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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/039,192	02/28/2008	Yoshimasa YAMAGUCHI	322991US0

CONFIRMATION NO. 7035

CONVERSION REQUEST

22850
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

OC000000039404590

Date Mailed: 12/30/2009

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **02/17/2009,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,694.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/039,192	02/28/2008	Yoshimasa YAMAGUCHI	322991US0	7035

22850 7590 12/17/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
JEAN-LOUIS, SAMIRA JM	
ART UNIT	**PAPER NUMBER**
1627	

NOTIFICATION DATE	DELIVERY MODE
12/17/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Copied from 12039192 on 12/29/2009

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DEC 1 7 2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

Yamaguchi et al. :
Serial No.: 12/039,192 : CONVERSION TO PROVISIONAL
Filed: February 28, 2008 :
Attorney Docket No.: **322991US0** :

This is in response to applicants' request, filed February 17, 2009, to convert this application to a provisional application.

The petition is **GRANTED**.

Should there be any questions regarding the conversion process please contact Janice Tippitt at 703-756-1477.

Should there be any questions with regard to this letter please contact Marianne C. Seidel by letter addressed to the Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0584 or by facsimile transmission at Office facsimile number, 703-872-9306.

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

Copied from 12039192 on 12/29/2009

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/418,051	04/03/2009	Shinji Takahashi	Q112910

CONFIRMATION NO. 7673

65565
SUGHRUE-265550
2100 PENNSYLVANIA AVE. NW
WASHINGTON, DC 20037-3213

CONVERSION REQUEST

OC000000040293337

Date Mailed: 02/26/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **01/29/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,695.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/418,185	04/03/2009	Junya Ohmori	Q112912

CONFIRMATION NO. 7937

65565
SUGHRUE-265550
2100 PENNSYLVANIA AVE. NW
WASHINGTON, DC 20037-3213

CONVERSION REQUEST

Date Mailed: 02/26/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **01/29/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,696.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/417,788	04/03/2009	Harlan S. Hall	098101-0105	7122

48329 7590 02/02/2010

FOLEY & LARDNER LLP
111 HUNTINGTON AVENUE
26TH FLOOR
BOSTON, MA 02199-7610

EXAMINER	
ART UNIT	PAPER NUMBER
1615	

MAIL DATE	DELIVERY MODE
02/02/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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FEB 02 2010

FOLEY & LARDNER LLP
111 HUNTINGTON AVENUE
26TH FLOOR
BOSTON MA 02199-7610

Hall et al.	:
Serial No.: 12/417,788	: CONVERSION TO PROVISIONAL
Filed: April 3, 2009	:
Attorney Docket No.: **098101-0105**	:

This is in response to applicants' request, filed January 27, 2010, to convert this application to a provisional application.

The petition is **GRANTED**.

Should there be any questions regard the conversion process please contact Janice Tippitt at 703-756-1477.

Should there be any questions with regard to this letter please contact Marianne C. Seidel by letter addressed to the Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0584 or by facsimile transmission at Office facsimile number, 703-872-9306.

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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Alexandria, Virginia 22313-1450
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/417,788	04/03/2009	Harlan S. Hall	098101-0105

CONFIRMATION NO. 7122

48329
FOLEY & LARDNER LLP
111 HUNTINGTON AVENUE
26TH FLOOR
BOSTON, MA 02199-7610

CONVERSION REQUEST

Date Mailed: 03/01/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **01/27/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,697.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/706,122	02/16/2010	Garry Cyrille Alfred VanDenBerghe	86316-132 ADB

CONFIRMATION NO. 1037

CONVERSION REQUEST

AIR MAIL
23529
ADE & COMPANY INC.
2157 Henderson Highway
WINNIPEG, MB R2G1P9
CANADA

OC000000041017182

Date Mailed: 04/07/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/18/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,698.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
11/731,014	03/29/2007	Reinder J. Boersma	ACUM-005AX

CONFIRMATION NO. 5874

207
WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI LLP
TEN POST OFFICE SQUARE
BOSTON, MA 02109

CONVERSION REQUEST

OC000000041018238

Date Mailed: 04/07/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/26/2008,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,699.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/731,014	03/29/2007	Reinder J. Boersma	ACUM-005AX	5874

207 7590 03/09/2010

WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI LLP
TEN POST OFFICE SQUARE
BOSTON, MA 02109

EXAMINER	
HANDAL, KAITY V	
ART UNIT	PAPER NUMBER
1795	
MAIL DATE	DELIVERY MODE
03/09/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

3/9/10

CST

In re application of
Reinder J. Boersma et al
Serial No. 11/731,014
Filed: March 29, 2007
For: ARCHITECTURES FOR ELECTROCHEMICAL SYSTEMS

DECISION ON PETITION

This is a decision on the REQUEST TO CONVERT NONPROVISIONAL APPLICATION TO PROVISIONAL APPLICATION, filed March 26, 2008.

A review of the application record indicates that all of the requirements for converting the above-identified application to a provisional application under 37 CFR 1.53(c)(2) have been met.

The petition is **GRANTED.**

This application will be forwarded to the Office of Patent Application Processing (OPAP) for conversion to a provisional application.

It is noted that an office action was mailed on February 25, 2010, after the petition to convert the above-identified application to a provisional application was filed. This office action will be vacated. No response to the office action of February 25, 2010 is required.

/ Christine Tierney /

Christine Tierney
Quality Assurance Specialist
Technology Center 1700

Copied from 11731014 on 04/07/2010

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/716,058	03/02/2010	Wilhelm R. Schmeider	MVIR-0619/328709.01

CONFIRMATION NO. 9978

CONVERSION REQUEST

41505
WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

OC000000041554831

Date Mailed: 05/10/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **04/29/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,700.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/660,255	02/23/2010	Slobodan Cuk	ISC-1

CONFIRMATION NO. 1915

71968
CUKS , LLC
35 TESLA, SUITE 350
IRVINE, CA 92618

CONVERSION REQUEST

OC000000041624801

Date Mailed: 05/13/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/25/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,701.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/455,568	06/03/2009	Michael F. Pickholz	7720.3008.001

CONFIRMATION NO. 7229

CONVERSION REQUEST

Michael F. Pickholz
1813 Manalee Lane
Oxford, MI 48371

OC000000042075920

Date Mailed: 06/14/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **08/17/2009,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,702.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/814,967	06/14/2010	Sean MOORE	JHN-4633-71

CONFIRMATION NO. 1400

23117
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

CONVERSION REQUEST

OC000000042325186

Date Mailed: 06/29/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **06/21/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,703.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/653,483	12/08/2009	Jason C. Beschen	0078058-000001

CONFIRMATION NO. 1723

Jason C. Beschen
135 Colonial Ave.
Pittman, NJ 08071

CONVERSION REQUEST

OC000000042325926

Date Mailed: 06/28/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **06/11/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,704.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/603,963	10/22/2009	Edward Tansingco	25517

CONFIRMATION NO. 7597

CONVERSION REQUEST

24932
LAUBSCHER & LAUBSCHER, P.C.
1160 SPA ROAD
SUITE 2B
ANNAPOLIS, MD 21403

OC000000042442267

Date Mailed: 07/07/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **06/23/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/275,705.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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JUN 25 2010

Laubscher & Laubscher P.C.
1160 Spa Road
Suite 2B
Annapolis, MD 21403

In re application of :
Edward Tansingco :
Application No. 12/603,963 : DECISION ON PETITION
Filed: October 22, 2009 : TO CONVERT TO A
For: TRAVEL PILLOW PROVIDING HEAD : PROVISIONAL APPLICATION
AND NECK ALIGNMENT DURING USE :

This is a decision on the petition under 37 CFR 1.53(c)(2) filed June 23, 2010, to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c)(2).

The requirements for the granting of such a petition are: (A) a petition requesting conversion and the petition fee set forth in 37 CFR 1.17(q), and (B) the petition must be filed prior to the abandonment of the 37 CFR 1.53(b) application, the payment of the issue fee, the expiration of 12 months after the applications filing date, or the filing of a request for a statutory invention registration under 37 CFR 1.293, whichever event is earlier. Upon the grant of such a petition no fees properly paid in the 37 CFR 1.53(b) application are entitled to be refunded.

Since all of the requirements for conversion to a provisional application under 37 CFR 1.53(c)(2) have been met, the petition is **GRANTED**.

The application will be assigned a new provisional application number and will be further processed by the Office of Initial Patent Examination (OIPE) as a **PROVISIONAL** application under 35 U.S.C. 111(b) and 37 CFR 1.53(c)(2). The new provisional application number will be communicated to applicant by OIPE in due course.

Steven N. Meyers,
Quality Assurance Specialist
Patent Technology Center 3600
(571) 272-6611

SM/SM: 6/24/10

Copied from 12603963 on 07/06/2010

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MARSHALL & MELHORN, LLC
FOUR SEAGATE - EIGHTH FLOOR
TOLEDO OH 43604

MAILED

JUN 08 2010

OFFICE OF PETITIONS

In re Application of :
Mark Rupp et al. :
Application No. 61/276, 221 : DECISION ON PETITION
Filed: September 9, 2009 :
Attorney Docket No: 1-18506 :

This is a decision on the petition to accord a filing date, filed March 29, 2010, which is treated as a petition under 37 CFR 1.53(e), requesting that the above-identified provisional application be accorded a filing date of September 9, 2009.

The petition is **GRANTED**.

The instant provisional application papers as deposited on September 9, 2009 consisted of sixty-one (61) pages of drawings. On January 29, 2010, however, the Office of Data Management sent a Notice of Incomplete Provisional Application, indicating that the papers as filed, lacked a specification and that the filing date would be the date of receipt of the missing specification.

In reply, the instant petition to accord a filing date of September 9, 2009 includes an argument that the written description, in accordance with 35 U.S.C. § 112 paragraph 1, was set forth. Some of the figures, such as Figs. 1-4, contained written description of the invention and while the entire structure and operation of a scrubber is not described, it need not be because the nature of the invention, that is the hinge and pin mechanism and the side emptying debris bin of the pre-sweep unit, is clear to those skilled in the art by the written description in the provisional application, .thus entitling the application to a filing date of September 9, 2009.

Pursuant to 35 U.S.C. 111(b)(1)(A);(B), in order to obtain a filing date, a provisional application must provide the specification required by 35 U.S.C. 112 ¶ 1, and a drawing as prescribed by 35 U.S.C. 113. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

RELEVANT STATUTES, REGULATIONS AND PROCEDURE

35 U.S.C. 111(b) provides, in pertinent part, that:

(1) AUTHORIZATION. —A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include —

(A) a specification as prescribed by the first paragraph of section 112 of this title; and

(B) a drawing as prescribed by section 113 of this title.

(2) CLAIM. —A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.

...

(4) FILING DATE. —The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

35 U.S.C. 112, first paragraph, provides that:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

37 C.F.R. § 1.53(c) further provides that:

> The filing date of a provisional application is the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.
>
> > (1) A provisional application must also include the cover sheet required by § 1.51(c)(1), which may be an application data sheet (§ 1.76), or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

MPEP 601.01(b) provides that:

> A provisional application will be given a filing date in accordance with 37 CFR 1.53(c) as of the date the written description and any necessary drawings are filed in the Office. The filing date requirements for a provisional application set forth in 37 CFR 1.53(c) parallel the requirements for a nonprovisional application set forth in 37 CFR 1.53(b), except that no claim is required. Amendments, other than those required to make the provisional application comply with applicable regulations, are not permitted after the filing date of the provisional application.

OPINION

Petitioner disputes the fact that the application as filed did not include a specification but while no evidence was presented to support the claim, petitioner relies on the written description about the invention and argues that the description is adequate to meet the requirements of 35 USC 112.

It is the practice of the Office to accord a filing date to an application that appears to comply with the requirements for according a filing date. Inasmuch as drawings alone may be sufficient to provide the written description requirement of § 112, first paragraph, and the instant application contains drawings and claims are not required, the instant provisional application appears to comply with the requirements for according a filing date. It is not necessary to now determine whether this provisional application will adequately support any non-provisional application claiming the benefit of its filing date. In this instance, the drawings will be construed as the written description required by 35 U.S.C. § 112, first paragraph.

CONCLUSION

In view thereof, the petition is **GRANTED**.

The petition fee is being refunded to Deposit Account No. 13-1816, as authorized.

The provisional application file is being returned to the Office of Patent Application Processing for **correction of the filing date to September 9, 2009**.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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P.O. Box 1450
Alexandria, VA 22313-1450
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R. REAMS GOODLOE, P.S.
24722 - 104TH AVENUE, S.E.
SUITE 102
KENT WA 98030-5322

MAILED

APR 2 6 2010

OFFICE OF PETITIONS

In re Application of	:	DECISION
Heins et al.	:	ON PETITION
Application No. 61/278376	:	
Filing or 371(c) Date: 10/05/2009	:	
Title of Invention:	:	
OPTIMIZATION OF SAGD	:	
PRODUCED WATER	:	
EVAPORATOR DESIGN	:	

This is a decision on the "Petition in Response to Notice of Omitted Item(s) in a Provisional Application (37 CFR 1.53(c), filed January 2, 2010, requesting the above-identified application be accorded a filing date of October 5, 2009, including page 4 of the specification. The petition is properly treated under 37 CFR 1.182.

The petition is dismissed.

Background

Application papers were filed in the above-identified application on October 5, 2009. On November 2, 2009, the Office of Patent Application Processing mailed a Notice of Omitted Item(s) in a Provisional Application (hereinafter "Notice"), informing Applicant that the application had been accorded a filing date; however, page 4 of the specification appeared to have been omitted from the application.

The present petition

Applicant responds with the present petition and avers that the application as-filed on October 5, 2009 included 8 pages of specification. In support of this assertion, applicant files copies of a return-receipt postcard; express mailing labels and the Declaration of Rhonda Goodloe wherein Ms. Goodloe declares, inter alia, that she personally mailed eight pages of specification to this Office on October 5, 2009.

A review of the application file

A review of the application file reveals that this Office did not receive page 4 of the specification. A document was placed in the file on October 5, 2009 noting that the Office did not receive page 4 of the specification. A review of the return-receipt postcard filed by applicants as evidence that the specification contained 8 pages of specification were filed in this Office on October 5, 2009 reveals that the postcard was annotated that this Office did not receive a "spec." This Office subsequently mailed a Notice of Omitted Item(s) in a Provisional Application informing Applicant that the application had been accorded a filing date; however, page 4 of the specification appeared to have been omitted from the application.

Applicable Law, Rules and MPEP

The Manual of Patent Examining procedure ("MPEP") 503 provides as follows:

A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

However, prima facie evidence as defined in Black's Law Dictionary is evidence sufficient to establish a given fact, and which if not rebutted or contradicted, will remain sufficient.

Analysis

In this instance, Applicant's return postcard was annotated noting that the "spec" was missing. In addition, the application file contains an entry on October 5, 2009 noting that the Office did not receive page 4 of the specification. Thereafter this Office mailed a Notice of Omitted Item(s) in a Provisional Application informing Applicant that the application had been accorded a filing date; however, page 4 of the specification appeared to have been omitted from the application.

Regarding the declaration of Ms. Goodloe, Applicant is advised that the USPTO file is the official record of the papers actually received or filed. The file does not contain a copy of page 4 of the of the specification that was filed on October 5, 2009. Applicant's (Ms. Goodloe's) recollection of events that had occurred seven weeks prior to the filing of the Declaration is not more persuasive than Office records.

Conclusion

Applicant has failed to demonstrate that page 4 of the specification was present on filing. Applicant's recollection of events that occurred more than seven weeks prior to the filing of the petition is not more persuasive than the application file.

The petition under 37 CFR 1.182 to establish receipt in the Office of page 4 of the specification is dismissed.

Applicant is advised that

> in view of the relatively low filing fee for provisional applications, and the USPTO's desire to minimize the processing of provisional applications, the USPTO will not grant petitions under 37 CFR 1.182 to accept omitted page(s) and accord an application filing date as of the date of such submission in provisional applications. The applicant should simply file a new completed provisional application.

MPEP 601.01(d)

The application will be returned to the Office of Initial Patent Examination for further processing with a filing date of October 5, 2009, using the application papers filed on that date.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

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JUN 28 2010

OFFICE OF PETITIONS

NORMAN E. LEHRER, P.C.
1205 NORTH KINGS HIGHWAY
CHERRY HILL NJ 08034

In re Application of
Gil Paul
Application No. 61/278,629
Filed: October 9, 2009
Attorney Docket No. 1894-51

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 22, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Vanitha M. Elgart, former attorney/agent associated with customer number 34678. Vanitha M. Elgart has been withdrawn. All other attorneys/agents will remain of record.

The correspondence address will remain the same until further notified by applicant.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

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1205 NORTH KINGS HIGHWAY
CHERRY HILL NJ 08034

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JUN 28 2010

OFFICE OF PETITIONS

In re Application of
Larry Goldberg et al.
Application No. 61/279,590
Filed: October 23, 2009
Attorney Docket No. 6938-1

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 22, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Vanitha M. Elgart, former attorney/agent associated with customer number 34678. Vanitha M. Elgart has been withdrawn. All other attorneys/agents will remain of record.

The correspondence address will remain the same until further notified by applicant.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

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Paper No.

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JAN 19 2010

OFFICE OF PETITIONS

MCNAIR LAW FIRM, P.A.
P.O. BOX 447
GREENVILLE SC 29602-0447

In re Application of :
Usher :
Application No. 61/280,062 : DECISION ON PETITION
Filed: October 28, 2009 : PURSUANT TO
Attorney Docket No.: : 37 C.F.R. § 1.182
044139.00007 :
Title: IPA/POLYESTER COPOLYMER :
FIBER :

This is a decision on the petition filed November 27, 2009, requesting that the above-identified application be accorded a filing date of October 29, 2009.

The application was deposited on October 28, 2009, and a filing receipt was mailed on November 16, 2009, indicating that this application had been accorded a filing date of October 28, 2009.

With this petition, Petitioner has asserted that this application was deposited on October 29, 2009. Petitioner has included a date-stamped post card receipt, which contains a date-stamp from the Office of Initial Patent Examination dated "Oct 28 2009" along with the following pre-printed text: "Date Mailed 10/29/09."

This petition cannot be granted as the pre-printed text which appears on this postcard is not more persuasive than the date-stamp which appears on the same.

This petition is **DISMISSED.**

The Office of Patent Application Processing (OPAP) will be notified that the application will retain the filing date of October 28, 2009.

It is noted that the transmittal sheet which was included on filing contains an Express Mail label number. If Petitioner is in possession of the corresponding Express-Mail label, he may wish to consider submitting the same along with a petition pursuant to 37 C.F.R. § 1.10(c) or (d), as appropriate. Any such petition should indicate in a prominent manner that the petition should be directed to the undersigned, and may be submitted by mail,[1] hand-delivery,[2] or facsimile.[3] Registered users of EFS-Web may alternatively submit such a petition via EFS-Web.[4] If submitting by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the submission to the undersigned.

The general phone number for OPAP is 571-272-4000. Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225.[5]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
2 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
3 (571) 273-8300- please note this is a central facsimile number.
4 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
5 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

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MAR 12 2010

OFFICE OF PETITIONS

ABELMAN FRAYNE & SCHWAB
666 THIRD AVENUE 10TH FLOOR
NEW YORK NY 10017

In re Application of :
Sheps, et al. :
Application No. 61/283,445 : DECISION GRANTING PETITION
Filed: December 2, 2009 :
Attorney Docket No. 210,658 :

This is a decision on the petition under 37 CFR 1.53, filed January 12, 2010, to accord the above-identified application a filing date of December 2, 2009, with 9 pages of drawing as part of the original disclosure.

The petition is **GRANTED**.

Application papers in the above-identified application were filed on December 2, 2009. However, on December 24, 2009, the Office of Data Management mailed applicants a "Notice of Incomplete Provisional Application." Applicants were informed that the application had not been accorded a filing date because the application was deposited without drawings.

In response, applicants filed the present petition. Applicants submitted nine page of drawings, together with a postcard receipt identifying the application, itemizing "Drawings (9 pgs.)" as enclosed, and bearing a USPTO date stamp of December 2, 2009.

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the Office of all items listed thereon on the date stamped thereon by the Office.[1]

Given the basis for granting this petition, the $400 petition fee has been refunded to Deposit Account No. 01-0035.

The application is being forwarded to the Office of Patent Application Processing for further processing with a filing date of December 2, 2009, using the application papers received in the Office on that date and the 9 drawing pages as re-supplied on petition filed January 12, 2010, and for indication in Office records that 9 sheets of drawings were present on filing.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

[1] See MPEP 503.

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NORMAN E. LEHRER, P.C.
1205 NORTH KINGS HIGHWAY
CHERRY HILL NJ 08034

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JUN 2 8 2010

OFFICE OF PETITIONS

In re Application of
Gil Paul et al.
Application No. 61/284,096
Filed: December 14, 2009
Attorney Docket No. 1894-52

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 22, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Vanitha M. Elgart, former attorney/agent associated with customer number 34678. Vanitha M. Elgart has been withdrawn. All other attorneys/agents will remain of record.

The correspondence address will remain the same until further notified by applicant.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

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CALFEE HALTER
& GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND OH 44114

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JUN 08 2010

OFFICE OF PETITIONS

In re Application of :
Babcock, et al. :
Application No. 61/284,379 : DECISION
Filed/Deposited: 16 December, 2009 :
Attorney Docket No. 19358/04049 :

This is a decision on the papers failing to state authority for their submission, but nonetheless considered as a petition pursuant to 37 C.F.R. §1.10, filed on 15 January, 2010, seeking for the above-identified application a filing date of 16 December, 2009, rather than the presently accorded filing date of 17 December, 2009.

NOTE:

Although Petitioner did not expressly state that the documents presented were "true copies," the Office has so construed Petitioner's statement and presentation, consistent with Petitioner's duty of candor to the Office.[1] If this understanding is incorrect, Petitioner **must** immediately so notify the Office.

The petition is **GRANTED**.

BACKGROUND AND ANALYSIS

The instant application was received by the Office and subsequently accorded a filing date of 15 April, 2008.

The record reflects that:

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[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

- the instant application (bearing Docket No. 19358/04049), averred to have been transmitted the package bearing US Postal Service (USPS) Express Mail Label No. EV764672555US, appears to have been received by the Office on 18 December, 2009, and subsequently given a filing date of 17 December, 2009;

- with the instant petition, filed on 15 January, 2010, Petitioner provided, *inter alia*, a copy of the USPS Express Mail label bearing USPS Express Mail Label No. EV764672555US, with a hand-written "date in" of "12 [space] 16 [space] 09," (there is no stamped date) and Petitioner avers that is the correct date. Moreover, the USPS online "Track and Confirm" website reports the following: "Acceptance, December 16, 2009, 8:13 pm, COLUMBUS, OH 43236." (Petitioner is reminded that this system may be an important resource in making such showings as may be required before the Office);

- Petitioner provides a file copy of the original receipt card, but it appears that Petitioner may not have received back a date-stamped copy;

- further, it appears that the Office issued a filing receipt on 11 January, 2010, and Petitioner replied with the instant petition on 15 January, 2010.

The record indicates that the instant petition was filed "promptly after [Petitioner became] aware that the Office ha[d] accorded, or w[ould] accord, a filing date other than the USPS deposit date."

The Express Mail label number appears to have been placed on the papers sought to be filed thereunder (but those papers were not provided with the petition, however, the Office has reviewed the papers deposited on filing and finds that the USPS Express Mail Label No. EV764672555US appears on the transmittal page of those papers), and appears on the USPS Express Mail label presented with the date-in data as described above. Again the Office notes that it has construed Petitioner's presentation to read that all of the copies submitted are "true copies" of papers submitted and of USPS materials—and Petitioner has made a showing consistent with at 37 C.F.R. §1.10. Thus, Petitioner has satisfied the requirements set forth at 37 C.F.R. §1.10.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts

of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[2]

The petition is **granted**, and the petition fee is waived and it appears that none was charged.

The instant file is released to the Office of Patent Application Processing (OPAP) to correct the filing date so as to accord to the instant application a filing date of 16 December, 2009, and to mail to Petitioner a corrected filing receipt reflecting a filing date of 16 December, 2009.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[3]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

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[2] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

[3] The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

Gillon, John

From: U.S._Postal_Service_ [U.S._Postal_Service@usps.com]
Sent: Monday, June 07, 2010 7:32 AM
To: Gillon, John
Subject: U.S. Postal Service Track & Confirm email Restoration - EV76 4672 555U S

This is a post-only message. Please do not respond.

John Gillon has requested that you receive this restoration information for Track & Confirm as listed below.

Current Track & Confirm e-mail information provided by the U.S. Postal Service.

Label Number: EV76 4672 555U S

Service Type: Express Mail(R)

Shipment Activity	Location	Date & Time
Delivered	ALEXANDRIA VA 22313	12/18/09 8:48am
Arrival at Unit	DULLES VA 20102	12/18/09 7:31am
Processed through Sort Facility	COLUMBUS OH 43236	12/16/09 10:35pm
Acceptance	COLUMBUS OH 43236	12/16/09 8:13pm

USPS has not verified the validity of any email addresses submitted via its online Track & Confirm tool.

For more information, or if you have additional questions on Track & Confirm services and features, please visit the Frequently Asked Questions (FAQs) section of our Track & Confirm site at http://www.usps.com/shipping/trackandconfirmfaqs.htm

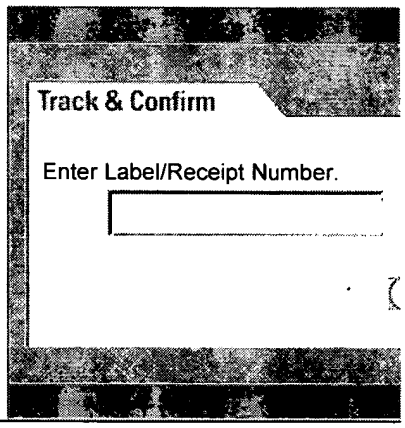
Track & Confirm

Search Results

Label/Receipt Number: **EV76 4672 555U S**
Class: **Express Mail®**
Status: **Delivered**

Your item was delivered at 8:48 AM on December 18, 2009 in ALEXANDRIA, VA 22313 to PATENT OFFICE . The item was signed for by M BOSTON.

Information on this item has been restored from offline files and will be available online for 30 days from 06/07/2010.



Detailed Results:

- **Delivered, December 18, 2009, 8:48 am, ALEXANDRIA, VA 22313**
- **Arrival at Unit, December 18, 2009, 7:31 am, DULLES, VA 20102**
- **Processed through Sort Facility, December 16, 2009, 10:35 pm, COLUMBUS, OH 43236**
- **Acceptance, December 16, 2009, 8:13 pm, COLUMBUS, OH 43236**

Notification Options

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425 SHERMAN AVENUE
SUITE 230
PALO ALTO, CA 94306

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APR 22 2010

OFFICE OF PETITIONS

In re Application of :
Jiyoun Lee, et al. :
Application No. 61/287,976 : ON PETITION
Filed: December 18, 2009 :
Attorney Docket No.: 3815.77 (S09-388) :

This is a decision on the "Petition Under 37 CFR 1.53(3)," filed January 27, 2010, which is being treated as a request to withdraw that the Notice of Omitted Item(s) in a Provisional Application mailed January 11, 2010.

On December 18, 2009, applicant filed the above-identified application. However, on January 11, 2010, the Office mailed a Notice of Omitted Item(s) in a Provisional Application, stating that the application had been accorded a filing date of December 18, 2009, and advising applicant that Figures 5A and 5B described in the specification appeared to have been omitted.

In response, on January 27, 2010, applicant filed the present petition and the petition fee. Applicant asserts that Figures 5A and 5B were not omitted from the application papers as filed on December 18, 2009. Petitioner explains that Figure 5 is identified in the specification as 5A and 5B because it clearly consists of two distinct portions on the same sheet.

Upon considering applicants' argument, it appears that no drawings were actually missing on December 18, 2009. Rather, the drawings of Figures 5A and 5B were simply not labeled as a result of applicant's filing error. However, the Notice of Omitted Item(s) in a Provisional Application, mailed January 11, 2010, was correct in stating that Figures 5A and 5B described in the specification appeared to have been omitted. Therefore, the Notice of Omitted Item(s) in a Provisional Application was properly mailed and will not be withdrawn.

Accordingly, the petition is dismissed.

The petition fee will not be refunded because the present petition was not necessitated by any error on the part of the USPTO.

The Office reminds applicant that amendments, other than those required to make the provisional application comply with applicable regulations, are not permitted after the filing date of the provisional application. MPEP 601.01(b). Likewise, in view of the relatively low filing fee for provisional applications, and the desire of the USPTO to minimize the processing of provisional applications, the USPTO will not grant petitions under 37 CFR 1.182 to accept omitted page(s) or drawing(s) and accord an application filing date as of the date of such submission in provisional applications. The applicant should simply file a new completed provisional application. MPEP 601.01(d).

This matter is being referred to the Office of Patent Application Processing to process the application with a filing date of December 18, 2009, using the papers filed on that date.

Any inquiries related to this decision should be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Mr. Dennis A. Bennett
10411 Clayton Road
Suite 304
St. Louis MO 63131

MAILED

JUN 07 2010

OFFICE OF PETITIONS

In re Application of :
Barnett :
Filed: December 18, 2009 : ON PETITION
Application No. 61/288,234 :
Dkt. No.: VBS0001-101-US :

This is a decision on the "PETITION IN RESPONSE TO NOTICE OF INCOMPLETE PROVISIONAL APPLICATION," filed February 5, 2010 to accord the above-identified application a filing date of December 18, 2009.

The petition is GRANTED TO THE EXTENT INDICATED HEREIN.

The application was filed December 18, 2009 without drawings. The Notice of Incomplete Provisional Application (Notice) was mailed January 13, 2010. The Notice indicated that the application had not been accorded a filing date because the application appeared to have been submitted without drawings as required per 35 USC 113.

Petitioner argues that drawings are not necessary for an understanding of the invention.

As stated in MPEP 601.01(f), it is the practice of the PTO to treat a provisional application that contains at least some disclosure of a process or method as an application for which a drawing is not necessary for an understanding of the invention under 35 USC 113 (first sentence).

Moreover, MPEP 601.01(f) states that a nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP 601.01(g), so long as the application contains something that can be construed as a written description and the names of all the inventors. Should the Technology Center determine that drawings are necessary under 35 U.S.C. 113 (first sentence) the filing date issue will be reconsidered by the USPTO.

A review of the official file reveals that the instant application includes at least one method claim. As it is USPTO practice to treat a provisional application that contains at least some disclosure of a process or method as an application for which a drawing is not necessary, the application, as submitted, is entitled to a filing date of December 18, 2009. Thus, the instant

petition is unnecessary as the instant application is otherwise entitled to a filing date under 37 CFR 1.53(c). Accordingly, the Notice is withdrawn.

The application will be processed with only the papers present on December 18, 2009, without drawings as part of the original disclosure.

No fee is due in connection with this matter. A refund of the $400.00 petition fee has been requested on petitioner's behalf.

The application is being returned to the Office of Patent Application Processing for further processing with a filing date of December 18, 2009 using only the papers present on that day and without entry of any drawings into the record.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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JUN 11 2010

OFFICE OF PETITIONS

GILEAD SCIENCES INC
333 LAKESIDE DR
FOSTER CITY, CA 94404

In re Application of Halcomb et al. :
Application No. 61/289,158 : Decision on Petition
Filing Date: December 22, 2009 :
Attorney Docket No. 774.P2 :

This is a decision on the paper filed on February 8, 2010, which is being treated as a petition requesting that the above-identified provisional application be accorded a filing date of December 22, 2009.

The petition is **granted**.

The application was filed December 22, 2009.

The specification filed December 22, 2009, described drawings containing Figures 1-3, but no drawings were filed on December 22, 2009.

On January 19, 2010, the Office mailed a Notice stating the application was filed without drawings. The Notice stated a filing date had not been accorded and the filing date would be the date of receipt of drawings.

It is the practice of the PTO to treat a provisional application that contains at least some disclosure directed to a process or method as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

MPEP 601.01(f) states:

> It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence)....
>
> A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in

MPEP § 601.01(g), so long as the application contains something that can be construed as a written description.

This application contains some disclosure directed to a process or method.

Per 601.01(g), a Notice of Omitted Items rather than a Notice of Incomplete Application should have been mailed. The Notice of Omitted Items would have informed petitioner a filing date had been accorded and that the drawing figures referred to in the specification appeared to be missing.

In view of the above, the Notice mailed January 19, 2010, was mailed in error and is hereby withdrawn.

The application will be accorded the December 22, 2009 filing date without drawings as requested in the petition.

It should be noted that the claims filed in any subsequent non-provisional application will determine whether or not drawings are necessary for that application since the "subject matter sought to be patented" is determined by the claims in an application. Therefore, the instant decision should not be construed as a determination that drawings will or will not be necessary for a filing date for any future non-provisional applications.

The petition fee of $400 has been credited back to Deposit Account No. 07-1250.

The application is being returned to the Office of Patent Application Processing for further processing with a filing date of December 22, 2009, and issuance of a filing receipt indicating "0" sheets of drawings were present on filing.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
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STEPTOE & JOHNSON LLP
1330 CONNECTICUT AVENUE, N.W.
WASHINGTON DC 20036

MAILED

MAY 03 2010

OFFICE OF PETITIONS

In re Application of :
Vincenzo Russo, et al. :
Application No.: 61/289,856 :
Filed: December 23, 2009 :
Atty Docket No.: 15358.0008 P1 :

ON PETITION

This is a decision on the petition filed January 27, 2010, requesting that the above-identified provisional application, without drawings, be accorded a filing date of December 23, 2009.

The petition is **GRANTED**.

The application was filed on December 23, 2009, without drawings. Accordingly, on January 19, 2010, the Office of Data Management, Application Assistance Unit mailed a "Notice of Incomplete Provisional Application" stating that the application had not been accorded a filing date because the application had been deposited without drawings.

On January 27, 2010, the present petition was filed. Petitioner concedes that the application was filed without drawings, but states that drawings are not necessary for an understanding of the subject matter sought to be patented.

MPEP § 601.01(f) states that:

> A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but

filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description.

The statement by petitioner in the petition is accepted that drawings are not necessary for a filing date in this application. Drawings will not be further considered as a part of this case.

In view of the above, the "Notice" mailed January 19, 2010, was mailed in error and is hereby withdrawn.

The application is accorded a filing date of December 23, 2009, without drawings as a part of the original disclosure.

Since the petition was necessitated by an error on the part of the USPTO, no petition fee is necessary. The $400 petition fee is being credited to counsel's deposit account.

The application is being referred to the Office of Patent Application Processing for correction of the filing date to December 23, 2009.

Telephone inquiries specific to this matter should be directed to the undersigned at 571 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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JEFFREY DEAN LINDSAY
20 DIANE LANE
APPLETON WI 54915

MAILED

MAR 26 2010

OFFICE OF PETITIONS

In re Application of :
Klingman :
Application No. 61/289,992 : ON PETITION
Deposited: December 23, 2009 :
Attorney Docket No. Klingman-P1 :

This is in response to the "PETITION TO RECEIVE FILING DATE FOR A PROVISIONAL APPLICATION FILED UNDER 37 CFR 1.182" filed January 29, 2010. This petition is being treated pursuant to 37 CFR 1.53(e)(2)[1].

Application papers in the above-identified application were deposited on December 23, 2009. However, on January 7, 2010, the Office of Patent Application Processing mailed applicants a "Notice of Incomplete Provisional Application," notifying applicants that the application papers had not been accorded a filing date because the application was deposited without drawings. In response, applicants timely filed this petition. Applicant argues drawings are not necessary for a filing date.

Petitioner's arguments and evidence have been considered. However, a review of the application confirms that, as filed, the application contained at least one method claim. MPEP 601.01(f) provides that:

> It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). The same practice has been followed in composition applications.

Thus, pursuant to § 601.01(f), a drawing is not considered essential for a filing date. The instant application is entitled to a filing date without drawings present in the application.

To the extent the instant petition requests a filing date of December 23, 2009 with no drawings present in the application, the petition is **GRANTED**.

Given the basis for granting this petition, a petition fee is not required. The petition fee will be refunded.

---

[1] Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

Pursuant to this decision, the application will be referred to Office of Patent Application Processing for:

- **correction of the filing date to December 23, 2009**;
- **for indication in Office records, as appropriate, that "0" sheets of drawings were present on filing** and
- **for issuance of a filing receipt.**

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3215.

Charlema Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JUDY JARECKI-BLACK; PH.D., J.D.
3239 SATELLITE BLVD. 3RD FLOOR
DULUTH GA 30096

MAILED

MAR 29 2010

OFFICE OF PETITIONS

In re Application of :
Guo :
Application No. 61/290,297 : ON PETITION
Filed: December 28, 2009 :
Attorney Docket No. MER 09-139P :

This is a decision on the petition filed January 29, 2010, requesting in effect, the "Notice of Omitted Item(s) in a Provisional Application" ("Notice") be withdrawn, and the above-identified application be accorded a filing date of December 28, 2009 including figure 6b.

The petition is **Dismissed**.

Any request for reconsideration of this decision should be filed within **TWO MONTHS** of the date of this decision in order to be considered timely (see 37 CFR 1.181(f)). No extensions of time pursuant to the provisions of 37 CFR 1.136 are permitted. If reconsideration is not requested within the time period specified above, this application will be forwarded to the Office of Patent Application Processing with the presently accorded filing date of December 28, 2009.

Application papers in the above-identified application were filed on December 28, 2009. However, on January 20, 2010, the Office of Patent Application Processing mailed applicant a "Notice of Omitted Item(s) in a Provisional Application" notifying applicants that the application papers had been accorded a filing date but figure 6b appeared to have been omitted.

In response, the present petition was filed wherein Petitioner contends figure 6b as described in the specification was filed on December 28, 2009 but was not labeled. A copy of figures 6a and 6b further accompanies the petition. Petitioner contends no new matter is being added.

A review of the record shows that the figure on page 14 of 25 is unlabeled.

However, the amendment and drawings submitted on petition cannot be considered as part of the original disclosure.

Petitioner is reminded the filing date of a provisional application is the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application. See 35 U.S.C. 111(b)(4) and 37 C.F.R. 1.53(c). Thus, in a provisional application, petitioner does not have the option of amending the application to include figures on the basis that those figures do not constitute new matter.

Furthermore, with regard to omitted figures in provisional applications, MPEP 601.01(d) specifically provides that:

> The submission of omitted page(s) or drawing(s) in a nonprovisional application and acceptance of the date of such submission as the application filing date is tantamount to simply filing a new application. Thus, applicants should consider filing a new application as an alternative to submitting a petition under 37 C.F.R. 1.182 (with the petition fee under 37 C.F.R. 1.17(h)) with any omitted page(s) or drawing(s), which is a cost effective alternative in instances in which a nonprovisional application is deposited without filing fees. Likewise, in view of the relatively low filing fee for provisional applications, and the USPTO's desire to minimize the processing of provisional applications, the USPTO will not grant petitions under 37 C.F.R. 1.182 to accept omitted page(s) or drawing(s) and accord an application filing date as of the date of such submission in provisional applications. The applicant should simply file a new completed provisional application.

Thus, it is concluded that applicant does not have the option of amending this provisional application to include the inadvertently unlabeled figures nor can applicant submit the labeled figures and accept a later filing date.

The petition is dismissed. The petition fee will not be refunded as the petition was necessitated by the condition of the application on filing.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3215.

Charlema Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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APR 22 2010

OFFICE OF PETITIONS

GENERAL MILLS, INC.
P.O. BOX 1113
MINNEAPOLIS, MN 55440

In re Application of :
John Engstrom, et al. :
Application No.: 61/290,735 : ON PETITION
Filed: December 29, 2009 :
Atty Docket No.: 7387USPRV :

This is a decision on the petition filed January 28, 2010, requesting that the above-identified provisional application, without drawings, be accorded a filing date of December 29, 2009.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. However, in accordance with 37 CFR 1.34(a), the signature of Wilson Aleya R. Champlin appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that she is authorized to represent the particular party on whose behalf she acts. However, if Ms. Champlin desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence regarding this application file will be directed solely to the address of record.

The petition is **GRANTED**.

The application was filed on December 29, 2009, without drawings. Accordingly, on January 11, 2010, the Office of Data Management, Application Assistance Unit mailed a "Notice of Incomplete Provisional Application" stating that the application had not been accorded a filing date because the application had been deposited without drawings.

On January 28, 2010, the present petition was filed, wherein petitioner states that drawings are not necessary for an understanding of the subject matter sought to be patented. Therefore, petitioner requests that the application be accorded a filing date and the petition fee refunded

MPEP § 601.01(f) states that:

> A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description.

The statement by petitioner in the petition is accepted that drawings are not necessary for a filing date in this application. Drawings will not be further considered as a part of this case.

In view of the above, the "Notice" mailed January 11, 2010, was mailed in error and is hereby withdrawn.

The application is accorded a filing date of December 29, 2009, without drawings as a part of the original disclosure.

Since the petition was necessitated by an error on the part of the USPTO, no petition fee is necessary. The $400 petition fee is being credited to counsel's deposit account.

The application is being referred to the Office of Patent Application Processing for correction of the filing date to December 29, 2009.

Telephone inquiries specific to this matter should be directed to the undersigned at 571 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No.

APR 12 2010

OFFICE OF PETITIONS

Kane Kessler P.C.
1350 Avenue of the Americas
26th Floor
New York NY 10019

In re Application of	:	
Stabile	:	
Application No. 61/291,062	:	DECISION ON PETITION
Filed: December 30, 2009	:	
Attorney Docket No.:	:	
7835/1139	:	
Title: 7835/1139	:	

This is a decision on the petition filed January 26, 2010, requesting that the above-identified application be accorded a filing date of December 30, 2009.

The application was deposited on December 30, 2009. However, on January 21, 2010, the Office of Data Management (ODM) mailed a "Notice of Incomplete Provisional Application" (notice), stating that the application had not been accorded a filing date, and advising applicants that a filing date would be accorded upon the deposit of a specification.

In response, on January 26, 2010, applicants filed the present petition along with the petition fee. Petitioner alleges that a specification was submitted on filing, albeit embedded within the text of the drawings.[1]

A review of the 11 pages of drawings filed on December 30, 2009, shows that the pages do contain a combination of text and drawing. Since there was something present on December 30, 2009 which can be construed as a written description, the present provisional application may be accorded the requested filing date.

1 Petition, page 2.

The petition is **GRANTED**.

However, this decision should not be construed as an indication that any particular invention disclosed in the present provisional application has been disclosed in the manner required by 35 U.S.C. § 112, first paragraph. Applicants are reminded that in order for a nonprovisional application to be entitled to the benefits of a prior provisional application filing date, the invention being claimed in the nonprovisional application must be disclosed in the provisional application in the manner provided by the first paragraph 35 U.S.C. § 112, including a recitation of the "best mode." See 35 U.S.C. § 119(e).

The notice mailed January 21, 2010 was sent in error, and is hereby **VACATED**. Therefore, no petition fee is necessary, and the petition fee will be refunded to Petitioner's credit card in due course.

Pursuant to this decision, the application will be referred to the Office of Patent Application Processing (OPAP) for:

- processing the application with a filing date of December 30, 2009, and;
- issuance of a filing receipt.

Petitioner will note that the one-page specification which was filed concurrently with this petition on January 26, 2010 has not been entered and is not a part of the original disclosure.

The general phone number for OPAP is 571-272-4000. Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225.[2]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

2 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

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P.O. Box 1450
Alexandria, VA 22313-1450
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ALSTON & BIRD LLP
PIONEER HI-BRED INTERNATIONAL, INC.
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE NC 28280-4000

MAILED

MAR 0 1 2010

OFFICE OF PETITIONS

In re Application of	:	
Gordon-Kamm, et al	:	
Application No. 61/291,247	:	DECISION ON PETITION
Filed: December 30, 2009	:	
Attorney Docket No. 035718/380123	:	

This is a decision on the request filed February 4, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee), requesting refund of the filing fee for the above-identified application.

The petition is **GRANTED**.

Petitioner asserts that the instant application was an unintended duplicate filing via EFS-Web.

37 CFR 1.26(a) states, in part: "The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee."

However, the Office may find a mistake pursuant to 37 CFR 1.26, waive the presumption in 37 CFR 1.26 that applications are not entitled to filing fee refunds, and refund the filing fees associated with unintended duplicate application filings via EFS-Web.

The Office has accepted petitioner's statement as an assertion that the duplicate application was filed by mistake. Accordingly, the filing fee of $490.00, submitted on December 30, 2009, has been credited to petitioner's deposit account no. 16-0605 as authorized.

The request for refund of the filing fee will normally be construed as a request to expressly abandon the above-mentioned application. It is noted that the instant application is already abandoned, either by operation of law, or through the filing of a declaration of express abandonment by applicant. Accordingly, no further action will be taken in this application.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitioner Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
61/293,157	01/07/2010	Michelle L. Prince		4409

EXAMINER

7590 02/02/2010

Perry P. Mason
PO Box 2455
Norman, OK 73070

ART UNIT	PAPER NUMBER

MAIL DATE	DELIVERY MODE
02/02/2010	PAPER

DECISION DISMISSING PETITION UNDER 37 CFR 1.138(d)

The declaration of express abandonment will not be recognized

This is in response to the petition under 37 CFR 1.138(d), requesting for a refund of any previously paid search fee and excess claims fee in the above-identified application.

The petition is dismissed.

The express abandonment will **not** be recognized for the reason(s) indicated below:

1. ☐ The petition was not filed in sufficient time to permit the appropriate officials to recognize the abandonment before an examination has been made of the application. See 37 CFR 1.138(d).

2. ☐ The petition was not signed by a party authorized by 37 CFR 1.33(b)(1), (3) or (4).

3. ☐ The application is not an application filed under 35 U.S.C. 111(a) on or after December 8, 2004.

4. ☑ The petition for express abandonment under 1.138(d) is dismissed because the applicant did not pay any search fee and excess claims fees in the above-identified application.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

Kaletus Buchanan

Patent Publication Branch
Office of Data Management

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
61/293,157	01/07/2010	Michelle L. Prince		4409

EXAMINER

7590 02/02/2010

Perry P. Mason
PO Box 2455
Norman, OK 73070

ART UNIT	PAPER NUMBER

MAIL DATE	DELIVERY MODE
02/02/2010	PAPER

DECISION DISMISSING PETITION UNDER 37 CFR 1.138(c)

The declaration of express abandonment will not be recognized

This is in response to the petition under 37 CFR 1.138(c), for express abandonment to avoid publication of the above-identified application.

The petition is dismissed.

The express abandonment will **not** be recognized for the reason(s) indicated below:

1. ☐ The petition under 37 CFR 1.138(c) was not filed in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process.
2. ☐ The petition was not signed by a party authorized by 37 CFR 1.33(b)(1), (3) or (4).
3. ☐ The Application was published in compliance with 35 U.S.C. 122(b), and it is available on the USPTO web site at http://www.uspto.gov/patft/index.html.
4. ☑ Petition fee was not paid.

The application **has/will be published** as scheduled.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

Kalista Buchanan
Patent Publication Branch
Office of Data Management

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JOHN RYZNIC
FLORIDA TURBINE TECHNOLOGIES, INC.
1701 MILITARY TRAIL, SUITE 110
JUPITER FL 33458-7887

MAILED
APR 22 2010
OFFICE OF PETITIONS

In re Application of :
Judson J. Kruerger, et al. :
Application No.: 61/293,233 : ON PETITION
Filed: January 8, 2010 :
Atty Docket No.: F845P :

This is a decision on the petition filed January 28, 2010, requesting that the above-identified provisional application, without drawings, be accorded a filing date of January 8, 2010.

The petition is **GRANTED**.

The application was filed on January 8, 2010, without drawings. Accordingly, on January 25, 2010, the Office of Data Management, Application Assistance Unit mailed a "Notice of Incomplete Provisional Application" stating that the application had not been accorded a filing date because the application had been deposited without drawings.

On January 28, 2010, the present petition was filed, wherein petitioner states that drawings are not necessary for an understanding of the subject matter sought to be patented.

MPEP § 601.01(f) states that:

> A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description.

The statement by petitioner in the petition is accepted that drawings are not necessary for a filing date in this application. Drawings will not be further considered as a part of this case.

In view of the above, the "Notice" mailed January 25, 2010, was mailed in error and is hereby withdrawn.

The application is accorded a filing date of January 8, 2010, without drawings as a part of the original disclosure.

Since the petition was necessitated by an error on the part of the USPTO, no petition fee is necessary. The $400 petition fee is being credited to counsel's deposit account.

The application is being referred to the Office of Patent Application Processing for correction of the filing date to January 8, 2010.

Telephone inquiries specific to this matter should be directed to the undersigned at 571 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, WILLIS TOWER
CHICAGO IL 60606-1080

MAILED

MAY 20 2010

OFFICE OF PETITIONS

In re Application of :
Dong-Man Khu et al. :
Application No. 61/293,652 : DECISION DISMISSING PETITION
Filed: January 9, 2010 :
Attorney Docket No: NBLE:072USP1 :

This decision is in response to the petition filed March 29, 2010, under 37 CFR 1.53 in response to the Notice of Omitted Items mailed January 28, 2010. The petition is treated under 37 CFR 1.182.

The petition is **DISMISSED**.

The application was filed January 9, 2010, however, on January 28, 2010, the Office of Data Management mailed a "Notice" stating that the application had been accorded a filing date Of January 9, 2010, but that Figure 10 described in the specification appeared to have been omitted.

In response, the present petition was filed. Petitioners argue that no Figures were missing on January 9, 2010. Instead, the petition argues that the Figures were mislabeled. Replacement drawings are submitted with the petition to correct the labels and therefore to show that Figure 10 was not omitted.

While the figures were mislabeled and therefore no drawings were actually missing on January 9, 2010, the error occurred as a result of the applicants' filing error. In view thereof, the "Notice" mailed on January 23, 2010 was correct in stating that Figure 10 described in the specification appeared to have been omitted. Therefore, the "Notice" was properly mailed and will not be withdrawn.

Petitioner, however, is reminded that no amendment/corrections, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to a provisional application after the filing date of the provisional application. See 37 CFR 1.53(c); 37 CFR 1.121(j).

As well, the option to take the later filing date, *i.e.*, the date of submission of the omitted page(s) or drawing(s), is not available.[1] As such, if petitioners desire to have the correctly labeled pages entered to reflect Figure 10, petitioners should simply file a new completed provisional application.

The application will be processed and examined using the application papers filed on January 9, 2010.

The petition fee in the amount of $400 has been charged to the credit card provided.

The application is being forwarded to the Office of Patent Application Processing for further processing with a filing date of January 9, 2010, using the application papers filed on that date.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

[1] MPEP 601.01(d). In view of the relatively low filing fee for provisional applications, and the USPTO's desire to minimize the processing of provisional applications, the USPTO will not grant petitions under 37 CFR 1.182 to accept omitted page(s) or drawing(s) and accord an application filing date as of the date of submission in provisional applications. The applicant should simply file a new completed provisional application. Id.

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WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
ATTN: PATENT DOCKETING
P.O. BOX 7037
ATLANTA, GA 30357-0037

MAILED

JUN 0 3 2010

OFFICE OF PETITIONS

In re Application of :
John Joseph Partridge, et. al. :
Application No. 61/294,594 : DECISION GRANTNG PETITION
Filed: January 13, 2010 :
Attorney Docket No. 0048 1010.P1 :

This is a decision on the petition filed February 2, 2010 requesting that the above-identified provisional application be accorded a filing date of January 13, 2010.

The application was deposited on January 13, 2010. However, on January 26, 2010, the Office of Patent Application Processing mailed a Notice of Incomplete Provisional Application (Notice) requiring drawings and stating that the filing date of the application would be the date of receipt of the omitted drawings.

In response, on February 2, 2010, the present petition was filed, in which Petitioner states that drawings are not necessary for an understanding of the subject matter and the application should be accorded the January 13, 2010 filing date without the drawings.

Since it is noted that drawings are not necessary for an understanding of the subject matter, the petition is **granted**.

In view of the above, the petition fee of $400 has been credited to petitioner's deposit account.

This application file is being referred to the Office of Patent Application Processing for further **processing with a filing date of January 13, 2010**.

Telephone inquiries concerning this matter may be directed to Andrea Smith at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

David Bucci
Petitions Examiner

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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LS9, INC.
600 GATEWAY BOULEVARD
SOUTH SAN FRANCISCO CA 94080

MAILED

MAY 25 2010

OFFICE OF PETITIONS

In re Application of
Andreas Schirmer
Application No. 61/294,847
Filed: January 14, 2010
Attorney Docket No. LS00025 P1

: ON PETITION

This is a decision on the petition filed March 10, 2010, in response to the Notice of Omitted Items mailed January 28, 2010. The petition is treated under 37 CFR 1.182.

The petition is **DISMISSED**.

On January 14, 2010 the application was filed. On January 28, 2010, the Office of Data Management mailed a Notice of Omitted Items in a Provisional Application stating that the application had been accorded a filing date of January 14, 2010, but that Figures 11 and 17 described in the specification appeared to have been omitted.

In response, petitioners concede that Figure 11 was in fact inadvertently omitted from the application as filed but argues that Figure 11 is not necessary for an understanding of the subject matter sought to be patented. Petitioner is advised, however, that this decision does not constitute a determination in accordance with 35 U.S.C. § 113 (first sentence).

Petitioner argues further that Figure 17 was included in the original submission, as can be seen at pages 218-225 submitted via the EFS-Web. Specifically, the title for the figure at issue, "FIG. 17 - Other sequences in the disclosure," can be found near the bottom of page 218. A review of the file reveals that the application as filed properly included Figure 17 and that Figure 17 appears on page 218 of 225. 6

As Figure 11 was not filed with the application, and since this was all due to applicant's filing error, the Notice of Omitted Items correctly stated that Figure 11 appeared to have been omitted.

Petitioners are advised that for provisional applications, the option to take the later

filing date, *i.e.*, the date of submission of the omitted page(s) or drawing(s), is not available.[1] As such, if petitioners desire to have Figure 11 considered as part of the application, petitioners should simply file a new completed provisional application, including Figure 11.

In view of the above, the petition fee is non-refundable.

The application is being forwarded to the Office of Patent Application Processing for further processing with a filing date of January 14, 2010, using the application papers filed on that date..

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

[1] MPEP 601.01(d). In view of the relatively low filing fee for provisional applications, and the USPTO's desire to minimize the processing of provisional applications, the USPTO will not grant petitions under 37 CFR 1.182 to accept omitted page(s) or drawing(s) and accord an application filing date as of the date of submission in provisional applications. The applicant should simply file a new completed provisional application. Id.

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NASTECH PHARMACEUTICAL COMPANY INC
MDRNA, Inc.
3830 MONTE VILLA PARKWAY
BOTHELL WA 98021-7266

MAILED

MAY 2 1 2010

OFFICE OF PETITIONS

In re Application of :
Narendra K. Vaish :
Application No. 61/295,321 : ON PETITION
Filed: January 15, 2010 :
Attorney Docket No. **09-01P2** :

This is a decision on the petition under 37 CFR 1.53(e) filed on April 2, 2010, requesting that the Office accord the above-identified provisional application a filing date of January 15, 2010.

On January 15, 2010, applicants deposited the above-identified provisional application without drawings. On February 2, 2010, the Office mailed a Notice of Incomplete Provisional Application, indicating that the application had not been accorded a filing date because the application had been deposited without drawings, and stating that the filing date would be the date of receipt of the omitted drawings.

On petition, applicants explain:

> ...that drawings are not necessary for the understanding of the subject matter sought to be Patented.

Petition, 04/02/2010, p. 1

A review of the provisional application papers deposited on January 15, 2010, reveals that the application contains method claims. As stated in MPEP § 601.01(f), it is the practice of the USPTO to treat a provisional application that contains at least some disclosure of a process or method as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

MPEP § 601.01(f) also states:

> A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which

a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description and the names of all the inventors.

As this application contains method claims, it should have been treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g). MPEP § 601.01(g) states that if an application is filed without all of the drawing figure(s) referred to in the specification, a "Notice of Omitted Item(s)" is mailed, indicating that the application has been accorded a filing date, but is lacking some of the figures of drawings described in the specification.

In view of the above, the Notice of Incomplete Provisional Application was sent in error. The above-identified application may be accorded a filing date of January 15, 2010, without any drawings.

Accordingly, the petition is **granted** to the extent indicated above.

The $400.00 petition fee is unnecessary and will be refunded to the Deposit Account.

This application is being forwarded to the Office of Patent Application Processing to accord the application a filing date of January 15, 2010, with "0" sheets of drawings, and to mail a corrected filing receipt.

Any inquiries regarding to this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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Alexandria, VA 22313-1450
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CANTOR COLBURN, LLP
20 CHURCH STREET
22ND FLOOR
HARTFORD CT 06103

COPY MAILED
MAR 19 2010

In re Application of :
Thayumanavan et al :
Application No. 61/295,382 : DECISION ON PETITION
Filed: January 15, 2010 :
Attorney Docket No. UMA0031US :

This is a decision on the request filed March 9, 2010 which is being treated as a petition under 37 CFR 1.181 (no fee), requesting refund of the filing fee for the above-identified application.

The petition is **DISMISSED**.

Petitioner asserts that the instant application was an unintended duplicate filing via EFS-Web.

37 CFR 1.26(a) states, in part: "The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee."

However, the Office may find a mistake pursuant to 37 CFR 1.26, waive the presumption in 37 CFR 1.26 that applications are not entitled to filing fee refunds, and refund the filing fees associated with unintended duplicate application filings via EFS-Web when the following conditions have been met:

(1) Applicant must certify that they had filed the duplicate application(s) prior to receiving appropriate confirmation from the Office that the initial application filing via EFS-Web was received by the Office;

(2) the request for a refund must be filed within three months from the filing date of the first application receiving an appropriate acknowledgement;

(3) the request must include a statement which attests on a personal knowledge basis or to the satisfaction of the Director that the duplicate application was intended to be the original application;

(4) the duplicate application must have been filed via EFS-Web on or after March 16, 2006;

(5) the request must list the other application(s) of which the instant application is deemed to be a "duplicate"; and

(6) the request should include a statement of express abandonment of the instant application as it was filed in error.

When the above conditions have been met, the Office will generally accept the statement as an assertion that the duplicate application was filed by mistake without requiring further information.

The instant petition lacks item **(5)** above.

Accordingly, the petition for refund of a duplicate filing fee under 37 CFR 1.181 cannot be granted at this time.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

By mail:	Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450 Alexandria, VA 22313-1450
By hand:	Customer Service Window Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314
By fax:	(571) 273-8300 ATTN: Office of Petitions
By internet:	EFS-Web www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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22ND FLOOR
HARTFORD CT 06103

MAILED

APR 14 2010

OFFICE OF PETITIONS

In re Application of	:	
Thayumanavan et al	:	
Application No. 61/295,382	:	NOTICE VACATING DECISION MAILED
Filed: January 15, 2010	:	MARCH 19, 2010
Attorney Docket No. UMA0031US	:	

This is a supplemental to the decision mailed March 19, 2010 in the above-identified application.

On March 9, 2010, a request for refund was filed that identified the above Application No. 61,295,382.

The request was treated as a petition under 37 CFR 1.181(no fee), requesting refund of the filing fee for the above-identified application. On March 19, 2010, a decision was rendered and mailed dismissing the petition.

However, it was later discovered that the petition filed March 9, 2010, was intended for Application No. 61/295,582 instead of 61/295,382.

A copy of the petition filed March 9, 2010 has been placed in the intended application no. 61/295,582.

In view of the above, the decision mailed March 19, 2010 is hereby **VACATED** in the above-identified application no. 61/295,382.

The Office regrets any inconvenience caused in this matter.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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CHALKER FLORES, LLP
2711 LBJ FRWY
SUITE 1036
DALLAS TX 75234

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FEB 02 2010

In re Application of :
Frank Seibert et al :
Application No. 61/295,582 : DECISION ON PETITION
Filed: January 15, 2010 :
Attorney Docket No. UTAU:1258 :

This is a decision on the request filed January 19, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee), requesting refund of the filing fee for the above-identified application.

The petition is **DISMISSED**.

Petitioner asserts that the instant application was a duplicate filing via EFS-Web.

37 CFR 1.26(a) states, in part: "The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee."

However, the Office may find a mistake pursuant to 37 CFR 1.26, waive the presumption in 37 CFR 1.26 that applications are not entitled to filing fee refunds, and refund the filing fees associated with unintended duplicate application filings via EFS-Web when the following conditions have been met:

(1) Applicant must certify that they had filed the duplicate application(s) prior to receiving appropriate confirmation from the Office that the initial application filing via EFS-Web was received by the Office;

(2) the request for a refund must be filed within three months from the filing date of the first application receiving an appropriate acknowledgement;

(3) the request must include a statement which attests on a personal knowledge basis or to the satisfaction of the Director that the duplicate application was intended to be the original application;

(4) the duplicate application must have been filed via EFS-Web on or after March 16, 2006;

(5) the request must list the other application(s) of which the instant application is deemed to be a "duplicate"; and

(6) the request should include a statement of express abandonment of the instant application as it was filed in error.

When the above conditions have been met, the Office will generally accept the statement as an assertion that the duplicate application was filed by mistake without requiring further information.

The instant petition lacks items (1), (3) and (6) above.

Accordingly, the petition for refund of a duplicate filing fee under 37 CFR 1.181 cannot be granted at this time.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By facsimile: **(571) 273-8300**
Attn: Office of Petitions

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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CHALKER FLORES, LLP
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DALLAS TX 75234

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APR 13 2010

OFFICE OF PETITIONS

In re Application of
Frank Seibert et al
Application No. 61/295,582
Filed: January 15, 2010
Attorney Docket No. UTAU:1258

DECISION ON PETITION

This is a decision on the request filed March 9, 2010 and supplemented on March 30, 2010, which are being treated as a petition under 37 CFR 1.181 (no fee), requesting refund of the filing fee for the above-identified application.

The petition is **GRANTED**.

It is noted that the petition filed March 9, 2010, referenced an incorrect application no. 61/295,382 rather than the above application no. 61/295,582. However, a copy of the petition has been placed in the above identified application.

Petitioner asserts that the instant application was an unintended duplicate filing via EFS-Web.

37 CFR 1.26(a) states, in part: "The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee."

However, the Office may find a mistake pursuant to 37 CFR 1.26, waive the presumption in 37 CFR 1.26 that applications are not entitled to filing fee refunds, and refund the filing fees associated with unintended duplicate application filings via EFS-Web.

The Office has accepted petitioner's statement as an assertion that the duplicate application was filed by mistake. Accordingly, the filing fee of $110.00, submitted on January 15, 2010, has been credited to petitioner's credit card account as it is the method in which the filing fee was paid.

As no further action will be taken in this application, this matter is being referred to the Office of Data Management for express abandonment of the subject application.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

/Karen Creasy/
Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
61/297,912	01/25/2010	Francois Binette	P0037876.00	2751

7590 02/19/2010

MEDTRONIC
Attn: Noreen Johnson - IP Legal Department
2600 Sofamor Danek Drive
MEMPHIS, TN 38132

EXAMINER	
ART UNIT	PAPER NUMBER
MAIL DATE	DELIVERY MODE
02/19/2010	PAPER

DECISION DISMISSING PETITION UNDER 37 CFR 1.138(d)

The declaration of express abandonment will not be recognized

This is in response to the petition under 37 CFR 1.138(d), requesting for a refund of any previously paid search fee and excess claims fee in the above-identified application.

The petition is dismissed.

The express abandonment will **not** be recognized for the reason(s) indicated below:

1. ☐ The petition was not filed in sufficient time to permit the appropriate officials to recognize the abandonment before an examination has been made of the application. See 37 CFR 1.138(d).

2. ☐ The petition was not signed by a party authorized by 37 CFR 1.33(b)(1), (3) or (4).

3. ☐ The application is not an application filed under 35 U.S.C. 111(a) on or after December 8, 2004.

4. ☑ The petition for express abandonment under 1.138(d) is dismissed because the applicant did not pay any search fee and excess claims fees in the above-identified application.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

Kalethia Buchanan

Patent Publication Branch
Office of Data Management

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
61/297,912	01/25/2010	Francois Binette	P0037876.00	2751

7590 02/19/2010

MEDTRONIC
Attn: Noreen Johnson - IP Legal Department
2600 Sofamor Danek Drive
MEMPHIS, TN 38132

EXAMINER	
ART UNIT	PAPER NUMBER
MAIL DATE	DELIVERY MODE
02/19/2010	PAPER

Decision Granting Petition under 37 CFR 1.138(c)

The declaration of express abandonment is recognized

This is in response to the petition under 37 CFR 1.138(c), for express abandonment to avoid publication of the above-identified application.

The petition is granted.

The express abandonment is recognized and the application has been withdrawn from publication.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

Kalathus Buchanan

Patent Publication Branch
Office of Data Management

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAILED

JUN 0 7 2010

OFFICE OF PETITIONS

DAVID S. RESNICK
NIXON PEABODY LLP
100 SUMMER STREET
BOSTON MA 02110-2131

In re Application of :
Adini, et al. :
Application No. 61/298,729 : DECISION DISMISSING
Filed: January 27, 2010 : PETITION
Attorney Docket No.: 701039-067170-P :

This is a decision on the "Petition under 37 CFR 1.53(e)(2) and Response to Notice of Omitted Items in a Provisional Application" filed March 19, 2010, which is being treated as a petition under 37 CFR 1.182.

The petition is **dismissed.**

The above-identified provisional application was filed on January 27, 2010. However, on February 12, 2010, the Office of Patent Application Processing mailed a Notice of Omitted Items in Provisional Application stating that application had been accorded a filing date of January 27, 2010, and advising applicant that Figure 2 as described in the specification appeared to be omitted. As to the alleged omitted figure, the notice set forth an extendable period of reply of two months from its mailing date.

In response, on March 19, 2010, applicant filed the present petition and remitted a $400.00 petition fee. Applicant explains that Figure 2 was not omitted January 27, 2010. Applicant further explains that what is identified in the specification as Figure 2 applies to the entirety of Figures 2A and 2B, which were present on January 27, 2010. The petition is accompanied by an amendment to the specification removing the reference to Figure 2 and another set of drawings.

It is obvious from the petition that no drawings were actually missing on January 27, 2010. Rather, the specification did not denote the drawing figures as accurately as possible. However, the Notice of Omitted Items in Provisional Application was correct in stating that Figure 2 as described in the specification appeared to have been omitted. Therefore, the language relative to the omitted figure in the Notice of Omitted Items in Provisional Application was properly mailed and will not be withdrawn.

The $400.00 petition fee will not be refunded because the present petition was not necessitated by any error on the part of the United States Patent and Trademark Office.

The application will be returned to the Office of Patent Application Processing with a filing date of January 27, 2010, using the drawings filed on that date.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Ashok K. Janah
650 DELANCEY STREET
SUITE 106
SAN FRANCISCO CA 94107-2001

MAILED

JUN 17 2010

OFFICE OF PETITIONS

In re Application of :
Jessen, et al. :
Application No. 61/305,945 : ON PETITION
Filed: February 18, 2010 :
Attorney Docket No.: **RAYN.1.P1.US** :

This is regarding the "Response to Notice of Omitted Item(s) in a Provisional Application", filed May 13, 2010, which will be treated as a petition under 37 CFR 1.182.

The petition under 37 CFR 1.182 is **dismissed**.

The above-identified provisional application was filed on February 18, 2010. On March 15, 2010, the Office of Patent Application Processing mailed a Notice of Omitted Items in Provisional Application stating that the application had been accorded a filing date, and advising applicant that Figure12 as described in the specification appeared to have been omitted. The notice set forth a non-extendable period for reply of two months from its mailing date.

In response, May 13, 2010, applicants filed the present petition and remitted a $400.00 petition fee. Applicant explains that Figure 12 was not omitted from the papers filed February 18, 2010. Applicant further explains that the label for Figure 12 did not show up on the scanned drawing sheet 2/21 due to a copy machine error on applicants' part.

It is obvious from the petition that no drawings were actually missing on February 18, 2010. Rather, Figure 12 was simply not labeled as a result of applicant's filing error. However, the "Notice of Omitted Items in Provisional Application was correct in stating that Figure 12 as described in the specification appeared to have been omitted. Therefore, the notice was properly mailed and will not be withdrawn. The petition fee will not be refunded because the present petition was not necessitated by any error on the part of the United States Patent and Trademark Office.

The application will be returned to the Office of Patent Application Processing with a filing date February 18, 2010, using the drawings filed on that date.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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DTW Jun-10

KOPPEL, PATRICK, HEYBL & DAWSON
2815 TOWNSGATE ROAD
SUITE 215
WESTLAKE VILLAGE CA 91361-5827

MAILED

JUN 18 2010

OFFICE OF PETITIONS

In re Application of :
Keith Berman :
Application No: 61/308,824 :
Filed: February 26, 2010 :
Attorney Docket No: 668-26-002 :

ON PETITION

This is a decision on the petition filed on March 26, 2010, which is treated as a petition requesting that the above-identified provisional application, without drawings, be accorded a filing date of February 26, 2010.

The petition is **GRANTED**.

The application was filed on February 26, 2010. Accordingly, on March 23, 2010, the Office of Patent Application Processing mailed a "Notice of Incomplete Provisional Application" stating that the application had not been accorded a filing date because the application had been deposited without drawings.

In response, on March 26, 2010, the subject petition was filed.

As stated in MPEP § 601.01(f), it is the practice of the PTO to treat a provisional application that contains at least some disclosure of a process or method as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

MPEP § 601.01(f) also states that:

> A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description and the names of all the inventors.

A review of the record reveals that the application papers deposited on March 26, 2010, contain at least one method claim. Accordingly, the application is treated as a provisional application containing at least some disclosure of a process or method.

Drawings will not be further considered as a part of this case.

In view of the above, the Notice of Incomplete Provisional Application mailed on March 23, 2010, was mailed in error and is hereby withdrawn.

The application is accorded a filing date of February 26, 2010, without drawings as a part of the original disclosure. The petition fee will be refunded to counsel's deposit account.

The application is being referred to the Office of Patent Application Processing for correction of the filing date to February 26, 2010, and for an indication in Office records that no (0) drawings were present on filing.

Telephone inquiries specific to this matter should be directed to Karen Creasy at 571 272-3208.

Anthony Knight
Director
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
61/311,002	03/05/2010	Steve Wang	C1241/21694 (1018)	5059

7590 04/26/2010

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.
11TH FLOOR, SEVEN PENN CENTER
1635 MARKET STREET
PHILADELPHIA, PA 19103-2212

EXAMINER	
ART UNIT	PAPER NUMBER
NOTIFICATION DATE	DELIVERY MODE
04/26/2010	ELECTRONIC

Decision Granting Petition under 37 CFR 1.138(c)

The declaration of express abandonment is recognized

This is in response to the petition under 37 CFR 1.138(c), for express abandonment to avoid publication of the above-identified application.

The petition is granted.

The express abandonment is recognized and the application has been withdrawn from publication.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

Kaletus Buchana

Patent Publication Branch
Office of Data Management

04/23/2010 KKING1 00000001 030075 61311002

01 FC:1464 130.00 DA

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
61/311,725	03/08/2010	Karl Huber	Oakwood - NetworkConnect	7697

EXAMINER

7590 04/05/2010

MARC E. HANKIN, ESQ.
11414 THURSTON CIRCLE
LOS ANGELES, CA 90049

ART UNIT	PAPER NUMBER

NOTIFICATION DATE	DELIVERY MODE
04/05/2010	ELECTRONIC

Decision Granting Petition under 37 CFR 1.138(c)

The declaration of express abandonment is recognized

This is in response to the petition under 37 CFR 1.138(c), for express abandonment to avoid publication of the above-identified application.

The petition is granted.

The express abandonment is recognized and the application has been withdrawn from publication.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

Zaletus Buchanan

Patent Publication Branch
Office of Data Management

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Alexandria, VA 22313-1450
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THE NATH LAW GROUP
112 South West Street
Alexandria VA 22314

In re Application of	:	
Halowani et al.	:	
Application No. 61/312,358	:	DECISION GRANTING PETITION
Filed: March 10, 2010	:	
Attorney Docket No. 30779P	:	

This is a decision on the "PETITION UNDER 37 C.F.R.§1.181" filed April 30, 2010 requesting to accept figure 1B as part of the original disclosure.

The petition is **Granted**.

The application was filed on March 10, 2010. However, on March 31, 2010, the Office of Patent Application Processing mailed a Notice of Omitted Items in a Provisional Application, "Notice" stating that the application had been accorded a filing date of March 10, 2010, but figure 1B as described in the specification appeared to have been omitted.

In response, the present petition was filed wherein Petitioner contends 18 sheets of figures including figure 1B were filed on March 10, 2010. In support, applicants refer to the electronic acknowledgement receipt which shows that 18 sheets of drawings were submitted. The petition is further accompanied by a copy of figure 1B.

A review of the record shows that applicants established, by prima facie evidence in the form of the electronic acknowledgement receipt, that 18 sheets of drawings, including figure 1B were originally submitted on March 10, 2010. Further review of the record shows that figure 1B has been located with the original papers submitted on March 10, 2010.

The $400.00 petition fee will be refunded.

The application will be returned to the Office of Patent Application Processing for further processing with a **filing date of March 10, 2010**, using the application papers filed on March 10, 2010 which includes figure 1B.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272 -3215.

Charlema Grant

Charlema Grant
Petitions Attorney
Office of Petitions

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JUL 20 2010

OFFICE OF PETITIONS

BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

In re Application of :
William J.Garner : DECISION ON PETITION
Application No. 61/321,278 :
Deposited: April 6, 2010 :
Atty. Docket No. 0070692-000004 :

This is a decision on the petition under 37 CFR 1.57(a), filed April 21, 2010, requesting to add inadvertently omitted material to the above-identified application.

The petition is **GRANTED**.

The application was deposited on April 6, 2010. On April 19, 2010, the Office of Patent Application Processing (OPAP) mailed a Notice of Omitted Items In A Provisional Application stating that Figure 6 described in the specification appears to have been omitted from the application.

The instant petition was filed on April 21, 2010, and is accompanied by a copy of Application No. 12/100,898 in its published form (U.S. Published Patent Application No. 2008/0255948) which includes Figure 6, and, an amendment adding the inadvertently omitted one sheet of drawing incorporating Figure 6.

Effective September 21, 2004, 37 CFR 1.57 allows a priority claim to a prior-filed application to be considered an incorporated by reference statement allowing for the incorporation of the prior filed application as to inadvertently omitted portion of the specification or drawings. When using 37 CFR 1.57 , applicant's are required to amend the application to include the inadvertently omitted material, and supply a copy of the prior-filed application and identify where the inadvertently omitted portion of the specification can be found in the prior-filed application.

It is noted that 37 CFR 1.57(a) indicates that if the application is not otherwise entitled to a filing date under 37 CFR 1.53(b), the amendment must be by way of the petition. This application was determined not to be entitled to a filing date. Accordingly,

a petition is required to amend the application pursuant to 37 CFR 1.57.

In view thereof, the petition under § 1.57(a) is **GRANTED**. The amendment will be entered in due course.

This application is being forwarded to the Office of Patent Application Processing (OPAP) for according of a filing date of April 6, 2010, using the application papers received in the Office on that date and the papers(to include Figure 6) submitted with the instant petition.

The application is referred to the Office of Patent Application Processing for further processing and the issuance of a corrected filing receipt.

Telephone inquiries specific to this decision should be directed to Karen Creasy at (571)272-3208.

Anthony Knight
Supervisor
Office of Petitions

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JUN 28 2010

OFFICE OF PETITIONS

Townsend and Townsend and Crew LLP/Solazyme, Inc.
Two Embarcadero Center
Eighth Floor
San Francisco CA 94111-3834

In re Application of :
Franklin, et al. :
Application No. 61/324,285 : ON PETITION
Filed: April 14, 2010 :
Attorney Docket No. 026172-007400US :

This is a decision on the petition under 37 CFR 1.53(e) filed on May 13, 2010, requesting that the Office accord the above-identified provisional application a filing date of April 14, 2010.

On April 14, 2010, applicants deposited the above-identified provisional application without drawings. On May 5, 2010, the Office mailed a Notice of Incomplete Provisional Application, indicating that the application had not been accorded a filing date because the application had been deposited without drawings, and stating that the filing date would be the date of receipt of the omitted drawings.

By the instant petition, petitioner states that the drawings are not necessary to understand the invention claimed.

A review of the provisional application papers deposited on April 14, 2010, reveals that the application contains method claims. As stated in MPEP § 601.01(f), it is the practice of the USPTO to treat a provisional application that contains at least some disclosure of a process or method as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

MPEP § 601.01(f) also states:

> A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description and the names of all the inventors.

As this application contains method claims, it should have been treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g). MPEP

§ 601.01(g) states that if an application is filed without all of the drawing figure(s) referred to in the specification, a "Notice of Omitted Item(s)" is mailed, indicating that the application has been accorded a filing date, but is lacking some of the figures of drawings described in the specification.

In view of the above, the Notice of Incomplete Provisional Application was sent in error. The above-identified application may be accorded a filing date of April 14, 2010, without any drawings.

Accordingly, the petition is **granted** to the extent indicated above.

The $400.00 petition fee is unnecessary and will be refunded to the Deposit Account.

This application is being forwarded to the Office of Patent Application Processing to accord the application a filing date of April 14, 2010, with "0" sheets of drawings, and to mail a corrected filing receipt.

Any inquiries regarding to this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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Townsend and Townsend and Crew LLP/Solazyme, Inc.
Two Embarcadero Center
Eighth Floor
San Francisco CA 94111-3834

MAILED

JUN 17 2010

OFFICE OF PETITIONS

In re Application of :
Franklin, et al. :
Application No. 61/324,286 : ON PETITION
Filed: April 14, 2010 :
Attorney Docket No. 026172-007500US :

This is a decision on the petition under 37 CFR 1.53(e) filed on May 13, 2010, requesting that the Office accord the above-identified provisional application a filing date of April 14, 2010.

On April 14, 2010, applicants deposited the above-identified provisional application without drawings. On May 5, 2010, the Office mailed a Notice of Incomplete Provisional Application, indicating that the application had not been accorded a filing date because the application had been deposited without drawings, and stating that the filing date would be the date of receipt of the omitted drawings.

By the instant petition, petitioner states that the drawings are not necessary to understand the invention claimed.

A review of the provisional application papers deposited on April 14, 2010, reveals that the application contains method claims. As stated in MPEP § 601.01(f), it is the practice of the USPTO to treat a provisional application that contains at least some disclosure of a process or method as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

MPEP § 601.01(f) also states:

> A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description and the names of all the inventors.

As this application contains method claims, it should have been treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g). MPEP

§ 601.01(g) states that if an application is filed without all of the drawing figure(s) referred to in the specification, a "Notice of Omitted Item(s)" is mailed, indicating that the application has been accorded a filing date, but is lacking some of the figures of drawings described in the specification.

In view of the above, the Notice of Incomplete Provisional Application was sent in error. The above-identified application may be accorded a filing date of April 14, 2010, without any drawings.

Accordingly, the petition is **granted** to the extent indicated above.

The $400.00 petition fee is unnecessary and will be refunded to the Deposit Account.

This application is being forwarded to the Office of Patent Application Processing to accord the application a filing date of April 14, 2010, with "0" sheets of drawings, and to mail a corrected filing receipt.

Any inquiries regarding to this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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STAN JONES, PATENTS
221 N. EMERAND DR., # 31
ST. GEORGE UT 84770

MAILED

MAY 20 2010

OFFICE OF PETITIONS

In re Application of:	:	
Jeremy Trimmer	:	
Application No. 61/335095	:	DECISION ON
Filing or 371(c) Date: 12/30/2009	:	PETITION
Title of Invention:	:	
PRINTED PUBLICATION AND DIGITAL MEMORY COMBINATION	:	

This is a decision on the "Petition in Response to Notice of Omitted Items," filed March 8, 2010.

The petition is dismissed.

The application was filed on December 30, 2009. On January 20, 2010, the Office Patent Application Processing mailed a Notice of Omitted Item(s) in a Nonprovisional Application ("Notice") stating that the application had been accorded a filing date, and advising applicants that Figure(s) 1 described in the specification appeared to have been omitted from the application.

In response, the present petition was filed. The petition explains that the omitted item(s) was in fact deposited with the application as-filed on December 30, 2009. Applicant provides that Figure 1 is identified as a visual example in the lower left corner of page 9. Applicant's enclose, *inter alia*, an amended page 9 including Fig. 1.

A review of the file confirms that the application papers filed on December 30, 2009 included two (2) sheets of drawings, and that a drawing figure identified as visual example was included among the application papers filed on December 30, 2009, although no page numbered page 9 was included among the application papers filed on December 30, 2009.

Petitioner also "opposes both the fee and the procedure employed in this case. The Patent Office document that assigns the Serial number and filing date, states of this provisional Application that: 'It will not be examined....' Quite obviously it was examined, otherwise the missing Fig. 1 would not have been discovered."

Petitioner is advised that the provisional application is processed (as opposed to examined for patentability), in accordance with 37 CFR 1.53, and when the specification or drawings are omitted, 37 CFR 1.53(e) requires that the applicant be notified and given a time period in which to submit the missing element to complete the filing. See, MPEP 601.01(f) and 601.01(g).

Regarding the drawings filed on December 30, 2009, since the drawings did not include a figure labeled "Fig. 1," the Notice mailed January 20, 2010, was correct in advising applicant that drawing Figure 1 appeared to have been omitted. Therefore, the "Notice" was properly mailed and will not be withdrawn.

Regarding Applicant's submission of the amended page 9, the MPEP provides that in view of the relatively low filing fee for provisional applications, and the USPTO's desire to minimize the processing of provisional applications, the USPTO will not grant petitions under 37 CFR 1.182 to accept omitted drawing(s) and accord an application filing date as of the date of such submission in provisional applications. The applicant should simply file a new completed provisional application. MPEP 601.01(g).

The petition is dismissed.

The petition fee is required, since the petition was not necessary to correct any PTO error.

The application file will be referred to the Office Patent Application Processing for further processing with a filing date of December 30, 2009, using the drawings filed on that date.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

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MAILED

JUL 13 2010

OFFICE OF PETITIONS

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK NY 10004

In re Application of	:	
Moshe Klerer et al	:	
Application No. 61/335,793	:	DECISION GRANTING
Filed: January 11, 2010	:	PETITION
Attorney Docket No. 14919/2	:	

This is a decision on the petition, filed April 26, 2010, requesting that the above-identified application be accorded a filing date of January 11, 2011, rather than the presently accorded date of July 10, 2010. The petition is properly treated as a petition under 37 CFR 1.10(d).

The petition is **GRANTED**.

Petitioner requests the earlier filing date on the basis that the application was purportedly deposited with Express Mail Service on January 11, 2010, pursuant to 37 CFR 1.10. The "date-in" on the copy of the Express Mail label receipt no. **EM093904672US** is missing. However, the same Express Mail number is found on the original application papers filed with the above identified application.

Paragraph (d) of 37 CFR 1.10 states that:

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

Petitioner's evidence shows that the package in question was accepted on January 11, 2010, not January 10, 2010. Since the above corroborates a "date-in" of January 11, 2010 , the application is entitled to the requested filing date.

This application file is being returned to the Office of Patent Application Processing (OPAP) for correction of the filing date to **January 11, 2010** and issuance of a corrected filing receipt.

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3208. Telephone inquiries related to OPAP processing should be directed to their hotline at (571) 272-4000.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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GOLDSTEIN LAW OFFICES, P.C.
34 DUMONT AVENUE
STATEN ISLAND NY 10305-1450

MAILED

MAY 13 2010

OFFICE OF PETITIONS

In re Application of :
Vadim Nosikovskiy :
Application No. 61/336905 :
Filing or 371(c) Date: 01/28/2010 : DECISION
Attorney Docket Number: G1147 :

This is a decision on the Petition filed March 8, 2010, requesting the above-identified application be accorded a filing date of January 28, 2010, including drawing Figure 4. The petition is properly treated under 37 CFR 1.182.

The petition is granted.

Background

Application papers were filed in the above-identified application on January 28, 2010. On February 22, 2010, the Office of Patent Application Processing mailed a Notice of Omitted Item(s) in a Provisional Application (hereinafter "Notice"), informing Applicant that the application had been accorded a filing date; however, Figure 4 described in the specification appeared to have been omitted from the application.

Applicant responds with the present petition filed March 17, 2008, wherein Applicant asserts that drawing Figure 4 was filed in the application on January 28, 2010. In support of this assertion, Applicant files a copy of his return-receipt postcard which acknowledges receipt by this Office of, *inter alia*, 5 drawing sheets on January 28, 2010. Applicant also files a copy of drawing Figure 4 with the present petition.

Applicable Law, Rules and MPEP

"A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all items listed thereon by the PTO." MPEP § 503.

Accordingly, the petition is granted.

The copy of Figure 4 filed with the present petition will be used for examination purposes.

The application will be returned to the Office of Patent Application Processing for further processing with a filing date of January 28, 2010, and an indication that Figure 4 described in the specification was included with the application papers filed on January 28, 2010, using the copy of Figure 4 filed with the present petition.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

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JUN 17 2010

OFFICE OF PETITIONS

Michael G. Cameron
2025 Savannah Drive
McKinney TX 75070

In re Application of :
Thacker :
Application No. 61/337,156 : DECISION GRANTING PETITION
Filed: January 26, 2010 :
Attorney Docket No. STHA.0001 :

The above-identified application has been forwarded to the Office of Petitions for consideration of the communication filed March 22, 2010. This matter is being treated as a petition under 37 CFR 1.10(c), as a request that the above-identified application be accorded a filing date of January 26, 2010, rather than the presently accorded filing date of February 1, 2010.

Applicants request the earlier filing date on the basis that the application was purportedly deposited with the U.S. Postal Service (USPS) as Express Mail on January 26, 2010 pursuant to 37 CFR 1.10. In support, applicants have submitted a copy of a USPS Track/Confirm printout for Express Mail label No. EW189823621US showing a USPS acceptance date of January 26, 2010. The same Express Mail receipt number was placed on the original patent application transmittal letter of record in the official file.

To substantiate petitioner's assertion that the package in question was deposited with the USPS as Express Mail on January 26, 2010, an independent search was made of the USPS Express Mail Track and Confirm records, which resulted in a finding that the package in question was in fact accepted on January 26, 2010 at the USPS. Therefore, in view of all the evidence, it is concluded that the application was deposited in Express Mail service on January 26, 2010. Accordingly, the instant application is entitled to a filing date of January 26, 2010, and has been so accorded.

The petition is **GRANTED**.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

This application is being forwarded to the Office of Initial Patent Examination for processing with a filing date of January 26, 2010.

/ALESIA M. BROWN/

Alesia M. Brown
Petitions Attorney
Office of Petitions

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ROBINS & PASTERNAK
1731 EMBARCADERO ROAD
SUITE 230
PALO ALTO CA 94303

MAILED

JUN 16 2010

OFFICE OF PETITIONS

In re Application of :
Doyon et al. :
Application No. 61/337769 : ON PETITION
Application Received: 02/08/2010 :
Attorney Docket Number: :
8325-0076P :

This Decision is in response to the "Petition Pursuant to 37 C.F.R. § 1.10(c) to Accord Filing Date," filed March 12, 2010.

The petition is **granted**.

Petitioner alleges that the application was deposited in Express Mail service on February 8, 2010. In support of this assertion, petitioner files a copy of Express Mail label No. EV513074323US. A review of the copy of copy of Express Mail label No. EV513074323US, reveals that the "Date In" indicated on the Express Mail label is February 10, 2010. However, the Express Mail Label contains a stamp of the United States Post Office ("USPS") dated February 8, 2010. The same Express Mail label number was placed on the original application papers located in the official file. Petitioner has also included a copy of a Docket Log Entry for Februar8, 2010 wherein the present application filing and postage fee were entered on February 8, 2010.

In view of the above, the petition is granted. No petition fee has been charged and none is due.

The application is being referred to the Office of Patent Application Processing for correction of the filing date to February 8, 2010, and for the mailing of a Corrected Filing Receipt.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
61/337,875	02/12/2010	Sandra M. Copling		7073

7590 05/05/2010

Sandra M. Copling
1585 Briarfield Rd.
Hampton, VA 23669

EXAMINER	
ART UNIT	PAPER NUMBER

MAIL DATE	DELIVERY MODE
05/05/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Sandra M. Copling
1585 Briarfield Rd.
Hampton VA 23669

MAY 05 2010

In re Application of	:	
Sandra M. Copling	:	DECISION ON PETITION
Application No. 61/337875	:	TO MAKE SPECIAL UNDER
Filed: February 12, 2010	:	THE GREEN TECHNOLOGY
	:	PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed April 19, 2010, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009).

The petition is **DENIED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications and be filed prior to the date of the notice, December 8, 2009.

The present application is a provisional application. Accordingly, this application is not eligible in the Green Technology Pilot Program.

Telephone inquires concerning this decision should be directed to Blaine Copenheaver at 571-272-1156.

/Blaine Copenheaver/

Blaine Copenheaver
Quality Assurance Specialist
Technology Center 1700

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COMMISSIONER FOR PATENTS
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MAILED Paper No.

JUL 01 2010

OFFICE OF PETITIONS

FOLEY & LARDNER LLP
321 NORTH CLARK STREET
SUITE 2800
CHICAGO IL 60654-5313

In re Application of :
Elam et al. :
Application No. 61/338,841 : DECISION ON PETITION
Filed: February 24, 2010 :
Attorney Docket No. 051583-0443 :
Title: MICRO-CHANNEL PLATE :
DETECTOR :

This is a decision on the petition filed April 15, 2010, requesting that Figures 11A and 11b be accorded a filing date of February 24, 2010, as part of the original disclosure. This petition is being treated as a petition pursuant to 37 C.F.R. § 1.182.

The petition is **GRANTED** to the extent indicated herein.

Receipt of the $400 petition fee is acknowledged.

On February 24, 2010, the above-identified application was filed. On March 29, 2010, the Office of Data Management (ODM) mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" (Notice), stating that the application had been accorded a filing date of February 24, 2010, and advising applicant that Figures 11A and 11b appeared to have been omitted.

In response, on April 15, 2010, applicants filed the present petition. The petition is further accompanied by an explanation that Figures 11A and 11b were included on filing, but were mislabeled as "Figure 11." Petitioner has further included a copy of the figures as originally filed, as well as one sheet of replacement drawings that has the existing label number "11" crossed out and "Fig. 11A" and "Fig. 11B" hand-written immediately adjacent to the figures.

Upon review of the record, Figures 11A and 11b have been located among the application papers, and it is obvious that they were included upon filing, and were simply mislabeled as a result of Applicant's filing error. Therefore, the application, including Figures 11A and 11b, was complete on filing and entitled to a filing date of February 24, 2010. However, the Notice mailed on March 29, 2010 was correct in stating that Figures 11A and 11b appeared to have been omitted. Therefore, the Notice was properly mailed and will not be withdrawn.

The petition fee of $400 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

The single sheet of replacement drawings cannot be entered. Although Petitioner has not submitted an amendment requesting the entry of the same, the Office will construe the submission as a constructive request for entry. The replacement drawings will not be entered due to the fact that provisional applications cannot be amended.[1]

The Office of Patent Application Processing (OPAP) will be notified of this decision, and jurisdiction over the application is transferred to OPAP, so that the application may receive further processing with a filing date of February 24, 2010, using the application papers filed on that date. OPAP will not enter the drawings filed on April 15, 2010.

Petitioner will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OPAP.

The general phone number for OPAP is 571-272-4000. Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225.[2]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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1 See 37 C.F.R. § 1.53(c). See also M.P.E.P. § 601.01(b).
2 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

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MAILED

JUN 09 2010

OFFICE OF PETITIONS

AYUB KHAN
SUITE 109
1765 SCOTT BLVD.
SANTA CLARA, CA 95050

In re Application of :
Mohammad Ayub Khan, et al. :
Application No. 61/340,801 : ON PETITION
Deposited: March 22, 2010 :
Attorney Docket No.: None :

This is a decision in response to the petition, filed April 19, 2010, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **DISMISSED** because it is not signed in accordance with 37 CFR 1.33(b). The petition is signed by one of six joint inventors.

37 CFR 1.33(b) states:

> Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:
>
> (1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);
>
> (2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
>
> (3) An assignee as provided for under §3.71(b) of this chapter; or
>
> (4) **All of the applicants** (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter. Emphasis added

An unsigned amendment (or other paper) or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment (or other paper) is signed by only one of many applicants and the one signing has not been given a power of attorney by the other applicants.

If the petition was intended to be signed on behalf of an assignee, the assignee must establish ownership in compliance 37 CFR 3.73(b).

37 CFR 3.73(b) provides that: (1) when an assignee seeks to take action in a matter before the Office, the assignee must establish its ownership of the property to the satisfaction of the Commissioner; (2) ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording) or by specifying (e.g., reel and frame number) where such evidence is recorded in the Office; (3) the submission establishing ownership must be signed by a party authorized to act on behalf of the assignee; and (4) documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

Lastly, petitioner is advised that the copy of the "postcard receipt" submitted with the petition is deficient since the side captured fails to include the Office's receipt date stamp and an itemized listing of all of the components of the application.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

By mail:	Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450 Alexandria, VA 22313-1450
By hand:	Customer Service Window Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314
By fax:	(571) 273-8300 ATTN: Office of Petitions
By Internet:	EFS-Web[1]

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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1 www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Donald E. Frank LLC
2934 - 60th Ave. S.
Saint Petersburg FL 33712

MAILED

JUN 01 2010

OFFICE OF PETITIONS

In re Application of :

Donald E. Frank :
Application No. 61/342,565 : DECISION ON PETITION
Filed: April 16. 2010 : TO MAKE SPECIAL UNDER
Attorney Docket No. : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed April 16, 2010, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required

The instant petition includes a statement by Donald Frank's, attesting to his age. Accordingly, the above-identified application will be accorded "special" status.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

This application is being referred to the Office of Patent Application Processing. This application will be accorded "special" status when pre-examination processing is done.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

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MAILED

JUN 17 2010

OFFICE OF PETITIONS

ITZHAK POMERANTZ
18 GOLOMB ST.
KEFAR SAVA 44357 IL

In re Application of	:	
Itzhak Pomerantz	:	
Application No. 61/349,213	:	DECISION ON REQUEST FOR REFUND
Filed: May 28, 2010	:	
For: HAND TOOL WITH BUILT IN GRIP SENSORS	:	

This is a decision on the Request For Refund filed May 28, 2010.

The request is **DISMISSED**.

The request is dismissed because USPTO regulations require that papers filed in the application be signed by a registered attorney or agent, by the applicants (inventors) or by the assignee of the entire interest who has taken action in the application in accordance with 37 CFR 3.71. The request for refund filed May 28, 2010 is not signed. See 37 CFR 1.33(b).

Applicant is encouraged to note MPEP 607.02 which states:

When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is ***not*** *a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d).*

37 CFR 1.26(a) also provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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United States Patent and Trademark Office
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/748,292	03/26/2010	Xiaokui ZHANG	9516-950-888

CONFIRMATION NO. 4874

84802
JONES DAY
222 E. 41ST. STREET
NEW YORK, NY 10017

CONVERSION REQUEST

OC000000042159509

Date Mailed: 07/02/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **06/15/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/397,692.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/762,299	04/16/2010	Steven Jay Freedman	FREE.P0001P

CONFIRMATION NO. 3153

48947
ADELI & TOLLEN, LLP
11940 San Vicente Blvd., Suite 100
LOS ANGELES, CA 90049

CONVERSION REQUEST

OC000000042579590

Date Mailed: 07/27/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **06/30/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/397,693.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/548,289	08/26/2009	Arun Rajaraman	110184.487

CONFIRMATION NO. 6832

CONVERSION REQUEST

68100
SEED INTELLECTUAL PROPERTY LAW GROUP, PLLC
701 FIFTH AVENUE
SUITE 5400
SEATTLE, WA 98104

OC000000042746165

Date Mailed: 07/27/2010

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **04/23/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/397,694.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/548,289	08/26/2009	Arun Rajaraman	110184.487	6832

68100 7590 04/29/2010

SEED INTELLECTUAL PROPERTY LAW GROUP, PLLC
701 FIFTH AVENUE
SUITE 5400
SEATTLE, WA 98104

EXAMINER	
ART UNIT	PAPER NUMBER
2624	

NOTIFICATION DATE	DELIVERY MODE
04/29/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

FRANKA.DOCKETING@SEEDIP.COM
MHEIN@BALLYTECH.COM

Copied from 12548289 on 07/26/2010

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SEED INTELLECTUAL PROPERTY LAW GROUP, PLLC
701 FIFTH AVENUE
SUITE 5400
SEATTLE WA 98104

In re Application of:
RAJARAMAN, ARUN
Serial No.: 12/548,289
Filed: August 26, 2009
For: **APPARATUS, METHOD AND ARTICLE FOR EVALUATING A STACK OF OBJECTS IN AN IMAGE**

DECISION ON PETITION
TO CONVERT APPLICATION

This is a decision on the petition for conversion under 37 C.F.R. § 1.53(c)(2), filed April 23, 2010, to convert the above-identified application to a provisional application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c)(2).

The petition is **GRANTED.**

The application is being returned to the Office of Patent Application Processing for further processing as a PROVISIONAL application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c), including the assignment of a new provisional application number.

The new provisional application number will be communicated to the applicant by the Office of Patent Application Processing in due course.

/Doris To/

Doris To
Quality Assurance Specialist
Technology Center 2600
Communications
(571) 272-7629

Copied from 12548289 on 07/26/2010

John Nelson 3700

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 11/9/04

TO SPE OF : ART UNIT 1600

SUBJECT : Request for Certificate of Correction on Patent No.: 4579530

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-915
Palm location **7580** - Tel. No. 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Henry Randall
Certificates of Correction Branch

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☐ **Approved**	**All** changes apply.
☑ **Approved in Part**	Specify below which changes **do not** apply.
☐ **Denied**	State the reasons for denial below.

Comments:

The Reexam Certificate is missing a line at the bottom of Col. 1. It now reads "7-", see lines 31, col 1. This should be replaced by -- "stature to build said veneer restoration con-" --

Kevin P. Shaver
SPE

3732
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,203	06/24/2009	7410272	27451C-014100US	4902

34026 7590 02/19/2010

JONES DAY
555 SOUTH FLOWER STREET FIFTIETH FLOOR
LOS ANGELES, CA 90071

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/19/2010

Please find below and/or attached an Office communication concerning this application or proceeding.

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Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TOWNSEND AND TOWNSEND AND CREW LLP
TOW EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Date:
MAILED

FEB 19 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001203
PATENT NO. : 7410272
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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MAILED

Charles A Kertell
JONES DAY
555 SOUTH FLOWER STREET FIFTIETH FLOOR
LOS ANGELES CA 90071

(For Patent Owner) FEB 19 2010

CENTRAL REEXAMINATION UNIT

Roger D Wylie
Townsend and Townsend and Crew LLP
1420 Fifth Avenue
Suite 4400
Seattle, WA 98101

(For Third Party Requester)

In re: Halasz
Inter Partes Reexamination Proceeding
Control No. 95/001,203
Deposited on: 24 June 2009
For: US Patent No. 7,410,272

DECISION
GRANTING-IN-PART
PETITION FOR
EXTENSION OF TIME
[37 CFR § 1.956 and § 1.181]

This is a decision on the 14 January 2010, "Request Reconsideration of the Patent Owner's December 9, 2009 Petition for Extension of Time [37 CFR 1.956]" requesting that the time for responding to the Non-Final Office action mailed 14 October 2009, be extended by one (1) month. The petition was timely filed with certificate of service.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is granting-in-part for the reasons set forth below.

Discussion

The Patent Owner's representative requests reconsideration of the earlier request that the period of time be extended in which to file a response to the non-final Office action mailed 14 October 2009, which set a two (2) month time for filing a response thereto. The petition for reconsideration of extension of time was timely filed together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The petition further requests that if the request for reconsideration is not persuasive that the petition be considered under 37 CFR §§ 1.137, 1.182 or 1.183. These additional petitions are dismissed under 37 CFR § 1.4(c) which states, "Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

The petition is granted in part for the reasons set forth below.

One-day is hereby granted.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

Addressing the requirement of 37 CFR § 1.956 to make a showing of "sufficient cause" to grant an extension request, MPEP § 2665 states, in pertinent part:

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against**

the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.

The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).

