patentability determination has been made.''

3. If a rejection in the reexamination has previously issued and that rejection is withdrawn under D.3. above in order to comply with the Federal Circuit's decision in Portola Packaging, the Office action withdrawing such rejection should state: ''The rejection is withdrawn in view of In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). No final patentability determination of the claims of the patent in view of such prior art has been made.'' If multiple rejections have been made, the Office action should clarify which rejections are being withdrawn.

Endnotes

1. 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir.), *reh'g in banc denied*, 122 F.3d 1473, 44 USPQ2d 1060 (1997).

2. 35 U.S.C. 304.

3. During the original prosecution of the application which led to the patent, the PTO had expressly rejected the claims separately based upon the Hunter and Faulstich references. The PTO never expressly applied the references in combination. During reexamination, Portola Packaging amended the patent claims, and for the first time the PTO expressly rejected the amended patent claims based upon the Hunter and Faulstich references in combination. Despite these facts, the Federal Circuit determined that the PTO was precluded from conducting reexamination on those references. 110 F.3d at 790, 42 USPQ2d at 1299.

4. 110 F.3d at 791, 42 USPQ2d at 1299.

5. 110 F.3d at 791, 42 USPQ2d at 1300.

6. Prior related PTO proceedings include the original prosecution history, any reissue prosecution history, and any previous reexamination prosecution history of a concluded PTO proceeding.

7. The relevance of the prior art to patentability may be discussed by either the applicant, patentee, examiner, or any third party. However, 37 CFR 1.2 requires that all PTO business be transacted in writing. Thus, the PTO cannot presume that a prior art reference was previously relied upon to reject or discussed in a prior PTO proceeding if there is no basis in the written record to so conclude other than the examiner's initials or a check on an information disclosure statement. Thus, any discussion of prior art must appear on the record of a prior related PTO proceeding. Examples of generalized statements in a prior related PTO proceeding that would not preclude reexamination include statements that prior art is ''cited to show the state of the art,'' ''cited to show the background of the invention,'' or ''cited of interest.''

8. *See* 35 U.S.C. 303 (''On his own initiative, and any time, the Commissioner

may determine whether a substantial new question of patentability is raised by patents and publication discovered by him . * * *''); *see also* MPEP § 2244 (''If the examiner believes that additional prior art patents and publications can be readily obtained by searching to supply any deficiencies in the prior art cited in the request, the examiner can perform such an additional search.'').

9. *See* Portola Packaging, Inc., 110 F.3d at 790, 42 USPQ2d at 1299 (examiner presumed to have done his job). There may be unusual fact patterns and evidence which suggests that the PTO did not consider the prior art that was discussed in the prior PTO proceeding. These cases should be brought to the attention of the Group Director. For a discussion of the treatment of such cases, see section E above.

10. If not specified, a reexamination generally includes all claims. However, reexamination may be limited to specific claims. *See* 35 U.S.C. 304 (authorizing the power to grant reexamination for determination of a ''substantial new question of patentability affecting *any claim* of a patent.'') (emphasis added). Thus, the Commissioner may order reexamination confined to specific claims. However, reexamination is not necessarily limited to those questions set forth in the reexamination order. *See* 37 CFR 1.104(a) (''The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed. * * *'').

11. The Commissioner may conduct a search for new art prior to determining whether a substantial new question of patentability exists prior to terminating any ongoing reexamination proceeding. *See* 35 U.S.C. 303. *See also* 35 U.S.C. 305 (indicating that ''reexamination will be conducted according to the procedures established for initial examination,'' thereby suggesting that the Commissioner may conduct a search during an ongoing reexamination proceeding).

12. *See* 62 FR 53,151, 53,191 (October 10, 1997) (to be codified at 37 CFR § 1.104(c)(2)).

13. The file history of the prior PTO proceeding should indicate which portion of the textbook was previously considered. *See* 37 CFR 1.98(a)(2)(ii) (an information disclosure statement must include a copy of each ''publication or that *portion* which caused it to be listed'') (emphasis added).

14. However, a reexamination request that merely provides a new interpretation of a reference already previously expressly relied upon or actually discussed by the PTO does not create a substantial new question of patentability.