As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

Decision

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition requesting reconsideration dated 14 January 2010 notes that the postmark on the envelope is 15 October 2009 when the date of the transaction in the file history indicated the action was mailed on 14 October 2009. This is persuasive. "Busy time" of the patent owner from mid-October to December is not persuasive as there is no supporting facts for such allegation. The next reason given is the length of the Office action, the petitioner's opinion notwithstanding, this arguments presented are not persuasive. "Difficult" and "time consuming" are relative terms without factual support for specific time. On balance, the petitioner has not demonstrated "sufficient cause" to grant-in-part an extension of time. The petitioner is reminded that Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The petition for extension of time reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. The need for an expert may be but the petitioner has not set forth what actions have been taken thus far and why the additional time is needed beyond that of ordinary response to an inter partes Office action. The age of an expert has no bearing on sufficient cause, what does have bearing is the steps taken thus far to provide a response and why in spite of the action taken that additional time is needed. The petition notes the difficulty locating the inventor but lacks that facts as to when a search was begun and shat steps were taken at the time the request was granted to locate the inventor, if such was deemed necessary for future prosecution of the proceeding. Copending litigation and district court activity has no bearing on the response time and need for "special dispatch" in the instant proceeding as such cannot be used for sufficient cause to extend a response period.

The petition further requests that if the request for reconsideration is not persuasive that the petition be considered under 37 CFR §§ 1.137, 1.182 or 1.183. These additional petitions are dismissed under 37 CFR § 1.4(c) which states, "Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

The patent owner is reminded that 37 CFR §1.137 is the appropriate authority for revival of terminated Reexamination proceedings.

The petition request to extend the response time is hereby granted-in-part.

An extension of **one-day** is hereby granted so that the response agrees with the postmark of the Office action.

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the non-final Office action dated 14 October 2009 is hereby **granted-in-part**

2. A one-day extension of time is hereby granted

3 The Patent Owner's response is due **15 December 2009.**

4. All correspondence involving this proceeding may be addressed to the following:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the absence of Mark Reinhart calls may be directed to Eric Keasel, at (571) 272-4929, or Jessica Harrison, at (571) 272-4449, all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 73

Roy Hopgood and Stephen Judlowe (For Patent Owner)
Hopgood, Calimafde, Kalil, Blaustein &
Judlowe
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New York NY 10165

MAR 8 2002

Charles W. Hanor (For Requester)
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Reexamination Proceeding	:	
Control No.: 90/003,489	:	
Filed : July 11, 1994	:	
For : U.S. Patent No. 4,721,101	:	
Reexamination Proceeding	:	
Control No.: 90/003,990	:	DECISION MERGING
Filed : October 4, 1995	:	REEXAMINATION
For : U.S. Patent No. 4,721,101	:	
Reexamination Proceeding	:	
Control No.: 90/005,329	:	
Filed : April 13, 1999	:	
For : U.S. Patent No. 4,721,101	:	

The above reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565 (c).

Reexamination in 90/003,489 was ordered in a decision mailed September 28, 1994 and remailed December 22, 1994. Reexamination in 90/003,990 was ordered in a decision mailed December 13, 1995. Reexaminations 90/003,489 and 90/003,990 were merged in a letter mailed February 1, 1996. Reexamination in 90/005,329 was ordered June 23, 1999

Further merger is proper if a reexamination is ordered while prior merged reexamination proceedings are pending. In view of the above, merger of 90/005,329 with the already merged proceedings of 90/003,489 and 90/003,990, is appropriate and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims (and claim numbering) in all files. In anticipation of a merger, Patent owner filed a preliminary amendment on May 4, 2001 to place the file in reexamination control No. 90/005,329 as reexamination file 90/003,489 and 90/003,990 currently stand. The amendment has been entered.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action that applies to all reexamination files. The action will contain identifying data for all files and will be physically entered in all reexamination files. Any response filed by the patent Owner must consist of a single response filed with two copies, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See 37 CFR 1.550(e).

Disposition of Petition filed May 4, 2001

Patent Owner filed on May 4, 2001, a petition to the Commissioner under 37 CFR 1.181 or 1.182 for an order vacating the order granting reexamination per control No. 90/005,329, or, in the alternative, for an order mandating accelerated action in said reexamination. On February 28, 2002, Patent Owner filed a letter withdrawing the petition filed May 4, 2001. Accordingly, in view of the request filed February 28, 2002, the petition of May 4, 2001 is considered withdrawn.

Upon the mailing of this decision, the reexamination file will be forwarded to the examiner for the prompt issuance of an action.

John E. Kittle, Director
Technology Center 3700
Phone: (703) 308-0873

ak/3/7/02

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(For Patent Owner)

MAILED
JUN 12 2006
CENTRAL REEXAMINATION UNIT

John R. Schiffhauer
2200 Sand Hill Road
Suite 100
Menlo Park, California 94025

(For Third Party Requester)

In re reissue application of	:
Horace L. Freeman *et al.*	:
Application No. 08/335,981	:
Filed: November 8, 1994	: **DECISION SEVERING**
For: U.S. Patent No. 5,088,484	: **PREVIOUSLY MERGED**
	: **REISSUE APPLICATION**
	: **AND *EX PARTE***
In re Horace L. Freeman *et al.*	: **REEXAMINATION**
Reexamination Proceeding	: **PROCEEDING**
Control No. 90/003,586	:
Filed: October 3, 1994	:
For: US. Patent No. 5,088,484	:

The merged proceeding consisting of reissue application 08/335,981 and *ex parte* reexamination proceeding 90/003,586 is before the Office of Patent Legal Administration for issuance of a decision to *sua sponte* sever the merged proceeding, in order to permit separate prosecution and examination of the reissue application and the *ex parte* reexamination proceeding.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,088,484 (the '484 patent) issued to Horace L. Freeman *et al.* on February 18, 1992 with 33 claims.

2. On October 3, 1994, a request for *ex parte* reexamination of the '484 patent was filed by a third party requester, and the resulting reexamination proceeding was assigned Control Number 90/003,586 (the '586 reexamination proceeding).

3. On November 8, 1994, the patent owner filed a reissue application based on the '484 patent, which was assigned Application Number 08/335,981 (the '981 reissue application). The filing was accompanied by a preliminary amendment narrowing independent claims 1 and 15 and adding claims 33-42 in an attempt to provoke an interference with U.S. Patent No. 5,342,291 issued to Matthew T. Scholz *et al.* August 30, 1994.

4. On December 22, 1994, an order granting the reexamination request was mailed for the '586 proceeding.

5. The Office merged the '981 reissue application and the '586 reexamination proceeding into a single combined proceeding, in a merger decision mailed August 11, 1995.

6. The August 11, 1995 merger decision required, *inter alia*, that the specification and claims of the merged reissue application and reexamination proceeding be maintained as identical by the filing of identical amendments for so long as the reissue application and reexamination proceeding remained merged.

7. On August 22, 1995, a housekeeping amendment was filed in the '586 reexamination proceeding, which resulted in the specification and claims of the '586 reexamination proceeding being identical to the specification and claims of the '981 reissue application.

8. On September 22, 1999, the Board of Patent Appeals and Interferences (Board) rendered a decision on appeal reversing all outstanding rejections of record against pending claims 1-42 of the merged proceeding.

9. On April 18, 2006, an Initial Interference Memorandum was forwarded to the Board regarding the '981 reissue application.

APPLICABLE STATUTORY AND REGULATORY PROVISIONS

35 U.S.C. § 305 states in pertinent part:

> "No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, **will be conducted with special dispatch** within the Office." [Emphasis added.]

37 CFR 1.565(d) and (e) state:

> "(d) If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will **normally** be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *ex parte* reexamination proceeding is ordered, the merged examination will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *ex parte* reexamination proceeding during the pendency of the merged proceeding. The examiner's actions and responses by the patent owner in a merged proceeding will apply to

[1] See 47 CFR 41.102, and the discussion in MPEP § 2303, Eighth Edition, Rev. 4, October 2005.

both the reissue application and the *ex parte* reexamination proceeding and be physically entered into both files.... "

" (e) If a patent in the process of *ex parte* reexamination is or becomes involved in an interference, the Director may suspend the reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion (§ 41.121(a)(3) of this title) to suspend the interference has been presented to, and denied by, an administrative patent judge, and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set...." [Emphasis added.]

37 CFR 1.550(a) and (g) provide, in pertinent part,

(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

(g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered.

DECISION

The April 18, 2006 forwarding of the Initial Interference Memorandum to the Board regarding the '981 reissue application is a representation that examination has been completed and all pending claims have been allowed, finally rejected or canceled, and that appeal from a final rejection has been completed including any judicial review. [2] The record accordingly shows that the instant merged proceeding has progressed to the point where all claims appear to be allowable, save for a question of priority of invention that has been referred to the Board for resolution in an interference proceeding.

Conducting an interference proceeding while the '981 reissue application and the '586 reexamination proceeding remain merged as a single combined proceeding would result in a lengthy delay of the conclusion of the present reexamination proceeding. This would run counter to the statutory mandate of 35 U.S.C. § 305 that the reexamination proceeding be conducted with special dispatch. Further, the conduct of an interference proceeding is, by its nature, an *inter partes* proceeding. If the '981 reissue application and the '586 *ex parte* reexamination proceeding remain merged as a single proceeding, this would raise a question of whether the '692 reexamination proceeding were in fact being conducted as an *ex parte* proceeding as is required by the statute, which requirement is implemented in 37 CFR 1.565 (g). *See Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989). [3]

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[2] See 47 CFR 41.102, and the discussion in MPEP § 2303, Eighth Edition, Rev. 4, October 2005.

[3] In *Syntex*, the court said (paragraph bridging pages 1868 & 1869):
"If reexamination is granted, a third-party requester has the right to reply to any statement submitted by the patent owner in response to the PTO's order granting reexamination (section 304). The statute gives third-party requesters no further, specific right to participate in the reexamination proceeding. **Indeed, the statute specifically prohibits further participation by third-party requesters during reexamination.** See 35 U.S.C. §305 ("[a]fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination"). Thus, a reexamination is conducted *ex parte* after it is instituted. See *In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1 , 5-6 n.6 (Fed. Cir.), cert. denied, 474 U.S. 828 (1985)." [Emphasis added in bold]

It is therefore determined that the most expeditious avenue to satisfy the special dispatch requirement of 35 U.S.C. § 305 and, at the same time, expedite resolution of the question of priority of invention raised by the Initial Interference Memorandum, is to sever the merged proceedings and take action on the '981 reissue application and '586 reexamination proceeding separately and concurrently.

Accordingly, the following action is taken:

Jurisdiction over the '586 reexamination proceeding is being returned to the Technology Center for immediate action on the proceeding by the primary examiner. In the event that the pending claims in the '586 reexamination proceeding have been impermissibly broadened pursuant to the guidelines in MPEP § 2258(III)(A) and contrary to 35 U.S.C. § 305, appropriate action should be taken to eliminate such broadening.[4] After any issue of any broadening has been resolved, if the claims remain in condition for confirmation/allowance, the preparation of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate pursuant to the practice in § 2287 should be undertaken with special dispatch.

If the'586 reexamination proceeding is concluded by the issuance and publication of an *Ex Parte* Reexamination Certificate, the '484 patent would be modified by any change effected via the certificate. The '484 patent, as modified by any issued *Ex Parte* Reexamination Certificate, would be the patent that is surrendered (as required by statue) in favor of any reissue patent ultimately resulting from the '981 reissue application.

CONCLUSION

1. The merged proceeding consisting of the '981 reissue application and the '586 *ex parte* reexamination proceeding is hereby severed into (1) a separate proceeding, the '981 reissue application, for reissue of the '484 patent, and (2) a separate proceeding, the '586 *ex parte* reexamination, for reexamination of the '484 patent. The two proceedings will be carried on separately and concurrently.

2. Jurisdiction over the '586 reexamination proceeding is being returned to the Technology Center for immediate action on the proceeding by the primary examiner, toward resolution of the proceeding.

3. The '981 reissue application is being forwarded to the Board for any action deemed appropriate with respect to the "Predecisional Memorandum Suggested Interference Referral".

---

[4] A thirty-day action may be promulgated requiring patent owner to eliminate any broadening that is present. It should be noted that restoring the claims in the '692 reexamination proceeding to the claims as they appear in the '484 patent would be one way to overcome the problem of broadened claims, if any exist.

4. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

June 7, 2006
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Office of the Director
Group 3600

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Washington, D.C. 20231

#59

RAYMOND N BAKER
SHANLEY AND BAKER
SUITE 430
2233 WISCONSIN AVE NW
WASHINGTON DC 20007

In re Rexamination :
Control No. 90/003,612 :
Filed: October 31, 1994 : DECISION ON PETITION
For: METAL WIRE PAPER :
CLIP STRUCTURE :

This is in response to the petition filed April 16, 1999 under 37 CFR §1.181. Petitioner requests (1) termination of the above-identified Reexamination, (2) reconsideration of the decision mailed April 2, 1999 and (3) proceedings in the above-identified Reexamination be suspended pending decision on this petition.

For the reason set forth below, the request to terminate the reexamination proceedings is denied. The request to reconsider the prior petition decision is granted to the extent of reviewing petitioner's arguments but denied with respect to making any changes to the decision. The request to suspend the reexamination proceedings is dismissed as moot.

With regard to the request to suspend proceedings, an Appeal Brief was filed on June 23, 1999. The examiner has not responded to the Brief to date. The file will be forwarded to the examiner for action after mailing of this decision. Therefore, the proceedings have essentially been suspended.

Petitioner requests termination of the reexamination and is founded on the present status of the patent claims, which were rewritten pursuant to the directives of the Board of Appeals decision of July 17, 1997. The present status of all the claims under reexamination in this proceeding (claims 6-10) is that they have been finally rejected in the final Office action of September 24, 1998. A Notice of Appeal and Appeal Brief have been filed in response to the final rejection. Petitioner's reference to the "directives of the Board of Appeals decision of July 17, 1997" is not understood. There are no directives in that decision. The "directive" referred to by petitioner is merely an advisement by the Board as to options available. There is no statement regarding the allowability of the claims.

Petitioner makes several arguments as to why reexamination should not have been ordered, including: (a) Winter et al was considered by the Board of Appeals in the decision of October 27, 1993 wherein the examiner was reversed, resulting in the issuance of the patent which is the subject of the reexamination; (b) Winter et al does not qualify as "new information", citing In re Recreative Technologies Corp., and did not escape review at the time of the initial examination of the application; (c) the record does not indicate that analysis of Winter et al was called to the attention of the Office of the Commissioner.

As to (a), whether or not the Board considered Winter et al is not relevant in deciding whether or not to grant reexamination unless Winter et al was used alone. However, this was not the case. Winter et al was used as a tertiary reference in a rejection based on the combination of two references. Since the rejection based on the combination of the two references was reversed, Winter et al was considered as to whether it overcame the deficiencies with respect to the two references applied.

As to (b), the Decision on Petition mailed April 2, 1999 is incorporated herein, without any change in the conclusions. Petitioner is apparently of the belief that if Winter et al was considered in the prosecution of the parent patent, it can not be used as a basis for reexamination. However, in view of In re Portola Packaging Inc., 110F.3d 786, 42 USPQ 1295 (Fed Cir 1997), this is simply not true. The basis for reexamination here was made on the consideration of several new references in addition to Winter et al. It is these new references that were "discovered", and which "escaped review" at the time of initial examination of the application. Petitioner's position would be well taken if reexamination was based solely on Winter et al. However, as pointed out in the prior decision of April 2, 1999, this was not the situation.

As to (c), petitioner's concern is not understood. The decision to order reexamination specifically states that "The Commissioner of Patents and Trademarks, pursuant to 37 CFR §1.520 has determined that the prior art discussed below raises a substantial new question of patentability as to claims 1-5 of US Patent No. 5,329,672". That decision was signed by the Deputy Assistant Commissioner for patents. Obviously, there would be no need to call the decision to order reexamination to the attention of the Office which initiated the order.

The petition is DENIED.

Al Lawrence Smith
Director, Technology Center 3600
(703)308-1020

KD:abk

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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OCT 17 2000

Paper No. 42

Robert E. Purcell, Esq.
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1120 Lincoln Street, Ste. 1500
Denver CO 80203

: For Patent Owner

Craig J. Lervick
Oppenheimer, Wolff & Donnelly, LLP
45 South Seventh Street, Suite 3400
Minneapolis, MN 55402

: For Requester

In re Reexamination
Control No. 90/003,842
U.S. Patent No. 5,288,077
Issued: January 4, 2000
Patent Owner: CoStar Corporation
Request Filed: March 3, 2000
Requester: Seiko Instruments USA, Inc.

: DECISION ON PETITION

This is a decision on the petition filed on August 9, 2000 requesting review and reversal of the examiner's refusal to enter Owner's "Request for Admission of Additional Evidence" ("Request"). The petition is granted-in-part.

On March 9, 2000, Owner filed a reply brief, and concurrently therewith, filed the Request. The examiner refused to enter it, holding, in essence, that the Request was not timely filed.

A review of the Request shows that it includes three exhibits. The first exhibit is a Consent Decree which includes U. S. Patent 5,288,077 ('077 patent). The second exhibit is a Press Release which discusses the Consent Decree. The third exhibit is a copy of an original Complaint filed in 1995 asserting that the '077 patent is invalid.

MPEP § 2282 does indeed state, as argued by Owner, that updated status information regarding prior or concurrent proceedings regarding the patent under reexamination will be accepted for placement in the patent files "at any time". Therefore, timeliness of the submission should not bar acceptance of the submission of information regarding the status of prior or concurrent proceedings. However, MPEP § 2282 does go on to state that:

> "Persons making such submissions must limit the submissions to the notification, and must not include further arguments **or information**. Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office."

It is clear to the undersigned that the Press Release does not constitute bare notice of the status of the proceedings discussed therein, particularly since the Consent Decree notice of the status of the litigation. Therefore, the Request is technically improper, and could be returned to Owner in accordance with MPEP § 2282.

However, it is noted that this reexamination proceeding has been pending for over five years. Reexamination proceedings are to be handled with special dispatch. 35 USC 305. Given that the Consent Decree is merely a settlement between parties who agree that the '077 is valid, and given that such an agreement is not binding on PTO, (see MPEP § 2287 and *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988)) with respect to reexamination proceedings (assuming, *arguendo*, that a consent decree would be treated as "a final decision by a Court"), it is not deemed to be particularly material to the issues presently outstanding on the record. Therefore, it would serve little purpose to return the technically improper Request because Owner could then simply refile the Request without the Press Release, thereby necessitating yet another Remand by the Board of Patent Appeals and Interferences ("Board") which would simply further delay proceedings. In short, the claims involved in the appeal are either patentable, or they are not, notwithstanding the Consent Decree and notwithstanding the fact that an original Complaint alleging invalidity was filed in 1995.

Therefore, the petition is granted to the extent that the Consent Decree and the copy of the 1995 Complaint are to be considered entered of record in this reexamination proceeding. The reexamination proceeding will not be forwarded to the examiner for further consideration, since these documents will have no impact on the present status of the proceedings. The Press Release will remain in the file of the reexamination proceeding, but is technically "not entered", and should not be considered by the Board in deciding the pending appeal.

The proceedings are being forwarded to the Board for appropriate action on the pending appeal.

PETITION GRANTED-IN-PART

E. Rollins-Cross, Director, Patent
Examining Groups 3710 & 3720

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MAILED

AUG 30 2006

CENTRAL REEXAMINATION UNIT

In re reissue application of
John P. Curtis, et al.
Serial No. 08/316,297
Filed: September 30, 1994
For: U.S. Patent No. 5,209,251

In re John P. Curtis, et al.
Reexamination Proceeding
Control No. 90/003,885
Filed: June 30, 1995
For: U.S. Patent No. 5,209,251

DECISION
SEVERING
MERGER

The merged proceeding consisting of reissue application 08/316,297 and *ex parte* reexamination proceeding 90/003,885 is before the Office of Patent Legal Administration for issuance of a decision to *sua sponte* sever the merged proceeding, in order to permit separate prosecution and examination of the reissue application and the *ex parte* reexamination proceeding.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,209,251 (the '251 patent) issued May 11, 1993.

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2. On September 30, 1994, the patent owner filed a reissue application based on the '251 patent, which was assigned Application Number 08/316,297 (the '297 reissue application).

3. On June 30, 1995, a request for *ex parte* reexamination of the '251 patent was filed by a third party requester, and the resulting reexamination proceeding was assigned Control Number 90/003,885 (the '885 reexamination proceeding).

4. On September 13, 1995, reexamination was ordered for the '885 reexamination proceeding.

5. In a merger decision mailed January 25, 1996, the Office merged the '297 reissue application and the '885 reexamination proceeding into a single combined proceeding. The reissue application and the reexamination file were then remanded to the Director of Examining Group 3300 for examination in accordance with the merger decision.

6. The merged proceeding of the '297 reissue application and the '885 reexamination proceeding progressed to the point where, on September 29, 2005, a final office action was mailed. The time for response expired on December 30, 2005, and no response has been received from the patent owner.

DECISION

At page 3 of the merger decision mailed January 25, 1996, it was stated:

> "If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned and the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings."

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In this instance, the patent owner failed to file a timely and appropriate response to the Final Office action of September 29, 2005. Accordingly, the merged proceeding of the '297 reissue application and the '885 reexamination proceeding is hereby dissolved and severed into two separate proceedings.

The '297 reissue application and the '885 reexamination proceeding are forwarded to Technology Center 3700 and the Central Reexamination Unit, respectively, for action as follows:

In the Technology Center, the reissue application will be held abandoned.

In the Central Reexamination Unit:

The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings.

If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination will be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) will be applied by the examiner. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution will be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

CONCLUSION

1. The merged proceeding consisting of '297 reissue application and the '885 *ex parte* reexamination proceeding is hereby severed into (1) a separate proceeding, for the '297 reissue application, for reissue of the '251 patent, and (2) a separate proceeding, the '885 *ex parte* reexamination, for reexamination of the '251 patent. The two proceedings will be addressed separately and concurrently.

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2. Jurisdiction over the '297 reissue application proceeding is forwarded to the Technology Center, and jurisdiction over the '885 reexamination proceeding is forwarded to the Central Reexamination Unit, in each case, for immediate action on the proceedings by the primary examiners, toward resolution of the proceedings, and not inconsistent with this decision.

3. Telephone inquiries related to this decision should be directed to Linda Sholl, Special Program Examiner, at (571) 272-4391.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

August 30, 2006
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(For Third Party Requester)

MAILED

DEC 2 1 2006

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
J. Curtis et al. :
Control No. 90/003,885 : DECISION DISMISSING PETITION
Filed: June 30, 1995 :
U.S. Patent No. 5,209,251 :
Attorney Docket No. 15300/220 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on November 21, 2006, for entry of late papers based upon unintentional delay.

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

37 CFR 1.137(b) states:

> *"Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

The present petition under 37 CFR 1.137(b) includes, inter alia, a response (Amendment And Response Under 37 C.F.R. § 1.550(b) - item 1), an authorization to charge counsel's deposit account for the $1,500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

A review of the record reveals that the response entitled "Amendment And Response Under 37

C.F.R. § 1.550(b)" is not in compliance with manner of making amendments in a reexamination proceeding under 37 CFR 1.530(e), as the status of all (pending, canceled) claims were not set forth. A grantable petition under 37 CFR 1.137(b) requires a proper response, which in this instance is an amendment in compliance with 37 CFR 1.530. Therefore, an amendment in compliance with 37 CFR 1.530 is required. It is also noted that the specific parenthetical expressions for any claim changed by an amendment were not used, 37 CFR 1.530(d)(2).

A further review of the present petition reveals that the requisite proof of service on the third party requester has not been included with the present petition papers.

Since there is no indication that the third party requester was provided with a copy of these papers, any response by patent owner to this decision must include a Certificate that the present petition papers have been served on the third party requester in the manner provided by § 1.248.

In addition, any future communications filed by patent owner in this proceeding (including any response to this decision) must include proof of service on the third party requester in accordance with 37 CFR 1.550(f).

CONCLUSION

1. In view of the above, the present petition under 37 CFR 1.137(b) is **dismissed**.

2. $1,500.00 has been charged to counsel's deposit account no. 11-0600 in accordance with the present petition.

3. For the granting of the present petition, it is required that patent owner provide:

   a. A Certificate that the present petition papers and any request for reconsideration have been served on the third party requester; and

   b. An amendment in compliance with 37 CFR 1.530.

4. The submissions should be included in a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

5. Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. An extension of time to file a request for reconsideration may be requested **only** under 37 CFR 1.550(c), extensions of time under 37 CFR 1.136 are **not** available in reexamination proceedings. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

6. Further correspondence with respect to this matter should be addressed as follows:

   By mail: Attn: Mail Stop "*Ex Parte* Reexam"

Central Reexamination Unit
Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

7. Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Conferee: Kenneth M. Schor, Senior Legal Advisor

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

FEB 15 2007

CENTRAL REEXAMINATION UNIT

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK NY 10004

(For Patent Owner)

MICHAEL S. MARCUS, ESQUIRE
MORGAN & FINNEGAN, LLP
1775 EYE STREET, N.W.
SUITE 400
WASHINGTON, DC 20006-2401

(For Third Party Requester)

In re Reexamination Proceeding :
J. Curtis et al. :
Control No. 90/003,885 : DECISION GRANTING
Filed: June 30, 1995 : REQUEST FOR RECONSIDERATION
U.S. Patent No. 5,209,251 :
Attorney Docket No. 15300/220 :

This is a decision on the request for reconsideration (renewed petition) filed January 22, 2007, in response to the Decision mailed December 21, 2006, in the above-identified application.

Petitioners by the renewed petition request entry of late papers based upon unintentional delay under 37 CFR 1.137(b). The renewed petition is accompanied by a Certificate that the original petition papers and any request for reconsideration have been served on the third party requester; and an amendment in compliance with 37 CFR 1.530, as required on page 2 of the Decision mailed December 21, 2006.

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

37 CFR 1.137(b) states:

> *"Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The

Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

37 CFR 1.530(e) states:

Status of claims and support for claim changes. Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (amendment and response filed January 22, 2007 - item 1), a $1,500.00 petition fee under 37 CFR 1.17(m) (an authorization to charge counsel's deposit account for the $1,500.00 petition fee under 37 CFR 1.17(m)) (item 2), the requisite statement (item 3) and a Certificate of Service on the Third Party Requester (filed January 22, 2007).

A review of the amendment and response filed January 22, 2007, reveals that it is not in compliance with 37 CFR 1.530(e), as it does not include on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims. In order to avoid any further delays and to further the statutory mandate for "special dispatch" in reexamination proceedings, the requirement for the status of all patent claims to be included on pages separate from the claims is hereby *waived* pursuant to 37 CFR 1.183. The amendment filed January 22, 2007, has been annotated to that effect.

The petition for entry of the late papers is granted.

A review of the financial records for this application reveals that a first $1,500.00 has been charged to counsel's deposit account no. 11-0600 pursuant to the original petition filed November 21, 2006, and a second $1,500.00 has been inadvertently charged to counsel's deposit account pursuant to the catch-all authorization contained in the renewed petition. The second $1,500.00 charged to counsel's deposit account will be refunded in due course.

The amendment filed November 21, 2006, is withdrawn and will not be entered or used during the prosecution of this proceeding. The amendment filed November 21, 2006, has been annotated to that effect.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3993 for further examination and consideration of the amendment and response filed January 22, 2007, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Beverly Flanagan, in CRU Art Unit 3993, who can be reached at 571-272-4766.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Conferee: Kenneth M. Schor, Senior Legal Advisor

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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Paper No. 62

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(For Patent Owner)

MAR 8 2002

Charles W. Hanor
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San Antonio TX 78205

(For Requester)

Reexamination Proceeding
Control No.: 90/003,489
Filed : July 11, 1994
For : U.S. Patent No. 4,721,101

Reexamination Proceeding
Control No.: 90/003,990
Filed : October 4, 1995
For : U.S. Patent No. 4,721,101

Reexamination Proceeding
Control No.: 90/005,329
Filed : April 13, 1999
For : U.S. Patent No. 4,721,101

DECISION MERGING
REEXAMINATION

The above reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565 (c).

Reexamination in 90/003,489 was ordered in a decision mailed September 28, 1994 and remailed December 22, 1994. Reexamination in 90/003,990 was ordered in a decision mailed December 13, 1995. Reexaminations 90/003,489 and 90/003,990 were merged in a letter mailed February 1, 1996. Reexamination in 90/005,329 was ordered June 23, 1999.

Further merger is proper if a reexamination is ordered while prior merged reexamination proceedings are pending. In view of the above, merger of 90/005,329 with the already merged proceedings of 90/003,489 and 90/003,990, is appropriate and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims (and claim numbering) in all files. In anticipation of a merger, Patent owner filed a preliminary amendment on May 4, 2001 to place the file in reexamination control No. 90/005,329 as reexamination file 90/003,489 and 90/003,990 currently stand. The amendment has been entered.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action that applies to all reexamination files. The action will contain identifying data for all files and will be physically entered in all reexamination files. Any response filed by the patent Owner must consist of a single response filed with two copies, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See 37 CFR 1.550(e).

Disposition of Petition filed May 4, 2001

Patent Owner filed on May 4, 2001, a petition to the Commissioner under 37 CFR 1.181 or 1.182 for an order vacating the order granting reexamination per control No. 90/005,329, or, in the alternative, for an order mandating accelerated action in said reexamination. On February 28, 2002, Patent Owner filed a letter withdrawing the petition filed May 4, 2001. Accordingly, in view of the request filed February 28, 2002, the petition of May 4, 2001 is considered withdrawn.

Upon the mailing of this decision, the reexamination file will be forwarded to the examiner for the prompt issuance of an action.

John E. Kittle, Director
Technology Center 3700
Phone: (703) 308-0873

ak/3/7/02

#36 (mail)

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COMMISSIONER FOR PATENTS
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Paper No. 36

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Troy, MI 48084

MAILED
APR 03 2001
REEXAM UNIT

In re Gordin
Reexamination Proceeding
Control No. 90/003,998
Filed: October 2, 1995
For: U.S. Patent No. 4,725,934

DECISION GRANTING PETITION

This is a decision on the December 8, 2000, patent owner petition requesting withdrawal of the holding of late filing of either patent owner's response to final rejection or appeal of the final rejection in the above-identified reexamination proceeding, which is being treated as a PETITION UNDER 37 C.F.R. § 1.181. The instant petition alternatively requests the acceptance of the late filing of patent owner's response to the final rejection or appeal of the final rejection, which is being treated as a PETITION UNDER 37 C.F.R. § 1.137(a), based upon unavoidable delay. The petition is before the Office of Patent Legal Administration for decision.

The petition requesting withdrawal of the holding of late filing of patent owner's response to the final rejection or appeal of the final rejection is **dismissed** for the reasons pointed out in Part I of the decision below. The petition for acceptance of the late filing of patent owner's response to the final rejection or appeal of the final rejection based upon unavoidable delay is **granted** for the reasons pointed out in Part II of the decision below.

REVIEW OF FACTS

1. U.S. Patent No. 4,725,934 issued to Myron K. Gordin on February 16, 1988.

2. On October 10, 1995, a request for reexamination was filed by a third party requester and was assigned Control No. 90/003,998.

3. Reexamination was ordered in the '3998 proceeding on December 11, 1995.

4. On June 15, 2000, a final rejection was mailed, which set a two month shortened statutory period for response.

5. Patent owner filed a request for an extension of time on August 14, 2000, which was supplemented on August 15, 2000.

6. A one month extension of time was granted in a letter mailed on August 24, 2000.

7. A Notice of Appeal was received on October 18, 2000.

8. On December 8, 2000, the present petition was received, along with a copy of the response to the outstanding final rejection.

9. An Appeal Brief in triplicate was received on December 19, 2000.

DECISION

This reexamination proceeding terminated after September 15, 2000, for failure to timely file a response within the meaning of 37 C.F.R. § 1.113 to the final Office action of June 15, 2000, which set a shortened statutory period for response of two (2) months, and noted that extensions of time were governed by

37 C.F.R. § 1.550(c). A request for an extension of time was received on August 14, 2000, which was supplemented on August 15, 2000. An extension of time for one month was granted in a decision mailed on August 24, 2000, thus resetting the due date for response to be September 15, 2000.

The petition includes a copy of the response (Exhibit A) signed on September 15, 2000, by Mark D. Hansing, which is accompanied by a certificate of service dated September 15, 2000, and signed by Mark D. Hansing, along with a copy of the USPTO receipt card, which is stamped as being received by the USPTO on September 19, 2000 (Exhibit B)..

The petition includes a declaration of Wanda Webb (Exhibit C), the attorney's secretary, which details her length of employment with ZARLEY, McKEE, THOMTE, VORHEES & SEASE, as well as her experience in handling tasks, such as filing responses with the USPTO by certificate of first class mail, as well as finalizing the file and docketing system to confirm the filing of the responses.

Part I. PETITION UNDER 37 C.F.R. § 1.181

Petitioner is requesting withdrawal of the holding of late filing of either patent owner's response to final rejection or appeal of the final rejection.

Petitioner alleges (pet., p.5) that a certificate of mailing was included with the response after final, but acknowledges that this can neither be proved nor disproved conclusively because (1) the petitioner's file does not contain a copy of the certificate of mailing, and (2) the Office cannot locate the original copy of the filed response. Petitioner argues, however, that the evidence submitted with the petition establishes that a response to the final rejection was prepared and mailed on September 15, 2000, and further appears to establish that a certificate of first class mailing under 37 C.F.R. § 1.8 was included with the timely filed mailing as evidenced by the return postcard.

Since the USPTO has made a diligent search for the original response, but to date has not been able to locate such response, patent owner cannot prove, and the Office cannot confirm, that a properly completed certificate of mailing was indeed included with the response. However, patent owner has provided evidence in the form of a copy of the USPTO receipt card for this reexamination proceeding, which itemizes a 6 page response, as well as a certificate of mailing, that the USPTO stamped as having been received on September 19, 2000.

MPEP 503 states:

> "A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Since the evidence of record includes a photocopy of the post card receipt, which clearly lists a certificate of mailing as being included with the response paper, and the USPTO stamped the post card, this is *prima facie* evidence that a certificate of mailing was included with the response paper. However, as to whether or not the certificate of mailing was completed properly under 37 C.F.R. § 1.8, this cannot be established unless a copy of the actual certificate of mailing is located. Absent a copy of the actual certificate of mailing with the proper date clearly shown, the evidence of record is not sufficient to establish that the response was timely filed. Therefore, the petition requesting withdrawal of the holding of late filing of patent owner's response to the final rejection or appeal of the final rejection is **dismissed**.

Part II. PETITION UNDER 37 C.F.R. § 1.137(a)

Petitioner alternatively requests the acceptance of the late filing of patent owner's response to the final rejection or appeal of the final rejection, which is being treated as a PETITION UNDER 37 C.F.R. § 1.137(a), based upon unavoidable delay.

A grantable petition for entry of belated papers under 37 C.F.R. § 1.137(a) must be accompanied (1) by an adequate showing of the cause of unavoidable delay, (2) by the proposed response to the outstanding Office action, and (3) by the petition fee required by law.

With regard to item (3) above, the petition fee under 37 C.F.R. § 1.17(l) of $110.00, for the request for relief under 37 C.F.R. § 1.137(a), based upon unavoidable delay, has been charged to petitioner's deposit account number 26-0084, as per petitioner's instructions on page 9 of the present petition.

Concerning item (2) above, the present petition is accompanied by a copy of the response to the outstanding final Office action of June 15, 2000 (Exhibit A). Also, a Notice of Appeal and the requisite fee were received on October 18, 2000 (with a certificate of mailing of October 13, 2000) and Patent Owner's Appeal Brief was filed in triplicate on December 19, 2000 (with a certificate of mailing of December 13, 2000).

As to item (1) above, an adequate showing of the cause of unavoidable delay, the present petition states that patent owner prepared and filed a response to the final rejection on September 15, 2000, the due date for the response, but that the certificate of mailing that accompanied the response is missing from the copy of the response in their file. The petition includes statements by the patent owner's attorney, Mark D. Hansing, indicating that he gave instructions to his staff to (a) file the response with the USPTO by certificate of mailing procedures, as well as to serve the response on the reexamination requester by mail, and (b) docket an appeal deadline for October 15, 2000, because an automatic one month extension of the appeal deadline is available if a response to the final rejection is made.

The petition further includes a declaration of Wanda Webb (Exhibit C), the attorney's secretary, which states that she has been working with Mark Hansing since 1995. In this case, she asserts that she believes that she filed the response with the USPTO by certificate of mailing procedures, as well as serving the response on the reexamination requester, and that she docketed an appeal deadline for October 15, 2000. She indicates that she routinely handles the tasks of filing responses with the USPTO by certificate of first class mail, as well as finalizing the file and docketing system to confirm the filing of the responses. She states that she prepared the USPTO receipt card, and asserts that since she itemized a 6 page response to the final rejection, as well as a certificate of mailing on the postcard, she believes that she did mail the response and a certificate of first class mail.

With regard to an adequate showing of the cause of unavoidable delay, the test of "unavoidable" delay is the "reasonably prudent person" test set forth in *In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912):

> "The test of whether the delay is unavoidable is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business".

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided

it is shown that:

> (A) the error was the cause of the delay at issue;
> (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
> (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

As noted in Part I above, the post card receipt *prima facie* shows that a certificate of mailing accompanied the response, but does not show whether or not the certificate was properly prepared. Accordingly, the error that was the cause of the delay is either failing to include a properly completed certificate of mailing with the response, or including the certificate of mailing with the response, but failing to keep a copy of the certificate of mailing with the copy of the response in patent owner's file. The evidence of record, which includes statements of both Mark D. Hansing and Wanda Webb, is sufficient to establish that there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance. The evidence also shows that the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. In addition to the averments made by petitioner, the efficiency and proper working of the docketing/mailing system and personnel involved is further evidenced by a review of record which shows that every response filed by patent owner (presently in the file) includes either a properly prepared certificate of mailing or certificate of express mail.

Therefore, in view of the evidence of record, a prudent and careful attorney could rely upon the established docketing/mailing system and personnel involved, and reasonably and properly assume that the response would be accompanied by a properly prepared certificate of mailing. Accordingly, the petitioner's request for entry of the late paper, based upon an adequate showing of the cause of unavoidable delay, is **granted.**

The case will be forwarded to the Technology Center for the examiner's consideration of the response filed September 19, 2000, as well as the appeal brief of December 19, 2000.

CONCLUSION

1. The petition requesting withdrawal of the holding of late filing of patent owner's response to the final rejection or appeal of the final rejection is **withdrawn**.

2. The petition requesting entry of the late paper based upon an adequate showing of the cause of unavoidable delay is **granted**.

3. The reexamination file is being forwarded to Technology Center 2800 for the examiner's consideration of the response filed September 19, 2000, as well as the appeal brief of December 19, 2000.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Stephen Husar, in Technology Center Art Unit 2875.

5. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

April 3, 2001

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

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#33

Trace Research & Development Center (For Requester)
5901 Research Park Blvd.
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MAILED
JUL 19 2000
REEXAM UNIT

In re Reissue Application of :
Kelly :
Serial No. 09/514,448 :
Filed: February 23, 2000 :
For: U.S. Patent No. 5,065,360 :
:
:
In re Kelly : **DECISION MERGING**
Reexamination Proceeding : **REEXAMINATION AND**
Control No. 90/004,214 : **REISSUE PROCEEDINGS**
Filed: April 10, 1996 :
For: U.S. Patent No. 5,065,360 :
:

The above-identified reissue and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,065,360 issued to Kelly on November 12, 1991.

2. On April 10, 1996, a third party requester filed a request for reexamination of the '360 patent, and the resulting proceeding was assigned Control No. 90/004,214.

3. Reexamination was ordered in the '214 proceeding on June 24, 1996.

4. On October 8, 1996, a stay of concurrent patent infringement litigation (in which the '360 patent was involved) was granted, pending the outcome of the '214 reexamination proceeding.

5. On December 5, 1996, a nonfinal Office action was mailed in the '214 proceeding, and patent owner, AlphaSmart, Inc., filed a response to such Office action on February 5, 1997.

6. A final rejection was then mailed on April 9, 1997, in the '214 proceeding.

7. Patent owner filed: a) a notice of appeal on June 9, 1997; b) an appeal brief on July 28, 1997; c) and an appeal brief on December 18, 1997, in the '214 proceeding [1].

8. On March 17, 1998, an examiner's answer was mailed in the '214 proceeding, which addressed the arguments in the appeal brief of December 18, 1997.

9. On July 30, 1998, patent owner filed a petition under 37 C.F.R. § 1.182, requesting that the appeal be stayed for consideration of an information disclosure statement.

10. A decision denying such petition was mailed on February 2, 1999.

11. On August 27, 1999, the Board of Patent Appeals and

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[1] Although the appeal brief of July 28, 1997 was not matched with the file, patent owner later supplied a copy of it on December 18, 1997, along with a copy of a return postcard. The return postcard acknowledges receipt of a Transmittal Letter, an Appeal Brief (in triplicate), a check in the amount of $150.00, a Certificate of Mailing, and a Certificate of Service by the Patent and Trademark Office on July 30, 1997. In a letter dated December 31, 1997, James Dwyer, Acting Director of 2700, indicated that the receipt date stamped on the postcard receipt is evidence that an appeal brief was timely submitted. The copy of the appeal brief submitted on December 18, 1997, and the papers filed with it were accepted as timely, since the Office apparently misplaced the appeal brief originally submitted.

Interferences (BPAI) mailed an affirmance of the examiner's decision in the '214 proceeding.

12. On August 30, 1999, patent owner supplied a *copy* of a reply brief and a request for oral hearing that had apparently been timely filed on April 24, 1998, but had not matched with the case. Based on this, patent owner filed a request for vacating the BPAI's decision in the '214 proceeding and remanding the case to the examiner on September 10, 1999.

13. An order vacating the BPAI's decision and remanding the case to the examiner was mailed by the BPAI on October 20, 1999.

14. A miscellaneous communication was mailed to patent owner on December 1, 1999, in the '214 proceeding, which noted the request for oral hearing and the reply brief of April 24, 1998. The examiner indicated in such communication that the reply brief was entered and considered, but no further response was deemed necessary.

15. On February 23, 2000, **a reissue application** was filed by AlphaSmart, Inc. (patent owner) requesting reissue of the '360 patent. The application was assigned application Serial No. 09/514,448. The reissue application amends original patent claims 1, 15, 16, 19, 22, and adds new claims 25-39. Patent owner indicates that this amendment amends the claims to conform to the arguments raised by AlphaSmart during reexamination.

16. Also on February 23, 2000, AlphaSmart filed a petition under 37 C.F.R. § 1.182 to merge the reissue application with the '214 reexamination proceeding.

17. The oral hearing in the '214 proceeding was scheduled for April 6, 2000. On March 28, 2000, patent owner filed a petition to request postponement of the oral hearing based on the filing of the reissue application and the petition to merge the reissue application with the '214 reexamination proceeding.

18. The BPAI granted the petition to postpone the oral hearing in a decision mailed on April 4, 2000.

20. A notice of the reissue application filing was published in the Official Gazette on May 9, 2000.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> "(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings...."

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the order has been mailed pursuant to § 1.525 in the reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings.

A review of the prosecution history of the reexamination file shows that the reexamination is awaiting a decision on appeal from the final rejection of original (unamended) patent claims 1-24 by the Board of Patent Appeals and Interferences (BPAI). The original specification, drawings and patent claims are presently in the reexamination file. A review of the prosecution history for the reissue file (Application No. 09/514,448) shows that, in addition to amending the original patent claims 1, 15, 16, 19 and 22, applicant has submitted new claims 25-39 for consideration. Thus, the claims are <u>not</u> identical in both proceedings. In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the

patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue and the reexamination proceedings will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in All Proceedings

The patent owner is required to maintain identical amendments in the reissue application and reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR § 1.565(d). **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 09/514,448, and Control Number 90/004,214. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of any of the proceedings in the housekeeping amendment.

III. Conduct of the Merged Reissue and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action at the most advanced point possible for the reexamination proceeding. Prosecution should be reopened by the examiner, and the appropriate action on the merits issued.

2. In the event that a housekeeping amendment is not timely submitted, any claim that does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods of response should be set at one (1) month to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305)[2].**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding. Each action will be physically entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two copies bearing a signature. Any such responses must be served on the third party requester, who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

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[2] As pointed out above, on October 8, 1996, a stay of patent infringement litigation (in which the '360 patent was involved) was granted, pending the outcome of the present '214 reexamination proceeding. MPEP 2286 points out that where a court issues such a stay, "[o]ffice actions in these reexamination proceedings will normally set a 1 month shortened statutory period for response rather than the 2 months usually set in reexamination proceedings. ... This 1-month period may be extended only upon a showing of sufficient cause."

6. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR § 1.570. See MPEP 2285.

7. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved *as to the reissue application*. With respect to the reexamination proceeding that will remain, the Director of the USPTO will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

8. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding *as to the reissue application*, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

9. Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 CFR § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continued prosecution of the reexamination proceeding.

CONCLUSION

1. The above-identified reissue and reexamination proceedings ARE MERGED into a single consolidated proceeding.

2. Pursuant to Part II of this decision, **a housekeeping amendment is required from applicant/patent owner within ONE MONTH of this decision**, placing the same amendments in all cases of the present merged proceeding.

3. The reissue and reexamination files are being returned to the Board of Patent Appeals and Interferences for any processing needed with respect to the appeal taken in the reexamination proceeding. The files will then be forwarded to the examiner via the Director of Technology Center 2700, to be stored and await receipt of the housekeeping amendment or the expiration of time for submitting same. The examiner will then promptly issue an Office action for the merged proceeding. All further examination should be conducted in accordance with Part III of this decision.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 306-5682.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

July 18, 2000
C:\kiva\pet3\4214-bd.lyn

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

(For Patent Owner)

#33 mrs

Paul E. Schaafsma
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(For Requester)

Trace Research & Development Center
5901 Research Park Blvd.
Madison, WI 53719

MA

JUL 19 2000

REEXAM UNIT

In re Reissue Application of
Kelly
Serial No. 09/514,448
Filed: February 23, 2000
For: U.S. Patent No. 5,065,360

In re Kelly
Reexamination Proceeding
Control No. 90/004,214
Filed: April 10, 1996
For: U.S. Patent No. 5,065,360

DECISION MERGING REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,065,360 issued to Kelly on November 12, 1991.

2. On April 10, 1996, a third party requester filed a request for reexamination of the '360 patent, and the resulting proceeding was assigned Control No. 90/004,214.

3. Reexamination was ordered in the '214 proceeding on June 24, 1996.

4. On October 8, 1996, a stay of concurrent patent infringement litigation (in which the '360 patent was involved) was granted, pending the outcome of the '214 reexamination proceeding.

5. On December 5, 1996, a nonfinal Office action was mailed in the '214 proceeding, and patent owner, AlphaSmart, Inc., filed a response to such Office action on February 5, 1997.

6. A final rejection was then mailed on April 9, 1997, in the '214 proceeding.

7. Patent owner filed: a) a notice of appeal on June 9, 1997; b) an appeal brief on July 28, 1997; c) and an appeal brief on December 18, 1997, in the '214 proceeding [1].

8. On March 17, 1998, an examiner's answer was mailed in the '214 proceeding, which addressed the arguments in the appeal brief of December 18, 1997.

9. On July 30, 1998, patent owner filed a petition under 37 C.F.R. § 1.182, requesting that the appeal be stayed for consideration of an information disclosure statement.

10. A decision denying such petition was mailed on February 2, 1999.

11. On August 27, 1999, the Board of Patent Appeals and

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[1] Although the appeal brief of July 28, 1997 was not matched with the file, patent owner later supplied a copy of it on December 18, 1997, along with a copy of a return postcard. The return postcard acknowledges receipt of a Transmittal Letter, an Appeal Brief (in triplicate), a check in the amount of $150.00, a Certificate of Mailing, and a Certificate of Service by the Patent and Trademark Office on July 30, 1997. In a letter dated December 31, 1997, James Dwyer, Acting Director of 2700, indicated that the receipt date stamped on the postcard receipt is evidence that an appeal brief was timely submitted. The copy of the appeal brief submitted on December 18, 1997, and the papers filed with it were accepted as timely, since the Office apparently misplaced the appeal brief originally submitted.

Interferences (BPAI) mailed an affirmance of the examiner's decision in the '214 proceeding.

12. On August 30, 1999, patent owner supplied a *copy* of a reply brief and a request for oral hearing that had apparently been timely filed on April 24, 1998, but had not matched with the case. Based on this, patent owner filed a request for vacating the BPAI's decision in the '214 proceeding and remanding the case to the examiner on September 10, 1999.

13. An order vacating the BPAI's decision and remanding the case to the examiner was mailed by the BPAI on October 20, 1999.

14. A miscellaneous communication was mailed to patent owner on December 1, 1999, in the '214 proceeding, which noted the request for oral hearing and the reply brief of April 24, 1998. The examiner indicated in such communication that the reply brief was entered and considered, but no further response was deemed necessary.

15. On February 23, 2000, **a reissue application** was filed by AlphaSmart, Inc. (patent owner) requesting reissue of the '360 patent. The application was assigned application Serial No. 09/514,448. The reissue application amends original patent claims 1, 15, 16, 19, 22, and adds new claims 25-39. Patent owner indicates that this amendment amends the claims to conform to the arguments raised by AlphaSmart during reexamination.

16. Also on February 23, 2000, AlphaSmart filed a petition under 37 C.F.R. § 1.182 to merge the reissue application with the '214 reexamination proceeding.

17. The oral hearing in the '214 proceeding was scheduled for April 6, 2000. On March 28, 2000, patent owner filed a petition to request postponement of the oral hearing based on the filing of the reissue application and the petition to merge the reissue application with the '214 reexamination proceeding.

18. The BPAI granted the petition to postpone the oral hearing in a decision mailed on April 4, 2000.

20. A notice of the reissue application filing was published in the Official Gazette on May 9, 2000.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> "(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings...."

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the order has been mailed pursuant to § 1.525 in the reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings.

A review of the prosecution history of the reexamination file shows that the reexamination is awaiting a decision on appeal from the final rejection of original (unamended) patent claims 1-24 by the Board of Patent Appeals and Interferences (BPAI). The original specification, drawings and patent claims are presently in the reexamination file. A review of the prosecution history for the reissue file (Application No. 09/514,448) shows that, in addition to amending the original patent claims 1, 15, 16, 19 and 22, applicant has submitted new claims 25-39 for consideration. Thus, the claims are <u>not</u> identical in both proceedings. In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the

patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue and the reexamination proceedings will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in All Proceedings

The patent owner is required to maintain identical amendments in the reissue application and reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR § 1.565(d). **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases,** specifically, Application No. 09/514,448, and Control Number 90/004,214. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of any of the proceedings in the housekeeping amendment.

III. Conduct of the Merged Reissue and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action at the most advanced point possible for the reexamination proceeding. Prosecution should be reopened by the examiner, and the appropriate action on the merits issued.

2. In the event that a housekeeping amendment is not timely submitted, any claim that does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods of response should be set at one (1) month to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305)[2].**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding. Each action will be physically entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two copies bearing a signature. Any such responses must be served on the third party requester, who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

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[2] As pointed out above, on October 8, 1996, a stay of patent infringement litigation (in which the '360 patent was involved) was granted, pending the outcome of the present '214 reexamination proceeding. MPEP 2286 points out that where a court issues such a stay, "[o]ffice actions in these reexamination proceedings will normally set a 1 month shortened statutory period for response rather than the 2 months usually set in reexamination proceedings. ... This 1-month period may be extended only upon a showing of sufficient cause."

6. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR § 1.570. See MPEP 2285.

7. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved *as to the reissue application*. With respect to the reexamination proceeding that will remain, the Director of the USPTO will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

8. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding *as to the reissue application*, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

9. Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 CFR § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continued prosecution of the reexamination proceeding.

CONCLUSION

1. The above-identified reissue and reexamination proceedings ARE MERGED into a single consolidated proceeding.

2. Pursuant to Part II of this decision, **a housekeeping amendment is required from applicant/patent owner within ONE MONTH of this decision**, placing the same amendments in all cases of the present merged proceeding.

3. The reissue and reexamination files are being returned to the Board of Patent Appeals and Interferences for any processing needed with respect to the appeal taken in the reexamination proceeding. The files will then be forwarded to the examiner via the Director of Technology Center 2700, to be stored and await receipt of the housekeeping amendment or the expiration of time for submitting same. The examiner will then promptly issue an Office action for the merged proceeding. All further examination should be conducted in accordance with Part III of this decision.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 306-5682.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

July 18, 2000
C:\kiva\pet3\4214-bd.lyn

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/514,448	2-23-00		

PATENT NUMBER	DATE OF THIS NOTICE
5,065,360	7/20/00

PAPER NUMBER
34

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/ 004,214 Filing Date: 4/10/96

Requester (name, address) TRACE RESEARCH & DEVELOPMENT CENTER
5901 RESEARCH PARK BLVD.
MADISON, WI 53719

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/ 004, 214, filed 4/10/96, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/514,448	2-23-00		

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,065,360	7/20/00	34

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C 20231
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Paper No. 14

MICHAEL T RAGGIO
DINNIN & DUNN
TOP OF TROY BUILDING
755 WEST BIG BEAVER SUITE 2100
TROY , MI 48084

COPY MAILED

APR 10 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of:
McDougal
Application No. 90/004,382
Issued: 11/03/1998
Attorney Docket No. 1324-00001

ON PETITION

This is a decision on the petition under 37 C.F.R. §1.183, filed on January 5, 2001, to reconsider the decision to dismiss Petitioner's first petition under 37 C.F.R. §1.183 (petition for correction of the assignee on the reexamination certificate), filed December 24, 1998.

The petition is **GRANTED**.

The certificate of correction fee under 37 C.F.R. §1.20(a) is One Hundred Dollars ($100.00). While the fee has not been paid, Petitioner has mistakenly paid the $130.00 petition fee twice. Therefore, the amount due has been overpaid by $30.00. A refund can be obtained by making a request to the Office of Finance. A copy of this decision should accompany any such request.

The file is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Scott M. Ledford in the Office of Petitions at (703) 306-5593.

Beverly Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Examination Policy

OIPE JC37 JAN 05 2001 PATENT & TRADEMARK OFFICE

90/004382

C of C

PTO/SB/17 (11-00)
Approved for use through 10/31/2002. OMB 0651-0032
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to r espond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2001

Patent fees are subject to annual revision

TOTAL AMOUNT OF PAYMENT	$130.00

Complete if Known	
Application Number	588,026
Filing Date	9/25/90
First Named Inventor	
Examiner Name	
Group Art Unit	
Attorney Docket No.	1324-00001

RECEIVED
JAN 18 2001
OFFICE OF PETITIONS

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to

Deposit Account Number: 04-1131

Deposit Account Name: Dinnin & Dunn, P.C.

☒ Charge Any Additional Fee Required Under 37 CFR §§ 1 16 and 1 17

☐ Applicant claims small entity status See 37 CFR § 1 27

2. ☒ Payment Enclosed:

☒ Check ☐ Credit card ☐ Money Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
101	710	201	355	Utility filing fee	
106	320	206	160	Design filing fee	
107	490	207	245	Plant filing fee	
108	710	208	355	Reissue filing fee	
114	150	214	75	Provisional filing fee	
				SUBTOTAL (1)	

2. EXTRA CLAIM FEES

	Extra Claims			Fee from below	Fee Paid
Total Claims		-20** =	0	X =	0.00
Independent Claims		- 3** =	0	X =	0.00
Multiple Dependent				=	

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
103	18	203	9	Claims in excess of 20
102	80	202	40	Independent claims in excess of 3
104	270	204	135	Multiple dependent claim, if not paid
109	80	209	40	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) $0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non - English specification	
147	2,520	147	2,520	For filing a request for *ex parte* reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	
117	890	217	445	Extension for reply within third month	
118	1,390	218	695	Extension for reply within fourth month	
128	1,890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,240	241	620	Petition to revive - unintentional	
142	1,240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	130.00
123	50	123	50	Processing fee under 37 CFR § 1 17(q)	
126	180	126	180	Submission of Information Disclosure Statement	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	710	246	355	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR § 1 129(b))	
179	710	279	355	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	
				Other fee (specify) _____	

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) $130.00

SUBMITTED BY

Complete *(if applicable)*

Name (Print/Type)	Michael T. Raggio	Registration No (Attorney/Agent)	36,645	Telephone	(248) 362-2800
Signature	Michael T. Raggio			Date	1/5/01

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on

Burden Hour Statement This form is estimated to take 0 2 hours to complete Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231 DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS SEND TO Assistant Commissioner for Patents, Washington, DC 20231

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 51

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

MAR 02 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte
MITSUBISHI MATERIALS CORPORATION

Appeal No. 2000-2073
Application No. 90/004,386

ON BRIEF

Before HANLON, PAK, and WARREN[1], Administrative Patent Judges.

PAK, Administrative Patent Judge.

REQUEST ON REHEARING

Appellants request a rehearing of the Board's decision entered September 30, 2003, wherein we affirmed the examiner's decision rejecting claims 1 through 14 under 35 U.S.C. § 103.[2]

[1] Administrative Patent Judge Lieberman has retired and Administrative Patent Judge Warren has been substituted. Note, ***In re Bose***, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

[2] This appeal is related to Appeal Nos. 2001-0310, 1999-2411 and 1999-2318, the appeals from the final rejections of the (continued...)

We have carefully considered the arguments raised by the appellants in the Request for Rehearing dated December 1, 2003. However, those arguments do not persuade us that our decision was in error in any respect.

First, the appellants argue (Request for Rehearing, page 1) that:

> There is no evidence in the case to support the Board's finding of an "implicit" fact in either Smith or Hoffmann regarding alternate conveyance of blister copper, nor any basis to find that the term "launder" as used in these references is generic.

However, contrary to the appellants' argument, there is ample evidence to support our factual findings. At page 11 and 12 of the decision entered September 30, 2003, we provided evidentiary support for our factual findings directed to alternate conveyance of blister copper, which are shown below for convenience:

> We find that Smith teaches that "[b]lister copper laundered directly to <u>one</u> of two rotary anode furnaces." See page 57. We find that Hoffmann, like Smith, teaches that "[b]lister copper ... continuously overflows a syphon and is conveyed by launder at the rate of 459 metric tons per day to the anode furnaces." See column 4, lines 58-61. We find that Hoffman also teaches that "[blister copper from the furnace flows directly by heated launder to <u>one</u> of the two anode furnaces." See column 5, lines 11-12. We find that implicit in the

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[2](...continued)
claims pending in Reexamination Control Nos. 90/004,385, 90/004,782 and 90/004,783, respectively.

above teachings of both Smith and Hoffmann is that blister copper is alternately conveyed from a blister copper producing furnace to a plurality of anode furnaces (filling one anode furnace at a time). ***See In re Preda***, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)(In evaluating the content of the prior art references, it is proper to take into account not only the specific teachings of the prior art references, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom)(Underline added and footnote removed).

As also indicated at footnote 7 at pages 11 and 12 of the decision:

> The appellants also do not dispute the examiner's finding that "both the systems of Smith and ...Hoffmann... specifically require a launder structure which would allow for delivery of molten copper products (blister copper) from a single upstream furnace alternately to a plurality of downstream furnaces..."

The appellants cannot now argue that Smith and Hoffmann do not teach such launder structure. See 37 CFR § 1.92(a) (1998).

With respect to evidentiary support for our factual findings directed to the generic use of the term "launders", we found that Smith and Hoffmann, as indicated above, do not limit their launders to either branched or unbranched launders.[3] Thus, it is reasonable to infer from the above teachings that the term "launders" is used generically to include both branched and unbranched launders so

[3] There are only two choices, i.e., branched or unbranched launders.

long as the launders are capable of alternately conveying blister copper from the claimed blister copper producing means to the claimed blister copper refining furnaces (anode furnaces). See the decision entered September 30, 2003, pages 13 and 14.

In reaching this determination, we considered the evidence referred to in the Brief and the McCain declarations. However, we determined that such evidence does not negate the above findings for the reasons indicated at footnote 11 of the decision entered September 30, 2003, which is provided below for convenience:

> According to the appellants, the launders mentioned in Smith should be interpreted as being limited to unbranched launders since the drawings in Exhibits E, F, G, H and I, which are drawn to the same Olympic Dam project as that described in Smith, illustrate only unbranched launders. See the Brief, pages 5 and 26-29. However, we do not read the generic term "launder" used in Smith as being limited to the two unbranched launders illustrated in Exhibits E, F, G, H, and I since Smith does not explicitly limit the launders described therein to an illustrated embodiment. ***See, e.g., In re Lamberti***, 192 USPQ 278, 280 (CCPA 1976) ("all disclosures of the prior art, including unpreferred embodiments, must be considered."). However, even were we to determine that Smith is limited to unbranched launders, the outcome is not altered for two reasons. First, Hoffmann still teaches employing launders in general, inclusive of both branched and non-branched launders. Second, Bibby teaches that its branched launders can perform the same function as unbranched launders, i.e., alternately conveying molten copper from an upstream furnace to a plurality of downstream furnaces, thus providing a suggestion to substitute one for the other.

Second, the appellants argue (Request for Rehearing, page 1) that

> there is no reasonable basis for rejecting the McCain Declarations. That Attorney's comments parallel the declaration [sic., declarations] is to be expected.

Although we noted that the opinions in the McCain declarations were identical or substantially identical to the attorney's arguments, we judged their significance based on their own merits. As indicated at pages 23-27 and 30 of the decision entered September 30, 2003, we determined that the opinions in the McCain declarations were based on "faulty assumptions and incomplete facts" and provided factual support for such determination. We then weighed these opinions, together with the other evidence of record, and determined that the evidence of obviousness, on balance, outweighed the evidence of unobviousness. See the decision entered September 30, 2003, page 30. Thus, notwithstanding the appellants' argument to the contrary, we fully considered and appropriately weighed the McCain declarations in determining the propriety of the examiner's obviousness rejections.

Finally, the appellants argue (Request for Rehearing, page 1) that:

> the Board has imposed its judgment that the claimed combination of elements provides benefits immediately obvious to those skill in the art.

However, our finding is not based on a vacuum, but based on observation of the known branched and unbranched launders taught by the applied prior art references. From this observation, we determined that one of ordinary skill in art would have readily recognized, for example, how many holes in the wall of the blister copper furnace are needed to accommodate a given number of branched or unbranched launders and how many branched or unbranched launders are needed to alternately transport or convey molten copper. Specifically, at pages 14-15 of the decision, we added that:

> In addition to the above suggestion and reasonable expectation success found in the applied prior art references, we determine that simple observation of branched and unbranched launders would have also revealed to one of ordinary skill in the art that the branched launders (having a number of branches attached to the main launder) are more advantageous than the unbranched launders in terms of the cost associated with, ***inter alia***, the length and number of launders needed to convey molten copper from a blister copper producing furnace to a plurality of blister copper refining (anode) furnaces, the number of holes needed in the blister copper producing furnace for a given number of launders and anode furnaces employed and the avoidance of the potential leakage associated with the increased number of holes present in the blister copper producing furnace. ***Compare In re Ludwig***, 353 F.2d 241, 147 USPQ 420 (CCPA 1965). Thus, the economic advantages readily apparent from simple observation of the branched launders taught by Bibby (as opposed to unbranched launders) alone would also have led one of ordinary skill in the art to the claimed subject matter. ***See In re Thompson***, 545 F.2d 1290, 1294, 192 USPQ 275, 277 (CCPA 1976)("Eliminating the cost of the preliminary step of wax impregnation would have been sufficient motivation for doing so."); ***In***

> ***re Clinton***, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976)("Economics alone would motivate a person of ordinary skill in the art...").

This finding is also supported by the appellants' argument which seems to indicate that the alleged advantages are apparent from simple observation of the claimed subject matter. See the decision entered September 30, 2003, page 27.[4]

Even were we to consider this finding to be erroneous, our conclusion would not be altered since there is an additional basis for supporting obviousness within the meaning of 35 U.S.C. 103. Specifically, we found at pages 11-14 of the decision entered September 30, 2003 that both Smith and Hoffman teach employing known launders, inclusive of the branched launders taught by Bibby, to alternately convey molten copper from a blister copper producing furnace to a plurality of blister copper refining (anode) furnaces. As the whole purpose of both the branched and unbranched launders is to convey molten copper from one furnace to another, one of ordinary skill in the art would have looked to the branched launders described in Bibby to improve the transport or conveyance of molten copper from a blister copper producing furnace to a plurality of blister copper refining (anode) furnaces. This is

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[4] See also related appeals, Appeal Nos. 2001-0310 and 1999-2411.

especially true in this case since Bibby specifically teaches that its branched launders are useful for alternately conveying molten copper from an upstream furnace to a plurality of downstream furnaces as required by Smith or Hoffmann.

In view of the foregoing, the appellants' request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

ADRIENE LEPIANE HANLON)
Administrative Patent Judge)
)
)
)
) BOARD OF PATENT
CHUNG K. PAK) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
)
)
CHARLES E. WARREN)
Administrative Patent Judge)

CKP/lp

Appeal No. 2000-2073
Application No. 90/004,386

OBLON, SPIVAC, MCLELLAND
1940 DUKE STREET
ALEXANDRIA, VA 22314

RALPH A. DOWELL
DOWELL AND DOWELL
SUITE 309 1213 JEFFERSON DAVIS HWY.
ARLINGTON, VA 22202

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

FEB 27 2004

PAT & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte
MITSUBISHI MATERIALS CORPORATION

Appeal No. 2000-2073
Application No. 90/004,386

ON BRIEF

Before HANLON, PAK, and WARREN[1], Administrative Patent Judges.

PAK, Administrative Patent Judge.

REQUEST ON REHEARING

Appellants request a rehearing of the Board's decision entered September 30, 2003, wherein we affirmed the examiner's decision rejecting claims 1 through 14 under 35 U.S.C. § 103.[2]

[1] Administrative Patent Judge Lieberman has retired and Administrative Patent Judge Warren has been substituted. Note, ***In re Bose***, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

[2] This appeal is related to Appeal Nos. 2001-0310, 1999-2411 and 1999-2318, the appeals from the final rejections of the (continued...)

We have carefully considered the arguments raised by the appellants in the Request for Rehearing dated December 1, 2003. However, those arguments do not persuade us that our decision was in error in any respect.

First, the appellants argue (Request for Rehearing, page 1) that:

> There is no evidence in the case to support the Board's finding of an "implicit" fact in either Smith or Hoffmann regarding alternate conveyance of blister copper, nor any basis to find that the term "launder" as used in these references is generic.

However, contrary to the appellants' argument, there is ample evidence to support our factual findings. At page 11 and 12 of the decision entered September 30, 2003, we provided evidentiary support for our factual findings directed to alternate conveyance of blister copper, which are shown below for convenience:

> We find that Smith teaches that "[b]lister copper laundered directly to one of two rotary anode furnaces." See page 57. We find that Hoffmann, like Smith, teaches that "[b]lister copper ... continuously overflows a syphon and is conveyed by launder at the rate of 459 metric tons per day to the anode furnaces." See column 4, lines 58-61. We find that Hoffman also teaches that "[blister copper from the furnace flows directly by heated launder to one of the two anode furnaces." See column 5, lines 11-12. We find that implicit in the

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[2](...continued)
claims pending in Reexamination Control Nos. 90/004,385, 90/004,782 and 90/004,783, respectively.

> above teachings of both Smith and Hoffmann is that blister copper is alternately conveyed from a blister copper producing furnace to a plurality of anode furnaces (filling one anode furnace at a time). ***See In re Preda***, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)(In evaluating the content of the prior art references, it is proper to take into account not only the specific teachings of the prior art references, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom)(Underline added and footnote removed).

As also indicated at footnote 7 at pages 11 and 12 of the decision:

> The appellants also do not dispute the examiner's finding that "both the systems of Smith and ...Hoffmann... specifically require a launder structure which would allow for delivery of molten copper products (blister copper) from a single upstream furnace alternately to a plurality of downstream furnaces..."

The appellants cannot now argue that Smith and Hoffmann do not teach such launder structure. See 37 CFR § 1.92(a) (1998).

With respect to evidentiary support for our factual findings directed to the generic use of the term "launders", we found that Smith and Hoffmann, as indicated above, do not limit their launders to either branched or unbranched launders.[3] Thus, it is reasonable to infer from the above teachings that the term "launders" is used generically to include both branched and unbranched launders so

[3] There are only two choices, i.e., branched or unbranched launders.

long as the launders are capable of alternately conveying blister copper from the claimed blister copper producing means to the claimed blister copper refining furnaces (anode furnaces). See the decision entered September 30, 2003, pages 13 and 14.

In reaching this determination, we considered the evidence referred to in the Brief and the McCain declarations. However, we determined that such evidence does not negate the above findings for the reasons indicated at footnote 11 of the decision entered September 30, 2003, which is provided below for convenience:

> According to the appellants, the launders mentioned in Smith should be interpreted as being limited to unbranched launders since the drawings in Exhibits E, F, G, H and I, which are drawn to the same Olympic Dam project as that described in Smith, illustrate only unbranched launders. See the Brief, pages 5 and 26-29. However, we do not read the generic term "launder" used in Smith as being limited to the two unbranched launders illustrated in Exhibits E, F, G, H, and I since Smith does not explicitly limit the launders described therein to an illustrated embodiment. ***See, e.g., In re Lamberti***, 192 USPQ 278, 280 (CCPA 1976) ("all disclosures of the prior art, including unpreferred embodiments, must be considered."). However, even were we to determine that Smith is limited to unbranched launders, the outcome is not altered for two reasons. First, Hoffmann still teaches employing launders in general, inclusive of both branched and non-branched launders. Second, Bibby teaches that its branched launders can perform the same function as unbranched launders, i.e., alternately conveying molten copper from an upstream furnace to a plurality of downstream furnaces, thus providing a suggestion to substitute one for the other.

Second, the appellants argue (Request for Rehearing, page 1) that

> there is no reasonable basis for rejecting the McCain Declarations. That Attorney's comments parallel the declaration [sic., declarations] is to be expected.

Although we noted that the opinions in the McCain declarations were identical or substantially identical to the attorney's arguments, we judged their significance based on their own merits. As indicated at pages 23-27 and 30 of the decision entered September 30, 2003, we determined that the opinions in the McCain declarations were based on "faulty assumptions and incomplete facts" and provided factual support for such determination. We then weighed these opinions, together with the other evidence of record, and determined that the evidence of obviousness, on balance, outweighed the evidence of unobviousness. See the decision entered September 30, 2003, page 30. Thus, notwithstanding the appellants' argument to the contrary, we fully considered and appropriately weighed the McCain declarations in determining the propriety of the examiner's obviousness rejections.

Finally, the appellants argue (Request for Rehearing, page 1) that:

> the Board has imposed its judgment that the claimed combination of elements provides benefits immediately obvious to those skill in the art.

However, our finding is not based on a vacuum, but based on observation of the known branched and unbranched launders taught by the applied prior art references. From this observation, we determined that one of ordinary skill in art would have readily recognized, for example, how many holes in the wall of the blister copper furnace are needed to accommodate a given number of branched or unbranched launders and how many branched or unbranched launders are needed to alternately transport or convey molten copper. Specifically, at pages 14-15 of the decision, we added that:

> In addition to the above suggestion and reasonable expectation success found in the applied prior art references, we determine that simple observation of branched and unbranched launders would have also revealed to one of ordinary skill in the art that the branched launders (having a number of branches attached to the main launder) are more advantageous than the unbranched launders in terms of the cost associated with, ***inter alia***, the length and number of launders needed to convey molten copper from a blister copper producing furnace to a plurality of blister copper refining (anode) furnaces, the number of holes needed in the blister copper producing furnace for a given number of launders and anode furnaces employed and the avoidance of the potential leakage associated with the increased number of holes present in the blister copper producing furnace. ***Compare In re Ludwig***, 353 F.2d 241, 147 USPQ 420 (CCPA 1965). Thus, the economic advantages readily apparent from simple observation of the branched launders taught by Bibby (as opposed to unbranched launders) alone would also have led one of ordinary skill in the art to the claimed subject matter. ***See In re Thompson***, 545 F.2d 1290, 1294, 192 USPQ 275, 277 (CCPA 1976)("Eliminating the cost of the preliminary step of wax impregnation would have been sufficient motivation for doing so."); ***In***

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This finding is also supported by the appellants' argument which seems to indicate that the alleged advantages are apparent from simple observation of the claimed subject matter. See the decision entered September 30, 2003, page 27.[4]

Even were we to consider this finding to be erroneous, our conclusion would not be altered since there is an additional basis for supporting obviousness within the meaning of 35 U.S.C. 103. Specifically, we found at pages 11-14 of the decision entered September 30, 2003 that both Smith and Hoffman teach employing known launders, inclusive of the branched launders taught by Bibby, to alternately convey molten copper from a blister copper producing furnace to a plurality of blister copper refining (anode) furnaces. As the whole purpose of both the branched and unbranched launders is to convey molten copper from one furnace to another, one of ordinary skill in the art would have looked to the branched launders described in Bibby to improve the transport or conveyance of molten copper from a blister copper producing furnace to a plurality of blister copper refining (anode) furnaces. This is

[4] See also related appeals, Appeal Nos. 2001-0310 and 1999-2411.

especially true in this case since Bibby specifically teaches that its branched launders are useful for alternately conveying molten copper from an upstream furnace to a plurality of downstream furnaces as required by Smith or Hoffmann.

In view of the foregoing, the appellants' request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

ADRIENE LEPIANE HANLON)
Administrative Patent Judge)
)
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) BOARD OF PATENT
CHUNG K. PAK) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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CHARLES E. WARREN)
Administrative Patent Judge)

CKP/lp

Appeal No. 2000-2073
Application No. 90/004,386

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ARLINGTON, VA 22202

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
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Washington, D.C. 20231

#30
(mar 9/28/00

Robert F. Conte (For Patent Owner)
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MAILED
SEP 28 2000
REEXAM UNIT

In re reissue application of Kotzab Application No. 09/330,356 Filed: June 7, 1999 For: U.S. Patent No. 5,427,720	:	DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS
In re Kotzab Reexamination Proceeding Control No. 90/004,441 Filed: November 4, 1996 For: U.S. Patent No. 5,427,720	:	

The above noted reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,427,720 issued to Kotzab on June 27, 1995, and a Certificate of Correction was issued for the '720 patent on November 7, 1995.

2. On November 4, 1996, a request for reexamination of the '720 patent was filed by a third party requester, and it was assigned Control No. 90/004,441.

3. On January 9, 1997, reexamination was ordered.

4. *Ex parte* prosecution was conducted in the reexamination proceeding, during which claim 1 was amended and claim 10 was added. All of the claims, i.e., claims 1-10, were finally rejected, and on September 29, 1997, patent owner appealed to the Board of Patent Appeals and Interferences (BPAI). The BPAI affirmed all rejections in its decision mailed July 15, 1998.

5. On January 21, 1999, patent owner appealed the BPAI's decision to the Court of Appeals for the Federal Circuit (CAFC).

6. On June 7, 1999, a reissue application was filed and assigned application no. 09/330,356, In the application, amendment was made to cancel claims 1-8, revise claim 9, and add new claims 10-17.

7. A notice of the reissue filing was published in the *Official Gazette* on October 19, 1999. A first Office action has not yet been issued in the reissue application.

8. The CAFC reversed the BPAI's decision in the reexamination proceeding, issuing its mandate on August 21, 2000.

DOCKET ALARM

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue application shows that no Office action has yet been issued, but the claims of the application have been amended. A review of the reexamination file shows that reexamination was ordered on January 9, 1997, and is awaiting termination based upon the CAFC's mandate of August 21, 2000, reversing the affirmance of the BPAI. Amendments have been filed in the reexamination proceeding. Accordingly, the claims are not identical in both proceedings.

In order to provide efficient and prompt handling of both proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceeding be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination will be merged in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-noted reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

I. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and the reexamination files for purposes of the merged proceeding. This maintenance of identical amendments in the two files is required as long as the proceedings remain merged. See 37 CFR § 1.565(d).

2. A proposed housekeeping amendment **must be filed within ONE (1) month of the mailing date of this decision**, to thereby place the same amendments in both cases.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that a housekeeping amendment is not timely submitted, any claim that does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to both the reissue application and the reexamination proceeding. Each action will contain identifying data *for both* the reissue application and the reexamination proceeding, and each action will be physically entered into both files (which will be maintained as separate files).

Declassified

5. Any response by the applicant/patent owner must consist of a single response, filed in duplicate, each bearing a signature, for entry in both files.

6. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissued patent, and the reissued patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.

7. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned. The Commissioner will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings.

8. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improper broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions remaining which cannot be considered under reexamination following dissolution of the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

9. Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 CFR 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continuation of prosecution of the reexamination proceeding.

90004441 - 20040506

CONCLUSION

1. The above-noted reissue application and reexamination proceeding ARE MERGED.

2. A housekeeping amendment **must be filed within ONE (1) month of the mailing date of this decision,** to place the same amendments in both the reissue application and reexamination proceeding.

3. The reissue and reexamination files are being forwarded to the examiner via the Director of Technology Center 1700. The examiner should issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding **after** the earlier of (a) the submission of the housekeeping amendment to place the same amendments in both cases or (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.

4. All further examination should be conducted in accordance with Part III of this decision.

5. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)306-5682.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

September 27, 2000
C:\KIVA\KENPET3\4441LYN.MER

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/330,356	06/07/99	Werner Kotzab	6504-1144.3

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,427,720	09/28/00	31

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/ 004,441 Filing Date: 11/04/96

Requester (name, address) Albert O. Cota
5460 White Oak Avenue
Suite A-331
Encino, CA 91316

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/004,441, filed 11/04/96, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

90004441 11/04/96

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DISSOLVED AS OF 6-7-2005

LEA/GAD

#88

A. Jason Mirabito (For Patent Owner)
Thomas M. Sullivan
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
One Financial Center
Boston, MA 02111

MAILED
AUG 26 1999
REEXAM UNIT

Walter E. Hanley, Jr. (For Requester)
Kenyon & Kenyon
One Broadway
New York, NY 10004

DECISION

In re reissue application of :
Peters, et al. :
Serial No. 08/418863 :
Filed: April 7, 1995 :
For: U.S. Patent No. 5,045,940 : DECISION, SUA SPONTE, TO MERGE
: REEXAMINATION AND
In re Peters, et al. : REISSUE PROCEEDINGS
Reexamination Proceeding :
Control No. 90/004,520 :
Filed: January 10, 1997 :
For: U.S. Patent No. 5,045,940 :
:
In re Peters, et al. :
Reexamination Proceeding :
Control No. 90/004,895 :
Filed: October 31, 1997 :
For: U.S. Patent No. 5,045,940 :

In re Peters, et al. :
Reexamination Proceeding :
Control No. 90/005,274 :
Filed: February 16, 1999 :
For: U.S. Patent No. 5,045,940 :

The above noted reexamination files and reissue application are before the Office of the Deputy Assistant Commissioner for Patent Policy and Projects, sua sponte, for a decision on whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,045,940 issued September 3, 1991.

2. On September 3, 1993, a first reissue application was filed.

3. On April 7, 1995, a file-wrapper continuation of the first application for reissue of the '940 patent was filed. Since the file-wrapper continuation reissue application is the only reissue application remaining, it will hereinafter be referred to simply as "the reissue application." The reissue application includes newly added claims 68 - 100 and 102 - 114, in addition to the claims 1 - 16, the number of claims originally in the patent.

4. On January 10, 1997, a request for reexamination of the patent was filed by a third party, Media 100, Inc.

5. On March 11, 1997, reexamination was ordered.

6. On April 26, 1997, Reissue Application No. 08/418,863 and Reexamination Proceeding Control No. 90/004,520 were merged.

7. On July 25, 1997, an Office action was mailed in which all claims were rejected.

8. On October 31, 1997, a second request for reexamination of the patent was filed by the third party, Media 100, Inc. (Reexamination Proceeding Control No. 90/004,895).

9. On January 27, 1998, reexamination was ordered in Reexamination Proceeding Control No. 90/004,895.

10. On April 13, 1998, Reissue Application No. 08/418,863 and Reexamination Proceedings Control Nos. 90/004,520 & 90/004, 895 were merged.

11. On February 16, 1999, a third request for reexamination of the patent was filed by third party, Media 100, Inc.

12. On April 27, 1999, reexamination was ordered in Reexamination Proceeding Control No. 90/005,274.

DISCUSSION

Under 37 CFR § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the three reexamination proceeding are currently pending. As the order to reexamine has been mailed in the third reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reasons for this policy is to prevent inconsistent, and possible conflicting amendments from being introduced into the two proceedings on behalf of the patent owner. Normally the proceedings will be merged whenever it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the proceedings consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue prosecution history shows that the announcement of the filing of the reissue application was published in the Official Gazette on August 15, 1995, thereby permitting the issuance of a first action on the merits after October 15, 1995. 37 CFR § 1.176. New claims have been added in the reissue application. A review of the Control No.90/005,274 reexamination file shows that the reexamination is awaiting an Office action by the examiner.. The original specification, drawings and patent claims are presently in the '274 reexamination file. The claims are not identical in all four proceedings. In order to provide efficient and prompt handling of all four proceedings and to prevent inconsistent, and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexaminations will be in accordance with the decision set forth below.

DECISION

I. Merger of Proceedings

The above noted reissue and reexamination proceedings are, sua sponte, merged. A joint

examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination files for purposes of the merged proceedings. The maintenance of identical amendments in the four files is required as long as the proceedings are merged. See 37 CFR § 1.565(d). An appropriate housekeeping amendment is required within one month of this decision placing the same amendments in all four proceedings. The patent owner should not address the issues of any of the proceedings in the housekeeping amendment.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

In view of the fact that the statutory provisions for reissue application examination include, inter alia, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader reissue application examination. The examiner will apply the reissue statute, rules and case law to the merged proceeding. The examiner's actions will take the form of a single action which jointly applies to both the reissue application and the reexamination proceedings. The action will contain identifying data for all of the reissue application and the reexamination proceedings and will be physically entered into all four files which will be maintained as separate files. Any response by the applicant/patent owner must consist of a single response, filed in quadruplicate, each bearing an original signature, for entry in the four files. Any such responses must be served on the requester who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned and the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged (reissue and reexamination) proceeding and continue the three reexamination proceedings (which will remain merged). Any grounds of rejection which are not applicable under reexamination should be withdrawn (e.g., based on public use or sale) and any new grounds of rejection which are applicable under reexamination (e.g., improper broadened claims) should be made by the examiner upon dissolution of the merged (reissue and reexamination) proceeding. The existence of any questions remaining which cannot be considered under reexamination following dissolution of the merged (reissue and reexamination) proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

If the reissue application ultimately matures into a reissue patent the reexamination proceedings shall be terminated by the grant of the reissued patent and the reissued patent will also serve as the certificate under § 1.570. See MPEP 2285.

Applicant/patent owner is advised that the filing of any continuation reissue application under 37 CFR § 1.53 will most likely result in the dissolution of the merged (reissue and reexamination) proceeding, a stay of the continuing reissue application, and separate, continued prosecution of the current merged reexamination proceedings.

IV. Remand for Examination

The above noted reissue application and reexamination proceedings are merged. The reissue application and the reexamination files are being forwarded to the Technology Center 2700 for examination in accordance with this decision.

Inquiries concerning this decision should be directed to the undersigned at (703)305-9285.

Lawrence E. Anderson
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

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REEXAM UNIT

In re Peters, et al.
Reexamination Proceeding
Control No. 90/004,520
Filed: January 10, 1997
For: U.S. Patent No. 5,045,940

In re Peters, et al.
Reexamination Proceeding
Control No. 90/004,895
Filed: October 31, 1997
For: U.S. Patent No. 5,045,940

In re Peters, et al.
Reexamination Proceeding
Control No. 90/005,274
Filed: February 16, 1999
For: U.S. Patent No. 5,045,940

In re Reissue Application of
Peters, et al.
Application No. 09/971,236
Filed: October 4, 2001
For: U.S. Patent No. 5,045,940

In re Reissue Application of
Peters, et al.
Application No. 08/418,863
Filed: April 7, 1995
For: U.S. Patent No. 5,045,940

DECISION, *SUA SPONTE*, DISSOLVING AND MERGING REISSUE AND REEXAMINATION PROCEEDINGS

The above reissue and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of:

(1) Whether the August 26, 1999 merger of reexamination Control Nos. 90/004,520, 90/004,895, and 90/005,274, and reissue Application No. 08/418,863, should be dissolved at this time; and

(2) Whether reexamination Control Nos. 90/004,520, 90/004,895, and 90/005,274 should, at this time, be merged under 37 CFR 1.565(d) with reissue Application No. 09/971,236.

REVIEW OF FACTS

1. U.S. patent No.5,045,940 (hereinafter, the '940 patent) issued on September 3, 1991, with 16 claims.

2. On September 3, 1993, an application for reissue of the '940 patent was filed, and was assigned application number 08/418,863 (hereinafter, the '863 application).

3. On April 7, 1995, a file-wrapper continuation of the'863 application was filed. The file-wrapper continuation application included newly added claims 68-100 and 102-114, in addition to original claims 1-16 of the '940 patent.

4. A first request for reexamination was filed by a third party requester on January 10, 1997, and the resulting proceeding was assigned control number 90/004,520 (hereinafter, the '4520 proceeding).

5. An order for reexamination of the '4520 proceeding was mailed on March 11, 1997.

6. On April 26, 1997, the '863 reissue application and the '4520 reexamination proceeding were merged.

7. On July 25, 1997, an Office action was mailed for the merged proceeding; all claims were rejected.

8. A second request for reexamination was filed by the third party requester on October 31, 1997, and the resulting proceeding was assigned control number 90/004,895 (hereinafter, the '4895 proceeding).

9. An order for reexamination of the '4895 proceeding was mailed on January 27, 1998.

10. On April 26, 1997, the '863 reissue application and the '4520 and '4895 reexamination proceedings were merged.

11. A third request for reexamination was filed by the third party requester on February 16, 1999, and the resulting proceeding was assigned control number 90/005,274 (hereinafter, the '5274 proceeding).

12. An order for reexamination of the '5274 proceeding was mailed on April 27, 1999.

13. On August 26, 1999, the '863 reissue application and the '4520, '4895, and '5274 reexamination proceedings were merged.

14. Prosecution for the merged proceeding progressed to the point where the examiner's final rejection of the proceeding claims was affirmed by the Board of Patent Appeals and Interferences.[1] The affirmance was appealed to the U.S. Court of Appeals for the Federal Circuit, and the decision of the Board was affirmed by the Federal Circuit.

15. On October 4, 2001, an application for reissue of the '940 patent was flled, and was assigned application number 09/971,236 (hereinafter, the '236 application).

16. The filing of the '236 reissue application was announced in the *Official Gazette* on June 11, 2002.

17. Three preliminary amendments were filed for the '236 reissue application, the last one on December 13, 2004.

18. On May 20, 2005, a Notice of Abandonment was mailed for the '863 reissue application. The Notice stated that the application was abandoned "In view of decision by CAFC, which all claims are affirmed."

DECISION DISSOLVING MERGER OF '863 APPLICATION AND '4520, '4895, AND '5274 PROCEEDINGS

As noted above, the '863 reissue application has been abandoned, based upon the decision by the Federal Circuit affirming the Board. Since the '863 reissue application is now abandoned, the August 26, 1999 merger of '863 reissue application and the '4520, '4895, and '5274 proceedings is hereby dissolved.

Based on the October 4, 2001 filing of the '236 reissue application for the '940 patent, and the announcement of the

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[1] The pending claims that went up on appeal were original patent claims 3 and 7-16, and new claims: 68, 70, 74-84, 86, 87, 89, 93-98, 100, 102-115, 119-148, 150, 154-160. All of the above "pending" claims were finally rejected by the examiner, and the examiner was affirmed on all rejections of these claims.

'236 reissue application in the *Official Gazette*, further action with respect to the three reexamination proceedings will be taken as discussed in the sections of this decision which follow.

DISCUSSION REGARDING MERGER OF '236 APPLICATION AND '4520, '4895, AND '5274 PROCEEDINGS

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, the '236 reissue and the '4520, '4895, and '5274 proceedings are currently pending. Since the order to reexamine has been mailed in all of the reexamination proceedings (and the '236 application has been announced in the *Official Gazette*), a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. In making a decision on whether or not to merge the proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In the present instance, the '236 reissue application was filed prior to the date on which the three reexamination prosecutions would have terminated based on the Court's affirmance of the Board's decision (affirming the rejection of all the claims in the reexamination proceedings). If the three reexamination prosecutions were now terminated by the Office and a reexamination certificate was permitted to issue, then the provisions of 37 CFR 1.570(d) would apply as follows:

> "If an *ex parte* reexamination certificate has been issued which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto."

Given that the '236 reissue application was filed prior to the date on which the three reexamination prosecutions would have terminated, it would be inequitable to now terminate the three reexamination prosecutions and issue a reexamination certificate. Such a certificate would result in the barring of the '236 reissue application, even though the '236 application was filed prior to the date on which the three reexamination prosecutions would have terminated. In order to prevent this inequity, and, at the same time prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner (for the reissue and reexamination proceedings), it is appropriate that the instant '236 reissue application and the '4520, '4895, and '5274 reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the '236 reissue application and the three reexamination proceedings will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. *The present merger is not an assurance that, in a future similar situation, merger would be ordered, since each merger question [2] is considered on a case-by-case basis governed by the given fact situation for the merger question to be considered.*

DECISION MERGING THE '236 REISSUE APPLICATION AND '4520, '4895, AND '5274 REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The'236 reissue application and the'4520, '4895, and '5274 reexamination proceedings are hereby **merged** into a single proceeding (hereinafter, "the merged proceeding"). A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings and to Provide Formal Amendments

1. The patent owner is required to maintain identical amendments in the reissue application and the

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[2] I.e. each decision of whether to merge or supend, or take other appropriate action.

reexamination proceedings for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

A review of the '236 reissue application shows that all of the original patent claims, i.e., claims 1-16, are cancelled, and new claims 17-88 are present. A review of the files for the three reexamination proceedings shows the following claim status:

Pending patent claims: 3 and 7-16.
Canceled patent claims: 1, 2, and 4-6.
Pending new claims: 68, 70, 74-84, 86, 87, 89, 93-98, 100, 102-115, 119-148, 150, 154-160.
Canceled new claims: 17-67, 69, 71-73, 85, 88, 90-92, 99, 101, 116-118, 149, 151-153.

Accordingly, the claims are not identical in both proceedings.

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the same amendments in all of cases.

2. For a merged proceeding of a reissue application and an *ex parte* reexamination proceeding, MPEP 2285 states:

> "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Accordingly, the filing of amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted.* Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

The December 13, 2004 amendment (confirmation copy filed January 31, 2005) submitted in the '236 reissue application fails to comply with the above. For example, claim 62 uses strike through for "signalling." Also, the text of claims 17-72 is not underlined in its entirety, even though those claims are new to the '940 patent.

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the amendments in all of cases in the form required by 37 CFR 1.173.

3. The response to these requirements must be limited to placing the same amendments in all cases and providing the amendments in the form required by the rules. The patent owner must **not** address any issue of patentability in the housekeeping amendment.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that an appropriate housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the '236 reissue application and the three reexamination proceedings. Each action will contain identifying data *for all of the cases*, i.e, the '236 reissue application and the three reexamination

proceedings, and each action will be entered into all files (which will be maintained as separate files). Note that there will **not** be any identifying data nor entry of papers for the '863 reissue application, since the '863 reissue application has been held abandoned, and is no longer merged within the present merged proceeding.

5. Any response by the applicant/patent owner must consist of a single response, with four copies being filed for entry in the four files, with each of the four bearing a signature. Any such response must contain identifying data *for all of the cases*, i.e, the '236 reissue application and the three reexamination proceedings. *Any such responses must be served on the requester*, who will also be sent copies of Office actions. Note that there will **not** be any identifying data nor providing of papers for the '863 reissue application, since the '863 reissue application has been held has been held abandoned, and is no longer merged within the present merged proceeding.

6. Pursuant to MPEP 2285:

> "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Thus, as pointed out above, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does <u>not</u> apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Also as pointed out above, pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appeal brief, even though the brief relates to the merged multiple proceedings, and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

8. Upon return of the present merged proceeding to the examiner, the examiner (a) will review the files to ensure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as are necessary as part of the next Office action in order to place the files in that condition.

9. If the reissue application ultimately matures into a reissue patent, the three reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed, e.g., as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which could not be considered under reexamination following the dissolution would be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceedings. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. The August 26, 1999 merger of '863 reissue application and the '4520, '4895, and '5274 proceedings is dissolved.

2. The '236 reissue application and the '4520, '4895, and '5274 reexamination proceedings **are merged** into a single proceeding.

3. Pursuant to Part II of this decision, it is required that applicant/patent owner file, **within ONE MONTH of this decision**, a housekeeping amendment (A) placing the same amendments in all cases of the present merged proceeding and (B) placing the amendments in the form required by 37 CFR 1.173.

4. The reissue and reexamination proceedings are being forwarded to the examiner via the Director of Technology Center 2600. Upon receipt of same, the examiner **should not issue an Office action for the present merged proceeding of the '236 reissue and reexamination proceedings until after the earlier of** (a) the submission of the housekeeping amendment to place the same amendments in both cases and formalize the amendment or (b) the expiration of the one month period from the mailing of this decision for filing the amendment.

5. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

6. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

June 6, 2005
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Paper No. 38

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(For Patent Owner)

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29 MAY 2002

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In re Joram Agar
Reexamination Proceeding
Control No. 90/004,524
Filed: January 22, 1997
For U.S. Patent No. 4,774,680

In re Joram Agar
Reexamination Proceeding
Control No. 90/006,236
Filed: March 6, 2002
For U.S. Patent No. 4,774,680

DECISION MERGING REEXAMINATION PROCEEDINGS

The above-identified reexamination files are before the Group Director of Examining Group 2850, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 4,774,680 issued on September 27, 1988.

2. A first request for reexamination, Control No. 90/002,684, was filed by the patent owner on March 27, 1992.

3. Reexamination was ordered for the '2684 reexamination proceeding on May 20, 1992.

4. A first Reexamination Certificate B1-4,774,680 was issued October 12, 1993, with the patentability of claims 1 through 16 being confirmed and new claims 17 through 34 being allowed.

5. A second request for reexamination, Control No. 90/004,524, was filed by the third party requester on January 22, 1997.

6. Reexamination was ordered for the '4524 reexamination proceeding on April 8, 1997.

7. A first Office action was issued on January 27, 1998, wherein the patentability of claims 22, 23, 32 and 33 was confirmed and claims 1-21, 24-31 and 34 were rejected as being unpatentable.

8. An amendment was filed on March 11, 1998, amending claims 2 through 6 and 14 through 16.

9. A second Office action was issued May 22, 1998, wherein the patentability of claims 1 through 21, 24 through 31 and 34 was confirmed and claims 22, 23, 32 and 33 were rejected as being unpatentable.

10. A response was filed on July 20, 1998, and supplemented on July 24, 1998. No amendment was made to the claims.

11. A final rejection was issued on September 23, 1998, wherein claims 22, 23, 32 and 33 were finality rejected and the patentability of claims 1 through 21, 24 through 31 and 34 was confirmed.

12. A Notice of Appeal was filed on November 23, 2000.

13. An Appeal Brief was filed on January 20, 1999.

14. An Examiner's Answer was mailed on December 2, 1999.

15. A Reply Brief was filed on January 24, 2000.

16. A Response to The Reply Brief was mailed on April 25, 2000.

17. A decision on appeal was issued on August 22, 2000, affirming the final rejections of claims 22, 23, 32 and 33.

18. A Request for Rehearing was filed on October 25, 2000.

19. The Request for Rehearing was denied in a decision mailed November 22, 2000.

20. An Appeal to the Federal Circuit was filed on January 9, 2001.

21. An Appeal Brief was filed by the patent owner/appellant April 27, 2001.

22. A corrected Appeal Brief was filed by the patent owner/appellant on May 15, 2001.

23. An Appeal Brief by the Director of the USPTO/Appellee was filed on June 25, 2001.

24. A Reply Brief by the patent owner/appellant was filed July 25, 2001.

25. A third request for reexamination, control No. 90/006,236, was filed on March 6, 2002, by the patent owner along with an amendment to claims 2 and 15.

26. Reexamination was ordered for the '6236 reexamination on April 5, 2002.

27. A joint motion to remand the '4943 reexamination proceeding was made to the Federal Circuit.

28. The '4943 reexamination proceeding was remanded to the USPTO in a decision, issued April 10, 2002, granting the joint motion to remand.

29. Both the '4943 and '6236 reexamination proceedings are now pending in front of the USPTO. A statement by the patent owner pursuant to 37 C.F.R. § 1.530(b) was not received for the '6236 reexamination proceeding.

90004524.052902

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '4524 and '6236 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Three Proceedings.

As noted above, the claims have been amended in the '4524 and '6236 reexamination proceedings. The claims in the '4524 reexamination proceeding are not the same as the claims in the '6236 reexamination proceeding. The patent owner is required to maintain the same claims and specification in both files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All

papers filed by the patent owner must consist of a single response, filed duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos.'4524 and '6236 are merged. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

Henry Phan for
Howard N. Goldberg, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

90004524.052902

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March 2005

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(Courtesy Copy)

In re Larry Wolfberg et al.
Reexamination Proceeding
Control No. 90/004,583
For: U.S. Patent No. 4,968,993
Issued: November 6, 1990

DECISION VACATING "DECISION ON REQUEST TO WITHDRAW FROM RECORD"

This is a decision (a) vacating the April 17, 2002 decision on the request to withdraw as attorney/agent of record filed on September 26, 1997, (b) vacating the April 17, 2002 Office communication, and (c) re-mailing the Office action mailed on April 22, 2002. This decision is being issued in place of the April 17, 2002 decision and communication.

BACKGROUND

1. U.S. Patent No. 4,968,993 (the '993 patent) issued on November 6, 1990.

2. A first reexamination of the '993 patent (assigned control No. 90/002,792) resulted in a Reexamination Certificate which: confirmed the patentability of claims 1-7, 9-14 and 20-30; cancelled claim 8; determined claims 15 and 17 to be patentable as amended; and determined claims 16 and 18-19, dependent on an amended claim, to be patentable.

3. The present request for reexamination of U.S. Patent No. 4,968,993 was filed by a third party requester on March 17, 1997, and it was assigned control No. 90/004,583.

4. Reexamination was ordered for the '583 reexamination proceeding on June 11, 1997, and the prosecution then progressed to the point where an Office action was issued on February 6, 1998.

5. In an Office decision dated August 6, 1998, the February 6, 1998 Office action was vacated, and the instant reexamination proceeding was suspended pending disposition of the patent rights in a bankruptcy proceeding in which the rights to the patent would be considered.

6. A request was filed on September 26, 1997, by a Mr. Thomas H. Jackson, to withdraw as an attorney of record. Mr. Jackson was never made an attorney/agent of record in the patent being reexamined, nor in the instant reexamination proceeding.

7. On April 8, 2002, the undersigned conducted separate conversations with Robert M. Yaspan (bankruptcy attorney) and Nancy Knupfer (trustee for the bankruptcy estate). Based upon the conversation with Mr. Yaspan, it is the understanding of the undersigned that Mr. Yaspan has transferred all his papers concerning the above-identified patent to Ms. Knupfer (telephone number: (310) 277-0077). Based upon the conversation with Ms. Knupfer, it is the understanding of the undersigned that the bankruptcy estate has legally abandoned the rights to the patent back to the debtors, Laurance & Carolyn Wolfberg. Ms. Knupfer gave the present address of Laurance & Carolyn Wolfberg as:

> 575 S. Barrington Avenue, Suite 206
> Los Angeles, CA 90049

8. On April 15, 2002, Ms. Knupfer sent the undersigned, via facsimile transmission, a copy of the Order authorizing the trustee for the estate of Laurance and Carolyn Wolfberg to abandon the estate's interest in the patent.

9. On April 17, 2002, a decision was issued on the request to withdraw filed by Mr. Thomas H. Jackson. The decision dismissed the request because as noted above Mr. Jackson was not an attorney of record. However, the decision also stated that the reexamination proceeding currently has no attorney of record representing the patent owner.

10. An Office communication was also sent on April 17, 2002 which indicated the resumption of prosecution in the reexamination proceeding, "[s]ince the part of the bankruptcy proceeding concerning the patent rights [was] concluded." It was stated in the communication as follows:

> "Based upon this Order [the copy received April 15, 2002] and the conversation with Ms. Knupfer, it is the understanding of the undersigned that at least part ownership of the legal rights to the patent is back with the first-named inventor Laurance Wolfberg....

> "Since the patent owner has no attorney of record, the correspondence address for the patent owner is being designated as that noted above for Laurance Wolfberg. All future communications from the Office will be directed to Laurance Wolfberg at the address indicated above unless otherwise notified by the patent owner."

The communication further stated that the file of the reexamination proceeding was being forwarded to the Technical Support Staff of Technology Center 2800 for the re-mailing of the Office action dated February 6, 1998.

11. Pursuant to the April 17, 2002 communication, the February 6, 1998 Office action was re-mailed April 22, 2002. Patent claims 1-7, 9-11 and 13-30 stand rejected, and patent claim 12 stands confirmed (claim 8 was cancelled in the first reexamination proceeding).

DECISION

I. The April 17, 2002 decision and communication are vacated:

The April 17, 2002 decision and communication (copies attached) each stated that the reexamination proceeding currently has no attorney of record representing the patent owner. This statement was inaccurate, because the attorneys/agents of record in application No. 07/323,399, now U.S. Patent No. 4,968,993 (the patent being reexamined) were never revoked nor withdrawn from the record. Thus, they remain the attorneys/agents of record in the reexamination proceeding. A copy of the Power of Attorney filed in application No. 07/323,399 is attached, and provides a listing of the attorneys of record. The address of record for the instant reexamination proceeding is:

Banner and Witcoff, LTD.
1001 G Street, N.W., 11th Floor
Washington, D.C. 20001

All future correspondence in the instant proceeding will be directed to the attorneys/agents of record at that address.

In view of the incorrect statement as to representation and incorrect correspondence address in the April 17, 2002 decision and communication , the April 17, 2002 decision and communication are hereby vacated. The present decision is issued in their place.

II The Patent Owner to be recognized in the proceeding:

The Office has the following records pertaining to the ownership of U.S. Patent No. 4,968,993:

On April 28, 1989, the inventors Larry Wolfberg and John Harper assigned the patent to L & C Family Partnership. On September 30, 1994, L & C Family Partnership and Advanced Printing Technology, LTD. (as joint assignors) assigned the patent to Advanced Licensing Limited Partnership. The record does not contain the assignment document by which Advanced Printing obtained its share of the patent; however, the assignment of September 30, 1994 indicated that

L& C Family Partnership had assigned the patent to Advanced Printing Technology, LTD. effective December 29, 1993. [1]

A 37 CFR 1.132 declaration by Nancy Knupfer (Post Confirmation Chapter 11 Trustee, In Re: Laurance and Carolyn Wolfberg, Debtors, Bankruptcy No. LA 97-37307) was filed on November 6, 2000. According to the declaration, the Advanced Licensing Limited Partnership had dissolved and therefore all of its assets were the assets of the bankruptcy Estate. A copy of a Court Order from the United States Bankruptcy Court Central District of California Los Angeles Division dated March 16, 2001 and entitled "ORDER AUTHORIZING TRUSTEE TO ABANDON PATENTS, CLAIMS AGAINST XEIKON NV VREDEBAAN AND CERTAIN OTHER ASSETS" was filed via facsimile transmission on April 15, 2002.

As noted in the communication from the undersigned mailed on April 17, 2002 , it is his understanding that the bankruptcy Estate legally abandoned its rights to the patent back to the debtors Laurance and Carolyn Wolfberg. As also noted in the communication, it is the understanding of the undersigned that at least part ownership of the legal rights to the patent is with the first-named inventor Larry Wolfberg (also known as Laurance Wolfberg). More specifically, it is his understanding that the Advanced Licensing Limited Partnership has dissolved, and the ownership of the legal rights to the patent has reverted back to the inventors Larry Wolfberg and John Harper.

A "Statement of Facts Re Ownership from Inventor" signed by Laurance Wolfberg filed via facsimile transmission on July 30, 2002 notes that inventor John Harper passed away. A copy of a Death Certificate included with the statement of facts indicates that John Harper passed away on November 11, 1996. Thus, the ownership of the legal rights to the patent would be with Larry Wolfberg **and** the estate of John Harper. In order for Larry Wolfberg to be considered as sole patent owner with 100% of the patent rights, a paper would need to be filed by the personal representative of the estate of John Harper stating that the estate relinquishes any legal rights it has to U.S. Patent No. 4,968,993 to Larry Wolfberg.

In summary, Larry Wolfberg and the estate of John Harper are deemed to be the joint patent owners in the instant proceeding.

III. Further conduct of the proceeding:

The Office action originally mailed on February 6, 1998 and then remailed on April 22, 2002, was not mailed to the Banner and Witcoff, LTD address; thus, it was mailed to an incorrect address. Accordingly, the Office action is being remailed with this decision to the Banner and Witcoff, LTD address. The two month period for response to the Office action will be restarted to run from the mail date of this decision.

Any response to the remailed Office action must be made by an attorney or agent of record, 37 CFR 1.33(b)(1), or by a registered patent attorney/agent acting in a representative capacity in accordance with 37 C.F.R. § 1.33(b)(2). In the event the power of attorney to the registered patent attorney(s)/agent(s) is duly revoked or withdrawn, any response must be made by **both** of the joint patent owners, in which 100% of the patent rights are legally vested. As pointed out

[1] On October 25, 1995, Advance Licensing Limited Partnership granted a non-exclusive license to Xeikon NV (the third party requester in the instant reexamination proceeding).

above, Larry Wolfberg and the estate of John Harper are deemed to be the joint patent owners in the instant proceeding; thus both would be required to join in any response, in the event that the power of attorney to the registered patent attorney(s)/agent(s) is duly revoked or withdrawn.

It is to be noted that the patent on which this reexamination proceeding is based has expired due to nonpayment of maintenance of maintenance fees under 37 CFR 1.362. It is now too late under 37 CFR 1.378(c) for the filing of an acceptable petition under 37 CFR 1.378(a) for acceptance of delayed payment of the maintenance fee to reinstate the patent. Accordingly, no amendment can be made to the patent specification, claims or drawings in this reexamination proceeding, other than the cancellation of claims. This reexamination proceeding will either result in the confirmation or the cancellation of the patent claims.

CONCLUSION

1. The April 17, 2002 decision and the April 17, 2002 communication are hereby vacated, and the present decision is issued in their place.

2. The attorneys listed in the attached copy of the Power of Attorney filed in application No. 07/323,399 are recognized as the attorneys of record for patent owner in the proceeding. All future correspondence for the instant reexamination proceeding will be mailed to Banner and Witcoff, LTD, at the above address.

3. The Office action originally mailed on February 6, 1998 and then remailed on April 22, 2002, is being remailed with this decision to the Banner and Witcoff, LTD address. **A TWO MONTH period for response to the Office action is set to run from the mail date of this decision.**

4. Any inquiries concerning this decision should be directed to Edward Westin at (571) 272-1638.

Edward Westin

Edward P. Westin, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and
Optical Systems, and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 12

Laurance Wolfberg (For Patent Owner)
575 S. Barrington Avenue, Suite 206
Los Angeles, CA 90049

MAILED

APR 17 2002

TECHNOLOGY CENTER 2...
SPECIAL PROGRAM CENTER

James J. Maune (For Requester)
Brumbaugh, Graves, Donohue & Raymond
30 Rockefeller Plaza
New York, NY 10112

DO NOT ENTER

In re Wolfberg et al. :
Reexamination Proceeding :
Control No. 90/004,583 : COMMUNICATION
Filed: March 19, 1997 :
For: U.S. Patent No. 4,968,993 :

On April 8, 2002, the undersigned conducted separate conversations with Robert M. Yaspan (bankruptcy attorney) and Nancy Knupfer (trustee for the bankruptcy estate). Based upon the conversation with Mr. Yaspan, it is the understanding of the undersigned that Mr. Yaspan has transferred all his papers concerning the above-identified patent to Ms. Knupfer (telephone number: (310) 277-0077). Based upon the conversation with Ms. Knupfer, it is the understanding of the undersigned that the bankruptcy estate has legally abandoned the rights to the patent back to the debtors, Laurance & Carolyn Wolfberg. Ms. Knupfer gave the present address of Laurance & Carolyn Wolfberg as:

575 S. Barrington Avenue, Suite 206
Los Angeles, CA 90049

On April 15, 2002, Ms. Knupfer sent the undersigned, via facsimile transmission, a copy of the Order authorizing the trustee for the estate of Laurance and Carolyn Wolfberg to abandon the estate's interest in the patent. Based upon this Order and the conversation with Ms. Knupfer, it is the understanding of the undersigned that at least part ownership of the legal rights to the patent is back with the first-named inventor Laurance Wolfberg.

In a decision dated August 6, 1998, the Office action dated February 6, 1998 in the above-identified reexamination proceeding was vacated and the reexamination proceeding was suspended pending disposition of the patent rights in the bankruptcy proceeding. Since the part of the bankruptcy proceeding concerning the patent rights has concluded, prosecution will be resumed in the reexamination proceeding.

The file of the reexamination proceeding is being forwarded to the Technical Support Staff of Technology Center 2800 for the remailing of the Office action dated February 6, 1998. A two month shortened statutory period to respond to the Office action will begin from the date of the remailing.

Since the patent owner has no attorney of record, the correspondence address for the patent owner is being designated as that noted above for Laurance Wolfberg. All future communications from the Office will be directed to Laurance Wolfberg at the address indicated above unless otherwise notified by the patent owner.

If there are any questions concerning this communication, please contact Edward Westin at (703) 308-4823.

Edward Westin

Edward P. Westin, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 11

Thomas H. Jackson
Banner & Witcoff, LTD.
1001 G Street, N.W., 11th Floor
Washinton, D.C. 20001

MAILED

APR 1 7 2002

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Wolfberg et al.
Reexamination Proceeding
Control No. 90/004,583
Filed: March 17, 1997
For: U.S. Patent No. 4,968,993

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney or agent of record filed on September 26, 1997 pursuant to 37 C.F.R. § 1.36 and 37 C.F.R. § 10.40.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the patent owner. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). See MPEP §402.06.

The request is **dismissed** as being moot since Mr. Thomas H. Jackson was never an attorney/agent of record in the above-identified reexamination proceeding.

The reexamination proceeding currently has no attorney of record representing the patent owner.

It has been determined that at least part ownership of the legal rights to the above-identified patent is back with the first-named inventor Laurance Wolfberg. The correspondence address of the patent owner has been designated as that noted below for Laurance Wolfberg. All future communications from the Office will be directed to Laurance Wolfberg at the address indicated below unless otherwise notified by the patent owner.

All inquiries relating to this decision should be directed to Edward Westin at (703) 308-4823.

Edward Westin

Edward Westin, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: Laurance Wolfberg
575 S. Barrington Avenue, Suite 206
Los Angeles, CA 90049

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1989
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:	)	
	)	
LARRY WOLFBERG ET AL.	)	Group Art Unit: 212
	)	
Serial Number: 942,324	)	BATCH NO. N03
	)	
Filed: December 16, 1986	)	Examiner: VOELTZ
	)	
For: PRINTING PRESS	)	

REVOCATION AND APPOINTMENT OF NEW POWER OF ATTORNEY

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

The undersigned, LARRY WOLFBERG and JOHN HARPER, residing at 4615 Kahala Avenue, Honolulu, Hawaii 96816, USA, and 815 East Second Street, Wichita, Kansas 67202, USA, respectively, being the inventors having the entire right, title and interest in and to the above-identified application, hereby revoke any and all previous Powers of Attorney and appoints, both jointly and severally, as their attorneys with full power of substitution and revocation, to prosecute this application, to transact all business in the Patent and Trademark Office connected therewith, receive any Letters Patent and to take any and all other actions with regard to this application and any Letters Patent issuing thereon, the following attorneys who are all members of the Bar of the District of Columbia, their registration numbers being listed after their names: Donald W. Banner, Registration No. 17,037; Harold J. Birch, Registration No. 16,527; Edward F. McKie, Jr., Registration No. 17,335; William W. Beckett,

Registration No. 18,262; Dale H. Hoscheit, Registration No. 19,090; Rodger L. Tate, Registration No. 27,399; Joseph M. Potenza, Registration No. 28,175; Scott F. Partridge, Registration No. 28,142; Alan I. Cantor, Registration No. 28,163; James A. Niegowski, Registration No. 28,331; Barry L. Grossman, Registration No. 30,844; Joseph M. Skerpon, Registration No. 29,864; and Thomas L. Peterson, Registration No. 30,969. All correspondence and telephone communications should be addressed to:

Banner, Birch, McKie & Beckett
One Thomas Circle, N.W.
Washington, D.C. 20005

whose telephone number is (202) 296-5500, which is also the address and telephone number of each of the above listed attorneys.

Jan 18, 1989
Date

Larry WOLFBERG

Date

John HARPER

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D C. 20231

Paper No. 22

Berj A. Terzian
PENNIE AND EDMOND
1155 Avenue of the Americas
New York, NY 10036-2711

(For Patent Owner)

Sean V. O'Connell
McKINNEY & STRINGER
Corporate Tower
101 North Robinson, Suite 1300
Oklahoma City, OK 73102-5504

(For first Requester)

Stanley C. Spooner
NIXON & VANDERHYE
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714

(For second Requester)

In re Ekchian et al.
Reexamination Proceeding
Control No. 90/005,315
Filed: April 6, 1999
For: U.S. Patent No. 4,624,140

In re Ekchian et al.
Reexamination Proceeding
Control No. 90/004,635
Filed: May 15, 1997
For: U.S. Patent No. 4,624,140

In re Ekchian et al.
Reexamination Proceeding
Control No. 90/005,504
Filed: September 24, 1999
For: U.S. Patent No. 4,624,140

DECISION MERGING
REEXAMINATION
PROCEEDINGS.

The above-identified reexamination files are before the Director of Technology Center 2800 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 4,624,635 issued on November 25, 1986.

2. A first request for reexamination, Control No. 90/004,635, was filed by a third party requester on May 15, 1997.

3. Reexamination was ordered in the '4635 reexamination proceeding on July 2, 1997.

4. A first Office action was mailed on December 23, 1998 to an incorrect correspondence address.

5. The first Office action was remailed on January 13, 1999.

6. A response to the first Office action was filed on March 15, 1999.

7. A second request for reexamination, Control No. 90/005,315, was filed by the same third party requester on April 6, 1999.

8. Reexamination was ordered in the '5315 reexamination proceeding on June 22, 1999.

9. A waiver of patent owner's statement under 37 CFR § 1.530(b) was filed in the '5315 reexamination on July 14, 1999 along with an updated litigation status related to the patent under reexamination.

10. A decision merging the '4635 and the '5315 reexamination proceedings was mailed on August 11, 1999.

11. A non-final Office action was mailed on September 10, 1999 setting a two-month time period for filing a response.

12. A third request for reexamination, Control No. 90/005,504, was by a second third party

requester on September 24, 1999.

13. A response to the non-final Office action was filed on November 10, 1999 for the '4635 and '5315 reexamination proceedings with claims 1, 9-11 and 40 being amended and new claims 43-47 presented.

14. Reexamination was ordered in the '5504 reexamination proceeding on November 19, 1999.

DISCUSSION

Under 37 CFR § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565© is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 CFR § 1.565(c), the '4635, '5315 and '5504 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Three Proceedings.

As noted above, claims 1, 9-11 and 40 have been amended and claims 43-47 were newly presented in the '4635 and '5315 reexamination proceedings. Patent owner is required to maintain the same claims and specification in all three files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all three files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 CFR § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all three proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all three files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

90/004,635 - 90/005,315

CONCLUSION

Reexamination Control Nos. 90/004,635, 90/005,315 and 90/005,504 are merged. The reexamination files are being returned to the Central Reexamination files where they await the "housekeeping" amendment from the patent owner.

Janice A. Howell, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 29

Commissioner for Patents
United States Patent and Trademark Office
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(For Patent Owner)

Mark H. Plager
Law Offices of Mark H. Plager, P.C.
2134 Main Street
Suite 130
Huntington Beach, CA 92648

(For Requester)

MAILED

SEP 19 2005

REEXAM UNIT

In re Brady
Ex Parte Reexamination Proceeding
Control Number 90/004,672
Filed: June 20, 1997
For: U.S. Patent No. 5,127,760

DECISION DISMISSING PETITION

In a notice of court action filed on June 20, 2005, patent owner advises the Office of a final decision issued by the U.S. District Court for the Central District of California[1], holding that U.S. Patent No. 5,127,760 has priority over U.S. Patent No. 5,127,203. Patent owner also advises the Office that the decision issued by the U.S. District Court for the Central District of California, was affirmed by the Court of Appeals for the Federal Circuit (CAFC)[2] on December 1, 2004, as to the holding that U.S. Patent No. 5,127,760 has priority over U.S. Patent No. 5,127,203.

A review of the '4672 *ex parte* reexamination file reveals an outstanding petition to stay proceeding that was filed on May 1, 1998. The petition is taken as a PETITION UNDER 37 C.F.R. § 1.182, and is before the Office of Patent Legal Administration for decision. The petition fee of $130 pursuant to 37 C.F.R. § 1.17(h) for the petition under 37 C.F.R. § 1.182 was paid by check.

---

[1] *Slip Track Systems, Inc. v. Metal Lite Inc.*, Civil Action No. SACV 98-20 AHS (C.D. Cal. Oct. 22, 2003)("Final Judgement")

[2] *Slip Track Systems, Inc. v. Metal Lite Inc.*, unpublished docket 04-1070 (Fed. Cir. 2004)

For the reasons set forth below, the petition to stay the '4672 *ex parte* reexamination proceeding is **dismissed as moot**.

REVIEW OF FACTS

1. U.S. Patent No. 5,127,760 issued to Brady on July 7, 1992.

2. A request for *ex parte* reexamination of the '760 patent was filed by third party requester on June 20, 1997, and was assigned reexamination control no. 90/004,672.

3. On August 6, 1997, reexamination was ordered in the '4672 proceeding.

4. A patent owner's statement was filed in the '4672 proceeding on October 6, 1997.

5. On November 12, 1997, a requester's reply was filed in the '4672 proceeding.

6. A non-final Office action was mailed in the '4672 proceeding on December 10, 1997.

7. On February 9, 1998, a response to the non-final Office action was filed by patent owner in the '4672 proceeding, and was accompanied by a petition to stay the instant reexamination proceeding.

8. Requester filed a notice of concurrent proceedings under 37 C.F.R. 1.565(a) in the '4672 proceeding on May 1, 1998, advising the Office of the status of concurrent litigation.

9. Patent owner filed a notice of concurrent proceedings under 37 C.F.R. 1.565(a) in the '4672 proceeding on May 6, 1998, advising the Office of the status of concurrent litigation.

10. Patent owner filed a notice of concurrent proceedings under 37 C.F.R. 1.565(a) in the '4672 proceeding on January 31, 2001, advising the Office of the status of concurrent litigation.

11. On January 3, 2005, patent owner filed a notice of court action in the '4672 proceeding advising the Office of a final decision issued by the U.S. District Court for the Central District of California on October 22, 2003, and also advising the Office that the decision was affirmed by the CAFC on December 1, 2004, as to the holding that U.S. Patent No. 5,127,760 has priority over U.S. Patent No. 5,127,203.

12. On February 5, 2005, patent owner filed a reissue application based on U.S. Patent No. 5,127,760, which application has been assigned Application No. 11/052,018.

13. On June 20, 2005, patent owner filed a notice of court action in the '4672 proceeding advising the Office that with regard to all appeals of the decision issued by the U.S. District Court for the Central District of California, the decision has been rendered final.

DECISION

A petition to stay the instant reexamination proceeding was filed on May 1, 1998. The record shows that on June 20, 2005, the patent owner filed a notice of court action, advising the Office of a final decision issued by the U.S. District Court for the Central District of California, holding that U.S. Patent No. 5,127,760 has priority over U.S. Patent No. 5,127,203. In this notice, patent owner also advises the Office that the court's final holding as to priority was affirmed by the CAFC.

Since the CAFC affirmed the final decision issued by the U.S. District Court for the Central District of California, as to the holding that U.S. Patent No. 5,127,760 has priority over U.S. Patent No. 5,127,203, and the time periods for any further appeal have expired, the petition to stay the '4672 *ex parte* reexamination proceeding is **dismissed as moot**,

CONCLUSION

1. The petition to stay the '4672 *ex parte* reexamination proceeding is **dismissed as moot**.

2. The Office of Patent Legal Administration will consider whether or not to merge the co-pending reissue and reexamination proceedings based on U.S. Patent No. 5,127,760 in due course.

3. **All correspondence relating to an *ex parte* reexamination proceeding** should be directed:

by Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand Delivery to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

4. Telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-7722.

Lynn M. Kryza
Senior Special Projects Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

August 14, 2005

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Mark H. Plager (For Requester)
Law Offices of Mark H. Plager, P.C.
2134 Main Street
Suite 130
Huntington Beach, CA 92648

MAILED

SEP 22 2005

REEXAM UNIT

In re Brady
Ex Parte Reexamination Proceeding
Control Number 90/004,672
Filed: June 20, 1997
For: U.S. Patent No. 5,127,760

In re reissue application of
Brady
Application Number 11/052,018
Filed: January 5, 2005
For: U.S. Patent No. 5,127,760

DECISION
SUA SPONTE
MERGING
REISSUE
AND
REEXAMINATION
PROCEEDINGS

The above-mentioned reissue and reexamination proceedings are before the Office of Patent Legal Administration for decision as to whether or not the proceedings should be merged.

For the reasons discussed below, the above-identified reissue application and reexamination proceedings are ***sua sponte* merged** into a single consolidated proceeding.

REVIEW OF FACTS

1. U.S. Patent No. 5,127,760 issued to Brady on July 7, 1992.

2. A request for *ex parte* reexamination of the '760 patent was filed by third party requester on June 20, 1997, and was assigned reexamination control no. 90/004,672.

3. On August 6, 1997, reexamination was ordered in the '4672 proceeding.

4. A patent owner's statement was filed in the '4672 proceeding on October 6, 1997.

5. On November 12, 1997, a requester's reply was filed in the '4672 proceeding.

6. A non-final Office action was mailed in the '4672 proceeding on December 10, 1997.

7. On February 9, 1998, a response to the non-final Office action was filed by patent owner in the '4672 proceeding, and was accompanied by a petition to stay the instant reexamination proceeding.

8. Requester filed a notice of concurrent proceedings under 37 C.F.R. 1.565(a) in the '4672 proceeding on May 1, 1998, advising the Office of the status of concurrent litigation.

9. Patent owner filed a notice of concurrent proceedings under 37 C.F.R. 1.565(a) in the '4672 proceeding on May 6, 1998, advising the Office of the status of concurrent litigation.

10. Patent owner filed a notice of concurrent proceedings under 37 C.F.R. 1.565(a) in the '4672 proceeding on January 31, 2001, advising the Office of the status of concurrent litigation.

11. On January 3, 2005, patent owner filed a notice of court action in the '4672 proceeding advising the Office of a final decision issued by the U.S. District Court for the Central District of California on October 22, 2003, and also advising the Office that the decision was affirmed by the CAFC on December 1, 2004, as to the holding that U.S. Patent No. 5,127,760 has priority over U.S. Patent No. 5,127,203.

12. On February 5, 2005, patent owner filed a reissue application based on U.S. Patent No. 5,127,760, which application has been assigned Application No. 11/052,018. A preliminary amendment was included, adding new claim 11.

13. On June 20, 2005, patent owner filed a notice of court action in the '4672 proceeding advising the Office that with regard to all appeals of the decision issued by the U.S.

District Court for the Central District of California, the decision has been rendered final.

14. A decision dismissing the petition to stay the '4672 proceeding was mailed on September 19, 2005.

DISCUSSION REGARDING MERGER OF PROCEEDINGS

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '4672 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision as to whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the '4672 reexamination file shows that no amendments have been made.

A review of the reissue (Application No. 11/052,018) prosecution history shows that the reissue application was published in the *Official Gazette* on October 5, 2005. In the reissue application, patent owner has filed a preliminary amendment adding new claim 11. Therefore, the claims are **not** identical in both proceedings.

In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). As noted above with regard to the amendments submitted, the claims are NOT the same in both files. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 11/052,018, and Control No. 90/004,672. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (*i.e,* the reissue Application No. and the reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue and reexamination files.

It should be noted that the housekeeping amendment for the merged proceeding should be provided in the proper format for reissue applications. **Amendments in a reissue application must be in compliance with 37 C.F.R. § 1.173,** therefore all amended claims should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173(b)(2), (d) and (g) and all new claims must be completely underlined pursuant to 37 C.F.R. § 1.173(b)(2) and (d)(2). Please be aware that a "clean copy" of the amendment is **not** required by this rule. **Note that amendment practice pursuant to 37 C.F.R. § 1.121 does not apply to reissue applications, as specifically indicated in 37 C.F.R. § 1.121(a) and (i), and therefore "Revised Amendment Practice" does not apply to reissue applications.** Therefore, the required housekeeping amendment must be in compliance with 37 C.F.R. § 1.173, *e.g.*, all amended claims should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173(b)(2), (d) and (g).

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application,

examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, *i.e*, the reissue application and the reexamination proceeding. Each action will be entered into both files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data for both of the cases (*i.e,* the reissue Application No. and the reexamination proceeding Control No.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 C.F.R. § 1.114, the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

CONCLUSION

1. The above-identified reissue application and reexamination proceedings are ***sua sponte*** **merged** into a single consolidated proceeding.

2. The reissue application file and the reexamination file are being forwarded to the Group Director of Technology Center 3600. All further examination should be conducted in accordance with this decision.

3. Pursuant to Part II. of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding, which amendment must be in compliance with 37 C.F.R. § 1.173.

4. The examiner should issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding **after** the earlier of the following events have occurred:

   (a) the submission of the housekeeping amendment to place the same amendments in both cases; or

   (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.

5. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this decision** placing the same amendments in both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claim, and therefore failing to particularly point out the invention.

6. All further examination should be conducted in accordance with Parts II. and III. of this decision.

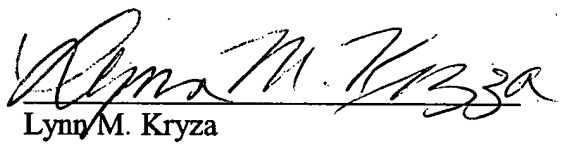
7. **All correspondence relating to an *ex parte* reexamination proceeding** should be directed:

by Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand Delivery to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

8. Telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-7722.



Lynn M. Kryza
Senior Special Projects Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

September 20, 2005

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Mark H. Plager
Law Offices of Mark H. Plager, PC
2134 Main Street, Suite 130
Huntington Beach, CA 92648

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/004,672*.

PATENT NO. *5127760*.

ART UNIT *2100*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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United States Patent and Trademark Office
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R. Joseph Trojan
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(For Patent Owner)

Mark H. Plager
Law Offices of Mark H. Plager, P.C.
2134 Main Street
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Huntington Beach, CA 92648

(For Requester)

In re Brady
Ex Parte Reexamination Proceeding
Control Number 90/004,672
Filed: June 20, 1997
For: U.S. Patent No. 5,127,760

In re reissue application of
Brady
Application Number 11/052,018
Filed: January 5, 2005
For: U.S. Patent No. 5,127,760

: **DECISION**
: **VACATING**
: **MERGER OF**
: **REISSUE AND**
: **REEXAMINATION**
: **PROCEEDINGS**
:
: **AND**
:
: **DECISION**
: **SUSPENDING**
: **REISSUE**

The above-mentioned reissue and reexamination proceedings were merged by the Office of Patent Legal Administration in a decision mailed on September 22, 2005.

For the reasons discussed below, the decision merging proceedings of September 22, 2005, is hereby **vacated.**

The prosecution of the above-mentioned reissue application is hereby **suspended,** pending the conclusion of the 90/004,672 reexamination proceeding by the issuance of the reexamination certificate.

REVIEW OF FACTS

1. U.S. Patent No. 5,127,760 issued to Brady on July 7, 1992.

2. A request for *ex parte* reexamination of the '760 patent was filed by third party requester on June 20, 1997, and was assigned reexamination control no. 90/004,672.

3. On August 6, 1997, reexamination was ordered in the '4672 proceeding.

4. A patent owner's statement was filed in the '4672 proceeding on October 6, 1997.

5. On November 12, 1997, a requester's reply was filed in the '4672 proceeding.

6. A non-final Office action was mailed in the '4672 proceeding on December 10, 1997.

7. On February 9, 1998, a response to the non-final Office action was filed by patent owner in the '4672 proceeding, and was accompanied by a petition to stay the instant reexamination proceeding.

8. Requester filed a notice of concurrent proceedings under 37 C.F.R. 1.565(a) in the '4672 proceeding on May 1, 1998, advising the Office of the status of concurrent litigation.

9. Patent owner filed a notice of concurrent proceedings under 37 C.F.R. 1.565(a) in the '4672 proceeding on May 6, 1998, advising the Office of the status of concurrent litigation.

10. Patent owner filed a notice of concurrent proceedings under 37 C.F.R. 1.565(a) in the '4672 proceeding on January 31, 2001, advising the Office of the status of concurrent litigation.

11. On January 3, 2005, patent owner filed a notice of court action in the '4672 proceeding advising the Office of a final decision issued by the U.S. District Court for the Central District of California on October 22, 2003, and also advising the Office that the decision was affirmed by the CAFC on December 1, 2004, as to the holding that U.S. Patent No. 5,127,760 has priority over U.S. Patent No. 5,127,203.

12. On February 5, 2005, patent owner filed a reissue application based on U.S. Patent No. 5,127,760, which application has been assigned Application No. 11/052,018. A preliminary amendment was included, adding new claim 11.

13. The reissue application was published in the *Official Gazette* on April 12, 2005.

14. On June 20, 2005, patent owner filed a notice of court action in the '4672 proceeding advising the Office that with regard to all appeals of the decision issued by the U.S. District Court for the Central District of California, the decision has been rendered final.

15. A decision dismissing the petition to stay the '4672 proceeding was mailed on September 19, 2005.

16. On September 22, 2005, a decision *sua sponte* merging reissue and reexamination and proceedings was mailed.

DECISION

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings....

35 USC 305 states (in part):

> "All reexamination proceedings under this section, including any on appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office."

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately, and at the same time, for a single patent. The reason for this Office policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. The decision as to whether to merge the proceedings or suspend a proceeding will be made on a case-by-case basis based upon the status of the various proceedings. Due consideration will be given to the finality of the reexamination requested.

In the present reexamination proceeding, prosecution has been conducted, and claims 1-10 stand rejected over U.S. Patent No. 5,127,203. In a notice of court action filed on June 20, 2005, patent owner advised the Office of a final decision issued by the U.S. District Court for the

Central District of California[1], holding that U.S. Patent No. 5,127,760 has priority over U.S. Patent No. 5,127,203, and that the decision was affirmed by the Court of Appeals for the Federal Circuit (CAFC)[2] on December 1, 2004. A review of *Slip Track Systems, Inc. v. Metal Lite Inc.*, unpublished docket 04-1070 (Fed. Cir. 2004) confirms that the CAFC affirmed the final decision issued by the U.S. District Court for the Central District of California, as to the holding that U.S. Patent No. 5,127,760 has priority over U.S. Patent No. 5,127,203, and the time periods for any further appeal have expired. Accordingly, since the only reference applied against the claims of the '4672 proceeding is no longer available as prior art in view of the final court decision, it is likely that the reexamination proceeding may be terminated in due course, provided that no new prior art is applied against the claims.

In the reissue application, the patent owner filed a preliminary amendment that adds claim 11. The status of the reissue application is that no Office action has yet been mailed.

While in other situations it may be beneficial to consolidate reexamination and reissue proceedings within the Office, in this instance, such consolidation would necessitate the prolonging of prosecution in the reexamination proceeding at a point where the reexamination proceeding will most likely be terminated. Any such prolonging of prosecution in the reexamination proceeding would be contrary to the **special dispatch** requirement set by the statute. Therefore, rather than merging the reexamination and reissue proceedings in this instance, it is instead appropriate that the reissue application be **suspended** pursuant to 37 C.F.R. § 1.103(e) in favor of the reexamination proceeding. The suspension of the reissue application will prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner into the reissue application. The suspension of the reissue application will also permit the reexamination proceeding to continue to move forward, and this will provide the most efficient and prompt handling of the reexamination proceeding.

Accordingly, the merger of the above-mentioned reexamination and reissue proceedings is **vacated.** The reissue application is **suspended** pursuant to 37 C.F.R. § 1.103(e) in favor of the reexamination proceeding, for the reasons indicated above. The prosecution of the 11/052,018 reissue application is hereby **suspended,** pending the conclusion of the 90/004,672 reexamination proceeding by the issuance of the reexamination certificate.

---

[1] *Slip Track Systems, Inc. v. Metal Lite Inc.*, Civil Action No. SACV 98-20 AHS (C.D. Cal. Oct. 22, 2003)("Final Judgement")

[2] *Slip Track Systems, Inc. v. Metal Lite Inc.*, unpublished docket 04-1070 (Fed. Cir. 2004)

CONCLUSION

1. The decision to merge mailed by the Office of Patent Legal Administration on September 22, 2005, is vacated.

2. The prosecution of reissue application number 11/052,018 is suspended pending the conclusion of the 90/004,672 reexamination proceeding by the issuance of the reexamination certificate.

3. A copy of this decision will be placed in both the 11/052,018 reissue file and the 90/004,672 reexamination file.

4. The reexamination file is being forwarded to the Central Reexamination Unit for processing, after which it will be forwarded via the Group Director of Technology Center 3600 to the examiner for the issuance of an Office action.

5. The reissue file is being forwarded via the Group Director of Technology Center 3600 to the Technology Center Special Program Examiner for storage pending the issuance of the reexamination certificate for the '4672 reexamination proceeding, after which an Office action will be issued for the reissue application.

6. The patent owner is advised to, at the time that a reexamination certificate is issued for the '4672 reexamination, call the issuance of the proceeding to the attention of the Office, and request a resumption of examination of the reissue application.

7. **All correspondence relating to an *ex parte* reexamination proceeding** should be directed:

by Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand Delivery to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

8. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza, Senior Special Projects Advisor at (571) 272-7722, or Robert Clarke, Deputy Director at (571) 272-7735.

Robert J. Spar, Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

September 27, 2005

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Paper No. 19

Joseph A. Sawyer, Jr.
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Palo Alto, CA 94303

MAIL

FOR OWNER

MAR 10 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Hugh R. Kress, Esq.
ARNOLD WHITE & DURKEE
P.O. Box 4433
Houston, Texas 77210

FOR THIRD PARTY REQUESTER

In re Reexamination of:
U.S. Patent No. 5,359,724
Reexamination Control No. 90/004,698
Filed: July 11, 1997
For: METHOD AND APPARATUS FOR STORING AND RETRIEVING MULTI - DIMENSIONAL DATA IN COMPUTER MEMORY

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed June 08, 2001 to expunge information submitted pursuant to MPEP 724.02.

The petition is **GRANTED**.

Petitioner requests that the documents "Deposition of Robert Earle dated January 22, 1998", "Excerpts from the deposition of Mark Stefix dated May 13, 1998 filed by PSI in opposition to claim construction of U.S. Patent No. 5,359,724", "A Validity Analysis of U.S. Patent No. 5,359,724" and "Planning Sciences International's Opposition Brief On Claim Construction of U.S. Patent No. 5,359,724", filed June 08, 2001, be expunged from the record. Petitioner states that the information contains materials that are subject to a protective order which have not been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant reexamination proceeding.

Patent Owner is required to retain the expunged material(s) for the life of the patent.

The expunged materials are returned herewith.

Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
(571) 272-3613

Enclosure: PROTECTIVE ORDER MATERIALS filed June 08, 2001.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

January 4, 2001

Paper No. 23

William J. Hone
Fish and Richardson
45 Rockefeller Plaza
New York, NY 10111

(For Patent Owner)

Enclosure: Paper filed December 16, 2000

A. Jason Mirabito
Mintz, Levin, Cohn, Ferris, Glovsky & Popeo
One Financial Center
Boston, MA 02111

(For Third Party Requester)

90004726

In re Mullis et al.
Reexamination Proceeding
Control No. 90/004,726
Filed: August 18, 1997
For: U.S. Patent No. 5,333,675

In re Mullis et al.
Reexamination Proceeding
Control No. 90/004,909
Filed: January 20, 1998
For: U.S. Patent No. 5,333,675

DECISION DISMISSING PETITION AND RETURNING IMPROPER PAPER

This is a decision on the December 16, 2000, petition filed under 37 CFR 1.182 by the patent owner requesting the Commissioner to withdraw the Notice of Intent to Issue a Reexamination Certificate, and direct the examiner to consider third party papers directed to the issue of inventorship of one or more claims of the patent. The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed.

37 CFR 1.550(g) provides (in part):

> "The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered."

37 CFR 1.550(g) additionally provides:

> "[N]o submissions on behalf of any third parties will be acknowledged or considered unless such submissions are (1) in accordance with § 1.510 or § 1.535; or (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525."

The petition under 37 CFR 1.182 filed by the patent owner on December 16, 2000, after the period for active participation of the reexamination third party requester had ended, is an improper submission under 37 CFR 1.550(g) because it includes a submission on behalf of the third party reexamination requester. The rules provide that the active participation of the reexamination requester ends with the reply under § 1.535 and prohibit any further third party requester participation. The intent of the rules is to make *ex parte* reexamination an *ex parte* proceeding with limited, well-defined, requester participation. In this regard, the patent owner cannot file papers on behalf of the requester and thereby circumventing the rules and create an *inter partes* proceeding. The instant communication filed by the patent owner is clearly a submission filed on behalf of the third party requester, and is an improper submission under § 1.550(g). Accordingly, the petition will not be made of record in the reexamination file and is being returned herewith. This decision will, however, be made of record in the reexamination file.

Telephone inquiries related to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at 703-305-8610.

Gerald A. Dost

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

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Paper No. 3 5

Maurice M. Klee
1951 Burr Street
Fairfield, CT 06430

(For Patent Owner)

FULBRIGHT & JAWORSKI, LLP
1301 McKinney
Suite 5100
Houston, TX 77010-3095

(For Requester)

In re reissue application of
Noiles
Application No. 07/191,225
Filed: May 6, 1988
For: U.S. Patent No. 4,678,472

In re Noiles
Reexamination Proceeding
Control No. 90/004,732
Filed: August 26, 1997
For: U.S. Patent No. 4,678,472

In re Noiles
Reexamination Proceeding
Control No. 90/005,596
Filed: June 22, 1999
For: U.S. Patent No. 4,678,472

MAILED

APR 2 1 2003

REEXAM UNIT

DECISION *SUA SPONTE* MERGING REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue application and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 4,678,472 issued to Noiles on July 7, 1987.

2. Patent owner filed a reissue application based on the '472 patent, on May 6, 1988, which was assigned Application No. 07/191,225. Portions of the specification, as well as claims 1, 3-5 and 7-8 were amended, and claims 9-14 were added.

3. Notice of the filing of the reissue application was published in the *Official Gazette* on July 5, 1988, and the reissue application (hereinafter '225 application) has undergone extensive prosecution.

4. The '225 application was placed into interference on December 8, 1992 and was assigned Interference No. 102,732. On March 3, 1997, the Board of Patent Appeals and Interferences issued a decision awarding priority of invention to Noiles.

5. A request for reexamination of the '472 patent was filed by a third party requester on August 26, 1997, and the resulting reexamination proceeding was assigned Control No. 90/004,732.

6. On November 14, 1997, reexamination was ordered in the '4732 proceeding.

7. A patent owner's statement under 37 C.F.R. § 1.530 was filed in the '4732 proceeding on December 19, 1997, including an amendment to place the same amendments in the reexam, as those in the reissue application.

8. A requester's reply under 37 C.F.R. § 1.535 was filed on February 23, 1998.

9. On February 26, 1998, a decision merging the '225 application and '4732 proceeding was mailed.

10. A non-final Office action was mailed in the merged proceeding on August 7, 1998.

11. A response, along with a request for an extension of time, was filed in the merged proceeding on February 3, 1999.

12. A request for reexamination of the '472 patent was filed by a third party requester on June 22, 1999, and the resulting reexamination proceeding was assigned Control No. 90/005,596.

13. Reexamination was ordered in the '5596 proceeding on February 7, 2000.

14. An amendment placing the same claims in the '5596 proceeding as are present in the merged proceeding was filed on February 26, 2003.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceedings are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '5596 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue (Application No. 07/191,225) prosecution history shows that the reissue application was published in the *Official Gazette* on July 5, 1988. Substantive prosecution took place in the reissue application. In the reissue application, patent owner has amended portions of the specification, as well as claims 1, 3-5 and 7-8, and has added claims 9-14.

In the '4732 proceeding, which is merged with the '225 application, these same amendments have been presented.

A review of the prosecution history of the '5596 reexamination file shows that the same amendments presented in the merged proceeding have been filed in a preliminary amendment in this reexamination file.

Therefore, the claims are identical in all three proceedings.

In order to provide efficient and prompt handling of all three proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the two reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the two reexamination proceedings will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in All Three Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all three files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d).

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a **single action** which jointly applies to the reissue application and the reexamination proceedings. Each action will contain identifying data **for all three of the cases,** *i.e*, the reissue application and the two reexamination proceedings. Each action will be physically entered into all three files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with **three copies being filed** for entry in each of the three files, with each of the three copies bearing a signature, and containing identifying data for all three of the cases (*i.e*, the reissue Application No. and the reexamination proceeding Control Nos.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be modified as follows. The reissue application will be held abandoned, and withdrawn from the merged proceeding. With respect to the merged reexamination proceedings, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, withdraw the reissue from the merged proceeding, and continue examination as to the merged reexamination proceedings.

Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improperly broadened claims) would be made by the examiner upon withdrawal of the reissue from the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the withdrawal of the reissue from the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

CONCLUSION

1. The above-identified reissue application and reexamination proceedings **ARE MERGED** into a single consolidated proceeding.

2. The reissue application file and the reexamination files are being forwarded to the Group Director of Technology Center 3700.

3. The examiner should immediately issue an Office action for the present merged proceeding of the reissue application and reexamination proceedings. All further examination should be conducted in accordance with Parts II and III of this decision.

4. Telephone inquiries related to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

April 17, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 35

Maurice M. Klee
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(For Patent Owner)

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(For Requester)

MAILED

APR 21 2003

REEXAM UNIT

In re reissue application of
Noiles
Application No. 07/191,225
Filed: May 6, 1988
For: U.S. Patent No. 4,678,472

In re Noiles
Reexamination Proceeding
Control No. 90/004,732
Filed: August 26, 1997
For: U.S. Patent No. 4,678,472

In re Noiles
Reexamination Proceeding
Control No. 90/005,596
Filed: June 22, 1999
For: U.S. Patent No. 4,678,472

DECISION *SUA SPONTE* MERGING REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue application and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 4,678,472 issued to Noiles on July 7, 1987.

2. Patent owner filed a reissue application based on the '472 patent, on May 6, 1988, which was assigned Application No. 07/191,225. Portions of the specification, as well as claims 1, 3-5 and 7-8 were amended, and claims 9-14 were added.

3. Notice of the filing of the reissue application was published in the *Official Gazette* on July 5, 1988, and the reissue application (hereinafter '225 application) has undergone extensive prosecution.

4. The '225 application was placed into interference on December 8, 1992 and was assigned Interference No. 102,732. On March 3, 1997, the Board of Patent Appeals and Interferences issued a decision awarding priority of invention to Noiles.

5. A request for reexamination of the '472 patent was filed by a third party requester on August 26, 1997, and the resulting reexamination proceeding was assigned Control No. 90/004,732.

6. On November 14, 1997, reexamination was ordered in the '4732 proceeding.

7. A patent owner's statement under 37 C.F.R. § 1.530 was filed in the '4732 proceeding on December 19, 1997, including an amendment to place the same amendments in the reexam, as those in the reissue application.

8. A requester's reply under 37 C.F.R. § 1.535 was filed on February 23, 1998.

9. On February 26, 1998, a decision merging the '225 application and '4732 proceeding was mailed.

10. A non-final Office action was mailed in the merged proceeding on August 7, 1998.

11. A response, along with a request for an extension of time, was filed in the merged proceeding on February 3, 1999.

12. A request for reexamination of the '472 patent was filed by a third party requester on June 22, 1999, and the resulting reexamination proceeding was assigned Control No. 90/005,596.

13. Reexamination was ordered in the '5596 proceeding on February 7, 2000.

14. An amendment placing the same claims in the '5596 proceeding as are present in the merged proceeding was filed on February 26, 2003.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceedings are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '5596 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue (Application No. 07/191,225) prosecution history shows that the reissue application was published in the *Official Gazette* on July 5, 1988. Substantive prosecution took place in the reissue application. In the reissue application, patent owner has amended portions of the specification, as well as claims 1, 3-5 and 7-8, and has added claims 9-14.

In the '4732 proceeding, which is merged with the '225 application, these same amendments have been presented.

A review of the prosecution history of the '5596 reexamination file shows that the same amendments presented in the merged proceeding have been filed in a preliminary amendment in this reexamination file.

Therefore, the claims are identical in all three proceedings.

In order to provide efficient and prompt handling of all three proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the two reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the two reexamination proceedings will be conducted in accordance with the decision set forth below.

DO NOT ENTER

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in All Three Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all three files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d).

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a **single action** which jointly applies to the reissue application and the reexamination proceedings. Each action will contain identifying data **for all three of the cases,** *i.e,* the reissue application and the two reexamination proceedings. Each action will be physically entered into all three files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with **three copies being filed** for entry in each of the three files, with each of the three copies bearing a signature, and containing identifying data for all three of the cases (*i.e,* the reissue Application No. and the reexamination proceeding Control Nos.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be modified as follows. The reissue application will be held abandoned, and withdrawn from the merged proceeding. With respect to the merged reexamination proceedings, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, withdraw the reissue from the merged proceeding, and continue examination as to the merged reexamination proceedings.

Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improperly broadened claims) would be made by the examiner upon withdrawal of the reissue from the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the withdrawal of the reissue from the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

CONCLUSION

1. The above-identified reissue application and reexamination proceedings **ARE MERGED** into a single consolidated proceeding.

2. The reissue application file and the reexamination files are being forwarded to the Group Director of Technology Center 3700.

3. The examiner should immediately issue an Office action for the present merged proceeding of the reissue application and reexamination proceedings. All further examination should be conducted in accordance with Parts II and III of this decision.

4. Telephone inquiries related to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

April 17, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

Paper No. 23

MARY E. GOLRICK
CALFEE HALTER & GRISWOLD
1400 MCDONALD INVESTMENT CENTER
800 SUPERIOR AVENUE
CLEVELAND OH 44114

(For Patent Owner)

MAILED
JUN 12 2000
REEXAM UNIT

09/004733 06/12/2000

In re Reexamination Proceeding	:	
Control No. 90/004,733	:	**DECISION**
Filed: August 27, 1997	:	**DISMISSING**
For: U.S. Patent No. 5,484,778	:	**PETITION**
Patentee: Kenney, et al.	:	

This is a decision on the patent owner Petition Under 35 U.S.C. § 133 filed March 17, 2000, for entry of late papers on the grounds of unavoidable delay; see MPEP 2268.

The petition is before the Office of Patent Legal Administration for decision.

The petition under 35 U.S.C. § 133 for the entry of late papers is **dismissed** for the reasons set forth below.

Any request for reconsideration of this decision must be submitted within ONE (1) MONTH from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are not permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 35 U.S.C. 133."

REVIEW OF FACTS

1. U.S. Patent No. 5,484,778 issued to Kenney, et al. on January 16, 1996.

2. A request for reexamination of the '778 patent was filed on August 27, 1997, by patent owner, and it was assigned Control No. 90/004,733.

3. Reexamination was ordered on October 30, 1997.

4. On October 28, 1999, a final Office action was mailed, which set a 2 month shortened statutory period for response.

5. Patent owner filed a response to the final rejection on December 27, 1999. No request for extension of time pursuant to 37 CFR § 1.550(c), was filed prior to the December 28, 1999, due date.

7. An advisory Office action was mailed on January 14, 2000, which indicated that the amendment of December 27, 1999, would not be entered. The advisory action extended the time period for response to be 3 months from the mailing date of the final Office action, i.e., January 28, 2000.

9. On March 17, 2000, the present petition was filed, along with a request for an extension of time of 2 months, accompanied by an amendment. The request for an extension of time was filed under 37 CFR § 1.136.

REVIEW OF FACTS

1. U.S. Patent No. 5,484,778 issued to Kenney, et al. on January 16, 1996.

2. A request for reexamination of the '778 patent was filed on August 27, 1997, by patent owner, and it was assigned Control No. 90/004,733.

3. Reexamination was ordered on October 30, 1997.

4. On October 28, 1999, a final Office action was mailed, which set a 2 month shortened statutory period for response.

5. Patent owner filed a response to the final rejection on December 27, 1999. No request for extension of time pursuant to 37 CFR § 1.550(c), was filed prior to the December 28, 1999, due date.

7. An advisory Office action was mailed on January 14, 2000, which indicated that the amendment of December 27, 1999, would not be entered. The advisory action extended the time period for response to be 3 months from the mailing date of the final Office action, i.e., January 28, 2000.

9. On March 17, 2000, the present petition was filed, along with a request for an extension of time of 2 months, accompanied by an amendment. The request for an extension of time was filed under 37 CFR § 1.136.

DECISION

A grantable petition for entry of belated papers under 35 U.S.C. 133 must be accompanied (1) by an adequate showing of the cause of unavoidable delay, (2) by the proposed response to the outstanding Office action, and (3) by the petition fee required by law. The present petition lacks item (2) above.

The present reexamination proceeding terminated on January 29, 2000, for failure to timely file a response within the meaning of 37 CFR 1.113 to the final Office action of October 28, 1999, which set a shortened statutory period for response of two (2) months, and noted that extensions of time were governed by 37 CFR 1.550(c). The proposed response required for consideration of a petition to revive must be a Notice of Appeal (and fee required by law) or an amendment that *prima facie* places the reexamination proceeding in condition for allowance. Since the amendment submitted March 17, 2000, does not *prima facie* place the proceeding in condition for allowance (see the Advisory Action attached to this decision), the response required must be a Notice of Appeal and requisite appeal fee.

Therefore, the petition is **dismissed**.

With respect to the unavoidable delay issue, the following is noted:

The advisory Office action of January 14, 2000[1], extended the time period for response to be 3 months from the mailing date of the final Office action, i.e., January 28, 2000. This provided patent owner with a 14 day period in which to provide a response to the final Office action. While ordinarily a 14 day time period would be considered a sufficient amount of time for response, e.g. for making the decision to file, and for the filing of a notice of appeal, due to the unexpected mail delay in

[1] Which indicated that the amendment of December 27, 1999, would not be entered.

the present situation[2], there were only four days remaining in the time period for response when the advisory action was received by Patent Owner. Accordingly, under these circumstances, the time period set in the advisory action for response is considered to have been insufficient. Note in this regard *Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg* (DC DC) 10 USPQ2d 1787.

Accordingly, an appropriate showing of the cause of unavoidable delay is present in the record.

CONCLUSION

A proper response to the outstanding Office action is required for the granting of the present petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

[2] Petitioner has supplied copies of docket sheets which show that the firm's docket records were last updated on January 29, 2000; that they indicate the advisory action was received on January 24, 2000, and that the last amendment was received by the PTO on January 5, 2000. A copy of the advisory action showing the receipt date stamp has also been supplied.

Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 306-5682.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Attachment: Reexamination Advisory Action *re* the Amendment submitted March 17, 2000.

June 8, 2000
C:\KIVA\KPET-ABE\REEX4733.LYN

90004733.031700

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

Paper No. 27

(For Patent Owner)

MARY E. GOLRICK
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800 SUPERIOR AVENUE
CLEVELAND OH 44114

MAILED
AUG 17 2000
REEXAM UNIT

In re Reexamination Proceeding :
Control No. 90/004,733 : **DECISION**
Filed: August 27, 1997 : **GRANTING**
For: U.S. Patent No. 5,484,778 : **PETITION**
Patentee: Kenney, et al. :

This is a decision on the patent owner RENEWED PETITION UNDER 35 U.S.C. § 133 filed June 29, 2000, for entry of late papers on the grounds of unavoidable delay; see MPEP 2268.

The petition is before the Office of Patent Legal Administration for decision.

The petition under 35 U.S.C. § 133 for the entry of late papers is **granted** for the reasons pointed out below.

DECISION

This reexamination proceeding terminated on January 29, 2000, for failure to timely file a response within the meaning of 37 CFR 1.113 to the final Office action of October 28, 1999, which set a shortened statutory period for response of two (2) months, and noted that extensions of time were governed by 37 CFR 1.550(c).

The proposed response required for consideration of a petition to revive must be a Notice of Appeal (and fee required by law) or an amendment that *prima facie* places the reexamination proceeding in condition for allowance. Since a Notice of Appeal and the requisite fee were received on June 27, 2000, the petition is granted. It is noted that Patent Owner's Appeal Brief is due on August 27, 2000. Due to the shortness of the time period remaining in which to file the Appeal Brief, the time period for filing the Appeal Brief is *sua sponte* extended for one (1) month, until September 27, 2000. The case will be forwarded to the Technology Center for the examiner's consideration of the response filed June 29, 2000.

Therefore, the petition is **granted**.

CONCLUSION

1. The petition is granted.
2. The time period for filing the Appeal Brief is *sua sponte* extended for one (1) month, until September 27, 2000.
3. The reexamination file is being forwarded to Technology Center 1600 for the examiner's consideration of the response filed June 29, 2000.
4. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 306-5682.

Gerald Dost
Senior Legal Advisor
Office of Patent Legal Administration

August 17, 2000

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re MAILED
3/09/04
FEB 27 2004
PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte
MITSUBISHI MATERIALS CORPORATION

Appeal No. 1999-2318
Application No. 90/004,783

ON BRIEF

Before HANLON, PAK, and WARREN[1], Administrative Patent Judges.

PAK, Administrative Patent Judge.

REQUEST ON REHEARING

Appellants request a rehearing of the Board's decision entered September 30, 2003, wherein we affirmed the examiner's decision rejecting claims 1 and 4 through 16 under 35 U.S.C. § 103.[2]

[1] Administrative Patent Judge Lieberman has retired and Administrative Patent Judge Warren has been substituted. Note, ***In re Bose***, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

[2] This appeal is related to Appeal Nos. 2000-2073, 1999-2411 and 2001-0310, the appeals from the final rejections of the claims pending in Reexamination Control Nos. 90/004,386, 90/004,782 and 90/004,385, respectively.

We have carefully considered the arguments raised by the appellants in the Request for Rehearing dated December 1, 2003. However, those arguments do not persuade us that our decision was in error in any respect.

First, the appellants argue (Request for Rehearing, page 1) that:

> There is no evidence in the case to support the Board's finding of an "implicit" fact in either Smith or Hoffmann regarding alternate conveyance of blister copper, nor any basis to find that the term "launder" as used in these references is generic.

However, contrary to the appellants' argument, there is ample evidence to support our factual findings. At page 11 and 12 of the decision entered September 30, 2003, we referred to evidentiary support for our factual findings directed to alternate conveyance of blister copper, which are provided below for convenience:

> We find that Smith teaches that "[b]lister copper laundered directly to <u>one</u> of two rotary anode furnaces." See page 57. We find that Hoffmann, like Smith, teaches that "[b]lister copper ... continuously overflows a syphon and is conveyed by launder at the rate of 459 metric tons per day to the anode furnaces." See column 4, lines 58-61. We find that Hoffman also teaches that "[blister copper from the furnace flows directly by heated launder to <u>one</u> of the two anode furnaces." See column 5, lines 11-12. We find that implicit in the above teachings of both Smith and Hoffmann is that blister copper is alternately conveyed from a blister copper producing furnace to a plurality of anode furnaces (filling one anode furnace at a time). ***See In re Preda***, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)(In

> evaluating the content of the prior art references, it is proper to take into account not only the specific teachings of the prior art references, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom)(Underline added and footnote removed).
>
> As also indicated at footnote 7 at page 12 of the decision:
>
> The appellants also do not dispute the examiner's finding that "both the systems of Smith and ...Hoffmann... specifically require a launder structure which would allow for delivery of molten copper products (blister copper) from a single upstream furnace alternately to a plurality of downstream furnaces..."

The appellants cannot now argue that Smith and Hoffmann do not disclose such launder structure. See, e.g. 37 CFR 1.192(a)(1998).

With respect to evidentiary support for our factual findings directed to the generic use of the term "launders", we found that Smith and Hoffmann, as indicated above, do not limit their launders to either branched or unbranched launders.[3] Thus, it is reasonable to infer from the above teachings that the term "launders" is used generically to include both branched and unbranched launders so long as the launders are capable of alternately conveying blister copper from the claimed blister copper producing means to the claimed blister copper refining furnaces (anode furnaces). See the decision entered September 30, 2003, pages 13 and 14.

---

[3] There are only two choices, i.e., branched or unbranched launders.

To the extent that the appellants may have relied on evidence[4] to show that the Olympic Dam Project described in Smith illustrates only unbranched launders, we still are not convinced that Smith is limited to such an illustrated embodiment only. There is nothing in Smith, which limits its launders to an illustrated embodiment. ***See, e.g., In re Lamberti***, 192 USPQ 278, 280 (CCPA 1976) ("all disclosures of the prior art, including unpreferred embodiments, must be considered.").

Even were we to determine that Smith is limited to unbranched launders, the outcome is still not altered for two reasons. First, as indicated ***supra***, Hoffmann still teaches employing launders in general, inclusive of both branched and non-branched launders. Second, as indicated at page 14 of the decision entered September 30, 2003, Bibby teaches that its branched launders can perform the same function as unbranched launders, i.e., alternately conveying molten copper from an upstream furnace to a plurality of downstream furnaces, thus providing a suggestion to substitute one for the other.

[4] Evidence referred to in a related appeal, Appeal No. 2001-0310.

Second, the appellants argue (Request for Rehearing, page 1) that

> there is no reasonable basis for rejecting the McCain Declarations. That Attorney's comments parallel the declaration [sic., declarations] is to be expected.

However, the appellants did not rely on the McCain declarations in the Brief. As such, we decline to consider this argument or the McCain declarations.[5] See 37 CFR § 1.192(a)(1998)("Any arguments and authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences unless good cause is shown.").

Finally, the appellants argue (Request for Rehearing, page 1) that:

> the Board has imposed its judgment that the claimed combination of elements provides benefits immediately obvious to those skill in the art.

However, our finding is not based on a vacuum, but based on observation of the known branched and unbranched launders taught by the applied prior art references. From this observation, we determined that one of ordinary skill in art would have readily

---

[5] To the extent that the appellants rely on the same arguments set forth in a related appeal, Appeal No. 2001-0310, we determine that the opinions in the McCain declarations were based on "faulty assumptions and incomplete facts" for the reasons indicated at pages 14-26 of the decision on Appeal No. 2001-0310.

recognized, for example, how many holes in the wall of the blister copper furnace are needed to accommodate a given number of branched or unbranched launders and how many branched or unbranched launders are needed to alternately transport or convey molten copper. Specifically, at page 13 of the decision, we added that:

> In addition to the above suggestion and reasonable expectation success found in the applied prior art references, we determine that simple observation of branched and unbranched launders would have also revealed to one of ordinary skill in the art that the branched launders (having a number of branches attached to the main launder) are more advantageous than the unbranched launders in terms of the cost associated with, ***inter alia***, the length and number of launders needed to convey molten copper from a blister copper producing furnace to a plurality of blister copper refining (anode) furnaces, the number of holes needed in the blister copper producing furnace for a given number of launders and anode furnaces employed and the avoidance of the potential leakage associated with the increased number of holes present in the blister copper producing furnace. ***Compare In re Ludwig***, 353 F.2d 241, 147 USPQ 420 (CCPA 1965). Thus, the economic advantages readily apparent from simple observation of the branched launders taught by Bibby (as opposed to unbranched launders) alone would also have led one of ordinary skill in the art to the claimed subject matter. ***See In re Thompson***, 545 F.2d 1290, 1294, 192 USPQ 275, 277 (CCPA 1976)("Eliminating the cost of the preliminary step of wax impregnation would have been sufficient motivation for doing so."); ***In re Clinton***, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976)("Economics alone would motivate a person of ordinary skill in the art...").

This finding is also supported by the appellants' arguments in related appeals, Appeal Nos. 2001-0310 and 1999-2411, which

indicate that the alleged advantages are apparent from simple observation of the claimed subject matter.

Even were we to consider this finding to be erroneous, our conclusion would not be altered since there is an additional basis for supporting obviousness within the meaning of 35 U.S.C. 103. Specifically, we found at pages 11-15 of the decision entered November 30, 2003 that both Smith and Hoffman teach employing known launders, inclusive of the branched launders taught by Bibby, to alternately convey molten copper from a blister copper producing furnace to a plurality of blister copper refining (anode) furnaces as indicated ***supra***. As the whole purpose of both the branched and unbranched launders is to convey molten copper from one furnace to another, one of ordinary skill in the art would have looked to the branched launders described in Bibby to improve the transport or conveyance of molten copper from a blister copper producing furnace to a plurality of blister copper refining (anode) furnaces. This is especially true since Bibby specifically teaches that its branched launders are useful for alternately conveying molten copper from an upstream furnace to a plurality of downstream furnaces as required by Smith or Hoffmann.

In view of the foregoing, the appellants' request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

ADRIENE LEPIANE HANLON Administrative Patent Judge	)
CHUNG K. PAK Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
CHARLES E. WARREN Administrative Patent Judge	)

CKP/lp

Appeal No. 1999-2318
Application No. 90/004,783

OBLON, SPIVAC, MCLELLAND
1940 DUKE STREET
ALEXANDRIA, VA 22314

RALPH A. DOWELL
DOWELL AND DOWELL
SUITE 309 1215 JEFFERSON DAVIS HWY.
ARLINGTON, VA 22202

90004783.093003

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/004,786	10/06/97	4733665	

QM31/1003

JOHN P MILNAMOW
DRESSLER ROCKEY MILNAMOW & KATZ LTD
180 NORTH STETSON AVENUE SUITE 4700
CHICAGO IL 60601

EXAMINER	
THALER, M	

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 10/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

#19

Reexam Control No.: 90/005,677	:	
Filed: March 31, 2000	:	
For: U.S. Patent No. 4,733,665	:	DECISION MERGING
	:	REEXAMINATION
Reexam Control No.: 90/004,916	:	PROCEEDINGS
Filed: February 18, 1998	:	
For: U.S. Patent No. 4,733,665	:	
Reexam Control No.: 90/004,786	:	
Filed: October 09, 1997	:	
For: U.S. Patent No. 4,733,665	:	

The above reexamination requests are before the Director of Patent Examining Group 3300 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in 90/005,677 was ordered in a decision mailed June 08, 2000. Reexamination in 90/004,916 was ordered in a decision mailed May 12,1998. Reexamination in 90/003,582 was ordered in a decision mailed December 09, 1997

Merger is proper if a reexamination is ordered while a prior reexamination proceeding(s) is pending. In view of the above, merger is appropriate and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims and claim numbering in all proceedings. A housekeeping amendment was filed in Reexamination Proceeding 90/005,677 in the amendment of July 11. 2000.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action which applies to both reexamination files. The action will contain identifying data for all files and will be physically entered in each

reexamination file. Any response filed by the Patent Owner must consist of a single response filed with one copy, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See CFR 1.550(e).

In order to expedite matters, the Patent Owner has filed on July 11, 2000 a housekeeping amendment and has waived the filing of a Patent Owner's Statement. As such, the application is being forwarded to the examiner in charge for appropriate action.

Angela D. Sykes for
John Kittle, Director
Technology Center 3700

JK:amo

John P. Milnamow
Dressler, Rockey, Milnamow, and Katz
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180 Stetson Avenue, Suite 4700
Chicago, IL 60601

(For Patent Owner)

Spiro Bereveskos, Esq.
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111 Monument Circle, Suite 3700
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(For Requestor)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/004,807	10/20/97	5465213	

LM21/0428

WILLIAM B CUNNINGHAM JR
POLSTER LIEDER WOODRUFF & LUCCHESI
763 SOUTH NEW BALLAS ROAD
ST LOUIS MO 63141-8750

EXAMINER	
GORDON, P	
ART UNIT	**PAPER NUMBER**
2786	18

DATE MAILED: 04/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

90004807 .062200

See attatched.

PTO-90C (Rev. 2/95)

1- File Copy

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 18

William B Cunningham, Jr.
Polster, Lieder, Woodruff & Lucchesi
763 South New Ballas Road
St. Louis, MO 63141-8750

U.S. Patent No. 5,465,213
Reexamination Control No. 90/004,807
Filed: October 20, 1997
For: SYSTEM AND METHOD FOR MANUFACTURING A SINGLE BOOK COPY

DECISION ON PETITION TO ACCEPT PAPERS AS TIMELY FILED

This is a decision on the Supplemental Petition to accept the response mailed August 6, 1999 as being timely filed in accordance with 37 C.F.R. § 1.8(b). The period to respond to the Examiner's action expired on August 11, 1999.

The petition is accompanied by the originally submitted amendment and a Certificate of Mailing signed by William B. Cunningham, Jr. dated August 6, 1999. The petition is also accompanied by a declaration from Mr. Cunningham attesting on a personal knowledge basis that the response was properly mailed to the appropriate address on August 6, 1999.

37 C.F.R. § 1.8(b) states:

> (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
>
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence,
>
> (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and
>
> (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the

correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

In the instant case, a copy of the original Response with a Certificate of Mailing and an attestation on a persona knowledge basis of the timely filing has been provided. The petition complies with the requirements set forth in 37 C.F.R. § 1.8(b).

The petition is **GRANTED**.

The application file is being forwarded to the technical support staff for entry of the response. From there, the application file will be forwarded to the examiner for consideration of the response.

Joseph J. Rolla, Director
Technology Center 2700
Communications & Information Processing

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 36

James E. Armstrong IV
ARMSTRONG WESTERMAN HATTORI
MCLELAND & NAUGHTON
Suite 1000
1725 K Street, NW
Washington, DC 20007

(For Patent Owner)

Judith A. Evans
JONES & VOLENTINE
12200 Sunrise Valley Drive
Suite 150
Reston, VA 20191

(For Requester)

MAILED
NOV 07 2001
REEXAM UNIT

In re reissue application of
Urano, et al.
Serial No. 09/810,650
Filed: March 15, 2001
For: U.S. Patent No. 5,216,135

In re Urano, et al.
Reexamination Proceeding
Control No. 90/004,812
Filed: October 23, 1997
For: U.S. Patent No. 5,216,135

DECISION MERGING REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,216,135 issued to Urano, et al., on June 1, 1993.

2. A request for reexamination of the '135 patent was filed by a third party requester on October 23, 1997, and the resulting reexamination proceeding was assigned Control No. 90/004,812. On December 11, 1997, reexamination was ordered in the '4812 proceeding.

3. A final rejection was mailed in the '4812 proceeding on September 22, 1998, in which claims 1-6 were rejected and claim 7 was indicated to be patentable. A response to the final rejection, accompanied by a notice of appeal, was filed on December 10, 1998, in the '4812 proceeding.

4. The Board of Patent Appeals and Interferences affirmed the rejection of claims 1-6 in the '4812 proceeding on September 24, 1999.

5. Patent owner appealed to the Court of Appeals for the Federal Circuit in the '4812 proceeding on November 19, 1999.

6. The Court of Appeals for the Federal Circuit affirmed the rejection of claims 1-6 in the '4812 proceeding on February 1, 2001.

7. On March 15, 2001, patent owner filed a reissue application which was assigned Application No. 09/810,650.

8. On March 16, 2001, patent owner filed a petition for panel rehearing and for rehearing *en banc* in the '4812 proceeding.

9. On May 8, 2001, on order denying both of the petitions for rehearing was filed in the '4812 proceeding.

10. The mandate of the Court issued on May 15, 2001, in the '4812 proceeding.

11. Notice of the filing of the reissue application was published in the *Official Gazette* on August 7, 2001.

12. A petition to correct the filing receipt was filed in the reissue application on October 2, 2001.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '4812 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the '4812 reexamination file shows that the original specification, drawings and patent claims are presently in the reexamination file. Claim 7 was indicated to be patentable, and the final rejection of claims 1-6 was affirmed by the Court of Appeals for the Federal Circuit. The Court mandate issued on May 15, 2001. The reexamination proceeding is awaiting conclusion of the proceeding via the examiner's preparation of a Notice of Intent to Issue Reexamination Certificate.

A review of the reissue (Application No. 09/810,650) prosecution history shows that the reissue application was published in the *Official Gazette* on August 7, 2001. The application is awaiting a first Office action on the merits by the examiner. In the

reissue application, applicant has canceled claims 1-6, amended claim 7 and submitted new claims 8-9 for consideration. Thus, the claims are not identical in both proceedings. In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceeding are *sua sponte* merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 09/810,650, and Control Number 90/004,812. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should comply with the requirements for a response, as set forth below in Part III, the 2nd and 3rd paragraphs.

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding. Each action will be physically entered into both files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in both files, with each of the two copies bearing a signature. Any such responses must be served on the requester, who will also be sent copies of all Office actions. See 37 C.F.R. § 1.550(e).

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of

rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 C.F.R. § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continued prosecution as to the reexamination proceeding.

CONCLUSION

1. The above-identified reissue application and reexamination proceeding **ARE MERGED** into a single consolidated proceeding.

2. The reissue application file and the reexamination file are being forwarded to the Group Director of Technology Center 1600. All further examination should be conducted in accordance with this decision.

3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding.

4. The examiner should issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding **after** the earlier of:

   (a) the submission of the housekeeping amendment to place the same amendments in both cases

   (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.

5. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

November 7, 2001

90004812.110701

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/810,650	05/15/01	Fumiyoshi Urano	910094RI

PATENT NUMBER	DATE OF THIS NOTICE
5,216,135	11-07-01

PAPER NUMBER
37

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/ 004812 Filing Date: 10/23/97

Requester (name, address) Judith A. Evans
Jones & Volentine
12200 Sunrise Valley Drive
Suite 150
Reston, VA 20191

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/ 004812, filed 10/23/97, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

FORM PTO-1527
(3-84)

#34
(mail.

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WASHINGTON, D.C. 20231
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NIXON & VANDERHYE
1100 North Glebe Rd.
8th Floor
Arlington, VA 22201-4714

(For Patent Owner)

MAILED

DEC 20 2000

REEXAM UNIT

In re Stamper et al.
Reexamination Proceeding
Control No. 90/004,843
Filed: November 21, 1997
For: U.S. Patent No. 5,267,734

DECISION GRANTING PETITION

DO NOT ENTER

This is a decision on the November 21, 2000, patent owner PETITION UNDER 37 CFR 1.182 requesting entry and consideration of an amendment filed subsequent to the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed October 20, 2000. Petitioner urges that the amendment is necessary to prevent impermissible broadening of the claims. The petition is before the Office of Patent Legal Administration for decision.

The petition is granted for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,267,734 issued to Stamper et al. on December 7, 1993.

2. On November 21, 1997, a request for reexamination of U.S. Patent No. 5,267,734 was filed by patent owner, and was assigned Control No. 90/004,843.

3. On February 19, 1998, reexamination was ordered in the '4843 proceeding.

4. Prosecution took place and a final rejection was mailed on January 14, 1999, which set a two (2) month shortened statutory period for response.

5. A request for a one (1) month extension of time was filed on March 4, 1999, and was granted in a decision mailed on March 15, 1999.

6. A Notice of Appeal was filed on April 14, 1999, and an Appeal Brief was filed on July 14, 1999.

7. On July 17, 2000, an amendment was filed and entered.

8. On October 20, 2000, a Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed.

9. On November 21, 2000, patent owner filed the present PETITION PURSUANT TO 37 CFR 1.182 requesting entry and consideration of an amendment filed subsequent to the NIRC.

Decision on Petition

DECISION

The petition is **granted**.

Petitioner proposes to amend three claims to re-insert two words ("controller means") previously removed by Patent Owner's July 17, 2000, amendment. Petitioner contends that the amendment is necessary to prevent the scope of original claim 7 and new claims 145 and 147, from being impermissibly broadened.

Petitioner states that the claims were improperly broadened in violation of 35 USC 305. A proposed amendment accompanies the petition removing the broadening language. In view of the statutory prohibition of broadening claims in a reexamination, it is appropriate that the amendment be entered and considered by the examiner.

REQUIREMENT FOR HOUSEKEEPING AMENDMENT

The proposed amendment which accompanies the present petition is not in conformance with the amendment format for reexamination proceedings, which is set forth in 37 CFR 1.530(d)(2). The amendment to claim 8 does not include the entire text of the claim which is being proposed to be amended, as a portion of the patent claim was omitted. Specifically, in the amendment to patent claim 8, line 10, "that controls", should be -that at least partially controls-. Also, in new claims 145-165, the bold font appearing in the latter portion of the claims is inappropriate and should be omitted. Further, in claims 1 and 7-8, "(As Cumulatively Amended)" is inappropriate, and instead a parenthetical expression "amended," "twice amended," *etc.*, should follow the original claim number.

Therefore, in response to this decision, petitioner is required to submit a housekeeping amendment which complies with 37 CFR 1.530(d)(2), within **one (1) month** of the mailing date of this decision granting the petition. The amendment should incorporate the missing language of claim 8, remove the bold font from new claims 145-165, and include in the amended patent claims a parenthetical expression "amended," "twice amended," *etc.*, following the original claim number, as per 37 CFR 1.530(d)(2)(i)(C).

CONCLUSION

1. The petition is **GRANTED.**

2. A housekeeping amendment must be filed within ONE (1) MONTH of the mailing date of this decision.

3. The reexamination file is being returned to Technology Center 3700 for consideration of the proposed amendment and either the reopening of prosecution or the issuance of a supplemental NIRC. If a housekeeping amendment is not received within ONE (1) MONTH of the mailing date of this decision, prosecution will be reopened and an appropriate Office action will be issued.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Gerald A. Dost

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

December 19, 2000

DOCKET ALARM

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

#18

MAILED
JUN 14 2000
Group 3700

Reexam Control No.: 90/004,848 Filed: November 25, 1997 For: U.S. Patent No. 5,383,879	DECISION MERGING REEXAMINATION PROCEEDINGS
Reexam Control No.: 90/004,999 Filed: June 04, 1998 For: U.S. Patent No. 5,383,879	
Reexam Control No.: 90/005,030 Filed: July 02, 1998 For: U.S. Patent No. 5,383,879	
Reexam Control No.: 90/005,450 Filed: August 18, 1999 For: U.S. Patent No. 5,383,879	
Reexam Control No.: 90/005,561 Filed: November 17, 1999 For U.S. Patent No.: 5,383,879	

The above reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in 90/004,848 was ordered in a decision mailed February 06, 1998. Reexamination in 90/004,999 was ordered in a decision mailed July 14, 1998. Reexamination in 90/005,030 was ordered in a decision mailed July 09, 1998. Reexamination in 90/005,450 was ordered in a decision October 18, 1999. Reexamination in 90/005,561 was ordered in a decision mailed February 03, 2000.

The first three reexamination proceedings are already merged. Merger is proper if a reexamination is ordered while a prior reexamination proceedings are pending. Accordingly, merger is appropriate for 90/005,450 and 90/005,561 and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims and identical claim numbering in all five files. A housekeeping amendment is required in 90/005450 and in 90/005561.

90004848, 6/14/2000

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action which applies to all five reexamination files. The action will contain identifying data for all files and will be physically entered in each reexamination file. Any response filed by the Patent Owner must consist of a single response filed with four copies, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See CFR 1.550(e).

At this time the Patent Owner is required to file a housekeeping amendment in Reexamination Proceedings 90/005,450 and 90/005,561 so that the claims in all three proceedings are identical in content and numbering. The Patent Owner is given 1 month from the date of this letter to file the housekeeping amendments.

John J. Love

John J. Love, Director
Technology Center 3700

JJL:amo

Ronald W. Citkowski
Gifford, Krass, Groh, Sprinkle,
Anderson and Citkowski
280 N. Old Woodward, Suite 400
Birmingham, MI 48009

(For Patent Owner)

90/004,999
90/005,030
90/005,450
90/005,561

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(For Requester)

90004848.112597

UNITED STATES PATENT AND TRADEMARK OFFICE

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AR

#24

Vito J. BeBari
KRAMER LEVIN NAFTALIS AND FRANKEL
919 THIRD AVENUE
NEW YORK, NY 10022

(For Patent Owner)

MAILED
AUG 22 2002
REEXAM UNIT

Gregory L. Bradley
MEDRAD, INC.
ONE MEDRAD DRIVE
INDIANOLA, PA 15051

(For Requester)

In re Heffernan et al.
Reexamination Proceeding
Control No. 90/004,870
Filed: December 12, 1997
For: U.S. Patent No. 5,620,425

In re Heffernan et al.
Reexamination Proceeding
Control No. 90/005,344
Filed: April 26, 1999
For: U.S. Patent No. 5,620,425

DECISION GRANTING PETITION UNDER 37 CFR 1.137(b)

Decision Mailed

This is a decision on the August 9, 2002, patent owner PETITION UNDER 37 C.F.R. § 1.137(b) TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION, requesting revival of the present proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $1280 for a petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 50-0540, in accordance with petitioner's authorization in the last paragraph of the present petition. See 37 CFR 1.17(m).

The petition is granted.

DECISION

1. The statement of unintentional delay presented in the petition is:

> "The entire delay in filing the required Notice of Appeal from the due date for the Notice of Appeal through the mailing date of this Petition was unintentional."

Effective December 1, 1997, 37 CFR 1.137(b)(3) requires the submission of a statement that "the entire delay in filing the required reply from the due date for the reply until **the filing** of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" [Emphasis added] The above-quoted statement does not comply with the current rule. However, the statement presented will be accepted and so construed. If this is an incorrect interpretation in view of the rules, petitioner is required to promptly provide a statement to that effect.

2. An appropriate response to the outstanding Office action has been received, i.e., the August 9, 2002, Notice of Appeal, containing authorization therein to charge the appeal fee under 37 CFR 1.17(b), which has been filed as an attachment to the present petition.

3. The instant petition is accompanied by a statement that has been accepted and construed as an appropriate statement pursuant to 37 CFR 1.137(b)(3), and by a response to the outstanding Office action. Further, payment of the required petition fee has been authorized. Accordingly, the petition is granted.

REINSTATEMENT OF MERGER

The present '4,870 and '5,344 reexamination proceedings are restored to pendency as a result of the granting of patent owner's petition in this decision. Accordingly, the merger of the two proceedings of the November 30, 1999, decision is hereby reinstated, and the merged proceeding will be conducted as stated in that decision.

PATENT OWNER FURTHER ACTION IN THE PROCEEDING

It is to be noted that a 2-month period for filing the appeal brief and fee is set below to run from the date of mailing of this decision. The patent owner cannot rely on the "Amendment Under 37 C.F.R. §1.116" submitted with the present petition to keep the present proceeding pending beyond that 2-month period. Pursuant to 37 CFR 1.116(b), "[t]he admission of, or refusal to admit, any amendment after a final rejection...will not operate to relieve the...patent under reexamination from its condition as subject to appeal or to save ...the reexamination from termination." Thus, it is patent owner's responsibility to take any steps needed to keep the present proceeding pending.

CONCLUSION

1. The petition is **granted**, and the merger of the '4,870 and '5,344 reexamination proceedings is reinstated.

2. THE 2-MONTH PERIOD FOR FILING THE APPEAL BRIEF, IN TRIPLICATE, ACCOMPANIED BY THE FEE REQUIRED BY LAW, RUNS FROM THE DATE OF THIS MAILING.

3. The reexamination file is being returned to Technology Center 3700 for the examiner's review of the "Amendment Under 37 C.F.R. §1.116" received with the petition, and issuance of an action advising patent owner of the status of the merged proceeding as a result of that amendment.

4. Any further communications as to the merits of the proceeding should be directed to the primary examiner, Anh-Tuan T. Nguyen, in Technology Center 3763.

5. Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

C:\KIVA\KPET-ABE\5344UNIN.GRT; 8-21-02

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Reexam Control No.: 90/004,888 :
Filed: January 09, 1998 : DECISON ON PETITION
For: U.S. Patent No. 4,903,695 : FOR EXTENSION OF TIME
Title: Method And Apparatus For :
Performing A Keratomileusis :
Or The Like Operation

Paper No.: 24

This is a decision on applicant's request for an extension of time in the above-identified Reexamination Proceeding to file a response to the outstanding Office action mailed January 14, 2000. Accordingly, a response is due on or before February 14, 2000. This request is for an additional one month extension to March 14, 2000. The request is filed pursuant to 37 CFR 1.550(c).

A review of the petition indicates that sufficient cause for an extension for the time requested has been established. Accordingly, the request is granted. No further extension of time for the response to the outstanding Office action will be granted unless it can be shown that unforeseeable and extraordinary circumstances exist.

John J. Love, Director
Technology Center 3700
703 308-0873

JJL:amo

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(For Patent Owner)

Fulbright and Jaworski
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Wshington, D.C. 20004-2615

(For Requester)

Docket No.: 2860-0032-25X REEXAM
IN RE REEXAMINATION OF
PATENT NO.: 4,903,695
ISSUED: FEBRUARY 27, 1990
PATENTEE: WARNER ET AL.
REEXAM CONTROL NO. 90/004,888

THIS IS A FILING RECEIPT

PAPER FILED: REQUEST FOR ONE MONTH EXTENSION OF TIME

RECEIVED
JAN 21 2000
TECHNOLOGY CENTER 3700

Docket No.: 2860-0032-25X REEXAM

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE REEXAMINATION OF PATENT NO.: 4,903,695 ISSUED: FEBRUARY 27, 1990 PATENTEE: WARNER ET AL.	: GROUP ART UNIT: 3311
REEXAM CONTROL NO. 90/004,888	:
FILED: JANUARY 09, 1998	:EXAMINER: DAVID SHAY

For: METHOD AND APPARATUS FOR PERFORMING KERATOMILEUSIS OR THE LIKE OPERATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Certificate of Mailing - 37 C.F.R. 1.8

REQUEST FOR ONE MONTH EXTENSION OF TIME

On January 19, 2000 the undersigned's firm received an office action date January 14, 2000 setting a one month period for response. That left 26 days (not all of which are business days) to respond to the office action.

The office action is 91 pages long.

In addition, the assignee Visx's Director of Intellectual Property, Freddie Park, who is overseeing this matter, will be out of her office for several days during that period for a Markman hearing.

In view of the length of the office action, the assignee of the patent does not believe that it will be able to fully and adequately respond to the rejections in the 26 days from the date of receipt of the office action until the date upon which a response is required.

Therefore the patentee requests a one month extension of time until March 14, 2000 to respond to the office action.

Respectfully submitted,

Richard A. Neifeld
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Extension of time granted. Formal letter to follow.
2/14/00

ALLEN M. OSTRAGER
SPECIAL PROGRAMS EXAMINER

NOTICE OF SERVICE

This paper notices service by Federal Express courier of a copy of this document on the reexamination requestor at the following address:

MARK E. UNGERMAN, ESQ.
FULBRIGHT & JAWORSKI, L.L.P..
801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, D.C. 20004-2615

1/20/00
DATE

RICHARD A. NEIFELD

I:\atty\RAN\clients\VISX\28600032\EOTRequest000120.wpd

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/004,888	01/09/98	4903695	300.217

QM22/0626
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ARLINGTON VA 22202

EXAMINER	
SHAY,D	
ART UNIT	**PAPER NUMBER**
3739	28

DATE MAILED: 06/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

DO NOT ENTER

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

In re Reexamination of
Patent No. 4,903,695
Issued: February 27,1990
Patentee: Warner, et al
Reexam Control No.: 90/004888
Filing Date: January 9, 1998
For: METHOD AND APPARATUS FOR PERFORMING KERATOMILEUSIS OR THE LIKE OPERATIONS

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. 1.181(a)(3), filed March 13, 2000, to withdraw the finality of the Office action mailed January 14, 2000.

The petitioner urges that the final Office action was premature because "...the examiner rejected the narrower claims 23-42 over the combination of Peyman and Barraquer, but he did not reject the broader claims 1 and 14-22 on those references... The patent owner provided the Barraquer reference to the examiner prior to the first Office action but the examiner did not rely on that reference in the first office action in the rejection of claims 1 and 3/1-11/1."

Petitioner's arguments concerning which references were used in the rejections of which claims is not of merit as to whether or not the finality of the Office action was proper or not. The question of finality of an action is solely based on whether or not the new grounds of rejection were necessitated by applicant's amendment. See MPEP §707(a). Applicant added new claims 23-42 after the first Office action thereby necessitating a new grounds of rejection on these claims by the examiner. The question of the validity of the rejection is an appealable, rather than a petitionable matter.

For the reasons given above, petitioner's request to withdraw the finality of the Office action mailed January 14, 2000 is denied.

Summary: Petition DENIED.

John J. Love
Director, Group 3730/3760
703 308-0873

JJL:lcmd

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(For Patent Owner)

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(For Requestor)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/004,888	01/09/98	4908695	300.217

QM12/0713
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUST
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EXAMINER
SHAY,D

ART UNIT	PAPER NUMBER
3739	29

DATE MAILED: 07/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev 2/95)
U S G P O 2000, 465-188/25266
1- File Copy

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Reexam Control No.: 90/004,888	:	
Filed: January 14, 1998	:	
For: U.S. Patent No. 4,903,695	:	DECISION
	:	MERGING
	:	REEXAMINATION
Reexam Control No.: 90/005,706	:	PROCEEDINGS
Filed: April 27, 2000	:	
For: U.S. Patent No. 4,903,695	:	

The above reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in 90/004,888 was ordered in a decision mailed April 06, 1998. Reexamination in 90/005,706 was ordered in a decision mailed July 07, 2000.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending. In view of the above, merger is appropriate and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims in both files. Upon entry of the amendment filed after final rejection in 90/004,888, and upon entry of the Preliminary Amendment in 90/005,706, both proceedings will have identical claims. No further amendment is required.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action which applies to both reexamination files. The action will contain identifying data for all files and will be physically entered in each reexamination file. Any response filed by the Patent Owner must consist of a single response filed with one copy, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See CFR 1.550(e).

Since there is no further amendment needed from the Patent Owner, the merged proceedings will be returned to the examiner in charge ion on the merits on all the pending claims as amended and added in the latest amendment. The Final Rejection in 90/4888 is hereby withdrawn to allow the examiner to consider the newly entered amendment.

for John J. Love, Director
Technology Center 3700

JJL:amo

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

FEB 25 2000

PEW
Paper Number 22

In re application of
Rolf Ryham
Serial No. 90/004,891
Filed: January 13, 1998
For: METHOD OF RECOVERY OF TURPENTINE AND HEAT IN A REFINER PULPING PROCESS

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT of the application for failure to respond to the Office action dated December 1, 1999. The petition requests that the abandonment be withdrawn since the applicant did timely respond to the Office action in a paper PTO date stamped on December 10, 1999.

DECISION

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181(no fee) - no abandonment-in-fact. A review of the application record and the evidence presented establishes that applicant did timely respond to the Office action dated December 1, 1999 as evidenced by the copy of the response having a PTO date stamp of December 10, 1999. Applicant's Petition for Review of the Propriety of Non-Compliance, filed concurrently with the instant petition, will be treated as a response to the Office action dated December 1, 1999. The latter petition will be addressed in a separate communication.

The Petition is **GRANTED**

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/004,891	01/13/98	4925527	Y51.608.9

IM22/0315

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EXAMINER	
ALVO, M	
ART UNIT	PAPER NUMBER
1731	24 23 1/2

DATE MAILED: 03/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Mailed:

JWM
Paper Number 24

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(for Patent Owner)

David T. Hunter
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(for Requestor)

In re Ryham
Reexamination Proceeding
Control No. 90/004,981
Filed: January 13, 1998
For: U.S. Patent No. 4,925,527

DECISION RE
PROPRIETY OF
NOTIFICATION OF
NON-COMPLIANCE
UNDER 37 C.F.R. 1.192(c)

This is a decision from the appellant's PETITION FOR REVIEW OF THE PROPRIETY OF THE NOTIFICATION OF NON-COMPLIANCE ISSUED DECEMBER 1, 1999, filed December 10, 1999 requesting reconsideration and withdrawal of the Notification of Non-Compliance With The Requirements Of 37 CFR 1.192(c), mailed December 1, 1999. The petitioner asserts that the appellant's APPEAL BRIEF of August 18, 1999 is in compliance with the requirements of 37 CFR 1.192(c)(7) and (9). The petitioner argues that the BRIEF:

> 1) complies with 37 CFR 1.192(c)(7) by making an argument for each of the claims at pages 19-28 of the appellant's BRIEF, and
> 2) does comply with 37 CFR 1.192(c)(9) in that the errors in printing the claims that were allowed in the Application Serial No. 07/313,797 should not be regarded as a reason for failure to submit a brief in compliance with 37 C.F.R. 1.192(c)(9). The claims of the appendix are the claims that were allowed.

DECISION

A careful review of the application record indicates that the APPEAL BRIEF of August 18, 1999 does satisfy all of the requirements set forth in 37 CFR 1.192(c)(7). Specifically, the appellants' BRIEF does provide individual arguments in support of the patentability of each individual claims relative to the prior art in the BRIEF as follows:

Pages 7-15 regarding claim 7,
Page 19, lines 12-20, regarding claim 8,
Page 16 regarding claim 14,
Page 19, lines 12-20, regarding claims 15-19,
Pages 17-19 regarding claim 20,
Page 19, lines 12-20, regarding claims 21, 22,
Pages 20-23 regarding claims 32, 33,
Pages 24-28 regarding claims 34, 35
Pages 20-23 regarding claims 36, 37, and
Pages 24-28 regarding claims 38, 39.

Additionally, with the filing of a proper AMENDMENT on March 13, 2000 correcting the typographical errors during the printing of the original claims 7, 20, and 21, the examiner's objections under 37 C.F.R. 1.192(c)(9) are rendered moot.

Therefore, the appellants' BRIEF is in complete compliance with the requirements of 37 CFR 1.192(c)(7) and (c)(9). See also MPEP 1206.

The Notification of Non-Compliance With The Requirements Of 37 CFR 1.192(c), mailed December 1, 1999, is hereby vacated, and the reexamination file returned to the examiner for prompt preparation of an Office action. An Office shall follow in due course.

The Petition is **GRANTED.**.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DISSOLVED AS OF 06/07/2005

LEA/GAD

#88

A. Jason Mirabito (For Patent Owner)
Thomas M. Sullivan
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
One Financial Center
Boston, MA 02111

MAILED
AUG 26 1999
REEXAM UNIT

Walter E. Hanley, Jr. (For Requester)
Kenyon & Kenyon
One Broadway
New York, NY 10004

In re reissue application of :
Peters, et al. :
Serial No. 08/418863 :
Filed: April 7, 1995 :
For: U.S. Patent No. 5,045,940 : DECISION, SUA SPONTE, TO MERGE
: REEXAMINATION AND
In re Peters, et al. : REISSUE PROCEEDINGS
Reexamination Proceeding :
Control No. 90/004,520 :
Filed: January 10, 1997 :
For: U.S. Patent No. 5,045,940 :
:
In re Peters, et al. :
Reexamination Proceeding :
Control No. 90/004,895 :
Filed: October 31, 1997 :
For: U.S. Patent No. 5,045,940 :

In re Peters, et al. :
Reexamination Proceeding :
Control No. 90/005,274 :
Filed: February 16, 1999 :
For: U.S. Patent No. 5,045,940 :

The above noted reexamination files and reissue application are before the Office of the Deputy Assistant Commissioner for Patent Policy and Projects, sua sponte, for a decision on whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,045,940 issued September 3, 1991.

2. On September 3, 1993, a first reissue application was filed.

3. On April 7, 1995, a file-wrapper continuation of the first application for reissue of the '940 patent was filed. Since the file-wrapper continuation reissue application is the only reissue application remaining, it will hereinafter be referred to simply as "the reissue application." The reissue application includes newly added claims 68 - 100 and 102 - 114, in addition to the claims 1 - 16, the number of claims originally in the patent.

4. On January 10, 1997, a request for reexamination of the patent was filed by a third party, Media 100, Inc.

5. On March 11, 1997, reexamination was ordered.

6. On April 26, 1997, Reissue Application No. 08/418,863 and Reexamination Proceeding Control No. 90/004,520 were merged.

7. On July 25, 1997, an Office action was mailed in which all claims were rejected.

8. On October 31, 1997, a second request for reexamination of the patent was filed by the third party, Media 100, Inc. (Reexamination Proceeding Control No. 90/004,895).

9. On January 27, 1998, reexamination was ordered in Reexamination Proceeding Control No. 90/004,895.

10. On April 13; 1998, Reissue Application No. 08/418,863 and Reexamination Proceedings Control Nos. 90/004,520 & 90/004, 895 were merged.

11. On February 16, 1999, a third request for reexamination of the patent was filed by third party, Media 100, Inc.

12. On April 27, 1999, reexamination was ordered in Reexamination Proceeding Control No. 90/005,274.

DISCUSSION

Under 37 CFR § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the three reexamination proceeding are currently pending. As the order to reexamine has been mailed in the third reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reasons for this policy is to prevent inconsistent, and possible conflicting amendments from being introduced into the two proceedings on behalf of the patent owner. Normally the proceedings will be merged whenever it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the proceedings consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue prosecution history shows that the announcement of the filing of the reissue application was published in the Official Gazette on August 15, 1995, thereby permitting the issuance of a first action on the merits after October 15, 1995. 37 CFR § 1.176. New claims have been added in the reissue application. A review of the Control No.90/005,274 reexamination file shows that the reexamination is awaiting an Office action by the examiner.. The original specification, drawings and patent claims are presently in the '274 reexamination file. The claims are not identical in all four proceedings. In order to provide efficient and prompt handling of all four proceedings and to prevent inconsistent, and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexaminations will be in accordance with the decision set forth below.

DECISION

I. Merger of Proceedings

The above noted reissue and reexamination proceedings are, sua sponte, merged. A joint

examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination files for purposes of the merged proceedings. The maintenance of identical amendments in the four files is required as long as the proceedings are merged. See 37 CFR § 1.565(d). An appropriate housekeeping amendment is required within one month of this decision placing the same amendments in all four proceedings. The patent owner should not address the issues of any of the proceedings in the housekeeping amendment.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

In view of the fact that the statutory provisions for reissue application examination include, inter alia, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader reissue application examination. The examiner will apply the reissue statute, rules and case law to the merged proceeding. The examiner's actions will take the form of a single action which jointly applies to both the reissue application and the reexamination proceedings. The action will contain identifying data for all of the reissue application and the reexamination proceedings and will be physically entered into all four files which will be maintained as separate files. Any response by the applicant/patent owner must consist of a single response, filed in quadruplicate, each bearing an original signature, for entry in the four files. Any such responses must be served on the requester who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned and the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged (reissue and reexamination) proceeding and continue the three reexamination proceedings (which will remain merged). Any grounds of rejection which are not applicable under reexamination should be withdrawn (e.g., based on public use or sale) and any new grounds of rejection which are applicable under reexamination (e.g., improper broadened claims) should be made by the examiner upon dissolution of the merged (reissue and reexamination) proceeding. The existence of any questions remaining which cannot be considered under reexamination following dissolution of the merged (reissue and reexamination) proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

If the reissue application ultimately matures into a reissue patent the reexamination proceedings shall be terminated by the grant of the reissued patent and the reissued patent will also serve as the certificate under § 1.570. See MPEP 2285.

Applicant/patent owner is advised that the filing of any continuation reissue application under 37 CFR § 1.53 will most likely result in the dissolution of the merged (reissue and reexamination) proceeding, a stay of the continuing reissue application, and separate, continued prosecution of the current merged reexamination proceedings.

IV. Remand for Examination

The above noted reissue application and reexamination proceedings are merged. The reissue application and the reexamination files are being forwarded to the Technology Center 2700 for examination in accordance with this decision.

Inquiries concerning this decision should be directed to the undersigned at (703)305-9285.

Lawrence E. Anderson
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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MAILED

JUN 0 7 2005

REEXAM UNIT

In re Peters, et al.
Reexamination Proceeding
Control No. 90/004,520
Filed: January 10, 1997
For: U.S. Patent No. 5,045,940

In re Peters, et al.
Reexamination Proceeding
Control No. 90/004,895
Filed: October 31, 1997
For: U.S. Patent No. 5,045,940

In re Peters, et al.
Reexamination Proceeding
Control No. 90/005,274
Filed: February 16, 1999
For: U.S. Patent No. 5,045,940

In re Reissue Application of
Peters, et al.
Application No. 09/971,236
Filed: October 4, 2001
For: U.S. Patent No. 5,045,940

In re Reissue Application of
Peters, et al.
Application No. 08/418,863
Filed: April 7, 1995
For: U.S. Patent No. 5,045,940

DECISION, *SUA SPONTE*, DISSOLVING AND MERGING REISSUE AND REEXAMINATION PROCEEDINGS

The above reissue and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of:

(1) Whether the August 26, 1999 merger of reexamination Control Nos. 90/004,520, 90/004,895, and 90/005,274, and reissue Application No. 08/418,863, should be dissolved at this time; and

(2) Whether reexamination Control Nos. 90/004,520, 90/004,895, and 90/005,274 should, at this time, be merged under 37 CFR 1.565(d) with reissue Application No. 09/971,236.

REVIEW OF FACTS

1. U.S. patent No.5,045,940 (hereinafter, the '940 patent) issued on September 3, 1991, with 16 claims.

2. On September 3, 1993, an application for reissue of the '940 patent was filed, and was assigned application number 08/418,863 (hereinafter, the '863 application).

3. On April 7, 1995, a file-wrapper continuation of the'863 application was filed. The file-wrapper continuation application included newly added claims 68-100 and 102-114, in addition to original claims 1-16 of the '940 patent.

4. A first request for reexamination was filed by a third party requester on January 10, 1997, and the resulting proceeding was assigned control number 90/004,520 (hereinafter, the '4520 proceeding).

5. An order for reexamination of the '4520 proceeding was mailed on March 11, 1997.

6. On April 26, 1997, the '863 reissue application and the '4520 reexamination proceeding were merged.

7. On July 25, 1997, an Office action was mailed for the merged proceeding; all claims were rejected.

8. A second request for reexamination was filed by the third party requester on October 31, 1997, and the resulting proceeding was assigned control number 90/004,895 (hereinafter, the '4895 proceeding).

9. An order for reexamination of the '4895 proceeding was mailed on January 27, 1998.

10. On April 26, 1997, the '863 reissue application and the '4520 and '4895 reexamination proceedings were merged.

11. A third request for reexamination was filed by the third party requester on February 16, 1999, and the resulting proceeding was assigned control number 90/005,274 (hereinafter, the '5274 proceeding).

12. An order for reexamination of the '5274 proceeding was mailed on April 27, 1999.

13. On August 26, 1999, the '863 reissue application and the '4520, '4895, and '5274 reexamination proceedings were merged.

14. Prosecution for the merged proceeding progressed to the point where the examiner's final rejection of the proceeding claims was affirmed by the Board of Patent Appeals and Interferences.[1] The affirmance was appealed to the U.S. Court of Appeals for the Federal Circuit, and the decision of the Board was affirmed by the Federal Circuit.

15. On October 4, 2001, an application for reissue of the '940 patent was flled, and was assigned application number 09/971,236 (hereinafter, the '236 application).

16. The filing of the '236 reissue application was announced in the *Official Gazette* on June 11, 2002.

17. Three preliminary amendments were filed for the '236 reissue application, the last one on December 13, 2004.

18. On May 20, 2005, a Notice of Abandonment was mailed for the '863 reissue application. The Notice stated that the application was abandoned "In view of decision by CAFC, which all claims are affirmed."

DECISION DISSOLVING MERGER OF '863 APPLICATION AND '4520, '4895, AND '5274 PROCEEDINGS

As noted above, the '863 reissue application has been abandoned, based upon the decision by the Federal Circuit affirming the Board. Since the '863 reissue application is now abandoned, the August 26, 1999 merger of '863 reissue application and the '4520, '4895, and '5274 proceedings is hereby dissolved.

Based on the October 4, 2001 filing of the '236 reissue application for the '940 patent, and the announcement of the

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[1] The pending claims that went up on appeal were original patent claims 3 and 7-16, and new claims: 68, 70, 74-84, 86, 87, 89, 93-98, 100, 102-115, 119-148, 150, 154-160. All of the above "pending" claims were finally rejected by the examiner, and the examiner was affirmed on all rejections of these claims.

'236 reissue application in the *Official Gazette*, further action with respect to the three reexamination proceedings will be taken as discussed in the sections of this decision which follow.

DISCUSSION REGARDING MERGER OF '236 APPLICATION AND '4520, '4895, AND '5274 PROCEEDINGS

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, the '236 reissue and the '4520, '4895, and '5274 proceedings are currently pending. Since the order to reexamine has been mailed in all of the reexamination proceedings (and the '236 application has been announced in the *Official Gazette*), a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. In making a decision on whether or not to merge the proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In the present instance, the '236 reissue application was filed prior to the date on which the three reexamination prosecutions would have terminated based on the Court's affirmance of the Board's decision (affirming the rejection of all the claims in the reexamination proceedings). If the three reexamination prosecutions were now terminated by the Office and a reexamination certificate was permitted to issue, then the provisions of 37 CFR 1.570(d) would apply as follows:

> "If an *ex parte* reexamination certificate has been issued which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto."

Given that the '236 reissue application was filed prior to the date on which the three reexamination prosecutions would have terminated, it would be inequitable to now terminate the three reexamination prosecutions and issue a reexamination certificate. Such a certificate would result in the barring of the '236 reissue application, even though the '236 application was filed prior to the date on which the three reexamination prosecutions would have terminated. In order to prevent this inequity, and, at the same time prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner (for the reissue and reexamination proceedings), it is appropriate that the instant '236 reissue application and the '4520, '4895, and '5274 reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the '236 reissue application and the three reexamination proceedings will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. *The present merger is not an assurance that, in a future similar situation, merger would be ordered, since each merger question [2] is considered on a case-by-case basis governed by the given fact situation for the merger question to be considered.*

DECISION MERGING THE '236 REISSUE APPLICATION AND '4520, '4895, AND '5274 REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The'236 reissue application and the'4520, '4895, and '5274 reexamination proceedings are hereby **merged** into a single proceeding (hereinafter, "the merged proceeding"). A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings and to Provide Formal Amendments

1. The patent owner is required to maintain identical amendments in the reissue application and the

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[2] I.e. each decision of whether to merge or supend, or take other appropriate action.

reexamination proceedings for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

A review of the '236 reissue application shows that all of the original patent claims, i.e., claims 1-16, are cancelled, and new claims 17-88 are present. A review of the files for the three reexamination proceedings shows the following claim status:

Pending patent claims: 3 and 7-16.
Canceled patent claims: 1, 2, and 4-6.
Pending new claims: 68, 70, 74-84, 86, 87, 89, 93-98, 100, 102-115, 119-148, 150, 154-160.
Canceled new claims: 17-67, 69, 71-73, 85, 88, 90-92, 99, 101, 116-118, 149, 151-153.

Accordingly, the claims are not identical in both proceedings.

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the same amendments in all of cases.

2. For a merged proceeding of a reissue application and an *ex parte* reexamination proceeding, MPEP 2285 states:

> "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Accordingly, the filing of amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

The December 13, 2004 amendment (confirmation copy filed January 31, 2005) submitted in the '236 reissue application fails to comply with the above. For example, claim 62 uses strike through for "signalling." Also, the text of claims 17-72 is not underlined in its entirety, even though those claims are new to the '940 patent.

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the amendments in all of cases in the form required by 37 CFR 1.173.

3. The response to these requirements must be limited to placing the same amendments in all cases and providing the amendments in the form required by the rules. The patent owner must **not** address any issue of patentability in the housekeeping amendment.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that an appropriate housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the '236 reissue application and the three reexamination proceedings. Each action will contain identifying data *for all of the cases*, i.e, the '236 reissue application and the three reexamination

proceedings, and each action will be entered into all files (which will be maintained as separate files). Note that there will **not** be any identifying data nor entry of papers for the '863 reissue application, since the '863 reissue application has been held abandoned, and is no longer merged within the present merged proceeding.

5. Any response by the applicant/patent owner must consist of a single response, with four copies being filed for entry in the four files, with each of the four bearing a signature. Any such response must contain identifying data *for all of the cases*, i.e, the '236 reissue application and the three reexamination proceedings. *Any such responses must be served on the requester*, who will also be sent copies of Office actions. Note that there will **not** be any identifying data nor providing of papers for the '863 reissue application, since the '863 reissue application has been held has been held abandoned, and is no longer merged within the present merged proceeding.

6. Pursuant to MPEP 2285:

> "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Thus, as pointed out above, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does <u>not</u> apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Also as pointed out above, pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appeal brief, even though the brief relates to the merged multiple proceedings, and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

8. Upon return of the present merged proceeding to the examiner, the examiner (a) will review the files to ensure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as are necessary as part of the next Office action in order to place the files in that condition.

9. If the reissue application ultimately matures into a reissue patent, the three reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed, e.g., as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which could not be considered under reexamination following the dissolution would be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceedings. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. The August 26, 1999 merger of '863 reissue application and the '4520, '4895, and '5274 proceedings is dissolved.

2. The'236 reissue application and the '4520, '4895, and '5274 reexamination proceedings **are merged** into a single proceeding.

3. Pursuant to Part II of this decision, it is required that applicant/patent owner file, **within ONE MONTH of this decision**, a housekeeping amendment (A) placing the same amendments in all cases of the present merged proceeding and (B) placing the amendments in the form required by 37 CFR 1.173.

4. The reissue and reexamination proceedings are being forwarded to the examiner via the Director of Technology Center 2600. Upon receipt of same, the examiner **should not issue an Office action for the present merged proceeding of the '236 reissue and reexamination proceedings until after the earlier of** (a) the submission of the housekeeping amendment to place the same amendments in both cases and formalize the amendment or (b) the expiration of the one month period from the mailing of this decision for filing the amendment.

5. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

6. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

June 6, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

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January 4, 2001

Paper No. 23

William J. Hone
Fish and Richardson
45 Rockefeller Plaza
New York, NY 10111

(For Patent Owner)

Enclosure: Paper filed December 16, 2000

A. Jason Mirabito
Mintz, Levin, Cohn, Ferris, Glovsky & Popeo
One Financial Center
Boston, MA 02111

(For Third Party Requester)

In re Mullis et al.
Reexamination Proceeding
Control No. 90/004,726
Filed: August 18, 1997
For: U.S. Patent No. 5,333,675

In re Mullis et al.
Reexamination Proceeding
Control No. 90/004,909
Filed: January 20, 1998
For: U.S. Patent No. 5,333,675

: DECISION DISMISSING
: PETITION AND RETURNING
: IMPROPER PAPER

This is a decision on the December 16, 2000, petition filed under 37 CFR 1.182 by the patent owner requesting the Commissioner to withdraw the Notice of Intent to Issue a Reexamination Certificate, and direct the examiner to consider third party papers directed to the issue of inventorship of one or more claims of the patent. The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed.

37 CFR 1.550(g) provides (in part):

> "The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered."

37 CFR 1.550(g) additionally provides:

> "[N]o submissions on behalf of any third parties will be acknowledged or considered unless such submissions are (1) in accordance with § 1.510 or § 1.535; or (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525."

The petition under 37 CFR 1.182 filed by the patent owner on December 16, 2000, after the period for active participation of the reexamination third party requester had ended, is an improper submission under 37 CFR 1.550(g) because it includes a submission on behalf of the third party reexamination requester. The rules provide that the active participation of the reexamination requester ends with the reply under § 1.535 and prohibit any further third party requester participation. The intent of the rules is to make *ex parte* reexamination an *ex parte* proceeding with limited, well-defined, requester participation. In this regard, the patent owner cannot file papers on behalf of the requester and thereby circumventing the rules and create an *inter partes* proceeding. The instant communication filed by the patent owner is clearly a submission filed on behalf of the third party requester, and is an improper submission under § 1.550(g). Accordingly, the petition will not be made of record in the reexamination file and is being returned herewith. This decision will, however, be made of record in the reexamination file.

Telephone inquiries related to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at 703-305-8610.

Gerald A Dost

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/004,916	02/15/98	4733665	3006-946

QM31/1003

JOHN P MILNAMOW
DRESSLER ROCKEY MILNAMOW AND KATZ LTD
TWO PRUDENTIAL PLAZA
180 NORTH STETSON AVENUE SUITE 4700
CHICAGO IL 60601

EXAMINER
THALER, M

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 10/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95) U.S.G.P.O. 1999-460-693

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D C. 20231

Reexam Control No.: 90/005,677	:	
Filed: March 31, 2000	:	
For: U.S. Patent No. 4,733,665	:	DECISION MERGING
	:	REEXAMINATION
Reexam Control No.: 90/004,916	:	PROCEEDINGS
Filed: February 18, 1998	:	
For: U.S. Patent No. 4,733,665	:	
Reexam Control No.: 90/004,786	:	
Filed: October 09, 1997	:	
For: U.S. Patent No. 4,733,665	:	

The above reexamination requests are before the Director of Patent Examining Group 3300 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in 90/005,677 was ordered in a decision mailed June 08, 2000. Reexamination in 90/004,916 was ordered in a decision mailed May 12,1998. Reexamination in 90/003,582 was ordered in a decision mailed December 09, 1997

Merger is proper if a reexamination is ordered while a prior reexamination proceeding(s) is pending. In view of the above, merger is appropriate and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims and claim numbering in all proceedings. A housekeeping amendment was filed in Reexamination Proceeding 90/005,677 in the amendment of July 11. 2000.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action which applies to both reexamination files. The action will contain identifying data for all files and will be physically entered in each

reexamination file. Any response filed by the Patent Owner must consist of a single response filed with one copy, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See CFR 1.550(e).

In order to expedite matters, the Patent Owner has filed on July 11, 2000 a housekeeping amendment and has waived the filing of a Patent Owner's Statement. As such, the application is being forwarded to the examiner in charge for appropriate action.

Angela D. Sykes for
John Kittle, Director
Technology Center 3700

JK:amo

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#27

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MAILED
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REEXAM UNIT

In re Frankel
Reexamination Proceeding
Control No. 90/004,922
Filed: February 20, 1998
For: U.S. Patent No. 5,400,990

DECISION GRANTING PETITION

This is a decision on the November 6, 2000, patent owner PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

The petition is granted.

DECISION

The "unintentional" standard for revival of a reexamination proceeding under 37 C.F.R. § 1.137(b), did not become available to patent owner until the appropriate section (§ 4605(a)) of "The American Inventors Protection Act of 1999" (AIPA), which was enacted into law on November 29, 1999, by Section 1000(a)(9), Division B, of Public Law 106-113, 113 Stat. 1501 (1999) became effective; i.e., November 29, 2000, when AIPA § 4608(b) made this relief available. Although the instant petition was filed prior to this effective date, the petition will be entertained at present, since the relief is now available. It would be a waste of resources to require petitioner to again submit a copy of this same petition after November 29, 2000.

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The instant petition is accompanied by a Notice of Appeal, the notice of appeal fee under 37 C.F.R. § 1.17(b), and the petition fee under 37 C.F.R. § 1.17(m). In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is granted.

An appeal brief (accompanied by the fee required by 37 C.F.R. § 1.17(c)) was filed on January 12, 2001.

Application/Control Number: 90/004,922

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 3600 for entry of the Notice of Appeal and appeal brief.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Ramon O. Ramirez, in Technology Center 3600.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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#27

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MAILED
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REEXAM UNIT

In re Frankel
Reexamination Proceeding
Control No. 90/004,922
Filed: February 20, 1998
For: U.S. Patent No. 5,400,990

DECISION GRANTING PETITION

This is a decision on the November 6, 2000, patent owner PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

The petition is granted.

DECISION

The "unintentional" standard for revival of a reexamination proceeding under 37 C.F.R. § 1.137(b), did not become available to patent owner until the appropriate section (§ 4605(a)) of "The American Inventors Protection Act of 1999" (AIPA), which was enacted into law on November 29, 1999, by Section 1000(a)(9), Division B, of Public Law 106-113, 113 Stat. 1501 (1999) became effective; i.e., November 29, 2000, when AIPA § 4608(b) made this relief available. Although the instant petition was filed prior to this effective date, the petition will be entertained at present, since the relief is now available. It would be a waste of resources to require petitioner to again submit a copy of this same petition after November 29, 2000.

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The instant petition is accompanied by a Notice of Appeal, the notice of appeal fee under 37 C.F.R. § 1.17(b), and the petition fee under 37 C.F.R. § 1.17(m). In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is granted.

An appeal brief (accompanied by the fee required by 37 C.F.R. § 1.17(c)) was filed on January 12, 2001.

Application/Control Number: 90/004,922

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 3600 for entry of the Notice of Appeal and appeal brief.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Ramon O. Ramirez, in Technology Center 3600.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

C:\KIVA\KPET-ABE\4922UNIN.GRT; 2-5-01

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Paper No. 19

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MAR 1 0 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Joseph A. Sawyer, Jr.
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FOR OWNER

Hugh R. Kress, Esq.
ARNOLD WHITE & DURKEE
P.O. Box 4433
Houston, Texas 77210

FOR THIRD PARTY REQUESTER

In re Reexamination of:
U.S. Patent No. 5,359,724
Reexamination Control No. 90/004,934
Filed: March 02, 1998
For: METHOD AND APPARATUS FOR STORING AND RETRIEVING MULTI – DIMENSIONAL DATA IN COMPUTER MEMORY

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed June 08, 2001 to expunge information submitted pursuant to MPEP 724.02.

The petition is **GRANTED**.

Petitioner requests that the documents "Deposition of Robert Earle dated January 22, 1998", "Excerpts from the deposition of Mark Stefik dated May 13, 1998 filed by PSI in opposition to claim construction of U.S. Patent No. 5,359,724", "A Validity Analysis of U.S. Patent No. 5,359,724" and "Planning Sciences International's Opposition Brief On Claim Construction of U.S. Patent No. 5,359,724", filed June 08, 2001, be expunged from the record. Petitioner states that the information contains materials that are subject to a protective order which have not been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant reexamination proceeding.

Patent Owner is required to retain the expunged material(s) for the life of the patent.

The expunged materials are returned herewith.

Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
(571) 272-3613

Enclosure: PROTECTIVE ORDER MATERIALS filed June 08, 2001.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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#33

Paper No. 33

Paul S. Madan
MADAN, MOSSMAN & SRIRAM, P.C.
2603 Augusta, Suite 700
Houston, Texas 77057

MAILED

MAY 29 2002

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

29 MAY 2002

In re Joram Agar	:	
Reexamination Proceeding	:	
Control No. 90/004,943	:	
Filed: March 16, 1998	:	
For U.S. Patent No. 5,263,363	:	DECISION MERGING
	:	REEXAMINATION
	:	PROCEEDINGS
In re Joram Agar	:	
Reexamination Proceeding	:	
Control No. 90/005,963	:	
Filed: March 27, 2001	:	
For U.S. Patent No. 5,263,363	:	

The above-identified reexamination files are before the Group Director of Examining Group 2850, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,101,367 issued on November 23, 1993.

2. A first request for reexamination, Control No. 90/004,526, was filed by the patent owner on January 22, 1997.

3. Reexamination was denied for the '4526 reexamination proceeding on March 25, 1997. No petition requesting reconsideration of the denial of reexamination was filed.

4. A second request for reexamination, Control No. 90/004,943, was filed by the patent owner on March 16, 1998.

5. Reexamination was ordered for the '4943 reexamination proceeding on May 27, 1998.

6. A first Office action was issued on March 2, 1999, wherein claims 3 and 4 were rejected as being unpatentable under 35 U.S.C. § 103 and the patentability of claims 1 and 2 was confirmed.

7. A response was filed on April 29, 1999, arguing and requesting reconsideration of the rejections of claims 3 and 4. No amendment was made to the claims.

8. A final rejection was issued on September 8, 1999, wherein claims 3 and 4 were finality rejected and the patentability of claims 1 and 2 was confirmed.

9. A Notice of Appeal was filed on January 6, 2000.

10. An Appeal Brief was filed on March 3, 2000.

11. An Examiner's Answer was mailed on May 25, 2000.

12. A Reply Brief was filed on July 27, 2000.

13. A Petition for Remand was field October 19, 2000, requesting that the appeal be remanded to the examiner.

14. An Order Remanding to Examiner was issued January 26, 2001, ordering the examiner to consider the Reply Brief filed on July 27, 2000, and to give consideration of the Petition for Remand filed October 19, 2000..

15. A Response to the Order Remanding to Examiner was mailed on December 8, 2000.

16. A supplemental Appeal Brief was submitted on March 14, 2001.

17. A third request for reexamination, control No. 90/005,963, was filed by the patent owner on March 27, 2001. An amendment was made to claims 3 and 4.

18. A decision on appeal was issued on March 28, 2001, affirming the final rejections of

claims 3 and 4 in the '4943 reexamination proceeding.

19. Reexamination was ordered for the '5963 reexamination proceeding on May 8, 2001.

20. An Appeal to the Federal Circuit was filed on May 24, 2001, in the '4943 reexamination proceeding.

21. An amendment to claims 3 and 4 and new claims 5 through 9 were submitted on July 12, 2001. No patent owner's statement was received.

22. An Appeal Brief was filed by the patent owner/appellant September 6, 2001, in the '4943 reexamination proceeding.

23. A corrected Appeal Brief was filed on September 25, 2001.

24. An Appeal Brief by the Director of the USPTO on December 3, 2001.

25. A Reply Brief was filed by the patent owner/appellant September 6, 2001, in the '4943 reexamination proceeding.

26. A joint motion to remand the '4943 reexamination proceeding was made to the Federal Circuit.

27. The '4943 reexamination proceeding was remanded to the USPTO in a decision, issued April 10, 2002, granting the joint motion to remand.

28. Both the '4943 and '5963 reexamination proceedings are now pending in front of the USPTO. A statement by the patent owner pursuant to 37 C.F.R. § 1.530(b) was not received for the '5963 reexamination proceeding.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '4943 and '5963 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Three Proceedings.

As noted above, the claims have been amended in the '4943 and '5963 reexamination proceedings. The claims in the '4963 reexamination proceeding are not the same as the claims in the '5963 reexamination proceeding. The patent owner is required to maintain the same claims and specification in both files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed duplicate, each bearing an original signature, for entry in each file.

CONCLUSION

Reexamination Control Nos.'4943 and '5963 are merged. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

Howard N. Goldberg, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

90004943 - 20050805

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/004,945	03/19/99	5524584	

MM41/0202

WILLAIM A. DRUCKER
1299 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20004-2400

EXAMINER
HIRSHFELD,A

ART UNIT	PAPER NUMBER
2659	

DATE MAILED: 02/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)

1- File Copy

UNITED STATES DEPARTMENT OF COMMERCE
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PATENTS AND TRADEMARKS
Washington, D C 20231

Paper No. 23

William A. Drucker
1299 Pennsylvania Ave., N.W.
Washington, D.C. 20004-2400

In re Milton B. Hollander et al.
Reexamination Proceeding
Control No. 90/004,945
Filed: March 19, 1998
For: METHOD AND APPARATUS FOR MEASURING TEMPERATURE

DECISION ON REQUEST FOR EXTENSION OF TIME

This is a decision on a request for an extension of time under 37 C.F.R. § 1.550(c) filed December 23, 1999. The request is for an extension of time of one (1) month in which to file a response to the Office action mailed November 18, 1999.

Pursuant to 37 C.F.R. § 1.550(c):

> (c) *The time for taking any action by a patent owner in a reexamination proceeding will be extended only for a sufficient cause, and for a reasonable time specified. Any request for such an extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of the request effect any extension. See Section 1.304(a) for extensions of time for filing a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.*

The request sets forth sufficient cause. Accordingly, the request for an extension of time is granted to extend one (1) month.

The request is GRANTED.

The period for filing a response is hereby extended to run three (3) months from November 18, 1999, the date of the Office action was mailed and expires February 18, 2000.

Janice A. Howell, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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#13
(mav)

George Wheeler (For Patent Owner)
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500 W. Madison St., 34th Floor
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David M. Crompton (For Requester)
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331 Second Avenue South
Suite 895
Minneapolis, MN 55401

MAILED

NOV 15 2000

REEXAM UNIT

In re reissue application of :
Ainsworth et al. :
Application No. 09/143,503 :
Filed: August 28, 1998 :
For: U.S. Patent No. 5,554,121 :
:
: **DECISION, SUA SPONTE, TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS**

In re Ainsworth et al. :
Reexamination Proceeding :
Control No. 90/004,946 :
Filed: November 4, 1996 :
For: U.S. Patent No. 5,554,121 :

The above noted reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,554,121 issued to Ainsworth et al. on September 10, 1996.

2. On April 9, 1997, a first request for reexamination of the '121 patent was filed by a third party requester, and was assigned Control No. 90/004,602.

3. On June 5, 1997, reexamination was ordered.

4. *Ex parte* prosecution was conducted in the reexamination proceeding, and resulted in issuance of a Notice of Intent to Issue Reexamination Certificate on January 20, 1998.

5. On March 23, 1998, a second request for reexamination of the '121 patent was filed by a third party requester, David M. Crompton, and was assigned Control No. 90/004,946.

6. Reexamination was ordered in the `4946 proceeding on June 8, 1998.

7. A first reexamination certificate issued in the `4602 proceeding on July 14, 1998, confirming patent claims 1-6 and adding new claims 7-17.

8. On August 28, 1998, a reissue application was filed and assigned application no. 09/143,503, which amended the specification, abstract, and claim 15, and added new claims 18-56.

9. A notice of allowance was mailed in the reissue application on April 6, 2000, and a notice of the reissue was published in the *Official Gazette* on September 19, 2000.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 C.F.R. § 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue application shows that applicant has amended the specification, abstract and claim 15, and added new claims 18-56, and a notice of allowance was mailed on April 6, 2000. A review of the reexamination file shows that reexamination was ordered on June 8, 1998, and is awaiting a first Office action. Original patent claims 1-6 have been filed in the reexamination proceeding. Accordingly, the claims and specification are not identical in both proceedings.

In order to provide efficient and prompt handling of both proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the notice of allowance mailed April 6, 2000, in the reissue application is being withdrawn, and the examination of the reissue application and the reexamination will be merged in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-noted reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and the reexamination files for purposes of the merged proceeding. This maintenance of identical amendments in the two files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d).

2. A proposed housekeeping amendment **must be filed within ONE (1) month of the mailing date of this decision**, to thereby place the same amendments in both cases. The housekeeping amendment should not address the issue of patentability. See 37 C.F.R. § 1.540.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action.

2. In the event that a housekeeping amendment is not timely submitted, any claim that does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35

Control - 90/004,946

U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to both the reissue application and the reexamination proceeding. Each action will contain identifying data *for both* the reissue application and the reexamination proceeding, and each action will be physically entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, filed in duplicate, each bearing a signature, for entry in both files.

6. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissued patent, and the reissued patent will serve as the certificate under § 1.570. See MPEP 2285.

7. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned. The Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings.

8. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improper broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions remaining which cannot be considered under reexamination following dissolution of the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

9. Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 C.F.R. § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continuation of prosecution of the reexamination proceeding.

CONCLUSION

1. The notice of allowance mailed April 6, 2000, in the reissue application is being withdrawn.

2. The above noted reissue application and reexamination proceeding ARE MERGED.

3. The reissue and reexaminations file are being forwarded to the examiner via the Director of Technology Center 3700. Upon receipt of same, the examiner **should not issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding until the expiration of ONE (1) month from the mailing of this decision,** to allow for submission of a proposed housekeeping amendment, to thereby place the same amendments in both cases, as required in Part II, above.

4. All further examination should be conducted in accordance with Part III of this decision.

5. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Robert J. Spar, Director
Office of Patent Legal Administration

November 14, 2000

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/143,503	08/28/98	Robert Ainsworth	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,554,121	11/15/00	14

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/ 004,946 Filing Date: 03/23/98

Requester (name, address) David M. Crompton
CROMPTON, SEAGER & TUFTE, LLC
331 Second Avenue South
Suite 895
Minneapolis, MN 55401

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/004,946, filed 03/23/98, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

90004946 - 11/15/00

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(mas)

George Wheeler
MCANDREWS, HELD & MALLOY, LTD.
500 W. Madison St., 34th Floor
Chicago, IL 60661

(For Patent Owner)

David M. Crompton
CROMPTON, SEAGER & TUFTE, LLC
331 Second Avenue South
Suite 895
Minneapolis, MN 55401

(For Requester)

MAILED
FEB 27 2001
REEXAM UNIT

DECISION MAILED

In re reissue application of :
Ainsworth et al :
Application No. 09/143,503 :
Filed: August 28, 1998 :
For: U.S. Patent No. 5,554,121 :

In re Ainsworth et al :
Reexamination Proceeding :
Control No. 90/004,946 :
Filed: November 4, 1996 :
For: U.S. Patent No. 5,554,121 :

DECISION ON PETITION REQUESTING RECONSIDERATION OF DECISION TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS

This is a decision on the December 18, 2000, patent owner petition for reconsideration of the November 15, 2000, decision to merge the above noted reissue application and reexamination proceeding. The present petition for reconsideration is taken as a petition under 37 CFR 1.181(a)(2), and it is before the Office of Patent Legal Administration for consideration.

The petition for reconsideration under 37 CFR 1.181(a)(2) is **granted** to the extent that the November 15, 2000, decision to merge has been reviewed, but is **denied** with respect to making any change therein.

REVIEW OF FACTS

1. U.S. Patent No. 5,554,121 (the '121 patent) issued to Ainsworth et al on September 10, 1996.

2. On April 9, 1997, a first request for reexamination of the '121 patent was filed by a third party requester and was assigned Control No. 90/004,602 (the '4602 proceeding).

3. On June 5, 1997, reexamination was ordered in the '4602 proceeding.

4. *Ex parte* prosecution was then conducted in the '4602 proceeding, and the proceeding terminated with the issuance of a Notice of Intent to Issue Reexamination Certificate (NIRC) on January 20, 1998.

5. On March 23, 1998, a second request for reexamination of the '121 patent was filed by a third party requester, David M. Crompton, and was assigned Control No. 90/004,946 (the '4946 proceeding).

6. Reexamination was ordered in the '4946 proceeding on June 8, 1998.

7. A first reexamination certificate issued in the '4602 proceeding on July 14, 1998, confirming patent claims 1-6 and adding new claims 7-17.

8. On August 28, 1998, a reissue application was filed and assigned application no. 09/143,503. The reissue application amended the specification, abstract, and claim 15, and it added new claims 18-56.

9. A notice of allowance was mailed in the reissue application on April 6, 2000, and a notice that a reissue patent would issue was published in the *Official Gazette* on September 19, 2000.

10. On November 15, 2000, a decision to merge the reissue application and the '4946 reexamination proceeding was issued by the Director of the Office of Patent Legal Administration. In the decision, the April 6, 2000, Notice of Allowance for the reissue application was withdrawn after the payment of the issue fee. Also, a housekeeping amendment was required of applicant/patent owner to place the same amendments in both the reissue and reexamination proceedings.

11. On December 18, 2000, patent owner filed the present petition for reconsideration of the November 15, 2000, decision to merge.

Decision Granted

DECISION

In support of the request for reconsideration, the present petition advances several arguments as to why merger would not be appropriate in the present instance. These arguments will be addressed in the order presented by the petition.

1) At page 2 of the petition, it is argued that the ordered merger violates the 35 U.S.C. 305 proscription of amended or new claims that broaden or enlarge the scope of the patent claims. This argument is directed to the housekeeping amendment requirement (made in the merger decision) to place the same amendments in both the reissue and reexamination proceedings; the requirement would result in the physical placement (entry) of the broadening claims of the reissue application into the reexamination file.

In response to this argument, a discussion is in order of the nature of the housekeeping amendment placing the same amendments in both proceedings. 37 CFR 1.565(d) states:

" If a reissue application and a reexamination proceeding on which an order pursuant to 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings. **Where merger of a reissue application and a reexamination proceeding is ordered, the merged examination will be conducted in accordance with 1.171 through 1.179 and the patent owner will be required to place and maintain the same claims in the reissue application and the reexamination proceeding during the pendency of the merged proceeding.** The examiners actions and any responses by the patent owner in a merged proceeding will apply to both the reissue application and the reexamination proceeding and be physically entered into both files. Any reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissued patent. " [Emphasis added]

In the merged proceeding, it is the reissue aspect of the proceeding that permits the providing of broadened claims. Once broadened claims are permitted for the proceeding as a whole, their presence in the reexamination file is only a reflection of the dual nature of the merged proceeding. The physical presence of the broadened claims in the reexamination file does not signify that broadened claims are present in a reexamination proceeding, but rather that broadened claims are present in a merged proceeding which permits such claims. The physical presence of the broadened claims in the reexamination is simply a display of the composite set of claims that exists in the merged proceeding. If the proceeding ceases to be merged (i.e., if the merger is dissolved), the broadened claims must be removed from the reexamination file, since there is no longer a dual nature (reexamination and reissue) to the proceeding. As stated in MPEP 2285, "[u]pon dissolution of the merged proceeding ... any new grounds of rejection which are applicable under reexamination (e.g., improper broadened claims) should be made by the examiner."

Accordingly, there is no violation of the 35 U.S.C. 305 proscription against broadening where applicant/patent owner provides the same claims in both proceedings. It is merely a consistent display of what is permitted by the dual nature

of the merged proceeding, and any broadening will be removed when and if the merged proceeding is dissolved. As to why the housekeeping amendment is required by 37 CFR 1.565(d), it has, as its purpose, the avoidance of confusion in referring to the claims, as well as inconsistency and potential conflict of claims for the same patent.

2) At page 3 of the petition, it is argued that the ordered merger does not promote uniformity. Petitioner points out that reexamination was ordered only for claims 1-6 (the claims present in the reexamination). On the other hand, the reissue deals with claims 7-56. Petitioner appears to be urging that the reissue will resolve patentability issues as to claims 7-56, while the reexamination will resolve such issues as to claims 1-6 (since reexamination was ordered for claims 1-6, only those claims will be reexamined); thus, combining the two proceedings dealing with the different claims can potentially result in non-uniformity of treatment of claims 1-6 already allowed in the reissue application.

As to petitioner's contention that the reexamination is limited to claims 1-6, MPEP 2216 points out that "[i]f a substantial new question of patentability is found as to one claim, all claims will be reexamined during the *ex parte* reexamination process." Thus, all claims for the '121 patent will be examined. As to what those claims are, such is presently open to doubt in view of the existence of different sets of claims in the different proceedings. As pointed out in the decision ordering merger, a review of the reissue application shows amendment of the specification, abstract and claim 15, and addition of new claims 18-56. On the other hand, the '4946 reexamination file contains only original patent claims 1-6. Claims 7-17 added by the reexamination certificate issued in the '4602 proceeding on July 14, 1998 are present in the reissue application but not in the reexamination file. Accordingly, the claims are not identical in both proceedings.

The same claims must be examined for both proceedings. Thus, they must be in both proceedings. As long as the claims are not the same, the claims do not particularly point out the invention of the patent, and there is an impermissible lack of uniformity between the proceedings.

3) At pages 3-5 of the petition, it is argued that the merger ordered by the Office has slowed down the reissue application which is "already complete," and that the status of the reissue application as complete makes it inappropriate to merge the application with the reexamination proceeding "which is just beginning." Petitioner contends that "there is nothing left to do in the reissue application, other than printing the reissued patent." Further, petitioner urges that the merger "will not expedite the prosecution of the reexamination" and is "not necessary to address the prior art raised in the second reexamination request."

Application/Control Number:

These arguments are not persuasive.

Once the reexamination has been filed and ordered, the information cited in the reexamination proceeding must, **at some point**, be "reviewed" in conjunction with that present in the reissue application. The question is: When is that point in time? In answer to that question, note the following. It would not be in the interest of the public for the Office to reissue the patent prior to doing this "review," because this could possibly result in the reissue of the '121 patent despite the presence of art cited in reexamination which renders claims unpatentable. Yet, as pointed out above, applicant has an interest in the fast issuance of the reissue patent. The most expeditious manner to balance these interests is to merge the proceedings. Addressing the delay of the reissue application in a merged proceeding, MPEP 2285 directs the examiner to issue his/her Office action "at the most advanced point possible" for the reissue application. If, upon consideration of the art cited in both the reissue application and the reexamination, the examiner finds the claims to be patentable, a Notice of Allowance will be promptly issued for the proceeding, and it will be processed into a reissue patent (that will also serve as the reexamination certificate for the patent). If, on the other hand, the art cited in the reissue application and the reexamination renders claims unpatentable, the examiner's Office action will open prosecution to resolve the issues.

Thus, if the claims are found patentable the patent will be reissued as fast as possible, given the circumstances. If the claims are not found patentable, then the time needed to resolve the patentability issues will be spent, as it should be.

Also to be noted is that the merger will ensure that prior art considered in the reissue application can be adequately addressed as to any **new** considerations, interpretations, and information supplied by the '4946 reexamination request. If the reissue application were permitted to be concluded by the issuance of a reissue patent prior to addressing the positions set forth in the '4946 reexamination, then prior art considered in the prosecution of the reissue application can become barred from use in the reexamination proceeding. *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997).

In view of the above, it cannot be said that the consideration of the reissue application is "already complete," because the information in the reexamination proceeding remains to be considered to complete the process.

4) At pages 5-6 of the petition, the argument as to the advanced stage of the reissue application *vis-a-vis* the earlier stage of the reexamination is augmented with a contention that it is unfair to applicant to delay issuance of a reissue patent while the reexamination proceeding (in its early stages) is carried out. Petitioner urges that patent owner will unfairly lose valuable "intervening rights" as a result of the merger, and that "this situation did not result from any action or inaction on the part of the patentee." This argument is apparently made in conjunction with the earlier argument that it "might have made sense to merge the second ['4946] reexamination" with the reissue application and assign them to the same examiner in 1998, but it should not be done at this point, since the reissue prosecution has progressed far beyond that of the reexamination.

This argument is not persuasive in view of the following.

The '4946 request for reexamination of the '121 patent was filed

On March 23, 1998, and reexamination was ordered in the '4946 proceeding on June 8, 1998. The present reissue application was filed August 28, 1998. A review of the record reveals that the filing of the reissue application did not include a notification of the existence of copending reexamination '4946 filed approximately 5 months prior to the reissue application. The record of the reissue does not reveal any notification of the reexamination that would have alerted the Office of same, such that the proceedings could be merged at the early stage referred to by petitioner. Rather, applicant/patent owner prosecuted the reissue application independently of the reexamination, knowing that the reexamination proceeding was not moving forward. Petitioner cannot now persuasively complain that the two proceedings should have been merged earlier, since applicant/ patent owner chose to conduct the prosecution separately, without notification to the Office of the existence of and relationship of the reexamination proceeding.

It is noted further that first notification to the Office of the reissue was not provided in the reexamination proceeding until October 28, 1999, after the claims in the reissue application had been found allowable over the art cited in that application. Applicant knew full well that different examiners had charge of the reexamination proceeding and the reissue application. Yet applicant/patent owner waited until one of the examiners found the claims allowable, so that applicant/patent owner could present that finding to the second examiner. If the reissue application were now permitted to be issued to thereby conclude the reissue proceeding, the second examiner would be bound by the findings as to the art in the reissue proceeding (as discussed above), without being given a chance to view those same references in light of the argument presented in the reexamination by the third party. This is not deemed equitable, especially since applicant/patent owner could easily have brought to the Office's attention the existence of and relationship of the two proceedings much earlier so that all information (in the two proceedings) could be considered together as a package by a single examiner, or at least such that the two examiners could have conferred and had knowledge of all the information in both files.

Summary:

In view of the above discussion, the petition for reconsideration (of the November 15, 2000, decision to merge

the reissue application and '4946 reexamination proceeding) is not persuasive. Merger is deemed to be the most effective vehicle, and the appropriate avenue, to handle the two proceedings (the reissue application and the '4946 reexamination) given the above-discussed situation and analysis.

REQUIREMENT FOR SAME AMENDMENTS IN BOTH PROCEEDINGS

In the November 15, 2000, decision to merge the reissue application and reexamination proceeding, the patent owner/applicant was required to maintain identical amendments in the reissue and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in the two files was, and is, required as long as the proceedings remain merged. See 37 CFR 1.565(d).

Patent owner/applicant did not comply with the requirement, and instead traversed it. The traverse is not found persuasive for the reasons set forth above in the present decision. **Accordingly, the requirement is hereby made final.**

A proposed housekeeping amendment **must be filed within ONE (1) month of the mailing date of this decision,** to thereby place the same amendments in both cases. The housekeeping amendment should not address the issue of patentability. See 37 CFR 1.540.

In view of the finality of the requirement, any future paper filed by patent owner/applicant which does not comply with the requirement will not be considered and may be returned to patent owner/applicant.

CONCLUSION

1. The Notice of Allowance mailed April 6, 2000, in the reissue application remains withdrawn, and the reissue and reexamination proceedings remain merged.

2. The present petition for reconsideration under 37 CFR 1.181(a)(2) is **granted** to the extent that the November 15, 2000, decision to merge made by the Director of the Office of Patent Legal Administration has been reviewed, but is **denied** with respect to making any change therein.

3. The reissue and reexamination files are being forwarded to the examiner via the Director of Technology Center 3700. Upon receipt of same, the examiner should not issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding until the expiration of ONE (1) month from the mailing of **the present decision,** to permit submission of a proposed housekeeping amendment to thereby place the same amendments in both cases.

4. Telephone inquiries related to this decision should be directed to Kenneth Schor, Senior Legal Advisor, at (703) 308-6710.

Robert J. Spar, Director
Office of Patent Legal Administration

February 14, 2001
C:\KIVA\KENPET3\4946MERG.REC

PAPER RECORD - SCANNED

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Commissioner for Patents
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MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

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NOV 13 2008

In re Application of:	:	
Ainsworth et al.	:	
Application No. 09/143503	:	DECISION DISMISSING
Filing or 371(c) Date: 08/28/1998	:	PETITION UNDER
Title of Invention:	:	37 CFR 1.47(a)
INTRALUMINAL CATHETER WITH	:	
HIGH STRENGTH PROXIMAL SHAFT	:	

This is in response to a "Declaration of George Wheeler 37 C.F.R. 1.47(a)," filed May 28, 1999. The Declaration is properly treated as a petition under 37 CFR 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor.

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under [insert the applicable code section]"; should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on August 28, 2008, without, a fully executed oath or declaration. Petitioner filed the present petition on May 28, 1999, along with an oath/declaration executed by two of three inventors. The signature block of the nonsigning inventor Tai C. Cheng has been executed by inventor Robert D. Ainsworth.

Applicable law, Rules and/or MPEP

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (2) and (3) set forth above.

Copied from 09143503 on 12/15/2008

As to item (2), the MPEP 409.03(a), At Least One Joint Inventor Available, provides in relevant part:

> All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP § 602, § 605.01, and § 1414) and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated. (Emphasis supplied).

In this instance, all of the available joint inventors have not made the oath/declaration on behalf of the nonsigning inventor. Here, only inventor Ainsworth has made the oath/declaration on behalf of the nonsigning inventor.

As to item (3), Applicant has failed to submit the petition fee. The petition fee for a petition under 37 CFR 1.47(a) is currently $200.00.

The petition fee, and an oath or declaration signed by all the available joint inventors, with the signature block of the nonsigning inventor(s) left blank, are required.

Further correspondence with respect to this matter should be addressed as follows:

By mail:	Director for Patents PO Box 1450 Alexandria, VA 22313-1450
By FAX:	(571) 273-8300 Attn: Office of Petitions
By hand:	Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions

Copied from 09143503 on 12/15/2008

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JAN 0 9 2009

In re Application of:	:	
Ainsworth et al.	:	
Application No. 09/143503/90/004946	:	DECISION GRANTING
Filing or 371(c) Date: 08/28/1998	:	PETITION UNDER
Title of Invention:	:	37 CFR 1.47(a)
INTRALUMINAL CATHETER WITH	:	
HIGH STRENGTH PROXIMAL SHAFT	:	

This is in response to a "Request for Reconsideration of Petition Under 37 CFR § 1.47(a)," filed December 17, 2008, to allow the other inventor(s) to proceed with the reissue application on behalf of himself or herself and the nonsigning inventor.

The petition is **granted**.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This reissue application is hereby accorded Rule 1.47(a) status.

Petitioner has shown that the non-signing inventor, Tai C. Cheng, refuses to join in the reissue application or cannot be found or reached after diligent effort.

As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the addresses given in the Petition. Notice of the filing of this reissue application will also be published in the Official Gazette.

The reissue application file is being referred to Technology Center Art Unit 3763 for continued examination in the normal course of business.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

DAVID CROMPTON
CROMPTON SEAGER AND TUFTE, LLC
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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/004,946*.

PATENT NO. *5554121*.

ART UNIT *3763*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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MCANDREWS HELD & MALLOY, LTD (For Patent Owner)
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MINNEAPOLIS, MN 55403-2420

In re reissue application of
Robert Ainsworth, et al.
Application No. 09/143,503
Filed: August 28, 1998
For: U.S. Patent No. 5,554,121

In re Robert Ainsworth, et al.
Reexamination Proceeding
Control No. 90/004,946
Filed: March 23, 1998
For: U.S. Patent No. 5,554,121

DECISION
SEVERING
MERGER

The merged proceeding consisting of reissue application 09/143,503 and *ex parte* reexamination proceeding 90/004,946 is before the Office for issuance of a decision to *sua sponte* sever the merged proceeding, in order to permit separate prosecution and examination of the reissue application and the *ex parte* reexamination proceeding.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,554,121 (the '121 patent) issued September 10, 1996.

2. On April 9, 1997, a request for ex parte reexamination of the '121 patent was filed by a third party requester, and the resulting reexamination proceeding was assigned Control Number

90/004,602. A first reexamination certificate issued on July 14, 1998 confirming claims 1-6 and adding new claims 7-17.

3. On March 23, 1998, a request for *ex parte* reexamination of the '121 patent was filed by a third party requester, and the resulting reexamination proceeding was assigned Control Number 90/004,946 (the '946 reexamination proceeding).

4. On June 8, 1998, reexamination was ordered for the '946 reexamination proceeding.

5. On August 28, 1998, the patent owner filed a reissue application based on the '121 patent, which was assigned Application Number 09/143,503 (the '503 reissue application).

6. In a merger decision mailed November 15, 1998, the Office merged the '503 reissue application and the '946 reexamination proceeding into a single combined proceeding. The reissue application and the reexamination file were then remanded to the Director of Examining Group 3700 for examination in accordance with the merger decision.

7. The merged proceeding of the '503 reissue application and the '946 reexamination proceeding progressed to the point where, on January 30, 2009, a non-final office action was mailed. The time for response expired on July 31, 2009 and no response has been received from the patent owner.

DECISION

At page 5 of the merger decision mailed November 15, 2000, it was stated:

> "If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned. The Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings."

In this instance, the patent owner failed to file a timely and appropriate response to the non-final Office action of January 30, 2009. Accordingly, the merged proceeding of the '503 reissue application and the '946 reexamination proceeding is hereby dissolved and severed into two separate proceedings.

The '503 reissue application and the '946 reexamination proceeding are forwarded to Technology Center 3700, for action as follows:

The reissue application will be held abandoned.

The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings.

If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination will be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) will be applied by the examiner. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution will be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

CONCLUSION

1. The merged proceeding consisting of '503 reissue application and the '946 *ex parte* reexamination proceeding is hereby severed into (1) a separate proceeding, for the '503 reissue application, for reissue of the '121 patent, and (2) a separate proceeding, the '946 *ex parte* reexamination, for reexamination of the '121 patent. The two proceedings will be addressed separately and concurrently.

2. Jurisdiction over the '503 reissue application proceeding and the '946 reexamination proceeding is returned to the examiner in Technology Center 3700 for immediate action on the proceedings, toward resolution of the proceedings, and not inconsistent with this decision.

3. Telephone inquiries related to this decision should be directed to Linda Sholl, Special Program Examiner, at (571) 272-4391.

Linda Sholl

Linda Sholl
Special Program Examiner
Technology Center 3700

APR 25 2002

UNITED STATES PATENT & TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

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APR 25 2002
OFFICE OF THE DIRECTOR
TC 3600

Reexamination Control No. 90/004,947 -- Paper No. 37
Reexamination Control No. 90/005,211 -- Paper No. 37
Reexamination Control No. 90/006,095 -- Paper No. 8-37

FOR PATENT OWNER:

Richard D. Emch
Emch Schaffer Schaub and Porcello
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P.O. Box 916
Toledo OH 43692-0916

Earl J. Fontaine
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Southfield, MI 48075

FOR REQUESTER:

Kenyon & Kenyon
One Broadway
New York, NY 10004

DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/004,947, 90/005,211 and 90/006,095

NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 4,550,540 issued on November 5, 1985.

2. A first request for reexamination of U.S. Letters Patent No. 4,550,540 was filed by a third party, Kenyon & Kenyon, on March 24, 1998, and was assigned Reexamination Control No. 90/004,947.

3. On November 30, 1998, a second request for reexamination of U.S. Letters Patent No. 4,550,540 was filed by a third party requester, Kenyon & Kenyon, and was assigned Reexamination Control No. 90/005,211.

4. On August 24, 2001, a third request for reexamination of U.S. Letters Patent No. 4,550,540 was filed by a third party, Kenyon & Kenyon, and was assigned Reexamination Control No. 90/006,095.

5. Reexamination was ordered in Reexamination Control No. 90/004,947 on May 14, 1998; in Reexamination Control No. 90/005,211 on February 10, 1999; and in Reexamination Control No. 90/006,095 on November 20, 2001.

6. Reexamination Control Nos. 90/004,947 and 90/005,211 were merged on June 2, 1999.

7. No Patent Owner's Statement has been filed in Reexamination Control No. 90/006,095.

Discussion

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the Reexamination proceedings will be consolidated and result in the issuance of a single Certificate under § 1.570.

As noted in the "Background", reexamination has been ordered in all reexamination proceedings. Accordingly, merging of the three reexamination proceedings is mandated by 37 CFR 1.565(c).

Decision

Under the provisions of 37 CFR 1.565(c), reexamination proceedings designated as Reexamination Control Nos. 90/004,947, 90/005,211 and 90/006,095 are merged for consolidated proceedings. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in All Files

Patent owner must maintain the same claims and the same description/specification in both files. Since the patent owner has not filed a patent owner's statement, and the submission of the required "housekeeping" amendment prior to a first Office action does not invoke the provisions of 37 CFR 1.535, prosecution will proceed *ex parte*. No reply or other submission will be considered in the merged reexamination proceeding filed by the third party requester.

It is noted that a request to change correspondence address has been filed by the representative of the patent owner in Reexamination Control No. 90/ 006,095 on October 9, 2001. In order to maintain consistent addresses for the patent owner, it is required that a request to change correspondence address be filed in Reexamination Control Nos. 90/004,947 and 90/005,211.

II. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single action, which applies to both reexamination proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each separate reexamination file. Any papers filed by the patent owner must consist of a single response addressed to all reexamination files, filed in triplicate, each bearing an original signature, for entry in all files. Each file will be maintained as separate complete files. All papers filed by the patent owner must be served upon the above-identified third party requester and such requester will be sent copies of all papers mailed by the Office during these merged proceedings.

Conclusion

Reexamination Control Nos. 90/004,947, 90/005,211 and 90/006,095 are hereby merged and an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866

Concur :
Anthony Knight
Acting Director
Technology Center 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D C 20231
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/004,950	04/03/1998		371672800200	7979

HAROLD C WEGNER
FOLEY AND LARDNER
WASHINGTON HARBOUR SUITE 500
3000 K STREET NW
WASHINGTON , DC 20007-5109

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2002

47

Please find below and/or attached an Office communication concerning this application or proceeding.

Enclosed - Mailed

UNITED STATES
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TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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FOR PATENT OWNER

E. THOMAS WHEELOCK
MORRISON & FOERSTER
755 PAGE MILL ROAD
PALO ALTO, CA 94304-1018

FOR REQUESTER

In re Reexamination Proceeding: :
Michihiko Ochiai, et al :
Serial No.: 90/004,950 and 90/005200 : PETITION DECISION
Filed: April 3, 1998 and December 22, 1998 :
Attorney Docket No: 087147/0265 :

This is in response to Patent Owner's petition under 37 CFR 1.181, filed April 8, 2002, requesting withdrawal of an Examiner's Answer and other unspecified relief.

BACKGROUND

A review of the proceedings' history would be extensive and tedious to provide in full. However, it can be summarized as a series of rejections to which a reply was timely made often accompanied by a petition on one or another matter, followed by a decision on petition and succeeding Office action. The recent history shows that a non-Final Office action was issued by a previous examiner on February 14, 2001. (It is noted that this was the seventh Office action in the 4950 proceeding and fifth Office action in the merged proceeding by the previous examiner following grant of the Order for Reexamination, none of which had been made Final. Following the sixth Office action Patent Owner filed a Notice of Appeal.) Thereafter a new examiner was assigned the Proceeding in April, 2001. Patent Owner's representatives held an extensive

interview with the new examiner in an attempt to clarify and resolve many of the issues in the Proceeding. Following the interview patent owner filed a letter reporting the interview and then filed an Appeal Brief, a Notice of Appeal having been filed in December, 2000. The Appeal Brief presented 9 specific issues from the last Office action for resolution:

(I) Rejection not based specifically on prior art;
(II) Rejection under 35 U.S.C. 102(b) based on Heymes et al or Durckheimer et al;
(III) Rejection under 35 U.S.C. 103(a) based on Takano et al;
(IV) Rejection under 35 U.S.C. 103(a) based on Yoshioka et al;
(V) Rejection under 35 U.S.C. 103(a) based on Chauvette, Gottstein, Fieser and Dolfini alone or in combination with each other;
(VI) Rejection for Obvious Double Patenting;
(VII) Other matters;
(VIII) Rejection under 35 U.S.C. 103(a) over Katner;
and (IX) Rejection under 35 U.S.C. 102(a) over Montavon.

The newly assigned examiner prepared an Examiner's Answer, mailed February 8, 2002, in which the issues before the Board were narrowed to issues II, VI and VIII. The examiner replied to each of Patent Owner's arguments for each issue with the Obvious Double Patenting issue being bifurcated into two separate arguments.

Patent Owner filed a Reply Brief and this petition on April 8, 2002. The delay in acting on this petition is regretted, but was, in part, occasioned by receipt of only one copy of the petition, rather than two copies, as required, for the merged reexamination proceeding. The only procedural basis presented for withdrawal of the Examiner's Answer is the possible inclusion of an impermissible new ground of rejection.

DISCUSSION

Patent Owner expresses concerns that procedurally this Proceeding may be forwarded to the Board of Patent Appeals and Interferences (Board) and then be remanded by them for reopening of prosecution or further actions by the examiner and that such would take an inordinate amount of time. However, it has been the experience of the Office that reexamination proceedings forwarded to the Board are considered expeditiously and are docketed for consideration in advance of other appeals. It is also unlikely that the Board would remand a proceeding except for examiner determination of an issue not properly addressed. It is not likely that such would occur in this Proceeding as the previous and current examiners have seemingly addressed all possible issues within the scope of reexamination.

Patent Owner states that the Examiner's Answer contains a new ground of rejection, specifically a second Obvious Double Patenting rejection. A review of the Office actions of February 14, 2001, and of October 26, 2000, has been made to determine what rejections for double patenting were made therein. It appears that both aspects of the Obvious Double Patenting rejection were present therein, specifically of the claims over previously issued parent applications alone as well

as in view of the issued parent applications in view of secondary references. However, they were not clearly delineated or set forth as two separate Obvious Double Patenting rejections. The Examiner's Answer clearly sets forth both aspects of the double patenting rejection and clearly delineates each from the another. Thus no new ground of rejection has been set forth, but existing grounds of rejection have been clarified and properly separated into their component parts.

Patent Owner then sets forth reasons for the delay in filing method claims in view of issued parent patents to compound claims and which is part of the basis supporting the Obvious Double Patenting rejections. This is not a procedural issue within the conduct of this reexamination, but are concerned with the merits of the rejections of record. These arguments are better presented to the Board for determination of the propriety of the rejections. Patent Owner further comments on the length of time which was needed to obtain broad claims. Again such argument does not address procedural insufficiencies in the Proceeding. Patent Owner then states that Schneller is inapposite to this case. However, since this is an issue directed to patentability of the claims, the issue will not be addressed in this decision.

Patent Owner then comments on the *Ex parte Bogese* decision cited by the examiner in support of the Obvious Double Patenting rejection suggesting that it is based on false premises of earlier cases and then proceeds through an analysis of *Woodbridge v United States* which appears to have no bearing on this petition decision.

In summary, Patent Owner's only apparent valid procedural question is with respect to the possible existence of a new ground of rejection in the Examiner's Answer. As noted above it is believed that such does not exist based on the prosecution history and the new examiner's attempt to clarify the record and issues to the extent possible.

DECISION

Applicants' petition is **DENIED.** The Examiner's Answer is maintained as proper and not containing a new ground of rejection.

The Proceeding will be forwarded to the examiner for consideration of the Reply Brief.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230..

Any request for reconsideration of this decision must be made within TWO MONTHS of the mailing date of this decision and should be addressed to the Office of Petitions.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/004,950	04/03/98	5283216	371672800200

023533 HM11/0504
STEPHEN B MAEBIUS
3000 K STREET, NW., SUITE 500
WASHINGTON DC 20007-5109

EXAMINER
FORD, J

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 05/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)
*U.S. GPO: 1997-422-198/60031
1- File Copy

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D C. 20231

HAROLD C WEGNER
FOLEY AND LARDNER
WASHINGTON HARBOUR SUITE 500
3000 K STREET NW
WASHINGTON , DC 20007-5109

MAILED
04 MAY 2000
TC 1600-CQM

In re Reexamination Proceeding:
Michihiko Ochiai, et al
Serial No.: 90/004,950
Filed: April 3, 1998, and
Serial No.: 90/005,200
Filed: December 22, 1998
Attorney Docket No: 087147/0265

PETITION DECISION

This is in response to applicant's petitions under 37 CFR 1.181, filed April 14, 2000, to review and clarify the examiner's actions in the last Office action and to modify the Office action as necessary and restart the period for response. Both are addressed in this decision.

Patent owner sets forth the following reasons for modification of the Office action: (1) claims 14-16 are identical to original claims 3-5 and should not be subject to a rejection under 35 U.S.C. 112; (2) claims 1-2 are original unamended claims and may not be rejected under 35 U.S.C. 112; (3) failure to address all of patent owner's arguments with respect to the issue of obvious double patenting.

DISCUSSION

A review of now pending claims 14-16 shows that they are identical to original claims 3-5. As such they cannot be subject to any rejection under 35 U.S.C. 112. Some confusion has arisen as to whether these claims should be treated as originally filed claims. According to Office policy, and as reflected in the M.P.E.P., original claims are subject to rejection on prior art only. In order to minimize confusion as to whether these are original claims or not, patent owner is requested to present claims 3-5 in the next response to an Office action as claims 3-5 (no underlining is required) and request that previously canceled claims 3-5 be reinstated in the proceeding. (Claims 14-16 should be canceled when this is done.) Any rejections of claims 14-16 should be considered as rejections of reinstated claims 3-5. In view of this, any rejections of claims 14-16 (which will be converted to reinstated claims 3-5) under 35 U.S.C. 112 are withdrawn as improper. Other rejections of these claims over prior art or for obvious double patenting are considered to be directed to reinstated claims 3-5 and should be addressed as such.

With respect to the rejection under 35 U.S.C. 112 of claims 1-2, which have not been amended, such rejection is improper, is withdrawn, and need not be replied to in patent owner's response to the outstanding Office action. The examiner raised a question of enablement under 35 U.S.C. 112 of these two claims. Such is improper. The patented claims under reexamination are to be given their broadest reasonable interpretation consistent with the specification, however, patent claims

must be given only an interpretation which is enabled by the specification (M.P.E.P. 2258). Thus any question of enablement of a claim is limited by that which is taught in the specification and any interpretation of a claim which falls outside the enablement of the specification is not within the scope of the claim and need not be considered by the examiner.

With respect to the failure to address all of patent owner's arguments, a review of patent owner's last response and the examiner's action fails to find this completely accurate. While patent owner has set forth several arguments in logical manner it is thought from the review of the examiner's action that these arguments have been addressed although not in the same order or with the same logicality as set forth by patent owner. The question of patentability of the method claims of the patent appears to revolve around the question of whether the method was disclosed (patent owner states it was) and claimed (patent owner concedes it wasn't) in the parent application which issued as a patent and the consequences of failing to claim the method in the parent application with respect to availability of other intervening prior art (intervening between disclosure and actual claiming of the method) and the question of obvious double patenting over the parent application. Both patent owner and the examiner have addressed these issues from different perspectives which at times may appear to avoid answering or responding to the other's arguments. These issues have also been clouded by the introduction of the issues raised under 35 U.S.C. 112, noted above. With the removal of such issues concentration on the crux of the matter may be had and the respective positions more clearly developed. In view of this no new Office action will be forthcoming until patent owner files a response to the outstanding Office action limited to the issues of prior art noted.

For the above reasons patent owner's petition is **GRANTED IN PART**. All rejections in the last Office action under or related to 35 U.S.C. 112 are withdrawn. Patent owners reply will be limited to addressing only questions related to rejections over prior art under 35 U.S.C. 102 or 103 and for obvious double patenting.

Patent owners time for response originally set at two months has been extended by an additional two months. Patent owner's concern with regard to the lack of progress in bringing this reexamination proceeding to a conclusion is noted. It is admitted that some of the delay has occurred within the Office, initially due to numerous requests for access by the public which prevented the examiner from working consistently on the file. This has since been overcome. It is expected that the next action following patent owner's next reply will be a final Office action which will bring this proceeding to an acceptable conclusion or lead to an appeal.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Group 1600/2900, Washington, DC 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 308-7922.

John Kittle
Director, Group 1600/2900

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#59

APR 13 2004

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E. THOMAS WHEELOCK
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PALO ALTO, CA 94304-1018

In re Reexamination Proceeding:	:	
Michihiko Ochiai *et al.*	:	
Control Nos. 90/004,950 and 90/005,200	:	ON PETITION
Filed: April 3, 1998 and December 22, 1998	:	
For: U.S. Patent No. 5,583,216	:	
Issued: December 10, 1996	:	

This is a decision on the patent owner petition filed on September 9, 2002, and the supplemental patent owner petitions filed on October 18, 2002, and December 1, 2003, under 37 CFR 1.181(a)(3) requesting supervisory review of the Technology Center Director's decision of July 15, 2002 to deny petitioner's request that the examiner's answer of February 8, 2002 be stricken from the record. These petitions have been forwarded by the Deputy Commissioner for Patent Examination Policy to the Technology Center Director for treatment as a request for reconsideration of the Technology Center Director's decision of July 15, 2002.

The petition under 37 CFR 1.181 is **granted** to the extent that:

The examiner's answer of February 8, 2002 is **vacated**; and

The reexamination proceeding is being forwarded to the examiner for appropriate action.

Upon further review, a comparison of the examiner's answer of February 8, 2002 with the prior Office actions in the file of this reexamination proceeding reveals that the rationale provided in support of the rejections has been sufficiently expanded that one could reasonably come to the conclusion that the "basic thrust" of the rejections in the examiner's answer of February 8, 2002 differ from those in the prior Office actions. Therefore, it is appropriate that such rejections be considered new rejections and set forth in an Office action reopening prosecution in this

reexamination proceeding. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976).

It is noted that petitioner has repeatedly complained of the length of time that has been taken to reach a conclusion in this reexamination proceeding. The Technology Center had forwarded the file of this reexamination proceeding to the Board of Patent Appeals and Interferences for a decision on the appeal, and it is at petitioner's insistence that prosecution is now being reopened. Nevertheless, petitioner is free to file a paper requesting that any non-final Office action subsequently issued in this reexamination proceeding be designated as a final Office action so as to permit an appeal from the rejections in such Office action. See Changes to Implement the 2002 *Inter Partes* Reexamination and Other Technical Amendments to the Patent Statute, 68 Fed. Reg. 70996, 71002 (Dec. 22, 2003), 1278 Off. Gaz. Pat. Office 218, 222 (response to comment 2).

Any inquiry concerning this decision may be directed to William R. Dixon, Jr., by telephone at 571-272-0519.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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APR 29 2004

#61

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MORRISON & FOERSTER
755 PAGE MILL ROAD
PALO ALTO, CA 94304-1018

In re Reexamination Proceeding:	:	
Michihiko Ochiai *et al.*	:	
Control Nos. 90/004,950 and 90/005,200	:	ON PETITION
Filed: April 3, 1998 and December 22, 1998	:	
For: U.S. Patent No. 5,583,216	:	
Issued: December 10, 1996	:	

In response to the request for clarification filed April 19, 2004, this is a supplemental decision on the patent owner petition filed on September 9, 2002, and the supplemental patent owner petitions filed on October 18, 2002, and December 1, 2003, under 37 CFR 1.181(a)(3) requesting supervisory review of the Technology Center Director's decision of July 15, 2002 to deny petitioner's request that the examiner's answer of February 8, 2002 be stricken from the record. These petitions have been forwarded by the Deputy Commissioner for Patent Examination Policy to the Technology Center Director for treatment as a request for reconsideration of the Technology Center Director's decision of July 15, 2002.

The petition under 37 CFR 1.181 is **granted** to the extent that:

The examiner's answer of February 8, 2002 is **vacated**; and

The reexamination proceeding is being forwarded to the examiner for appropriate action.

Upon further review, a comparison of the examiner's answer of February 8, 2002 with the prior Office actions in the file of this reexamination proceeding reveals that the rationale provided in support of the rejections has been sufficiently expanded that one could reasonably come to the conclusion that the "basic thrust" of the rejections in the examiner's answer of February 8, 2002 differ from those in the prior Office actions. Therefore, it is appropriate that such rejections be

considered new rejections and set forth in an Office action reopening prosecution in this reexamination proceeding. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976).

It is noted that petitioner has repeatedly complained of the length of time that has been taken to reach a conclusion in this reexamination proceeding. The Technology Center had forwarded the file of this reexamination proceeding to the Board of Patent Appeals and Interferences for a decision on the appeal, and it is at petitioner's insistence that prosecution is now being reopened. Nevertheless, in the event that a non-final Office action is subsequently issued in this reexamination proceeding, petitioner may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in 37 CFR 1.17(b) within the time period for reply provided under 37 CFR 1.550(c). See 37 CFR 1.191(a)(1).

Any inquiry concerning this decision may be directed to William R. Dixon, Jr., by telephone at 571-272-0519.

Bruce M. Kisliuk
Director, Technology Center 1600

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MICHIHIKO OSHIAI, TAIITI OKADA, OSAMI AKI, AKIRA MORIMOTO, KENJI KAWAKITA and YOSHIHIRO MATSUSHITA

MAILED

MAY 25 2006

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-1465
Reexamination Control No. 90/004,950
Patent No. 5,583,216

DECISION ON PETITION

This is a decision on the petition filed March 10, 2006 under 37 CFR § 41.3 seeking entry and consideration of appellants' reply brief filed January 13, 2006.

FINDINGS

1. On January 13, 2006, appellants filed a reply brief.

2. On January 20, 2006, jurisdiction over this appeal passed to the Board of Patent Appeals and Interferences ("Board").

3. On February 27, 2006, the primary examiner in Technology Center 1600 issued a communication stating that the reply brief "has not been considered because it is not in compliance with 37 CFR 41.41(a)."

4. On March 10, 2006, appellants filed the present petition, addressed to the Chief Administrative Patent Judge of the Board ("Chief Judge"), seeking "entry and consideration of the Reply Brief filed on January 13, 2006."

5. In the petition, appellants also request "that an Oral Hearing be scheduled as soon as possible to expedite conclusion of the proceedings in this case."

6. In the petition, appellants also request that the petition shall not stay the appeal.

7. On March 10, 2006, appellants also filed a Declaration of Leon Radomsky "in support of a petition to be concurrently filed herewith for consideration of a Reply Brief."

DISCUSSION

As indicated, the action about which appellants complain and from which appellants seek relief was an action by the primary examiner in Technology Center 1600. Petitions concerning actions of primary examiners in the technology centers are properly addressed to the appropriate technology center director. Manual of Patent Examining Procedure (MPEP) § 1002.02(c)3 (8th ed., Aug. 2001, rev., Oct. 2005). ("action or requirement [] by the examiner which is not subject to appeal").

Petitions properly addressed to the Chief Judge include those seeking relief from "actions *of* the Board [] or *of personnel at* the Board." *Id.* at § 1002.02(f)4.b. (italics added). However, petitions concerning non-appealable actions of primary examiners are not properly addressed to the Chief Judge.

Accordingly, should appellants wish to have the petition considered on the merits, the appellants should request the Board to remand the appeal to Technology Center 1600 where the petition properly would be before the Director of Technology Center 1600.

Alternatively, since the Board presently has jurisdiction of the appeal, should appellants wish to proceed to oral hearing without further delay, the appellants should notify the Board to proceed with the appeal without consideration of the reply brief and request that the Board dismiss the petition.

Accordingly, appellants are given 14 days from the date of this decision to file the following:

1. A Request for Remand of the appeal to Technology Center 1600 for consideration of the petition; or
2. A Notification to proceed with the appeal without consideration of the reply brief and a Request to Dismiss the petition.

If there is no response within 14 days, the Board will treat the lack of response as a notification to proceed with the appeal without the consideration of the reply brief and dismiss the petition.

Michael R. Fleming
Chief Administrative Patent Judge
Board of Patent Appeals and Interferences

Harold C. Wegner
FOLEY & LARDNER LLP
3000 K Street, N.W.
Washington, DC 20001

MAILED
JUL 31 2001
PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 54

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re STANLEY LUSTIG et al.	
Reexamination Control Nos. 90/004,675, 90/004,956, and 90/005,139	Appeal No. 01-0254
Filed: June 24, 1997	

ORDER GRANTING REQUEST TO RESET HEARING DATE

An oral hearing before a merits panel of the Board of Patent Appeals and Interferences has been set for August 16, 2001, (Paper No. 52). The notice setting the hearing was mailed to counsel on June 13, 2001. The date counsel received the notice is not apparent from the record. On June 20, 2001, a facsimile letter was received (Paper No. 53) wherein counsel requested that the oral hearing be rescheduled. The request has been granted.

According to counsel:

> [Counsel] is scheduled to participate in a client meeting in which [he is] to play a central role, and into which [he has] already invested substantial efforts. The date for this client meeting was established on January 18, 2001, many months prior to [counsel's] receipt of the Notice of Hearing. Due to the large number of people involved, the client meeting cannot be rescheduled or postponed. [Counsel] has been advised that

[his] attendance at this meeting is critical, and that it would be virtually impossible for [counsel's] role in the meeting to be played by another individual.

Because the Final Rejection from which this Appeal is taken involves six rejections based on twenty-two references, it will take a substantial amount of time [for counsel] to re-familiarize [himself] with the references and the rejections, and to prepare for oral argument. Because of the extensive history of the present reexamination, and [counsel's] prosecution of the entire reexamination to date, it would be very inefficient for another attorney to argue the present Appeal.

Accordingly, such a postponement is requested.

For the reasons given above, it is

Ordered that the request to reschedule the hearing to a date after August 16, 2001, is granted, and that a new date for the oral hearing will be sent to applicant.

BOARD OF PATENT APPEALS
AND INTERFERENCES

CRAIG R. FEINBERG
Program and Resource Administrator
(703) 308-9797

Raymond W. Green, Esq.
Brinks, Hofer, Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

CRF:llf

24

The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

MAILED

JAN 2 6 2001

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

Ex parte JORAM AGAR

Appeal No. 2001-0108
Reexamination Control No. 90/004,960

DECISION ON PETITION

This is in response to the petition filed December 14, 2000, requesting that a formal oral hearing be scheduled in the above identified application. The petition is Dismissed.

Background

A Request for Reexamination was filed on April 9, 1998. On August 24, 1998, after two rejections, appellants filed a Notice of Appeal (Paper No.11).

On October 25, 1999, appellant filed an Appeal Brief (Paper No. 13). On February 17, 2000, the examiner responded, mailing a Notice of Defective Brief (Paper No. 14). On March 6, 2000, appellant responded by filing a second Appeal Brief (Paper No. 15).

On April 25, 2000, the examiner responded by mailing an Examiner's Answer to Appellant (Paper No. 16). On June 28, 2000 appellant responded by filing a Reply Brief (Paper No. 17). On August 7, 2000, the examiner responded, by entering the Reply Brief and forwarding the Reexamination proceeding to the Board of Patent

Appeal No: 2001-0108
Reexamination Control No.: 90/004,960
Appeals and Interferences.

On July 29, 2000, appellant filed a Request for Oral Hearing (Paper No. 21). On October 19, 2000, Mr. Craig R. Feinberg, a Program and Resource Administrator for the Board of Patent Appeals and Interferences responded by mailing an Order Denying Hearing to appellant.

On December 14, 2000 appellant filed a petition under 37 CFR § 1.196 (Paper No. 23), requesting that the reexamination proceeding be remanded to the examiner to review claim 1 in light of issues that were raised in a related reexamination proceeding.

DISCUSSION

The current request for remanding the reexamination proceeding appears to be unwarranted. Appellant is asking the examiner to again review a record in which the examiner has already reviewed, and upon which the examiner has made his determination of the patentablility of claim 1. Appellant has not added anything to the instant record that would require the examiner to reconsider his position in regards to claim 1.

DECISION

Appellants petition requesting that the Reexamination Proceeding be remanded is **DISMISSED.**

Dale M. Shaw
Program and Resource Administrator
Board of Patent Appeals and Interference

dms:DMS

Appeal No: 2001-0108
Reexamination Control No.: 90/004,960

cc: Steven G. Morgan
Madan, Mossman, & Sriram, P.C.
2603 Augusta, Suite 700
Houston, TX 77057

UNITED STATES PATENT AND TRADEMARK OFFICE

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#31

Paper No. 31/9

Paul S. Madan
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2603 Augusta, Suite 700
Houston, Texas 77057

MAILED

MAY 29 2002

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

29 MAY 2002

In re Joram Agar	:	
Reexamination Proceeding	:	
Control No. 90/004,960	:	
Filed: April 9, 1998	:	
For U.S. Patent No. 5,101,367	:	DECISION MERGING
	:	REEXAMINATION
	:	PROCEEDINGS
In re Joram Agar	:	
Reexamination Proceeding	:	
Control No. 90/005,961	:	
Filed: March 23, 2001	:	
For U.S. Patent No. 5,101,367	:	

The above-identified reexamination files are before the Group Director of Examining Group 2850, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,101,367 issued on March 31, 1992.

2. A first request for reexamination, Control No. 90/004,525, was filed by the patent owner on March 27, 1992.

3. Reexamination was denied for the '4525 reexamination proceeding on April 8, 1997. No

petition requesting reconsideration of the denial of reexamination was filed.

4. A second request for reexamination, Control No. 90/004,960, was filed by the patent owner on April 9, 1998.

5. Reexamination was ordered for the '4960 reexamination proceeding on June 4, 1998.

6. A first Office action was issued on March 1, 1999, wherein claim 1, the sole claim in the patent, was were rejected as being unpatentable under 35 U.S.C. § 103.

7. A response was filed on April 29, 1999, arguing and requesting reconsideration of the rejection of claim 1. No amendment was made to the claim.

8. A final rejection was issued on July 16, 1999, wherein claim 1 was finality rejected.

9. A Notice of Appeal was filed on August 24, 1999.

10. An Appeal Brief was filed on October 25, 1999.

11. A Notice of Defective Brief was mailed on February 17, 2000.

12. A corrected Appeal Brief was filed on March 6, 2000.

13. An Examiner's Answer was mailed on April 25, 2000.

14. A Reply Brief was filed on June 28, 2000.

15. An acknowledgment of receipt of the Reply Brief was mailed on August 7, 2000.

16. A Petition for Remand was field October 19, 2000, requesting that the appeal be remanded to the examiner.

17. A decision dismissing the Petition for Remand was issued January 26, 2001.

18. A third request for reexamination, control No. 90/005,961, was filed by the patent owner on March 23, 2001.

19. An amendment to claim 1 was filed with the '5961 request for reexamination.

19. A supplemental Appeal Brief was filed in the '4960 reexamination proceeding on April 12, 2001.

20. Reexamination was ordered for the '5961 reexamination proceeding on May 8, 2001.

21. A second amendment was filed in the '5961 reexamination proceeding wherein the amendment to claim 1 was resubmitted and new claims 2 through 11 were presented.

22. A decision on appeal was issued on August 16, 2001, affirming the final rejection of claim 1, the sole claim in the '4960 reexamination proceeding.

23. An Appeal to the Federal Circuit was filed on October 10, 2001 in the '4960 reexamination proceeding.

24. An Appeal Brief was filed by the patent owner/appellant April 27, 2001 in the '4960 reexamination proceeding.

25. A joint motion to remand the '4960 reexamination proceeding was made to the Federal Circuit.

28. The '4960 reexamination proceeding was remanded to the USPTO in a decision, issued April 18, 2002, granting the joint motion to remand.

29. Both the '4960 and '5961 reexamination proceedings are now pending in front of the USPTO. A statement by the patent owner pursuant to 37 C.F.R. § 1.530(b) was not received for the '5961 reexamination proceeding.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '4960 and '5961 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Three Proceedings.

As noted above, the claims have been amended in the '4960 and '5961 reexamination proceedings. The claim in the '4960 reexamination proceeding is not the same as the claims in the '5961 reexamination proceeding. The patent owner is required to maintain the same claims and specification in both files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed duplicate, each bearing an original signature, for entry in each file.

CONCLUSION

Reexamination Control Nos.'4960 and '5961 are merged. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

Henry S. Phan for

Howard N. Goldberg, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Paper No. 45

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John R. Duncan (For Requester)
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4565 Ruffner Street, Suite 200
San Diego, CA 92111-2115

MAILED

MAR 30 2001

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Ming Xu et al.)
Reexamination Proceeding)
Control No. 90/004,980) DECISION REFUSING ENTRY OF
Filed: April 28, 1998) LITIGATION NOTICE
For: U.S. Patent No. 5,488,907)

The paper, filed February 16, 20001, by a third party, entitled "SUBMISSION OF COURT DECISION FROM LITIGATION INVOLVING PATENT IN REEXAMINATION PURSUANT TO M.P.E.P. § 2282," (hereinafter "Submission") is before the Director of Technology Center 2800.

Under 37 C.F.R. § 1.565:

> (a) In any reexamination proceeding before the Office, the patent owner shall call the attention of the Office of any prior or concurrent proceedings in which the patent is or was involved such as interference, reissue, reexamination, or litigation and the results of such proceedings.

Under section 2282 of the Manual of Patent Examining Procedure (M.P.E.P.), the Office will, at any time, accept for placement in the patent file copies from any parties of notices of suits and other proceedings involving the patent.

The Submission was filed by a third party who is not the requester of the instant reexamination proceeding and gives notice to a litigation of patent No. 5,830,263 which patent is not currently under reexamination nor reissue. As such, the Submission will not be made of record in this instant reexamination file.

The Submission is not being returned but is treated as a submission for U.S. patent No. 5,830,263 and will be placed in the file record of U.S. patent No. 5,830,263.

A copy of the Submission is enclosed for the patent owner and the third party requester since there is no evidence that such copy has been properly served on these two parties.

This decision will be made of record in the reexamination file.

Howard N. Goldberg, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

Enclosures: Copy of the "Submission of Court Decision from Litigation Involving Patent in Reexamination Pursuant to M.P.E.P. § 2282," filed February 16, 2001, for third party requester and for patent owner.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C 20231

#10

MAILED
AUG 30 2000
Group 3700

Reexam Control No.: 90/004,998 Filed: June 04, 1998 For: U.S. Patent No. 5,242,343	:	DECISION MERGING REEXAMINATION PROCEEDINGS
Reexam Control No.: 90/005,560 Filed: November 17, 1999 For: U.S. Patent No. 5,242,992	:	

The above reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in 90/004,998 was ordered in a decision mailed July 14, 1998. Reexamination in 90/005,344 was ordered in a decision mailed January 19. 2000.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending. In view of the above, merger is appropriate and is hereby ordered.

Requirement for Same Claims in All Proceedings

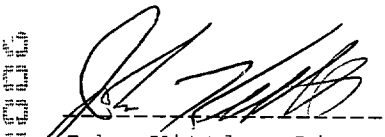
The Patent Owner is required to maintain identical claims in both files. In view of the fact that amendments have been filed in Reexam 90/004,998, a housekeeping amendment is required in Proceeding 90/005,560.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action which applies to both reexamination files. The action will contain identifying data for all files and will be

physically entered in each reexamination file. Any response filed by the Patent Owner must consist of a single response filed with one copy, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See CFR 1.550(e).

Patent Owner is given 30 days from the date of this letter to file a housekeeping amendment in 90/005,560. The amendment will leave both reexaminations with identical claims and identical claim numbers.



John Kittle, Director
Technology Center 3700

JK:amo

Ronald W.Citkowski
Gifford, Krass, Groh, Sprinkle, (For Patent Owner)
Anderson, Citkowski, P.C.
280 N. Old Wooward, Suite 400
Birmingham, MI 48009

Michael McMurry
1210 Astor Street
Chicago, IL 60610 (For Requestor)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

#68
#12

MAILED
JUN 14 2000
Group 3700

Reexam Control No.: 90/004,848 :
Filed: November 25, 1997 :
For: U.S. Patent No. 5,383,879 :
:
Reexam Control No.: 90/004,999 :
Filed: June 04, 1998 :
For: U.S. Patent No. 5,383,879 :

Reexam Control No.: 90/005,030 : DECISION MERGING
Filed: July 02, 1998 : REEXAMINATION
For: U.S. Patent No. 5,383,879 : PROCEEDINGS
:
Reexam Control No.: 90/005,450 :
Filed: August 18, 1999 :
For: U.S. Patent No. 5,383,879 :

Reexam Control No.: 90/005,561 :
Filed: November 17, 1999 :
For U.S. Patent No.: 5,383,879 :

The above reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in 90/004,848 was ordered in a decision mailed February 06, 1998. Reexamination in 90/004,999 was ordered in a decision mailed July 14, 1998. Reexamination in 90/005,030 was ordered in a decision mailed July 09, 1998. Reexamination in 90/005,450 was ordered in a decision October 18, 1999. Reexamination in 90/005,561 was ordered in a decision mailed February 03, 2000.

The first three reexamination proceedings are already merged. Merger is proper if a reexamination is ordered while a prior reexamination proceedings are pending. Accordingly, merger is appropriate for 90/005,450 and 90/005,561 and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims and identical claim numbering in all five files. A housekeeping amendment is required in 90/005450 and in 90/005561.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action which applies to all five reexamination files. The action will contain identifying data for all files and will be physically entered in each reexamination file. Any response filed by the Patent Owner must consist of a single response filed with four copies, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See CFR 1.550(e).

At this time the Patent Owner is required to file a housekeeping amendment in Reexamination Proceedings 90/005,450 and 90/005,561 so that the claims in all three proceedings are identical in content and numbering. The Patent Owner is given 1 month from the date of this letter to file the housekeeping amendments.

John J. Love

John J. Love, Director
Technology Center 3700

JJL:amo

Ronald W. Citkowski
Gifford, Krass, Groh, Sprinkle,
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90/004,999
90/005,030
90/005,450
90/005,561

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90/005,028 06/26/98 5553083 STR-001RX

LM41/0118

PATENT ADMINISTRATOR
TESTA HURWITZ AND THIEBEAULT
HIGH STREET TOWER
125 HIGH STREET
BOSTON MA 02110

BAKER,S

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

01/19/00 #14

In re Application of:
C. KENNETH MILLER et al.

Control No. 90/005,028

Filed: June 26, 1998

For: METHOD FOR QUICKLY AND RELIABLY TRANSMITTING FRAMES OF DATA OVER COMMUNICATIONS LINKS

DECISION
ON
PETITION

This is a decision on the petition for correction of inventorship. The petition filed on October 13, 1999 is **GRANTED**.

HISTORY

The parent application was filed on January 19, 1995 with the sole inventor indicated as C Kenneth Miller.

The application was allowed and issued as U.S. Patent No. 5,553,083 on September 3, 1996 with the sole inventor indicated as C. Kenneth Miller.

A Re-examination application (90/005,028) was filed on June 26, 1998 with the sole inventor indicated as C. Kenneth Miller.

On October 13, 1999, the present petition was filed requesting correction of inventorship.

DISCUSSION

The petition filed on October 13, 1999, requests correction of inventorship under 37 CFR 1.324 to include **Kary Robertson; Kenneth Gates, and Marc White** as a joint inventor with C. Kenneth Miller. Applicant has filed letters of consent from both assignees and statement (declaration) from all the inventors. Applicant has also filed an executed declaration in the names of the joint inventors Kary Robertson, Kenneth Gates, and Marc White. The declaration states that inventors were not named in error and that the error was without deceptive intent on the part of the actual inventors.

DECISION

Since applicant has supplied satisfactory proof that the error arose without deceptive intent and all the assignees agree to the correction, the inventorship shall be corrected. The new inventorship shall be C. Kenneth Miller, Kary Robertson, Kenneth Gates, and Marc White.

SUMMARY

The petition filed on October 13, 1999 is **GRANTED**. The new inventorship shall be **C. Kenneth Miller, Kary Robertson, Kenneth ~~Gates~~ Cates, and Marc White**.

Albert DeCady
SPE, Art Unit 2784

Testa, Hurwitz & Thibeault, LLP
High Street Tower
125 High Street
Boston, Massachusetts 02110

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

~~#8~~ #13

MAILED
JUN 14 2000
Group 3700

Reexam Control No.: 90/004,848 Filed: November 25, 1997 For: U.S. Patent No. 5,383,8~~7~~2~~9~~	:	
Reexam Control No.: 90/004,999 Filed: June 04, 1998 For: U.S. Patent No. 5,383,8~~7~~2~~9~~	:	
Reexam Control No.: 90/005,030 Filed: July 02, 1998 For: U.S. Patent No. 5,383,8~~7~~2~~9~~	:	DECISION MERGING REEXAMINATION PROCEEDINGS
Reexam Control No.: 90/005,450 Filed: August 18, 1999 For: U.S. Patent No. 5,383,8~~7~~2~~9~~	:	
Reexam Control No.: 90/005,561 Filed: November 17, 1999 For U.S. Patent No.: 5,383,8~~7~~2~~9~~	:	

The above reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in 90/004,848 was ordered in a decision mailed February 06, 1998. Reexamination in 90/004,999 was ordered in a decision mailed July 14, 1998. Reexamination in 90/005,030 was ordered in a decision mailed July 09, 1998. Reexamination in 90/005,450 was ordered in a decision October 18, 1999. Reexamination in 90/005,561 was ordered in a decision mailed February 03, 2000.

The first three reexamination proceedings are already merged. Merger is proper if a reexamination is ordered while a prior reexamination proceedings are pending. Accordingly, merger is appropriate for 90/005,450 and 90/005,561 and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims and identical claim numbering in all five files. A housekeeping amendment is required in 90/005450 and in 90/005561.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action which applies to all five reexamination files. The action will contain identifying data for all files and will be physically entered in each reexamination file. Any response filed by the Patent Owner must consist of a single response filed with four copies, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See CFR 1.550(e).

At this time the Patent Owner is required to file a housekeeping amendment in Reexamination Proceedings 90/005,450 and 90/005,561 so that the claims in all three proceedings are identical in content and numbering. The Patent Owner is given 1 month from the date of this letter to file the housekeeping amendments.

John J. Love

John J. Love, Director
Technology Center 3700

JJL:amo

Ronald W. Citkowski
Gifford, Krass, Groh, Sprinkle,
Anderson and Citkowski
280 N. Old Woodward, Suite 400
Birmingham, MI 48009

(For Patent Owner)

90/004,999
90/005,030
90/005,450
90/005,561

James W. Miller
Foshay Tower
Suite 1005
821 Marquette Avenue
Minneapolis, MN 55402

(For Requester)

Michael B. McMurry
Brunswick Corporation
1210 Astor Street
Chicago, IL 60610

(For Requester)

90005030 .070298

#17

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,647	02/20/00	5440179	PM 236440

MM71/0620

Victor Treyz
Fish & Neave
1251 Avenue of the Americas
New York, NY 10020-1104

EXAMINER
FLEMING,F

ART UNIT	PAPER NUMBER
2836	7/8

DATE MAILED: 06/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Kevin Joyce
Pillsbury Madison & Sutro
1100 New York Avenue, N.W
Ninth Floor, East Tower
Washington, DC. 20005-0944

PTO-90C (Rev. 2/95)

1- File Copy

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 17/8

Victor Treyz (For Patent Owner)
FISH & NEAVE
1251 Avenue of the Americas
New York, New York 10020-1104

Kevin E. Joyce (For Requester)
PILLSBURY, MADISON & SUTRO
Intellectual Property Group
1100 New York Avenue, N.W., Ninth Floor
Washington, D.C. 20005-3918

In re Alex J. Severinsky	:	
Reexamination Proceeding	:	
Control No. 90/005,039	:	
Filed: July 14, 1998	:	
For U.S. Patent No. 5,440,179	:	DECISION MERGING
Title: UPS WITH BI-DIRECTIONAL POWER FLOW	:	REEXAMINATION
	:	PROCEEDINGS
	:	
In re Alex J. Severinsky	:	
Reexamination Proceeding	:	
Control No. 90/005,647	:	
Filed: February 28, 2000	:	
For U.S. Patent No. 5,440,179	:	
Title: UPS WITH BI-DIRECTIONAL POWER FLOW	:	

The above-identified reexamination files are before the director of Examining Group 2830, Technology Center 2800, for consideration of merger of the above-identified reexamination proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,440,179 was issued on August 8, 1995

2. A first request for reexamination, Control No. 90/005,039 was filed by a third party requester on July 14, 1998.

3. Reexamination was ordered in the '5039 reexamination proceeding on September 3, 1998.

4. An Office action was mailed on November 5, 1999.

5. An amendment was submitted on November 19, 1999 canceling claim 7 and amending claim 8.

6. A supplemental amendment was submitted on January 27, 2000 in response to an Office communication mailed January 12, 2000, no amendment to claims was made.

7. A second request for reexamination, Control No. 90/005,647 was filed by the same third party requester on February 28, 2000.

8. Reexamination was ordered in the '5647 reexamination proceeding on April 25, 2000.

9. A Notification of Intention Not to File a Patent Owner's Statement was filed, via facsimile transmission, on May 3, 2000.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is

appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '5370 and '5519 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in Both Proceedings.

As noted above, the claims have been amended in the '5039 reexamination proceeding. Patent owner is required to maintain the same claims and specification in both files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. '5039 and '5647 are merged. The reexamination files are being returned to the Central Reexamination Files where they await the "housekeeping" amendment from the patent owner.

Stewart J. Levy, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,060	08/05/98	5503176	09934/002001

QM61/1107

RICHARD L. HUGHES
SHERIDAN ROSS P.C.
SUITE 3500
1700 LINCOLN STREET
DENVER CO 80203

EXAMINER	
RIVELL, J	
ART UNIT	**PAPER NUMBER**
3753	28 & 29
DATE MAILED:	11/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Paper No. 29

In re Application of US Patent 5,503,176
Appl. No.: 90/005,060
Filed: August 5, 1998
For: Backflow Preventor With Adjustable Outflow Direction

DECISION ON PETITION UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed February 9, 1999, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until prosecution on the merits is closed, at which time the petition will be decided.

Petitioner requests that a document entitled Exhibits B-1, B-2, B-3, B-4, B-6, B-9 and B-10, filed April 26, 1999, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(i) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material" with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be returned to the petitioner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rivell whose telephone number is (703) 308-2599. The examiner can normally be reached on Mon.-Thur. from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (703) 308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7765 for regular communications and (703) 308-7765 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

j.r.
11/01/00

John Rivell
Primary Examiner
Art Unit 3753

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAY 31 2005

Paper No. 46

Baker + Hostetler, LLP
Washington Square, Suite 1100e
1050 Connecticut Avenue, NW
Washington, DC 20036-5304

(For Patent Owner)

Fish & Richardson
225 Franklin Street
Boston, MA 02110-2804

(For Requester)

In re CMB Industries, Inc.
Reexamination Proceeding
Control No. 90/005,060
Filed: August 4, 1998
For: U.S. Patent No. 5,503,176

: DECISION ON PETITION
: TO EXPUNGE

On April 26, 1999, certain information was submitted to the Office in connection with the above styled reexamination proceeding. The material was submitted with a concurrently filed petition to expunge the information.

The reexamination proceeding has been concluded, and the examiner reports that the material was not regarded by the examiner as being material to the patentability of the claims involved in this proceeding. Accordingly, the petition is granted, and the material is being returned to Owner with this communication. A copy of the material is being forwarded to Requester.

PETITION GRANTED.

Questions regarding this matter may be referred to the undersigned, who may be reached at (571) 272-4368.

Stephen Marcus, Special Program Examiner
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAY 31 2005

Paper No. 43

Baker + Hostetler, LLP
Washington Square, Suite 1100e
1050 Connecticut Avenue, NW
Washington, DC 20036-5304

(For Patent Owner)

Fish & Richardson
225 Franklin Street
Boston, MA 02110-2804

(For Requester)

In re CMB Industries, Inc.
Reexamination Proceeding
Control No. 90/005,061
Filed: August 5, 1998
For: U.S. Patent No. 5,385,166

: DECISION ON PETITION
: TO EXPUNGE

On April 26, 1999, certain information was submitted to the Office in connection with the above styled reexamination proceeding. The material was submitted with a concurrently filed petition to expunge the information.

The reexamination proceeding has been concluded, and the examiner reports that the material was not regarded by the examiner as being material to the patentability of the claims involved in this proceeding. Accordingly, the petition is granted, and the material is being returned to Owner with this communication. A copy of the material is being forwarded to Requester.

PETITION GRANTED.

Questions regarding this matter may be referred to the undersigned, who may be reached at (571) 272-4368.

Stephen Marcus, Special Program Examiner
Technology Center 3700

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,062	08/06/98	5226441	09934/003001

QM61/1107

RICHARD L. HUGHES
SHERIDAN ROSS P.C.
SUITE 3500
1700 LINCOLN STREET
DENVER CO 80203

EXAMINER	
RIVELL, J	
ART UNIT	**PAPER NUMBER**
3753	26 & 27
DATE MAILED:	11/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

DO NOT REMOVE

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT COMMISSIONER FOR PATENTS

Paper No. 29

In re Application of US Patent 5,226,441
Appl. No.: 90/005,062
Filed: August 6, 1998
For: Backflow Preventor With Adjustable Outflow Direction

DECISION ON PETITION UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed February 9, 1999, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until prosecution on the merits is closed, at which time the petition will be decided.

Petitioner requests that a document entitled Exhibits B-1, B-2, B-3, B-4, B-6, B-9 and B-10, filed April 26, 1999, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(i) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material" with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be returned to the petitioner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rivell whose telephone number is (703) 308-2599. The examiner can normally be reached on Mon.-Thur. from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (703) 308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7765 for regular communications and (703) 308-7765 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

j.r.
11/01/00

John Rivell
Primary Examiner
Art Unit 3753

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 14

FEB 23 2000
REEXAM UNIT

PAUL S. SHARPE
MCFADDEN FINCHAM
225 METCALFE STREET
SUITE 606
OTTAWA, ONTARIO
CANADA K2P 1P9

(For Patent Owner)

THOMAS Q. HENRY, ESQ.
WOODWARD, EMHARDT, NAUGHTON,
MORIARTY & MCNETT
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

(For Requester)

In re Reexamination Proceeding :
90/005,088 : DECISION
Filed: August 26, 1998 : GRANTING
For: U.S. Patent No. 5,661,117 : PETITION
Patentee: Dufresne :

This is a decision on the renewed patent owner PETITION UNDER 35 U.S.C. 133 filed October 8, 1999, for entry of late papers on the grounds of unavoidable delay; see MPEP 2268.

The petition is before the Office of the Deputy Assistant Commissioner for Patent Policy and Projects for decision.

The petition under 35 U.S.C. 133 for the entry of late papers is granted for the reasons pointed out below.

DECISION

This reexamination proceeding terminated on July 6, 1999, for failure to timely file a response to the non-final Office action of May 5, 1999, which set a shortened statutory period for response of two (2) months, and noted that extensions of time were governed by 37 CFR 1.550(c).

Petitioner asserts that docketing error was the cause of delay in responding to the May 5, 1999, Office action.

1. Petitioner has submitted verified copies of docket sheets which substantiate the error in docketing, along with supporting statements. Specifically, a copy of the docket records showing the failure to indicate "the inextensibility of the July 5, 1999 deadline" in the docket records has been submitted. Further, Ms. Toward's copy of the docket marked to move the deadline "ahead to August 5, 1999," has also been provided.

2. Additionally, petitioner has supplied a detailed explanation by Ms. O'Connell of the docketing/call-up system which is in use and has identified the type of records kept.

3. Further, petitioner has provided a verified statement by all persons with direct knowledge of why docket procedures failed, setting forth the facts as they know them. Ms. O'Connell has provided a verified statement indicating the extent of her training and experience in docketing of reexaminations, and also points out her omission of the normal "LAST DATE - WILL GO ABANDONED" annotation in the docket record, which would have indicated the inextensibility of the July 5, 1999 deadline in the computerized docketing system. A verified statement by Ms. Toward has also been provided, explaining her assumption that an extension of time to respond to the outstanding office

action was available, due to the lack of an entry in the docket record indicating "LAST DATE - WILL GO ABANDONED" or "CANNOT EXTEND," which usually tells her when a date cannot be extended.

4. Petitioner has indicated that Ms. Toward has been instructed for the future that where a reexamination is denoted on the docket report, its time for response cannot be extended in the manner of a petition for extension under 1.136(a), even if it is inadvertently not marked as unextendable.

5. Petitioner has requested entry of both the July 27, 1999 amendment and September 7, 1999 supplemental response. Since the renewed petition under 35 U.S.C. § 133 for the entry of late papers is **granted**, these submissions by patent owner are timely and will be entered.

6. Petitioner has provided the requisite proof of service with the renewed petition and accompanying papers filed October 8, 1999, and has indicated that these and all prior papers[1] were served on reexamination requester's counsel[2].

CONCLUSION

1. The Petition Under 35 U.S.C. 133 is **granted**.

2. The Reexamination file will be forwarded to Technology Center 1700 for entry of the July 27, 1999 amendment and the September 7, 1999 supplemental response, and for examination based upon the patent owner responses.

---

[1] This includes the amendment of July 27, 1999, as well as the supplemental response of September 9, 1999, filed by Patent Owner.

[2] Which at the time of service, was Bruce M. Monroe of RATNER & PRESTIA, in Wilmington, DE.

3. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 306-5682.

Kenneth M. Schor
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

February 22, 2000
reex5088.lyn

SOLICITOR

FEB 29 2000

U.S. PATENT & TRADEMARK OFFICE

NOTE: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public order.

United States Court of Appeals for the Federal Circuit

MISCELLANEOUS DOCKET NO. 605

IN RE DOME PATENT, L.P.,

Petitioner.

ON PETITION FOR WRIT OF MANDAMUS

Before NEWMAN, LOURIE, and BRYSON, Circuit Judges.

LOURIE, Circuit Judge.

ORDER

Dome Patent, L.P. petitions for a writ of mandamus to direct the Commissioner of Patents and Trademarks "to apply the Administrative Procedure Act in the manner mandated by the United States Supreme Court." Dome Patent submits a "supplement" to its petition.

By order dated November 9, 1998, the Patent and Trademark Office denied a request for reexamination of U.S. patent no. 4,306,402. The requester filed a petition to the Commissioner seeking review of the order. On June 24, 1999, the Commissioner's designee, the group director, determined that there was a substantial new question of patentability and granted the petition. Dome Patent petitioned the Commissioner for review of the June 24 decision. The Commissioner denied that petition. Apparently, reexamination proceedings are now underway.

Dome Patent argues that the Commissioner was required, pursuant to 5 U.S.C. § 706 of the Administrative Procedure Act and Dickinson v. Zurko, 527 U.S. 150 (1999),

to state and use the Zurko standard of review when it decided that a substantial new question of patentability was raised. Dome Patent argues, without support, that "Zurko applies to all review of agency actions, whether by a reviewing court or upon reconsideration of the agency's own action." Dome Patent further argues that, under the Zurko standard of review, a substantial new question of patentability was not raised.

We determine that Dome Patent's arguments are totally without merit. Dome Patent cites no authority establishing that the standard for court review of an agency decision applies when an agency reviews a previous decision on petition. See Zurko, 119 S.Ct. at 1818 (deciding the issue whether "judicial review" of an agency's findings of fact are governed by 5 U.S.C. § 706); 5 U.S.C. § 706 (stating a reviewing court's scope of review of an agency's findings of fact). In any event, although this court might ultimately review a decision that canceled claims on reexamination, the decision to institute reexamination is not subject to review. Joy Mfg. v. National Mine Serv. Co., 810 F.2d 1127, 1130 (Fed. Cir. 1987).

The remedy of mandamus is available only in extraordinary situations to correct a clear abuse of discretion or usurpation of judicial power. In re Calmar, Inc., 854 F.2d 461, 464 (Fed. Cir. 1988). A party seeking a writ bears the burden of proving that it has no other means of attaining the relief desired, Mallard v. U.S. Dist. Court for the Southern Dist. of Iowa, 490 U.S. 296, 309 (1989), and that the right to issuance of the writ is "clear and indisputable," Allied Chemical Corp. v. Daiflon, Inc., 449 U.S. 33, 35 (1980). Dome Patent has not met this heavy burden.

Further, the only harm of which Dome Patent could complain, that a patent might unnecessarily be reexamined, does not present an extraordinary circumstance justifying

the remedy of mandamus. See United States v. Watson, 603 F.2d 192, 196-97 (CCPA 1979) (that the petitioner "may suffer hardship, inconvenience, or an unusually complex trial" does not provide a basis for a court exercising its discretion to grant mandamus). See also Federal Trade Comm'n v. Standard Oil Co. of California, 449 U.S. 232, 244 (1980) (expenses and burdens of defending action do not constitute irreparable harm); Communication Workers of America AFL-CIO v. American Telephone Co., 932 F.2d 199, 213 (3rd Cir. 1991) (a party having to arbitrate before taking an appeal does not mean that the party does not have adequate relief).

Accordingly,

IT IS ORDERED THAT:

Dome Patent's petition for a writ of mandamus is denied.

FOR THE COURT

FEB 25 2000

Date

Alan D. Lourie

Alan D. Lourie
Circuit Judge

cc: John P. Sutton, Esq.
Albin F. Drost, Esq.

s8

FILED
U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT

FEB 25 2000

JAN HORBALY
CLERK

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
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Paper No. 37

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(For Requester)

MAILED

NOV 26 2002

REEXAM UNIT

In re Neefe
Reexamination Proceeding
Control No. 90/005,090
Filed: August 27, 1998
For: U.S. Patent No. 4,306,042

DECISION GRANTING PETITION

This is a decision on the November 8, 2002, patent owner petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), based upon unintentional delay. The petition is before the Office of Patent Legal Administration for decision.

A petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), requires a fee under 37 C.F.R. § 1.17(m) of $1280.00. The instant petition was accompanied by a check for $1240.00, which is an insufficient amount for this type of petition. The petition paper includes an authorization to charge any underpayment to the deposit account, therefore the $40.00 difference has been charged to deposit account 50-2207, as per petitioner's instructions on page 2 of the instant petition.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The required reply to the outstanding final Office action of May 23, 2002, in the form of a response to the final rejection and a Notice of Appeal of July 12, 2002, and an Appeal Brief of October 25, 2002, along with the appropriate appeal fees, have been received. As discussed above, the instant petition was accompanied by a check for $1240.00, which is an insufficient amount for this type of petition. However, the petition paper includes an authorization to charge any underpayment to the deposit account, therefore the $40.00 difference has been charged to deposit account 50-2207, as per petitioner's instructions on page 2 of the instant petition. The instant petition includes the statement of item (3) above. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

In view of the above, the petition for the entry of late papers

is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

It is noted that an advisory action was never mailed in this reexamination proceeding despite the receipt of a timely response to the final Office action on July 12, 2002. Since the response to the final Office action has not yet been addressed by the examiner in this proceeding, the next Office action should include an indication of the examiner's ruling on the timely filed response to the final Office action.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 1700 for consideration of the response to the final Office action of July 12, 2002, and the Appeal Brief of October 25, 2002.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Sanza McClendon, of Group Art Unit 1711.

4. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

November 22, 2002

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/659,377	09/07/00	Eric B. Johansson	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,229,068	09/13/2002	30

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/ 005,098 Filing Date: 09/03/1998

Requester (name, address) Nixon and Vanderhye, P. C.
1100 North Glebe Road
8th Floor
Arlington, VA 22201-4714

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/ 005,098, filed 09/03/1998, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 29

Nixon & Vanderhye PC
1100 North Glebe Road
8th Floor
Arlington VA 22201--4714

(For Patent Owner)

MAILED

SEP 13 2002

REEXAM UNIT

In re reissue application of
Johansson, et al.
Application No. 09/659,377
Filed: September 7, 2000
For: U.S. Patent No. 5,229,068

In re Johansson, et al.
Reexamination Proceeding
Control No. 90/005,098
Filed: September 3, 1998
For: U.S. Patent No. 5,229,068

DECISION VACATING FINAL OFFICE ACTION IN REEXAMINATION PROCEEDING AND DECISION MERGING REEXAMINATION AND REISSUE PROCEEDINGS

DO NOT ENTER

The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,229,068 issued to Johansson et al., on July 20, 1993.

2. A request for reexamination of the '068 patent was filed by patent owner on September 3, 1998, and the resulting reexamination proceeding was assigned Control No. 90/005,098.

3. On November 18, 1998, reexamination was ordered in the '5098 proceeding.

4. The examiner issued an Office action in the '5098 reexamination proceeding on June 6, 2000, rejecting all of the outstanding patent claims raising, *inter alia*, the issues of new matter and broadening, as well as 35 U.S.C. 112 (1st) and 35 U.S.C. 112 (2nd) paragraph issues.

5. On September 6, 2000, patent owner filed an amendment in the '5098 reexamination proceeding.

6. Patent owner filed a reissue application based on the '068 patent, on September 7, 2000, which was assigned Application No. 09/659,377. Claims 1-14, 17-19, 21 and 45-71 were canceled, claims 15, 16, 20, 22, 27, 28, and 35 were amended, and claims 72-74 were added. In the reissue application, patent owner alerted the Office of the co-pending '5098 reexamination proceeding, and stated that the purpose of filing the reissue application was to have the two proceedings merged and examination continued under the reissue rules. In this regard, patent owner stated in the first paragraph of the reissue application: "Merger of the Reexamination and Reissue is requested, with examination to proceed in accordance with 35 U.S.C. 1.171 through 1.179 (sic)."

7. On April 9, 2001, the Office mailed a "Notice of Missing Parts of Reissue Application / Filing Date Granted" in the reissue application.

8. Patent owner filed a paper submitting the noted missing parts of the reissue application on September 10, 2001.

9. On October 2, 2001, the reissue application was forwarded to Technology Center 3600 for examination.

10. The examiner issued a final rejection in the '5098 reexamination proceeding on October 4, 2001, setting a 2-month shortened statutory period for response, in which claims 15-16, 20, 22-24, and 107-109 were rejected.

11. On October 15, 2001, a preliminary amendment was filed in the reissue application placing the same amendments in the reissue application as were submitted in the '5098 reexamination proceeding. The specification was amended,

claims 72-74 were canceled, claims 75-106 were added and canceled, and claims 107-109 were added. On page 13 of the amendment, patent owner stated: "Should the USPTO merge the two proceedings as previously requested, subsequent amendments will be made in the manner called for in Section 2285C. Action on the merged proceedings under the normal Reissue rules is requested."

12. Patent owner filed a request for an extension of time to respond to the final rejection in the '5098 reexamination proceeding, on October 23, 2001. In the request for an extension of time, patent owner again alerted the Office of the co-pending reissue application, and inquired as to why the files had not yet been forwarded to the Commissioner's Office for a decision on the merger issue in accordance with MPEP 2285C. Patent owner requested the extension of time "in order to have the question of merger decided." Patent owner correctly noted that if the proceedings were merged, the merged proceeding would be conducted under the reissue rules and not the reexamination rules. Patent owner stated: "In order to fully understand applicant's options with respect to going forward with the prosecution of this case, a decision on the issue of merger is critical and applicant therefore requests this additional one month time period for response, with the hope and expectation that a decision on the merger will have been made so that applicant can then go forward as appropriate."

13. Notice of the filing of the reissue application was published in the *Official Gazette* on October 30, 2001.

14. On December 4, 2001, the Group Director of Technology Center 3600 mailed a decision in the '5098 reexamination proceeding granting the request for a one month extension of time to respond to the outstanding final rejection of October 4, 2001. In the decision the Group Director noted: "Patent Owner requests an extension of one month to January 4, 2002 in order to have the question of merger decided and for Patent Owner to have the opportunity to decide on how to proceed."

15. Patent owner filed a response to the final rejection in the '5098 reexamination proceeding on January 4, 2002. On pages 5-6 of the response patent owner once again alerted the Office of the co-pending reissue application, and requested that a decision on merger be made by the Office. Patent owner stated: "Applicants specifically request (and this may

be considered a petition if necessary, with any required fee authorized to be charged to the deposit account identified on the cover sheet of this amendment) that the pending reissue and reexamination proceedings be merged prior to any further Office Action in this reexamination proceeding."

16. An advisory action in response to the January 4, 2002, amendment after final rejection has not been mailed in the '5098 reexamination proceeding.

17. On April 4, 2002, the 6-month statutory period for filing a response to the October 4, 2001, final Office action expired. No Notice of Appeal has been received in the '5098 reexamination proceeding.

VACATING OF FINAL OFFICE ACTION OF OCTOBER 4, 2001, IN REEXAMINATION PROCEEDING

A review of the records of the reexamination and reissue files shows that the patent owner filed the reissue application on September 7, 2000, for the purpose, *inter alia*, of effecting a merger of the reissue and reexamination proceedings, in order to have the examination conducted under the reissue rules in lieu of the reexamination rules. In this regard, patent owner, in the first paragraph of the reissue application papers, alerted the Office of the existence of the co-pending reexamination proceeding and of the reason for the filing of the reissue application (merger of the proceedings). Further, on October 15, 2001, patent owner filed a preliminary amendment in the reissue application, placing the same amendments in the reissue application as were submitted in the reexamination proceeding. In the preliminary amendment, patent owner noted that under MPEP 2285C, amendments in a merged proceeding will be governed by the reissue rules, and again requested the merger of the proceedings and examination under the reissue rules.

The records further show that on October 4, 2001, a final rejection was mailed in the reexamination proceeding. On October 23, 2001, patent owner filed a request for an extension of time to respond to the final Office action. In the request for an extension of time, patent owner alerted the Office of the co-pending reissue application, and inquired as to why the files

were not forwarded to the Commissioner's Office for a decision on the merger issue, in accordance with MPEP 2285C. Patent owner requested the extension of time in order to have the question of merger decided. On December 4, 2001, the Group Director granted a one month extension of time, noting that patent owner requested an extension for one month to January 4, 2002, in order to have the question of merger decided and for Patent Owner to have the opportunity to decide on how to proceed.

On January 4, 2002, patent owner filed a response to the final rejection of October 4, 2001. On pages 5-6 of the response, patent owner again alerted the Office of the co-pending reissue application, and specifically requested that a decision on merger be made by the Office. Patent owner stated that, if necessary, this request for merger may be considered a petition that the pending reissue and reexamination proceedings be merged, prior to any further Office Action in this reexamination proceeding.

90/005,098

MPEP 714.13 provides (page 700-185):

> Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. An examiner is expected to turn in a response to an amendment after final rejection within 10 calendar days from the time the amendment is received by the examiner. A reply to an amendment after final rejection should be mailed within 30 days of the date the amendment is received by the Office.

MPEP 2272 (FINAL REJECTION - TIME FOR RESPONSE) provides:

> The statutory period for response to a final rejection in a reexamination proceeding will normally be two (2) months. If a response to the final rejection is filed, the time period set in the final rejection continues to run. ... Any advisory Office action (form PTOL-467) issued in reply to patent owner's response after final rejection will inform the patent owner of the automatic 1 month extension of time. ... Note further that the patent owner is entitled to know the examiner's ruling on a timely response filed after final rejection before being required to file a notice of appeal. Notification of the examiner's ruling should reach the patent owner with sufficient time for the patent owner to consider the ruling and act on it. Accordingly, the period for response to the final rejection should be appropriately

> extended in the examiner's advisory action. See *Theodore Groz & Sohne & Ernst Beckert Nadelfabrik KG v. Quigg*, 10 USPQ2d 1787 (D.D.C. 1988). The period for response may not, however, be extended to run past 6 months from the date of the final rejection.

MPEP 2285C (Reexamination Proceedings Underway, Reissue Application Filed) provides:

> When a reissue application after a reexamination proceeding has begun following an order therefor, the reexamination, patent, and the reissue files should be forwarded to the Office of Patent Legal Administration (OPLA) for consideration as to whether or not to merge the proceedings or stay one proceeding.

The record clearly shows that the Office failed to follow its established procedures in two respects. First, despite two attempts in the reissue application and two attempts in the reexamination proceeding by patent owner to have the issue of merger of the proceedings addressed, the Office failed to do so. Further, notwithstanding the filing of the reissue application, which should have resulted in consideration of merger of the proceedings, a final rejection was mailed in the reexamination proceeding.

Second, patent owner filed an amendment to the final Office action in the reexamination proceeding with three months remaining in the six month statutory period for response to an Office action. An advisory action should have been mailed within 30 days of the receipt of the amendment after final. No such advisory action has been mailed to date. Further, if an advisory action had been mailed, the examiner would have been required to extend the time for response to provide appropriate time for response (i.e., to file a notice of appeal). If, when mailing the advisory action, insufficient time remained in the original six month response period for the patent owner to timely respond, the examiner (to be in accordance with the *Groz & Sohne* decision, *supra*) would have been compelled to vacate the final Office action and re-mail the final Office action setting a new period for response (i.e., a shortened statutory time period in a new six month period).

In view of all of the above, it is appropriate that the final

Office action of October 4, 2001, be *ab initio* vacated[1], and that the reissue and reexamination proceedings be merged. Accordingly, the final Office action of October 4, 2001, in the '5098 reexamination proceeding is hereby, *ab initio*, vacated. The amendment after final Office action filed on January 4, 2002, will not be entered into the reexamination file.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '5098 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings,

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[1]the Office action must be *ab initio* vacated to preclude the termination of the reexamination proceeding for failure to timely respond within the six month statutory period for response to an Office action

consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the '5098 reexamination file shows that amendments to the claims were made in the reexamination file. A final rejection was mailed in the '5098 reexamination proceeding on October 4, 2001, setting a two month shortened statutory period for response, in which claims 15-16, 20, 22-44, and 107-109 were rejected. Patent owner was granted a one month extension of time to provide such response, and a proposed response to the final rejection was received on January 4, 2002. An advisory action has not been mailed, but since the final rejection of October 4, 2001, has been *ab initio* vacated, as indicated *supra*, the response will not be entered.

A review of the reissue (Application No. 09/659,377) prosecution history shows that the reissue application was published in the *Official Gazette* on October 30, 2001. The application is awaiting a first Office action on the merits by the examiner. In the reissue application, patent owner has canceled claims 1-14, 17-19, 21 and 45-71, amended claims 15-16, 20, 22, 27-28 and 35, and added claims 72-74. Patent owner then amended the specification, canceled claims 72-74, added claims 75-106 and then canceled claims 75-106, and added claims 107-109 for consideration. Patent owner has indicated that they filed this preliminary amendment in the reissue application in order to place the same amendments in the reissue application as were submitted in the reexamination proceeding. Thus, the claims appear to be identical in both proceedings, with the exception of one typographical difference in claim 37. In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

Since the patent owner has repeatedly requested merger of the reexamination and reissue proceedings, and the final Office action in the reexamination proceeding has been *ab initio* vacated in order to enable such requested merger, the above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d).

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding. Each action will be physically entered into both files (which will be maintained as separate files).

DOCKET ALARM

Any response by the applicant/patent owner must consist of a single response, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data *for both of the cases* (i.e, the reissue Application No. and the reexamination proceeding Control No.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

CONCLUSION

1. The final Office action mailed October 4, 2001, in the '5098 reexamination proceeding is hereby *ab initio* vacated.

2. The above-identified reissue application and reexamination proceeding **ARE MERGED** into a single consolidated proceeding.

3. The reissue application file and the reexamination file are being forwarded to the Group Director of Technology Center 3600.

4. The examiner should immediately issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding. All further examination should be conducted in accordance with Parts II and III of this decision.

5. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Robert J. Spar, Director
Office of Patent Legal Administration

September 12, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 13

KILPATRICK STOCKTON LLP
Atten: Roger T, Frost
Suite 2800
1100 Peachtree Street
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(For Patent Owner)

Ross F. Hunt
LARSON & TAYLOR
TransPotomac Plaza
119 North Fairfax Street, Suite 900
Alexandria, VA 22314-1437

(For Requester)

MAILED

SEP 07 2001

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re William H. Leverett
Reexamination Proceeding
Control No. 90/005,106
Filed: September 10, 1998
For: U.S. Patent No. 5,677,516

DECISION ON REQUEST
TO REMAIL
OFFICE ACTION

This is a decision on the request, filed August 31, 2001, to withdraw any holding of abandonment and remail the Office action mailed July 18, 2000, filed August 31, via facsimile transmission, which is treated as a petition under 37 C.F.R. § 1.181 to remail the Office action dated July 18, 2000, based on non-receipt of such action.

The petition is GRANTED.

Petitioner asserts that the Office action mailed July 18, 2000, was not received. A review of the written record indicates no irregularity in the mailing of the Office action, and in the absence of any irregularity there is a strong presumption that the Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office action must include a statement from the practitioner stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c).

To support the petition, the petitioner has submitted a copy of the docket records where the Office action would have been entered had it been received and a statement attesting that a search of the file jacket and dockets records indicates that the Notice was not received. This decision presumes that the copy of the docket record accompanying the petition is a copy of the record where the Office action would have been logged in had it been received at the law firm of Jones & Askew, 191 Peachtree Street, N.E., 37th Floor, Atlanta, Georgia. Should this presumption be incorrect, petitioner is required to promptly inform the Office so that this decision may be vacated.

The petition satisfies the conditions set forth under M.P.E.P. § 711.03(c) for showing non-receipt of an Office action. Accordingly, the petition is granted and the Office action dated December 6,2000 will be remailed.

The application file is being forwarded to the Technology Center technical support staff for re-mailing the Office action. The time period for submitting a response will be reset to expire 2 (two) months from the date the Office action is remailed. Extensions of this time are NOT AVAILABLE under 37 C.F.R. § 1.136(a) but are governed by 37 C.F.R. § 1.550(c).

Any inquiry relating to this letter should be directed to Hien H. Phan, Special Programs Examiner, at (703) 308-7502.

Howard N. Goldberg, Director
Technology Center 2800
Semiconductor, Electrical and Optical
Systems and Components

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,133	11/20/98	4856007	

MM21/0621

WARD & OLIVO
708 THIRD AVENUE
NEW YORK NY 10017

EXAMINER
SCOTT JR, L

ART UNIT	PAPER NUMBER
2881	10

DATE MAILED: 06/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)
1- File Copy
U S G P O 2000 ; 465-188/25266

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Washington, D.C. 20231

Paper No. 10

WARD & OLIVO
708 Third Avenue
New York, NY 10017

(For Patent Owner)

Laurence A. Greenberg
LERNER AND GREENBERG
2200 Hollywood Boulevard
P.O. Box 2480
Hollywood, Florida 33020-2480

(For Requester)

In re U.S. Patent of)
Hardy P. Weiss)
Reexamination Proceeding)
Control No. 90/005,133)
Filed: November 20, 1998)
For U.S. Patent No. 4,856,007)
Title: AXIAL GAS LASER AND)
PROCESS FOR STABILIZING)
ITS OPERATION)

DECISION ON REQUEST FOR
REMAILING OFFICE ACTION

This is a decision on the request for extension of time under 37 CFR § 1.550(c), filed June 2, 2000, via facsimile transmission, which is treated as a request to reset the period for response set in the Office action dated April 5, 2000.

The request is GRANTED.

The requester asserts that the Office action, dated April 5, 2000, was mailed to the law firm of Antonelli, Terry, Stout and Krauss who were the attorneys prosecuting the application which matured into the patent under reexamination. The mailing of the Office action was improper because a revocation and change of power of attorney was filed for this patent on November 13, 1997 providing a correspondence address of Ward & Olivo, 708 Third Avenue, New York, New York 10017. Due to the improper mailing, the requester did not receive the Office action until May 24, 2000.

A review of the file record indicates that an Office action was mailed on April 5, 2000 setting a time period of two months for filing a reply. The Office action was mailed to a previous address and not to the current correspondence address of record. On June 2, 2000, a request for extension of time was submitted via facsimile transmission. It is noted that the request was not served on the third party requester pursuant to 37 CFR § 1.550(e).

Pursuant to M.P.E.P. § 707.13, when an Office action was returned because the US Postal Service was not able to deliver it, the Office action will be remail... and the period running against the application begins with the date of remailing.

Pursuant to M.P.E.P. § 710.06, the period for response due to late receipt of an Office action will be reset if 1) a petition was filed with two months of the date of receipt of the Office action, 2) a substantial portion of the set reply period had elapsed on the date of receipt, and 3) a petition including evidence showing the date of receipt of the Office action at the correspondence address.

It is apparent from the file records that the Office action of April 5, 2000 was not duly mailed to the proper correspondence address of record. However, since the Office action was forwarded and has been received by the patent owner on May 24, 2000, it is appropriate that the period for response be reset to run from the date the Office action was received at the proper correspondence address of record.

The period for response set in the Office action dated April 5, 2000, is hereby **reset to run 2 (two) months from May 24, 2000, the date the Office action was received by the patent owner, and expires July 24, 2000. Extensions of time are governed by 37 CFR 1.550(c).**

The patent owner is reminded that all papers submitted for this reexamination proceeding must be served to the requester pursuant to 37 CFR 1.550(e).

A copy of the request for extension of time filed June 2, 2000 is being supplied herewith to the third party requester.

Hien H. Phan, Special Programs Examiner
Technology Center 2800
Semiconductors, Optical and Electrical

enclosure: Copy of Request for Extension of Time filed June 2, 2000 to third party requester
Systems and Components

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,134	10/01/98	5449519	007206-0051

HM32/1129

GERALD J FLINTOFT
PENNIE AND EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036-2711

EXAMINER	
SEIDLECK, B	

ART UNIT	PAPER NUMBER
1615	#15

DATE MAILED: 11/29/00

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90005134 20001129

UNITED STATES DEPARTMENT OF COMMERCE
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Washington, D.C. 20231

MAILED TC-1600
11/29/00

GERALD J FLINTOFT
PENNIE AND EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK , NY 10036-2711

FOR PATENT OWNER

DONALD J. BIRD
PILSBURY MADISON & SUTRO
INTELLECTUAL PROPERTY GROUP
1100 NEW YORK AVE., NW
NINTH FLOOR, EAST TOWER
WASHINGTON, D.C 20005-3918

FOR REQUESTER

In re Wolf et al
Reexamination Proceeding
Control No.: 90/005,134
Filed: October 1, 1998
For: U.S.Patent No. 5,449,519

In re Wolf et al
Reexamination Proceeding
Control No.: 90/005,448
Filed: August 12, 1999
For: U.S.Patent No.5,449,519

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination files are before the director of Technology Center 1600 for consideration of merger of the proceedings under 37 CFR 1.656(c).

BACKGROUND

1. Patent No. 5,449,519 issued September 12, 1995

2. A first request for reexamination, Control No. 90/005,134, was filed by patent owner on October 1, 1998

3. Reexamination was ordered in the '134 reexamination proceeding on December 21, 1998

4. A second request for reexamination, Control No. 90/005,448, was filed by third party requester on August 12, 1999

5. Reexamination was ordered in the '448 reexamination proceeding on October 1, 1999

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above review of facts, reexamination has been ordered in both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate. The delay in merging these proceedings is regretted.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '134 and '448 reexamination proceedings are merged In view of the merger the Notice of Intent to Issue a Reexamination Certificate in the '134 proceeding is withdrawn. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

Patent Owner is required to maintain the same claims and specification in both files. **Patent Owner is required to submit an appropriate "housekeeping" amendment within ONE MONTH of this decision placing the same amendments in both files**. The paper should strictly be limited to the bare presentation of the necessary amendments. Any discussion of the merits or issues of the proceeding would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the Patent Owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office

CONCLUSION

Reexamination Control Nos. 90/005,1234 and 90/005,448 are merged. Upon receipt of the required paper placing the same amendments in both files, an Office action will issue in due course.

John Doll
Director, Technology Center 1600

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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

JUN - 8 2000

Paper No. 14

ROCKEY, MILNAMOW & KATZ, LTD.
TWO PRUDENTIAL PLAZA
180 NORTH STETSON, SUITE 4700
CHICAGO, IL 60601 : For Patent Owner

CHARLES E. TEMKO
TEMKO AND TEMKO
19 WEST 44TH STREET
NEW YORK, NY 10036-6001 : For Requester

In re Reexamination
Control No. 90/005,145
U.S. Patent No. 4,938,370 : DECISION ON PETITION
Issued: July 3, 1990 : FOR EXTENSION OF TIME
Patent Owner: H-C Industries, Inc..
Request Filed: October 8, 1998
Requester: Charles E. Temko

This is a decision on the paper filed by facsimile transmission on June 1, 2000 by which Patent Owner requests a one month extension of time pursuant to 37 CFR § 1.550(c) in which to reply to the outstanding final Office action dated April 4, 2000. No fee is required.

The petition is granted.

The petition sets forth a reason which is considered to adequately justify the grant of a one month extension of time. Accordingly, Patent Owner's request for a one month extension of time in which to file a reply to the final Office action dated April 4, 2000 is granted. A response to said Office letter will therefore be due on or before July 5, 2000, July 4, 2000 being a holiday in the District of Columbia.

It should be noted that pursuant to MPEP § 2265, the filing of a timely first reply to a final rejection in a reexamination proceeding will be construed as including a request to extend the time for reply for an additional one month, and such request will be granted notwithstanding the granting of the present petition. Thereafter, in view of the statutory requirement of 35 USC § 305 that reexamination proceedings be conducted with "special dispatch", Patent Owner may expect that any further extensions of time to respond to the outstanding Office letter will be granted only upon a strong showing of sufficient cause under 37 CFR § 1.550(c).

PETITION GRANTED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,146	10/09/98	5214582	EDGE-101REEX

PM51/1108

EDWARD D MANZO
COOK MCFARRON AND MANZO
200 WEST ADAMS SUITE 2850
CHICAGO IL 60606

EXAMINER
LOUIS JACQUES,J

ART UNIT	PAPER NUMBER
3661	20

DATE MAILED: 11/08/00

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UNITED STATES PATENT & TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

11-8-00

Paper No. 20

Edward D. Manzo
Cook, McFarron & Manzo
200 West Adams, Suite 2850
Chicago, IL 60606

In re Reexamination Proceeding No. 90/005,146	:	**LETTER *RE***
Filed: October 9, 1998	:	**RESTARTING PERIOD**
For: U.S. Patent No. 5,214,582	:	**FOR RESPONSE**

This is in response to Patent Owner's papers filed via facsimile transmission on October 10, 2000 and supplemented by an additional facsimile transmission on October 20, 2000.

A review of the reexamination file indicates that a nonfinal Office action was mailed on March 13, 2000 setting a two month period for response to expire on May 15, 2000 (May 13 being a Saturday). Patent Owner responded on May 16, 2000 (Certificate of Mailing dated May 11, 2000). This response was held to be improper in that it included a claim which had not been amended in compliance with 37 CFR §1.530. The examiner notified Patent Owner of the deficiency in a letter dated June 22, 2000. This letter set a one month period for response to expire on July 24, 2000 (July 22 being a Saturday). On or about October 10, 2000 the examiner called Patent Owner's representative to inquire about the filing of a proper response. At that time, Patent Owner's representative, Mr. John R. Lagowski, indicated that a response had been filed on July 20, 2000. Mr. Lagowski subsequently submitted a copy of the response and a copy of the self-addressed return postcard indicating that the response had been received in the United States Patent and Trademark Office (USPTO) on July 27, 2000. A certificate of mailing dated July 20, 2000 on the response made the response timely. This showing was supplemented by a statement from Ms. Donna Janus Moss attesting on a personal knowledge basis to the previous timely mailing of the response, 37 CFR §1.8(b)(3). The certificate of mailing taken in conjunction with the personal knowledge statement of Ms. Moss is sufficient proof that the response was timely filed, 37 CFR §1.8(a).

The reexamination file will be forwarded to the Primary Examiner, via the Supervisory Legal Instruments Examiner, for consideration of Patent Owner's response to the Office action of March 13, 2000.

John F. Terapane, Jr., Director
Patent Technology Center 3600
(703)306-4180

JFT:rr 10/27/00

UNITED STATES DEPARTMENT OF COMMERCE
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PATENTS AND TRADEMARKS
Washington, D.C. 20231

#24

FEB 14 2000

Knobbe, Martens, Olson & Bear, LLP
620 Newport Center Drive, Suite 1600 (For Patent Owner)
Newport Beach, CA 92660

Richard J. Minnich
Fay, Sharpe, Beall, Fagan, Minnich & McKee (For Requester)
1100 Superior Avenue, 7th Floor
Cleveland, OH 44114-2518

In re Gunzel, Jr., et al.
Reexamination Proceeding
Control No. 90/005,176
Filed: December 4, 1998
For U.S. Patent No. 5,039,016

In re Gunzel, Jr., et al.
Reexamination Proceeding
Control No. 90/005,437
Filed: July 28, 1999
For U.S. Patent No. 5,039,016

MERGER OF REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Examining Groups 3740 and 3750 for consideration of merger of the proceedings under 37 CFR § 1.656(c).

BACKGROUND

1. U.S. Patent No. 5,039,016 issued on August 13, 1991.

2. A first request for reexamination, Control No. 90/005,176, was filed by the requester on December 4, 1998.

3. Reexamination was ordered in the '176 reexamination proceeding on February 3, 1999.

4. A first Office action, containing a rejection of claims 15 and 16 and a confirmation of the patentability of claims 1-14, was mailed on May 21, 1999, as paper No. 6.

5. In response to the first Office action, an amendment was filed on July 23, 1999, which contained amendments to claims 15 and 16 and proposed the addition of claims 17 and 18. Claims 15 and 16 were entered, but claims 17 and 18 were not entered because they are not in compliance with the claim format provisions of 37 CFR 1.530(d)(2).

6. A second request for reexamination, Control No. 90/005,437, was filed by the requester on July 28, 1999.

7. Reexamination was ordered in the '437 reexamination proceeding on October 25, 1999.

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

Since reexamination has been ordered in both of the above noted reexamination proceedings, the time for the patent owner to file a statement in both proceedings has expired, merger of the proceedings under 37 CFR § 1.565(c) is appropriate.

MPEP Section 2283 indicates that if two requests for reexamination are filed with respect to the same patent, after the second request has been decided, and the time for the patent owner's statement in response to the reexamination order has expired, the proceeidngs will be merged.

Under the circumstances, it is considered proper to merge these proceedings at this point in time.

Even though claims 17 and 18 do not comply with the claim format provisions of 37 CFR 1.530(d)(2), they should be considered on the merits because they were filed timely in response to a first Office action in the '176 proceeding.

DECISION

1. Merger of Proceedings.

In accordance with 37 CFR § 1.565(c), the '176 and '437 reexamination proceedings are merged. The basis of the merged reexamination proceeding will be claims 1 through 18.

2. Conduct of Merged Proceedings.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. The patent owner shall maintain the same claims in both proceedings. All

papers filed by the patent owner must be served on the requester and the requester will be sent copies of all papers mailed by the Office.

HOUSEKEEPING AMENDMENT

The patent owner is required to promptly file, in this merged proceeding, a corrected copy of the amendment filed on July 23, 1999, i.e., a copy of the amendment in which claims 17 and 18 comply with the provisions of 37 CFR 1.530(d)(2), and which is captioned as a housekeeping amendment. By "promptly" is meant within one month of the date of this paper.

An Office action will issue in due course.

Any questions regarding the merged proceeding should be directed to Mr. Robert J. Webster, Special Program Examiner, Groups 3740 and 3750, at (703) 308-2619.

CONCLUSION

Reexamination control Nos. 90/005,176, and 90/005,437 are merged.

Ira Lazarus
Acting Director
Technology Center 3700400
Phone: (703) 308-1935
Fax: (703) 308-7764

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,182	12/14/98	5470954	018652-00070

HM32/1107

MICHAEL C SCHIFFER
BAXTER HEALTHCARE CORPORATION
P O BOX 15210
IRVINE CA 92623-5210

EXAMINER	
KEMMERER, E	

ART UNIT	PAPER NUMBER
1646	14

DATE MAILED: 11/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Control Number: 90/005,182

#14

UNITED STATES DEPARTMENT OF COMMERCE
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1600 - 11-07-00

MICHAEL C SCHIFFER
BAXTER HEALTHCARE CORPORATION
P O BOX 15210
IRVINE , CA 92623-5210

In re Reexamination Proceeding of
Neslund et al
Serial No.: 90/005,182
Filed: December 14, 1998
Attorney Docket No.: 18652-000700

: PETITION DECISION

This is in response to the Petition under 37 CFR 1.59, to expunge proprietary material submitted by applicants, filed August 24, 2000..

Applicants state that on December 14, 1998 and May 11, 1999, proprietary materials, as identified on the lists attached to the petition, were filed Applicant asserts that the proprietary information is not material to the patentability of the application and requests return thereof.

The petition is **GRANTED**. The identified materials are hereby returned, as requested.

The petition fee of $130.00 will be charged to patent owner's Deposit Account No. 20-1430, as directed.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 308-7922.

Jasemine C. Chambers
Director, Technology Center 1600

90005182 20001107

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

#16
Mail 12/21/0

Paper No. 16

MCGLEW & TUTTLE, P.C.
Scarborough Station
Scarborough, NY 10510-0827

(For Patent Owner)

Douglas R. Hanscom
JONES, TULLAR & COOPER
P.O. BOX 2266
Eads Station
Arlington, VA 22202

(For Requester)

MAILED

DEC 21 2000

REEXAM UNIT

In re Reexamination Proceeding :
Control No. 90/005,195 : **DECISION**
Filed: December 16, 1998 : **DISMISSING**
For: U.S. Patent No. 5,775,222 : **PETITION**
Patentee: Zweifel, et al. :

This is a decision on the patent owner petition of September 27, 2000, requesting the entry and consideration of the late response to the outstanding Office notification re defective paper. The petition is being treated as a PETITION UNDER 35 U.S.C. § 133 for the entry of late papers on the grounds of unavoidable delay; see MPEP 2268. The petition fee under 37 CFR § 1.17(h) of $130.00 has been charged to petitioner's deposit account, as per petitioner's instructions on page 2 of the present petition.

The petition is before the Office of Patent Legal Administration for decision.

The petition under 35 U.S.C. § 133 for the entry of late papers is **dismissed** for the reasons pointed out below.

Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. Extensions of time under 37 CFR § 1.136(a) are **not** permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 35 U.S.C. § 133."

REVIEW OF FACTS

1. U.S. Patent No. 5,775,222 issued to Zweifel, et al. on July 7, 1998.

2. A request for reexamination of the `222 patent was filed on December 16, 1998, by patent owner, and was assigned Control No. 90/005,195.

3. Reexamination was ordered on February 22, 1999.

4. On April 22, 1999, a timely Owner's statement was filed, along with an amendment. On August 5, 1999, another amendment was filed.

5. A non-final Office action was mailed on December 6, 1999, which set a 2 month shortened statutory period for response.

6. An amendment was filed on February 2, 2000, but it was held to be informal/non-responsive, as it was not in compliance with 37 CFR § 1.121(c).

7. On March 16, 2000, a notification of informal or non-responsive amendment was mailed, which indicated that the amendment of February 2, 2000, would not be entered. The notification set a time period for response of ONE (1) MONTH from the mailing date of the notification i.e., April 16, 2000.

8. No request for extension of time pursuant to 37 CFR § 1.550(c), was filed prior to the April 16, 2000, due date.

9. On September 27, 2000, the present petition was filed, accompanied by an amendment.

Decision Mailed

DECISION

A grantable petition for entry of belated papers under 35 U.S.C. § 133 must be accompanied (1) by an adequate showing of the cause of unavoidable delay, (2) by the proposed response to the outstanding Office action, and (3) by the petition fee required by law. This petition lacks items (1) and (2) above.

This reexamination proceeding terminated on April 17, 2000, for failure to timely file a response within the meaning of 37 CFR § 1.113 to the non-final Office action of December 6, 1999, which set a shortened statutory period for response of two (2) months, and noted that extensions of time were governed by 37 CFR § 1.550(c). The proposed response required for the present petition for entry of late papers must be an amendment in the proper format for a reexamination proceeding.

(1) With regard to an adequate showing of the cause of unavoidable delay, the present petition indicates that the Notice Re Defective Paper in Reexamination had been misinterpreted by representative's docket staff, and that the docket staff failed to docket a reply to the Notice in both of representative's docket systems. Additionally, it is indicated that the misinterpretation of the Notice resulted in a failure to route the Notice to the proper attorneys and agents working on the case. Initially, it is unclear what the nature of the misinterpretation was, and how it contributed to the delay in responding to the Notice. Clarification of such details should be presented in any renewed petition based upon unavoidable delay. Also, it is required that a showing be provided which sets forth the entirety of the facts surrounding the delay in responding to the Office action of December 6, 1999. Such showing must explain what MCGLEW & TUTTLE, P.C. did with the Office notification of informal/non-responsive amendment of March 16, 2000, when the firm received the communication from the USPTO, and why the firm did not provide a timely response. A statement is in order from the MCGLEW & TUTTLE, P.C. staff responsible for processing and docketing incoming Office correspondence to address this matter in detail. Also, the showing should include copies of any docket reports for the two docketing systems referred to in the petition, relevant to the time period in question, showing when the Notification of Informal or Non-responsive Amendment was received, and how it was

09/25/2000

handled. Therefore, with regard to petitioner's assertion that a docketing error was the cause of delay in responding to the Official communication of March 16, 2000, the showing provided is incomplete as to substantiating a docketing error, and the present petition is inadequate to establish a case of unavoidable delay within the meaning of the statute.

Any response to this petition decision to establish the cause of unavoidable delay must comply with the following:

As noted in MPEP 711.03(c)§(III)(2), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable delay", provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

DECISION

See In re Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds sub nom Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

It follows that petitioner's showing currently fails to meet criteria (B) and (C) above. The showing fails to adequately evidence there was a business routine for ensuring that USPTO correspondence was properly received, docketed and forwarded, and that the personnel were sufficiently trained in docketing due dates for reexamination proceedings such that petitioner was prudent in relying upon the personnel.

(2) A proper proposed response to the outstanding Office action has not been submitted. The proposed amendment submitted September 27, 2000, is defective. The amendment cannot be entered, as it is **not** in compliance with the amendment format for reexamination proceedings, as set forth in 37 CFR § 1.530(d). Specifically, in the proposed amendment to claim 1, lines 7-10, the recitation added (i.e., "each said drive motor directly . . . said folding jaw cylinder,") is not completely underlined. Also, in claim 3, line 1, the comma should be underlined and the deleted text should appear in brackets as --[.a]--; and in line

2, after "unit", --via a mechanical coupling-- should be inserted, or such text should appear in brackets if it is patent owner's intent to delete such text. In claim 12, line 2, "said each of" should be --a said each-of-- (as it appears in the patent), or such text should appear in brackets if it is patent owner's intent to delete such text. In claim 18, a period should be inserted at the end of the claim. Accordingly, if a renewed petition is filed, a proper amendment in compliance with 37 CFR § 1.530(d) should be provided.

(3) Further, it should be noted that the Certificate of Proof of Service includes a date of service of January 28, 2000. It is unclear how the response of September 27, 2000 could possibly have been served on the third party requester on January 28, 2000. Therefore, a Certificate of Proof of Service that includes a correct date of service should be provided with any renewed petition and proposed amendment.

For the reasons set forth above, the petition is **dismissed**.

ALTERNATIVE OPTION

Petition based on unintentional delay:

Petitioner may wish to consider the filing of a petition under 37 CFR § 1.137(b) if the delay in filing the proposed amendment of September 27, 2000, was unintentional. The unintentional delay fee provisions of 35 U.S.C. § 41(a)(7) have been imported into, and are applicable to, all *ex parte* reexamination proceedings by Sec. 4605 of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR § 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the entire delay from the due date for the response to the filing of a grantable petition was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR § 1.17(m).

09005195.092700

CONCLUSION

1. The petition is **dismissed**.

2. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision.

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

4. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

DECISION

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

December 20, 2000

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#19
(mas)

Paper No. 19

Theobald Dengler
MCGLEW & TUTTLE P.C.
Scarborough Station
Scarborough, NY 10510-0827

(For Patent Owner)

Douglas R. Hanscom
JONES, TULLAR & COOPER
P.O. Box 2266
Eads Station
Arlington, VA 22202

(For Requester)

MAILED
FEB 20 2001
REEXAM UNIT

In re Zweifel et al.
Reexamination Proceeding
Control No. 90/005,195
Filed: December 16, 1998
For: U.S. Patent No. 5,775,222

DECISION GRANTING PETITION

This is a decision on the January 9, 2001, patent owner PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

DECISION

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. This statement is contained in the instant petition. The instant petition is accompanied by a response, including an amendment, to the outstanding Office action, and the petition fee under 37 C.F.R. § 1.17(m). In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is granted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 2800 for consideration of the amendment.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, E. Eickholt, in Technology Center 2800.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

February 16, 2001

OIPE JC148
JAN 9 2000
PATENT & TRADEMARK OFFICE
MAIL DATE CANCELLED

ATTORNEY DOCKET NO: 60926

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: ZWEIFEL et al.
Serial No	: 90/005,195
Filed	: December 16, 1998
For	: INDIVIDUALLY DRIVEN...
Art Unit	: 2854
Examiner	: Hien Phan
Dated	: January 9, 2001

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

CERTIFICATE OF PROOF OF SERVICE

It is certified that a copy of the Petition To Revive has been served in its entirety on the Reexamination Requestor in accordance with 37 CFR § 1.530 and 37 CFR 1.248. The name and address of the party served and the date of service are Douglas R. Hanscom, Jones Tullar and Cooper, P.O. Box 2266, Eads Station, Arlington, VA 22202 on January 9, 2001.

Respectfully submitted
for Applicant,

By: _____
Theobald Dengler
Registration No. 34,575
McGLEW AND TUTTLE, P.C.

TD:tj
60926.22

Enclosed: as stated above

DATED: JANUARY 9, 2001
SCARBOROUGH STATION
SCARBOROUGH, NEW YORK 10510-0827
(914) 941-5600

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 13-0410.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS EXPRESS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER OF PATENTS AND TRADEMARKS, WASHINGTON, D.C. 20231, NO. EL450910521US

McGLEW AND TUTTLE, P.C., SCARBOROUGH STATION,
SCARBOROUGH, NEW YORK 10510-0827

BY: Sherri Krinsky DATE: January 9, 2001

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/004,950	04/03/98	5283216	371672800200

023533 HM11/0504
STEPHEN B MAEBIUS
3000 K STREET, NW., SUITE 500
WASHINGTON DC 20007-5109

EXAMINER
FORD, J

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 05/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)
*U.S. GPO: 1997-422-198/60031
1- File Copy

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D C. 20231

HAROLD C WEGNER
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WASHINGTON HARBOUR SUITE 500
3000 K STREET NW
WASHINGTON , DC 20007-5109

MAILED
04 MAY 2000
TC 1600-CQM

In re Reexamination Proceeding:
Michihiko Ochiai, et al
Serial No.: 90/004,950
Filed: April 3, 1998, and
Serial No.: 90/005,200
Filed: December 22, 1998
Attorney Docket No: 087147/0265

PETITION DECISION

This is in response to applicant's petitions under 37 CFR 1.181, filed April 14, 2000, to review and clarify the examiner's actions in the last Office action and to modify the Office action as necessary and restart the period for response. Both are addressed in this decision.

Patent owner sets forth the following reasons for modification of the Office action: (1) claims 14-16 are identical to original claims 3-5 and should not be subject to a rejection under 35 U.S.C. 112; (2) claims 1-2 are original unamended claims and may not be rejected under 35 U.S.C. 112; (3) failure to address all of patent owner's arguments with respect to the issue of obvious double patenting.

DISCUSSION

A review of now pending claims 14-16 shows that they are identical to original claims 3-5. As such they cannot be subject to any rejection under 35 U.S.C. 112. Some confusion has arisen as to whether these claims should be treated as originally filed claims. According to Office policy, and as reflected in the M.P.E.P., original claims are subject to rejection on prior art only. In order to minimize confusion as to whether these are original claims or not, patent owner is requested to present claims 3-5 in the next response to an Office action as claims 3-5 (no underlining is required) and request that previously canceled claims 3-5 be reinstated in the proceeding. (Claims 14-16 should be canceled when this is done.) Any rejections of claims 14-16 should be considered as rejections of reinstated claims 3-5. In view of this, any rejections of claims 14-16 (which will be converted to reinstated claims 3-5) under 35 U.S.C. 112 are withdrawn as improper. Other rejections of these claims over prior art or for obvious double patenting are considered to be directed to reinstated claims 3-5 and should be addressed as such.

With respect to the rejection under 35 U.S.C. 112 of claims 1-2, which have not been amended, such rejection is improper, is withdrawn, and need not be replied to in patent owner's response to the outstanding Office action. The examiner raised a question of enablement under 35 U.S.C. 112 of these two claims. Such is improper. The patented claims under reexamination are to be given their broadest reasonable interpretation consistent with the specification, however, patent claims

must be given only an interpretation which is enabled by the specification (M.P.E.P. 2258). Thus any question of enablement of a claim is limited by that which is taught in the specification and any interpretation of a claim which falls outside the enablement of the specification is not within the scope of the claim and need not be considered by the examiner.

With respect to the failure to address all of patent owner's arguments, a review of patent owner's last response and the examiner's action fails to find this completely accurate. While patent owner has set forth several arguments in logical manner it is thought from the review of the examiner's action that these arguments have been addressed although not in the same order or with the same logicality as set forth by patent owner. The question of patentability of the method claims of the patent appears to revolve around the question of whether the method was disclosed (patent owner states it was) and claimed (patent owner concedes it wasn't) in the parent application which issued as a patent and the consequences of failing to claim the method in the parent application with respect to availability of other intervening prior art (intervening between disclosure and actual claiming of the method) and the question of obvious double patenting over the parent application. Both patent owner and the examiner have addressed these issues from different perspectives which at times may appear to avoid answering or responding to the other's arguments. These issues have also been clouded by the introduction of the issues raised under 35 U.S.C. 112, noted above. With the removal of such issues concentration on the crux of the matter may be had and the respective positions more clearly developed. In view of this no new Office action will be forthcoming until patent owner files a response to the outstanding Office action limited to the issues of prior art noted.

For the above reasons patent owner's petition is **GRANTED IN PART**. All rejections in the last Office action under or related to 35 U.S.C. 112 are withdrawn. Patent owners reply will be limited to addressing only questions related to rejections over prior art under 35 U.S.C. 102 or 103 and for obvious double patenting.

Patent owners time for response originally set at two months has been extended by an additional two months. Patent owner's concern with regard to the lack of progress in bringing this reexamination proceeding to a conclusion is noted. It is admitted that some of the delay has occurred within the Office, initially due to numerous requests for access by the public which prevented the examiner from working consistently on the file. This has since been overcome. It is expected that the next action following patent owner's next reply will be a final Office action which will bring this proceeding to an acceptable conclusion or lead to an appeal.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Group 1600/2900, Washington, DC 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 308-7922.

John Kittle
Director, Group 1600/2900

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,200	12/22/1998		371672800300	5793

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EXAMINER	
ART UNIT	PAPER NUMBER
	47

DATE MAILED: 07/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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FOR PATENT OWNER

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MORRISON & FOERSTER
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PALO ALTO, CA 94304-1018

FOR REQUESTER

In re Reexamination Proceeding: :
Michihiko Ochiai, et al :
Serial No.: 90/004,950 and 90/005200 : PETITION DECISION
Filed: April 3, 1998 and December 22, 1998 :
Attorney Docket No: 087147/0265 :

DECISION MAILED

This is in response to Patent Owner's petition under 37 CFR 1.181, filed April 8, 2002, requesting withdrawal of an Examiner's Answer and other unspecified relief.

BACKGROUND

A review of the proceedings' history would be extensive and tedious to provide in full. However, it can be summarized as a series of rejections to which a reply was timely made often accompanied by a petition on one or another matter, followed by a decision on petition and succeeding Office action. The recent history shows that a non-Final Office action was issued by a previous examiner on February 14, 2001. (It is noted that this was the seventh Office action in the 4950 proceeding and fifth Office action in the merged proceeding by the previous examiner following grant of the Order for Reexamination, none of which had been made Final. Following the sixth Office action Patent Owner filed a Notice of Appeal.) Thereafter a new examiner was assigned the Proceeding in April, 2001. Patent Owner's representatives held an extensive

interview with the new examiner in an attempt to clarify and resolve many of the issues in the Proceeding. Following the interview patent owner filed a letter reporting the interview and then filed an Appeal Brief, a Notice of Appeal having been filed in December, 2000. The Appeal Brief presented 9 specific issues from the last Office action for resolution:

(I) Rejection not based specifically on prior art;
(II) Rejection under 35 U.S.C. 102(b) based on Heymes et al or Durckheimer et al;
(III) Rejection under 35 U.S.C. 103(a) based on Takano et al;
(IV) Rejection under 35 U.S.C. 103(a) based on Yoshioka et al;
(V) Rejection under 35 U.S.C. 103(a) based on Chauvette, Gottstein, Fieser and Dolfini alone or in combination with each other;
(VI) Rejection for Obvious Double Patenting;
(VII) Other matters;
(VIII) Rejection under 35 U.S.C. 103(a) over Katner;
and (IX) Rejection under 35 U.S.C. 102(a) over Montavon.

The newly assigned examiner prepared an Examiner's Answer, mailed February 8, 2002, in which the issues before the Board were narrowed to issues II, VI and VIII. The examiner replied to each of Patent Owner's arguments for each issue with the Obvious Double Patenting issue being bifurcated into two separate arguments.

Patent Owner filed a Reply Brief and this petition on April 8, 2002. The delay in acting on this petition is regretted, but was, in part, occasioned by receipt of only one copy of the petition, rather than two copies, as required, for the merged reexamination proceeding. The only procedural basis presented for withdrawal of the Examiner's Answer is the possible inclusion of an impermissible new ground of rejection.

DISCUSSION

Patent Owner expresses concerns that procedurally this Proceeding may be forwarded to the Board of Patent Appeals and Interferences (Board) and then be remanded by them for reopening of prosecution or further actions by the examiner and that such would take an inordinate amount of time. However, it has been the experience of the Office that reexamination proceedings forwarded to the Board are considered expeditiously and are docketed for consideration in advance of other appeals. It is also unlikely that the Board would remand a proceeding except for examiner determination of an issue not properly addressed. It is not likely that such would occur in this Proceeding as the previous and current examiners have seemingly addressed all possible issues within the scope of reexamination.

Patent Owner states that the Examiner's Answer contains a new ground of rejection, specifically a second Obvious Double Patenting rejection. A review of the Office actions of February 14, 2001, and of October 26, 2000, has been made to determine what rejections for double patenting were made therein. It appears that both aspects of the Obvious Double Patenting rejection were present therein, specifically of the claims over previously issued parent applications alone as well

as in view of the issued parent applications in view of secondary references. However, they were not clearly delineated or set forth as two separate Obvious Double Patenting rejections. The Examiner's Answer clearly sets forth both aspects of the double patenting rejection and clearly delineates each from the another. Thus no new ground of rejection has been set forth, but existing grounds of rejection have been clarified and properly separated into their component parts.

Patent Owner then sets forth reasons for the delay in filing method claims in view of issued parent patents to compound claims and which is part of the basis supporting the Obvious Double Patenting rejections. This is not a procedural issue within the conduct of this reexamination, but are concerned with the merits of the rejections of record. These arguments are better presented to the Board for determination of the propriety of the rejections. Patent Owner further comments on the length of time which was needed to obtain broad claims. Again such argument does not address procedural insufficiencies in the Proceeding. Patent Owner then states that Schneller is inapposite to this case. However, since this is an issue directed to patentability of the claims, the issue will not be addressed in this decision.

Patent Owner then comments on the *Ex parte Bogese* decision cited by the examiner in support of the Obvious Double Patenting rejection suggesting that it is based on false premises of earlier cases and then proceeds through an analysis of *Woodbridge v United States* which appears to have no bearing on this petition decision.

In summary, Patent Owner's only apparent valid procedural question is with respect to the possible existence of a new ground of rejection in the Examiner's Answer. As noted above it is believed that such does not exist based on the prosecution history and the new examiner's attempt to clarify the record and issues to the extent possible.

DECISION

Applicants' petition is **DENIED.** The Examiner's Answer is maintained as proper and not containing a new ground of rejection.

The Proceeding will be forwarded to the examiner for consideration of the Reply Brief.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230..

Any request for reconsideration of this decision must be made within TWO MONTHS of the mailing date of this decision and should be addressed to the Office of Petitions.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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#59

APR 13 2004

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In re Reexamination Proceeding:	:	
Michihiko Ochiai *et al.*	:	
Control Nos. 90/004,950 and 90/005,200	:	ON PETITION
Filed: April 3, 1998 and December 22, 1998	:	
For: U.S. Patent No. 5,583,216	:	
Issued: December 10, 1996	:	

This is a decision on the patent owner petition filed on September 9, 2002, and the supplemental patent owner petitions filed on October 18, 2002, and December 1, 2003, under 37 CFR 1.181(a)(3) requesting supervisory review of the Technology Center Director's decision of July 15, 2002 to deny petitioner's request that the examiner's answer of February 8, 2002 be stricken from the record. These petitions have been forwarded by the Deputy Commissioner for Patent Examination Policy to the Technology Center Director for treatment as a request for reconsideration of the Technology Center Director's decision of July 15, 2002.

The petition under 37 CFR 1.181 is **granted** to the extent that:

The examiner's answer of February 8, 2002 is **vacated**; and

The reexamination proceeding is being forwarded to the examiner for appropriate action.

Upon further review, a comparison of the examiner's answer of February 8, 2002 with the prior Office actions in the file of this reexamination proceeding reveals that the rationale provided in support of the rejections has been sufficiently expanded that one could reasonably come to the conclusion that the "basic thrust" of the rejections in the examiner's answer of February 8, 2002 differ from those in the prior Office actions. Therefore, it is appropriate that such rejections be considered new rejections and set forth in an Office action reopening prosecution in this

reexamination proceeding. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976).

It is noted that petitioner has repeatedly complained of the length of time that has been taken to reach a conclusion in this reexamination proceeding. The Technology Center had forwarded the file of this reexamination proceeding to the Board of Patent Appeals and Interferences for a decision on the appeal, and it is at petitioner's insistence that prosecution is now being reopened. Nevertheless, petitioner is free to file a paper requesting that any non-final Office action subsequently issued in this reexamination proceeding be designated as a final Office action so as to permit an appeal from the rejections in such Office action. See Changes to Implement the 2002 *Inter Partes* Reexamination and Other Technical Amendments to the Patent Statute, 68 Fed. Reg. 70996, 71002 (Dec. 22, 2003), 1278 Off. Gaz. Pat. Office 218, 222 (response to comment 2).

Any inquiry concerning this decision may be directed to William R. Dixon, Jr., by telephone at 571-272-0519.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 29 2004

#61

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In re Reexamination Proceeding:	:	
Michihiko Ochiai *et al.*	:	
Control Nos. 90/004,950 and 90/005,200	:	ON PETITION
Filed: April 3, 1998 and December 22, 1998	:	
For: U.S. Patent No. 5,583,216	:	
Issued: December 10, 1996	:	

In response to the request for clarification filed April 19, 2004, this is a supplemental decision on the patent owner petition filed on September 9, 2002, and the supplemental patent owner petitions filed on October 18, 2002, and December 1, 2003, under 37 CFR 1.181(a)(3) requesting supervisory review of the Technology Center Director's decision of July 15, 2002 to deny petitioner's request that the examiner's answer of February 8, 2002 be stricken from the record. These petitions have been forwarded by the Deputy Commissioner for Patent Examination Policy to the Technology Center Director for treatment as a request for reconsideration of the Technology Center Director's decision of July 15, 2002.

The petition under 37 CFR 1.181 is **granted** to the extent that:

The examiner's answer of February 8, 2002 is **vacated**; and

The reexamination proceeding is being forwarded to the examiner for appropriate action.

Upon further review, a comparison of the examiner's answer of February 8, 2002 with the prior Office actions in the file of this reexamination proceeding reveals that the rationale provided in support of the rejections has been sufficiently expanded that one could reasonably come to the conclusion that the "basic thrust" of the rejections in the examiner's answer of February 8, 2002 differ from those in the prior Office actions. Therefore, it is appropriate that such rejections be

considered new rejections and set forth in an Office action reopening prosecution in this reexamination proceeding. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976).

It is noted that petitioner has repeatedly complained of the length of time that has been taken to reach a conclusion in this reexamination proceeding. The Technology Center had forwarded the file of this reexamination proceeding to the Board of Patent Appeals and Interferences for a decision on the appeal, and it is at petitioner's insistence that prosecution is now being reopened. Nevertheless, in the event that a non-final Office action is subsequently issued in this reexamination proceeding, petitioner may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in 37 CFR 1.17(b) within the time period for reply provided under 37 CFR 1.550(c). See 37 CFR 1.191(a)(1).

Any inquiry concerning this decision may be directed to William R. Dixon, Jr., by telephone at 571-272-0519.

Bruce M. Kisliuk
Director, Technology Center 1600

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MICHIHIKO OSHIAI, TAIITI OKADA, OSAMI AKI, AKIRA MORIMOTO, KENJI KAWAKITA and YOSHIHIRO MATSUSHITA

MAILED

MAY 25 2006

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-1443
Reexamination Control No. 90/005,200
Patent No. 5,583,216

DECISION ON PETITION

This is a decision on the petition filed March 10, 2006 under 37 CFR § 41.3 seeking entry and consideration of appellants' reply brief filed January 13, 2006.

FINDINGS

1. On January 13, 2006, appellants filed a reply brief.

2. On January 20, 2006, jurisdiction over this appeal passed to the Board of Patent Appeals and Interferences ("Board").

3. On February 27, 2006, the primary examiner in Technology Center 1600 issued a communication stating that the reply brief "has not been considered because it is not in compliance with 37 CFR 41.41(a)."

4. On March 10, 2006, appellants filed the present petition, addressed to the Chief Administrative Patent Judge of the Board ("Chief Judge"), seeking "entry and consideration of the Reply Brief filed on January 13, 2006."

5. In the petition, appellants also request "that an Oral Hearing be scheduled as soon as possible to expedite conclusion of the proceedings in this case."

6. In the petition, appellants also request that the petition shall not stay the appeal.

7. On March 10, 2006, appellants also filed a Declaration of Leon Radomsky "in support of a petition to be concurrently filed herewith for consideration of a Reply Brief."

DISCUSSION

As indicated, the action about which appellants complain and from which appellants seek relief was an action by the primary examiner in Technology Center 1600. Petitions concerning actions of primary examiners in the technology centers are properly addressed to the appropriate technology center director. Manual of Patent Examining Procedure (MPEP) § 1002.02(c)3 (8th ed., Aug. 2001, rev., Oct. 2005). ("action or requirement [] by the examiner which is not subject to appeal").

Petitions properly addressed to the Chief Judge include those seeking relief from "actions *of* the Board [] or *of personnel at* the Board." *Id.* at § 1002.02(f)4.b. (italics added). However, petitions concerning non-appealable actions of primary examiners are not properly addressed to the Chief Judge.

Accordingly, should appellants wish to have the petition considered on the merits, the appellants should request the Board to remand the appeal to Technology Center 1600 where the petition properly would be before the Director of Technology Center 1600.

Alternatively, since the Board presently has jurisdiction of the appeal, should appellants wish to proceed to oral hearing without further delay, the appellants should notify the Board to proceed with the appeal without consideration of the reply brief and request that the Board dismiss the petition.

Accordingly, appellants are given 14 days from the date of this decision to file the following:

1. A Request for Remand of the appeal to Technology Center 1600 for consideration of the petition; or
2. A Notification to proceed with the appeal without consideration of the reply brief and a Request to Dismiss the petition.

If there is no response within 14 days, the Board will treat the lack of response as a notification to proceed with the appeal without the consideration of the reply brief and dismiss the petition.

Michael R. Fleming
Chief Administrative Patent Judge
Board of Patent Appeals and Interferences

Harold C. Wegner
FOLEY & LARDNER LLP
3000 K Street, N.W.
Washington, DC 20001

APR 25 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

MAILED
APR 25 2002
OFFICE OF THE DIRECTOR
TC 3600

Reexamination Control No. 90/004,947 -- Paper No. 37
Reexamination Control No. 90/005,211 -- Paper No. 37
Reexamination Control No. 90/006,095 -- Paper No. 8-37

FOR PATENT OWNER:

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Emch Schaffer Schaub and Porcello
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Earl J. Fontaine
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DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/004,947, 90/005,211 and 90/006,095

FOR REQUESTER:

Kenyon & Kenyon
One Broadway
New York, NY 10004

Document Page

NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 4,550,540 issued on November 5, 1985.

2. A first request for reexamination of U.S. Letters Patent No. 4,550,540 was filed by a third party, Kenyon & Kenyon, on March 24, 1998, and was assigned Reexamination Control No. 90/004,947.

3. On November 30, 1998, a second request for reexamination of U.S. Letters Patent No. 4,550,540 was filed by a third party requester, Kenyon & Kenyon, and was assigned Reexamination Control No. 90/005,211.

4. On August 24, 2001, a third request for reexamination of U.S. Letters Patent No. 4,550,540 was filed by a third party, Kenyon & Kenyon, and was assigned Reexamination Control No. 90/006,095.

5. Reexamination was ordered in Reexamination Control No. 90/004,947 on May 14, 1998; in Reexamination Control No. 90/005,211 on February 10, 1999; and in Reexamination Control No. 90/006,095 on November 20, 2001.

6. Reexamination Control Nos. 90/004,947 and 90/005,211 were merged on June 2, 1999.

7. No Patent Owner's Statement has been filed in Reexamination Control No. 90/006,095.

Discussion

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the Reexamination proceedings will be consolidated and result in the issuance of a single Certificate under § 1.570.

As noted in the "Background", reexamination has been ordered in all reexamination proceedings. Accordingly, merging of the three reexamination proceedings is mandated by 37 CFR 1.565(c).

Decision

Under the provisions of 37 CFR 1.565(c), reexamination proceedings designated as Reexamination Control Nos. 90/004,947, 90/005,211 and 90/006,095 are merged for consolidated proceedings. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in All Files

Patent owner must maintain the same claims and the same description/specification in both files. Since the patent owner has not filed a patent owner's statement, and the submission of the required "housekeeping" amendment prior to a first Office action does not invoke the provisions of 37 CFR 1.535, prosecution will proceed *ex parte*. No reply or other submission will be considered in the merged reexamination proceeding filed by the third party requester.

It is noted that a request to change correspondence address has been filed by the representative of the patent owner in Reexamination Control No. 90/ 006,095 on October 9, 2001. In order to maintain consistent addresses for the patent owner, it is required that a request to change correspondence address be filed in Reexamination Control Nos. 90/004,947 and 90/005,211.

II. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single action, which applies to both reexamination proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each separate reexamination file. Any papers filed by the patent owner must consist of a single response addressed to all reexamination files, filed in triplicate, each bearing an original signature, for entry in all files. Each file will be maintained as separate complete files. All papers filed by the patent owner must be served upon the above-identified third party requester and such requester will be sent copies of all papers mailed by the Office during these merged proceedings.

Conclusion

Reexamination Control Nos. 90/004,947, 90/005,211 and 90/006,095 are hereby merged and an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866

Concur: Anthony Knight
Anthony Knight
Acting Director
Technology Center 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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January 8, 2001

Paper No. 15

Scott D. Wofsy
Cummings & Lockwood
Four Stamford Plaza
P.O. Box 120
Stamford, CT 06904-0120

(For Patent Owner)

Thomas C. Saitta, P.A.
6821 Southpoint Drive North
Suite 203
Jacksonville, FL 32216

(For Third Party Requester)

Enclosure: Paper filed May 25, 2000

In re Bernhardt et al.
Reexamination Proceeding
Control No. 90/005,212
Filed: December 18, 1998
For: U.S. Patent No. 5,591,166

: DECISION DISMISSING
: PETITION AND RETURNING
: IMPROPER PAPERS

This is a decision on the May 25, 2000, petition filed under 37 CFR 1.183 by the third party requester requesting the Commissioner to waive the rules and instruct the examiner to consider papers submitted by requester directed to the merits of the reexamination proceeding. The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed.

37 CFR 1.550(g) provides (in part):

> "The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered."

37 CFR 1.550(g) additionally provides:

> "[N]o submissions on behalf of any third parties will be acknowledged or considered unless such submissions are (1) in accordance with § 1.510 or § 1.535; or (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525."

The petition under 37 CFR 1.183 was filed May 25, 2000, after the period for active participation of the reexamination third party requester had ended. In addition, the petition is not in compliance with the requirements of 37 CFR 1.510. Nor does the petition qualify as a prior art statement under 37 CFR 1.501.

In the May 25, 2000, petition the third party requester questions the adequacy of the examination, discusses the prior art cited in the proceeding, and raises patentability concerns with regard to additional prior art not of record. As such, the substance of the petition is directed to the merits of the reexamination proceeding. Neither the rules nor any provisions of the statute provide authority for a third party in a reexamination proceeding to file papers directed to the issues and merits of the reexamination proceeding. *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). The statute and its intent are clear that the reexamination proceeding must be *ex parte*. The assertions raised in the petition are clearly directed to the merits of the reexamination proceeding, and addressing them would be contrary to the intent of the statute. Comments by third parties at this stage are precluded since reexamination is an *ex parte* proceeding. A waiver of the rules in the present case to permit a third party submission would not be justified in view of the intent of the legislation and rules to make reexamination an *ex parte* proceeding. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (third parties do not participate before the PTO). Accordingly, the third party requester petition of May 25, 2000, is an improper submission under 37 CFR §1.550(g) and is being returned to the third party requester. This decision will be made of record in the reexamination file.

Telephone inquiries related to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at (703) 305-8610.

Gerald A. Dost

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

C:\JERRY\90_5212 IP 3PR paper 183.wpd

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Director's Office
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#8/dpm
1/13/00
Supplement
to Petition

FJCPH&S Ref. 225/Y-466A Today's Date July 2, 1991

Serial/Patent No. 4,423,543 Serial Number: 06/391,224

Applicant Gerritt W.E. LEUVELINK

Filing Date June 23, 1982 Issue Date: January 3, 1984

The following has been received in the U.S. Patent & Trademark Office on the date stamped hereon:

- ☐ _____ pp. Specification & _____ Claims
- ☐ Combined Declaration, Power of Attorney
- ☐ Preliminary Amendment
- ☐ Rule 60 Application
- ☐ Rule 62 Application
- ☐ Claim to Priority and Certified Copy
- ☐ Substitute ☐ Subsequent Declaration
- ☒ Maintenance Fee
- ☐ Drawings ___ Sheets ___ Formal ___ Informal
- ☒ ~~Assignment~~/Change of Name
- ☐ Small Entity Declaration
- ☒ Check for $ 495.00
- ☐ Response to Office Action
- ☐ Disclosure Statement
- ☐ Copies of References
- ☐ Verification of Translation
- ☐ Rule 132 Declaration
- ☐ Petition for XOT
- ☐ Notice of Appeal
- ☐ Brief
- ☐ Issue Fee Transmittal
- ☒ Other Fee Address Form

PATENT & TRADEMARK OFFICE JUL 2 1991

FJCPH&S 4/89 DUE DATE 7/3/91

FLEIT, JACOBSON, COHN, PRICE,
HOLMAN & STERN
400 SEVENTH STREET, N.W.
WASHINGTON, D.C. 20004

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JAN 06 2000
Director's Office
Group 3700

JACOBSON, PRICE, HOLMAN & STERN, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004-2201

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***** IMPORTANT - FACSIMILE COVER SHEET *****

From: D. Douglas Price To: Steve Marcus

Date: January 6, 2000 Tech Center 3700

Facsimile Telephone Number: 703-305-3762

Total pages (including this cover sheet): 2

If you do not receive all pages, please contact us at:
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JAN 13 2000

Paper No. 9

FLEIT, JACOBSEN, COHN, PRICE
HOMAN AND STERN
400 SEVENTH STREET, N.W.
WASHINGTON, DC 20004

: For Patent Owner

VOLPE AND KOENIG
400 ONE PENN CENTER
1617 JOHN F. KENNEDY BLVD.
PHILADELPHIA, PA 19103

: For Requester

In re Reexamination
Control No. 90/005,218
U.S. Patent No. 4,423,543
Issued: January 3, 1984
Patent Owner: T. T. Haaksbergen, B.V.
Request Filed: January 13, 1999
Requester: Volpe and Koenig, P.C.

: DECISION ON PETITION
: FOR EXTENSION OF TIME

This is a decision on the petition filed on December 16, 1999 by Patent Owner ("Owner"), as supplemented by a facsimile transmission dated January 6, 2000, in which Owner requests the remailing of the Office Action originally dated June 29, 1999 and remailed August 13, 1999. Owner additional requests the resetting of the shortened statutory period for response to the remailed Office Action to run from the date of the new remailing.

The petition is GRANTED.

It appears from the petition that correspondence in this proceeding has not been directed to the current address of counsel for Owner. It further appears that counsel filed papers on July 2, 1991 directed to patent No. 4,423,543, and that included in those papers was a change of correspondence address reflecting a change of firm name and address. It further appears that while some of the papers filed on July 2, 1991 were properly entered in the patented file, the change of correspondence address was not.

Owner has appended to the petition a copy of the papers filed on July 2, 1991, including a copy of the paper requesting the change of correspondence address. By facsimile transmission on January 6, 2000, Owner has furnished a copy of the postcard receipt for all of the papers, confirming that they were in fact received in the Office on July 2, 1991. It is noted that a copy of the January 6, 2000 facsimile transmission was not served on Requester; at the time that its submission was requested by the undersigned during a telephone discussion with Mr. D. Douglas Price, the undersigned told Mr. Price that the Office would undertake to serve a copy of that submission on Requester. Accordingly, a copy of the January 6, 2000 submission is attached to Requester's copy of this Decision.

As it is clear that Office from the attachments to the petition that correspondence in this

proceeding has not been directed to Owner's correspondence address of record, it is appropriate to remail the Office letter in question. A copy of that letter is attached to Owner's copy of this Decision (presumably Requester received at least one of the originally mailed or remailed copies of the action). A shortened statutory period of **TWO MONTHS** in which to file a reply to the Office letter in question will begin to run from the mailing date of this Decision. The shortened statutory period may be extended only pursuant to the provisions of 37 CFR § 1.550(c).

PETITION GRANTED

Stephen Marcus, Special Program Examiner
Patent Examining Groups 3710 and 3720

Attachments:

Owner: Complete Copy of Office letter mailed June 29, 1999 and remailed August 13, 1999

Requester: Copy of Facsimile Transmission by Owner received on January 6, 2000

#21
(mas)

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Stephen B. Salai
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(For Patent Owner)

Patrick J. Finnan
Epstein, Edell & Retzer
1901 Research Blvd, Suite 400
Rockville, MD 02850-3164

(For Third Party Requester)

MAILED
OCT 23 2001
REEXAM UNIT

In re Clark
Reexamination Proceeding
Control No. 90/005,220
Filed: January 14, 1999
For: U.S. Patent No. 5,530,582

DECISION GRANTING PETITION

This is a decision on the September 14, 2001, patent owner PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the "unintentional" delay standard. The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is granted.

A. *Background*

1. On March 18, 1999, the USPTO granted a request filed by a third party for reexamination of U.S. Patent No. 5,530,582.

2. On November 30, 2000, a non-final Office action was mailed which rejected all of the patent claims remaining under examination (i.e., all of the claims not previously cancelled during the prior prosecution of the reexamination proceeding). The examiner set a shortened statutory period of three months for patent owner's response to the Office action, making a response due by February 28, 2001. The Office action was mailed to "2 State St., Rochester, NY," the correspondence address of record.

3. On December 22, 2000, the Office action was returned to the USPTO by the U.S. Post Office with a stamp on the face of the envelope which stated: "forward time expired, return to sender."

4. The returned Office action is presently in the reexamination file. An undated note addressed to the Technology Center (TC) special program examiner from the TC paralegal is stapled to the face of the returned Office action. The note states that the patent owner's attorney: (1) requests a fax copy of the Office action, (2) inquires as to whether the response period could start over, and (3) said he would fax a change of address to the Office. (There is no further information as to the nature of this communication, and there is no indication in the file as to whether or not a copy of the Office action was faxed to the attorney and/or a new response period was set.)

5. On March 12, 2001, the patent owner's attorney filed, by facsimile transmission, a Change of Address changing the correspondence address in the reexamination to "700 Midtown Tower, Rochester, N.Y." The reexamination file contains no other papers filed by the patent owner prior to March 12, 2001.

6. On May 11, 2001, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed to the new address of record "700 Midtown Tower, Rochester, N.Y." The NIRC indicated that pursuant to patent owner's failure to respond to the Office action of November 30, 2000, that the reexamination proceeding was terminated, and a reexamination certificate would issue cancelling all of the patent claims.

7. On July 31, 2001, reexamination certificate No. C1 5,530,582 was issued in which all of the patent claims were cancelled.

8. On September 14, 2001, patent owner's attorney filed: (1) a response to the Office action of November 30, 2000, and (2) a petition to revive the reexamination proceeding on the basis of "unintentional delay" under the provisions of 37 CFR 1.137(b). The transmittal cover sheet shows the current address of patent owner's attorney to be "1600 Bausch & Lomb Place, Rochester, N.Y."

9. On October 3, 2001, during a telephone call with Mr. Gerald A. Dost of the Office of Patent Legal Administration, the secretary of Mr. Stephen B. Salai, patent owner's attorney, confirmed that the current address of the firm is "1600 Bausch & Lomb Place, Rochester, N.Y." Mr. Salai's secretary stated that the firm moved to this address in June of 2001. She further stated that she would submit, by facsimile transmission, a new change of correspondence address in the reexamination proceeding.

10. On October 10, 2001, the patent owner's attorney filed, by facsimile transmission, a Change of Address changing the correspondence address in the reexamination to "1600 Bausch & Lomb Place, Rochester, N.Y." The letter states that this address became effective on June 22, 2001.

B. *A terminated reexamination proceeding may be revived for "unintentional" delay under 35 U.S.C. § 41(a)(7).*

The "unintentional" delay standard, became available to a patent owner in a reexamination proceeding under section § 4605(a) of "The American Inventors Protection Act of 1999," (AIPA) which was enacted into law on November 29, 1999, by Section 1000(a)(9), Division B, of Public Law 106-113, 113 Stat. 1501 (1999) codified at 35 U.S.C. § 41(a)(7). Under AIPA § 4608(b) this relief became effective on November 29, 2000.

Under the reasoning set forth in *In re Katrapat, AG*, 6 USPQ2d 1863 (Comm'r Pat. 1988) relating to revival of a terminated reexamination under the "unavoidable" delay standard of § 133, the Commissioner may under 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) revive a reexamination proceeding which has been terminated due to a late response to an Office action, provided the delay was "unintentional" in the sense of § 41(a)(7). The *Katrapat* decision distinguishes between revival of a terminated reexamination under the "unavoidable" delay standard of § 133 and the "unintentional" delay standard of § 41(a)(7), holding that the "unintentional" delay standard is not available in reexamination. The Commissioner states at 6 USPQ2d 1866:

> Had Congress intended to additionally permit revival of unintentionally terminated reexamination proceedings, it could have demonstrated such intent by U.S.C. § 41(a)(7) as well as § 133, but it did not do so.

As noted above, Congress has now demonstrated such intent by specifically making the "unintentional" delay standard of § 41(a)(7) available to a patent owner in reexamination under section § 4605(a) of the AIPA. The petition, therefore, will be addressed under the "unintentional" delay standard of § 41(a)(7) and § 1.137(b).

Page 3 of 5

C. *Unintentional delay standard in reexamination is the same standard as applied in applications.*

The standard to be applied for unintentional delay in a reexamination proceeding is the same as the standard applied in an abandoned application. Congress by expressly referring in § 41(a)(7) to abandoned applications, delayed payment of the issue fee, and delayed response in a reexamination proceeding, intended that termination of reexamination proceedings be analogous to abandonment of patent applications. Compare *In re Katrapat, AG*, supra, at 1865. That is, Congress intended that upon the failure of a patent owner to timely respond to an Office action in a reexamination proceeding, the proceeding must be terminated unless the delay in responding to the Office action can be shown to the satisfaction of the Commissioner to have been "unintentional" in the sense of § 41(a)(7).

The regulations concerning revival of terminated proceedings require a "statement" that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The USPTO relies upon the patent owner's duty of candor and good faith and usually accepts the "statement" without requiring further information in the vast majority of petitions under § 1.137(b). See "Clarification of Application Revival Procedures (37 CFR 1.137)" reprinted at 1225 O.G. 127 (February 20, 2001).

D. *Decision.*

A grantable petition for relief under the unintentional standard under 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 CFR 1.17(m); and,

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

The instant petition is accompanied by a response to the Office action of November 30, 2000; the petition fee under 37 C.F.R. § 1.17(m); and the statement required by 37 C.F.R. § 1.137(b)(3). Nothing in the record indicates that the delay in responding was not "unintentional." In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

Accordingly, the petition is granted.

In view of the foregoing, Reexamination Certificate No. C1 5,530,582, published in the O.G. on July 31, 2001, is vacated and deemed null and void. A notice to this effect will be published forthwith in the Official Gazette. Compare *In re Katrapat, AG*, supra, at 1868.

Undeliverable

E. *Summary.*

(1) The petition under 37 C.F.R. § 1.137(b) to revive the terminated reexamination is granted.

(2) The reexamination certificate is vacated and deemed null and void.

(3) The reexamination file is being returned to the examiner for consideration of the merits of patent owner's response of September 14, 2001.

(4) Telephone inquiries related to this decision should be directed to Gerald A. Dost, Senior Legal Advisor at (703)305-8610.

Robert J. Spar
Director
Office of Patent Legal Administration

C:\zJerry\90_5220 unintentional decision.wpd

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 12

STEPHEN G. ADRIAN (Patent Owner)
ARMSTRONG, WESTERMAN, HATTORI,
MCLELAND & NAUGHTON
1725 K STREET, NW
SUITE 1000
WASHINGTON, D.C. 20006

COPY MAILED
FEB 29 2000
SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

Enclosure: Opposition of February 14, 2000

STEVEN B. KELBER (Requester)
OBLON, SPIVAK, MCCLELLAND,
MAIER & NEUSTADT, P.C.
1755 JEFFERSON DAVIS HIGHWAY
FOURTH FLOOR
ARLINGTON, VA 22202

Enclosure: Petition of February 2, 2000

Reexamination of U.S. Patent No. 5,741,354 to KAWASUMI et al.
Control No. 90/005,261
Filed: February 16, 1999

DECISION DISMISSING PETITION

This is a decision on the third party requester petition filed February 2, 2000, under 37 C.F.R. §1.183, to suspend the rules, and terminate the present reexamination. This is also a decision on the paper filed on February 14, 2000, by patent owner, responding to the third party requester petition, which is being treated as a petition under either 37 C.F.R. §1.182 or 1.183.

The two petitions are before the Office of the Deputy Assistant Commissioner for Patent Policy and Projects for decision.

Both petitions are **dismissed** and are being returned to the sender for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent 5,741,354 to KAWASUMI et al. issued on April 21, 1998.

2. A request for reexamination of the '354 patent was filed on February 16, 1999 by third party requester, and was assigned Control No. 90/005,261.

3. Reexamination was ordered in the '5261 proceeding on March 31, 1999.

4. On July 26, 1999, a nonfinal Office action was mailed, and patent owner filed a response on September 20, 1999.

5. A nonfinal rejection was mailed on October 13, 1999, and patent owner filed a response with an amendment on December 13, 1999.

6. On January 12, 2000, a final rejection was mailed.

7. The third party requester filed a petition on February 2, 2000, under 37 C.F.R. §1.183, to suspend the rules, and terminate the present reexamination.

8. On February 14, 2000, patent owner filed a paper in opposition to the requester petition.

DECISION

With regard to the requester's petition, 37 C.F.R. §1.550(e) provides (in part):

> ****(1) The active participation of the reexamination requester ends with the reply pursuant to §1.535, and no further submission on behalf of the reexamination requester will be acknowledged or considered. Further, no submission on behalf of any third parties will be acknowledged or considered unless such submissions are:
> (i) In accordance with §1.510; or
> (ii) Entered in the patent file prior to the date of the order to reexamine pursuant to §1.525.
> (2) Submissions by third parties, filed after the date of the order to reexamine pursuant to §1.525, must meet the requirements of and will be treated in accordance with §1.501(a).

The third party requester petition is not a request for reexamination in compliance with the requirements of 37 CFR §1.510 and is not a reply pursuant to §1.535. Nor does this petition qualify as a prior art statement under 37 CFR §1.501. Neither the rules nor any provision of the statute provides authority for a third party to a reexamination proceeding to file a paper directed to the issues of the reexamination proceeding. *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981).

Accordingly, a waiver of the rules would be necessary to enter the instant petition. The requester petition to waive the rules constitutes a petition under 37 CFR §1.183, which requires a petition fee of $130.00. See 37 CFR §1.17(h). Since a check was not included with the requester petition, the required petition fee of $130.00 has been charged to Deposit Account No. 15-0030, as per the authorization given in the cover letter attached to the petition.

At pages 1-3 of the petition, it is urged that reexamination of the '354 patent should be terminated, as petitioner alleges he did not receive a copy of the amendment filed by patent owner on December 13, 1999. Petitioner asserts that the amendment of December 13, 1999 was either (a) incomplete, as not bearing a certificate of service, and thus not timely filed in accordance with 37 CFR 1.550(c); or (b) if it did bear a certificate of service, it was falsely filed as a response indicating service, without actual service of the document on the petitioner in accordance with 37 CFR 1.550(e).

The record reveals that the amendment does indeed include a certificate of service indicating that a copy of such paper was sent to reexamination requester, Steven B. Kelber, at the above address on December 13, 1999. The certificate of service is executed by Stephen G. Adrian, attorney for patent owner, and therefore patent owner's response is considered to be complete, as well as timely. Thus, the remaining assertion is whether a determination needs to be made with regard to any alleged false filing of a response, including a certificate of service, without actual service of the response on the requester. This allegation is clearly directed to an issue of conduct in the reexamination proceeding; note 37 CFR 10.18(b). The PTO does not review applications and proceedings for conduct issues. Third party requester may, if desired, refer this matter to the Office of Enrollment and Discipline (OED).

Accordingly, the third party requester petition of December 17, 1999, is **dismissed**, and as an improper submission under 37 CFR §1.550(e), it is being returned to the third party requester.

With regard to the patent owner paper of February 14, 2000, since it is not a response to the outstanding Office action, nor an information disclosure statement, it must be considered under either 37 CFR §1.182 or §1.183, both of which require a petition fee of $130.00. See 37 CFR §1.17(h). As the required petition fee has not been submitted, this petition is **dismissed** and it will not be made of record in the reexamination file. In any event, since the third party requester petition is dismissed as not being appropriate for relief, the patent onwer opposition to the petition is moot. The present decision will be made of record in the reexamination file.

CONCLUSION

1. The third party petition is **DISMISSED** and is being returned to the third party requester.

2. The patent owner opposition is **DISMISSED** and is being returned to the patent owner.

3. A copy of this decision will be made of record in the reexamination file.

4. Telephone inquires related to this decision should be directed to Lynn M. Kryza of the Special Program Law Office, at (703) 306-5682.

Kenneth M. Schor
Senior Legal Advisor
Special Program Law Office

February 28, 2000

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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90/005274

DISSOLVED AS OF 06/07/2005 LEA/GAD

#88

A. Jason Mirabito (For Patent Owner)
Thomas M. Sullivan
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
One Financial Center
Boston, MA 02111

MAILED
AUG 26 1999
REEXAM UNIT

Walter E. Hanley, Jr. (For Requester)
Kenyon & Kenyon
One Broadway
New York, NY 10004

In re reissue application of :
Peters, et al. :
Serial No. 08/418863 :
Filed: April 7, 1995 :
For: U.S. Patent No. 5,045,940 : DECISION, SUA SPONTE, TO MERGE
: REEXAMINATION AND
In re Peters, et al. : REISSUE PROCEEDINGS
Reexamination Proceeding :
Control No. 90/004,520 :
Filed: January 10, 1997 :
For: U.S. Patent No. 5,045,940 :
:
In re Peters, et al. :
Reexamination Proceeding :
Control No. 90/004,895 :
Filed: October 31, 1997 :
For: U.S. Patent No. 5,045,940 :

In re Peters, et al. :
Reexamination Proceeding :
Control No. 90/005,274 :
Filed: February 16, 1999 :
For: U.S. Patent No. 5,045,940 :

The above noted reexamination files and reissue application are before the Office of the Deputy Assistant Commissioner for Patent Policy and Projects, sua sponte, for a decision on whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,045,940 issued September 3, 1991.

2. On September 3, 1993, a first reissue application was filed.

3. On April 7, 1995, a file-wrapper continuation of the first application for reissue of the '940 patent was filed. Since the file-wrapper continuation reissue application is the only reissue application remaining, it will hereinafter be referred to simply as "the reissue application." The reissue application includes newly added claims 68 - 100 and 102 - 114, in addition to the claims 1 - 16, the number of claims originally in the patent.

4. On January 10, 1997, a request for reexamination of the patent was filed by a third party, Media 100, Inc.

5. On March 11, 1997, reexamination was ordered.

6. On April 26, 1997, Reissue Application No. 08/418,863 and Reexamination Proceeding Control No. 90/004,520 were merged.

7. On July 25, 1997, an Office action was mailed in which all claims were rejected.

8. On October 31, 1997, a second request for reexamination of the patent was filed by the third party, Media 100, Inc. (Reexamination Proceeding Control No. 90/004,895).

9. On January 27, 1998, reexamination was ordered in Reexamination Proceeding Control No. 90/004,895.

10. On April 13, 1998, Reissue Application No. 08/418,863 and Reexamination Proceedings Control Nos. 90/004,520 & 90/004, 895 were merged.

11. On February 16, 1999, a third request for reexamination of the patent was filed by third party, Media 100, Inc.

12. On April 27, 1999, reexamination was ordered in Reexamination Proceeding Control No. 90/005,274.

DISCUSSION

Under 37 CFR § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the three reexamination proceeding are currently pending. As the order to reexamine has been mailed in the third reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reasons for this policy is to prevent inconsistent, and possible conflicting amendments from being introduced into the two proceedings on behalf of the patent owner. Normally the proceedings will be merged whenever it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the proceedings consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue prosecution history shows that the announcement of the filing of the reissue application was published in the Official Gazette on August 15, 1995, thereby permitting the issuance of a first action on the merits after October 15, 1995. 37 CFR § 1.176. New claims have been added in the reissue application. A review of the Control No.90/005,274 reexamination file shows that the reexamination is awaiting an Office action by the examiner.. The original specification, drawings and patent claims are presently in the '274 reexamination file. The claims are not identical in all four proceedings. In order to provide efficient and prompt handling of all four proceedings and to prevent inconsistent, and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexaminations will be in accordance with the decision set forth below.

DECISION

I. Merger of Proceedings

The above noted reissue and reexamination proceedings are, sua sponte, merged. A joint

examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination files for purposes of the merged proceedings. The maintenance of identical amendments in the four files is required as long as the proceedings are merged. See 37 CFR § 1.565(d). An appropriate housekeeping amendment is required within one month of this decision placing the same amendments in all four proceedings. The patent owner should not address the issues of any of the proceedings in the housekeeping amendment.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

In view of the fact that the statutory provisions for reissue application examination include, inter alia, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader reissue application examination. The examiner will apply the reissue statute, rules and case law to the merged proceeding. The examiner's actions will take the form of a single action which jointly applies to both the reissue application and the reexamination proceedings. The action will contain identifying data for all of the reissue application and the reexamination proceedings and will be physically entered into all four files which will be maintained as separate files. Any response by the applicant/patent owner must consist of a single response, filed in quadruplicate, each bearing an original signature, for entry in the four files. Any such responses must be served on the requester who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned and the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged (reissue and reexamination) proceeding and continue the three reexamination proceedings (which will remain merged). Any grounds of rejection which are not applicable under reexamination should be withdrawn (e.g., based on public use or sale) and any new grounds of rejection which are applicable under reexamination (e.g., improper broadened claims) should be made by the examiner upon dissolution of the merged (reissue and reexamination) proceeding. The existence of any questions remaining which cannot be considered under reexamination following dissolution of the merged (reissue and reexamination) proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

If the reissue application ultimately matures into a reissue patent the reexamination proceedings shall be terminated by the grant of the reissued patent and the reissued patent will also serve as the certificate under § 1.570. See MPEP 2285.

Applicant/patent owner is advised that the filing of any continuation reissue application under 37 CFR § 1.53 will most likely result in the dissolution of the merged (reissue and reexamination) proceeding, a stay of the continuing reissue application, and separate, continued prosecution of the current merged reexamination proceedings.

IV. Remand for Examination

The above noted reissue application and reexamination proceedings are merged. The reissue application and the reexamination files are being forwarded to the Technology Center 2700 for examination in accordance with this decision.

Inquiries concerning this decision should be directed to the undersigned at (703)305-9285.

Lawrence E. Anderson
Senior Legal Advisor
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for Patent Policy and Projects

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MAILED

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REEXAM UNIT

In re Peters, et al.
Reexamination Proceeding
Control No. 90/004,520
Filed: January 10, 1997
For: U.S. Patent No. 5,045,940

In re Peters, et al.
Reexamination Proceeding
Control No. 90/004,895
Filed: October 31, 1997
For: U.S. Patent No. 5,045,940

In re Peters, et al.
Reexamination Proceeding
Control No. 90/005,274
Filed: February 16, 1999
For: U.S. Patent No. 5,045,940

In re Reissue Application of Peters, et al.
Application No. 09/971,236
Filed: October 4, 2001
For: U.S. Patent No. 5,045,940

In re Reissue Application of Peters, et al.
Application No. 08/418,863
Filed: April 7, 1995
For: U.S. Patent No. 5,045,940

DECISION, *SUA SPONTE*, DISSOLVING AND MERGING REISSUE AND REEXAMINATION PROCEEDINGS

The above reissue and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of:

(1) Whether the August 26, 1999 merger of reexamination Control Nos. 90/004,520, 90/004,895, and 90/005,274, and reissue Application No. 08/418,863, should be dissolved at this time; and

(2) Whether reexamination Control Nos. 90/004,520, 90/004,895, and 90/005,274 should, at this time, be merged under 37 CFR 1.565(d) with reissue Application No. 09/971,236.

REVIEW OF FACTS

1. U.S. patent No.5,045,940 (hereinafter, the '940 patent) issued on September 3, 1991, with 16 claims.

2. On September 3, 1993, an application for reissue of the '940 patent was filed, and was assigned application number 08/418,863 (hereinafter, the '863 application).

3. On April 7, 1995, a file-wrapper continuation of the'863 application was filed. The file-wrapper continuation application included newly added claims 68-100 and 102-114, in addition to original claims 1-16 of the '940 patent.

4. A first request for reexamination was filed by a third party requester on January 10, 1997, and the resulting proceeding was assigned control number 90/004,520 (hereinafter, the '4520 proceeding).

5. An order for reexamination of the '4520 proceeding was mailed on March 11, 1997.

6. On April 26, 1997, the '863 reissue application and the '4520 reexamination proceeding were merged.

7. On July 25, 1997, an Office action was mailed for the merged proceeding; all claims were rejected.

8. A second request for reexamination was filed by the third party requester on October 31, 1997, and the resulting proceeding was assigned control number 90/004,895 (hereinafter, the '4895 proceeding).

9. An order for reexamination of the '4895 proceeding was mailed on January 27, 1998.

10. On April 26, 1997, the '863 reissue application and the '4520 and '4895 reexamination proceedings were merged.

11. A third request for reexamination was filed by the third party requester on February 16, 1999, and the resulting proceeding was assigned control number 90/005,274 (hereinafter, the '5274 proceeding).

12. An order for reexamination of the '5274 proceeding was mailed on April 27, 1999.

13. On August 26, 1999, the '863 reissue application and the '4520, '4895, and '5274 reexamination proceedings were merged.

14. Prosecution for the merged proceeding progressed to the point where the examiner's final rejection of the proceeding claims was affirmed by the Board of Patent Appeals and Interferences.[1] The affirmance was appealed to the U.S. Court of Appeals for the Federal Circuit, and the decision of the Board was affirmed by the Federal Circuit.

15. On October 4, 2001, an application for reissue of the '940 patent was flled, and was assigned application number 09/971,236 (hereinafter, the '236 application).

16. The filing of the '236 reissue application was announced in the *Official Gazette* on June 11, 2002.

17. Three preliminary amendments were filed for the '236 reissue application, the last one on December 13, 2004.

18. On May 20, 2005, a Notice of Abandonment was mailed for the '863 reissue application. The Notice stated that the application was abandoned "In view of decision by CAFC, which all claims are affirmed."

DECISION DISSOLVING MERGER OF '863 APPLICATION AND '4520, '4895, AND '5274 PROCEEDINGS

As noted above, the '863 reissue application has been abandoned, based upon the decision by the Federal Circuit affirming the Board. Since the '863 reissue application is now abandoned, the August 26, 1999 merger of '863 reissue application and the '4520, '4895, and '5274 proceedings is hereby dissolved.

Based on the October 4, 2001 filing of the '236 reissue application for the '940 patent, and the announcement of the

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[1] The pending claims that went up on appeal were original patent claims 3 and 7-16, and new claims: 68, 70, 74-84, 86, 87, 89, 93-98, 100, 102-115, 119-148, 150, 154-160. All of the above "pending" claims were finally rejected by the examiner, and the examiner was affirmed on all rejections of these claims.

'236 reissue application in the *Official Gazette*, further action with respect to the three reexamination proceedings will be taken as discussed in the sections of this decision which follow.

DISCUSSION REGARDING MERGER OF '236 APPLICATION AND '4520, '4895, AND '5274 PROCEEDINGS

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, the '236 reissue and the '4520, '4895, and '5274 proceedings are currently pending. Since the order to reexamine has been mailed in all of the reexamination proceedings (and the '236 application has been announced in the *Official Gazette*), a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. In making a decision on whether or not to merge the proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In the present instance, the '236 reissue application was filed prior to the date on which the three reexamination prosecutions would have terminated based on the Court's affirmance of the Board's decision (affirming the rejection of all the claims in the reexamination proceedings). If the three reexamination prosecutions were now terminated by the Office and a reexamination certificate was permitted to issue, then the provisions of 37 CFR 1.570(d) would apply as follows:

> "If an *ex parte* reexamination certificate has been issued which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto."

Given that the '236 reissue application was filed prior to the date on which the three reexamination prosecutions would have terminated, it would be inequitable to now terminate the three reexamination prosecutions and issue a reexamination certificate. Such a certificate would result in the barring of the '236 reissue application, even though the '236 application was filed prior to the date on which the three reexamination prosecutions would have terminated. In order to prevent this inequity, and, at the same time prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner (for the reissue and reexamination proceedings), it is appropriate that the instant '236 reissue application and the '4520, '4895, and '5274 reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the '236 reissue application and the three reexamination proceedings will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. *The present merger is not an assurance that, in a future similar situation, merger would be ordered, since each merger question [2] is considered on a case-by-case basis governed by the given fact situation for the merger question to be considered.*

DECISION MERGING THE '236 REISSUE APPLICATION AND '4520, '4895, AND '5274 REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The'236 reissue application and the'4520, '4895, and '5274 reexamination proceedings are hereby **merged** into a single proceeding (hereinafter, "the merged proceeding"). A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings and to Provide Formal Amendments

1. The patent owner is required to maintain identical amendments in the reissue application and the

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[2] I.e. each decision of whether to merge or supend, or take other appropriate action.

reexamination proceedings for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

A review of the '236 reissue application shows that all of the original patent claims, i.e., claims 1-16, are cancelled, and new claims 17-88 are present. A review of the files for the three reexamination proceedings shows the following claim status:

Pending patent claims: 3 and 7-16.
Canceled patent claims: 1, 2, and 4-6.
Pending new claims: 68, 70, 74-84, 86, 87, 89, 93-98, 100, 102-115, 119-148, 150, 154-160.
Canceled new claims: 17-67, 69, 71-73, 85, 88, 90-92, 99, 101, 116-118, 149, 151-153.

Accordingly, the claims are not identical in both proceedings.

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the same amendments in all of cases.

2. For a merged proceeding of a reissue application and an *ex parte* reexamination proceeding, MPEP 2285 states:

> "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Accordingly, the filing of amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

The December 13, 2004 amendment (confirmation copy filed January 31, 2005) submitted in the '236 reissue application fails to comply with the above. For example, claim 62 uses strike through for "signalling." Also, the text of claims 17-72 is not underlined in its entirety, even though those claims are new to the '940 patent.

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the amendments in all of cases in the form required by 37 CFR 1.173.

3. The response to these requirements must be limited to placing the same amendments in all cases and providing the amendments in the form required by the rules. The patent owner must **not** address any issue of patentability in the housekeeping amendment.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that an appropriate housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the '236 reissue application and the three reexamination proceedings. Each action will contain identifying data *for all of the cases*, i.e, the '236 reissue application and the three reexamination

proceedings, and each action will be entered into all files (which will be maintained as separate files). Note that there will **not** be any identifying data nor entry of papers for the '863 reissue application, since the '863 reissue application has been held abandoned, and is no longer merged within the present merged proceeding.

5. Any response by the applicant/patent owner must consist of a single response, with four copies being filed for entry in the four files, with each of the four bearing a signature. Any such response must contain identifying data *for all of the cases*, i.e, the '236 reissue application and the three reexamination proceedings. *Any such responses must be served on the requester*, who will also be sent copies of Office actions. Note that there will **not** be any identifying data nor providing of papers for the '863 reissue application, since the '863 reissue application has been held has been held abandoned, and is no longer merged within the present merged proceeding.

6. Pursuant to MPEP 2285:

> "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Thus, as pointed out above, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does <u>not</u> apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Also as pointed out above, pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appeal brief, even though the brief relates to the merged multiple proceedings, and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

8. Upon return of the present merged proceeding to the examiner, the examiner (a) will review the files to ensure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as are necessary as part of the next Office action in order to place the files in that condition.

9. If the reissue application ultimately matures into a reissue patent, the three reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed, e.g., as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which could not be considered under reexamination following the dissolution would be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceedings. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. The August 26, 1999 merger of '863 reissue application and the '4520, '4895, and '5274 proceedings is dissolved.

2. The'236 reissue application and the '4520, '4895, and '5274 reexamination proceedings **are merged** into a single proceeding.

3. Pursuant to Part II of this decision, it is required that applicant/patent owner file, **within ONE MONTH of this decision**, a housekeeping amendment (A) placing the same amendments in all cases of the present merged proceeding and (B) placing the amendments in the form required by 37 CFR 1.173.

4. The reissue and reexamination proceedings are being forwarded to the examiner via the Director of Technology Center 2600. Upon receipt of same, the examiner **should not issue an Office action for the present merged proceeding of the '236 reissue and reexamination proceedings until after the earlier of** (a) the submission of the housekeeping amendment to place the same amendments in both cases and formalize the amendment or (b) the expiration of the one month period from the mailing of this decision for filing the amendment.

5. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

6. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

June 6, 2005
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February 5, 2001

#10

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Enclosure: Paper filed June 6, 2000, in 90/005,275.

In re Thomas Heinl
Reexamination Proceeding
Control No. 90/005,275
Filed: February 25, 1999
For: U.S. Patent No. 4,903,691

In re Thomas Heinl
Reexamination Proceeding
Control No. 90/005,809
Filed: September 5, 2000
For: U.S. Patent No. 4,903,691

DECISION ON PETITION

This is a decision on the October 3, 2000, petition filed by the patent owner under 37 CFR § 1.183. Patent owner, *inter alia*, requests the Commissioner to waive the rules and address the petition prior to the determination on the second 5809 reexamination request, and summarily deny the request as a matter of law. The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is granted-in-part.

BACKGROUND

1. U.S. Patent No. 4,903,691 issued February 27, 1990.

2. On February 25, 1999, a first request for reexamination of the '691 patent was filed by a third party requester. The first reexamination was assigned Control No. 90/005,275. The request was based on patents and printed publications (catalogs). The first reexamination included a first declaration by Karl-E Lieberman (manager for Medicon AG, the third party requester) declaring "on information and belief" that the catalogs are prior art to the '691 patent.

3. On April 27, 1999, reexamination was ordered in the first reexamination proceeding. Patent owner did not elect to file a statement under 37 CFR 1.530 prior to the first Office action on the merits.

4. On January 18, 2000, the examiner issued an Office action rejecting all of the patent claims over the catalogs and patents submitted with the request for reexamination.

5. On March 20, 2000, patent owner filed a response to the Office action in the first reexamination. Patent owner (1) argued (pages 4-8) that the rejections should be withdrawn because there is no evidence or showing that the catalogs are prior art; and (2) argued the technical merits of the rejection with respect to three of the four applied catalogs. Patent owner did not address the merits of the rejection with respect to the Medicon Instruments Catalog (pages 8-9).

6. On June 6, 2000, the third party requester filed a paper in the first reexamination arguing that the printed publications are prior art. An additional declaration by Karl-E Lieberman attesting that the catalogs are prior art to the '691 patent accompanied the third party submission. This paper is an improper submission for the reasons set forth below, and has not been entered, nor made of record in the first reexamination file.

7. On July 19, 2000, the examiner issued a Notice of Intent to Issue a Reexamination Certificate. The examiner held that the previously applied prior art was in error in that based on the evidence of record, the printed publications submitted by the requester do not constitute prior art, and withdrew the rejections based on the catalogs "on this legal basis." The examiner further held that the claims are patentable over the "prior art."

8. On July 21, 2000, the patent owner filed comments on the examiner's statement of reasons for allowance. Patent owner stated that the examiner is correct in his legal conclusion that there is no evidence of record that the catalogs are prior art to the '691 patent, and agreed that the withdrawal of the rejections (based on the catalogs) on this legal basis is appropriate.

9. On September 5, 2000, a second request for reexamination of the '438 patent was filed by the same third party requester. The second request for reexamination was assigned Control No. 90/005,809. The second reexamination is based on the same prior art as the first reexamination with additional evidence that the printed publications (catalogs) are prior art to the '691 patent. The second request includes a second declaration by Karl-E Lieberman (second Lieberman declaration), and a declaration by Dr. Ulrike Mammel (Mammel declaration), a patent attorney for requester in Germany.

10. On October 3, 2000, the patent owner filed the present petition in the second reexamination. Petitioner requests the following relief:

    a. That the provisions of 37 CFR § 1.530(a), which would bar the patent owner from filing a submission in the second reexamination prior to the reexamination order, be suspended and the petition be addressed. Petitioner argues (pp. 6-7) that the basis for the rule (administrative convenience) must give way to patent owner's right to be free from continued abuse and harassment of the filing of a second reexamination where the USPTO has already conducted a full reexamination proceeding based on the same prior art presented in the second reexamination.

    b. That the second request for reexamination be summarily denied (or terminated if ordered prior to a decision on this petition), as a matter of law, in view of the Federal Circuit's holdings in *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997); and *In re Recreative Technologies Corp.*, 83 F3d 1394, 1398; 38 USPQ2d 1776, 1779 (Fed. Cir. 1996). Petitioner argues (p.12) that under the *Portola Packaging* and *Recreative Technologies* holdings, as a matter of law, reexamination cannot be ordered on the basis of references previously considered by an examiner. Petitioner requests that in light of these holdings and in view of the fact that the second reexamination is based on the same prior art addressed in the first reexamination, that the second reexamination should be denied as a matter of law.

    c. That the reexamination certificate in the first reexamination, confirming the patentability of all the claims of the '691 patent, be issued. Further (if procedurally appropriate) that a reexamination certificate be issued in the second reexamination confirming the patentability of all the patent claims.

    d. That further requests for reexamination filed by the same third party requester which would be clearly subject to denial under the *Portola Packaging* and *Recreative Technologies* holdings would subject the patent attorney or agent who filed the request to disciplinary proceedings before the Office of Enrollment & Discipline.

11. On October 20, 2000, reexamination was ordered in the second reexamination proceeding. Reexamination was ordered based on the cited U.S. patents, foreign patents, and published catalogs including the second Lieberman and Mammel declarations.

09/25/2001 SJACKSON 00000009

DECISION

I. Return of improper third party requester paper in first reexamination.

37 CFR 1.550(g) provides (in part):

> "The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered."

37 CFR 1.550(g) additionally provides:

> "[N]o submissions on behalf of any third parties will be acknowledged or considered unless such submissions are (1) in accordance with § 1.510 or § 1.535; or (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525."

The paper filed June 6, 2000, in the first reexamination by the third party requester, which addresses the merits of the proceeding, was filed after the period for active participation of the third party requester had ended. The rules provide that the active participation of the reexamination requester ends with the reply under § 1.535, and prohibit any further third party requester participation. The intent of the rules is to make *ex parte* reexamination an *ex parte* proceeding with limited, well-defined, requester participation. In this regard, the third party requester cannot file papers and create an *inter partes* proceeding. Thus the paper is an improper submission under § 1.550(g). Accordingly, the paper will not be made of record in the first reexamination file and is being returned herewith. This decision will, however, be made of record in both reexamination files.

II. Request to waive the rules and permit the filing and consideration of the petition in the second reexamination prior to the reexamination order.

Initially, it is noted that the petition is not permitted under the reexamination rules. These rules require that "[n]o statement or other response by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515 or § 1.520." 37 CFR § 1.530(a). The present patent owner petition in the second reexamination was filed prior to the determination to order reexamination. Thus, the petition is an improper submission under § 1.530(a), and it would be appropriate to return the petition to the patent owner. See MPEP 2267. However, patent owner's petition does not address the patentability issues raised in the second reexamination, but is an *ultra vires* challenge as to whether there is statutory basis for the granting of the second reexamination in light of the *Portola Packaging* and *Recreative Technologies* holdings. Accordingly, it is appropriate to consider patent owner's petition under § 1.183, which permits suspension of the requirements of the rules under appropriate circumstances.

III. Request that second reexamination request be denied because it was filed for purposes of harassment of the patent owner.

MPEP 2240 states as follows:

> "If a second or subsequent request for reexamination is filed (by any party) while a reexamination is pending, the presence of a substantial new question of patentability depends on the prior art cited by the second or subsequent requester. If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should generally be ordered. This is because the prior art

> which raised a substantial new question of patentability resulting in an order for reexamination continues to raise a substantial new question of patentability until the pending reexamination is concluded. However, in aggravated situations ... where it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, the request should be denied."

In the present instance, patent owner does not provide evidence that the purpose of the second reexamination is for harassment of the patent owner. On the contrary, as noted in the above review of facts, the second reexamination is based, *inter alia*, on the same four catalogs which the examiner withdrew from consideration in the first reexamination holding, as a matter of law, pursuant to arguments raised by patent owner, that the catalogs are not prior art to the '691 patent. In addition to the catalogs, the second request submits additional declaration evidence relating to the issue as to whether or not the catalogs are prior art to the '691 patent. In the first reexamination patent owner elected not to file a statement raising this issue, which would have permitted the requester to file a reply in rebuttal in the first reexamination. Instead, patent owner waited until after the first Office action to raise the issue, thereby precluding the requester from addressing the issue. Requester attempted to file a paper in rebuttal in the first reexamination, but, properly, it was not addressed by the examiner, and is being returned as an improper submission along with this decision. Patent owner cannot be heard to allege harassment by the filing of a second reexamination by the same requester filed for the purpose to address issues which could have been timely raised by patent owner and addressed by the requester in the first reexamination. Thus, in accordance with MPEP 2240, it appears proper to order reexamination in the second reexamination based upon the prior art (plus additional evidence) which raised a substantial new question of patentability in the first reexamination and which continues to raise a substantial new question of patentability until the first reexamination is concluded.

IV. Request that second reexamination request be denied, as a matter of law, in light of the *Portola Packaging* and *Recreative Technologies* holdings.

Petitioner argues that an order of reexamination in the second reexamination based upon the same prior art which raised a substantial new question of patentability in the first reexamination would be contrary to the case law set forth in the *Portola Packaging* and *Recreative Technologies* holdings. At page 12-13 of the petition petitioner points to the following portion of the *Portola* decision:

> "[W]e hold 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 in relation to the same or broader claims."

Patent owner argues the four catalogs cited in the first reexamination were applied in a rejection by the examiner, then withdrawn in view of patent owner's response to the Office action, and as a result, a substantial new question of patentability cannot be raised by the same catalogs in the second reexamination as a matter of law.

Petitioner's position is not persuasive. Initially, it is noted that the *Portola Packaging* and *Recreative Technologies* holdings do not address a situation where the earlier examination which cited the art (which was before the examiner) was an ongoing examination. Rather, the earlier examination of the *Portola Packaging* and *Recreative Technologies* cases was a concluded examination that resulted in the granting of the patent. Accordingly, the *Portola Packaging* and *Recreative Technologies* cases are not on point as to the present fact situation, and do not control

the question as to whether a substantial new question of patentability exists in the second reexamination filed during the pendency of the first reexamination.

In the alternative, a reading of the *Portola Packaging* case tends to suggest that finding a substantial new question based upon the same prior art that was before the examiner during an earlier examination is barred only where the earlier examination (in which the prior art was before the examiner) is a concluded examination. A review of the *Portola Packaging* decision reveals the following statements directed to this point:

In re Portola Packaging Inc., 42 USPQ2d at 1300:

> "We understand that the PTO's goal is to perform thoroughly and conscientiously its function of allowing applications claiming only patentable subject matter, and that in order to do so it wishes to take advantage of a second opportunity to examine claims it once issued when reexamination gives it that chance. However, Congress did not grant the PTO such a broad mandate by enacting the reexamination statute. Even when the door to the reexamination gate is opened, the PTO is not freed from the limitations Congress placed on the reexamination process. Whatever the basis on which reexamination is granted, it was intended to deal only with substantial new questions of patentability, essentially those based on prior art that was not before the examiner during an earlier examination." (Emphasis added.)
>
> "Since the original bases for concluding that a substantial new question of patentability existed to justify reexamination were withdrawn by the PTO during reexamination, leaving only arguments based on references previously considered by the PTO, the reexamination should have been terminated. See *Recreative Technologies*, 83 F.3d at 1396, 38 USPQ2d at 1777 ('[O]nce it becomes apparent that there is no new question of patentability, it is improper to conduct reexamination on an old question that had been finally resolved during the initial examination.')." (Emphasis added.)

The earlier examination which bars a finding of a substantial new question based on the same art that was before the examiner must be a concluded earlier examination that finally resolved the question of patentability with respect to that art, such that claims which issued (in the earlier examination) will not be examined again based on that art. In the present instance, the first examination is not a concluded reexamination, and has not finally resolved the question of patentability with respect to the catalogs.

The first reexamination is not a concluded proceeding. Section 307(a) of Title 35 states:

> In a reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable." (Emphasis added.)

In the first reexamination the examiner issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) which states that the examination has been terminated, and a certificate will issue in due course. Under the statute, it is the reexamination certificate that confirms the patentability of the claims of the patent and not the NIRC. Further, as in an application where

after a Notice of Allowance is mailed prosecution can be reopened, so can an NIRC be withdrawn in a reexamination and prosecution reopened.

Further evidence that a reexamination is not a concluded proceeding until the certificate issues is seen in section 307(b) which provides that intervening rights to not accrue until the certificate issues. Section 307(b) states:

> "Any proposed amended or new claim determined to be patentable and incorporated into a patent following a reexamination proceeding will have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation for the same, prior to issuance of a certificate under the provisions of subsection (a) of this section." (Emphasis added.)

Thus, under §§ 307 (a) & (b) no rights accrue until the certificate issues notwithstanding the allowance of claims during the reexamination proceeding.

In addition to the fact that the first reexamination has not yet concluded, it is noted that the question of the patentability of the claims over the teachings of the catalogs has not been finally resolved in the first reexamination. In the first Office action on January 18, 2000, the examiner rejected the claims over the four catalogs alone, and further in combination with foreign and U.S. patents. On March 20, 2000, the patent owner filed a response to the Office action in which patent owner (1) argued that there is no evidence of record that the catalogs are prior art to the '691 patent, and thus the rejections based on the catalogs should be withdrawn on this legal basis; and (2) argued the patentability issues with respect to the teachings of three of the four catalogs. On July 19, 2000, the examiner issued the NIRC withdrawing the rejection based on the catalogs because they do not constitute prior art. The examiner also withdrew the remaining prior art rejections because they failed to teach the claimed invention. The record does not show that the examiner considered patent owner's arguments in the response that the claims are not patentable over the teachings of the catalogs, especially in view of the fact that the teaching of one of the catalogs was not addressed by patent owner.

Accordingly, in view of all of the above, the *Portola Packaging* and *Recreative Technologies* holdings are not a bar to the finding of a substantial new question of patentability based on the prior art of the second reexamination.

V. Request that the reexamination certificate be issued, and request that further filings of certain requests for reexamination result in disciplinary proceedings.

In view of the above, patent owner's request that the reexamination certificates confirming the patentability of the claims be published in the reexaminations is dismissed. The request that further requests for reexamination filed by the same third party be referred to the Office of Enrollment and Discipline is dismissed as premature. Whether a further request for reexamination is appropriate must be decided on the facts present at that time.

VI. Extension of time for filing a statement under 37 CFR §1.530 in the second reexamination.

The second reexamination was ordered on October 20, 2000. Patent owner had two months in which to elect to file a statement under § 1.530. No statement has been filed. In view of the fact that during this time patent owner was waiting for a decision on his petition filed October 3, 2000, challenging the legality of the reexamination, it is appropriate that the time for filing a statement in the second reexamination be extended. Accordingly, the time for filing a patent owner's statement in the second reexamination is extended to expire two months from the date of this decision. Patent owner may file a statement during this period, or, if he desires that prosecution be advanced, patent owner may file a paper waiving his right to file a statement.

SUMMARY

1. The improper paper filed June 6, 2000, by the third party requester in the first reexamination is being returned with this decision.

2. The provisions of § 1.530(a) are waived under § 1.183, and the merits of the petition filed by the patent owner on October 3, 2000, challenging the legality of the second reexamination has been considered.

3. Patent owner has failed to show that the second reexamination was filed for purposes of harassment.

4. The *Portola Packaging* and *Recreative Technologies* holdings are not a bar to the finding of a substantial new question of patentability based on the prior art of the second reexamination.

5. The request that the reexamination certificate be issued, and the request that further filings of certain requests for reexamination result in disciplinary proceedings are dismissed.

6. The time for filing a patent owner's statement in the second reexamination is extended to expire two months from the date of this decision.

Telephone inquiries related to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at 703-305-8610.

Gerald A. Dost

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

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Paper No. 13

JUN 4 2001

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(For Third Party Requester)

In re Thomas Heinl
Reexamination Proceeding
Control No. 90/005,275
Filed: February 25, 1999
For: U.S. Patent No. 4,903,691

In re Thomas Heinl
Reexamination Proceeding
Control No. 90/005,809
Filed: September 5, 2000
For: U.S. Patent No. 4,903,691

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technology Center 3700 for consideration of merger of proceedings under 37 CFR 1.656 (c). This Decision is issued pursuant to the Order of the district court in Heinl v. Godici, CV 01-458-A (E.D. Va May 30, 2001).

BACKGROUND

A third party requester filed a first request for reexamination, Control No. 90/005,275 on February 25, 1999. Reexamination was ordered in a decision mailed April 27, 1999. A Notice of Intent to Issue Reexamination Certificate was mailed July 7, 2000.

A third party requester filed a second request for reexamination, Control No. 90/005,809 on September 5, 2000. Reexamination was ordered in a decision mailed October 20, 2000.

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under 37 CFR 1.570.

As noted in the above review of facts, reexamination has been ordered in both of the noted reexamination proceedings. Accordingly, merger of proceedings under 37 CFR 1.565(c) is appropriate.

DECISION

I. Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '275 and '809 reexamination proceedings are **merged**. Accordingly, the Notice of Intent to Issue Reexamination Certificate issued July 7, 2000 in the '275 proceedings is hereby withdrawn. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Claims in Both Proceedings.

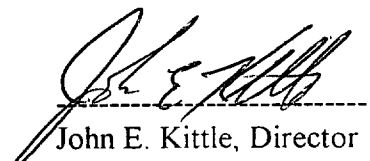
The Patent Owner is required to maintain identical claims in both proceedings.

III. Conduct of Merged Proceeding.

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action that applies to both reexamination files. The action will contain identifying data for both files and will be physically entered in each reexamination file. Any response filed by the Patent Owner must consist of a single response, filed in duplicate, each paper bearing an original signature, for entry in each file. All papers filed by the Patent Owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/005,275 and 90/005,809 are merged. Upon the mailing of this decision, both files will be forwarded to the Examiner for issuance of an Office action.



John E. Kittle, Director
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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
907005,292	03/10/99	5076/91	21110-5501

QM31/0403

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ART UNIT	PAPER NUMBER
3732	13

DATE MAILED: 04/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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APR 3 - 2000
Group 3700

Reexam Control No.: 90/005,292 :
Filed: March 10,1999 : DECISION ON PETITION
For: U.S. Patent No. 5,076,791 : FOR EXTENSION OF TIME
Title: Professional Home Method :
For Bleaching Teeth :

Paper No.: 12

This is a decision on applicant's request for an extension of time in the above-identified Reexamination Proceeding to file a response to the outstanding Office action mailed March 6, 2000. Accordingly, a response is due on or before May 6, 2000. This request is for an additional one month extension to June 06, 2000. The request is filed pursuant to 37 CFR 1.550(c).

A review of the petition indicates that sufficient cause for an extension for the time requested has been established. Accordingly, the request is granted. No further extension of time for the response to the outstanding Office action will be granted unless it can be shown that unforeseeable and extraordinary circumstances exist.

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OFFICE OF PETITIONS

In re Madray :
Reexamination Proceeding : **DECISION**
Control No. 90/005,292 : **DISMISSING**
Filed: March 10, 1999 : **PETITION**
For: U.S. Patent No. 5,076,791 :

This is a decision on the March 4, 2005, patent owner petition to revive the above-identified proceeding under the unintentional provisions of 37 CFR 1.137(b).

The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 CFR 1.137(b) is dismissed.

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The instant petition under 37 CFR 1.137(b) is accompanied by the appropriate statement pursuant to 37 CFR 1.137(b)(3). In addition, the patent owner's response to the Office action of March 6, 2000, has been received, thereby providing the "reply required to the outstanding Office action or notice" pursuant to 37 CFR 1.137(b)(1). Further, the required petition fee of $750 has been received, thereby providing the "petition fee as set forth in 37 CFR 1.17(m)" pursuant to 37 CFR 1.137(b)(2).

However, the petition cannot be granted at this time, since there is no indication that patent owner has complied with the service requirements of 37 CFR 1.550(f). In this regard, the papers submitted fail to provide proof that patent owner has served upon the *ex parte* reexamination requester the papers filed on March 4, 2005. *See* 37 CFR 1.248.

CONCLUSION

In view of the above, a grantable petition must include a showing that the papers filed on March 4, 2005 were served upon the *ex parte* requester.

Any request for reconsideration of this decision must be submitted within two (2) months of the mail date of this decision.

This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (703) 872-9306
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Frances Hicks at (571) 272-3218.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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JUN 27 2005

OFFICE OF PETITIONS

In re Madray
Reexamination Proceeding
Control No. 90/005,292
Filed: March 10, 1999
For: U.S. Patent No. 5,076,791

DECISION GRANTING PETITION

This is a decision on the April 15, 2005, patent owner renewed petition to revive the above-identified proceeding under the unintentional provisions of 37 CFR 1.137(b).

The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 CFR 1.137(b) is **granted**.

BACKGROUND

A petition to revive the above-identified reexamination proceeding under the unintentional provisions of 37 CFR 1.137(b) was filed on March 4, 2005. The petition was dismissed in a decision mailed April 5, 2005, since there was no indication that patent owner had complied with the service requirements of 37 CFR 1.550(f). More specifically, the papers submitted failed to provide proof that patent owner had served upon the *ex parte* reexamination requester the papers filed on March 4, 2005.

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The renewed petition under 37 CFR 1.137(b) is accompanied by a Certificate of Service as proof that the papers filed March 4, 2005, including the petition to revive, the Patent Owner's Statement, and the Response to Office action, as well as the instant renewed petition, have been served upon the *ex parte* reexamination requester. Accordingly, as all requirements for a grantable petition have been met, the petition under 37 CFR 1.137(b) is granted.

CONCLUSION

1. The petition under 37 CFR 1.137(b) is **granted**.

2. The reexamination matter is being returned to Technology Center AU 3732 for action, in due course, on the response filed with the instant petition.

3. Any further communications as to the merits of the reexamination proceeding should be directed to Examiner Ralph Lewis in Technology Center AU 3732, who can be reached at (571) 272-4712.

4. Telephone inquiries related to this decision should be directed to Frances Hicks at (571) 272-3218.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
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REEXAM UNIT

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In re Reissue Application of George Madray
Application No.: 09/610,064
Filed: July 5, 2000
For: U.S. Patent No. 5,076,791

In re George Madray Reexamination Proceeding
Control No.: 90/005,292
Filed: March 10, 1999
For: U.S. Patent No.: 5,076,791

: DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

The above-captioned reissue application and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

REVIEW OF FACTS

U.S. Patent No. 5,076,791 (the '791 patent) issued on December 31, 1991.

1. A request for reexamination, assigned control No. 90/005,292, was filed by a third party requester on March 10, 1999.

2. Reexamination was ordered for the '5292 reexamination proceeding on May 10, 1999.

3. A patent owner's statement under 37 CFR 1.530 was received in the '5292 reexamination proceeding on July 12, 1999.

4. A non-final action was mailed by the Office in the '5292 proceeding on January 27, 2000.

5. A supplemental non-final action was mailed by the Office in the '5292 proceeding on March 6, 2000.

6. A response was received from the patent owner to the March 6, 2000 non-final action on July 5, 2000.

7. Also on July 5, 2000, the patent owner filed an application for reissue, assigned application No. 09/610,064 (the '064 reissue application).

8. A Notice of Intent to Issue a Reexam Certificate (NIRC), noting that the response received on July 5, 2000 was improper, was mailed by the Office in the '5292 proceeding on November 17, 2004.

9. A petition to revive the '5292 reexamination proceeding, accompanied by a proper response to the March 6, 2000 non-final action, was received from the patent owner on March 4, 2005.

10. A decision dismissing the March 4, 2005 petition in the '5292 reexamination proceeding was mailed by the Office on April 5, 2005.

11. A renewed petition to revive the '5292 reexamination proceeding was received from the patent owner on April 15, 2005.

12. A decision reviving the '5292 reexamination proceeding was mailed by the Office on June 27, 2005.

13. Litigation styled as *George W. Madray, Jr. DMD v. Wal-Mart Stores, Inc.*, No. 2:97-CV-00240 was filed in the United States District Court, Southern District of Georgia (Brunswick Division) on December 22, 1997.

14. On May 14, 199, an Order issued by which the civil action was marked "closed for statistical purposes" due to the pending reexamination of the underlying '791 patent. The Court retained jurisdiction in order to restore the case to the trial docket on motion of a party "if the circumstances change."

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, reissue application No. 09/610,064 and reexamination control No. 90/005,292 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In order to provide efficient and prompt handling of all proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) is discretionary. *The present merger is not an assurance that, in a future similar situation, merger would be ordered.*

As pointed out above, in *George W. Madray, Jr. DMD v. Wal-Mart Stores, Inc., supra.*, an Order issued by which the civil action was marked "closed for statistical purposes" due to the pending reexamination of the underlying '791 patent, while the Court retained jurisdiction in order to restore the case to the trial docket on motion of a party "if the circumstances change." The litigation is, therefore, regarded as having been stayed by the Court, and the merged proceeding will be treated pursuant to MPEP 2286, Part I.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-captioned reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue application and the reexamination proceeding files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the file for reexamination control No. 90/005,292 shows that none of original patent claims 1 to 9 are amended or cancelled, and no claims are added by amendment.

3. A review of the file for the '064 reissue application shows that none of original patent claims 1 to 9 are amended or cancelled. However, new claims 10-14 have been added to the reissue application by preliminary amendment filed on July 5, 2000. Claims 12-14 are copied from U.S. Patent No. 5,165,424 to Silverman.

4. It is also noted that extensive amendments to the specification of the '064 reissue application were introduced by the July 5, 2000 preliminary amendment.

5. Accordingly, the claims and specification are **not** identical in the '5292 reexamination proceeding and the '064 reissue application. Therefore, patent owner is **required** to file a housekeeping amendment in the '5292 reexamination proceeding within **ONE (1) MONTH** of this decision rendering the specification and claims thereof identical to the claims and specification in the '064 reissue application. The response to this requirement **must** be limited to an amendment of one or both of the proceedings placing identical claims, specifications and drawings in both proceedings. *The patent owner must not address any issue of patentability in the response.*

III. Conduct of the Merged Reissue and Reexamination Proceeding

1. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, due to the existence of stayed litigation in this proceeding, periods of response should be set at ONE (1) month to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 U.S.C. 305).**

2. Each Office action issued by the examiner will take the form of a single action that jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data for both of the cases, *i.e.*, the reissue application and the reexamination proceeding, and each action will be physically entered into both files, which will be maintained as separate Image File Wrapper (IFW) files.

3. Any response by the applicant/patent owner must consist of a single response, with two copies being filed so that a copy may be entered in each of the two files. **Each copy must bear a signature.** Any such responses must be served on the requester, who will also be sent copies of Office actions.

4. Pursuant to MPEP 2285:

   "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

   Thus, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, and such clean copies *are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented, via markings, pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

   Pursuant to 37 CFR 1.173(g), all amendments must be made **relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application**. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

5. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee, excess claims fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief, even though the brief relates to merged multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding.

6. Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

7. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the reexamination certificate under 37 CFR 1.570. See MPEP 2285.

8. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the USPTO Director will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings. For any further action in the reexamination proceeding, any grounds of rejection that are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

9. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceedings. Such examination would be conducted as set forth in the immediately preceding paragraph.

CORRESPONDENCE ADDRESS AND ATTORNEY

A review of the record shows that there are different patent owner correspondence addresses and attorneys for the present reexamination and reissue proceedings – as follows:

John S. Pratt, Esq.
KILPATRICK STOCKTON LLP
1100 Peachtree Street
Atlanta, GA 30309

MYERS & KAPLAN LLC
1899 Powers Ferry Road
Suite 310
Atlanta, GA 30339

Patent owner is required to, within **ONE MONTH** of this decision, (a) designate one of the two correspondence addresses and attorneys prosecuting these proceedings as the correspondence address and attorney of record in both proceedings (to provide one address and attorney for the merged proceeding), and (b) supply the designated attorney with the power of attorney in both proceedings.

As a courtesy, this decision is being mailed to both addresses.

CONCLUSION

1. Reissue application No. 09/610,064 and reexamination control No. 90/005,292 **ARE MERGED** into a single consolidated proceeding. A copy of this merger decision will be made of record in both of the files.

2. **The patent owner is required to, within ONE MONTH of this decision,** file a housekeeping amendment as set forth in item II(5), *supra*.

3. **The patent owner is further required to, within ONE MONTH of this decision**, (a) designate one of the two correspondence addresses and attorneys prosecuting these proceedings as the correspondence address and attorney of record in both proceedings and (b) supply the designated attorney with the power of attorney in both proceedings.

4. Jurisdiction over the reissue and reexaminations files is being forwarded to the Technology Center Special Program Examiner (SPRE) via the Director of Technology Center 3700. Upon receipt of same, the SPRE should ensure that the reissue and reexamination proceedings are assigned to the same examiner.

5. The assigned examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of:

(A) The expiration of the one month period from the mailing of this decision for the filing of (i) the required housekeeping amendment and (ii) the papers unifying the correspondence address and attorney of record in both proceedings or the receipt of such papers, or

(B) The receipt of both the required amendment and papers.

6. All further examination in the merged proceeding is to be conducted in accordance with Part III of this decision.

7. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

April 10, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

#28

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 28

Jeffrey A. Lindeman
MORGAN, LEWIS & BOCKIUS L.L.P.
1800 M Street, N.W.
Washington, D.C. 20036-5869

(For Patent Owner)

MAILED

FEB 20 2001

REEXAM UNIT

In re George et al.
Reexamination Proceeding
Control No. 90/005,306
Filed: March 25, 1999
For: U.S. Patent No. 5,709,940

DECISION GRANTING PETITION

This is a decision on the December 4, 2000, patent owner PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

DECISION

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by

37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The instant petition is accompanied by an Appeal Brief in triplicate, as well as authorization to charge the appeal brief fee under 37 C.F.R. § 1.17(c), and the petition fee under 37 C.F.R. § 1.17(m) to deposit account 50-0310. In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is granted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 1700 for consideration of the Appeal Brief.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, J.M. Gray, in Technology Center 1700.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

February 16, 2001

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,307	03/30/99	PP05751	

HM32/0210

LOREN S MILLER
1788 OAK CREEK DRIVE APT 407
PALO ALTO CA 94303

EXAMINER	
LOCKER, H	

ART UNIT	PAPER NUMBER
1649	10

DATE MAILED: 02/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

LOREN S MILLER
1788 OAK CREEK DRIVE APT 407
PALO ALTO , CA 94303

In re Reexamination Proceeding:
Loren MIller
Serial No.: 90/005,307
Filed: April 3, 1998
Patent No: PP 5,751

: EXTENSION OF TIME

This is in response to applicant's request, filed February 3, 2000, by facsimile transmission, for a two month extension of time to reply to the Office action mailed November 3, 1999, which set a two month shortened statutory period for reply.

Extensions of time for response to Office actions in reexamination Proceedings are governed by 37 CFR 1.550(c) and (e):

> 37 CFR 1.550. Conduct of reexamination proceedings.
>
> (c) *The time for taking any action by a patent owner in a reexamination proceeding will be extended only for sufficient cause, and for a reasonable time specified.* Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S.Court of Appeals for the Federal Circuit or for commencing a civil action.
>
> (e) The reexamination requester will be sent copies of Office actions issued during the reexamination proceeding ***Any document filed by the patent owner must be served on the requester in the manner provided in § 1.248. The document must reflect service or the document may be refused consideration by the Office***. The active participation of the reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are (1) in accordance with § 1.510 or (2) entered in the patent file prior to the date of the order to reexamine pursuant to § 1.525. Submissions by third parties, filed after the date of the order to reexamine pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a)

Patent owner has previously requested and been granted a two month extension of time to file a response to the Office action mailed November 3, 1999. The due date for patent owner's response currently is March 3, 2000. 37 CFR 1.550(c) and M.P.E.P. 2265 specifically state that time will be extended only for sufficient cause and for a reasonable time. While a first request will normally be granted for any reasonable statement of need, second and subsequent requests are more carefully scrutinized. Inasmuch as reexamination proceedings are to be conducted with "special dispatch" the granting of more than one extension of time except for good and sufficient reason is not in accord with the rules. Patent owner's initial request, granted for 60 days (two months), was granted in order to allow patent owner to obtain adequate legal representation. Even though patent owner was on notice that the reexamination request had been filed on March 30, 1999 and the order granted on May 28, 1999, patent owner appears to have delayed until after issuance of a first Office action on the merits before deciding to seek proper legal representation. Patent owner now presents a second request for an additional 60 days (two months) extension of time in order to consult with the engaged attorney, Steven Bent. However, no schedule of meetings or other efforts to meet with the engaged attorney or details of what is to

be accomplished by when have been provided. Patent owner's request also appears to be premature since at least one month remains within the extended time period to file a response.

It is further noted that, contrary to 37 CFR 1.550(e) and M.P.E.P. 2266, a copy of the request for extension of time has not been filed on the third party requester as is required. (It is further noted that no certification of service of the first request for extension of time on the third party requester has been made.) 37 CFR 1.550(e) requires that all papers filed by patent owner, including requests for extension of time, be filed on the third party requester. Failure to certify service on the third party requester of the first extension of time request appears to have been due to patent owner's lack of familiarity with reexamination proceeding rules and will not be required. However any additional papers filed with the Office must provide confirmation of service on the third party requester. (A copy of this letter and the requested extension of time will be mailed to the third party requester.)

The extension of time request is **DISMISSED** as improper in that service of the third party requester has not been provided and no good and sufficient reason for the request has been provided.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Group 1600/2900, Washington, DC 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 308-7922.

John Kittle
Director, Group 1600/2900

09/29/2006

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,310	03/31/99	5821269	RE-06

HM32/1106

HENRY D. COLEMAN
COLEMAN SUDOL, LLP
708 THIRD AVENUE
14TH FLOOR
NEW YORK NY 10017-4101

EXAMINER
HARRISON,R

ART UNIT	PAPER NUMBER
1619	08

DATE MAILED: 11/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95) U.S. G P.O. 1999 460-693 1- File Copy

#08

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAILED IN TECH CENTER
1600 - 11-06-00

HENRY D. COLEMAN
COLEMAN SUDOL, LLP
708 THIRD AVENUE, 14TH FLOOR
NEW YORK , NY 10017-4101

FOR PATENT OWNER

DAVID H. VOORHEES
MEREK & VOORHEES
643 S. WASHINGTON ST. #B
ALEXANDRIA, VA 22314-4109

FOR REQUESTER

In re Blumberg
Reexamination Proceeding
Control No.: 90/005,310
Filed: October 13, 1998
For: U.S. Patent No. 5,821,269

: DECISION ON PETITION

This is in response to applicant's petition under 37 CFR 1.181, filed June 6, 2000, requesting resetting of the period for reply based on failure to timely receive the last Office action.

A review of the file history shows that patent owner filed a change of address with the Office for both the issued patent and the reexamination proceeding. The change of address was accepted and was entered for the patent, but was not entered in the electronic reexamination file record. Failure to enter the address change resulted in the Office action, mailed November 5, 1999, being forwarded to an old address without the action being forwarded to patent owner until after the period for reply had expired. Patent owner has received a copy of the Office action. In view of the Office error, the proceeding is restored to pending status.

Applicant's petition is **GRANTED**.

The TWO MONTH period for filing a reply to the Office action originally mailed November 5, 1999, is restarted to run from the date of mailing of this decision.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7939.

Jasemine C. Chambers
Director, Technology Center 1600

DO NOT ENTER

UNITED STATES P NT and TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D C 20231
WWW USPTO GOV

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Mailed: JUN 2 9 2000

GROUP 1700

JWM
Paper Number 15

Eugene C. Rzucidlo, Esq;
Graham and James
885 Third Avenue, 21st Floor
New York, NY 10022-4834

(for Patent Owner)

Douglass C. Hochstetler
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606

(for Third Party)

In re Tellini et al
Reexamination Proceeding
Control No. 90/005,314
Filed: April 5, 1999
For: U.S. Patent No. B2 4,844,723

In re Tellini et al
Reexamination Proceeding
Control No. 90/005,689
Filed: March 31, 2000
For: U.S. Patent No. B2 4,844,723

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technical Center 1700 for consideration of merger of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent Reexamination Certificate B2 4,844,723 issued on January 19, 1993.

2. A first REQUEST FOR REEXAMINATION UNDER 37 CFR 1.510 for United States Patent Reexamination Certificate B2 4,844,723, assigned Reexamination Control No. 90/005,314 ('314), was filed April 5, 1999 by Douglass C. Hochstetler, 6300 Sears Tower, 233 South Wacker Drive, Chicago, IL 60606. The request urged that a substantial new question of patentability was raised by the teachings of Guerrieri, Bode et al , Darby, and Heinrich et al.

3. Reexamination was ordered for '314 on May 18, 1999.

4. A patent owner's reply, under 37 C.F.R. 1.530(b), was received July 12, 1999, and a requestor's response, under 37 C.F.R. 1.535, was received on September 7, 1999.

5. A first Office action was mailed December 21, 1999 and contained rejections of claims 4-11 under 35 U.S.C. 103(a) over Bode et al taken with Heinrich et al alone or in further view of Darby et al.

6. Patent owner responded to the first Office action with a timely AMENDMENT AND REQUEST FOR RECONSIDERATION on February 25, 2000, which was followed by a DECLARATION OF GARY J. GRIECO on March 29, 2000, each of which emphasized the difference between the claimed invention which operates at both maximum voltage and current whereas Heinrich et al operates at a minimum power necessary to maintain maximum voltage (i.e., minimum current for maximum voltage) across the electrodes. An amendment correcting a typographical error at claim 5 in the Reexamination Certificate B1 4,844,723 which issued July 21, 1992.

7. A second REQUEST FOR REEXAMINATION UNDER 37 CFR 1.510 for United States Patent Reexamination Certificate B2 4,844,723, assigned Reexamination Control No. 90/005,689 ('689), was filed March 31, 2000 by Douglass C. Hochstetler, 6300 Sears Tower, 233 South Wacker Drive, Chicago, IL 60606. The request urged that a substantial new question of patentability was raised by the teachings of Bode et al and Heinrich et al, as well as the teachings of Weyer et al. The later prior art reference is asserted to refute the "maximum" versus "minimum" power operation argument traversing the rejections in the patent owner REQUEST FOR RECONSIDERATION of February 25, 2000 and the supplemental DECLARATION OF GARY J. GRIECO of March 29, 2000 in the '314 proceeding.

8. A final Office action was mailed April 6, 2000 and repeated the rejections of claims 4-11 under 35 U.S.C. 103(a) over Bode et al taken with Heinrich et al alone or in further view of Darby et al; while responding to arguments raised by the patent owner with regard to the "maximum" versus "minimum" power operation of the claimed invention versus the teachings of Heinrich et al.

9. Reexamination was ordered for '689 on May 30, 2000.

10. An after-final RESPONSE TO OFFICE ACTION in the '314 proceeding was filed June 8, 2000, in which the patent owner continued the traversal of the prior art rejections of all claims. The response also presented for the first time the Weyer et al article (cited in the '689 proceeding) and presented arguments traversing the teachings of said article.

11. Patent owner filed, on June 7, 2000, a WAIVER OF RIGHT TO FILE OWNER'S STATEMENT in the '689 reexamination proceeding indicating that no patent owner's statement under 37 C.F.R. 1.530(b) would be filed and requesting that the '689 proceeding be considered along with the '314 proceeding.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> "If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under 37 C.F.R. 1.570."

As noted in the above review of facts, reexamination has been ordered in each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. The MPEP Chapter 2283, further sets forth:

> "If the second request is based upon essentially the same patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as those raised in the first request, and if reexamination is ordered, the examination of the merged proceeding will continue at the point reached in the first reexamination proceeding. If, however, new patents or printed publications are presented in the second request which raise different questions than those raised in the first request, then prosecution in the merged reexamination proceeding will be reopened, if applicable, to the extent necessary to fully treat the questions raised."

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the '90/005,314, and 90/005,689 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. REQUIREMENTS FOR SAME AMENDMENTS IN BOTH PROCEEDINGS

As noted above, the claim 5 has amended in the '314 reexamination proceeding. Patent owner is required to maintain the same claims and specification in both files. Patent owner is required to submit an appropriate "housekeeping amendment" within one month of this decision placing the same amendment in all files. This amendment should be the same as Item 6. above. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. 1.540, and would result in the return of the paper as an improper submission.

III. CONDUCT OF MERGED PROCEEDING

Since substantially the same prior art and issues were cited and considered in each request for reexamination, the merged reexamination proceeding shall proceed from the point reached in the '314 reexamination, i.e., consideration of the after final REQUEST FOR RECONSIDERATION in the '314 proceeding. The reexamination files shall be forwarded to the examiner for consideration of the claims, statements, and evidence presented in the second '689 REQUEST FOR REEXAMINATION, as well as

consideration of the REQUEST FOR RECONSIDERATION of June 8, 2000 filed in the '314 reexamination proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature and identifying data for all files, for entry into each file. All correspondence from the PTO will be addressed to the patent owner's representative address listed in the Reexamination Control No. 90/005,314 and No. 90/005,689 as:

Eugene C. Rzucidlo, Esq
Graham and James
885 Third Avenue, 21st Floor
New York, NY 10022-4834

CONCLUSION

Reexamination Control Nos. 90/005,314, and 90/005,689 are merged. An Office action will be issued in due course.

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

#24 (mail)

Paper No. 24

Gerard F. Diebner, Esq. (For Patent Owner)
GREENBERG TRAURIG, LLP
885 Third Avenue, 21st Floor
New York, NY 10022

Douglas C. Hochstetler (For Requester)
Marshall, O'Toole, Gerstein, Murray & Borun
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606

MAILED

MAR 05 2001

REEXAM UNIT

In re Reexamination Proceeding :
Control No. 90/005,314 :
Filed: April 5, 1999 :
For: U.S. Patent No. 4,844,723 :
Patentee: Tellini, et al. :
: **DECISION**
: **DISMISSING**
: **PETITION**
In re Reexamination Proceeding :
Control No. 90/005,689 :
Filed: March 31, 2000 :
For: U.S. Patent No. 4,844,723 :
Patentee: Tellini, et al. :

This is a decision on the patent owner petition of January 31, 2001, requesting the entry of the late filed Appeal Brief. The petition is being treated as a PETITION UNDER 37 C.F.R. § 1.137(a) for the entry of late papers on the grounds of unavoidable delay; see MPEP 2268. A single petition fee under 37 C.F.R. § 1.17(l) of $110.00, as well as a single appeal brief fee under 37 C.F.R. § 1.17(c) of $310.00, for the merged proceeding have been charged to petitioner's deposit account, as per petitioner's instructions on page 2 of the present petition.

The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 C.F.R. § 1.137(a) for the entry of late papers is **dismissed** for the reasons pointed out below.

Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are **not** permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(a)."

DECISION

A grantable petition for entry of belated papers under 37 C.F.R. § 1.137(a) must be accompanied (1) by an adequate showing of the cause of unavoidable delay, (2) by the proposed response to the outstanding Office action, and (3) by the petition fee required by law. This petition lacks item (1) above.

This reexamination proceeding terminated after December 5, 2000, for failure to timely file an Appeal Brief within two months of the Notice of Appeal filed October 5, 2000. The proposed response required for the present petition for entry of late papers must be 4 copies of an Appeal Brief for the merged reexamination proceeding. It is noted that sufficient copies of the Appeal Brief have been received.

With regard to an adequate showing of the cause of unavoidable delay, the present petition indicates that there was a merger of law firms. Specifically, the New York office of Graham & James, LLP merged with the firm of Greenberg Traurig, LLP, on July 17, 2000, and each law firm had a different docketing system. It is stated that in transferring cases from the Graham & James, LLP docketing system to the Greenberg Traurig, LLP docketing system, the instant merged reexamination proceeding was, through inadvertence, "not properly transferred."

Initially, it is unclear what happened with regard to the transfer of the merged proceeding to the Greenberg Traurig, LLP docketing system, i.e., what is meant by "not properly transferred?" Was it not docketed into the Greenberg Traurig, LLP docketing system at all, or was it transferred, but docketed improperly? If improperly docketed, what was the nature of the improper docketing, and how did it contribute to the delay in filing the Appeal Brief? Was the merged reexamination proceeding docketed in the Graham & James, LLP docketing system prior to July 17, 2000, and if so, did it remain in their system subsequent to the July 17, 2000, merger of the law firms? If it remained in their system, how long after the merger of July 17, 2000, did it remain in their docketing system, and why did the docketing system fail to notify the Graham & James, LLP, law firm that an action was due (so that Graham & James, LLP, could notify the Greenberg Traurig, LLP)? It is noted that a number of papers were filed by patent owner in the merged proceeding between August 24, 2000 and January 31, 2001. Since these papers were filed subsequent to the merger of the law firms, which docketing system were they entered into ? Clarification of such details should be presented in any renewed petition based upon unavoidable delay. This clarification should be accompanied by supporting statements from the appropriate parties having knowledge of this information bearing on the above inquiries. These parties would appear to include those responsible in the docketing departments of the two firms for transferring the docketing information from the Graham & James, LLP, and receiving and entering it for the Greenberg Traurig, LLP.

It is required that a showing be provided which sets forth the entirety of the facts surrounding the delay in filing the Appeal Brief. Such showing must explain what Greenberg Traurig, LLP did with the merged reexamination proceeding, and why the firm did not provide a timely Appeal Brief. A statement is in order from the Greenberg Traurig, LLP staff responsible for processing and docketing the cases transferred from the Graham & James, LLP, to address this matter in detail.

The showing should include copies of any records including docket reports for the two docketing systems referred to in the petition, relevant to the time period in question, with supporting statements. Additionally, a copy of the file jacket for the merged reexamination proceeding is in order to show any annotation as to the transfer of the merged file between the two firms. Specifically, copies of the docket records should be provided showing when the last Office communication (prior to the merger of the law firms) with regard to the merged reexamination proceeding was entered into the Graham & James, LLP, docketing system, and how the merged proceeding was handled in their docketing system subsequent to the July 17, 2000, merger of the

two law firms. Further, copies of the docket records from the Greenberg Traurig, LLP docketing system should be provided, showing where the merged reexamination proceeding entries would have appeared if they had been properly transferred into that system subsequent to the July 17, 2000, merger of the law firms, and where/how they appeared once the problem was identified and such merged proceeding was properly transferred into their docketing system.

It should be clarified that the time period in question is the period of time between the last Office communications mailed to patent owner prior to the July 17, 2000, merger of the law firms, i.e., the decision merging reexamination proceedings of June 29, 2000, and the final rejection of June 30, 2000, and the filing of the instant petition and Appeal Brief on January 31, 2001. Therefore, with regard to petitioner's assertion that a docketing error was the cause of delay in filing the Appeal Brief, the showing provided is incomplete as to substantiating a docketing error, and the present petition is inadequate to establish a case of unavoidable delay within the meaning of the statute. It is noted that a request for extension of time was filed on August 24, 2000, i.e., after the July 17, 2000, merger of the law firms. Any renewed petition based upon unavoidable delay which is filed should explain how this request for extension of time came to be filed in view of the statement in the petition that the present file was not properly transferred to the Greenberg Traurig, LLP docketing system. Also, when making the request for the extension of time, why was the improper transfer not corrected, and what docketing was carried out when making the request for extension of time?

Any response to this petition decision to establish the cause of unavoidable delay must comply with the following:

As noted in MPEP 711.03(c)§(III)(2), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable delay", provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See *In re* Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds *sub nom* Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); *In re* Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

Petitioner's showing currently fails to meet criteria (A),(B) and (C) above. The showing fails to adequately evidence the error was the cause of the delay at issue; there was a business routine for ensuring that USPTO correspondence was properly received, docketed and forwarded; and that the personnel were sufficiently trained in docketing due dates for reexamination proceedings such that petitioner was prudent in relying upon the personnel. The nature and extent of training provided to the personnel should be set forth, with respect to the docketing and monitoring of reexamination cases. As a final point, any renewed petition based upon unavoidable delay should point out the nature of the precautions taken by appropriate parties in the transfer of cases from the system of one firm to the other, which would address problems such as the improper transfer of the present case which is referred to in the present petition.

For the reasons set forth above, the petition is **dismissed**.

ALTERNATIVE OPTION

Petition based on unintentional delay:

Petitioner may wish to consider the filing of a petition under 37 C.F.R. § 1.137(b) if the delay in filing the Appeal Brief of January 31, 2001, was unintentional. The unintentional delay fee provisions of 35 U.S.C. § 41(a)(7) have been imported into, and are applicable to, all *ex parte* reexamination proceedings by Sec. 4605 of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 C.F.R. § 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the entire delay from the due date for the response to the filing of a grantable petition was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 C.F.R. § 1.17(m).

CONCLUSION

1. The petition is **dismissed**.

2. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision.

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

4. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

March 2, 2001

#26 (mar.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 26

Gerard F. Diebner, Esq.
GREENBERG TRAURIG, LLP
885 Third Avenue, 21st Floor
New York, NY 10022

(For Patent Owner)

Douglas C. Hochstetler
MARSHALL, O'TOOLE, GERSTEIN, MURRAY & BORUN
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606

(For Requester)

MAILED
APR 0 5 2001
REEXAM UNIT

DO NOT USE IN PALM PRINTER

In re Reexamination Proceeding :
Control No. 90/005,314 :
Filed: April 5, 1999 :
For: U.S. Patent No. 4,844,723 :
Patentee: Tellini, et al. :

In re Reexamination Proceeding :
Control No. 90/005,689 :
Filed: March 31, 2000 :
For: U.S. Patent No. 4,844,723 :
Patentee: Tellini, et al. :

DECISION GRANTING PETITION

This is a decision on the March 19, 2001, patent owner PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present merged reexamination proceedings and revival of the merged proceedings under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

DECISION

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The appeal brief filed in response to the notice of appeal of October 5, 2000, was received on January 31, 2001, and therefore is already of record. A single petition fee under 37 C.F.R. § 1.17(m) of $1240.00 for the merged proceeding has been charged to Deposit Account No. 501561, as per petitioner's instructions on page 1 of the instant petition. In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 1700 for consideration of the appeal brief of January 31, 2001.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the examiner, Richard Chiesa in Technology Center Art Unit 1724.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

April 5, 2001

90005314.031901

UNITED STATES P NT and TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D C 20231
WWW USPTO GOV

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GROUP 1700

JWM
Paper Number 15

Eugene C. Rzucidlo, Esq;
Graham and James
885 Third Avenue, 21st Floor
New York, NY 10022-4834

(for Patent Owner)

Douglass C. Hochstetler
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606

(for Third Party)

In re Tellini et al
Reexamination Proceeding
Control No. 90/005,314
Filed: April 5, 1999
For: U.S. Patent No. B2 4,844,723

In re Tellini et al
Reexamination Proceeding
Control No. 90/005,689
Filed: March 31, 2000
For: U.S. Patent No. B2 4,844,723

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technical Center 1700 for consideration of merger of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent Reexamination Certificate B2 4,844,723 issued on January 19, 1993.

2. A first REQUEST FOR REEXAMINATION UNDER 37 CFR 1.510 for United States Patent Reexamination Certificate B2 4,844,723, assigned Reexamination Control No. 90/005,314 ('314), was filed April 5, 1999 by Douglass C. Hochstetler, 6300 Sears Tower, 233 South Wacker Drive, Chicago, IL 60606. The request urged that a substantial new question of patentability was raised by the teachings of Guerrieri, Bode et al , Darby, and Heinrich et al.

3. Reexamination was ordered for '314 on May 18, 1999.

4. A patent owner's reply, under 37 C.F.R. 1.530(b), was received July 12, 1999, and a requestor's response, under 37 C.F.R. 1.535, was received on September 7, 1999.

5. A first Office action was mailed December 21, 1999 and contained rejections of claims 4-11 under 35 U.S.C. 103(a) over Bode et al taken with Heinrich et al alone or in further view of Darby et al.

6. Patent owner responded to the first Office action with a timely AMENDMENT AND REQUEST FOR RECONSIDERATION on February 25, 2000, which was followed by a DECLARATION OF GARY J. GRIECO on March 29, 2000, each of which emphasized the difference between the claimed invention which operates at both maximum voltage and current whereas Heinrich et al operates at a minimum power necessary to maintain maximum voltage (i.e., minimum current for maximum voltage) across the electrodes. An amendment correcting a typographical error at claim 5 in the Reexamination Certificate B1 4,844,723 which issued July 21, 1992.

7. A second REQUEST FOR REEXAMINATION UNDER 37 CFR 1.510 for United States Patent Reexamination Certificate B2 4,844,723, assigned Reexamination Control No. 90/005,689 ('689), was filed March 31, 2000 by Douglass C. Hochstetler, 6300 Sears Tower, 233 South Wacker Drive, Chicago, IL 60606. The request urged that a substantial new question of patentability was raised by the teachings of Bode et al and Heinrich et al, as well as the teachings of Weyer et al. The later prior art reference is asserted to refute the "maximum" versus "minimum" power operation argument traversing the rejections in the patent owner REQUEST FOR RECONSIDERATION of February 25, 2000 and the supplemental DECLARATION OF GARY J. GRIECO of March 29, 2000 in the '314 proceeding.

8. A final Office action was mailed April 6, 2000 and repeated the rejections of claims 4-11 under 35 U.S.C. 103(a) over Bode et al taken with Heinrich et al alone or in further view of Darby et al; while responding to arguments raised by the patent owner with regard to the "maximum" versus "minimum" power operation of the claimed invention versus the teachings of Heinrich et al.

9. Reexamination was ordered for '689 on May 30, 2000.

10. An after-final RESPONSE TO OFFICE ACTION in the '314 proceeding was filed June 8, 2000, in which the patent owner continued the traversal of the prior art rejections of all claims. The response also presented for the first time the Weyer et al article (cited in the '689 proceeding) and presented arguments traversing the teachings of said article.

11. Patent owner filed, on June 7, 2000, a WAIVER OF RIGHT TO FILE OWNER'S STATEMENT in the '689 reexamination proceeding indicating that no patent owner's statement under 37 C.F.R. 1.530(b) would be filed and requesting that the '689 proceeding be considered along with the '314 proceeding.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> "If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under 37 C.F.R. 1.570."

As noted in the above review of facts, reexamination has been ordered in each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. The MPEP Chapter 2283, further sets forth:

> "If the second request is based upon essentially the same patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as those raised in the first request, and if reexamination is ordered, the examination of the merged proceeding will continue at the point reached in the first reexamination proceeding. If, however, new patents or printed publications are presented in the second request which raise different questions than those raised in the first request, then prosecution in the merged reexamination proceeding will be reopened, if applicable, to the extent necessary to fully treat the questions raised."

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the '90/005,314, and 90/005,689 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. REQUIREMENTS FOR SAME AMENDMENTS IN BOTH PROCEEDINGS

As noted above, the claim 5 has amended in the '314 reexamination proceeding. Patent owner is required to maintain the same claims and specification in both files. Patent owner is required to submit an appropriate "housekeeping amendment" within one month of this decision placing the same amendment in all files. This amendment should be the same as Item 6. above. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. 1.540, and would result in the return of the paper as an improper submission.

III. CONDUCT OF MERGED PROCEEDING

Since substantially the same prior art and issues were cited and considered in each request for reexamination, the merged reexamination proceeding shall proceed from the point reached in the '314 reexamination, i.e., consideration of the after final REQUEST FOR RECONSIDERATION in the '314 proceeding. The reexamination files shall be forwarded to the examiner for consideration of the claims, statements, and evidence presented in the second '689 REQUEST FOR REEXAMINATION, as well as

consideration of the REQUEST FOR RECONSIDERATION of June 8, 2000 filed in the '314 reexamination proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature and identifying data for all files, for entry into each file. All correspondence from the PTO will be addressed to the patent owner's representative address listed in the Reexamination Control No. 90/005,314 and No. 90/005,689 as:

Eugene C. Rzucidlo, Esq
Graham and James
885 Third Avenue, 21st Floor
New York, NY 10022-4834

CONCLUSION

Reexamination Control Nos. 90/005,314, and 90/005,689 are merged. An Office action will be issued in due course.

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

#24 (mail)

Paper No. 24

Gerard F. Diebner, Esq. (For Patent Owner)
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New York, NY 10022

Douglas C. Hochstetler (For Requester)
Marshall, O'Toole, Gerstein, Murray & Borun
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606

MAILED

MAR 05 2001

REEXAM UNIT

In re Reexamination Proceeding :
Control No. 90/005,314 :
Filed: April 5, 1999 :
For: U.S. Patent No. 4,844,723 :
Patentee: Tellini, et al. :
: **DECISION**
: **DISMISSING**
: **PETITION**
In re Reexamination Proceeding :
Control No. 90/005,689 :
Filed: March 31, 2000 :
For: U.S. Patent No. 4,844,723 :
Patentee: Tellini, et al. :

This is a decision on the patent owner petition of January 31, 2001, requesting the entry of the late filed Appeal Brief. The petition is being treated as a PETITION UNDER 37 C.F.R. § 1.137(a) for the entry of late papers on the grounds of unavoidable delay; see MPEP 2268. A single petition fee under 37 C.F.R. § 1.17(l) of $110.00, as well as a single appeal brief fee under 37 C.F.R. § 1.17(c) of $310.00, for the merged proceeding have been charged to petitioner's deposit account, as per petitioner's instructions on page 2 of the present petition.

The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 C.F.R. § 1.137(a) for the entry of late papers is **dismissed** for the reasons pointed out below.

Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are **not** permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(a)."

DECISION

A grantable petition for entry of belated papers under 37 C.F.R. § 1.137(a) must be accompanied (1) by an adequate showing of the cause of unavoidable delay, (2) by the proposed response to the outstanding Office action, and (3) by the petition fee required by law. This petition lacks item (1) above.

This reexamination proceeding terminated after December 5, 2000, for failure to timely file an Appeal Brief within two months of the Notice of Appeal filed October 5, 2000. The proposed response required for the present petition for entry of late papers must be 4 copies of an Appeal Brief for the merged reexamination proceeding. It is noted that sufficient copies of the Appeal Brief have been received.

With regard to an adequate showing of the cause of unavoidable delay, the present petition indicates that there was a merger of law firms. Specifically, the New York office of Graham & James, LLP merged with the firm of Greenberg Traurig, LLP, on July 17, 2000, and each law firm had a different docketing system. It is stated that in transferring cases from the Graham & James, LLP docketing system to the Greenberg Traurig, LLP docketing system, the instant merged reexamination proceeding was, through inadvertence, "not properly transferred."

Initially, it is unclear what happened with regard to the transfer of the merged proceeding to the Greenberg Traurig, LLP docketing system, i.e., what is meant by "not properly transferred?" Was it not docketed into the Greenberg Traurig, LLP docketing system at all, or was it transferred, but docketed improperly? If improperly docketed, what was the nature of the improper docketing, and how did it contribute to the delay in filing the Appeal Brief? Was the merged reexamination proceeding docketed in the Graham & James, LLP docketing system prior to July 17, 2000, and if so, did it remain in their system subsequent to the July 17, 2000, merger of the law firms? If it remained in their system, how long after the merger of July 17, 2000, did it remain in their docketing system, and why did the docketing system fail to notify the Graham & James, LLP, law firm that an action was due (so that Graham & James, LLP, could notify the Greenberg Traurig, LLP)? It is noted that a number of papers were filed by patent owner in the merged proceeding between August 24, 2000 and January 31, 2001. Since these papers were filed subsequent to the merger of the law firms, which docketing system were they entered into ? Clarification of such details should be presented in any renewed petition based upon unavoidable delay. This clarification should be accompanied by supporting statements from the appropriate parties having knowledge of this information bearing on the above inquiries. These parties would appear to include those responsible in the docketing departments of the two firms for transferring the docketing information from the Graham & James, LLP, and receiving and entering it for the Greenberg Traurig, LLP.

It is required that a showing be provided which sets forth the entirety of the facts surrounding the delay in filing the Appeal Brief. Such showing must explain what Greenberg Traurig, LLP did with the merged reexamination proceeding, and why the firm did not provide a timely Appeal Brief. A statement is in order from the Greenberg Traurig, LLP staff responsible for processing and docketing the cases transferred from the Graham & James, LLP, to address this matter in detail.

The showing should include copies of any records including docket reports for the two docketing systems referred to in the petition, relevant to the time period in question, with supporting statements. Additionally, a copy of the file jacket for the merged reexamination proceeding is in order to show any annotation as to the transfer of the merged file between the two firms. Specifically, copies of the docket records should be provided showing when the last Office communication (prior to the merger of the law firms) with regard to the merged reexamination proceeding was entered into the Graham & James, LLP, docketing system, and how the merged proceeding was handled in their docketing system subsequent to the July 17, 2000, merger of the

two law firms. Further, copies of the docket records from the Greenberg Traurig, LLP docketing system should be provided, showing where the merged reexamination proceeding entries would have appeared if they had been properly transferred into that system subsequent to the July 17, 2000, merger of the law firms, and where/how they appeared once the problem was identified and such merged proceeding was properly transferred into their docketing system.

It should be clarified that the time period in question is the period of time between the last Office communications mailed to patent owner prior to the July 17, 2000, merger of the law firms, i.e., the decision merging reexamination proceedings of June 29, 2000, and the final rejection of June 30, 2000, and the filing of the instant petition and Appeal Brief on January 31, 2001. Therefore, with regard to petitioner's assertion that a docketing error was the cause of delay in filing the Appeal Brief, the showing provided is incomplete as to substantiating a docketing error, and the present petition is inadequate to establish a case of unavoidable delay within the meaning of the statute. It is noted that a request for extension of time was filed on August 24, 2000, i.e., after the July 17, 2000, merger of the law firms. Any renewed petition based upon unavoidable delay which is filed should explain how this request for extension of time came to be filed in view of the statement in the petition that the present file was not properly transferred to the Greenberg Traurig, LLP docketing system. Also, when making the request for the extension of time, why was the improper transfer not corrected, and what docketing was carried out when making the request for extension of time?

Any response to this petition decision to establish the cause of unavoidable delay must comply with the following:

As noted in MPEP 711.03(c)§(III)(2), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable delay", provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See *In re* Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds *sub nom* Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); *In re* Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

Petitioner's showing currently fails to meet criteria (A),(B) and (C) above. The showing fails to adequately evidence the error was the cause of the delay at issue; there was a business routine for ensuring that USPTO correspondence was properly received, docketed and forwarded; and that the personnel were sufficiently trained in docketing due dates for reexamination proceedings such that petitioner was prudent in relying upon the personnel. The nature and extent of training provided to the personnel should be set forth, with respect to the docketing and monitoring of reexamination cases. As a final point, any renewed petition based upon unavoidable delay should point out the nature of the precautions taken by appropriate parties in the transfer of cases from the system of one firm to the other, which would address problems such as the improper transfer of the present case which is referred to in the present petition.

For the reasons set forth above, the petition is **dismissed**.

ALTERNATIVE OPTION

Petition based on unintentional delay:

Petitioner may wish to consider the filing of a petition under 37 C.F.R. § 1.137(b) if the delay in filing the Appeal Brief of January 31, 2001, was unintentional. The unintentional delay fee provisions of 35 U.S.C. § 41(a)(7) have been imported into, and are applicable to, all *ex parte* reexamination proceedings by Sec. 4605 of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 C.F.R. § 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the entire delay from the due date for the response to the filing of a grantable petition was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 C.F.R. § 1.17(m).

CONCLUSION

1. The petition is **dismissed**.

2. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision.

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

4. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

March 2, 2001

#26 (mar.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 26

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(For Patent Owner)

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233 South Wacker Drive
Chicago, IL 60606

(For Requester)

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APR 0 5 2001
REEXAM UNIT

DO NOT USE IN PALM PRINTER

In re Reexamination Proceeding :
Control No. 90/005,314 :
Filed: April 5, 1999 :
For: U.S. Patent No. 4,844,723 :
Patentee: Tellini, et al. :

In re Reexamination Proceeding :
Control No. 90/005,689 :
Filed: March 31, 2000 :
For: U.S. Patent No. 4,844,723 :
Patentee: Tellini, et al. :

DECISION GRANTING PETITION

This is a decision on the March 19, 2001, patent owner PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present merged reexamination proceedings and revival of the merged proceedings under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

DECISION

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The appeal brief filed in response to the notice of appeal of October 5, 2000, was received on January 31, 2001, and therefore is already of record. A single petition fee under 37 C.F.R. § 1.17(m) of $1240.00 for the merged proceeding has been charged to Deposit Account No. 501561, as per petitioner's instructions on page 1 of the instant petition. In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 1700 for consideration of the appeal brief of January 31, 2001.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the examiner, Richard Chiesa in Technology Center Art Unit 1724.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

April 5, 2001

90005314.031901

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 22

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In re Ekchian et al.
Reexamination Proceeding
Control No. 90/005,315
Filed: April 6, 1999
For: U.S. Patent No. 4,624,140

In re Ekchian et al.
Reexamination Proceeding
Control No. 90/004,635
Filed: May 15, 1997
For: U.S. Patent No. 4,624,140

In re Ekchian et al.
Reexamination Proceeding
Control No. 90/005,504
Filed: September 24, 1999
For: U.S. Patent No. 4,624,140

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above-identified reexamination files are before the Director of Technology Center 2800 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 4,624,635 issued on November 25, 1986.

2. A first request for reexamination, Control No. 90/004,635, was filed by a third party requester on May 15, 1997.

3. Reexamination was ordered in the '4635 reexamination proceeding on July 2, 1997.

4. A first Office action was mailed on December 23, 1998 to an incorrect correspondence address.

5. The first Office action was remailed on January 13, 1999.

6. A response to the first Office action was filed on March 15, 1999.

7. A second request for reexamination, Control No. 90/005,315, was filed by the same third party requester on April 6, 1999.

8. Reexamination was ordered in the '5315 reexamination proceeding on June 22, 1999.

9. A waiver of patent owner's statement under 37 CFR § 1.530(b) was filed in the '5315 reexamination on July 14, 1999 along with an updated litigation status related to the patent under reexamination.

10. A decision merging the '4635 and the '5315 reexamination proceedings was mailed on August 11, 1999.

11. A non-final Office action was mailed on September 10, 1999 setting a two-month time period for filing a response.

12. A third request for reexamination, Control No. 90/005,504, was by a second third party

requester on September 24, 1999.

13. A response to the non-final Office action was filed on November 10, 1999 for the '4635 and '5315 reexamination proceedings with claims 1, 9-11 and 40 being amended and new claims 43-47 presented.

14. Reexamination was ordered in the '5504 reexamination proceeding on November 19, 1999.

DISCUSSION

Under 37 CFR § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565© is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 CFR § 1.565(c), the '4635, '5315 and '5504 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Three Proceedings.

As noted above, claims 1, 9-11 and 40 have been amended and claims 43-47 were newly presented in the '4635 and '5315 reexamination proceedings. Patent owner is required to maintain the same claims and specification in all three files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all three files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 CFR § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all three proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all three files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

Application/Control Number: 90/005,315

CONCLUSION

Reexamination Control Nos. 90/004,635, 90/005,315 and 90/005,504 are merged. The reexamination files are being returned to the Central Reexamination files where they await the "housekeeping" amendment from the patent owner.

Janice A. Howell, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Arent Fox Kintner Plotkin & Kahn, PLLC (For Patent Owner)
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Martin L. Katz (For Requester)
Rockey, Milnamow and Katz Ltd.
180 North. Stetson, Suite 4700
Chicago, IL 60601

Enclosures: (1) Copy of petition papers filed by patent owner on November 28, 2000.

(2) Copy of Notice of Appeal filed by patent owner on July 28, 2000.

MAILED
MAR 2 3 2001
REEXAM UNIT

In re Hayashi et al :
Reexamination Proceeding : **DECISION**
Control No. 90/005,318 : **DISMISSING**
Filed: April 6, 1999 : **PETITIONS**
For: U.S. Patent No. 5,134,028 :

This is a decision on the November 28, 2000, patent owner PETITION TO REVIVE APPLICATION UNDER 37 CFR 1.137, which is taken as a petition for entry of belated papers under 37 CFR 1.137. The petition requests relief under 37 CFR 1.137(a) based upon unavoidable delay, or alternatively under 37 CFR 1.137(b) based upon unintentional delay. The petition, which is in effect two petitions, is before the Office of Patent Legal Administration for decision.

The petition under 37 CFR 1.137(a) is **dismissed.**

The petition under 37 CFR 1.137(b) is **dismissed.**

Any request for reconsideration of this decision must be submitted within ONE (1) MONTH from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are not permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

DECISION ON PETITION UNDER 37 CFR 1.137(a)

A grantable petition for entry of belated papers under 37 CFR 1.137(a) must be accompanied (1) by an adequate showing of the cause of unavoidable delay, (2) by the proposed response to the outstanding Office action, and (3) by the petition fee (set in 37 CFR 1.17(l)) required by law.

As to item (3), the petition fee under 37 CFR 1.17(l) of $110.00, has been charged to petitioner's deposit account number 01-2300 as per petitioner's instructions on page 2 of the present petition.

The present petition under 37 CFR 1.137(a) lacks items (1) and (2) above.

Item (2): On July 28, 2000, patent owner filed a Notice of Appeal in the reexamination proceeding. The reexamination proceeding terminated after September 28, 2000, for failure to file a brief within the time period set by 37 CFR 1.192(a). Accordingly, the proposed response required for consideration of the petition for entry of belated papers under 37 CFR 1.137(a) must be three copies of a brief complying with 37 CFR 1.192 and the fee required by 37 CFR 1.17(c). It should be noted that although the petition indicates that the examiner intended to allow the proceeding (as will be discussed below), there is nothing in the present record to support the indication in the petition that the proceeding is in condition for "allowance." Accordingly, the appeal brief is required.

Item (1): With respect to the showing of unavoidable delay set forth in the petition, MPEP 711.03(c) states as follows[1] [emphasis added in bold]:

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[1] See revision 1, February 2000, the paragraph bridging pages 700-94 and 700-95.

"Delay resulting from the lack of knowledge or **improper application** of the patent statute, rules of practice or the MPEP, however, does not constitute 'unavoidable' delay. *See Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891). For example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, **a delay is not 'unavoidable' when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action.** Likewise, as a 'reasonably prudent person' would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the PTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant's failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute 'unavoidable' delay. *See Krahn*, 15 USPQ2d at 1825. Finally, **a delay caused by an applicant's** lack of knowledge or **improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from PTO employees**; or (B) the PTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. *See In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985)."

The present petition states, at page 2, that "[d]uring a telephone interview of Examiner Foelak in August 2000, Examiner Foelak told applicant's counsel that he was ready to allow the application pending an approval from a Special Program Examiner." The petition goes on to state that "[d]uring the telephone interview of September 21, 2000, Examiner Foelak told applicant's counsel that the Special Program Examiner indicated that the application was ready for allowance and that Examiner Foelak should prepare the necessary paper work for the allowance." The petition then points out that (during the September 21, interview) the examiner told counsel that he would prepare the allowance paper work shortly. It is further indicated that counsel relied upon the examiner's statements and thus did not request "the additional time so that the allowance paper work could be completed on time."

With respect to this argument, 37 CFR 1.2 states:

"All business with the Patent and Trademark Office should be transacted in writing..... The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

Thus, it was not prudent for patent owner to have relied upon the examiner's oral statements. No interview summary form has been found of record as to either of the telephone interviews (referred to in the petition) which indicates that the proceeding was ready for allowance. Further, there is nothing else of record to support the statements in the petition that the case was indicated by the examiner to be in condition for allowance. To the contrary, there is a status letter in the file dated November 1, 2000, stating that "[d]uring a telephone interview on September 21, 2000, Examiner Foelak said that an official decision on the reexamination would be forthcoming shortly. However, to date no official action or Notice of Allowance has been received." This letter indicates that a decision was shortly to be made, and it might be an Office action or it might be a Notice of Allowance. This status letter does not indicate that patent owner had been informed the case was to be allowed.

Patent owner could have requested issuance (mailing or hand delivery to a "local" representative of patent owner) of an interview summary form indicating that the proceeding was ready for allowance. This would have provided a written record of the allowance. Patent owner could have requested an extension of time pursuant to 37 CFR 1.550(c) before the due date of the appeal brief, referring to the examiner's oral statements of allowance and requesting a sufficient time extension until the examiner would prepare and mail the allowance papers. Patent owner chose to exercise neither of these two options.

As pointed out in the above-cited portion of MPEP 711.03(c), the delay is not unavoidable when, as in the present instance, the patent owner simply permits the time for action to expire while awaiting a notice of allowance of the case. Such inaction is an improper application of the patent rules and the MPEP, and the delay caused by patent owner's improper application of the patent rules and the MPEP is not rendered "unavoidable" due to the patent owner's reliance upon oral advice from USPTO employees.

Accordingly, the showing of unavoidable delay set forth in the petition is not persuasive.

DECISION ON PETITION UNDER 37 CFR 1.137(b)

A grantable petition for entry of belated papers under 37 CFR 1.137(b) must be accompanied by (1) a proper statement that the entire delay from the due date for the response to the filing of a grantable petition was unintentional, (2) by the proposed response to the outstanding Office action, and (3) by the petition fee (set in 37 CFR 1.17(m)) required by law. The present petition lacks item (2) above.

As to item (3), a petition fee under 37 CFR 1.17(m) of $1240.00, has been charged to petitioner's deposit account number 01-2300 as per petitioner's instructions on page 2 of the present petition.

As to item (1), proper statement has been made at page 2 of the petition that the entire delay from the due date for the response to the filing of a grantable petition was unintentional.

The petition under 37 CFR 1.137(b) is, however, incomplete as to item (2) because the required proposed response to the outstanding Office action has not been submitted, as discussed above. If petitioner will submit three copies of a brief complying with 37 CFR 1.192 and the fee required by 37 CFR 1.17(c), the petition under 37 CFR 1.137(b) will be granted and the proceeding restored to pending status.

SERVICE OF COPIES

37 CFR 1.550(f) states as follows:

> After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

The requisite proof of service on third party requester was not included with the instant petition papers, nor with the Notice of Appeal filed by patent owner on July 28, 2000.

Since there is no indication that the third party requester was provided with a copy of the papers, a copy of the instant petition papers and a copy of the Notice of Appeal are being provided to the third party requester with this decision.

Any future communications filed by patent owner in this proceeding, however, must include proof of service on the third party requester in accordance with 37 CFR 1.550(f).

EXTENSIONS OF TIME

Petitioner included a petition for extension of time to file the Appeal Brief (a) on December 27, 2000, and (b) with the present petition. The question of granting an extension of time is not, however, ripe for consideration, since the present reexamination proceeding is not pending. If the proceeding is restored to pending status, then questions as to the granting of an extension(s) of time can be considered. Accordingly, the petitions for extension of time are dismissed as not being applicable. In the present instance, however, the petitions for extension of time have no bearing on the granting or not granting of the petition. As pointed out above, the statement made at page 2 of the petition that the entire delay from the due date for the response to the filing of a grantable petition was unintentional *is sufficient* for the purposes of the petition under 37 CFR 1.137(b).

It should be noted, however, that the submitted petitions for extension of time appear to be styled as extensions of time under 37 CFR 1.136(a). It is thus pointed out that extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings; but rather extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). **Any request for extension of time must be filed** on or before the day on which action by the patent owner is due, **and will be granted only** upon a presentation of "sufficient cause" for the extension and "for a reasonable time specified."

CONCLUSION

1. The petition under 37 CFR 1.137(a) is **dismissed.**

2. The petition under 37 CFR 1.137(b) is **dismissed.**

3. **The submission of three copies of a brief complying with 37 CFR 1.192 and the fee pursuant to 37 CFR 1.17(c) is required for the granting of the present petition.** If petitioner desires to make the required submission in order that the present petition be granted, the submission should be included in a cover letter entitled **"Renewed Petition under 37 CFR 1.137(b)."**

4. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision.

5. Further correspondence with respect to this matter should be addressed as follows:

   By mail: Assistant Commissioner for Patents
   Box DAC
   Washington, D.C. 20231

   By FAX: (703) 308-6916
   Attn: Office of Petitions

   By hand: Crystal Plaza Four, Suite 3C23
   2201 South Clark Place
   Arlington, VA

6. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-6710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

March 21, 2001
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Chicago, IL 60601

In re Hayashi et al	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/005,318	:	**GRANTING**
Filed: April 6, 1999	:	**PETITION**
For: U.S. Patent No. 5,134,028	:	

This is a decision on the April 23, 2001, patent owner RENEWED PETITION UNDER 37 CFR 1.137(b) for entry of late papers on the grounds of unintentional delay. The present renewed petition is before the Office of Patent Legal Administration for decision.

The petition under 37 CFR 1.137(b) is **granted.**

The March 23, 2000, decision on petition found that the November 28, 2000, petition under 37 CFR 1.137(b) was incomplete because the required proposed response to the outstanding Office action had not been submitted. Accompanying the present petition are three copies of patent owner's brief on appeal and the fee required by 37 CFR 1.17(c). The petition under 37 CFR 1.137(b) is now complete, and the petition is **granted.**

The file is being forwarded to Technology Center 1700.

Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-6710.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

May 1, 2001
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UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 18

Roy Hopgood and Stephen Judlowe
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(For Patent Owner)

MAR - 8 2002

Charles W. Hanor
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San Antonio TX 78205

(For Requester)

Reexamination Proceeding
Control No.: 90/003,489
Filed : July 11, 1994
For : U.S. Patent No. 4,721,101

Reexamination Proceeding
Control No.: 90/003,990
Filed : October 4, 1995
For : U.S. Patent No. 4,721,101

Reexamination Proceeding
Control No.: 90/005,329
Filed : April 13, 1999
For : U.S. Patent No. 4,721,101

DECISION MERGING REEXAMINATION

The above reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565 (c).

Reexamination in 90/003,489 was ordered in a decision mailed September 28, 1994 and remailed December 22, 1994. Reexamination in 90/003,990 was ordered in a decision mailed December 13, 1995. Reexaminations 90/003,489 and 90/003,990 were merged in a letter mailed February 1, 1996. Reexamination in 90/005,329 was ordered June 23, 1999

Further merger is proper if a reexamination is ordered while prior merged reexamination proceedings are pending. In view of the above, merger of 90/005,329 with the already merged proceedings of 90/003,489 and 90/003,990, is appropriate and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims (and claim numbering) in all files. In anticipation of a merger, Patent owner filed a preliminary amendment on May 4, 2001 to place the file in reexamination control No. 90/005,329 as reexamination file 90/003,489 and 90/003,990 currently stand. The amendment has been entered.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action that applies to all reexamination files. The action will contain identifying data for all files and will be physically entered in all reexamination files. Any response filed by the patent Owner must consist of a single response filed with two copies, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See 37 CFR 1.550(e).

Disposition of Petition filed May 4, 2001

Patent Owner filed on May 4, 2001, a petition to the Commissioner under 37 CFR 1.181 or 1.182 for an order vacating the order granting reexamination per control No. 90/005,329, or, in the alternative, for an order mandating accelerated action in said reexamination. On February 28, 2002, Patent Owner filed a letter withdrawing the petition filed May 4, 2001. Accordingly, in view of the request filed February 28, 2002, the petition of May 4, 2001 is considered withdrawn.

Upon the mailing of this decision, the reexamination file will be forwarded to the examiner for the prompt issuance of an action.

John E. Kittle, Director
Technology Center 3700
Phone: (703) 308-0873

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No. 15

Stephen J. Schultz
WATTS, HOFFMANN, FISHER & HEINKE
1100 Superior Ave., Suite 1750
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(For Patent Owner)

MAILED
OCT 12 2000
GROUP 2500

Paul Devinsky
McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, D.C. 20005-3096

(For Requester)

90005336, 90005731

In re Hilton F. Glavish et al.
Reexamination Proceeding
Control No. 90/005,731
Filed: May 18, 2000
For U.S. Patent No. 4,667,111

In re Hilton F. Glavish et al.
Reexamination Proceeding
Control No. 90/005,336
Filed: April 22, 1999
For U.S. Patent No. 4,667,111

DECISION MERGING REEXAMINATION PROCEEDINGS

The above-identified reexamination files are before the director of Examining Group 2870, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 4,667,111 issued on May 19, 1987

2. A first request for reexamination, Control No. 90/005,336 was filed by a third party requester on April 22, 1999.

3. Reexamination was ordered in the '5370 reexamination proceeding on May 19, 1999.

4. An Office action was mailed January 5, 2000, rejecting all the claims of the patent under reexamination.

5. An amendment was filed March 21, 2000 canceling claims 2, 8 and 15, amending claims 3-7, 10 and 17, and adding new claims 18-32.

6. A second request for reexamination, Control No. 90/005,731 was filed by the same third party requester on May 18, 2000.

7. A Notice of Intent to Issue Reexamination Certificate was mailed June 22, 2000.

5. Reexamination was ordered in the '5731 reexamination proceeding on August 11, 2000.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is

appropriate.

DECISION

Because the '5731 reexamination was ordered based on prior publications not yet considered by the examiner, it is necessary to vacate the Notice of Intent to Issue Reexamination Certificate. The Notice of Intent to Issue Reexamination Certificate mailed June 22, 2000 in the '5336 reexamination is hereby vacated.

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '5336 and '5731 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in Both Proceedings.

As noted above, the claims have been amended in the '5336 reexamination proceeding. Patent owner is required to maintain the same claims and specification in both files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each

bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. '5336 and '5731 are merged. The reexamination files are being returned to the Central Reexamination Files where they await the "housekeeping" amendment from the patent owner.

Henry S Pham for

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Stephan J. Schultz
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Cleveland, Ohio 44114

(For Patent Owner)

#20

Paul Devinsky
McDermott, Will & Emery
600 13th Street, N.W.
Washington, D.C. 20005-3096

(For Requester)

MAILED

JAN 3 0 2001

REEXAM UNIT

In re Reexamination of U.S. Patent No. 4,667,111 to Glavish et al.
Control No. 90/005,731
Filed: May 18, 2000

In re Reexamination of U.S. Patent No. 4,667,111 to Glavish et al.
Control No. 90/005,336
Filed: April 22, 1999

DECISION GRANTING-IN-PART & DISMISSING-IN-PART PETITION

This is a decision on the patent owner petition under 37 CFR 1.182, filed December 21, 2000, requesting (1) that the examiner's "Statement of Reasons for Patentability and/or Confirmation" be reconsidered and (2) that petitioner's proposed "Examiner's Amendment" to correct the examiner's Statement of Reasons for Patentability and/or Confirmation be entered and considered.

The petition fee under 37 CFR § 1.17(h) of $130.00 has been charged to petitioner's deposit account, as per petitioner's instructions on page 3 of the petition.

The petition is before the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

The petition is **granted-in-part** and **dismissed-in-part**, for the reasons set forth below.

THE PETITION

The present petition is for a grant of relief in a situation not specifically provided for in the regulations. It is requested that:

(1) the examiner's Statement of Reasons for Patentability and/or Confirmation be reconsidered, and

(2) petitioner's proposed "Examiner's Amendment" (submitted with the petition) to correct the examiner's Statement be entered and considered.

This is, in effect, a request to withdraw the Notice of Intent to Issue Reexamination Certificate in the proceeding to reopen prosecution and consider patent owner's comments on the examiner's "Statement of Reasons for Patentability and/or Confirmation."

The record reveals that the examiner correctly terminated the examination in the proceeding via a Notice of Intent to Issue Reexamination Certificate (NIRC). Petitioner, however, urges that prosecution should be reopened due to "errors" in the examiner's Statement of Reasons for Patentability and/or Confirmation. Petitioner argues that the examiner's statement should be amended as per the proposed "Examiner's Amendment" to correct the examiner's statement, in order to avoid the effects of estoppel that would result from the examiner's statement as it presently exists. The petition states (at page 10) that "[f]airness mandates that the Patent Owner not be placed in a position of disadvantage at the starting line" when a "simple Examiner's amendment" will suffice.

DECISION

Petitioner's proposed "Examiner's Amendment" (accompanying the petition) to correct the examiner's Statement of Reasons for Patentability and/or Confirmation is, in actuality, a presentation of patent owner's **comments** on the Statement and Reasons for Patentability and/or Confirmation. There is, however, no provision in the statute or rules for reopening a reexamination proceeding and withdrawing a NIRC to permit

consideration of a patent owner's Comments on Statement and Reasons for Patentability and/or Confirmation. As pointed out in MPEP 1302.14, "comments made by applicants on the examiner's statement of reasons for allowance will not be returned to the examiner after their entry in the file and will not be commented upon by the examiner." (MPEP Page 1300-10 of Rev.1, Feb. 2000, column 1.) Thus, there would be no reason to reopen prosecution, since the patent owner's comments will not be considered in any event.

Patent owner's submission has been made of record in the present proceeding as comments on the examiner's Statement of Reasons for Patentability and/or Confirmation, and thus, both the patent owner's statement as to reasons for patentability, and those of the examiner, will be available as part of the record of the reexamination proceeding.

37 CFR 1.104(e) states:

> The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication.

Thus, the failure of the examiner to comment upon Patent Owner's submission (which has been entered into the record) does not give rise to any negative inference, and a court will be free to view what the examiner presented as the reasons for patentability and what Patent Owner believes to be an appropriate revision of same.

In view of the above, the relief requested as to reconsideration of the Statement and Reasons for Patentability and/or Confirmation will not be granted. Also, the "entry" of petitioner's proposed "Examiner's Amendment" to correct the examiner's Statement will not be granted. The Patent Owner's submission, however, will be entered into the record as Comments on the Statement of Reasons for Patentability and/or Confirmation.

CONCLUSION

1. The petition is GRANTED as to entry of the Patent Owner's submission into the record in the present merged reexamination proceeding as Comments on the examiner's Statement of Reasons for Patentability and/or Confirmation.

2. The petition is DISMISSED as to the request for reconsideration of the examiner's Statement of Reasons for Patentability and/or Confirmation and as to the request for "entry" of petitioner's proposed "Examiner's Amendment" to correct the examiner's Statement.

3. The reexamination files of the merged proceeding will be fowarded for issuance of a reexamination certificate.

4. Telephone inquiries related to this decision should be directed to the undersigned at (703) 308-6710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

January 29, 2001
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DO NOT ENTER

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D C 20231
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ANTONELLI TERRY STOUT AND KRAUS (For Patent Owner)
1300 NORTH 17TH STREET SUITE 1800
ARLINGTON , VA 22209

In re Reexamination Proceeding	:	
Control No. 90/005,340	:	DECISION
Ordered by USPTO: May 25, 1999	:	DISMISSING
For: U.S. Patent No. 5,612,686	:	PETITION
Patentee: Takano, et al.	:	

This is a decision on the *unsigned* patent owner petition under 35 U.S.C. 133, filed March 3, 2000, and supplemented on September 20, 2000, with a *signed copy*. The petition is for entry of late papers (a belated response to an Office action) on the grounds of unavoidable delay. See MPEP 2268. The petition fee under 37 CFR § 1.17(l) of $110.00 has been charged to petitioner's deposit account # 01-2135, as per petitioner's instructions on page 4 of the petition. The petition is before the Office of Patent Legal Administration for decision.

The present petition under 35 U.S.C. 133 for the entry of late papers is **dismissed** for the reasons pointed out below.

Any request for reconsideration of the decision on the petition under 35 U.S.C. 133 must be submitted within ONE (1) MONTH from the mail date of this decision. An extension of time may be requested only under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are **not** available in reexamination proceedings. Any reconsideration request which is submitted should include a cover letter entitled "Renewed Petition under 35 U.S.C. 133."

DECISION

A grantable petition for entry of belated papers under 35 U.S.C. 133 must be accompanied by (1) an adequate showing of the cause of unavoidable delay, (2) the proposed response to the outstanding Office action, and (3) the petition fee required by law. This petition lacks item (1) above.

This reexamination proceeding terminated after January 6, 2000, for failure to timely file a response to the non-final Office action of November 5, 1999, which set a shortened statutory period for response of two (2) months, and noted that extensions of time were governed by 37 CFR 1.550(c).

With regard to the showing of the cause of unavoidable delay in responding to the Office action, the present petition states that the reexamination status of the present proceeding was not carried forward when a "new docketing system" was put in place. The petition explains that this resulted in the failure to properly annotate the Office action of November 5, 1999, as a reexamination when it was received by the attorney's office. This in turn caused the docketing department to transfer the Office action to the attorney's secretary for "normal processing."

The showing of the cause of unavoidable delay is incomplete. A showing which sets forth the facts surrounding the delay in responding must be provided. Statements from all persons responsible for the entire delay from the time of termination of the reexamination proceeding to the filing of the present petition are required. If a showing is made by a person not registered to practice before the United States Patent and Trademark Office (USPTO), the statement must be verified by way of affidavit or declaration according to 37 CFR 1.68.

Accordingly, a statement is required from the appropriate person who performed the docket change-over, describing the inadvertency in failing to carry over the reexamination status of the present proceeding to the "new docketing system." How did it occur? In addition, a statement is in order from the appropriate person in the docketing department that processed the newly received Office action and then transferred it to the attorney's secretary, as well as a statement from the secretary, as to his/her knowledge of the cause of the delay in responding to the Office action.

Petitioner should provide copies of docket records showing the identification of the present proceeding as a reexamination in the old docketing system, and showing no identification of the proceeding as a reexamination in the new docketing system. This showing would include verified copies of any docket sheets, file wrappers and any other records as may exist which would show the identification as a reexamination in the old system and lack thereof in the new system, with the appropriate supporting statements being provided.

As the showing of the cause of unavoidable delay is incomplete, the present petition is inadequate to establish a case of unavoidable delay within the meaning of the statute. Accordingly, the petition is **dismissed**.

ALTERNATIVE OPTION

Petition based on unintentional delay: Petitioner may wish to consider the filing of a petition under 37 CFR 1.137(b) if the delay in filing the proposed amendment of March 3, 2000, was unintentional. The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) have been imported into, and are applicable to, all *ex parte* reexamination proceedings by Section 4605 of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed in response to an Office action subsequent to the order for reexamination. Any such petition must provide (1) a verified statement that *the entire delay from the due date for the response to the filing of a grantable petition was unintentional*, (2) a proposed response to continue prosecution (unless it has been previously filed), and (3) the petition fee required by 37 CFR 1.17(m). In the present instance, a proposed response to continue prosecution is already of record (i.e., the proposed amendment of March 3, 2000), and it need not be resubmitted.

CONCLUSION

1. The petition is **dismissed**.

2. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision.

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 305-1013
Attn: Office of Patent Legal Administration

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

4. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-6710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

February 8, 2000
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Reexamination

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 10

ANTONELLI, TERRY, STOUT & KRAUS
1300 North 17th Street
Suite 1800
Arlington, VA 22209

(For Patent Owner)

MAILED

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REEXAM UNIT

In re Takano et al.
Reexamination Proceeding
Control No. 90/005,340
Ordered by USPTO: May 25, 1999
For: U.S. Patent No. 5,612,686

DECISION
GRANTING
PETITION

This is a decision on the March 8, 2001, patent owner PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

DECISION

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by

37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The proposed amendment filed in response to the non-final rejection of November 5, 1999, was received on March 3, 2000, and therefore is already of record. The instant petition is accompanied by the petition fee under 37 C.F.R. § 1.17(m). In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 2600 for consideration of the amendment of March 3, 2000.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the examiner, Brent Swarthout in Technology Center Art Unit 2632.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

April 5, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D C 20231
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Vito J. BeBari (For Patent Owner)
KRAMER LEVIN NAFTALIS AND FRANKEL
919 THIRD AVENUE
NEW YORK, NY 10022

MAILED
AUG 2 2 2002
REEXAM UNIT

Gregory L. Bradley (For Requester)
MEDRAD, INC.
ONE MEDRAD DRIVE
INDIANOLA, PA 15051

Decision Mailed

In re Heffernan et al.
Reexamination Proceeding
Control No. 90/004,870
Filed: December 12, 1997
For: U.S. Patent No. 5,620,425

In re Heffernan et al.
Reexamination Proceeding
Control No. 90/005,344
Filed: April 26, 1999
For: U.S. Patent No. 5,620,425

DECISION GRANTING PETITION UNDER 37 CFR 1.137(b)

This is a decision on the August 9, 2002, patent owner PETITION UNDER 37 C.F.R. § 1.137(b) TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION, requesting revival of the present proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $1280 for a petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 50-0540, in accordance with petitioner's authorization in the last paragraph of the present petition. See 37 CFR 1.17(m).

The petition is granted.

DECISION

1. The statement of unintentional delay presented in the petition is:

> "The entire delay in filing the required Notice of Appeal from the due date for the Notice of Appeal through the mailing date of this Petition was unintentional."

Effective December 1, 1997, 37 CFR 1.137(b)(3) requires the submission of a statement that "the entire delay in filing the required reply from the due date for the reply until **the filing** of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" [Emphasis added] The above-quoted statement does not comply with the current rule. However, the statement presented will be accepted and so construed. If this is an incorrect interpretation in view of the rules, petitioner is required to promptly provide a statement to that effect.

2. An appropriate response to the outstanding Office action has been received, i.e., the August 9, 2002, Notice of Appeal, containing authorization therein to charge the appeal fee under 37 CFR 1.17(b), which has been filed as an attachment to the present petition.

3. The instant petition is accompanied by a statement that has been accepted and construed as an appropriate statement pursuant to 37 CFR 1.137(b)(3), and by a response to the outstanding Office action. Further, payment of the required petition fee has been authorized. Accordingly, the petition is granted.

REINSTATEMENT OF MERGER

The present '4,870 and '5,344 reexamination proceedings are restored to pendency as a result of the granting of patent owner's petition in this decision. Accordingly, the merger of the two proceedings of the November 30, 1999, decision is hereby reinstated, and the merged proceeding will be conducted as stated in that decision.

PATENT OWNER FURTHER ACTION IN THE PROCEEDING

It is to be noted that a 2-month period for filing the appeal brief and fee is set below to run from the date of mailing of this decision. The patent owner cannot rely on the "Amendment Under 37 C.F.R. §1.116" submitted with the present petition to keep the present proceeding pending beyond that 2-month period. Pursuant to 37 CFR 1.116(b), "[t]he admission of, or refusal to admit, any amendment after a final rejection...will not operate to relieve the...patent under reexamination from its condition as subject to appeal or to save ...the reexamination from termination." Thus, it is patent owner's responsibility to take any steps needed to keep the present proceeding pending.

CONCLUSION

1. The petition is **granted**, and the merger of the '4,870 and '5,344 reexamination proceedings is reinstated.

2. THE 2-MONTH PERIOD FOR FILING THE APPEAL BRIEF, IN TRIPLICATE, ACCOMPANIED BY THE FEE REQUIRED BY LAW, RUNS FROM THE DATE OF THIS MAILING.

3. The reexamination file is being returned to Technology Center 3700 for the examiner's review of the "Amendment Under 37 C.F.R. §1.116" received with the petition, and issuance of an action advising patent owner of the status of the merged proceeding as a result of that amendment.

4. Any further communications as to the merits of the proceeding should be directed to the primary examiner, Anh-Tuan T. Nguyen, in Technology Center 3763.

5. Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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Application/Control Number: 90/005,344

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
5	10/28/99	58[illegible]	

MM21/0420

BRIAN SIFFERY ESQ
PILLSBURY MADISON & SUTRO LLP
1100 NEW YORK AVENUE NW
WASHINGTON DC 20005-3918

EXAMINER
[illegible]

ART UNIT	PAPER NUMBER
[illegible]	8

DATE MAILED: [illegible]

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
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Washington, D C 20231

Paper No. 8

PILLSBURY, MADISON & SUTRO (For Patent Owner)
1100 New York Avenue, N.W.
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Jacqueline E. Hart (For Requester)
ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST
225 South Orange Avenue, Suite 1401
P.O. Box 3791
Orlando, Florida 32802

In re Alf Petersen et al.	:	
Reexamination Proceeding	:	
Control No. 90/005,519	:	
Filed: September 28, 1999	:	
For U.S. Patent No. 5,805,287	:	DECISION MERGING
	:	REEXAMINATION
	:	PROCEEDINGS
In re Alf Petersen et al.	:	
Reexamination Proceeding	:	
Control No. 90/005,5,370	:	
Filed: May 25, 1999	:	
For U.S. Patent No. 5,805,287	:	

The above-identified reexamination files are before the director of Examining Group 2870, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,805,287 issued on September 8, 1998.

2. A first request for reexamination, Control No. 90/005,370 was filed by a third party requester on May 25, 1999.

3. Reexamination was ordered in the '5370 reexamination proceeding on July 20, 1999.

4. A preliminary amendment was submitted with the filing of the request for reexamination amending column 3, line 21 of the patent specification[1].

5. A second request for reexamination, Control No. 90/005,519 was filed by the patent owner on September 28, 1999.

5. Reexamination was ordered in the '5519 reexamination proceeding on January 18, 2000.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

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[1] It is noted that the amendment was improper because it does not comply with 37 C.F.R. § 1.121(c) and 37 C.F.R. § 1.530(d)(1)(I) requiring that the entire paragraph where the change is made be rewritten.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '5370 and '5519 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in Both Proceedings.

As noted above, the specification has been amended in the '5370 reexamination proceeding. Patent owner is required to maintain the same claims and specification in both files. Since the amendment has not been entered because the entire paragraph where the change is to be made was not rewritten and the proposed change does not appear to affect the merits of the patent, it is suggested that the amendment be submitted in proper format in both reexamination proceedings in response to a first Office action to be issued by the examiner.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. '5370 and '5519 are merged. The reexamination files are being forwarded to the examiner for reexamination and issuing an Office action.

Henry Phan for

Janice A. Howell, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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Office of the Director
Group 3600

Reexamination Control No. 90/005,372

Paper No. 14

FOR PATENT OWNER:

Joseph L. Strabala
LAW OFFICES OF JOSEPH L. STRABALA
One Embarcadero Center
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FOR REQUESTER:

Thomas K. Stine
WALLENSTEIN & WAGNER, LTD.
311 South Wacker Drive
53rd Floor
Chicago, IL 60606

DECISION ON RENEWED PETITION TO REDATE AND REMAIL OFFICE ACTION DUE TO NON-RECEIPT BY THE PATENT OWNER AND DECISION ON PETITION TO DISMISS ORDER GRANTING REEXAMINATION

This decision is in response to the "Petition for Rehearing and/or Petition to Exercise Supervisory Authority Over Decision of Richard A. Bertsch Denying Petition to Redate and Remail Office Action Due to Non-Receipt by Patent Owner" received in the United States Patent and Trademark Office (USPTO) on September 15, 2000, and supplemented by additional evidence received on October 24, 2000. This petition is considered to be a request to invoke the supervisory authority of the Commissioner under 37 CFR §1.181. There is no fee associated with this petition.

The petition is **GRANTED-IN-PART**.

A thorough review of the reexamination file was conducted and has revealed that Patent Owner submitted a document on August 12, 1999, prior to the order granting reexamination, also dated August 12, 1999. It was determined that this submission from Patent Owner was premature in view of the fact that Patent Owner could not have had the benefit of the Examiner's decision to grant reexamination prior to submission of the document. In a letter dated September 3, 1999, Patent Owner was informed that the submission was in violation of 37 CFR §1.530(a) and was being returned according to the provisions of MPEP 2267. On December 22, 1999, the Examiner issued a first Office action on the merits, setting a two month period for response thereto. When the Examiner noted that no response to the Office action had been filed, he called Patent

Owner's representative on April 3, 2000 to inquire about this deficiency. On May 3, 2000 Patent Owner submitted a "Petition for Re-Instatement" alleging that the Office action of December 22, 1999 had never been received. In addition to the assertion of non-receipt of the Office action, Patent Owner also argued the propriety of granting the reexamination in view of the arguments presented in the paper that had been returned as being premature. A decision on this petition, mailed on July 17, 2000, dismissed the reinstatement request due to certain deficiencies in the required evidence of non-receipt (Patent Owner in the most recently submitted petition states that the decision was a denial rather than a dismissal).

Reinstatement of Reexamination to Pending Status

In the decision of July 17, 2000, the deficiencies noted in the original petition were (1) a statement from Patent Owner's representative attesting to the fact that a search of the file jacket and docket records indicate that the Office communication was not received, and (2) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed. On page 3 of the renewed petition dated September 15, 2000, a declaration is referenced which allegedly states that a diligent review of the file had been made along with other office records and that there was no evidence that the Office action had been received. Contrary to what was stated in the renewed petition this declaration was not included with the petition; however, since the renewed petition has been signed by Patent Owner's representative, the statement made therein about the review of the file and office records is considered to be sufficient to meet item (1) noted above. The supplemental submission received on October 24, 2000 included a copy of the docket record for February 2000. There is no record of the due date for filing a response to the Office action noted in this record. This showing satisfies item (2) noted above. Therefore, based upon this showing the instant reexamination proceeding is reinstated to pending status.

The Office action will be redated and remailed with a two (2) month period for response set to run from the date of the remailed action. It is noted that Patent Owner obtained a copy of the Office action of December 22, 2000 from the Requester and has filed a response thereto as part of the papers submitted with the original May 3 petition. This response is not considered a proper response since it does not reply to every ground of objection and rejection in the prior Office action, 37 CFR 1.111(b). In addition, the response is informal in that it is unsigned.

Issues Relating to Dismissal of Order Granting Reexamination

Patent Owner has stressed that there are insufficient grounds for granting reexamination and requests dismissal of the reexamination. Patent Owner reasons that the art submitted for reexamination was less pertinent than the art considered during the original patent prosecution and cites *In re Portola Packaging, Inc.*, 110 F3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997).

As set forth in MPEP 2246,

> A substantive determination by the Commissioner to institute reexamination pursuant to a finding that the prior art patents or printed publications raise a substantial new question of patentability is not subject to review by the courts until a final agency decision in the reexamination proceeding has issued. See *Joy Mfg. Co. v. Nat 'l Mine Serv. Co., Inc.*, 810 F.2d 1127, 1 USPQ2d 1627 (Fed. Cir. 1987); *Heinl v. Godici*, 143 Supp.2d 593 (E.D.Va. 2001). Note further the decision of *Patlex Corp. v. Quigg*, 6 USPQ2d 1296, 1298 (D.D.C. 1988) (the legislative scheme leaves the Commissioner's 35 U.S.C. 303 determination entirely to his or her discretion and not subject to judicial review until a final agency decision on the reexamination proceeding has issued). Accordingly, neither the patent owner nor the requester has a right to petition, or request reconsideration of, a finding that prior art patents or printed publications raise a substantial new question after a request for reexamination is granted. There is no right to petition such a finding after a request for reexamination is granted even if the finding of a substantial new question is based on reasons other than those urged by the requester (or based on less than all the grounds urged by the requester).

Under very limited circumstances may a petition under 37 CFR 1.181(a)(3) be considered to vacate the order granting reexamination. One of the situations in which such a petition may be considered is when the reexamination order is based wholly on prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding), MPEP 2246.

Requester requests reexamination of the Houston '359 patent based primarily upon the MTS brochure that was not considered during the original prosecution of the application that led to the Houston '359 patent. Therefore, the petition to dismiss the reexamination is not persuasive that the reexamination order is based wholly on prior art previously considered in an earlier concluded examination of the patent by the Office.

Patent Owner asserts that the MTS brochure is less pertinent than the Cummings [sic: Cummins] patent cited in the original prosecution. The reason that it is considered to be less pertinent, according to Patent Owner, is that the brochure shows a wholly unitary liner structure rather than removable inserts. Patent Owner has failed to mention other features disclosed by the MTS brochure that were not disclosed by Cummins or other prior art during the original prosecution, such as the fasteners used to secure the pedestal liners to various locomotive trucks.

As set forth in MPEP 2242,

> A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable.

The fasteners, as well as the other pedestal liner elements, disclosed by the MTS brochure were deemed to be important by the Examiner in arriving at a decision whether or not the claims of the Houston '359 patent are patentable; thus, the reexamination was ordered.

The order granting reexamination was proper and will not be dismissed.

Other Related Matters Raised by Petitioner

Patent Owner asserts that the motion to dismiss the reexamination filed on August 12, 1999 was timely since it was file prior to the Office action of December 22, 1999. Patent Owner further asserts that the motion should have been held in abeyance and considered at the time of the reexamination in the interests of fair play and to avoid abuse.

37 CFR §1.530(a) states:

> Except as provided in § 1.510(e), no statement or other response by the patent owner in an ex parte reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515 or § 1.520. If a premature statement or other response is filed by the patent owner, it will not be acknowledged or considered in making the determination.

37 CFR §1.540 states:

> The failure to timely file or serve the documents set forth in § 1.530 or in § 1.535 may result in their being refused consideration. No submissions other than the statement pursuant to § 1.530 and the reply by the ex parte reexamination requester pursuant to § 1.535 will be considered prior to examination.

MPEP 2267 states

> Where the patent owner is NOT the requester, any response or amendment filed by owner prior to an order to reexamine is premature and will be returned and will not be considered.

Correct procedure was followed in returning the motion of August 12, 1999. Further, Patent Owner had the opportunity to file arguments regarding the propriety of the order granting reexamination after the order was mailed on August 12, 1999 in an owner's statement as provided for in 37 CFR §1.530(b), (c) but failed to do so. Submission of a petition for dismissal of the reexamination on May 3, 2000 (Patent Owner considered this petition to be a response to the Office action of December 22, 1999) is deemed to be

untimely under 37 CFR 1.181(f), even had the "response" been received within the two month period set for responding to the Office action.

The reexamination file will be forwarded to the Head Supervisory Legal Instruments Examiner for redating and remailing the Office action originally mailed on December 22, 1999. In addition, the $130 fee submitted with the September 15, 2000 petition will be refunded and credited to Deposit Account No. 500334.

SUMMARY:

The petition to reinstate the reexamination proceeding to pending status is **GRANTED**.

The petition to dismiss the order granting reexamination is **DENIED**.

Gerald Goldberg

Gerald Goldberg, Director
Technology Center 3600
Telephone No. (703) 308-1134
Facsimile No. (703) 308-2177

RR
rar: 12/20/01

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DW

MAY - 4 2001

UNITED STATES PATENT & TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

MAILED
MAY 4 2001
Office of the Director
Group 3600

Reexamination Control No. 90/005,382

FOR PATENT OWNER:

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PAUL & PAUL
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Philadelphia, PA 19103

FOR REQUESTER:

Gregory J. Gore
Attorney at Law
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DECISION ON PETITION TO REVIVE REEXAMINATION PROCEEDING

This is in reply to Patent Owner's Petition to Revive the above-noted reexamination proceeding under 37 CFR 1.137(b) filed April 24, 2001.

The petition is **DISMISSED as moot**.

Telephone inquiries relative to this decision should be directed to Special Programs Examiner Steven N. Meyers at (703) 308-3868.

A review of the file history reveals that in response to a second rejection by the examiner of record in this proceeding on January 10, 2001, the patent owner filed a Notice of Appeal on March 12, 2001. The Notice of Appeal was missing a certificate of service on the third party requester.

The patent owner believing that because of the missing certificate of service in the Notice of Appeal, the reexamination proceeding has been abandoned, has filed this petition in the hope of reinstating the reexamination proceeding.

Because this is a reexamination proceeding and not an application, and only applications go abandoned, this proceeding, by definition cannot go abandoned, but can be terminated. While the rule to revive under 37 CFR 1.137(b) was recently changed to include terminated reexamination proceedings, since the prosecution of this proceeding has never been terminated, as outlined below, no petition for revival is required. As such, the patent owner's petition fee of $1240 will be refunded to patent owner's deposit account No. 16-0750.

As outlined in MPEP 2266.03, the proper Office response to a paper filed without a certificate of service is to give the submitting party a 1 month or 30 day period (whichever is longer) to supply the missing certificate of service, once the Office becomes aware of the lack of service. In this proceeding the Office contacted the patent owner's attorney on April 27, 2001 only to find that service had earlier been recognized by the patent owner as being missing from the Notice of Appeal and was subsequently made on April 24, 2001. Therefore, since the patent owner had taken care of the lack of service prior to the Office issuing a time period for correction, this reexamination proceeding was never held to have been terminated, and no petition of any kind is seen as being necessary.

The patent owner is reminded that the Appeal brief or a proper request for extension of time that complies with 37 CFR 1.550(c) is due by May 12, 2001 (2 months from the date of the Notice of Appeal).

In conclusion: The petition for Revival of the reexamination proceeding is **DISMISSED as moot**.

Al Lawrence Smith
Director, Technology Center 3600
(703) 308-1020
Facsimile: (703) 306-4597

snm: 5/3/01
FM

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,384	06/04/99	5162666	

MM41/0210

THOMAS E. O'CONNOR
ARTER & HADDEN LLP
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COLUMBUS OH 43215-3422

EXAMINER	
WELLS, K	
ART UNIT	**PAPER NUMBER**
2816	14

DATE MAILED: 02/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Washington, D.C. 20231

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Alan R. Loudermilk
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Suite B
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REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005 384

PATENT NO. 5,162,666

ART UNIT 2816

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding. 37 C.F.R. 1.550(e).

Where this copy is supplied after the reply by requester, 37 C.F.R. 1.535, or the time for filing a reply has passed, no submissions on behalf of the reexamination requester will be acknowledged or considered. 37 C.F.R. 1.550(e).

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D C 20231

Paper No. 14

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In re Dzung J. Tran)
Reexamination Proceeding)
Control No. 90/005,384)
Filed: June 4, 1999) DECISION ON REQUEST FOR
For: U.S. Patent No. 5,162,666) EXTENSION OF TIME
Title: TRANSMISSION GATE SERIES)
MULTIPLEXER)

This is a decision on a request for an extension of time under 37 C.F.R. § 1.550(c) filed December 30, 1999. The request is for an extension of time of one (1) month in which to file a response to the Office action mailed November 3, 1999.

Pursuant to 37 C.F.R. § 1.550(c):

> (c) *The time for taking any action by a patent owner in a reexamination proceeding will be extended only for a sufficient cause, and for a reasonable time specified. Any request for such an extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of the request effect any extension. See Section 1.304(a) for extensions of time for filing a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.*

The request sets forth sufficient cause. Accordingly, the request for an extension of time is granted to extend one (1) month.

The request is GRANTED.

The period for filing a response is hereby extended to run three (3) months from November 3, 1999, the date the Office action was mailed, and expires February 3, 2000.

It is noted that the litigation of the patent under reexamination has been stayed. Current Office practice dictates that the period for response to an Office action be set to expire one month from its mail date. Further requests for extensions of this period will be granted only upon showing good cause why a response may not be timely submitted despite reasonable efforts by the patent owner.

It is also noted that the request indicates that the delay was due, in part, to the "Office action was mailed to former prosecution counsel, no longer actively representing the patent owner, which counsel had to ultimately receive and forward the office action to the subject counsel." A review of the file record reveals that the correspondence address of record is that indicated above (Marger Johnson & McCollom) where the request for reexamination was served by the requester and where the Notice of Reexamination Filing date and the Notice of Reexamination Request were mailed by the Patent and Trademark Office. The correspondence address of the patent owner has been changed as indicated above.

Document Scanned

Janice A. Howell, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

#18

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,384	06/04/99	5162666	

MM41/0531

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EXAMINER
WELLS, K

ART UNIT	PAPER NUMBER
2816	

DATE MAILED: 05/31/00

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,384	06/04/99	5162666	

MM41/0531

EXAMINER
WELLS,K

ART UNIT	PAPER NUMBER
2816	

DATE MAILED: 05/31/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 18

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In re Dzung J. Tran)
Reexamination Proceeding)
Control No. 90/005,384)
Filed: June 4, 1999)
For: U.S. Patent No. 5,162,666)
Title: TRANSMISSION GATE SERIES MULTIPLEXER)

DECISION ACCEPTING PAPERS AS BEING TIMELY FILED

This is a decision on the petition for an extension of time under 37 C.F.R. § 1.550(c) or, in the alternative, to withdraw the holding of abandonment/termination of proceeding, filed May 22, 2000, which is treated as a request to accept the accompanying amendment as being timely filed.

The request is GRANTED.

Requester asserts that the delay in submitting a proper amendment was caused by nonreceipt of the Notice Re Defective Paper in Reexamination (hereinafter "Notice") mailed March 9, 2000. A review of the written record indicates no irregularity in the mailing of the Notice, and in the absence of any irregularity there is a strong presumption that the Notice was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Notice was not in fact received. The showing required to establish the failure to receive an Office action must consist of a statement from the practitioner stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the

non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c).

The request complies with the above stated requirements for showing non-receipt of the Notice. Accordingly, the amendment filed with the request is hereby accepted as being timely filed.

The reexamination file is being forwarded to the Technical Support Staff for entry of the amendment filed May 22, 2000 with the request. From there, the file will be returned to the examiner for further examination.

Hien H. Phan, Special Programs Examiner
Technology Center 2800
Semiconductors, Optical and Electrical
Systems and Components

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TECHNOLOGY CENTER 2800

Paper No. 28

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In re Dzung J. Tran :
Reexamination Proceeding :
Control No. 90/005384 :
Filed: June 4, 1999 :
For U.S. Patent No. 5,162,666 : DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

In re Dzung J. Tran :
Reexamination Proceeding :
Control No. 90/005,823 :
Filed: September 26, 2000 :
For U.S. Patent No. 5,162,666 :

The above-identified reexamination files are before the director of Examining Group 2870, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,162,666 was issued on November 10, 1992.

2. Reexamination Control No. 90/005,384 was requested by the third party requester on June 4, 1999.

3. Reexamination was ordered in the '5384 reexamination proceeding on July 27, 1999.

4. The claims of the '5382 reexamination proceeding were amended and new claims were added by amendments filed May 22, 2000 and July 24, 2000.

5. A Notice of Intent To Issue Reexamination Certificate (NIRC) was mailed on August 28, 2000.

6. A second reexamination Control No. 90/005,823 was requested by the same third party requester on September 26, 2000.

7. Reexamination was ordered in the '5758 reexamination proceeding on October 19, 2000.

8. On October 20, 2000, the patent owner submitted a statement waiving its right to file a patent owner's statement pursuant to 37 C.F.R. § 1.550(c). In anticipation of the merging of the '5384 and '5823 reexaminations proceedings, the patent owner also submitted therewith an amendment to put the same claims of both reexamination proceedings.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '5384 and '5823 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Since reexamination has been ordered in the '5823 reexamination proceeding based on new prior art not previously considered by the examiner, the NIRC mailed August 28, 2000 in the '5384 reexamination proceeding is hereby vacated.

Reexamination Control Nos. '5384 and '5823 are merged. The reexamination files are being forwarded to the examiner for preparing a first Office action.

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 8/35

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MAILED
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GROUP 2800

In re Dzung J. Tran
Reexamination Proceeding
Control No. 90/005384
Filed: June 4, 1999
For U.S. Patent No. 5,162,666

In re Dzung J. Tran
Reexamination Proceeding
Control No. 90/005,823
Filed: September 26, 2000
For U.S. Patent No. 5,162,666

In re Dzung J. Tran
Reexamination Proceeding
Control No. 90/005,881
Filed: December 8, 2000
For U.S. Patent No. 5,162,666

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above-identified reexamination files are before the director of Examining Group 2870, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,162,666 was issued on November 10, 1992.

2. Reexamination Control No. 90/005,384 was requested by the third party requester on June 4, 1999.

3. Reexamination was ordered in the '5384 reexamination proceeding on July 27, 1999.

4. The claims of the '5382 reexamination proceeding were amended and new claims were added by amendments filed May 22, 2000 and July 24, 2000.

5. A Notice of Intent To Issue Reexamination Certificate (NIRC) was mailed on August 28, 2000.

6. A second reexamination Control No. 90/005,823 was requested by the same third party requester on September 26, 2000.

7. Reexamination was ordered in the '5758 reexamination proceeding on October 19, 2000.

8. On October 20, 2000, the patent owner submitted a statement waiving its right to file a patent owner's statement pursuant to 37 C.F.R. § 1.550(c). In anticipation of the merging of the '5384 and '5823 reexaminations proceedings, the patent owner also submitted therewith an amendment to put the same claims of both reexamination proceedings.

9. A decision merging the '5382 and the '823 reexamination proceedings was mailed October 27, 2000, wherein the NIRC mailed August 28, 2000 was vacated.

10. A non-final Office action was issued November 15, 2000.

11. A personal interview was held on November 20, 2000, between Joe Tran, sole inventor, Mark Becker, counsel for patent owner, and examiner Ken Wells.

12. On November 20, 2000, subsequent to the personal interview, an amendment was filed adding new claims 33 through 38.

13. A supplemental response was filed on November 27, 2000, via facsimile transmission.

14. A third reexamination Control No. 90/005,881 was requested by the same third party requester on December 8, 2000.

15. A telephone interview between Joe Tran and Mark Becker, representing the patent owner, and Ken Wells and Time Callahan, PTO personnel, was held on December 15, 2000.

16. A non-final Office action was mailed on December 20, 2000, rejecting all the pending claims under 35 USC 102 and 35 USC 103 over the prior art of record.

17. Reexamination was ordered in the '5881 reexamination proceeding on January 5, 2001.

18. On January 5, 2001, the patent owner submitted, via facsimile transmission and in triplicate, a statement waiving the right to file a patent owner's statement pursuant to 37 C.F.R. § 1.550(c) in the '5881 reexamination proceeding. In anticipation of the merging of the three reexaminations proceedings, the patent owner also submitted therewith an amendment to put the same claims in all three reexamination proceedings.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in all three of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '5384, '5823 and '5881 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all three proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all three files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. '5384, '5823 and '5881 are merged. The reexamination files are being forwarded to the examiner for preparing a first Office action.

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
Washington, D C. 20231
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Paper No. 10/49

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(For Third Party Requester)

In re Dzung J. Tran
Reexamination Proceeding
Control No. 90/005,384
Filed: June 4, 1999
For U.S. Patent No. 5,162,666

In re Dzung J. Tran
Reexamination Proceeding
Control No. 90/005,823
Filed: September 26, 2000
For U.S. Patent No. 5,162,666

In re Dzung J. Tran
Reexamination Proceeding
Control No. 90/005,881
Filed: December 8, 2000
For U.S. Patent No. 5,162,666

DECISION MERGING
REEXAMINATION
PROCEEDINGS

In re Dzung J. Tran :
Reexamination Proceeding :
Control No. 90/006,051 :
Filed: July 3, 2001 :
For U.S. Patent No. 5,162,666 :
:

The above-identified reexamination files are before the group director of Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,162,666 was issued on November 10, 1992.

2. Reexamination Control No. 90/005,384 was requested by the third party requester on June 4, 1999.

3. Reexamination was ordered in the '5384 reexamination proceeding on July 27, 1999.

4. The claims of the '5384 reexamination proceeding were amended and new claims were added by amendments filed May 22, 2000 and July 24, 2000.

5. A Notice of Intent To Issue Reexamination Certificate (NIRC) was mailed on August 28, 2000.

6. A second reexamination Control No. 90/005,823 was requested by the same third party requester on September 26, 2000.

7. Reexamination was ordered in the '5823 reexamination proceeding on October 19, 2000.

8. On October 20, 2000, the patent owner submitted a statement waiving its right to file a patent owner's statement pursuant to 37 C.F.R. § 1.550(c). In anticipation of the merging of the '5384 and '5823 reexaminations proceedings, the patent owner also submitted therewith an amendment to put the same claims of both reexamination proceedings.

9. A decision merging the '5384 and the '5823 reexamination proceedings was mailed

October 27, 2000, wherein the NIRC mailed August 28, 2000 was vacated.

10. A non-final Office action was issued November 15, 2000.

11. A personal interview was held on November 20, 2000, between Joe Tran, sole inventor, Mark Becker, counsel for patent owner, and examiner Ken Wells.

12. On November 20, 2000, subsequent to the personal interview, an amendment was filed adding new claims 33 through 38.

13. A supplemental response was filed on November 27, 2000, via facsimile transmission.

14. A third reexamination Control No. 90/005,881 was requested by the same third party requester on December 8, 2000.

15. A telephone interview between Joe Tran and Mark Becker, representing the patent owner, and Ken Wells and Time Callahan, PTO personnel, was held on December 15, 2000.

16. A non-final Office action was mailed on December 20, 2000, rejecting all the pending claims under 35 USC 102 and 35 USC 103 over the prior art of record.

17. Reexamination was ordered in the '5881 reexamination proceeding on January 5, 2001.

18. On January 5, 2001, the patent owner submitted, via facsimile transmission and in triplicate, a statement waiving the right to file a patent owner's statement pursuant to 37 C.F.R. § 1.550(c) in the '5881 reexamination proceeding. In anticipation of the merging of the three reexaminations proceedings, the patent owner also submitted therewith an amendment to put the same claims in all three reexamination proceedings.

19. A decision merging the '5881 reexamination proceeding and the '5384 and '5823 reexamination proceedings was mailed on January 8, 2001.

20. A non-final Office action was mailed on January 16, 2001.

21. A personal interview was held on January 18, 2001, between Joe Tran, sole inventor, Mark Becker, counsel for patent owner, examiner Ken Wells and Tim Callahan, SPE.

22. An amendment was submitted on January 18, 2001, the day of the personal interview was held.

23. A non-final Office action was mailed on February 22, 2001.

24. A personal interview was held on February 26, 2001, between Joe Tran, sole inventor, Mark Becker, counsel for patent owner, examiner Ken Wells and Tim Callahan, SPE.

25. An amendment was filed on March 23, 2001, and supplemented, via facsimile transmission, on May 2, 2001.

26. A final Office action was mailed on May 2, 2001.

27. A proposed after final amendment was filed June 5, 2001.

28. An Advisory Action was mailed June 14, 2001, indicating that the proposed after final amendment filed June 5, 2001 will not be entered.

29. A notice of Appeal was filed on June 26, 2001.

30. A fourth reexamination Control No. 90/006,051 was requested by the patent owner on July 3, 2001. The filing of the fourth request for reexamination by the patent owner resulted in the appeal being dismissed and the prosecution of the previously merged reexamination proceedings suspended.

31. Reexamination was ordered in the '6051 reexamination proceeding on September 6, 2001.

32. On November 6, 2001, a patent owner's statement pursuant to 37 C.F.R. 1.530(b) was submitted along with an amendment to the claims.[1]

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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[1]A copy of the papers filed November 6, 2001, via Express Mail, was resubmitted via facsimile due to the interruption in the mail delivery by the US Postal Service. The copy is hereby accepted.

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in all four of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '5384, '5823, '5881 and '6051 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in Both Proceedings.

As noted above, the claims have been amended in the '5384, '5823 and '5881 reexamination proceedings which were previously merged and the claims of the '6051 reexamination proceeding has been amended. The claims in the '6051 reexamination proceeding are not the same as the claims in the other three reexamination proceedings. The patent owner is required to maintain the same claims and specification in all four files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all four files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all four proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all four files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in quadruplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. '5384, '5823, '5881 and '6051 are merged.

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

Page 6 of 6

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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90/005,881
90/004,051
90/005,823

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,392	09/27/2002	5162666	TTI666RES	2026

90/005,384

23380 7590 01/14/2003

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C 20231
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Paper No. 67/8

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(For Third Party Requester)

In re Dzung J. Tran
Reexamination Proceeding
Control No. 90/005,384
Filed: June 4, 1999
For U.S. Patent No. 5,162,666

In re Dzung J. Tran
Reexamination Proceeding
Control No. 90/005,823
Filed: September 26, 2000
For U.S. Patent No. 5,162,666

In re Dzung J. Tran
Reexamination Proceeding
Control No. 90/005,881
Filed: December 8, 2000
For U.S. Patent No. 5,162,666

DECISION MERGING
REEXAMINATION
PROCEEDINGS

In re Dzung J. Tran :
Reexamination Proceeding :
Control No. 90/006,051 :
Filed: July 3, 2001 :
For U.S. Patent No. 5,162,666 :
:
:
In re Dzung J. Tran :
Reexamination Proceeding :
Control No. 90/006,392 :
Filed: September 27, 2002 :
For U.S. Patent No. 5,162,666 :

The above-identified reexamination files are before the Group Director of Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,162,666 was issued on November 10, 1992.

2. Reexamination Control No. 90/005,384 was requested by the third party requester on June 4, 1999.

3. Reexamination was ordered in the '5384 reexamination proceeding on July 27, 1999.

4. The claims of the '5384 reexamination proceeding were amended and new claims were added by amendments filed May 22, 2000 and July 24, 2000.

5. A Notice of Intent To Issue Reexamination Certificate (NIRC) was mailed on August 28, 2000.

6. A second reexamination Control No. 90/005,823 was requested by the same third party requester on September 26, 2000.

7. Reexamination was ordered in the '5823 reexamination proceeding on October 19, 2000.

8. On October 20, 2000, the patent owner submitted a statement waiving its right to file a patent owner's statement pursuant to 37 C.F.R. § 1.550(c). In anticipation of the merging of the '5384 and '5823 reexaminations proceedings, the patent owner also submitted therewith an amendment to put the same claims of both reexamination proceedings.

9. A decision merging the '5384 and the '5823 reexamination proceedings was mailed October 27, 2000, wherein the NIRC mailed August 28, 2000 was vacated.

10. A non-final Office action was issued November 15, 2000.

11. A personal interview was held on November 20, 2000, between Joe Tran, sole inventor, Mark Becker, counsel for patent owner, and examiner Ken Wells.

12. On November 20, 2000, subsequent to the personal interview, an amendment was filed adding new claims 33 through 38.

13. A supplemental response was filed on November 27, 2000, via facsimile transmission.

14. A third reexamination Control No. 90/005,881 was requested by the same third party requester on December 8, 2000.

15. A telephone interview between Joe Tran and Mark Becker, representing the patent owner, and Ken Wells and Time Callahan, PTO personnel, was held on December 15, 2000.

16. A non-final Office action was mailed on December 20, 2000, rejecting all the pending claims under 35 USC 102 and 35 USC 103 over the prior art of record.

17. Reexamination was ordered in the '5881 reexamination proceeding on January 5, 2001.

18. On January 5, 2001, the patent owner submitted, via facsimile transmission and in triplicate, a statement waiving the right to file a patent owner's statement pursuant to 37 C.F.R. § 1.550(c) in the '5881 reexamination proceeding. In anticipation of the merging of the three reexaminations proceedings, the patent owner also submitted therewith an amendment to put the same claims in all three reexamination proceedings.

19. A decision merging the '5881 reexamination proceeding and the '5384 and '5823 reexamination proceedings was mailed on January 8, 2001.

20. A non-final Office action was mailed on January 16, 2001.

21. A personal interview was held on January 18, 2001, between Joe Tran, sole

inventor, Mark Becker, counsel for patent owner, examiner Ken Wells and Tim Callahan, SPE.

22. An amendment was submitted on January 18, 2001, the day of the personal interview was held.

23. A non-final Office action was mailed on February 22, 2001.

24. A personal interview was held on February 26, 2001, between Joe Tran, sole inventor, Mark Becker, counsel for patent owner, examiner Ken Wells and Tim Callahan, SPE.

25. An amendment was filed on March 23, 2001, and supplemented, via facsimile transmission, on May 2, 2001.

26. A final Office action was mailed on May 2, 2001.

27. A proposed after final amendment was filed June 5, 2001.

28. An Advisory Action was mailed June 14, 2001, indicating that the proposed after final amendment filed June 5, 2001 will not be entered.

29. A notice of Appeal was filed on June 26, 2001.

30. A fourth reexamination Control No. 90/006,051 was requested by the patent owner on July 3, 2001. The filing of the fourth request for reexamination by the patent owner resulted in the appeal being dismissed and the prosecution of the previously merged reexamination proceedings suspended.

31. Reexamination was ordered in the '6051 reexamination proceeding on September 6, 2001.

32. On November 6, 2001, a patent owner's statement pursuant to 37 C.F.R. 1.530(b) was submitted along with an amendment to the claims.[1]

33. A decision merging the '6051 reexamination proceeding and the '5384 , '5823 and '5881

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[1]A copy of the papers filed November 6, 2001, via Express Mail, was resubmitted via facsimile due to the interruption in the mail delivery by the US Postal Service. The copy is hereby accepted.

reexamination proceedings was mailed on December 17, 2001.

34. A house keeping amendment placing the same claims in all four reexamination proceedings was submitted on January 17, 2002, and entered.

35. A non-final Office action was mailed on March 6, 2002.

36. An amendment was filed on May 8, 2002 and a supplemental amendment was filed on June 11, 2002, and entered.

37. A final Office action was issued on July 31, 2002.

38. An interview with the examiner was conducted on August 19, 2002.

39. A Notice of Appeal was filed on August 19, 2002.

40. A proposed after-final amendment was filed on August 22, 2002.

41. A fifth reexamination Control No. 90/006,392 was requested by third part Allan Loudermilk on September 27, 2002.

42. A request for an extension of time was filed October 3, 2002.

43. A further request for extension of time was filed on October 15, 2002.

44. Reexamination was ordered in the '6392 reexamination proceeding on October 16, 2002.

45. A decision by the Group Director of Technology Center 2800 was issued October 21, 2002, dismissing the appeal and suspending action in the merged reexamination proceedings in view of the order granting reexamination of the '6392 reexamination proceeding on October 16, 2002.

46. A waiver of Patent Owner's right to file a statement was filed in the '6392 reexamination proceeding on December 19, 2002.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in all five of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '5384, '5823, '5881, '6051 and '6392 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Five Proceedings.

As noted above, the claims have been amended in the '5384, '5823, '5881 and '6051 reexamination proceedings which were previously merged and the claims of the '6392 reexamination proceeding has not been amended. The claims in the '6392 reexamination proceeding are not the same as the claims in the other four reexamination proceedings. The patent owner is required to maintain the same claims and specification in all five files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all five files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all five proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all five files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in quintuplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. '5384, '5823, '5881, '6051 and '6392 are merged.

An appropriate house keeping amendment is required within ONE MONTH of this decision. Extension of this time is NOT available under 37 C.F.R. 1.136(a).

Any inquiry regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (703) 308-7502.

Richard K. Seidel, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,384	06/04/1999			7780

24197 7590 04/24/2009

KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

Please find below and/or attached an Office communication concerning this application or proceeding.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALAN R. LOUDERMILK
LOUDERMILK & ASSOCIATES
P.O. BOX 3607
LOS ALTOS, CA 94024-0607

Date:

MAILED

APR 24 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90005384
PATENT NO. : 5162666
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,823	09/26/2000	5162666		8016

24197 7590 04/24/2009

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PORTLAND, OR 97204

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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LOS ALTOS, CA 94024-0607

Date:

MAILED

APR 24 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90005823
PATENT NO. : 5162666
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,881	12/08/2000	5162666		5515

24197 7590 04/24/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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ALAN R. LOUDERMILK
LOUDERMILK & ASSOCIATES
P.O. BOX 3607
LOS ALTOS, CA 94024-0607

Date:
MAILED
APR 24 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90005881
PATENT NO. : 5162666
ART UNIT : 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,051	07/03/2001	5162666	69782/92408	3088

24197 7590 04/24/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,392	09/27/2002	5162666	TTI666RES	2026

24197 7590 04/24/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ALAN R. LOUDERMILK
LOUDERMILK & ASSOCIATES
P.O. BOX 3607
LOS ALTOS, CA 94024-0607

Date:

MAILED

APR 24 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006392
PATENT NO. : 5162666
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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Klarquist Sparkman LLP
121 SW Salmon Street
Suite 1600
Portland, Oregon 97204

(For Patent Owner)

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APR 242009

CENTRAL REEXAMINATION UNIT

Alan R. Loudermilk
Loudermilk & Associates
P.O. Box 3607
Los Altos, California 94024-0607

(For Third Party Requester)

(Enclosure: Copy of March 13, 2009 patent owner petition with attachments.)

D. Scott Hemingway
Hemingway & Hansen, LLP
1717 Main Street, Suite 2500
Dallas, Texas 75201

(Courtesy Copy)

In re Dzung J. Tran	:	
Merged Reexamination Proceeding	:	**DECISION**
Control No: 90/005,384	:	**DISMISSING**
Filing Date: June 4, 1999	:	**PETITION**
Control No: 90/005,823	:	
Filing Date: September 6, 2000	:	
Control No: 90/005,881	:	
Filing Date: December 8, 2000	:	
Control No: 90/006,051	:	
Filing Date: July 3, 2001	:	
Control No: 90/006,392	:	
Filing Date: September 27, 2002	:	
All for: U.S. Patent No.: 5,162,666	:	

This is a decision on the patent owner petition filed on March 13, 2009, entitled "Petition to Prevent the Issuance and Publication of Reexamination Certificate Cancelling any Claims that are subject to a Prior-Filed Reissue Application, or in the alternative, Requesting Revocation of any Published Certificate that Purports to cancel any claims

subject to the prior-filed reissue Application." The petition is being treated under 37 CFR 1.183 as a request to waive 37 CFR 1.570.

The petition paper is before the Office of Patent Legal Administration for consideration. The fee for the petition under 37 CFR 1.17(f) of $400 has been paid.

The petition to prevent the issuance of the certificate, or in the alternative, to revoke the certificate, if issued is dismissed.

BACKGROUND

1. Patent number 5,162.666 (the '666 patent) issued on November 10, 1992.

2. Reexamination Control No. 90/005,384 was requested by a third party requester on June 4, 1999, reexamination was ordered in the '5384 proceeding on July 27, 1999, and prosecution proceeded to the issuance of a Notice of Intent to Issue Reexamination Certificate (NIRC) on August 28, 2000.

3. A second reexamination request (by the same requester) was filed September 26, 2000, and assigned Control No. 90/005,823. Reexamination was ordered in the '5823 proceeding on October 19, 2000 and a decision merging the '5384 and the '5823 reexamination proceedings (in which the NIRC was vacated) was mailed on October 27, 2000. Prosecution continued in the merged proceeding.

4. A third reexamination request (by the same requester) was filed December 8, 2000, and assigned Control No. 90/005,881. Reexamination was ordered in the '5881 proceeding on January 5, 2001 and a decision merging the '5881 reexamination proceeding and the previously merged '5384 and '5823 reexamination proceeding was mailed on January 8, 2001. Prosecution continued in the merged proceeding to the stage of a filing of a Notice of Appeal on June 6, 2001.

5. A fourth reexamination request (by the patent owner) was filed July 3, 2001, and assigned Control No. 90/006,051. Reexamination was ordered in the '6051 proceeding on September 6, 2001, and a decision merging the '6051 reexamination proceeding and the previously merged '5384, '5823, and '5881 reexamination proceeding was mailed on December 17, 2001. Prosecution continued in the merged proceeding to the stage of a filing of a Notice of Appeal on August 19, 2002.

6. A fifth reexamination request (by the same third party requester) was filed September 27, 2002, and assigned Control No. 90/006,392. Reexamination was ordered in the '6392 proceeding on October 16, 2002, and a decision merging the '6392 reexamination proceeding and the previously merged '5384, '5823, 5881, and '6051 reexamination proceeding was mailed on January 14, 2003. Prosecution

continued in the merged proceeding in front of the examiner leading to a final rejection of all claims remaining in the proceeding on May 15, 2003.

7. Patent owner appealed the examiner's final rejection of claims 16, 17, 39-45, 47 and 48 to the Board of Patent Appeals and Interferences (BPAI). [1] The BPAI affirmed the examiner's position in its decision mailed July 14, 2005, and the patent owner perfected an appeal to the Court of Appeals for the Federal Circuit.

8. On October 12, 2007, the Federal Circuit affirmed the decision of the BPAI, and the decision was issued as a mandate on February 4, 2008. Patent owner filed a Petition for Writ of *Certiorari* to the United States Supreme Court. The petition for *certiorari* was denied on December 1, 2008.

9. On February 20, 2009 a NIRC was mailed, stating that a certificate will issue cancelling all the claims in the '666 patent.

10. On March 13, 2009, patent owner filed a petition requesting the Office to refrain from issuing the certificate, or in the alternative, requesting revocation of any published certificate that cancels the claims. This petition is the subject of this decision.

11. *Ex Parte* Reexamination Certificate (6763rd) for U.S. Patent No. 5,162,666 issued and published April 14, 2009. The certificate stated that "As a result of reexamination, it has been determined that: Claims 1-27 are cancelled" and further noted that "the patent remains subject to pending reissue application number 12/322,857 filed February 9, 2009."

DECISION

I. Pertinent Statutes and Regulations

35 U.S.C. 307 Certificate of patentability, unpatentability, and claim cancellation.

(a) In a reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

[1] Patent claims 1-15 and 18-27 and claims 28-38 and 46 added during reexamination were canceled prior to the appeal.

37 CFR § 1.570 Issuance and publication of *ex parte* reexamination certificate c*oncludes ex parte* reexamination proceeding.

(a) To conclude an *ex parte* reexamination proceeding, the Director will issue and publish an *ex parte* reexamination certificate in accordance with 35 U.S.C. 307 setting forth the results of the *ex parte* reexamination proceeding and the content of the patent following the *ex parte* reexamination proceeding.

(b) An *ex parte* reexamination certificate will be issued and published in each patent in which an *ex parte* reexamination proceeding has been ordered under § 1.525 and has not been merged with any inter partes reexamination proceeding pursuant to § 1.989(a). Any statutory disclaimer filed by the patent owner will be made part of the *ex parte* reexamination certificate.

..

(d) If an *ex parte* reexamination certificate has been issued and published which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

37 CFR § 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part **which is not a requirement of the statutes** may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in **§ 1.17**(f). [Emphasis added]

II. Decision

Patent owner has prosecuted the merits of these claims to the point of a final decision by the Federal Circuit finding all the pending claims unpatentable and the denial of the petition to have the case heard by the U.S. Supreme Court. 35 U.S.C. 307 directs the Director of the USPTO to "issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable" to complete the reexamination proceeding "when the time for appeal has expired or any appeal proceeding has terminated." [2] Thus, the issuance and publication of the certificate cancelling the claims of the '666 patent is required by statute, and the Office has no authority to waive the statute. Additionally, since the certificate was properly issued and published in

[2] This directive is implemented in the Office's rules by means of 37 CFR 1.570.

accordance with the statute, the Office is without power to revoke the certificate pursuant to petitioner's request.

Accordingly, the patent owner March 12, 2008 petition is dismissed.

III. Lack of Proof Of Service

Pursuant to 37 CFR 1.550(f):

> "After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. **The document must reflect service or the document may be refused consideration by the Office."** [Emphasis added]

A review of the instant petition shows that the requisite proof of service (of the instant petition) by the patent owner on the third party requester was not included with the present petition.

As pointed out in MPEP § 2266.03:

> "Any paper filed with the Office, i.e., any submission made, in a third party requested reexamination by either the patent owner or the third party requester, must be served on every other party in the reexamination proceeding.
>
> "**As proof of service, the party submitting the paper to the Office must attach a certificate of service to the paper.** It is required that the name and address of the party served, and the method of service be set forth in the certificate of service. Further, a copy of the certificate of service must be attached with the copy of the paper that is served on the other party." [Emphasis added]

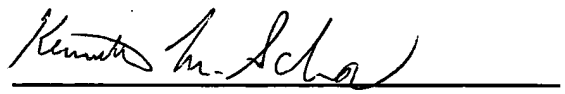
A certificate of service pursuant to MPEP § 2266.03 has not been found attached to the instant petition. This provides separate basis for dismissal of the patent owner March 12, 2008 petition (however, while this basis could be remedied, the main basis for this decision cannot be).

Since the third party requester was not provided with a copy of the petition submitted by the patent owner, a copy is being forwarded (via this decision) to the requester together with all attachments thereto.

CONCLUSION

1. The patent owner petition filed on March 12, 2008, requesting that the Office not issue a reexamination certificate or in the alternative to vacate any certificate that may have issued is dismissed.

2. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

4-22-09
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COUNSEL BUILDING 220 12W 01
P O BOX 33427
ST PAUL , MN 55133-3427

(For Patent Owner)

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FEB 0 5 2001

REEXAM UNIT

In re Reexamination Proceeding	:	
Control No. 90/005,386	:	DECISION
Filed: July 7, 1999	:	DISMISSING
For: U.S. Patent No. 5,692,821	:	PETITION
Patentee: Rodriguez, et al.	:	

This is a decision on the petition under 35 U.S.C. 133, filed September 18, 2000, and supplemented September 20, 2000, for entry of late papers (a belated response to an Office action) on the grounds of unavoidable delay. See MPEP 2268. The petition fee under 37 CFR § 1.17(l) of $110.00 has been charged to petitioner's deposit account, as per petitioner's instructions on pages 1 and 2 of the September 20th supplement to the petition. The petition is before the Office of Patent Legal Administration for decision.

The petition under 35 U.S.C. § 133 for the entry of late papers is **dismissed** for the reasons pointed out below.

Any request for reconsideration of the decision on the petition under 35 U.S.C. 133 must be submitted within ONE (1) MONTH from the mail date of this decision. An extension of time may be requested only under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are **not** available in reexamination proceedings. Any reconsideration request which is submitted should include a cover letter entitled "Renewed Petition under 35 U.S.C. § 133."

DECISION

A grantable petition for entry of belated papers under 35 U.S.C. § 133 must be accompanied (1) by an adequate showing of the cause of unavoidable delay, (2) by the proposed response to the outstanding Office action, and (3) by the petition fee required by law. This petition lacks item (1) above.

This reexamination proceeding terminated after April 17, 2000, for failure to timely file a response to the non-final Office action of February 16, 2000, which set a shortened statutory period for response of two (2) months, and noted that extensions of time were governed by 37 CFR 1.550(c).

The showing provided in the present petition of the cause of unavoidable delay is incomplete, and the present petition is inadequate to establish a case of unavoidable delay within the meaning of the statute.

A showing which sets forth the facts surrounding the delay in responding must be provided. Statements from all persons responsible for the entire delay from the time of termination of the reexamination proceeding to the filing of the present petition are required. If a showing is made by a person not registered to practice before the United States Patent and Trademark Office (USPTO), the statement must be verified by way of affidavit or declaration according to 37 CFR 1.68.

As explained in MPEP 711.03(c)(III)(D), there are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(a):

> (1) The delay in reply that originally resulted in abandonment (here, in the termination of the reexamination proceeding);
>
> (2) The delay in filing an initial petition pursuant to § 1.137(a) to revive the application (here, to revive the terminated reexamination proceeding); and
>
> (3) the delay in filing a *grantable* petition pursuant to § 1.137(a) to revive the application (here, to revive the terminated reexamination proceeding). *See Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* 53131 at 53158 (October 10, 1997).

The showing does not demonstrate that the delay in periods (1) and (2) above was unavoidable.

As to period # 1:

With regard to the showing of the cause of unavoidable delay, the present petition indicates that the existence of a continuation of the patent being reexamined resulted in confusion. The petition states that "Applicants' Attorney" responded to the USPTO communications in the continuation, and "did not realize that a separate response was due for the reexamination proceedings until one day after the due date." In regard to this, a complete statement is required from Applicants' Attorney as to the nature of the confusion and why it resulted in the late filing of the response to the Office action of February 16, 2000. Why did the docket system used by the attorney's office fail to alert the attorney that the response to the **reexamination Office action** had not been filed? Why was an alert not issued in time to make the filing? If an alert was issued, why did it fail to achieve a timely filing of the response?

Any response to the above should be accompanied by a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person(s) responsible for the maintenance of the system. The showing of unavoidable delay must include an indication as to why the system failed in this instance to provide adequate notice that a response was due. An adequate showing requires a verified statement by all persons with direct knowledge of why docket procedures failed to achieve a timely response, setting forth the facts as they know them. The showing would include verified copies of any docket sheets, file wrappers and such other records as may exist which would have bearing on why a timely response was not achieved, with the appropriate supporting statements being provided.

As to period # 2:

The interview summary of May 10, 2000, shows that petitioner was aware of the lateness of the response filed April 20, 2000, and that a petition under 37 CFR 1.137 was necessary, whereas the petition was not filed until September 18, 2000. Accordingly, the record does not show that the delay in filing the petition was unavoidable. An explanation, with supporting documentation, as to why the delay in presenting the petition should be

considered unavoidable is required. The requirement in 35 U.S.C. § 133 for a showing of unavoidable delay requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay from the time an applicant becomes aware of the abandonment of the application until the filing of a petition to revive. *See In re Application of Takao* 17 USPQ2d 1155 (Comm'r Pat. 1990). A petition under 35 U.S.C. § 133 cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 133. *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

For the reasons set forth above, the petition is **dismissed.**

ALTERNATIVE OPTION

Petition based on unintentional delay:

Petitioner may wish to consider the filing of a petition under 37 CFR § 1.137(b) if the delay in filing the proposed amendment of September 27, 2000, was unintentional. The unintentional delay fee provisions of 35 U.S.C. § 41(a)(7) have been imported into, and are applicable to, all *ex parte* reexamination proceedings by Sec. 4605 of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR § 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the entire delay from the due date for the response to the filing of a grantable petition was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR § 1.17(m).

CONCLUSION

1. The petition is **dismissed**.

2. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision.

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

4. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-6710.

Page 5 of Decision

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

February 5, 2000
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#11
(mas)

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

DOCKETING CLERK 3M CENTER
3M OFFICE OF INTELLECTUAL PROPERTY
COUNSEL BUILDING 220 12W 01
P O BOX 33427
ST PAUL , MN 55133-3427

(For Patent Owner)

MAILED
MAY 30 2001
REEXAM UNIT

In re Reexamination Proceeding	:	
Control No. 90/005,386	:	DECISION
Filed: July 7, 1999	:	GRANTING
For: U.S. Patent No. 5,692,821	:	PETITION
Patentee: Rodriguez, et al.	:	

This is a decision on the petition under 37 CFR 1.137(b), filed May 10, 2001, for entry of late papers (a belated response to an Office action) on the grounds of unintentional delay. The petition is before the Office of Patent Legal Administration for decision.

The petition is **granted**.

The reexamination file is being forwarded to Technology Center 2800.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, William C. Dowling (703-308-1287), of Technology Center Art Unit 2851.

Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-6710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

May 30, 2001
C:\KIVA\KPET-ABE\5386GRNT.WPD

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C 20231
www.uspto.gov

Paper No. 14

MAYER, BROWN & PLATT
P.O. Box 2828
Chicago, Illinois 60690-2828

(For Patent Owner)

FEB 1 2001

In re Robert J. Burns)
Reexamination Proceeding)
Control No. 90/005,392)
Filed: June 15, 1999) DECISION ON PETITION TO
For: U.S. Patent No. 5,739,684) REMAIL OFFICE ACTION
Title: UNITARILY FORMED HUB AND)
ABS EXCITER RING)

DO NOT ENTER

This is a response to the Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action, filed October 18, 2000, and supplemented November 1, 2000, all via facsimile transmission. The petition is being treated as a petition to remail the Office action due to non-receipt of the action pursuant to Section 711.03(c) of the Manual for Patent Examining Procedure (M.P.E.P.)

The petition is GRANTED.

Petitioner asserts that the Office action dated August 11, 2000 was not received. A review of the written record indicates no irregularity in the mailing of the Office action, and in the absence of any irregularity there is a strong presumption that the Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office action must consist of a statement from the practitioner stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c).

The petition complies with the above-stated conditions for showing non-receipt of an Office action.

The reexamination file is being forwarded to the Technical Support Staff for remailing the Office action of August 11, 2000. The shortened statutory period for response will be reset to expire 2 (two) months from the date the Office action is remailed. Extensions of this time are NOT available under 37 C.F.R. § 1.136(a) but are governed by 37 C.F.R. § 1.550(c).

Henry Thanh for

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

#12

DEC 21 2000

UNITED STATES PATENT & TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

Reexamination Control No. 90/005,399

MAILED

DEC 21 2000

Office of the Director
Group 3600

FOR PATENT OWNER:

James W. Kayden, Esq.
HOPKINS AND THOMAS
100Galleria Parkway N.W., Suite 1200
Atlanta, GA 30330

FOR REQUESTER:

Nicholas L. Coch
KRAMER, LEVIN, HAFTALIS & FRANKEL LLP
919 Third Avenue
New York, NY 10022

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

This is in reply to petitioner's communication filed December 6, 2000 and supplemented on December 21, 2000 that will be treated as a Petition To Accept Late Filed Papers. There is no fee required for this petition.

The petition is **GRANTED**.

A review of the above reexamination file indicates that a Final Rejection was mailed July 21, 2000. The after-final amendment and the Notice of Appeal with a Certificate of Mailing date of September 21, 2000 submitted by the patent owner in response to the final rejection was apparently never received by the Office. In addition, an Appeal Brief filed by the patent owner bearing a Certificate of Mailing date of November 21, 2000 was also apparently never received by the Office. The patent owner has submitted a copy of the after-final amendment, the Notice of Appeal and the Appeal Brief bearing the above-noted Certificate of Mailing dates. In addition the patent owner has

submitted, by facsimile transmission, on December 21, 2000 a statement by Sheila Gray attesting on a personal knowledge basis to the timely mailing of the above correspondence. This is acceptable evidence of a timely filing of the after-final amendment, Notice of Appeal and Appeal Brief.

Telephone inquiries relative to this decision should be directed to Special Programs Examiner Steven N. Meyers at (703) 308-3868.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner to enter the copies of the communications from the patent owner filed December 6, 2000.

Al Lawrence Smith
Director, Technology Center 3600
(703) 308-1020
Facsimile: (703) 306-4597

snm: 12/21/00
SM

SEP 13 2001

UNITED STATES PATENT & TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

#2
DC

Reexamination Control No. 90/005,399

MAILED

SEP 13 2001

Office of the Director
Group 3600

FOR PATENT OWNER:

James W. Kayden, Esq.
HOPKINS AND THOMAS
100 Galleria Parkway N.W., Suite 1200
Atlanta, GA 30330

FOR REQUESTER:

Nicholas L. Coch
KRAMER, LEVIN, HAFTALIS & FRANKEL LLP
919 Third Avenue
New York, NY 10022

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

This is in reply to petitioner's Petition for the Acceptance of Late Papers filed August 17, 2001. There is no fee required for this petition.

The petition is **GRANTED**.

A review of the above reexamination file indicates that the Reply Brief submitted by the patent owner on May 9, 2001 was apparently never received by the Office. With the petition of August 17, 2001, the patent owner has submitted a copy of the Reply Brief, a copy of the post card receipt having a date stamp of May 14, 2001, and a statement by Carla Stone attesting on a personal knowledge basis to the timely mailing of the above correspondence . This is acceptable evidence of a timely filing of the Reply Brief

It is noted that the Reply Brief included an incorrect Reexamination Control Number which could be the reason that the Reply Brief was not matched with the proper file. Steps should be taken to insure that the correct Control Number is used in future correspondence.

Telephone inquiries relative to this decision should be directed to Special Programs Examiner Randolph A. Reese at (703) 308-2121.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner for entry of the Reply Brief filed August 17, 2001, and then to the examiner for prompt consideration of the issues raised in the Reply Brief.

Al Lawrence Smith, Director
Patent Technology Center 3600
(703) 308-2121
Facsimile No.: (703) 306-4597

ALS;rar;9/10/01

cc: Requester

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,401	06/22/99	5555402	L02-42875

TM21/0226

RUSSELL L JOHNSON
SKJERVEN MORRILL MACPHERSON
FRANKLIN AND FRIEL LLP
25 METRO DRIVE SUITE 700
SAN JOSE CA 95110

EXAMINER	
ENG, D	

ART UNIT	PAPER NUMBER
2155	12

DATE MAILED: 02/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Merge 90/005,728

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 12

Russell L. Johnson. Skjerven Morrill MacPherson Franklin and Friel LLP 25 Metro Drive, Suite 700 San Jose, California 95110	FOR OWNER
Robert A. Schroeder Pretty Schroeder & Poplawski 444 South Flower Street 19th Floor Los Angeles, California 90071-2909	FOR FIRST THIRD PARTY REQUESTER
Robert A. Schroeder Pretty Schroeder & Poplawski 444 South Flower Street 19th Floor Los Angeles, California 90071-2909	FOR SECOND THIRD PARTY REQUESTER
In re Tuma et al. Reexamination Proceeding Control No. 90/005,401 Filed: June 22, 1999 For: U.S. Patent No. 5,555,402	DECISION SUA SPONTE, MERGING REEXAMINATION PROCEEDINGS
In re Tuma et al. Reexamination Proceeding Control No. 90/005,728 Filed: June 16, 2000 For: U.S. Patent No. 5,555,402	

The above noted reexamination proceedings are before the Director of Technology Center 2100 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 5,555,402 issued on September 10, 1996.

'401 Proceeding

2. A first request for reexamination, Control No. 90/005,401 ('401) was filed by the Third Party Requester on June 22, 1999. [Paper No. 3]

3. Reexamination was ordered in the '401 reexamination proceeding on September 3, 1999. [Paper No. 5]

4. Two Information Disclosure Statements [Paper Nos. 6 & 7] were filed on October 6, 1999.

5. A first Office action [Paper No. 8] was mailed on February 11, 2000.

6. The previous action [Paper No. 8] was remailed on March 7, 2000, restarting the period of response. [Paper No. 9]

7. A letter from the Examiner requesting Clarification from the owner with respect to the response to Paper No. 8 and setting a one-month period for response was mailed on August 2, 2000. [Paper No. 10]

8. Applicant's Amendment and Response dated April 6, 2000 is matched to the file and entered on December 7, 2000. [Paper No. 11]

'728 Proceeding

9. A second request for reexamination, Control No. 90/005,728 ('728) was filed by the Third Party Requester on June 16, 2000. [Paper No. 3]

10. Reexamination was ordered in the '728 reexamination proceeding on August 4, 2000. [Paper No. 5]

DISCUSSION

37 CFR § 1.565(c) states:

"If reexamination is ordered while a prior reexamination is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570."

DECISION

I. Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '401 and '728 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in all Proceedings

The Patent Owner is required to maintain the same claims and specification in both files.

Since the files do not currently maintain the same claims and specification, a "housekeeping" amendment is required. Applicant is required to file a proper housekeeping amendment, to make the claims the same in each file, within **ONE MONTH** of the mail date of this decision.

III. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry into each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

Allen R. MacDonald, Director
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce

UNITED STATES PATENT AND TRADEMARK OFFICE

MAIL

APR 1 3 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 32

Norman R. Klivans, Jr.
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, CA 94304-1018

FOR OWNER

Robert Schroeder, Esq.
BINGHAM McCUTCHEN
555 South Grand Avenue, Suite 4400
Los Angeles, CA 90071-3106

FOR THIRD PARTY REQUESTER

In re Reexamination of:
U.S. Patent No. 5,555,402
Reexamination Control Nos.:
90/005,401 and 90/005,728
For: DISK STORAGE SUBSYSTEM FOR INTERFACING WITH A PARALLEL PATH, A NON VOLATILE MEDIA AND A VOLATILE STORAGE MEDIUM

DECISION ON PETITION

This is a decision on a Letter to the Board of Appeals dated March 26, 2003. The Letter to the Board of Appeals has been treated as a petition under 37 CFR § 1.181(a)(3) to invoke the supervisory authority of Technology Center Director to review the procedural irregularities in the Examiner's Answer mailed July12, 2002.

BACKGROUND

The above-identified reexamination proceedings were filed on June 22, 1999 and May 16, 2000 with original patent claims 1-19.

On February 26, 2001, the '401 reexamination proceeding and the '728 reexamination proceeding were merged.

On March 9, 2001, an Amendment (Paper No. 14) was filed adding new claim 20.

On May 7, 2001, a final Office action (Paper No. 15) was mailed wherein claims 1-7 and 20 were finally rejected and the patentability of claims 8-19 were confirmed.

On July 18, 2001, a proposed Amendment after final rejection (Paper No. 19) was filed amending claim 1 to include a limitation "over said parallel path" and amending claim 8 to include all the limitations of original base claim 1.

On September 28, 2001, an Advisory action (Paper No. 20) was mailed advising the Patent Owner that the proposed Amendment to claims 1 and 8 will not be entered and the Final rejection stands because they raise new issue that would require further search and consideration. This Advisory action was remailed on October 18, 2001 restarting the period of response.

On October 9, 2001, a Petition under 37 CFR 1.127 (Paper No. 21½) was filed requesting the Examiner to admit the proposed Amendment dated July 18, 2001 in whole.

On November 1, 2001, another Advisory action (Paper No. 22) was mailed advising the Patent Owner that the proposed Amendment dated July 18, 2001 will be entered, in whole, upon filing of an appeal.

On December 14, 2001, an Appeal brief (Paper No. 24) was filed.

On July 12, 2002, an Examiner's Answer (Paper No. 25) was mailed. In the examiner's answer, the Examiner for the first time pointed out "The amended claim 1 is in error introduced by the amendment after final". See Examiner's Answer, page 4, last paragraph.

On September 11, 2002, a reply Brief and Request for Oral Hearing (Paper No. 26) was filed. In the reply, the Patent owner pointed out that the Examiner's answer is procedurally incorrect because it does raise a new ground of rejection contrary to 37 CFR § 1.193(a)(2), even though the Examiner did not phrase his comments in terms of a rejection.

On March 4, 2003, a Letter from the examiner was mailed informing the Owner that the reply Brief filed on September 11, 2002 has not been entered because it is improper under 37 CFR § 1.193 and requesting that the request for oral hearing and the request to reopen prosecution must be submitted in paper separated from the reply brief.

On March 26, 2003, a reply Brief and a Request for Oral Hearing were resubmitted in separated papers. In addition, a letter to Board of Appeal was filed requesting the Board to strike and/or ignore the purported "error" cited by the Examiner in the Answer or remand these two reexamination proceedings to the Examiner to make a new rejection if he deems such is appropriate.

REGULATIONS and PRACTICE

MPEP § 2271 states in part:

> **Before a final action is in order, a clear issue should be developed between the examiner and the patent owner**. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, **the examiner will twice provide the patent owner with such information** and references as may be useful in defining the position of the Office as to unpatentability before the action is made final... [Emphasis added].

37 CFR § 1.193(a)(2) states:

> An examiner's answer must not include a new ground of rejection, but if an amendment under § 1.116 proposes to add or amend one or more claims and appellant was advised that the amendment under § 1.116 would be entered for purposes of appeal and which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then the appeal brief must address the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised and the examiner's answer may include the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised. The filing of an amendment under § 1.116 which is entered for purposes of appeal represents appellant's consent that when so advised any appeal proceed on those claim(s) added or amended by the amendment under § 1.116 subject to any rejection set forth in the action from which the appeal was taken.

37 CFR § 41.39 states in part:

...

(a)(2) An examiner's answer may include a new ground of rejection.

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sue sponte dismissal of the appeal as to the claims subject to the new ground of rejection.

...

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

DECISION

A review of the advisory action (Paper No. 22) mailed 01 November 2001, the appeal brief (Paper No. 24) filed 14 December 2001 and the examiner's answer (Paper No. 25) mailed 12 July 2002, it reveals that the limitation "over said parallel path" was added to claim 1 (for the first time) in the amendment after final rejection. In the advisory action mailed 01 November 2001, this limitation was admitted that it would be entered upon filing an appeal.

Pursuant to 37 CFR 1.193(a)(2), the patent owner addressed the rejection of claim 1 amended by the amendment under § 1.116 as he was advised; the examiner's answer may include the rejection of claim 1 amended by the amendment under § 1.116, but the examiner's answer must not include a new ground of rejection. At the time the examiner's answer was written, the examiner did not introduce a new ground of rejection, but provided an objection/rejection to the limitation "over said parallel path" in the ARGUMENT section of the examiner's answer.

Pursuant to MPEP § 2271, the examiner must provide the patent owner twice such objection/rejection to the added limitation "over said parallel path", and the issue must be clearly developed between the examiner and the patent owner prior to bring the prosecution to a close. The record shows there is an unclear issue (i.e., "over said parallel path" limitation) to be resolved, and the patent owner did not receive twice the objection/rejection to the limitation "over said parallel path".

Pursuant to 37 CFR § 40.39(a)(2), effective 13 September 2004, it is ordered the examiner to reissue a new examiner's answer to address the added limitation "over said parallel path".

Accordingly, the petition is **GRANTED**. The examiner's answer (Paper No. 25) mailed July 12, 2002 is hereby withdrawn.

The reexamination proceeding files are hereby returned to the examiner to issue another examiner's answer to clearly address the unresolved issue "over said parallel path" as amended in claim 1.

Peter Wong, Director
Technology Center 2100
Computer Architecture, Software, and
Information Security

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAILED
26 APR 2000
TECH CENTER 1600

SUSAN STONE ROSENFIELD
BRYAN CAVE, LLP
TWO NORTH CENTRAL AVENUE
SUITE 2200
PHOENIX , AZ 85004

DECISION ON PETITION

JOHN D. LONG
LAW OFFICES OF LONG & LONG
222 NORTH LASALLE STREET
SUITE 340
CHICAGO, IL 60601

In re Deihl
Reexamination Proceeding
Control No.: 90/005,411
Filed: July 2, 1999
For: U.S.Patent No. 4,525,341

This decision is in response to Patent Owner's petition under 37 CFR 1.181, filed January 21, 2000, seeking modification of the examiner's Order Granting the Reexamination Request, mailed October 1, 1999.

Petitioner argues in the petition that the examiner made improper statements in the Order granting reexamination implying that the claim is unpatentable which were then raised in a court proceeding by the Requester and which have had an influence on the court and its procedures.

A review of the reexamination file shows that the Order was mailed at the end of the three month statutory period for deciding whether to grant or deny the reexamination request. Normally such orders are mailed well before the last day of the statutory period. However, the decision on the order was delayed due to the need to first address improper submissions by the third party Requester. Thus the examiner had little time to render a decision and have it reviewed for correctness of form prior to mailing in order to meet the statutory deadline. As a result statements which imply that the claim is unpatentable were included in the Order. Such conclusory statements about patentability in the order are improper on their face, but are not improper if interpreted as a statement pointing out a substantial new question of patentability as was the intent.

Applicant requests that a new order be issued which corrects the statements in the original Order. Applicant's petition is **GRANTED-IN-PART** to the extent that the above paragraph modifies the Order.

It is noted from papers filed by the third party Requester that a further stay of court proceedings has been granted to May 12, 2000. It is expected that an Office action in this reexamination proceeding will issue prior to that date and will set forth the position of the Office with respect to the claims of the patent under reexamination.

John Kittle
Director, Technology Center 1600/2900

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 39

Robert A. Parsons
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Phoenix, AZ 85004

(For Patent Owner)

Law Offices of John D. Long
2941 Sage Ridge Drive
Reno, NV 89509

(For Requester)

MAILED

MAR 30 2004

REEXAM UNIT

In re Deihl
Reexamination Proceeding
Control No. 90/005,411
Filed: July 2, 1999
For: U.S. Patent No. 4,525,341

DECISION GRANTING PETITION

This is a decision on the December 23, 2003, patent owner petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), based upon unintentional delay. The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $665.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) has been received.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The petition is accompanied by the petition fee. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the present petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The required reply to the non-final Office action of September 17, 2003, has been received.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 1600 for consideration of the response to the non-final Office action of September 17, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Frank Choi, of Group Art Unit 1616.

4. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

March 29, 2004

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAILED
26 APR 2000
TECH CENTER 1600

SUSAN STONE ROSENFIELD
BRYAN CAVE, LLP
TWO NORTH CENTRAL AVENUE
SUITE 2200
PHOENIX , AZ 85004

DECISION ON PETITION

JOHN D. LONG
LAW OFFICES OF LONG & LONG
222 NORTH LASALLE STREET
SUITE 340
CHICAGO, IL 60601

In re Deihl
Reexamination Proceeding
Control No.: 90/005,411
Filed: July 2, 1999
For: U.S.Patent No. 4,525,341

This decision is in response to Patent Owner's petition under 37 CFR 1.181, filed January 21, 2000, seeking modification of the examiner's Order Granting the Reexamination Request, mailed October 1, 1999.

Petitioner argues in the petition that the examiner made improper statements in the Order granting reexamination implying that the claim is unpatentable which were then raised in a court proceeding by the Requester and which have had an influence on the court and its procedures.

A review of the reexamination file shows that the Order was mailed at the end of the three month statutory period for deciding whether to grant or deny the reexamination request. Normally such orders are mailed well before the last day of the statutory period. However, the decision on the order was delayed due to the need to first address improper submissions by the third party Requester. Thus the examiner had little time to render a decision and have it reviewed for correctness of form prior to mailing in order to meet the statutory deadline. As a result statements which imply that the claim is unpatentable were included in the Order. Such conclusory statements about patentability in the order are improper on their face, but are not improper if interpreted as a statement pointing out a substantial new question of patentability as was the intent.

Applicant requests that a new order be issued which corrects the statements in the original Order. Applicant's petition is **GRANTED-IN-PART** to the extent that the above paragraph modifies the Order.

It is noted from papers filed by the third party Requester that a further stay of court proceedings has been granted to May 12, 2000. It is expected that an Office action in this reexamination proceeding will issue prior to that date and will set forth the position of the Office with respect to the claims of the patent under reexamination.

John Kittle
Director, Technology Center 1600/2900

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ALEXANDRIA, VA 22313-1450
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Paper No. 39

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(For Patent Owner)

Law Offices of John D. Long
2941 Sage Ridge Drive
Reno, NV 89509

(For Requester)

MAILED

MAR 30 2004

REEXAM UNIT

In re Deihl
Reexamination Proceeding
Control No. 90/005,411
Filed: July 2, 1999
For: U.S. Patent No. 4,525,341

DECISION GRANTING PETITION

This is a decision on the December 23, 2003, patent owner petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), based upon unintentional delay. The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $665.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) has been received.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The petition is accompanied by the petition fee. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the present petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The required reply to the non-final Office action of September 17, 2003, has been received.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 1600 for consideration of the response to the non-final Office action of September 17, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Frank Choi, of Group Art Unit 1616.

4. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

March 29, 2004

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,414	07/03/99	5424780	7422-R1

90/005,484

LM41/0128

WILLIAM S LIGHTBODY
1717 EAST NINTH STREET SUITE 2121
CLEVELAND OH 44114

EXAMINER
GRANT, C

ART UNIT	PAPER NUMBER
2711	7

DATE MAILED: 01/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

William S. Lightbody **LIGHTBODY LAW OFFICE** **1717 East 9th Street, Suite 2121** **Cleveland, Ohio 44114**	)	**FOR OWNER**
John J. Lauter **PENNIE & EDMONDS L.L.P.** **1155 Avenue of the Americas** **New York, N.Y. 10036-2711**	)	**FOR THIRD PARTY REQUESTOR**
In Re Cooper **Reexamination Proceeding** **Control No. 90/005,414** **Filed 7-3-99** **For U.S. Patent No. 5,414,780**	)	**DECISION SUA SPONTE MERGING REEXAMINATION PROCEEDINGS**
In Re Cooper **Reexamination Proceeding** **Control No. 90/005,484** **Filed 9-7-99** **For: U.S. Patent No. 5,424,780**	)	

The above noted reexamination proceedings are before the Director of Technology Center 2700 for consideration of merger of the proceedings under 37 CFR 1.56(c).

BACKGROUND

1. Patent No. 5,424,780 issued on June 13, 1995.

2. A first request for reexamination, Control No. 90/005,414 ('414) was filed by the Patent Owner on July 3, 1999.

3. Reexamination was ordered on the '414 reexamination proceedings on September 9, 1999.

4. A second request for reexamination, Control No. 90/005,484 ('484) was filed by the Third Party Requestor on September 7, 1999.

5. Reexamination was ordered on the '484 reexamination proceedings on October 25, 1999.

6. A request by the Patent Owner for merger of reexamination proceedings was filed on October 18, 1999 and supplemented on November 29, 1999.

DISCUSSION

37 CFR 1.565(c) states:

> "If reexamination is ordered while a prior reexaminations is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570".

DECISION

I. Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '414 and '484 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for the same amendment's in all proceedings.

The Patent Owner is required to maintain the same claims and specification in all three filed.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action, which applies to all proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for both filed and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each

bearing an original signature, for entry into each file. All papers filed by the Patent Owner must be served on the requestor and requestor will be sent copies of all papers mailed by the Office.

James L. Dwyer, Acting Director
Technology Center 2700
Communications & Information Processing

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,423	07/08/99	D402361	APU-003

HM11/0105

JEFFREY SZUMA
BROOKS AND KUSHMAN
1000 TOWN CENTER TWENTY SECOND FLR
SOUTHFIELD MI 48075

EXAMINER
CLARK, D

ART UNIT	PAPER NUMBER
2914	11

DATE MAILED: 01/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

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MAILED 01/05/01
TECH CENTER - 1600

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FOR PATENT OWNER

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TROY, MI 48084-3107

FOR REQUESTER

KEVIN D. McCARTHY
HODGSON, RUSS, ANDREWS, WOODS
& GOODYEAR
ONE M & T PLAZA, SUITE 2000
BUFFALO, NY 14203-2391

FOR REQUESTER

In re Gruda et al
Reexamination Proceeding
Control No.: 90/005,423
Filed: July 8, 1999
For: U.S.Patent No. D402,381

In re Gruda et al
Reexamination Proceeding
Control No.: 90/005,464
Filed: August 26, 1999
For: U.S.Patent No. D402,381

: DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

The above noted reexamination files are before the director of Technology Center 2900 for consideration of merger of the proceedings under 37 CFR 1.656(c).

BACKGROUND

1. Patent No. D402,381 issued December 8, 1998.

2. A first request for reexamination, Control No. 90/005,423, was filed by a first third party requester on July 8, 1999.

3. Reexamination was ordered in the '423 reexamination proceeding on October 5, 1999.

4. A second request for reexamination, Control No. 90/005,464, was filed by a second third party requester on August 26, 1999.

5. Reexamination was ordered in the '464 reexamination proceeding on November 3, 1999.

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above review of facts, reexamination has been ordered in both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '423 and '464 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

Patent Owner is required to maintain the same claim and specification in both files.

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the Patent Owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/005,423 and 90/005,464 are merged. In view of the merger the Notice of Intent to Issue a Reexamination Certificate (NIRC) issued in the '423 proceeding July 19, 2000, is vacated. The merged files will be forwarded to the examiner for action not inconsistent with this decision.

John Kittle
Director, Technology Center 3700/2900

Page 2 of 3 - 90/005,464

REEXAMINATION

90/005423

PATENT APPLICATION

90005423

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3.	Not. of Reex. Req. Fil. Dt.	7/16/99
4.	" " Assigned Grp.	7/16/99
5.	R.E.X.O.	05 OCT 1999
6.	IDS	11/20/00
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8.	~~Date of Mailing~~ Notice of Intent to Issue Reexam	2-14-00
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Paper No. 7

CHRISTENSEN, O'CONNER, JOHNSON & KINDNESS
Suite 2800
1420 Fifth Avenue
Seattle, WA 98101-2347

(For Patent Owner)

MAILED
APR 0 6 2001
REEXAM UNIT

In re Gleason
Reexamination Proceeding
Control No. 90/005,431
Ordered by USPTO: August 9, 1999
For: U.S. Patent No. 5,762,251

DECISION
DISMISSING
PETITION

This is a decision on the February 20, 2001, patent owner PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 C.F.R. § 1.137(b) is **dismissed** for the reasons indicated below.

Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are **not** permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(b)."

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee as set forth in 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The instant petition is accompanied by the petition fee under 37 C.F.R. § 1.17(m). The instant petition lack(s) item(s) (1) and (3) above.

This reexamination proceeding terminated after December 11, 2000, for failure to timely file a response within the meaning of 37 C.F.R. § 1.113 to the final Office action of October 11, 2000, which set a shortened statutory period for response of two (2) months, and noted that extensions of time were governed by 37 C.F.R. § 1.550(c). The proposed response required for consideration of the present petition to revive must be:

(A) a Notice of Appeal (and appeal fee); or

(B) an amendment in the proper format for a reexamination proceeding that cancels all the rejected claims or otherwise *prima facie* places the reexamination proceeding in condition for issuance of a Notice of Intent to Issue Reexamination Certificate (NIRC).

With regard to the required reply of item (1) above, in accordance with MPEP 711.03(c), for amendments submitted after a final Office action, patent owner's proposed response of February 20, 2001, has been referred to the primary examiner, who has determined that the late paper does not *prima facie* place this proceeding in condition for issuance of an NIRC. Attached is page 2 of the examiner's report, which is the relevant portion of the examiner's commentary on the proposed response.

Specifically, Primary Patent Examiner Renee S. Luebke has indicated that the proposed amendment to claim 1 does not overcome the rejection of record, as the "adjustment mechanism of Wilkes involves the sliding rotation of rod 33 in relation to link 17." Also, the examiner notes that patent owner has proposed to add "two additional claims, without cancelling a corresponding number of finally rejected claims." She further indicates that patent owner "has neither addressed the patentability of these claims nor addressed the issue of why these claims were not earlier presented." Therefore, the proposed response of February 20, 2001, is **not** a response within the meaning of 37 C.F.R. § 1.113 to the final Office action of October 11, 2000, as it does not cancel all the rejected claims or otherwise *prima facie* place the reexamination proceeding in condition for issuance of an NIRC. Accordingly, any renewed petition must include a Notice of Appeal (and appeal fee).

Concerning item (3) above, 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3), and is **not** sufficient to meet the requirement of 37 C.F.R. § 1.137(b)(3), as it merely indicates that "the entire delay from the response due date to the date of this Petition was unintentional." Accordingly, any renewed petition should include the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

In view of the above, the petition is **not** sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **dismissed**.

CONCLUSION

1. The petition is **dismissed**.

2. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision and must include a Notice of Appeal (and appeal fee).

3. Further correspondence with respect to this matter should be addressed as follows:

By mail:	Assistant Commissioner for Patents Box DAC Washington, D.C. 20231
By FAX:	(703) 308-6916 Attn: Office of Petitions
By hand:	Crystal Plaza Four, Suite 3C23 2201 South Clark Place Arlington, VA

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

April 5, 2001

The proposed amendment after final, filed February 16, 2001, does not place claims 1, 2 and 9 in condition for allowance. In particular, the amendment to claim 1 does not overcome the rejection. The adjustment mechanism of Wilkes involves the sliding rotation of rod 33 in relation to link 17.

Further, applicant has added two additional claims, without cancelling a corresponding number of finally rejected claims. Applicant has neither adressed the patentability of these claims nor adressed the issue of why these claims were not earlier presented.

This amendment should not be entered.

Renee S. Luebke
Primary Patent Examiner
February 26, 2001

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Paper No. 12

CHRISTENSEN, O'CONNER, JOHNSON & KINDNESS
Suite 2800
1420 Fifth Avenue
Seattle, WA 99101-2347

(For Patent Owner)

MAILED

JUN 29 2001

REEXAM UNIT

In re Gleason
Reexamination Proceeding
Control No. 90/005,431
Ordered by USPTO: August 9, 1999
For: U.S. Patent No. 5,762,251

DECISION GRANTING PETITION

DO NOT ENTER

This is a decision on the April 17, 2001, patent owner RENEWED PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

DECISION

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the renewed petition contains the language required by 37 C.F.R. § 1.137(b)(3).

The renewed petition is accompanied by a proposed amendment filed in response to the final rejection of October 11, 2000, along with a notice of appeal. The instant petition was accompanied by a check for $300 for the appeal fee under 37 C.F.R. § 1.17(b), and the $10 deficiency in such fee has been charged to deposit account no. 03-1740, as per patent owner's instructions on page 1 of the notice of appeal. The petition fee under 37 C.F.R. § 1.17(m) was paid with the original petition of February 20, 2001. In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is granted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 2800 for consideration of the notice of appeal and proposed amendment of April 17, 2001, as well as the appeal brief of June 11, 2001.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the examiner, Renee Luebke in Technology Center Art Unit 2833.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

June 27, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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WASHINGTON, DC 20231
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(For Requester)

Philip S. Johnson
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New Brunswick NJ 08933

(For requester)

Reexam Control No.: 90/005,435
Filed: July 27, 1999
For: U.S. Patent No. 5,769,880

Reexam Control No.: 90/005,866
Filed: November 22, 2000
For: U.S. Patent No. 5,769,880

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application Control No. 90/005,435 was ordered in a decision mailed October 14, 1999. Prosecution progressed through to the filing of a Notice of Appeal on February 27, 2001.

Reexamination in application Control No. 90/005,866 was ordered in a decision mailed February 15, 2001. On February 27, 2001, patent owner filed a waiver of the right to file a patent owner statement under 37 CFR 1.530.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending. In view of the above, merger is appropriate and is hereby ordered.

Requirement for Same Claims in Both Proceedings

The patent owner is required to maintain identical specifications, claims and claim numbering in both files. Accordingly, patent owner is required to submit a "housekeeping" amendment within **one month** of the mailing date of this decision placing identical claims in both files. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on requesters and requesters will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/005,435 and 90/0005,866 are hereby merged. Upon receipt of the required paper placing the same claims in both files, an Office action will issue in due course. The paper must be submitted within **one month** of the mailing date of this decision.

John E. Kittle, Director
Technology Center 3700
Phone: (7030 308-0873

ak5/22/01

Control Numbers

UNITED STATES PATENT AND TRADEMARK OFFICE

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Reexam Control No.: 90/005,435
Filed: July 27, 1999
For: U.S. Patent No. 5,769,880

Reexam Control No.: 90/005,866
Filed: November 22, 2000
For: U.S. Patent No. 5,769,880

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application Control No. 90/005,435 was ordered in a decision mailed October 14, 1999. Prosecution progressed through to the filing of a Notice of Appeal on February 27, 2001.

Reexamination in application Control No. 90/005,866 was ordered in a decision mailed February 15, 2001. On February 27, 2001, patent owner filed a waiver of the right to file a patent owner statement under 37 CFR 1.530.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending. In view of the above, merger is appropriate and is hereby ordered.

Requirement for Same Claims in Both Proceedings

The patent owner is required to maintain identical specifications, claims and claim numbering in both files. Accordingly, patent owner is required to submit a "housekeeping" amendment within **one month** of the mailing date of this decision placing identical claims in both files. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on requesters and requesters will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/005,435 and 90/0005,866 are hereby merged. Upon receipt of the required paper placing the same claims in both files, an Office action will issue in due course. The paper must be submitted within **one month** of the mailing date of this decision.

John E. Kittle, Director
Technology Center 3700
Phone: (7030 308-0873

ak5/22/01

Control Numbers

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

FEB 14 2000

#24

Knobbe, Martens, Olson & Bear, LLP
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Newport Beach, CA 92660

Richard J. Minnich
Fay, Sharpe, Beall, Fagan, Minnich & McKee (For Requester)
1100 Superior Avenue, 7th Floor
Cleveland, OH 44114-2518

In re Gunzel, Jr., et al. :
Reexamination Proceeding :
Control No. 90/005,176 :
Filed: December 4, 1998 :
For U.S. Patent No. 5,039,016 :
: MERGER OF REEXAMINATION
In re Gunzel, Jr., et al. : PROCEEDINGS
Reexamination Proceeding :
Control No. 90/005,437 :
Filed: July 28, 1999 :
For U.S. Patent No. 5,039,016 :

The above noted reexamination files are before the Director of Examining Groups 3740 and 3750 for consideration of merger of the proceedings under 37 CFR § 1.656(c).

BACKGROUND

1. U.S. Patent No. 5,039,016 issued on August 13, 1991.

2. A first request for reexamination, Control No. 90/005,176, was filed by the requester on December 4, 1998.

3. Reexamination was ordered in the '176 reexamination proceeding on February 3, 1999.

4. A first Office action, containing a rejection of claims 15 and 16 and a confirmation of the patentability of claims 1-14, was mailed on May 21, 1999, as paper No. 6.

5. In response to the first Office action, an amendment was filed on July 23, 1999, which contained amendments to claims 15 and 16 and proposed the addition of claims 17 and 18. Claims 15 and 16 were entered, but claims 17 and 18 were not entered because they are not in compliance with the claim format provisions of 37 CFR 1.530(d)(2).

6. A second request for reexamination, Control No. 90/005,437, was filed by the requester on July 28, 1999.

7. Reexamination was ordered in the '437 reexamination proceeding on October 25, 1999.

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

Since reexamination has been ordered in both of the above noted reexamination proceedings, the time for the patent owner to file a statement in both proceedings has expired, merger of the proceedings under 37 CFR § 1.565(c) is appropriate.

MPEP Section 2283 indicates that if two requests for reexamination are filed with respect to the same patent, after the second request has been decided, and the time for the patent owner's statement in response to the reexamination order has expired, the proceeidngs will be merged.

Under the circumstances, it is considered proper to merge these proceedings at this point in time.

Even though claims 17 and 18 do not comply with the claim format provisions of 37 CFR 1.530(d)(2), they should be considered on the merits because they were filed timely in response to a first Office action in the '176 proceeding.

DECISION

1. Merger of Proceedings.

In accordance with 37 CFR § 1.565(c), the '176 and '437 reexamination proceedings are merged. The basis of the merged reexamination proceeding will be claims 1 through 18.

2. Conduct of Merged Proceedings.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. The patent owner shall maintain the same claims in both proceedings. All

papers filed by the patent owner must be served on the requester and the requester will be sent copies of all papers mailed by the Office.

HOUSEKEEPING AMENDMENT

The patent owner is required to promptly file, in this merged proceeding, a corrected copy of the amendment filed on July 23, 1999, i.e., a copy of the amendment in which claims 17 and 18 comply with the provisions of 37 CFR 1.530(d)(2), and which is captioned as a housekeeping amendment. By "promptly" is meant within one month of the date of this paper.

An Office action will issue in due course.

Any questions regarding the merged proceeding should be directed to Mr. Robert J. Webster, Special Program Examiner, Groups 3740 and 3750, at (703) 308-2619.

CONCLUSION

Reexamination control Nos. 90/005,176, and 90/005,437 are merged.

Ira Lazarus
Acting Director
Technology Center 3700400
Phone: (703) 308-1935
Fax: (703) 308-7764

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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#9
(mai)

Paper No. 9

Allen Ratner (For Patent Owner)
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Stanford M. Altschul, Esq. (For Requester)
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MAILED

FEB 2 1 2001

REEXAM UNIT

In re Sera et al.
Reexamination Proceeding
Control No. 90/005,438
Filed: July 30, 1999
For: U.S. Patent No. 5,461,202

DECISION GRANTING PETITION

This is a decision on the January 30, 2001, patent owner PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

DECISION

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The instant petition is accompanied by a response, including an amendment, to the outstanding non-final Office action of June 1, 2000, and the petition fee under 37 C.F.R. § 1.17(m). In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is granted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 2800 for consideration of the amendment.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, K. Cuneo, in Technology Center 2800.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

February 16, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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#9
(mai)

Paper No. 9

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Mineola, NY 11501-2593

MAILED

FEB 2 1 2001

REEXAM UNIT

In re Sera et al.
Reexamination Proceeding
Control No. 90/005,438
Filed: July 30, 1999
For: U.S. Patent No. 5,461,202

DECISION GRANTING PETITION

This is a decision on the January 30, 2001, patent owner PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

DECISION

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The instant petition is accompanied by a response, including an amendment, to the outstanding non-final Office action of June 1, 2000, and the petition fee under 37 C.F.R. § 1.17(m). In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is granted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 2800 for consideration of the amendment.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, K. Cuneo, in Technology Center 2800.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

February 16, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www uspto gov

Paper No. 12

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Valley Forge, PA 19482

(For Patent Owner)

Stanford M. Altschul
174 Mineola Blvd.
Mineola, NY 11501-2593

(For Third Party Requester)

MAILED

21 JUN 2002

JUN 21 2002

OFFICE OF THE SPECIAL PROGRAMS EXAMINER

In re Naoki Sera et al.)
Reexamination Proceeding)
Control No. 90/005,438)
Filed: July 30, 1999)
For: U.S. Patent No. 5,461,202)
Title: FLEXIBLE WIRING BOARD AND ITS FABRICATION METHOD)

DECISION ACCEPTING PAPERS

This is a decision accepting the papers filed June 10, 2002, via facsimile transmission, as being timely filed in response to the Office communication mailed September 6, 2001.

A communication was mailed on September 6, 2001, setting a two-month time period for submitting a response to the rejections of claims 1, 2, 7-10, and 15-28. In the absence of receipt of a response, a telephone call was directed to the patent owner's counsel to inquire whether a response was timely submitted. The papers filed June 10, 2002, was submitted to establish that a response to the communication was timely filed received in the Patent and Trademark Office on January 4, 2002.

The patent owner has submitted a copy of a postcard receipt which acknowledges receipt by the U.S. Patent and Trademark Office of an amendment along with a Certificate of Service on January 4, 2002. A copy of the amendment with the Certificate of Service were submitted with the copy of the postcard receipt.

Pursuant to M.P.E.P. § 503, "A post card receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, it is concluded that the amendment and the cover letter listed on the postcard receipt were received in the PTO but lost after receipt thereof. Further, the amendment bears a certificate of Mailing under 37 C.F.R. § 1.8(a) with a deposit date of November 6, 2001. Pursuant to the provisions of 37 C.F.R. § 1.8, the amendment is hereby accepted as being timely filed.

In view of the above stated reasons, it is hereby determined that a response to the Office action of September 6, 2001 was timely filed and the copy of the amendment submitted April 4, 2001 is hereby accepted for entry in the file record since the PTO has apparently misplaced the originally submitted papers. June 10 2002

It is noted that the information listed on the amendment and on the postcard receipt is for the patent under reexamination. To allow for proper matching of papers, it is suggested that in formation regarding this reexamination proceeding be used in future communications with the PTO.

The reexamination file is being forwarded to the technical support staff for entry of the amendment. From there, the file will be returned to the examiner for further examination.

A copy of the papers filed June 10, 2002, is enclosed for the third party requester.

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

enclosure: copy of papers filed June 10, 2002 for third party requester

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,438	07/30/1999		REEXAMINATIO	2892

7590 06/27/2005

ALLEN RATNER
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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RATNER & PRESTIA
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(For Patent Owner)

MAILED

JUN 2 7 2005

STANFORD M ALTSCHUL
174 MINEOLA BLVD
MINEOLA NY 11501-2593

(For Third Party Requester) REEXAM UNIT

In re Reexamination Proceeding :
N. Sera et al. :
Control No. 90/005,438 : DECISION GRANTING PETITION
Filed: October 5, 1993 :
U.S. Patent No. 5,461,202 :
Attorney Docket No. MAT-F00911 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on April 29, 2005, requesting acceptance of a delayed response and revival of the present reexamination preceding.

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

37 CFR 1.137(b) states:

> *"Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

The present petition under 37 CFR 1.137(b) includes the requisite response (item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition is granted.

The reexamination file is being returned to Technology Center Art Unit 2841 for further examination and consideration of the amendment filed April 29, 2005, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, J. Vigushin, in Technology Center Art Unit 281, who can be reached at 571-272-1936

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Conferee: Fred A. Silverberg

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 10

Price Heneveld Cooper Dewitt & Litton
695 Kenmoor, S.E.
P.O. Box 2567
Grand Rapids, MI 49501

(for patent owner)

MAILED

APR 13 2001

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Stam *et al.*
Reexamination Proceeding
Control Number 90/005,439
Filed: July 30, 1999
For: U.S. Patent No. 5,837,994

DECISION ON REQUEST

This is a decision on the request to withdrawal as attorney filed July 24, 2000. The request was signed by Mark D. Chuey of the firm Brooks & Kushman P.C.

The request is **dismissed** as moot.

A review of the patented and reexamination file records reveal that Mark D. Chuey is not named as having power of attorney in the patented file nor has he been accorded power of attorney in the above-identified reexamination proceeding. Mr. Chuey, therefore, is not an attorney or agent of record in this reexamination proceeding. Accordingly, the request cannot be accepted and must be dismissed.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by patent owner.

A courtesy copy of this decision has been mailed to Mark D. Chuey, the practitioner who filed the request, at the below-listed address.

Inquiries concerning this decision should be directed to Ed Glick, Special Programs Examiner, at (703) 308-4858.

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: Mark D. Chuey
Brooks & Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, Michigan 48075

enclosure to patent owner: copy of the Request for Withdrawal, filed July 24, 2000.

#6

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,448	08/12/99	5449519	PMS-224813

HM32/1129

GERALD J. FLINTOFT
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1155 AVENUE OF THE AMERICAS
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EXAMINER	
SEIDLECK, B	

ART UNIT	PAPER NUMBER
1615	06

DATE MAILED: 11/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Control Number: 90/005,448

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

#(

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11/29/00

GERALD J FLINTOFT
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1155 AVENUE OF THE AMERICAS
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FOR PATENT OWNER

DONALD J. BIRD
PILSBURY MADISON & SUTRO
INTELLECTUAL PROPERTY GROUP
1100 NEW YORK AVE., NW
NINTH FLOOR, EAST TOWER
WASHINGTON, D.C 20005-3918

FOR REQUESTER

In re Wolf et al
Reexamination Proceeding
Control No.: 90/005,134
Filed: October 1, 1998
For: U.S.Patent No. 5,449,519

In re Wolf et al
Reexamination Proceeding
Control No.: 90/005,448
Filed: August 12, 1999
For: U.S.Patent No.5,449,519

: DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

The above noted reexamination files are before the director of Technology Center 1600 for consideration of merger of the proceedings under 37 CFR 1.656(c).

BACKGROUND

1. Patent No. 5,449,519 issued September 12, 1995.

2. A first request for reexamination, Control No. 90/005,134, was filed by patent owner on October 1, 1998.

3. Reexamination was ordered in the '134 reexamination proceeding on December 21, 1998

4. A second request for reexamination, Control No. 90/005,448, was filed by third party requester on August 12, 1999.

5. Reexamination was ordered in the '448 reexamination proceeding on October 1, 1999

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above review of facts, reexamination has been ordered in both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate. The delay in merging these proceedings is regretted.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '134 and '448 reexamination proceedings are merged. In view of the merger the Notice of Intent to Issue a Reexamination Certificate in the '134 proceeding is withdrawn. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

Patent Owner is required to maintain the same claims and specification in both files. **Patent Owner is required to submit an appropriate "housekeeping" amendment within ONE MONTH of this decision placing the same amendments in both files**. The paper should strictly be limited to the bare presentation of the necessary amendments. Any discussion of the merits or issues of the proceeding would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the Patent Owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/005,1234 and 90/005,448 are merged. Upon receipt of the required paper placing the same amendments in both files, an Office action will issue in due course.

John Doll
Director, Technology Center 1600

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 47

Ronald W. Citkowski (for Patent Owner)
GIFFORD, KRASS, GROH, SPRINKLE,
ANDERSON & CITKOWSKI, P.C.
280 N. Old Woodward, Suite 400
Birmingham, MI 48009

Michael B. McMurry (for Requester)
1210 Astor Street
Chicago, IL 60610

MAILED
JAN 27 2000
REEXAM UNIT

Reexamination of U.S. Patent No. 5,383,829 to Miller.

Control No. 90/005,450
Filed: August 13, 1999

Control No. 90/005,561
Filed: November 12, 1999

DECISION DISMISSING PETITION

This is a decision on the September 2, 1999, patent owner petition under 37 CFR 1.182 which requests denial of the request for reexamination filed August 13, 1999, by third party requester Life Fitness.

This petition is before the Office of the Deputy Assistant Commissioner for Patent Policy and Projects for decision.

The petition is **DISMISSED** for the reasons set forth below.

REVIEW OF FACTS

1. On January 24, 1995, U.S. Patent No. 5,383,829 (the '829 patent) was issued.

2. On November 25, 1997, the patent owner, Larry Miller, filed a first request for reexamination of the '829 patent, which request was assigned Control No. 90/004,848.

3. On February 6, 1998, an order granting reexamination was mailed in Control No. 90/004,848.

4. On April 17, 1998, a third party requester, the NordicTrack Corporation, filed a second request for reexamination of the '829 patent, which request was assigned Control No. 90/005,030.

5. On May 15, 1998, a third party requester, the Brunswick Corporation, filed a third request for reexamination of the '829 patent, which request was assigned Control No. 90/004,999.

6. On July 9, 1998, an order granting reexamination was mailed in Control No. 90/005,030.

7. On July 14, 1998, an order granting reexamination was mailed in Control No. 90/004,999.

8. On March 18, 1999, a decision merging reexamination Control Nos. 90/004,848, 90/005,030 and 90/004,999 was mailed.

9. A nonfinal Office action for the merged proceeding of Control Nos. 90/004,848, 90/005,030 and 90/004,999 was mailed on May 5, 1999. Patent owner filed, on July 6, 1999, a response to the nonfinal Office action.

10. On August 13, 1999, a third party requester, the Life Fitness division of the Brunswick Corporation, filed a fourth request for reexamination of the '829 patent, which request was assigned Control No. 90/005,450.

11. On September 2, 1999, the present petition was filed by the patent owner, Larry Miller, requesting denial of the reexamination request Control No. 90/005,450 as harassment of the patent owner.

12. On October 18, 1999, an order granting reexamination was mailed in Control No. 90/005,450. The period for filing a patent owner's statement under 37 CFR 1.530 after the request has expired.

13. On November 12, 1999, Life Fitness filed a fifth request for reexamination of the '829 patent, which request was assigned Control No. 90/005,561.

14. A decision on the request for reexamination of U.S. Patent No. 5,383,829, in Control No. 90/005,561 has not yet been mailed.

DECISION

MPEP section 2240 sets forth the criteria for a decision on a request for reexamination, and this section specifically addresses second or subsequent requests filed during reexamination. This section indicates that "If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should generally be ordered. This is because the prior art which raised a substantial new question of patentability resulting in an order for reexamination continues to raise a substantial new question of patentability until the pending reexamination is concluded."

MPEP section 2240 also indicates that "upon petition by the patent owner under 37 C.F.R. §1.182, where it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, the request should be denied. The grant of such a request would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement that reexamination proceeding be conducted with special dispatch."

The present petition under 37 CFR 1.182 requesting denial of the request for reexamination of the '829 patent is **DISMISSED**.

With regard to the harassment issue raised by Patent Owner, consideration is being given to this issue with regard to the requests in both Control Nos. 90/005,450 and 90/005,561 reexamination proceedings, the '5,561 proceeding being addressed *sua sponte* by the U.S. Patent & Trademark Office. Accordingly, a copy of this decision is being placed in both the 90/005,450 and 90/005,561 files.

A review of the records for the reexamination proceedings reveals that the fourth and fifth requests for reexamination (Control Nos. 90/005,450 and 90/005,561) included the prior art that raised a substantial new question in the merged proceeding of Control Nos. 90/004,848, 90/005,030 and 90/004,999, along with additional prior art, and additional evidence. Based on this, reexamination could generally be ordered because the prior art which raised a substantial new question of patentability in the merged proceeding continues to raise a substantial new question of patentability until the merged proceeding is concluded.

In addition, the August 13, 1999, fourth request for reexamination (Control No. 90/005,450) was filed less than 6 weeks after the patent owner's July 6, 1999, response to the May

5, 1999, nonfinal Office action in the merged proceeding (of Control Nos. 90/004,848, 90/005,030 and 90/004,999). Thus, it does not appear that granting of the fourth request would unduly prolong the conclusion of the pending merged reexamination proceeding. Similarly, the November 12, 1999, fifth request for reexamination (Control No. 90/005,561)by the Life Fitness division of the Brunswick Corporation was filed less than one month after the October 18, 1999 order granting reexamination in Control No. 90/005,450. Thus, it does not appear that granting of the fifth request would unduly prolong the conclusion of the pending merged reexamination proceedings.

Since there is no showing that the granting of the fourth and fifth requests for reexamination would unduly prolong the conclusion of the pending merged reexamination proceeding, it has not been established that the fourth or fifth requests were filed for purposes of harassment of the patent owner. The grant of the fourth and fifth requests, and consideration of them, has not been shown to provide a delay of sufficient duration to interfere with the "special dispatch" requirement for the merged reexamination proceeding.

HANDLING OF THE PROCEEDINGS
BY THE TECHNOLOGY CENTER

1. The examiner is directed to issue a decision on the fifth request for reexamination (90/005,561) immediately upon return of the reexamination proceedings to the Technology Center 3700.

2a. If reexamination *is granted* for the 90/005,561 proceeding, the five proceedings will be forwarded to the Group Director of Technology Center 3700 for issuance of a decision merging the 90/005,450 and 90/005,561 proceedings with the merged proceeding of Control Nos. 90/004,848, 90/005,030 and 90/004,999 at the appropriate time.

2b. If reexamination *is denied* for the 90/005,561 proceeding, the reexamination proceedings will be forwarded to the Group Director of Technology Center 3700 for issuance of a decision merging the present 90/005,450 proceeding with the merged proceeding of Control Nos. 90/004,848, 90/005,030 and 90/004,999.

CONCLUSION

The petition is **DISMISSED**.

The reexamination files are being forwarded to the Group Director of Technology Center 3700, for processing not inconsistent with this decision.

Telephone inquires related to this decision should be directed to Lynn M. Kryza of the Special Program Law Office, at (703) 306-5682.

Kenneth M. Schor
Senior Legal Advisor
Special Program Law Office

January 27, 2000

90005450 .081399

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

#8

Reexam Control No.: 90/004,848
Filed: November 25, 1997
For: U.S. Patent No. 5,383,879

Reexam Control No.: 90/004,999
Filed: June 04, 1998
For: U.S. Patent No. 5,383,879

Reexam Control No.: 90/005,030
Filed: July 02, 1998
For: U.S. Patent No. 5,383,879

Reexam Control No.: 90/005,450
Filed: August 18, 1999
For: U.S. Patent No. 5,383,879

Reexam Control No.: 90/005,561
Filed: November 17, 1999
For U.S. Patent No.: 5,383,879

MAILED
JUN 14 2000
Group 3700

DECISION MERGING
REEXAMINATION
PROCEEDINGS

05/15/2000

The above reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in 90/004,848 was ordered in a decision mailed February 06, 1998. Reexamination in 90/004,999 was ordered in a decision mailed July 14, 1998. Reexamination in 90/005,030 was ordered in a decision mailed July 09, 1998. Reexamination in 90/005,450 was ordered in a decision October 18, 1999. Reexamination in 90/005,561 was ordered in a decision mailed February 03, 2000.

The first three reexamination proceedings are already merged. Merger is proper if a reexamination is ordered while a prior reexamination proceedings are pending. Accordingly, merger is appropriate for 90/005,450 and 90/005,561 and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims and identical claim numbering in all five files. A housekeeping amendment is required in 90/005450 and in 90/005561.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action which applies to all five reexamination files. The action will contain identifying data for all files and will be physically entered in each reexamination file. Any response filed by the Patent Owner must consist of a single response filed with four copies, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See CFR 1.550(e).

At this time the Patent Owner is required to file a housekeeping amendment in Reexamination Proceedings 90/005,450 and 90/005,561 so that the claims in all three proceedings are identical in content and numbering. The Patent Owner is given 1 month from the date of this letter to file the housekeeping amendments.

John J. Love

John J. Love, Director
Technology Center 3700

JJL:amo

Ronald W. Citkowski
Gifford, Krass, Groh, Sprinkle,
Anderson and Citkowski
280 N. Old Woodward, Suite 400
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(For Patent Owner)

90/004,999
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90/005,561

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Brunswick Corporation
1210 Astor Street
Chicago, IL 60610

(For Requester)

90005450.081399

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,454	08/17/99	5746919	P04159US2

EXAMINER	
WYSE, T	
ART UNIT	PAPER NUMBER
1724	9

IM22/0406

DONALD H ZARLEY
ZARLEY MCKEE THOMTE VOORHEES AND SEASE
801 GRAND AVENUE SUITE 3200
DES MOINES IA 50309-2721

DATE MAILED: 04/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

JWM
Paper No. 9

Ms. Wendy K. Marsh
Zarley, McKee, Thomte, Voorhees & Sease
801 Grand Avenue
Suite 3200
Des Moines, IA 50309

(for Patent Owner)

In re Dague et al
Reexamination Proceeding
Control No. 90/005,454
Filed August 17, 1999
For: U.S. Patent No. 5,746,919

DECISION ON PETITION
UNDER 37 CFR 1.183
TO WAIVE OR SUSPEND
37 C.F.R. 1.550(c)

This is a decision on the PETITION UNDER 37 C.F.R. 1.183 FOR SUSPENSION OR WAIVER OF 37 C.F.R. 1.550(c), filed March 20, 2000 by the Patent Owner, requesting that the USPTO waive or suspend that portion of 37 C.F.R. 1.550(c) which requires that a request for an extension of time be filed on or before the day on which a response is due. The petitioner states that to continue with the instant reexamination proceeding without entry of the amendment accompanying the PATENT OWNER'S STATEMENT and PETITION AND FEE FOR EXTENSION OF TIME of January 19, 2000 would create an unnecessary use of USPTO resources, i.e., preparing a first office action on the claims as originally filed, followed by entering and treating exactly the same amendment as filed on January 19, 2000 when filed in response to the first office action. The petitioner further asserts that, since the instant reexamination proceeding is a patent owner request for a reexamination, no third parties would be prejudiced by considering the PATENT OWNER'S STATEMENT of January 19, 2000 as a timely filing pursuant to 37 C.F.R. 1.550(c).

BACKGROUND

1. US Patent No. 5,746,919 issued on May 5, 1998 from US Application. No. 08/656,607, filed May 31, 1996, which is a continuation-in-part of US Application. No. 08/316,860, filed October 3, 1994, which is in turn a continuation of US Application No. 08/124,871, filed September 23, 1993, now abandoned.

2. A Request for Reexamination was filed on August 17, 1999 with respect to US Patent No. 5,746,919. The request was granted on October 19, 1999, and set a TWO (2) month period for filing a patent owner's statement, pursuant to 37 C.F.R. 1.530(b).

3. On January 19, 2000, the Patent Owner filed a PATENT OWNER'S STATEMENT and PETITION AND FEE FOR EXTENSION OF TIME under 37 C.F.R. 1.136(a).

DECISION

A careful review of the reexamination record reveals that the petitioner's request has merit. Specifically, 35 U.S.C. 304 - Reexamination order by Commissioner - states:

> "If, in a determination made under the provisions of subsection 303(a) of this title, the Commissioner finds that a substantial new question of patentability affecting any claim of a patent is raised...The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to...file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination..." (Emphasis added)

Additionally, 37 C.F.R. 1.530 - Statement and amendment by patent owner - sets forth:

> "(b) The order for reexamination will set a period of not less than two months from the date of the order within which the patent owner may file a statement on the new question of patentability including any proposed amendments the patent owner wishes to make.
>
> (c) Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Any statement filed must be served upon the reexamination requester in accordance with § 1.248.
>
> (d) Any proposed amendments to the description and claims must be made in accordance with § 1.121(f)...."

While 37 C.F.R. 1.550 - Conduct of reexamination proceedings - points out that:

> "(c) The time for taking any action by a patent owner in a reexamination proceeding will be extended only for sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension...." (Emphasis added)

Given the advantages of avoiding unnecessary paperwork for both the patent owner and the Office for this patent owner filed reexamination proceeding, and since 35 U.S.C. 304 and 37 C.F.R. 1.530(b) permit the setting of a period for response of greater than two (2) months from the date of mailing of the grant of reexamination, the instant petition is accepted as a petition under 37 C.F.R. 1.530(b) to reset the period for response to the grant of reexamination to three months from the date of mailing on October 19, 1999, which is hereby granted.

Accordingly, the period for response to file a patent owner's statement has been reset to expire three months (3) from the October 19, 1999 mailing date, i.e., the response period would expire on January 19, 2000. As a consequence, the filing of a PATENT OWNER'S STATEMENT on January 19, 2000 is considered to be a timely patent owner's statement, and the accompanying PETITION AND FEE FOR EXTENSION OF TIME (37 C.F.R. 1.136(a)) is deemed to be unnecessary and rendered moot.

The Petition is **GRANTED**.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
99/003,464	05/26/99	D402381	28809.0000

HM11/0105

JEFFREY M SZUMA
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EXAMINER
CLARK, D

ART UNIT	PAPER NUMBER
2914	09

DATE MAILED: 01/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95) U.S. G P.O 1999 460-693 1- File Copy

#7

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Washington, D.C. 20231

MAILED 01/05/01
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FOR PATENT OWNER

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TROY, MI 48084-3107

FOR REQUESTER

KEVIN D. McCARTHY
HODGSON, RUSS, ANDREWS, WOODS
& GOODYEAR
ONE M & T PLAZA, SUITE 2000
BUFFALO, NY 14203-2391

FOR REQUESTER

In re Gruda et al
Reexamination Proceeding
Control No.: 90/005,423
Filed: July 8, 1999
For: U.S.Patent No. D402,381

In re Gruda et al
Reexamination Proceeding
Control No.: 90/005,464
Filed: August 26, 1999
For: U.S.Patent No. D402,381

: DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

The above noted reexamination files are before the director of Technology Center 2900 for consideration of merger of the proceedings under 37 CFR 1.656(c).

BACKGROUND

1. Patent No. D402,381 issued December 8, 1998.

2. A first request for reexamination, Control No. 90/005,423, was filed by a first third party requester on July 8, 1999.

3. Reexamination was ordered in the '423 reexamination proceeding on October 5, 1999.

4. A second request for reexamination, Control No. 90/005,464, was filed by a second third party requester on August 26, 1999.

5. Reexamination was ordered in the '464 reexamination proceeding on November 3, 1999.

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above review of facts, reexamination has been ordered in both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '423 and '464 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

Patent Owner is required to maintain the same claim and specification in both files.

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the Patent Owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/005,423 and 90/005,464 are merged. In view of the merger the Notice of Intent to Issue a Reexamination Certificate (NIRC) issued in the '423 proceeding July 19, 2000, is vacated. The merged files will be forwarded to the examiner for action not inconsistent with this decision.

John Kittle
Director, Technology Center 3700/2900

UNITED STATES DEPARTMENT OF COMMERCE
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Washington, D.C. 20231

Mailed

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Group 2700

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30 N LASALLE STREET SUITE 2630
CHICAGO , IL 60602

Paper No. 13

U.S. Patent Number: 5,017,903
Reexamination Control No.: 90/005,468
Filed: August 30, 1999
For: EMERGENCY LIGHT

DECISION ON REQUEST FOR EXTENSION OF TIME

This is a decision on a request for an extension of time under 37 C.F.R. § 1.550 filed on June 28, 2000. The request is for an extension of time of one month. This petition requests an extension until August 5, 2000 to respond to the Office action of June 5, 2000.

Pursuant to 37 C.F.R. § 1.550(c):

> *The time for taking any action by a patent owner in a reexamination proceeding will be extended only for a sufficient cause, and for a reasonable time specified. Any request for such an extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of the request effect any extension. See Section 1.304(a) for extensions of time for filing a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.*

The request sets forth sufficient cause and indicates a situation beyond the ordinary in which the owner would have difficulty in responding within the period set forth in the last Office action.

Accordingly, the request is **GRANTED**.

The Owner is reminded of the requirement under 35 U.S. § 305 to conduct reexamination proceedings with special dispatch.

Jin F. Ng, Director
Technology Center 2700
Communications and Information Processing

Page 2 of 2 - 90/0005,468

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

Paper No. 20

David L. Stewart
MCDERMOTT, WILL & EMERY
600 13TH Street, N.W.
Washington, D.C. 20005

(For Patent Owner)

MAILED

JUN 0 8 2001

REEXAM UNIT

In re reissue application of
Nally, et al.
Serial No. 09/374,041
Filed: August 13, 1999
For: U.S. Patent No. 5,598,525

In re Nally, et al.
Reexamination Proceeding
Control No. 90/005,471
Filed: August 13, 1999
For: U.S. Patent No. 5,598,525

DECISION, SUA SPONTE, TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,598,525 issued to Nally, et al. on January 28, 1997.

2. A request for reexamination of the `525 patent was filed on August 13, 1999, by patent owner and the resulting reexamination proceeding was assigned Control No. 90/005,471.

3. On the same date, August 13, 1999, patent owner filed a reissue application which was assigned Application No. 09/374,041.

4. Notice of the filing of the reissue application was published in the *Official Gazette* on September 28, 1999.

5. On October 21, 1999, reexamination was ordered in the `5471 proceeding.

6. A non-final Office action was mailed in the `5471 proceeding on July 31, 2000, which set a shortened statutory period for response of one month, due to concurrent litigation that has been stayed.

7. A request for an extension of time was filed in the `5471 proceeding on August 28, 2000, and a two month extension of time was granted in a letter mailed on September 13, 2000.

8. A response to the Office action in the `5471 proceeding was filed on October 31, 2000.

9. A final Office action was mailed in the `5471 proceeding on March 14, 2001, which set a shortened statutory period for response of one month.

10. A request for an extension of time was filed in the `5471 proceeding on April 12, 2001, and a one month extension of time was granted in a letter mailed on April 17, 2001.

11. A response to the final Office action in the `5471 proceeding was filed on May 14, 2001, accompanied by a request for an extension of time for one month.

12. On the same date, May 14, 2001, patent owner filed a Notice of Appeal in the `5471 proceeding.

Application/Control Number: 90/005,471

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the `5471 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the `5471 reexamination file shows that an amendment was filed with the original reexamination request. Claims 1, 13, 15-16, 25, 34, 37, 40-41 and 43 have been amended, and new claim 48 has been added in the `5471 reexamination proceeding. Patent owner has filed a response to the most recent Office action, accompanied by a request for an extension of time, and a Notice of Appeal.

A review of the reissue (Application No. 09/374,041) prosecution history shows that the reissue application was published in the *Official Gazette* on September 28, 1999. Two months from the publication of the present reissue have passed, and the application is awaiting a first Office action on the merits by the examiner. In a preliminary amendment, in addition to amending portions of the specification (Cols. 3 and 5-14), as well as amending patent claims 1-2, 5, 7-9, 13, 15-16, 20, 23-26, 28-30, 34-37, 39-41, and 43-45, in the reissue application, applicant

has submitted new claim 48 for consideration, Thus, the specification and claims are not identical in both proceedings. In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceeding be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are, *sua sponte*, merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 09/374,041, and Control Number 90/005,471. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of any of the proceedings in the housekeeping amendment.

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding. Each action will be physically entered into both files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature.

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner

upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 C.F.R. § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continued prosecution of the reexamination proceeding.

CONCLUSION

1. The above-identified reissue application and reexamination proceeding ARE MERGED into a single consolidated proceeding.

2. The reissue application file and the reexamination file are being forwarded to the Group Director of Technology Center 2600. All further examination should be conducted in accordance with this decision.

3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding.

4. The examiner should withdraw the finality of the previous Office action in the reexamination proceeding, and issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding pursuant to Part III of this decision, **after** the earlier of the following events have occurred:

   (a) the submission of the housekeeping amendment to place the same amendments in both cases; or

   (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the housekeeping amendment.

5. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Robert J. Spar
Director
Office of Patent Legal Administration

June 6, 2001

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/374,041	08/13/99	Robert M. Nally	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,598,525	06/08/01	21

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/ 005,471 Filing Date: 08/13/99

Requester (name, address) David L. Stewart
McDermott, Will, and Emery
600 13th Street, N. W.
Washington, DC 20005

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/ 005,471, filed 08/13/99, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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JJGJr: 02-06

Paper No: __

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ORLANDO FL 32802-3791

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OFFICE OF PETITIONS

In re Re-Issue Application of	:	
Nally, et al.	:	
Application No. 09/374,041	:	DECISION ON PETITION
Filed: 13 August, 1999	:	
Attorney Docket No.: 81001_REX	:	
U.S. Patent No. 5,598,525	:	
In re Re-Examination Application of	:	
Nally, et al.	:	
Application No. 90/005,471	:	
Filed: 13 August, 1999	:	
Attorney Docket No.: 81001_REX	:	
U.S. Patent No. 5,598,525	:	

This is a decision on the petition filed on 17 October, 2005, under 37 C.F.R. §1.183, to waive provisions of 37 C.F.R. §1.125(d) and §1.173(a)(1).

For the reasons set forth below, the petition under 37 C.F.R. §1.183 to waive provisions of 37 C.F.R. §1.125(d) and §1.173(a)(1) is **GRANTED**.

Copied from 09374041 on 03/13/2006

BACKGROUND

The record reflects that:

- in the instant merged applications, one a reissue, the other a reexamination, the Examiner has requested (31 August, 2001) that a clean copy of the specification, which incorporated the Certificate of Correction changes;
- however, the regulations at 37 C.F.R. §1.125(d) bar entry of the substitute specification filed on 17 September 2001 (see: Office action of 11 August, 2005);
- therefore, the Petitioner seeks waiver under 37 C.F.R. §1.183 to waive provisions of 37 C.F.R. §1.125(d) and §1.173(a)(1).

CONCLUSION

Petitioner's request for waiver under 37 C.F.R. §1.183 of the provisions of 37 C.F.R. §1.125(d) and §1.173(a)(1) hereby is **granted**.

This file is released to Technology Center 2600 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

Copied from 09374041 on 03/13/2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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CROSSROADS CORPORATE CENTER
SUITE 218 NORTH
1393 VETERANS MEMORIAL HIGHWAY ROUTE 454
HAUPPAGE , NY 11788-3067

(For patent owner)

PATENT ADMINISTRATOR
TESTA HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON, MA 02110

(For requestor)

Paper No. 19

U.S. Patent Number: 5,519,769
Reexamination Control No.: 90/005,473
Filed: August 31, 1999
For: METHOD AND SYSTEM FOR UPDATING A CALL RATING DATABASE

DECISION ON REQUEST FOR EXTENSION OF TIME

This is a decision on two requests for an extension of time under 37 C.F.R. § 1.550. An action was mailed on April 4, 2000. Three previous extension of time requests were filed and granted. The two current extension of time requests were filed on September 5, 2000 and October 4, 2000, respectively. The first new extension requested additional time until October 4, 2000, and the second requested an extension until November 4, 2000. A response to the April 4, 2000 action was previously filed. The extensions have been requests to supplement that response.

Pursuant to 37 C.F.R. § 1.550(c):

The time for taking any action by a patent owner in a reexamination proceeding

will be extended only for a sufficient cause, and for a reasonable time specified. Any request for such an extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of the request effect any extension. See Section 1.304(a) for extensions of time for filing a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

Neither new extension of time request sets forth sufficient cause for a further extension. The justifications for the extensions have not changed since the first one was granted on June 29, 2000. The previous extensions of time that were granted were justified by a need to gather evidence to include with an affidavit under 37 CFR 1.131. Since there has not been any demonstrated movement to complete the affidavit, no further extension appears warranted. It does not appear from the September and October extension requests that any progress to obtain this evidence has occurred or is likely to occur within the additional period of time requested.

Accordingly, the requests for an extension of time are **DENIED**.

This reexaminations will be forwarded to the examiner for prompt action. The Owner is reminded of the requirement under 35 U.S. § 305 to conduct reexamination proceedings with special dispatch.

Jin F. Ng, Director
Technology Center 2600
Communications

UNITED ST[illegible] DEPARTMENT OF COMMERCE
Patent and [illegible]mark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

FEB - 4 2000

Paper No. 8

Theresa Fritz Camoriano
CAMORIANO AND ASSOCIATES
8225 Shelbyville Road
Louisville, KY 40222

Reexamination of U.S. Patent No. 5,465,433 to Nolan
Control No. 90/005,474
Filed: September 2, 1999
Attorney Docket No. AQU.100

DECISION DENYING PETITION

This is a decision on the December 1, 1999 petition requesting review (under 37 CFR §1.515(c)) of the November 8, 1999 denial of reexamination.

The petition is before the Technology Center Group Director for decision, see MPEP 1002.02(c)(12).

The examiner denied the request for reexamination because it did not raise a substantial new question of patentability. The '282 and '008 patents to Nolan were cited and described by applicant in an IDS filed June 6, 1994, in the prosecution of the patent application that resulted in U.S. Patent No. 5,465,433 (the patent being reexamined). The examiner also indicated that the consideration to be given to prior art patents in the earlier examination was controlled by In re Portola Packaging Inc. 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). Petitioner now requests that the Patent and Trademark Office (PTO) base its decision denying reexamination on the merits of the cited art, and not on a "blanket rule" that prevents consideration of the merits.

Refund Ref: 03/10/2000 JELEYI 00000090907
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Petitioner indicates that the request for reexamination was filed by the Patent Owner because of a new interpretation of the prior art cited in the prosecution of the original patent application. Petitioner notes that the cases of In re Portola Packaging Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), as well as In re Recreative Technologies 83 F.3d 1934, 38 USPQ2d 1776 (Fed. Cir.

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

FEB - 4 2000

Paper No. 8

Theresa Fritz Camoriano
CAMORIANO AND ASSOCIATES
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Reexamination of U.S. Patent No. 5,465,433 to Nolan
Control No. 90/005,474
Filed: September 2, 1999
Attorney Docket No. AQU.100

DECISION DENYING PETITION

This is a decision on the December 1, 1999 petition requesting review (under 37 CFR §1.515(c)) of the November 8, 1999 denial of reexamination.

The petition is before the Technology Center Group Director for decision, see MPEP 1002.02(c)(12).

The examiner denied the request for reexamination because it did not raise a substantial new question of patentability. The '282 and '008 patents to Nolan were cited and described by applicant in an IDS filed June 6, 1994, in the prosecution of the patent application that resulted in U.S. Patent No. 5,465,433 (the patent being reexamined). The examiner also indicated that the consideration to be given to prior art patents in the earlier examination was controlled by In re Portola Packaging Inc. 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). Petitioner now requests that the Patent and Trademark Office (PTO) base its decision denying reexamination on the merits of the cited art, and not on a "blanket rule" that prevents consideration of the merits.

Petitioner indicates that the request for reexamination was filed by the Patent Owner because of a new interpretation of the prior art cited in the prosecution of the original patent application. Petitioner notes that the cases of In re Portola Packaging Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), as well as In re Recreative Technologies 83 F.3d 1934, 38 USPQ2d 1776 (Fed. Cir.

Document Date: 03/10/2000

FC:147

1996), involved reexamination requests filed by **third party requesters**, and in both cases the decision was based on a concern that third parties should not be permitted to harass patent owners by rehashing issues that had already been considered in the prosecution of the patent application. Petitioner then points out that in the instant request for reexamination, it is Patent Owner that has filed the request, and therefore such a concern does not exist. Accordingly, petitioner urges that the PTO consider the cited art (substantively) and determine whether it raises a substantial new question of patentability.

Petitioner notes that if the PTO determines *there is* a new issue, it gives the patent owner an opportunity to present arguments or amendments to resolve the new issue; if it determines that the prior art *does not* raise substantial new issues, then it bolsters the strength of the patent. Petitioner asserts that a refusal to consider the patent owner's request for reexamination based on a "blanket rule," rather than on the merits of the cited art, does serious harm to the patent owner, since patent owner is left with no way other than litigation to deal with the issues directed to the merits of the cited art. It is urged that this result will thwart the purpose of reexamination and prohibit amendment of the claims to overcome any such issues.

Petitioner's arguments are not persuasive. The decisions of In re Portola Packaging Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), and In re Recreative Technologies 83 F.3d 1934, 38 USPQ2d 1776 (Fed. Cir. 1996), do not make any distinction as to the identity of the reexamination requester. Accordingly, both decisions apply regardless of whether the patent owner or a third party is the reexamination requester. Further, when the statute calls for a substantial new question of patentability, it does not provide separate standards for a request for reexamination by patent owner and a request by a third party. Thus, the examiner applied the correct standard in determining that a substantial new question of patentability did not exist, and the request for reexamination was appropriately denied.

CONCLUSION

1. The petition is **DENIED**. This decision is final and nonappealable. (37 C.F.R. § 1.515(c)). No further communication on this matter will be acknowledged or considered.

2. The reexamination proceeding will be terminated and forwarded to the Office of Finance for a partial refund of the filing fee for requesting reexamination to be made to the requester. (35 U.S.C. 303(c) and 37 C.F.R. § 1.26(c)).

3. Telephone inquires related to this decision should be directed to the Group 3740 and 3750 Special Program Examiner, Robert J. Webster, at (703) 308-2619.

Ira Lazarus, Acting Director
Technology Center 3700

January 5, 2000
C:\TEMP\1.WPD

UNITED STATES DEPARTMENT OF COMMERCE
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#7

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,476

PATENT NO. 4,795,454

ART UNIT 3761

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding. 37 C.F.R. 1.550(e).

Where this copy is supplied after the reply by requester, 37 C.F.R. 1.535, or the time for filing a reply has passed, no submissions on behalf of the reexamination requester will be acknowledged or considered. 37 C.F.R. 1.550(e).

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAILED
MAR 15 2000

Reexam Control No.: 90/005,476
Filed: September 07, 1999
For: U.S. Patent No. 4,795,454
Title: Absorbent Article Having Leakage Resistant Dual Cuffs

DECISION ON REQUEST FOR RECONSIDERATION OF DENIAL OF REEXAMINATION

RECEIVED
MAR 20 2000

Paper No.: 07

This is a decision on Requester's Petition of December 17, 1999 requesting reconsideration of the examiner's decision denying reexamination in the above identified proceeding. The examiner's Denial of the Request for Reexamination was mailed November 18, 1999.

For substantially the same reasons set forth in the Petition, an order GRANTING reexamination is hereby ordered. The references to Lawson and Aziz were neither applied nor considered in any prior Patent Office proceeding. Petitioner is correct in his assertions that these references are not precluded under *Portolla Packaging*. The reference to Shikinami has been demonstrated as being a prima facie "important reference" as it shows various features shown by either or both Lawson or Aziz. A reasonable examiner would find such a reference to be an "important reference" in making the any patentability determinations.

The Petition having been GRANTED, this proceeding will be returned to an examiner in charge for a first action on the merits. Reexamination is ordered for all claims of the patent. In keeping with Office policy, this proceeding will **not** be returned to the same examiner that initially has Denied reexamination.

John J. Love, Director
Technology Center 3700
703 308-0873

JJL:amo

Mr. Durk I. Jager
President (Patent Owner)
The Proctor & Gamble Company
One Proctor & Gamble Plaza
Cincinnati, OH 45202

Gregory J. Lavorgna
Seidel, Gonda, Lavorgna, &
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UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 7599
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LOVELAND CO 80537-0599

(For Patent Owner)

MAILED OCT 03 2005

T. Gene Dillahunty
Burns Doane Swecker & Mathis LLP
P.O. Box 1404
Alexandria, VA 22314-1404

(For Third Party Requester)

In re Simons et al.
Reexamination Proceeding
Control No. 90/005478
Filed: September 7, 1999
For U.S. Patent No. 5,871,494

DECISION ON PETITION

This is a decision on petitioner's request filed January 31, 2001, requesting reinstatement of the above identified reexamination proceeding because the patent owner did not receive the Office communication mailed on August 1, 2000 at the correspondence address of record. Patent Owner has filed an amendment in response to the August 1, 2000 office action with this petition.

The petition is granted.

In support of the request, petitioner has provided a showing of non-receipt of the Office action in accordance with Official Gazette Notice 1156 O.G. 53 (November 16, 1993). MPEP 711.03(c)II.

In view of the above, the termination of the reexamination proceeding is in error and is hereby vacated.

The amendment accompanying this petition will be entered and the file will be forwarded to the examiner for an action on the merits.

Any inquiry concerning this decision should be directed to Linda Sholl, Special Programs Examiner, at telephone No. (571) 272-4391.

Summary: Reexamination proceedings reinstated.

Richard A. Bertsch, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 26

Christopher L. Makay
1634 Milam Building
115 East Travis Street
San Antonio, TX 78205

(For Patent Owner)

Patrick M. Dwyer
1818 Westlake Avenue N.
Suite 114
Seattle, WA 98109

(For Requester)

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REEXAM UNIT

In re Reexamination Proceeding
Control No. 90/005,480
Filed: September 7, 1999
For: U.S. Patent No. 5,007,585
Patentee: Kubacak, et al.

DECISION DISMISSING PETITION

DO NOT ENTER

This is a decision on the patent owner renewed PETITION UNDER 37 C.F.R. § 1.137(b) of June 22, 2001, for the entry of late papers on the grounds of unintentional delay, requesting the entry of the late filed amendment in response to the final Office action of January 2, 2001. A petition fee under 37 C.F.R. § 1.17(m) of $620.00, for the reexamination proceeding has been paid by check, as indicated on page 2 of the present petition. The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 C.F.R. § 1.137(b) is **dismissed** for the reasons indicated below.

Any request for reconsideration of this decision under 37 C.F.R. § 1.137(b) must be submitted within **ONE (1) MONTH** from the mail date of this decision. **Extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(b)."

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The instant petition is accompanied by the required reply and the petition fee. The instant petition lack(s) item (3) above. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3), and is **not** sufficient to meet the requirement of 37 C.F.R. § 1.137(b)(3), as it merely indicates that "the failure to provide acceptable claim amendments as well as submit a timely Notice of Appeal was unintentional." Accordingly, any renewed petition based upon unintentional delay should include the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

In view of the above, the petition for the entry of late papers is **not** sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **dismissed**.

CONCLUSION

1. The petition is **dismissed**.

2. Any renewed petition based upon unintentional delay must be filed within **ONE (1) MONTH** of the mailing date of this decision.

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Patent Legal Administration

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

4. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

August 21, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C 20231
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Paper No. 29

Christopher L. Makay
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(For Patent Owner)

Patrick M. Dwyer
1818 Westlake Avenue N.
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Seattle, WA 98109

(For Requester)

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REEXAM UNIT

In re Reexamination Proceeding
Control No. 90/005,480
Filed: September 7, 1999
For: U.S. Patent No. 5,007,585
Patentee: Kubacak, et al.

DECISION GRANTING PETITION

This is a decision on the August 28, 2001, patent owner renewed PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

DECISION

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The previous petition was accompanied by the petition fee under 37 C.F.R. § 1.17(m). A response, including an amendment, to the outstanding non-final Office action of June 1, 2000, was received on June 22, 2001. In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is granted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 3700 for consideration of the amendment.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, S. Ganey, in Technology Center 3700.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

September 5, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 25

Christopher L. Makay
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(For Patent Owner)

Patrick M. Dwyer
1818 Westlake Avenue N.
Suite 114
Seattle, WA 98109

(For Requester)

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REEXAM UNIT

In re Reexamination Proceeding
Control No. 90/005,483
Filed: September 7, 1999
For: U.S. Patent No. 5,284,297
Patentee: Kubacak, et al.

DECISION DISMISSING PETITION

RECEIVED
SEP 05 2001

This is a decision on the patent owner renewed PETITION UNDER 37 C.F.R. § 1.137(b) of June 22, 2001, for the entry of late papers on the grounds of unintentional delay, requesting the entry of the late filed amendment in response to the final Office action of January 2, 2001. A petition fee under 37 C.F.R. § 1.17(m) of $620.00, for the reexamination proceeding has been paid by check, as indicated on page 2 of the present petition. The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 C.F.R. § 1.137(b) is **dismissed** for the reasons indicated below.

Any request for reconsideration of this decision under 37 C.F.R. § 1.137(b) must be submitted within **ONE (1) MONTH** from the mail date of this decision. **Extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(b)."

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The instant petition is accompanied by the required reply and the petition fee. The instant petition lack(s) item (3) above. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3), and is **not** sufficient to meet the requirement of 37 C.F.R. § 1.137(b)(3), as it merely indicates that "the failure to provide acceptable claim amendments as well as submit a timely Notice of Appeal was unintentional." Accordingly, any renewed petition based upon unintentional delay should include the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

In view of the above, the petition for the entry of late papers is **not** sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **dismissed**.

CONCLUSION

1. The petition is **dismissed**.

2. Any renewed petition based upon unintentional delay must be filed within **ONE (1) MONTH** of the mailing date of this decision.

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Patent Legal Administration

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

4. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

August 21, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 28

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(For Patent Owner)

Patrick M. Dwyer
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(For Requester)

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REEXAM UNIT

DO NOT ENTER
Director Initials

In re Reexamination Proceeding
Control No. 90/005,483
Filed: September 7, 1999
For: U.S. Patent No. 5,284,297
Patentee: Kubacak, et al.

DECISION GRANTING PETITION

This is a decision on the August 28, 2001, patent owner renewed PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

DECISION

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The previous petition was accompanied by the petition fee under 37 C.F.R. § 1.17(m). A response, including an amendment, to the outstanding final Office action of January 2, 2001, was received on July 16, 2001. In view of the above, the renewed petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is granted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 3700 for consideration of the amendment.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, S. Ganey, in Technology Center 3700.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

September 5, 2001

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,484	09/07/99	5424780	5735-201

90/005,414

LM41/0128

JAMES C COOPER
PIXEL INSTRUMENTS CORPORATION
110 KNOWLES DRIVE
LOS GATOS CA 95032

EXAMINER
GRANT,C

ART UNIT	PAPER NUMBER
2711	7

DATE MAILED: 01/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)

1- File Copy

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

William S. Lightbody **LIGHTBODY LAW OFFICE** **1717 East 9th Street, Suite 2121** **Cleveland, Ohio 44114**	)	**FOR OWNER**
John J. Lauter **PENNIE & EDMONDS L.L.P.** **1155 Avenue of the Americas** **New York, N.Y. 10036-2711**	)	**FOR THIRD PARTY REQUESTOR**
In Re Cooper **Reexamination Proceeding** **Control No. 90/005,414** **Filed 7-3-99** **For U.S. Patent No. 5,414,780**	)	**DECISION SUA SPONTE MERGING REEXAMINATION PROCEEDINGS**
In Re Cooper **Reexamination Proceeding** **Control No. 90/005,484** **Filed 9-7-99** **For: U.S. Patent No. 5,424,780**	)	

The above noted reexamination proceedings are before the Director of Technology Center 2700 for consideration of merger of the proceedings under 37 CFR 1.56(c).

BACKGROUND

1. Patent No. 5,424,780 issued on June 13, 1995.

2. A first request for reexamination, Control No. 90/005,414 ('414) was filed by the Patent Owner on July 3, 1999.

3. Reexamination was ordered on the '414 reexamination proceedings on September 9, 1999.

4. A second request for reexamination, Control No. 90/005,484 ('484) was filed by the Third Party Requestor on September 7, 1999.

5. Reexamination was ordered on the '484 reexamination proceedings on October 25, 1999.

6. A request by the Patent Owner for merger of reexamination proceedings was filed on October 18, 1999 and supplemented on November 29, 1999.

DISCUSSION

37 CFR 1.565(c) states:

> "If reexamination is ordered while a prior reexaminations is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570".

DECISION

I. Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '414 and '484 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for the same amendment's in all proceedings.

The Patent Owner is required to maintain the same claims and specification in all three filed.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action, which applies to all proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for both filed and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each

bearing an original signature, for entry into each file. All papers filed by the Patent Owner must be served on the requestor and requestor will be sent copies of all papers mailed by the Office.

James L. Dwyer, Acting Director
Technology Center 2700
Communications & Information Processing

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 14

Edward A. Boeschenstein
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St. Louis, MO 63141-8750

(For Patent Owner)

Enclosure: Third Party Paper filed March 21, 2001

Eugene E. Renz, Jr. Esq.
Eugene E. Renz, Jr. PC
P.O. BOX 2056
Media, PA 19063-9056

(For Requester)

MAILED
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REEXAM UNIT

In re Reexamination of	:	
U.S. Patent No. RE 35,860	:	DECISION
to Ward	:	DISMISSING PETITION
Control No. 90/005,486	:	& RETURNING
Filed: September 8, 1999	:	IMPROPER PAPER

This is a decision on the patent owner petition under 37 C.F.R. § 1.182, of February 23, 2001, requesting that prosecution be reopened and the reexamination certificate withdrawn to allow for reconsideration of the examiner's interpretation of "zinc alloy". This is also a decision returning the paper filed by the third party requester on March 21, 2001, which is taken as a petition in opposition to the patent owner petition. The petition is

before the Office of Patent Legal Administration of the United States Patent and Trademark Office (USPTO).

The petition is **dismissed** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Reissue Patent No. RE 35,860 issued to Ward on July 28, 1998.

2. On September 8, 1999 a request for reexamination of the reissue patent was filed by a third party requester.

3. Reexamination was ordered on October 18, 1999, and the order was re-mailed on March 7, 2000.

4. A non-final Office action was mailed on June 20, 2000, and a response to the action, including an amendment, was received on August 14, 2000.

5. On October 16, 2000, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed.

6. Comments on the Statement of Reasons for Patentability were filed on November 20, 2000.

7. On January 2, 2001, the reexamination certificate issued.

8. A patent owner petition was filed on February 23, 2001. (See Part I below.)

9. A third party requester petition was filed on March 21, 2001. (See Part II below.)

DECISION

Part I. Patent Owner Petition:

The patent owner petition of February 23, 2001, requests that the reexamination proceeding be reopened and that the reexamination certificate be withdrawn to allow for consideration of the proper interpretation of the term "zinc-alloy." Petitioner indicates that the examiner improperly narrowly defined the term "zinc-alloy" in his examination of the claims. Petitioner asserts that the examiner's construction of this term unnecessarily narrows the claims to limit them to the preferred embodiment of the invention. Accordingly, petitioner requests that prosecution of the reexamination proceeding be reopened, and that the reexamination certificate be withdrawn, to allow for consideration of the proper interpretation of the term "zinc alloy." The requested relief will **not** be granted.

The reexamination certificate has already issued, and there is no provision in the statute or rules for reopening a reexamination proceeding and withdrawing the reexamination certificate to allow for consideration of "the proper interpretation" of claim terminology. Accordingly, the request for reopening the reexamination proceeding and withdrawing the reexamination certificate cannot be granted.

However, a review of the record reveals that Patent Owner presented such arguments in response to the first Office action, and that such arguments were considered by the examiner prior to the issuance of the NIRC. The examiner addressed such arguments in the NIRC, and maintained that his interpretation of the claim terminology is appropriate based upon the facts in this reexamination proceeding. The record also reveals that a "Patentability Review Conference" was conducted prior to issuance of the NIRC, in accordance with USPTO policy in *ex parte* reexamination proceedings set forth in the *Official Gazette* Notice of August 29, 2000 (1237 OG 138), and the conference resulted in the issuance of the NIRC. Accordingly, patent owner's arguments regarding the definition of "zinc-alloy" have already been presented and considered in the reexamination

proceeding, but were not found to be persuasive. Therefore, although the examiner and patent owner may have a difference of opinion in this case, the result of the patentability review conference reflects that a clear error has not been committed in the conclusion of this reexamination proceeding. Further, it should be noted that patent owner's "Comments on Statement and Reasons for Patentability and/or Confirmation" filed on November 20, 2000, have been made of record in the reexamination file, and therefore both the examiner's reasons for patentability and patent owner's comments are available as part of the record of the reexamination proceeding.

The petition is **dismissed.**

Document Page

Part II. Third Party Requester's Paper:

Third party requester's petition of March 21, 2001, in opposition to patent owner's petition of February 23, 2001, requests that patent owner's petition be denied *inter alia* for the reasons that it is untimely, and the USPTO no longer has jurisdiction to decide the petition.

37 C.F.R. § 1.550(e)(1) states:

> (1) The active participation of the reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (i) In accordance with § 1.510; or
>
> (ii) Entered in the patent file prior to the date of the order to reexamine pursuant to § 1.525.
>
> (2) Submissions by third parties, filed after the date of the order to reexamine pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a).

The present petition is not a request for reexamination in compliance with the requirements of 37 C.F.R. § 1.510 and is not a reply pursuant to § 1.535. Nor does the petition qualify as a prior art statement under 37 C.F.R. § 1.501. Accordingly, the present petition in opposition to the patent owner petition is an improper submission under 37 C.F.R. § 1.550(e) and as such, the petition is **dismissed**. Even if such petition were proper, entry of this paper would be moot in view of the dismissal of the patent owner petition.

It should additionally be noted that neither the rules nor any provision of the statute provides authority for a third party to a reexamination proceeding to file a paper directed to the issues of the reexamination proceeding. *In re Amp*, 212 USPQ 826 (Commr. Pats. 1981). In the present instance, petitioner's assertions are clearly directed to the merits of the reexamination proceeding, and permitting entry of such third party assertions would be contrary to the intent of the statute. These third party comments are precluded since the examination of a reexamination proceeding is strictly *ex parte*.

Lack of Service:

It should also be noted that the requisite proof of service on the third party requester by patent owner of the petition of February 23, 2001, as well as on the patent owner by third party requester of the petition of March 21, 2001, were not included with either of these petition papers. Pursuant to 37 C.F.R. § 1.550(e) "[a]fter filing of a request for reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office."

Since the third party requester responded in opposition to the patent owner petition, it appears that third party requester has a copy of the patent owner petition. However, it is not known whether patent owner has received a copy of the petition filed by the third party requester. Accordingly, in this instance, the improper third party requester paper is being forwarded to patent

owner, rather than returned to requester.

This decision will be made of record in the reexamination file.

CONCLUSION

1. The patent owner petition is **dismissed** for the reasons indicated in Part I of the decision above.

2. The third party requester petition is **dismissed** as an improper paper, as discussed in Part II of the decision above, and is being forwarded to patent owner.

3. The reexamination file will be forwarded to the Files Repository for storage.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza of the Office of Patent Legal Administration, at (703) 308-0255.

Page 6 of the Decision

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

April 25, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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Paper No. 16

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MAILED
SEP 0 6 2001
REEXAM UNIT

Enclosure: petition papers of February 7, 2001

In re Reexamination of :
U.S. Patent No. RE 35,860 : **DECISION**
to Ward : **DISMISSING PETITION**
Control No. 90/005,486 : **& RETURNING**
Filed: September 8, 1999 : **IMPROPER PAPER**

This is a decision on the third party requester petition under 37 C.F.R. § 1.182, of February 7, 2001, requesting that the appeal brief filed by patent owner on January 17, 2001, be stricken from the record. The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office (USPTO).

The petition is **dismissed** for the reasons set forth below.

DECISION

On January 2, 2001, the reexamination certificate for the present reexamination proceeding issued. Third party requester's petition of February 7, 2001, requesting that patent owners appeal brief of January 17, 2001, be stricken from the record is **dismissed** as an improper paper and is being returned to requester for the reasons set forth below.

37 C.F.R. § 1.550(e)(1) states:

> (1) The active participation of the reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (i) In accordance with § 1.510; or
>
> (ii) Entered in the patent file prior to the date of the order to reexamine pursuant to § 1.525.
>
> (2) Submissions by third parties, filed after the date of the order to reexamine pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a).

The petition of February 7, 2001, is not a request for reexamination in compliance with the requirements of 37 C.F.R. § 1.510 and is not a reply pursuant to § 1.535. Nor does the petition qualify as a prior art statement under 37 C.F.R. § 1.501. Accordingly, the petition is an improper submission under 37 C.F.R. § 1.550(e) and as such, the petition is **dismissed**. Even if such petition were proper, entry of this paper would be moot in view of the return of the patent owner appeal brief with the petition decision mailed February 5, 2001.

This decision will be made of record in the reexamination file.

CONCLUSION

1. The third party requester petition is **dismissed** as an improper paper and is being returned to requester, as indicated in the decision above.

2. The reexamination file will be returned to the Files Repository for storage.

3. Telephone inquiries related to this decision should be directed to Lynn M. Kryza of the Office of Patent Legal Administration, at (703) 308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

September 6, 2001

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 7

Thomas D. Paul (Patent Owner)
Fulbright & Jaworski L.L.P.
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Houston, TX 77010-3095

MAILED
FEB 14 2000
REEXAM UNIT

Gerard H. Bencen (Requester)
Bencen & Van Dyke, P.A.
1630 Hillcrest Street
Orlando, FL 32803

Enclosure: Paper filed January 31, 2000

Reexamination of U.S. Patent No. 5,364,759 to Caskey, et al.
Control No. 90/005,499
Filed: September 20, 1999

DECISION DISMISSING PETITION

Application/Control Number: 90005499

This is a decision on the January 31, 2000, patent owner petition filed under 37 C.F.R. §1.181 requesting entry into the record of a letter stated to have been previously sent to the Office of Enrollment & Discipline of the Patent & Trademark Office (PTO), and its attachments.

This petition is before the Office of the Deputy Assistant Commissioner for Patent Policy and Projects for decision.

The petition is **dismissed** as an improper paper for the reasons set forth below.

BACKGROUND

1. A request for reexamination of U.S. Patent No. 5,364,759 (the '759 patent) was filed September 20, 1999, by the third party requester.

2. A decision denying reexamination was mailed in the instant reexamination proceeding on October 25, 1999.

3. On November 26, 1999, a petition was filed by the third party requester under 37 C.F.R. §1.181, §1.515(c) and §1.525(a), seeking review of the examiner's determination refusing reexamination.

4. On January 31, 2000, patent owner filed the present petition.

THE NATURE OF THE PRESENT PETITION

Petitioner indicates that this petition is for entry of materials in an effort to show harassment, and it is a petition under 37 C.F.R. §1.181; however, as will be discussed below,[1] entry of this petition is precluded under the rules. Thus, although this petition is entitled a "petition under 37 C.F.R. §1.181", it is being taken as a petition under 37 C.F.R. §1.183, to waive the rules. As per petitioner's instructions in the last paragraph of this petition, the PTO is charging patent owner's deposit account No. 06-2375 the $130.00 fee associated with this type of petition, in accordance with 37 C.F.R. §1.17(h).

DECISION

The present petition is dismissed for the following reasons:

(1) The petition is incomplete: No copy of the letter referred to in the petition, and the enclosures, was attached to the petition. Therefore the petition is incomplete.

(2) The issue is not ripe for decision: Petitioner appears to be alleging harassment by the third party requester, and the desire to deal with potential future harassment. This issue, however, is not ripe for decision. In the present proceeding, the examiner's decision on the request for reexamination determined that no substantial new question of patentability was present, and reexamination was denied. There has not yet been a decision on the third party requester's November 26, 1999, petition under

[1] In the "Return of Papers" section of this decision.

37 C.F.R. §1.181, §1.515(c) and §1.525(a) seeking review of the examiner's determination refusing reexamination. Thus, at present, there is no issue of harassment of the patent owner. In the event a substantial new question of patentability is found in the decision on petition, then the question of harassment could be ripe for decision, if properly raised by petition at that time. At the present time, however, it would be premature to speculate as to what the decision on the November 26, 1999, petition will provide, and how it might relate to the question of harassment.

(3) The present petition is not germane to the third party requester's petition under 37 C.F.R. §1.515(c): From the statement in the present petition that it is filed as a result of Gerard H. Bencen's November 26, 1999, petition submitted on behalf of the third party requester, the present petition could be taken as an opposition to the November 26, 1999, petition. To the extent that the present petition requests entry (and consideration) as an opposition to third party requester's petition of November 26, 1999, seeking review of the examiner's determination refusing reexamination, the present petition is not directed to the issues to be decided in the November 26, 1999, petition. The decision on the November 26, 1999, third party requester petition will be one of whether a substantial new question of patentability exists, and the question of harassment is not germane to that issue.

(4) No showing under 37 C.F.R. §1.183: Petitioner has not shown that an extraordinary situation exists where justice requires waiver of 37 CFR § 1.540 to enter the present petition, (the letter and enclosures in fact not being attached). There is no showing as to why the materials cannot be presented at a later time, if and when the question of harassment might become relevant.[2]

(5) It should also be noted that the requisite proof of service on third party requester was not included with the instant petition papers. Any future communications filed by patent owner in this proceeding must include proof of service on the third party requester in accordance with 37 CFR §1.550(e).

---

[2] In the event that the decision on the November 26, 1999, third party requester petition should find the existence of some substantial new question of patentability,

RETURN OF PAPER

Under 37 CFR § 1.540:

> ... No submissions other than the statement pursuant to § 1.530 and the reply by the requester pursuant to § 1.535 will be considered prior to examination.

The present petition filed by the patent owner has been filed prior to the start of the examination on the merits, and it is not a statement under § 1.530. Accordingly, the petition is an improper submission under § 1.540, and it will not be made of record in the reexamination file. While ordinarily the petition would be returned to the patent owner, in this instance it is being forwarded to the third party requester, since there is no indication that the third party requester was provided with a copy of the papers, as discussed above. The present decision will be made of record in the reexamination file.

CONCLUSION

1. The petition is **DISMISSED.**

2. The present patent owner petition is being forwarded to the third party requester, to provide the third party requester with a copy of the papers.

3. The reexamination file is being forwarded to Technology Center 1600 for immediate decision on the petition of November 26, 1999 filed by the third party requester under 37 C.F.R. §1.181, §1.515(c) and §1.525(a) seeking review of the examiner's determination refusing reexamination.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza of the Special Program Law Office, at (703) 306-5682.

Kenneth M. Schor
Senior Legal Advisor
Special Program Law Office

February 14, 2000
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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	09

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

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THOMAS D. PAUL
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HOUSTON, TX 77010-3095

DECISION ON PETITION

GERARD H. BENCEN
BENCEN & VAN DYKE
1630 HILLCRESST STREET
ORLANDO, FL 32803

In re Caskey et al
Reexamination Proceeding
Control No.: 90/005,499
Filed: September 20, 1999
For: U.S. Patent No. 5,364,759

This decision is in response to Third Party Requester's petition under 37 CFR 1.515(c), filed August 13, 1999, seeking review of the examiner's Order Denying the Reexamination Request, mailed October 25, 1999.

BACKGROUND

US Patent No 5,364,759 (hereinafter '759) issued to Charles T. Caskey and Albert O. Edwards on November 15, 1994 based on an application filed January 31, 1991. The application was examined by examiners Robert Wax and Dian Jacobson. A first request for reexamination (Control No. 90/003,901) was filed July 21, 1995, by Gerard H. Bencen and was assigned to examiner Stephanie Zitomer. Upon conclusion of reexamination a certificate issued on November 18, 1997, in which the patentability of claims 1-12, 16-17, 21 and 24 was confirmed, claims 13, 18, 22-23 and 25 were determined to be patentable as amended and claims 14-15 and 19-20, dependent on amended claims were determined to be patentable and added claim 26 was determined to be patentable. A second reexamination request (Control No. 90/004,798) was filed October 14, 1997, and assigned to examiner Zitomer. Upon conclusion of reexamination a certificate issued on July 20, 1999, in which the patentability of claims 1-12, 16-17, 21-22 and 24-26 was confirmed, claims 13 and 18 were determined to be patentable as amended and claims 14-15, 19-20 and 23 dependent on amended claims were also determined to be patentable. In the prosecution of the original application, four foreign patent references and 41 literature references were considered by the examiner. During the first reexamination, in addition to the previous references considered, the examiner considered two newly cited US patents, two foreign patents and 23 new literature references, seven original references being cited again. During the second reexamination, the examiner considered 18 newly cited literature references in addition to the two

previously cited US patents and 19 previously cited literature references all of which were cited again. Thus a total of two US patents, four foreign patents and 83 literature references have been considered by the examiners, especially examiner Zitomer.

In the first request for reexamination, requester relied on Smeets et al or Edwards et al or Beroldingen or Tautz et al or Weber et al or US Patent No. 5,075,217 (Weber) as anticipating the claims under 35 U.S.C. 102 (a), (b) or (e); or as obvious under 35 U.S.C. 103. The examiner ordered reexamination. In the subsequent first action claims 21 and 24 were determined to be patentable and all other claims were rejected. Specifically, claims 1-12 and 25 were rejected under 35 U S C. 103 over Smeets (Human Genetics, 1989) in view of Williamson et al (Tenth International Workshop...., 1990) and further in view of Chehab et al (PNAS 1989) and Gibbs et al (PCR Technology, 1989). Claims 13-15 were rejected under 35 U.S.C. 103 over Mullis et al in view of Smeets et al. Claims 16-17 were rejected under 35 U.S.C. 103 over Smeets et al in view of Williamson et al and applicants' admissions of record. Claims 18-20 were rejected under 35 U.S.C. 103 over Mullis et al in view of Williamson et al and further in view of Maniatis et al. Lastly, claims 22-23 were rejected under 35 U.S.C. 103 over Smeets et al in view of Williamson and further in view of Chehab et al, Gibbs et al and Polymeropoulos et al (NAR, Dec., 1990). The examiner also commented on requester's proposed rejections under 35 U.S.C. 102 noting that none of the references taught all of the claim limitations and therefor were not anticipatory and also commented on differences in the rejections under 35 U.S.C. 103 between those proposed by requester and those set forth by the examiner. In response, Patent owner supplied affidavits under 37 CFR 1.131 to antedate some references as well as appropriate arguments. The examiner maintained most of the rejections until the affidavits were perfected and added a new rejection under 35 U.S.C. 103 over Jackle (WO 90/04040). Following Patent owner's perfecting of the affidavits which removed Williamson et al and Polymeropoulos et al as prior art and several claim amendments, a Notice of Intent to Issue a Reexamination Certificate was mailed and the Certificate issued on November 18, 1997.

In the second reexamination request by the same requester supposed errors in the conduct of the previous reexamination were suggested as well as supposed errors in the examiner's evaluation of the prior art. In addition, requester suggested new grounds of rejection based on 19 newly cited prior art references. Each reference was identified as suggesting one or more limitations expressed in the claims, but no specific rejection was suggested. The examiner granted reexamination based on one of the cited references and noted that a number of the cited references were merely cumulative to the teachings of references already of record. The examiner then issued a first Office action in which the patentability of claims 1-12 and 21-26 was confirmed and only claims 13-20 rejected. The examiner analyzed a number of references with respect to the patentability questions raised by requester. The examiner then rejected claims 13 and 15 under 35 U.S.C. 102(b) over Chamberlain et al (NAR, 1988); claims 13-15 under 35 U.S.C. 103 over Chamberlain et al in view of Yandell et al (Am. J Gen., 1989); claims 16-17 under 35 U.S.C. 103 over Yandell et al in view of Moyzis et al (Genomics, 1989); and claims 18-20 under 35 U.S.C. 103 over Goodbourn et al (PNAS, 1983) in view of Innis et al (PNAS 1989). Following an interview and amendments and arguments by Patent owner the examiner mailed a Notice of Intent to Issue a Reexamination Certificate and the Certificate issued on July 20, 1999.

In the third or current reexamination request by the same requester eleven pages of reference citations on Form 1449 were submitted. It is apparent that all of these references are already of record in the previous prosecution of the application and reexamination proceedings. Only two

new literature references appear to be cited, Peake et al (Throb. Haem., 1989) and Skolnick et al (Genomics, 1988). Requester suggests that the claims are unpatentable over these two new references (whether anticipated or obvious is unclear) alone or combined with any of 36 other references cited which are already of record. The examiner analyzed each of the new references in detail determining that Peake et al is a one page reference generally describing DNA sequencing of von Willebrand Factor gene clones , but giving little experimental or procedural details. A comparison of this reference with Smeets et al (or several other references) shows that is no more than cumulative to the teachings contained therein and therefor cannot be considered to raise a substantial new question of patentability, either alone or in combination with any other reference. Skolnick et al is directed to methods of multiple simultaneous analyses of polymorphism sequences. In terms of what has been considered in the art of simultaneous analysis, Chehab et al, previously applied, appears to teach as much as, if not more than Skolnick et al with respect to the claims herein. Thus Skolnick et al is at most cumulative to and no better than art already of record. Based on these determinations the request for reexamination was denied.

DISCUSSION

As seen from the above and the file records the examiner conducting this sequence of reexamination proceedings has thoroughly analyzed each of the references and applied those appropriate to the claims under the appropriate section of the statute. This has not always agreed with requester's analysis or suggestions In consequence of the two reexaminations, Patent owner has narrowed by amendment some of the claims in view of the art and has provided evidence in the form of affidavits under 37 CFR 1.131 and 1.132 of earlier reduction to practice and unexpected results. The examiner has also indicated that many of the references suggest parts of the claimed inventions, but that there is no suggestion or motivation to combine the parts to derive the inventions and that absent such motivation the claims are patentable thereover. Requester disputes this conclusion by stating that combining the references leads logically to the claimed invention. While logic is impeccable in hindsight, reality requires a suggestion or motivation to combine the references to reach the desired outcome. With respect to requester's specific points:

1. Peake et al has been reviewed. As noted above it is a one page reference giving little detail as to how to do anything and is no more than cumulative to Smeets et al which discloses significantly more detail in accomplishing that which Peake et al desires to do. Thus Peake et is cannot be relied on to raise a substantial new question of patentability.

2. Since Peake et al is merely cumulative to Smeets et al which was applied in previous reexaminations and the claims determined patentable thereover, it cannot raise a substantial new question of patentability with any reference already of record since Smeets et al has already been considered with each and every other reference of record. With respect to consideration with Skolnick et al, newly cited, Skolnick et al also appears to be no more than cumulative to Chehab et al, already of record and therefor cannot raise a substantial new question of patentability. It is noted that requester does not set forth any specific rejections, but merely attempts a shotgun approach by citing up to 36 other references with which the new references could be combined.

3. Skolnick et al does not appear to teach analysis of short tandem repeats (STRs) as claimed by Patent owner and is therefor not enabling for that which is claimed. While that which

Skolnick et al teach may be a precursor to that which is claimed by Patent owner, it does not suggest or enable it.

4. Requester petitions that the examiner's assertion that "No argument is made that the cited references are newly applied in a manner different than in the previous prosecutions." be withdrawn on the basis that the requester is not required to identify the statutory or procedural basis for the examiner to rely on and that the request clearly demonstrates the manner in which the references should be applied. Requester urges that the burden is upon the Office to appropriately and fully apply the references. As noted above, the examiner fully and thoroughly discussed all of the applied references in previous proceedings. If requester is of the opinion that the references were improperly applied or analyzed it has not been clearly made known. Further, if requester is of the opinion that the newly cited references in a reexamination request may be misunderstood or misapplied, it is requester's duty to guide the examiner in the appropriate direction. Requester's request in this reexamination appears to be no more than a citation of references, each of which contains a part of the claimed invention and which are so argued accompanied by a general conclusion that the references make the invention obvious even though there is no motivation apparent or pointed out by requester to combine the teachings of the references to teach the claimed inventions.

5. Requester is correct that Williamson et al was withdrawn as a reference in view of an affidavit under 37 CFR 1.131. Requester asserts that any reference which antedates Williamson et al must be considered as a reference in this reexamination. Such has been done. However requester does not assert that any reference cited teaches that which Williamson et al teach. Further, Peake et al was considered cumulative to Smeets et al and Skolnick et al to Chehab et al, not to Williamson et al.

6. Reassignment of this reexamination to another examiner would be appropriate if the examiner's decision not to grant reexamination is found to be in error. Requester's comments appear to rise to the level of belief that when a request for reexamination is filed the Office will conduct the proceedings in such a manner as to cause the patent to be canceled. This is not the focus of the Office. The mission of the Office is to grant valid patents. When a reexamination request raises a substantial new question of patentability that question is examined in the same manner and under the same statutes as in the original examination of the application. Only in rare instances does a reexamination result in loss of all patent claims. Not infrequently a reexamination results in revised or amended claims which are still patentable and preserve some or all of Patent owner's rights.

7. All necessary and appropriate procedures have been followed.

With respect to requesters "arguments for review" it is noted, contrary to requester's assertions, that the examiner has undertaken detailed and thorough analyses of each of the references, not of just those applied and that the references applied have been applied in a thoughtful reasoned manner with detailed explanations. Thus requester's contention of the examiner's failure to thoroughly consider all of the references is misplaced. As to enablement of the Skolnick et al reference, it is concluded that the examiner is correct in that it is not enabling for the invention claimed in the patent. It may be enabling for other purposes, but not for the specific claimed invention. Requester's comments have been considered, but are not found to evidence error on the examiner's part in the decision not to order reexamination. Requester's challenge to the

Office or examiner to define the basis of any unexpected results achieved by the patent is inappropriate. The Office has the responsibility of determining patentability, not unexpected results. Requester challenges the examiner's position that the claims must be reviewed for the invention "as a whole". However, this is not the position of the Office alone. It is the position that numerous judicial decisions have directed the Office to take when considering patentability of a claim. Lastly, it is noted that requester has resorted to earlier and earlier references seeking to support a reconsideration of the patent claims. However, it must also be realized that earlier references teach fewer and fewer of the claimed invention's elements and thus support more strongly a determination of patentability in that more references must be combined to show all of the elements of the claimed invention. However, merely citing references which show the claimed invention's elements is not in and of itself sufficient. Motivation to combine the references to achieve the claimed invention must also be shown. This lack becomes more evident with use of earlier dated references.

DECISION

Third Party Requester's petition for reconsideration of the examiner's denial of reexamination has been thoroughly considered. The petition is **DENIED**.

This decision is final and non-appealable. 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

John Kittle
Director, Technology Center 1600

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,504	09/24/99	4624140	557-79

MM41/0210

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1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036-2711

EXAMINER	
HIRSHFELD,A	

ART UNIT	PAPER NUMBER
2859	

DATE MAILED: 02/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

90005504-20000210

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C 20231

Paper No. 22

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Sean V. O'Connell (For first Requester)
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Stanley C. Spooner (For second Requester)
NIXON & VANDERHYE
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Arlington, VA 22201-4714

In re Ekchian et al.
Reexamination Proceeding
Control No. 90/005,315
Filed: April 6, 1999
For: U.S. Patent No. 4,624,140

DECISION MERGING REEXAMINATION PROCEEDINGS

In re Ekchian et al.
Reexamination Proceeding
Control No. 90/004,635
Filed: May 15, 1997
For: U.S. Patent No. 4,624,140

In re Ekchian et al.
Reexamination Proceeding
Control No. 90/005,504
Filed: September 24, 1999
For: U.S. Patent No. 4,624,140

The above-identified reexamination files are before the Director of Technology Center 2800 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 4,624,635 issued on November 25, 1986.

2. A first request for reexamination, Control No. 90/004,635, was filed by a third party requester on May 15, 1997.

3. Reexamination was ordered in the '4635 reexamination proceeding on July 2, 1997.

4. A first Office action was mailed on December 23, 1998 to an incorrect correspondence address.

5. The first Office action was remailed on January 13, 1999.

6. A response to the first Office action was filed on March 15, 1999.

7. A second request for reexamination, Control No. 90/005,315, was filed by the same third party requester on April 6, 1999.

8. Reexamination was ordered in the '5315 reexamination proceeding on June 22, 1999.

9. A waiver of patent owner's statement under 37 CFR § 1.530(b) was filed in the '5315 reexamination on July 14, 1999 along with an updated litigation status related to the patent under reexamination.

10. A decision merging the '4635 and the '5315 reexamination proceedings was mailed on August 11, 1999.

11. A non-final Office action was mailed on September 10, 1999 setting a two-month time period for filing a response.

12. A third request for reexamination, Control No. 90/005,504, was by a second third-party

requester on September 24, 1999.

13. A response to the non-final Office action was filed on November 10, 1999 for the '4635 and '5315 reexamination proceedings with claims 1, 9-11 and 40 being amended and new claims 43-47 presented.

14. Reexamination was ordered in the '5504 reexamination proceeding on November 19, 1999.

DISCUSSION

Under 37 CFR § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565© is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 CFR § 1.565(c), the '4635, '5315 and '5504 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Three Proceedings.

As noted above, claims 1, 9-11 and 40 have been amended and claims 43-47 were newly presented in the '4635 and '5315 reexamination proceedings. Patent owner is required to maintain the same claims and specification in all three files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all three files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 CFR § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all three proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all three files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/004,635, 90/005,315 and 90/005,504 are merged. The reexamination files are being returned to the Central Reexamination files where they await the "housekeeping" amendment from the patent owner.

Janice A. Howell, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 10

Theodore F. Neils (For Patent Owner)
Kinney and Lange
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Minneapolis MN 55415-1002

J. Georg Seka (For Requester)
Townsend and Townsend and Crew
Two Embarcadero Ctr, 8th floor
San Francisco CA 94111-3834

In re: Bruce C. Johnson :
Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/005,509 : FOR EXTENSION OF TIME
Filed : October 4, 1999 :
For : U.S. Patent No. 5,533,499 :

This is a decision on applicant's request filed May 4, 2001 for an extension of time in the above-identified Reexamination Proceeding to file a response to the outstanding Office action mailed March 7, 2001. A response is due on or before May 7, 2001. The request is for an additional one-month extension to June 7, 2001. The request is filed pursuant to 37 CFR 1.550 (c).

A review of the petition indicates that sufficient cause for an extension for the time requested has been established. Accordingly, the request is granted. No further extension of time for the response to the outstanding Office action will be granted unless it can be shown that unforeseeable and extraordinary circumstances exist.

John E. Kittle, Director
Technology Center 3700
Phone: (703) 308-0873

ak/5/07/01

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 19

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(For Patent Owner)

J. Georg Seka
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Two Embarcadero Center, 8th Floor
San Francisco, CA 94111-3834

(For Requester)

In re Creative Integration & Design, Inc.
Reexamination Proceeding
Control No. 90/005,509
Filed: October 4, 1999
For: U.S. Patent No. 5,533,499

: DECISION ON PETITION

Patent Owner filed an amendment responsive to the Office letter dated May 17, 2002. The amendment was accorded a filing date of July 18, 2002. It is Owner's position that the amendment in question was properly deposited with the United States Postal Service as Express Mail, Post Office to Addressee on July 17th and not July 18th. On August 21, 2002, Owner filed a petition pursuant to 37 CFR 1.10(d) to correct the filing date of the amendment to July 17, 2002.

A review of the discussion in MPEP § 513, the allegations in the petition, and the attachments to the petition in support of the allegations show that Owner has made out a sufficient showing to establish entitlement to a filing date of July 17, 2002 for the amendment in question. Accordingly, the amendment is being docketed in the file with a filing date of July 17, 2002, and will in due course be forwarded to the examiner for appropriate action.

PETITION GRANTED.

for John E. Kittle, Director,
Technology Center 3700

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,512	10/08/99	5371017	100.002

HM12/0102

ALISA A HARBIN
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EMERYVILLE CA 94608

EXAMINER	
WAX,R	
ART UNIT	**PAPER NUMBER**
1652	07

DATE MAILED: 01/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

90005512 20010102

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAILED IN TECH CENTER
1600 01/02/01

ALISA A HARBIN
CHIRON CORPORATION
INTELLECTUAL PROPERTY R440
P O BOX 8097
EMERYVILLE , CA 94608

FOR PATENT OWNER

MARIA L. MAEBIUS
SHANKS & HERBERT
1033 NORTH FAIRFAX STREET
SUITE 306
ALEXANDRIA, VA 22314

FOR REQUESTER

In re Houghton et al
Reexamination Proceeding
Control No.: 90/005,512
Filed: October 8, 1999
For: U.S. Patent No. 5,371,017

In re Houghton et al
Reexamination Proceeding
Control No.: 90/005,512
Filed: December 6, 1999
For: U.S. PATENT No. 5,371,017

: DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

The above noted reexamination files are before the director of Technology Center 1600 for consideration of merger of the proceedings under 37 CFR 1.656(c).

BACKGROUND

1. Patent No. 5,573,751 issued December 6, 1994.

2. A first request for reexamination, Control No. 90/005,512, was filed by patent owner on October 8, 1999.

3. Reexamination was ordered in the '512 reexamination proceeding on December 22, 1999

4. A second request for reexamination, Control No. 90/005,582, was filed by third party requester on December 6, 1999.

5. Reexamination was ordered in the '582 reexamination proceeding on February 22, 2000.

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above review of facts, reexamination has been ordered in both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '512 and '582 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

Patent Owner is required to maintain the same claims and specification in both files.

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the Patent Owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

The Office action in '512, mailed November 9, 2000, is hereby vacated in view of the merger. A new Office action will issue in due course following the merger.

CONCLUSION

Reexamination Control Nos. 90/005,512 and 90/005,582 are merged. Upon receipt of the required paper placing the same amendments in both files, an Office action will issue in due course.

Jasemine C. Chambers
Director, Technology Center 1600

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,513	10/08/99	3585258	100.003

HM11/0702

ALISA A HARBIN
CHIRON CORPORATION
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EXAMINER	
PROUTY,R	
ART UNIT	PAPER NUMBER
1652	13

DATE MAILED: 07/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

90005513 20020702

UNITED STATES
PATENT AND
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C 20231
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ALISA A HARBIN
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FOR PATENT OWNER

SHELLY GUEST CERMAK
SHANKS 7 HERBERT
TRANS-POTOMAC PLAZA
1033 N FAIRFAX STREET, SUITE 305
ALEXANDRIA, VA 22314

FOR REQUESTER

In re Houghton et al
Reexamination Proceeding
Control No.: 90/005,513
Filed: October 8, 1999
For: U.S. Patent No. 5,585, 258

In re Houghton et al
Reexamination Proceeding
Control No.: 90/005,954
Filed: March 16, 2001
For: U.S. PATENT No. 5,585, 258

: DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

The above noted reexamination files are before the director of Technology Center 1600 for consideration of merger of the proceedings under 37 CFR 1.656(c).

BACKGROUND

1. Patent No.5,585, 258 issued December 17, 1996.

2. A first request for reexamination, Control No. 90/005,513, was filed by patent owner on October 8, 1999.

3. Reexamination was ordered in the '513 reexamination proceeding on December 22, 1999.

4. A second request for reexamination, Control No. 90/005,954, was filed by third party requester on March 16, 2001.

5. Reexamination was ordered in the '954 reexamination proceeding on April 23, 2001.

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above review of facts, reexamination has been ordered in both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate. The delay in merging these proceedings is regretted.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '513 and '954 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

Patent Owner is required to maintain the same claims and specification in both files.

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. **All papers filed by the Patent Owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.**

CONCLUSION

Reexamination Control Nos. 90/005,513 and 90/005,954 are merged. The files will be forwarded to the examiner for further consideration.

John Doll
Director, Technology Center 1600

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,517	10/12/99	5346306	7641-2015

MM21/1218

ALSAN BAGDADI ESQ
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WASHINGTON DC 20037

EXAMINER
BENNETT, G

ART UNIT	PAPER NUMBER
2859	9

DATE MAILED: 12/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

90005517 121899

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/005,517	10/12/99	5346306	7641-2015

MM21/1218

LAWRENCE B. GOODWIN
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666 FIFTH AVENUE
NEW YORK, NY 10103-0001

EXAMINER	
BENNETT, G	
ART UNIT	**PAPER NUMBER**
2859	9

DATE MAILED: 12/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

09005517

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 6/9

Alsan Bagdadi (For Patent Owner)
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Washington, D.C. 20037

Lawrence B. Goodwin (For Third Party Requester)
ORRICK, HERRINGTON & SUTCLIFFE
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New York, NY 10103-0001

In re Michael Reading et al. :
Reexamination Proceeding :
Control No. 90/005,517 :
Filed: October 12, 1999 :
For U.S. Patent No. 5,346,306 : DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

In re Michael Reading et al :
Reexamination Proceeding :
Control No. 90/005,770 :
Filed: July 14, 2000 :
For U.S. Patent No. 5,346,306 :

The above-identified reexamination files are before the director of Examining Group 2870, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,346,306 was issued on September 13, 1994.

2. A first request for reexamination, Control No. 90/005,517, was filed by a third party requester onOctoberr 12, 1999.

3. Reexamination was ordered on December 3, 1999.

4. A second request for reexamination, Control No. 90/005,770, was filed by the same third party requester on July 14, 2000.

5. Reexamination was ordered in the '5770 reexamination proceeding August 24, 2000.

6. An Information DisclosureStatementt was submitted on January 31, 2000 in the '5517 reexamination proceeding.

7. No statement by the patent owner was received in either of the reexamination proceedings.

DO NOT ENTER

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '5517 and '5770 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

UNDER SEAL

CONCLUSION

Reexamination Control Nos. '5517 and '5770 are merged. The reexamination files are being forwarded to the examiner for preparing a first Office action.

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005519	9/28/99	[illegible]	[illegible]

MM21/0420

BRIAN SIRITZKY ESQ
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WASHINGTON DC 20005-3918

EXAMINER	
HANTIS,K	

ART UNIT	PAPER NUMBER
2876	8

DATE MAILED: 04/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

90005519 20000420

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER C
PATENTS AND TRADEMARKS
Washington, D C 20231

Paper No. 8

PILLSBURY, MADISON & SUTRO
1100 New York Avenue, N.W.
Ninth Floor, East Tower
Washington, D.C. 20005-3918

(For Patent Owner)

Jacqueline E. Hart
ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST
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P.O. Box 3791
Orlando, Florida 32802

(For Requester)

In re Alf Petersen et al.
Reexamination Proceeding
Control No. 90/005,519
Filed: September 28, 1999
For U.S. Patent No. 5,805,287

In re Alf Petersen et al.
Reexamination Proceeding
Control No. 90/005,5,370
Filed: May 25, 1999
For U.S. Patent No. 5,805,287

DECISION MERGING
REEXAMINATION
PROCEEDINGS

90005519

The above-identified reexamination files are before the director of Examining Group 2870, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,805,287 issued on September 8, 1998.

2. A first request for reexamination, Control No. 90/005,370 was filed by a third party requester on May 25, 1999.

3. Reexamination was ordered in the '5370 reexamination proceeding on July 20, 1999.

4. A preliminary amendment was submitted with the filing of the request for reexamination amending column 3, line 21 of the patent specification[1].

5. A second request for reexamination, Control No. 90/005.519 was filed by the patent owner on September 28, 1999.

5. Reexamination was ordered in the '5519 reexamination proceeding on January 18, 2000.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

---

[1] It is noted that the amendment was improper because it does not comply with 37 C.F.R. § 1.121(c) and 37 C.F.R. § 1.530(d)(1)(I) requiring that the entire paragraph where the change is made be rewritten.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '5370 and '5519 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in Both Proceedings.

As noted above, the specification has been amended in the '5370 reexamination proceeding. Patent owner is required to maintain the same claims and specification in both files. Since the amendment has not been entered because the entire paragraph where the change is to be made was not rewritten and the proposed change does not appear to affect the merits of the patent, it is suggested that the amendment be submitted in proper format in both reexamination proceedings in response to a first Office action to be issued by the examiner.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. '5370 and '5519 are merged. The reexamination files are being forwarded to the examiner for reexamination and issuing an Office action.

Janice A. Howell, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

90005519 . 062899

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,521	09/29/99	576/067	515-4166

HM11 0516

BROWDY AND NEIMARK
419 SEVENTH STREET NW
SUITE 200
WASHINGTON DC 20004

EXAMINER
[illegible]

ART UNIT	PAPER NUMBER
1646	7

DATE MAILED: 05/16/00

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Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95) U.S. G.P.O. 1999 460-693 1- File Copy

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Patent and Trademark Office
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OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

BROWDY AND NEIMARK
419 SEVENTH STREET NW
SUITE 300
WASHINGTON , DC 20004

DECISION ON PETITION

EDWARD A. HEDMAN
HEDMAN, GIBSON & COSTIGAN
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-2646

In re Arpaia
Reexamination Proceeding
Control No.: 90/005,521
Filed: September 29, 1999
For: U.S. Patent No. 5,767,067

This decision is in response to third party Requester's petition under 37 CFR 1.181, filed January 21, 2000, seeking reversal of the examiner's order denying reexamination..

BACKGROUND

On September 29, 1999, third party requester filed the above identified reexamination request citing in the detailed explanation of reasons for granting reexamination seven documents which requester alleged raise a substantial new question of patentability with respect to claims 1-10 of the above identified patent. The patent itself has an issue date of January 16, 1998, but relies on a grandparent application for a priority date of at least February 7, 1989, the date of completion of the requirements for filing a National Stage application under 35 U.S.C. 375. Patent Owner's filing date for the PCT application on which the national stage filing is based is June 24, 1988. Requester relies primarily on European patent EP 0 211 894 which has a publication date of March 24, 1993. This reference also claims descent from an international application and lists an international publication date of August 14, 1986, upon which requester relies. The order denying reexamination denies reliance on this date and grants only the March 24, 1993, date as the effective prior art date of the publication

Requester's petition raises three points for consideration:

1. Is the EP '894 publication prior art based on the publication date of the international application?

2. If the answer to 1 is yes, may the Mannaerts publication be used to support and further explain the EP publication?

3. If the answer to 1 and 2 are yes, has the requester raised a substantial new question of patentability?

Reexamination may be granted only on the basis of prior patents and publications. In order for a publication to qualify as proper prior art it must have been published prior to the date of filing of the earliest application from which priority is claimed. In this instance, the earliest priority date claimed is the date of filing of the international application, June 26, 1988. Requester candidly admits that the EP publication does not have a publication date which qualifies it as prior art, but attempts to qualify it based on the publication date of the International Application from which it descends. Under 35 U.S.C. 102(a) or (b) a publication becomes prior art only as of its date of publication. 35 U.S.C. 102(e) permits a US patent to be considered prior art against an application as of the patent's filing date, but this is the only instance in which a date other then the publication date or issue date may be used to establish an earlier effective date for a reference. This provision does not apply to foreign patents or any publication. Thus the EP reference does not have an effective publication date with respect to the earliest priority date of the patent identified above and is therefor not prior art. The answer to point 1 being "no", points 2 and 3 need not be considered.

Requester's petition is **DENIED**.

This decision is final and nonappealable. 37 CFR 1.515(c). No further communication in this matter will be acknowledged or considered.

John Doll
Director, Technology Center 1600/2900

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
ALEXANDRIA, VA 22313-1450
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JAN 07 2004

Paper No. 30

Sofer & Haroun, LLP
317 Madison Avenue
Suite 910
New York, NY 10017

(For Patent Owner)

In re Protechna SA
Reexamination Proceeding
Control No. 90/005,524
Filed: September 30, 1999
For: U.S. Patent No. 4,909,387

DECISION, *SUA SPONTE*,
MERGING REEXAMINATION
PROCEEDINGS

In re Protechna SA
Reexamination Proceeding
Control No. 90/006,722
Filed: July 22, 2003
For: U.S. Patent No. 4,909,387

The above noted *ex parte* reexamination proceedings are before the Director of Technology Center 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the 90/005,524 and 90/006,722 reexamination proceedings are hereby MERGED. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

Owner is required to maintain the same claims and specification in both files. The contents of each file will be hereafter be maintained identically, and all actions promulgated and papers filed subsequent to this Decision will bear the same paper number. This Decision is paper No. 30 in both files. There will be no paper Nos. 9-29 in Control No. 90/006,722.

III. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single combined action which applies to both proceedings, and which will cross-reference the two proceedings. A separate action cover form for each proceeding will be printed by the PALM printer for each of the two reexamination control numbers. Owner will receive the body of the action and a copy of each cover sheet.

All papers filed by owner, (except for the housekeeping amendment and a copy of the new Schutz declaration as discussed in section IV below), will contain the identifying data for both files and will be physically entered in each reexamination file. Therefore, **all** papers filed by owner, (except for the housekeeping amendment, and a copy of the new Schutz declaration as discussed in section IV below), **must** consist of a single response bearing both control numbers, **filed in duplicate**, each having an original signature. One copy of the duplicate submission will be entered in each file.

Owner is asked to review 37 CFR 1.530 and MPEP § 2250 prior to filing any amendments to the drawings, specification or claims in order to make sure that the amendments are in proper

reexamination format. **Clean copies of the amended claims are not required; only so called "marked-up" claims and complete paragraphs in which specification amendments are requested** must be filed together with remarks satisfying the requirements of 37 CFR 1.530(e). Only currently proposed amendments adding amended or new material are to be presented; all pending claims are not to be represented in each successive amendment. Amendments are always made relative to the text of the patent. All added words that did not appear in the text of the patent are always underlined when presented by any amendment and continue to be underlined if the added words are presented of successive amendments. All words being deleted from the text of the patent appear in brackets and continue to appear in brackets if the words continue to be deleted in successive amendments. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

IV. Housekeeping Amendment and Other Preliminary Papers

Prior to the commencement of *ex parte* examination under 37 CFR 1.550, owner is **required** to file a housekeeping amendment in control No. 90/006,722 **only**. The housekeeping amendment will render the specification and claims in control No. 90/006,722 identical to the specification and claims in control No. 90/005,525. The housekeeping amendment will be paper No. 31 in control No. 90/006,722.

In control No. 90/005,524 **only**, owner is **required** to file a copy of the declaration of Udo Schutz that was filed concurrently with control No. 90/006,722. The copy of the declaration will be entered in control No. 90/005,524 as paper No. 31 so that each file contains the declaration.

Owner **may elect** to file additionally file a preliminary amendment presenting additional claims and/or further amending the claims and/or amending the specification in this merged proceeding. If that is the case, the preliminary amendment **must** in filed in accordance with paragraph III above (i.e. single submission bearing both control numbers, filed in duplicate), must be based upon the record as presented in the housekeeping amendment, and must comply with the formatting requirements 37 CFR 1.530(e) as explained in MPEP § 2250. If filed, this paper would be entered as paper No. 32 in both proceedings.

Owner is required to file the housekeeping amendment (paper No. 31 in control No. 90/006,722) and the copy of the Schutz declaration (paper No. 31 in control No. 90/005,524) not later than ONE MONTH from the date of this decision. If owner elects to file a further preliminary amendment in the nature of additional claims and/or additional amendments to the existing claim and/or amendments to the specification, that amendment must also be filed within ONE MONTH from the date of this decision.

Attention is invited to 37 CFR 1.550(c) regarding extensions of time in reexamination proceedings.

V. Examiner's Action and Citation of Patents and Printed Publications

Following the filing of the papers discussed in section IV above, the examiner will promulgate an action on the merits of the claims in accordance with the guidelines in section III above. This action will expressly consider and address the new declaration of Udo Schutz (paper No. 2 in control No. 90/006,722; paper No. 31 in control No. 90/005,524). The examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition. If the first *ex parte* action in this proceeding includes a rejection or objection, that action **cannot** be made final

The reexamination proceeding files are being returned to storage in the Technology Center 3700 Central Files awaiting the filing of the papers described section IV above. The papers must be filed by owner **not later than ONE MONTH from the date of this decision, unless an extension of time pursuant to 37 CFR 1.550(c) is obtained.**

E. Rollins-Cross, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
ALEXANDRIA, VA 22313-1450
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JAN 07 2004

Paper No. 30

Sofer & Haroun, LLP
317 Madison Avenue
Suite 910
New York, NY 10017

(For Patent Owner)

In re Protechna SA
Reexamination Proceeding
Control No. 90/005,524
Filed: September 30, 1999
For: U.S. Patent No. 4,909,387

DECISION, *SUA SPONTE*,
MERGING REEXAMINATION
PROCEEDINGS

In re Protechna SA
Reexamination Proceeding
Control No. 90/006,722
Filed: July 22, 2003
For: U.S. Patent No. 4,909,387

The above noted *ex parte* reexamination proceedings are before the Director of Technology Center 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the 90/005,524 and 90/006,722 reexamination proceedings are hereby MERGED. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

Owner is required to maintain the same claims and specification in both files. The contents of each file will be hereafter be maintained identically, and all actions promulgated and papers filed subsequent to this Decision will bear the same paper number. This Decision is paper No. 30 in both files. There will be no paper Nos. 9-29 in Control No. 90/006,722.

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All papers mailed by the Office will take the form of a single combined action which applies to both proceedings, and which will cross-reference the two proceedings. A separate action cover form for each proceeding will be printed by the PALM printer for each of the two reexamination control numbers. Owner will receive the body of the action and a copy of each cover sheet.

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Owner is asked to review 37 CFR 1.530 and MPEP § 2250 prior to filing any amendments to the drawings, specification or claims in order to make sure that the amendments are in proper

reexamination format. **Clean copies of the amended claims are not required; only so called "marked-up" claims and complete paragraphs in which specification amendments are requested** must be filed together with remarks satisfying the requirements of 37 CFR 1.530(e). Only currently proposed amendments adding amended or new material are to be presented; all pending claims are not to be represented in each successive amendment. Amendments are always made relative to the text of the patent. All added words that did not appear in the text of the patent are always underlined when presented by any amendment and continue to be underlined if the added words are presented of successive amendments. All words being deleted from the text of the patent appear in brackets and continue to appear in brackets if the words continue to be deleted in successive amendments. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

IV. Housekeeping Amendment and Other Preliminary Papers

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In control No. 90/005,524 **only**, owner is **required** to file a copy of the declaration of Udo Schutz that was filed concurrently with control No. 90/006,722. The copy of the declaration will be entered in control No. 90/005,524 as paper No. 31 so that each file contains the declaration.

Owner **may elect** to file additionally file a preliminary amendment presenting additional claims and/or further amending the claims and/or amending the specification in this merged proceeding. If that is the case, the preliminary amendment **must** in filed in accordance with paragraph III above (i.e. single submission bearing both control numbers, filed in duplicate), must be based upon the record as presented in the housekeeping amendment, and must comply with the formatting requirements 37 CFR 1.530(e) as explained in MPEP § 2250. If filed, this paper would be entered as paper No. 32 in both proceedings.

Owner is required to file the housekeeping amendment (paper No. 31 in control No. 90/006,722) and the copy of the Schutz declaration (paper No. 31 in control No. 90/005,524) not later than ONE MONTH from the date of this decision. If owner elects to file a further preliminary amendment in the nature of additional claims and/or additional amendments to the existing claim and/or amendments to the specification, that amendment must also be filed within ONE MONTH from the date of this decision.

Attention is invited to 37 CFR 1.550(c) regarding extensions of time in reexamination proceedings.

V. Examiner's Action and Citation of Patents and Printed Publications

Following the filing of the papers discussed in section IV above, the examiner will promulgate an action on the merits of the claims in accordance with the guidelines in section III above. This action will expressly consider and address the new declaration of Udo Schutz (paper No. 2 in control No. 90/006,722; paper No. 31 in control No. 90/005,524). The examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition. If the first *ex parte* action in this proceeding includes a rejection or objection, that action **cannot** be made final

The reexamination proceeding files are being returned to storage in the Technology Center 3700 Central Files awaiting the filing of the papers described section IV above. The papers must be filed by owner **not later than ONE MONTH from the date of this decision, unless an extension of time pursuant to 37 CFR 1.550(c) is obtained.**

E. Rollins-Cross, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SEP 15 2004

Paper No. 38

Sofer & Haroun, LLP
317 Madison Avenue
Suite 910
New York, NY 10017

(For Patent Owner)

In re Protechna SA
Reexamination Proceeding
Control No. 90/005,524
Filed: September 30, 1999
For: U.S. Patent No. 4,909,387

In re Protechna SA
Reexamination Proceeding
Control No. 90/006,722
Filed: July 22, 2003
For: U.S. Patent No. 4,909,387

DECISION ON PETITION

In response to a courtesy telephone call from the examiner prior to preparation of a Notice of Intent to Issue Reexamination Certificate due to a failure to reply to the Office action dated March 29, 2004, Patent Owner has filed a petition and a copy of a reply to that Office action. Patent Owner alleges that a timely reply to the Office action in question was in fact filed on June 29, 2004.

A review of the petition shows that Patent Owner has supported the allegation by furnishing a copy of the reply, and a copy of a post card receipt showing that the reply was actually received in the Office on June 29, 2004, within the period set by the Office action in question as extended by the Decision on Petition for Extension of Time dated July 1, 2004.

As it appears that a reply to the Office action dated March 29, 2004 was in fact timely filed, the attached copy of the reply will be treated as though filed on June 29, 2004, and entered in the record for examination purposes. The application will then be forwarded to the examiner for appropriate action.

PETITION GRANTED.

Stephen Marcus, Special Program Examiner
Technology Center 3700

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,535	10/19/99	541702[illegible]	30061/9004

PM32/0419

MICHAEL B HURD
SHOOK HARDY AND BACON P C
ONE KANSAS CITY PLACE
1200 MAIN STREET
KANSAS CITY MO 64105-2118

EXAMINER
CALLU,L

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 04/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

90005535.101099

PTO-90C (Rev. 2/95)

1- File Copy

UNITED STATES PATENT & TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

Reexamination Control No. 90/005,535 – Paper No. 7-8
Reexamination Control No. 90/005,540 – Paper No. 8

FOR PATENT OWNER:

Michael B. Hurd
SHOOK, HARDY, AND BACON, P.C.
One Kansas City Place
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Kansas City, MO 64105-2118

FOR FIRST REQUESTER;

Paul F. Donovan
MICHAEL BEST & FRIEDRICH L.L.P.
100 East Wisconsin Aveneue
Milwaukee, WI 53202-4108

FOR SECOND REQUESTER;

Barry C. Kane
MILLER, JOHNSON, SNELL & CUMMISKEY, P.L.C.
250 Monroe Ave., N.W., Suite 800
P.O. Box 306
Grand Rapids, MI 49501-0306

DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/005,535 and 90/005,540

DO NOT REMOVE

NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 5,417,024 issued on May 23, 1995.

2. A first request for reexamination was filed by a third party requester, Paul F. Donovan, on October 19, 1999, and was assigned Reexamination Control No. 90/005,535.

3. On October 26, 1999, a second request for reexamination of U.S. Letters Patent No. 5,417,024 was filed by a third party requester, Karona, Inc. and was assigned Reexamination Control No. 90/005,540.

4. Reexamination was ordered in both Reexamination Control No. 90/005,535 and 90/005,540 on January 4, 2000.

DO NOT ENTER

Discussion

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the Reexamination proceedings will be consolidated and result in the issuance of a single Certificate under § 1.570.

As noted in the "Background", reexamination has been ordered in two reexamination proceedings simultaneously. Accordingly, merging of the two reexamination proceedings is mandated by 37 CFR 1.565(c).

Decision

Under the provisions of 37 CFR 1.565(c), reexamination proceedings designated as Reexamination Control Nos 90/005,535 and 90/005,540 are merged for consolidated proceedings. The merged proceeding will be conducted in accordance with the following guidelines and requirements

I. Requirements for Same Amendments in All Files

Patent owner must maintain the same claims and the same description/specification in both files. Since the patent owner has stipulated that no patent owner's statement would be filed, and the submission of the required "housekeeping" amendment prior to a first Office action does not invoke the provisions of 37 CFR 1.535, prosecution will proceed *ex parte*. No reply or other submission will be considered in the merged reexamination proceeding filed by the third party requester.

II. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single action which applies to both reexamination proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each separate reexamination file. Any papers filed by the patent owner must consist of a single response addressed to both reexamination files, filed in duplicate, each bearing an original signature, for entry in both files. Each file will be maintained as separate complete files. All papers filed by the patent owner must be served upon the above-identified third party requesters and such requesters will be sent copies of all papers mailed by the Office during these merged proceedings.

Docket Search

Conclusion

Reexamination Control Nos 90/005,535 and 90/005,540 are hereby merged and an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

Concur:

Al Lawrence Smith
Director
Technology Center 3600

Serial No. 90005535

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
[illegible]	[illegible]	[illegible]	[illegible]

PM32/0419

MICHAEL B HURD
SHOOK HARDY AND BACON P C
1200 MAIN STREET
KANSAS CITY MO 64105

EXAMINER
[illegible]

ART UNIT	PAPER NUMBER
[illegible]	

DATE MAILED: 04/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

UNITED STATES PATENT & TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

Reexamination Control No. 90/005,535 – Paper No. 7-8
Reexamination Control No. 90/005,540 – Paper No. 8

FOR PATENT OWNER:

Michael B. Hurd
SHOOK, HARDY, AND BACON, P.C.
One Kansas City Place
1200 Main Street
Kansas City, MO 64105-2118

FOR FIRST REQUESTER;

Paul F. Donovan
MICHAEL BEST & FRIEDRICH L.L.P.
100 East Wisconsin Aveneue
Milwaukee, WI 53202-4108

FOR SECOND REQUESTER;

Barry C. Kane
MILLER, JOHNSON, SNELL & CUMMISKEY, P.L.C.
250 Monroe Ave., N.W., Suite 800
P.O. Box 306
Grand Rapids, MI 49501-0306

DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/005,535 and 90/005,540

90005535, 90005540

NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 5,417,024 issued on May 23, 1995.

2. A first request for reexamination was filed by a third party requester, Paul F. Donovan, on October 19, 1999, and was assigned Reexamination Control No. 90/005,535.

3. On October 26, 1999, a second request for reexamination of U.S. Letters Patent No. 5,417,024 was filed by a third party requester, Karona, Inc. and was assigned Reexamination Control No. 90/005,540.

4. Reexamination was ordered in both Reexamination Control No. 90/005,535 and 90/005,540 on January 4, 2000.

Discussion

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the Reexamination proceedings will be consolidated and result in the issuance of a single Certificate under § 1.570.

As noted in the "Background", reexamination has been ordered in two reexamination proceedings simultaneously. Accordingly, merging of the two reexamination proceedings is mandated by 37 CFR 1.565(c).

Decision

Under the provisions of 37 CFR 1.565(c), reexamination proceedings designated as Reexamination Control Nos. 90/005,535 and 90/005,540 are merged for consolidated proceedings. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in All Files

Patent owner must maintain the same claims and the same description/specification in both files. Since the patent owner has stipulated that no patent owner's statement would be filed, and the submission of the required "housekeeping" amendment prior to a first Office action does not invoke the provisions of 37 CFR 1.535, prosecution will proceed *ex parte*. No reply or other submission will be considered in the merged reexamination proceeding filed by the third party requester.

II. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single action which applies to both reexamination proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each separate reexamination file. Any papers filed by the patent owner must consist of a single response addressed to both reexamination files, filed in duplicate, each bearing an original signature, for entry in both files. Each file will be maintained as separate complete files. All papers filed by the patent owner must be served upon the above-identified third party requesters and such requesters will be sent copies of all papers mailed by the Office during these merged proceedings.

Conclusion

Reexamination Control Nos 90/005,535 and 90/005,540 are hereby merged and an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

Concur:
Al Lawrence Smith
Director
Technology Center 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Mc Donnell Boehnen Hulbert
& Berghoff, Ltd.
300 South Wacker Dr.
7th Floor
CHICAGO, IL 60606

(For Patent Owner)

MAILED

MAY 16 2002

REEXAM UNIT

Hamilton Brook Smith & Reynolds, PC
530 Virginia Road
P.O. Box 9133
CONCORD, MA 01742

(For Requester)

In re Bernstein, et al
Reexamination Proceeding
Control No. 90/005,546
Filed: November 4, 1999
For: U.S. Patent No. 5,355,439

DECISION GRANTING PETITION

DOCKET, ALARM

This is a decision on the May 13, 2002, patent owner PETITION TO REVIVE UNDER 37 C.F.R. § 1.137(b), requesting revival of the present proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $1280 for the petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 13-2490, in accordance with petitioner's authorization in the last paragraph of the instant petition.

The petition is granted.

DECISION

The instant petition is accompanied by the appropriate statement pursuant to 37 CFR 1.137(b)(3) and a response to the outstanding Office action of February 28, 2002. Further, the required petition fee is being charged to petitioner's deposit account as authorized in the petition. Accordingly, the petition is granted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 2100 for issuance of an Office action in due course, with respect to the response received with the petition.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Reba I. Elmore, in Technology Center 2187.

4. Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

C:\KIVA\KPET-ABE\5546UNIN.GRT; 5-15-02

Decision on Petition

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D C 20231
www.uspto.gov

Paper No. 20

A. Blair Hughes
MCDONNELL BOEHNEN HULBERT
and BERGHOFF
300 South Wacker Drive
7th Floor
Chicago, Illinois 60606

FOR PATENT OWNER

MAR 24 2003

James M Smith Esq.
HAMILTON BROOK SMITH & REYNOLDS
Two Militia Drive
Lexington, MA 02421-4799

FOR THIRD PARTY REQUESTOR

In re Reexamination of:
U.S. Patent No. 5,355,439
Reexamination Control No.
90/005,546
For: METHOD AND APPARATUS FOR AUTOMATED TISSUE ASSAY

DECISION ON A REQUEST FOR AN EXTENSION OF TIME

This is a decision on a request for an extension of time under 37 CFR § 1.550(c) filed March 11, 2003. The request is for an extension of time of two week - until March 27, 2003 to file a response to the Office Action dated January 13, 2003.

On March 13, 2003, Patent Owner filed a response with exhibits. Copies of these papers were served on Third Party Requestor on March 21, 2003.

Since the response was timely filed on March 13, 2003, the request is **DISMISSED AS MOOT**.

The Reexamination file is being forwarded to the Examiner for consideration of the response.

Vincent N. Trans
Technology Center 2100
Computer Architecture, Software, and
Information Security
(703) 305-9750

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90/005,546	11/04/1999	5355439	1159.04A

A. BLAIR HUGHES
McDONNELL, BOEHNEN, HULBERT & BERGHOFF
300 SOUTH WACKER DRIVE
SEVENTH FLOOR
CHICAGO, IL 60606

EXAMINER
ELMORE, R.

ART UNIT	PAPER
2187	29

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

cc: JAMES M. SMITH, ESQ.
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 29
MAILED
SEP 26 2003

A. Blair Hughes
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FOR PATENT OWNER

James M. Smith, Esquire
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O. Box 9133
Concord, Massachusetts 01742-9133

FOR THIRD PARTY REQUESTOR

In re Reexamination of:
U.S. Patent No. 5,355,439
Reexamination Control No.
90/005,546
For: METHOD AND APPARATUS FOR AUTOMATED TISSUE ASSAY

DECISION ON REQUEST UNDER 37 C.F.R. § 1.550(C) FOR EXTENSION OF TIME

This is a decision on a request for an extension of time under 37 CFR § 1.550(c) filed August 29, 2003. The request is for an extension of time of one month. This petition requests extension until October 4, 2003 to respond to the Office action of June 4, 2003

The filing of a timely ***first*** response to a final rejection in a reexamination having a shortened statutory period of response is construed as a including a request to extend the period for an additional month. The extension is granted automatically in order to obviate the need of Patent Owner filing a Notice of Appeal merely to gain time to consider the Examiner's response. (*See*, MPEP § 2265.)

Patent Owner filed a timely response on September 3, 2003 which resulted in an automatic one-month extension of time. Accordingly, The request is **DISMISSED AS MOOT**.

The Owner's response to the Office action of June 4, 2003 is due on or before October 4, 2003. The Owner is reminded of the requirement under 35 U.S.C. § 305 to conduct reexamination proceedings with special dispatch.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 6

Errol B. Taylor (For Patent Owner)
FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, NY 10112-3801

Reexamination of U.S. Patent No. 5,478,852 to Olefsky et al.
Control No. 90/005,547
Filed: November 4, 1999
Attorney Docket No. 2425100REX

DECISION GRANTING PETITION

This is a decision on the December 22, 1999 petition under 37 CFR 1.182 requesting that certain materials produced in a lawsuit pursuant to a protective order be received under seal in the present reexamination proceeding, prior to the decision on the request for reexamination. The petition is being treated as a petition under 37 CFR 1.183 to suspend the rules.

The present petition is before the Office of the Deputy Assistant Commissioner for Patent Policy and Projects for decision.

The petition is **granted** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,478,852, the patent presently being reexamined, is the subject of a pending lawsuit filed in the District Court for the District of Columbia, *Beecham Group p.l.c. v. Sankyo Co. Limited*, C.A. No. 98-2087 (GK) (DAR) (hereinafter, "the § 146 lawsuit"), in which a civil remedy from the final decision in Interference No. 103,822 is requested pursuant to 35 U.S.C. 146.

2. A request for reexamination of the 5,478,852 patent was filed on November 4, 1999 by the patent owner (Sankyo). In the request, the patent owner presented Exhibits D-F, which are the reports of Beecham's experts detailing allegations made by Beecham in the § 146 lawsuit, but in redacted form. A decision on the request has not yet been issued.

3. In the § 146 lawsuit, Sankyo filed a motion to stay action in the litigation pending a decision by the Patent & Trademark Office (PTO) on Sankyo's request for reexamination of the 5,478,852 patent.

4. In response to Sankyo's motion, the Court issued a Court Order stating that a brief stay will be granted but under certain conditions. Specifically, the Court granted Sankyo's motion subject to the following:

- The entire contents of the Beecham expert reports[1] and all relevant quotations and statements by Dr. Olefsky (unredacted form) are to be filed with the PTO.
- The stay is to be in effect until no later than February 15, 2000.
- No later than February 10, 2000, the parties are to submit a joint precipe informing the Court of the status of proceedings before the PTO and whether the PTO has ruled that the request for reexamination has raised a substantial new question of patentability.

5. Petitioner now requests that the provisions of 37 CFR 1.530(a) be suspended or waived, to accommodate the recent order of the District Court for the District of Columbia in *Beecham Group p.l.c. v. Sankyo Co. Limited*, C.A. No. 98-2087 (GK) (DAR) ("Order") (attached as Exhibit A) which requires that the materials attached as Exhibits B-H (unredacted form) be submitted to the PTO supplemental to the November 4, 1999 request for reexamination of the 5,478,852 patent. Petitioner asserts that the Court's order provides an extraordinary situation, where justice requires that the provisions of 37 CFR 1.530(a) be suspended or waived. Petitioner indicates that Exhibits B-H were produced in the § 146 lawsuit pursuant to a Protective Order and petitioner now submits them for the present reexamination proceeding and requests that the PTO process them under seal.

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[1] i.e. Exhibits B-H, rather than only Exhibits D-F which were originally submitted.

DECISION

MPEP section 2258 sets forth the scope of reexamination, and part E. of this section indicates that "affidavits or declarations which *explain* the contents or pertinent dates of prior patents or printed publications *in more detail* may be considered in reexamination". Further, MPEP section 2258, Part F. 1. indicates that "an admission by the patent owner of record in the file or in a court record may be utilized *in combination with* a patent or printed publication." In order for the examiner to properly evaluate the prior art, it is appropriate for the examiner to consider the contents of the Beecham expert reports, and any relevant quotations and statements by Dr. Oflefsky contained in the unredacted Exhibits B-H.

The Court's order in the § 146 lawsuit which requires that the materials attached as Exhibits B-H (unredacted form) be submitted to the PTO provides an extraordinary situation, where justice requires that the provisions of 37 CFR 1.530(a) be suspended or waived. The reexamination process will not be harmed by granting a waiver of the rules in this instance, and it would appear beneficial to permit the examiner access to Exhibits B-H in unredacted form. This will permit consideration of these materials by the examiner in determining whether or not to order reexamination, and subsequently in the proceeding as needed. Accordingly, the present petition to suspend the rules is granted to permit the materials produced in the § 146 lawsuit pursuant to a protective order to be received under seal at this time.

EXAMINER TREATMENT OF MATERIALS

The examiner will treat the Exhibit materials submitted with this petition in accordance with MPEP 724.04(c)[2] as follows:

(1) The submitted information will be sealed in an envelope or container clearly marked "Not Open To The Public" and will be maintained separate from the reexamination file. It will not be publicly available until a determination has been made (see below) that the information is important to a reasonable examiner in deciding whether or not at least one claim is patentable.

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[2] Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d).

(2) The examiner will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not at least one claim is patentable.

(3) If any portion or all of the submitted information is found to be important to a reasonable examiner in deciding whether or not at least one claim is patentable, that information will be identified in the examiner's decision on the request for reexamination and will thereafter become a permanent part of the reexamination file and open to the public. See MPEP 724.04(c).

(4) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, the decision on the request will so indicate without including in the communication the details of the submitted information.

(5) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, that information will be resealed in its envelope or container and retained separate from the reexamination file, and unavailable to the public, pending the possible filing of a petition to expunge the information, which petition must be filed prior to the termination of the reexamination proceeding.

(6) Pending the filing of the petition to expunge, the sealed envelope or container should not be made available to any member of the public inspecting the reexamination file during the pendency of the reexamination proceeding. If no petition to expunge is filed and granted prior to termination of the reexamination proceeding, the envelope will be unsealed at the time the proceeding is terminated.

(7) Any petition to expunge a portion or all of the submitted information will be treated in accordance with MPEP 724.05.

With respect to considering the information submitted, the examiner is reminded that MPEP section 2258 stipulates that any rejection must be based upon "the prior patents or printed publications *as explained by* the affidavits or declarations". In addition, any admissions by patent owner must be evaluated in conjunction with the teachings of the prior art, in order to interpret or to modify a patent or printed publication in this reexamination proceeding.

CONCLUSION

1. The petition is **GRANTED**.

2. The reexamination file is being forwarded to Technology Center 1600 **for an immediate determination on the reexamination request of November 4, 1999.** The materials that were submitted with the present petition will be treated as discussed above.

3. Telephone inquires related to this decision should be directed to Lynn M. Kryza of the Special Program Law Office, at (703) 306-5682.

Kenneth M. Schor
Senior Legal Advisor
Special Program Law Office

January 12, 2000
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UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

Errol B. Taylor
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30 Rockefeller Plaza
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MAILED
AUG 23 2000
REEXAM UNIT

Reexamination of U.S. Patent No. 5,478,852 to Olefsky et al.
Control No. 90/005,547
Filed: November 4, 1999
Attorney Docket No. 2425100REX

DECISION GRANTING PETITION

This is a decision on the petition of May 30, 2000, under 37 C.F.R. §1.182 requesting certain materials produced in a lawsuit pursuant to a Protective Order be received in the present reexamination proceeding under seal.

This petition is being treated as a petition under 37 C.F.R. §1.183 to suspend the rules, and is before the Office of Patent Legal Administration for decision. The petition fee of $130.00 was authorized to be charged to Deposit Account No. 06-1205 in a telephone conversation with Errol B. Taylor on August 21, 2000.

The petition is **granted** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,478,852 issued to Olefsky et al. on December 26, 1995. This patent is the subject of the pending lawsuit filed in the District Court for the District of Columbia (*Beecham Group p.l.c. v. Sankyo Co. Limited*, C.A. No. 98-2087 (GK) (DAR) (the "§ 146 Action") requesting a civil remedy from the Final Decision in Interference No. 103,822 pursuant to 35 U.S.C. § 146.

2. A request for reexamination was filed by Sankyo, the Patent Owner, on November 4, 1999, and the resulting proceeding was assigned Control No. 90/005,547. In the request, the Patent Owner (Defendent in above lawsuit) presented Exhibits D-F, which are the reports of Beecham's experts detailing allegations made by Beecham (Plaintiff) in the § 146 Action, but in redacted form.

3. In the ongoing litigation in *Beecham Group p.l.c. v. Sankyo Co. Limited*, (*supra*), owner Sankyo had filed a motion to stay action in the litigation pending a decision by the Patent & Trademark Office on Sankyo's request for reexamination of U.S. Patent No. 5,478,852.

4. In response to Sankyo's motion, the Court issued a Court Order stating that a brief stay was granted but under certain conditions. Specifically, the Court granted Sankyo's motion subject to the following conditions:

   - The entire contents of the Beecham expert reports[1] and all relevant quotations and statements by Dr. Olefsky (unredacted form) shall be filed with the PTO.
   - The stay is to be in effect until no later than February 15, 2000.
   - No later than February 10, 2000 the parties are to submit a joint precipe informing the Court of the status of proceedings before the PTO and whether the PTO has ruled that the request for reexamination has raised a substantial new question of patentability[2].

5. A petition filed under 37 C.F.R. §1.182 was filed by patent owner (Sankyo) on December 22, 1999, who requested that the provisions of 37 C.F.R. §1.530(a) be suspended or waived, as the recent order of the District Court for the District of Columbia in *Beecham Group p.l.c. v. Sankyo Co. Limited*, C.A. No. 98-2087 (GK) (DAR) ("Order") (attached as Exhibit A)

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[1]i.e. Exhibits B-H, rather than only D-F which were originally submitted.

[2]In a telephone interview of August 21, 2000, with Lynn M. Kryza of the USPTO, Errol B. Taylor, attorney for patent owner, indicated that yes, the joint precipe was submitted to the Court on February 10, 2000.

required that the materials attached as Exhibits B-H (unredacted form) be submitted to the PTO supplemental to the November 4, 1999 request for reexamination of U.S. Patent No. 5,478,852. Petitioner asserted that the Court's Order was an extraordinary situation, where justice required that the provisions of 37 C.F.R. §1.530(a) be suspended or waived. Petitioner indicated that Exhibits B-H had been produced in the lawsuit pursuant to a Protective Order and Petitioner submitted them under seal for the present reexamination proceeding and requested that the PTO process them under seal.

6. On January 12, 2000, a decision on the petition under 37 C.F.R. §1.183 to suspend the rules was mailed, indicating that the petition was granted in order to allow the materials produced in the lawsuit pursuant to a Protective Order to be received under seal, and permit consideration of these materials by the examiner in determining whether or not to order reexamination, and subsequently in the proceeding as needed. The examiner was directed to treat these materials submitted under seal in accordance with **MPEP 724.04(c) Materials Submitted in Reexamination File Open to the Public Under 37 C.F.R. §1.11(d)**

7. Reexamination was ordered on January 28, 2000, in which the examiner indicated that "all of the information submitted (the Beecham expert reports and the papers of inventor Dr. Olefsky) in unredacted Exhibits B-H is important in deciding whether or not at least one claim is patentable". Therefore, the examiner has acted in accordance with MPEP 724.04(c)(C), which states:

> "If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, it will be cited in the next Office action or other appropriate Office communication and will thereafter become a permanent part of the reexamination file and open to the public."

8. A petition filed under 37 C.F.R. §1.182 was filed by patent owner (Sankyo) on June 15, 2000, requesting that the provisions of 37 C.F.R. §1.530(a) be suspended or waived so that the PTO may consider the material (attached as Exhibit I hereto and submitted under seal) which has been produced in the lawsuit pursuant to a Protective Order and owner Sankyo submits it under seal and respectfully requests that the PTO process it in that manner. Exhibit I is the

transcript of the testimony of Dr. Olefsky, one of the inventors of the patent, on cross-examination. It is indicated that the order of the District Court for the District of Columbia in *Beecham Group p.l.c. v. Sankyo Co. Limited*, C.A. No. 98-2087 (GK) (DAR) ("Order") requires that Exhibit I be submitted to the PTO in regard to the November 4, 1999, Request for Reexamination. It is asserted that this is an extraordinary situation, when justice requires that the provisions of 37 C.F.R. §1.530(a) be suspended or waived.

9. A notice of concurrent proceedings under 37 C.F.R. 1.565, was submitted by patent owner in a facsimile transmission dated August 22, 2000. It is indicated that the concurrent litigation has been stayed pending reexamination pursuant to Order of the Court dated February 16, 2000, and a copy of such Court Order is provided as an attachment.

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DECISION

The information submitted with the request for suspension of the rules is in fact a notification of the existence of prior or concurrent proceedings and decisions (see MPEP 2282). This information will be entered, since it is important for the Office to be aware of any prior or concurrent proceedings in which a patent undergoing reexamination is or was involved, such as interferences, reissues, reexamination or litigations and any results of such proceedings.

As pointed out above, the submitted information, which is attached as Exhibit I of the petition and submitted under seal, has been produced in the lawsuit pursuant to a Protective Order. Patent owner Sankyo requests that the PTO process the information in the manner provided for processing such material submitted under seal. Accordingly, the submitted material will be treated by the Technology Center in accordance with MPEP 724.04(c), which states:

> (A) The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is

important to a reasonable examiner in deciding whether or not a claim is patentable.

(B) The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, it will be cited in the next Office action or other appropriate Office communication and will thereafter become a permanent part of the reexamination file and open to the public.

(D) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether or not a claim is patentable, the next Office action or other appropriate Office communication will so indicate without including in the communication the details of the submitted information.

(E) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether or not a claim is patentable, that information will be resealed in its envelope or container and retained separate from the reexamination file, and unavailable to the public, pending the possible filing of a petition to expunge the information.

(F) Pending the filing of the petition to expunge the sealed envelope or container should be clearly marked "Not Open To The Public" and Office personnel will not make such envelope or container available to any member of the public inspecting the reexamination file.

(G) Any petition to expunge a portion or all of the submitted information under 37 C.F.R. §1.59(b) will be treated in accordance with MPEP 724.05.

The petition is granted.

REMINDER OF CONTINUING DUTY

In accordance with 37 C.F.R. §1.565(a), patent owner is reminded of the continuing obligation to provide the Office with update information regarding the existence of any such proceedings, and the results thereof, if known.

TIME PERIODS TO BE SET

Periods of response to Office actions should be set at one (1) month in order to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).

As pointed out in the FAX transmission received August 22, 2000, a stay of patent infringement litigation (in which the patent being reexamined is involved) was granted, pending the outcome of the present reexamination proceeding. MPEP 2286 points out that where a court issues such a stay, "[o]ffice actions in these reexamination proceedings will normally set a 1 month shortened statutory period for response rather than the 2 months usually set in reexamination proceedings. ... This 1-month period may be extended only upon a showing of sufficient cause."

CONCLUSION

1. The petition is granted.

2. **The material attached to the petition as Exhibit I which has been submitted under seal will be entered and processed by the Technology Center as a protected material in accordance with the procedure set forth in MPEP 724.04(c).**

3. The reexamination file will be forwarded to the examiner in Technology Center 1600 for consideration of such material in accordance with MPEP 724.04(c) in conjunction with issuance of the first Office action.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 306-5682.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

August 23, 2000

UNITED STATES PATENT & TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

Paper No. 9

W. NORMAN ROTH (For Patent Owner)
ROTH AND GOLDMAN
523 W. Sixth St., Suite 707
Los Angeles CA 90014

KEVIN E. McDERMOTT (For Requester)
3 Vanderbilt Drive, E-77
Mineola, NY 11501

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GROUP 3600

DO NOT SCAN

In re Rexamination of :
U.S. Patent No. 4,834,194 :
Frank Manchak, Jr. : PETITION
Control No. 90/005,548 : UNDER 37 CFR 1.181
Filed: November 5, 1999 : AND 37 CFR 1.515(c)
Attorney Docket No.:RE-002 :
METHOD AND APPARARTUS FOR :
DETECTION OF VOLATILE SOIL :
CONTAMINENTS IN SITU :

This is in response to Requester's petition filed February 23, 2000 under 37 CFR 1.181 and 1.515(c) requesting review of the January 19, 2000 Order Denying Request For Reexamination.

On November 5, 1999, the Requester filed a request for Reexamination of U.S. Patent No. 4,834,194 primarily based upon the WIPO document No. WO86/01439. On January 19, 2000 the Examiner issued an Order Denying Request for Reexamination. In the Denial Order the Examiner provides an in depth analysis of the WIPO '439 reference and a comparison of the