15. For example, the examiner may have not believed that the reference qualified as prior art because: (i) the reference was undated; (ii) the applicant submitted a declaration believed to be sufficient to antedate the reference under 37 CFR 1.131; or (iii) the examiner attributed an incorrect filing date to the claimed invention.

16. For example, the request could: (i) verify the date of the reference; (ii) undermine the sufficiency of the section 131 declaration; or (iii) explain the correct filing date accorded a claim.

17. For purposes of reexamination, a cumulative reference that is repetitive is one that substantially reiterates verbatim the teachings of a reference that was either previously expressly relied upon or discussed in a prior PTO proceeding even though the title or the citation of the reference may be different.

Dated: June 9, 1998.

Bruce A. Lehman,

Assistant Secretary of Commerce and Commissioner of Patents and Trademarks.

[FR Doc. 98–15778 Filed 6–12–98; 8:45 am]

BILLING CODE 3510–16–P

DEPARTMENT OF EDUCATION

Submission for OMB Review; Comment Request

AGENCY: Department of Education.

ACTION: Submission for OMB review; comment request.

SUMMARY: The Acting Deputy Chief Information Officer, Office of the Chief Information Officer, invites comments on the submission for OMB review as required by the Paperwork Reduction Act of 1995.

DATES: Interested persons are invited to submit comments on or before July 15, 1998.

ADDRESSES: Written comments should be addressed to the Office of Information and Regulatory Affairs, Attention: Danny Werfel, Desk Officer, Department of Education, Office of Management and Budget, 725 17th Street, NW., Room 10235, New Executive Office Building, Washington, DC 20503. Requests for copies of the proposed information collection requests should be addressed to Patrick J. Sherrill, Department of Education, 600 Independence Avenue, SW, Room 5624, Regional Office Building 3, Washington, DC 20202–4651.

FOR FURTHER INFORMATION CONTACT: Patrick J. Sherrill (202) 708–8196. Individuals who use a telecommunications device for the deaf (TDD) may call the Federal Information Relay Service (FIRS) at 1–800–877–8339 between 8 a.m. and 8 p.m., Eastern time, Monday through Friday.

SUPPLEMENTARY INFORMATION: Section 3506 of the Paperwork Reduction Act of 1995 (44 U.S.C. Chapter 35) requires that the Office of Management and Budget (OMB) provide interested Federal agencies and the public an early opportunity to comment on information collection requests. OMB may amend or waive the requirement for public consultation to the extent that public participation in the approval process would defeat the purpose of the information collection, violate State or Federal law, or substantially interfere with any agency's ability to perform its statutory obligations. The Acting Deputy Chief Information Officer, Office of the Chief Information Officer, publishes this notice containing proposed information collection requests prior to submission of these requests to OMB. Each proposed information collection, grouped by office, contains the following: (1) Type of review requested, e.g., new, revision, extension, existing or reinstatement; (2) Title; (3) Summary of the collection; (4) Description of the need for, and proposed use of, the information; (5) Respondents and frequency of collection; and (6) Reporting and/or Recordkeeping burden. OMB invites public comment at the address specified above. Copies of the requests are available from Patrick J. Sherrill at the address specified above.

Dated: June 10, 1998.

Hazel Fiers,

Acting Deputy Chief Information Officer, Office of the Chief Information Officer.

Office of the Under Secretary

Type of Review: New.

Title: Follow-up Study of State Implementation of Federal Elementary and Secondary Education Programs.

Frequency: One time.

Affected Public: State, local or Tribal Gov't; SEAs or LEAs.

Reporting and Recordkeeping Hour Burden:

Responses: 459.

Burden Hours: 459.

Abstract: The Department of Education is charged with evaluating Title I of the Elementary and Secondary Education Act (ESEA) and other elementary and secondary education legislation enacted by the 103rd Congress. These surveys will collect information on the operations and effects at the state level of legislative provisions and federal assistance, in the context of state education reform efforts. Findings will be used in reporting to Congress and improving information dissemination. Respondents are managers in nine programs in all 50 state education agencies.

Office of the Under Secretary

Type of Review: New.

Title: 1998 Study of America Reads Challenge: READ*WRITE*NOW! (ARC:RWN) Summer Sites.

Frequency: On Occasion.

Affected Public: State, local or Tribal Gov't, SEAs or LEAs.

Reporting and Recordkeeping Hour Burden: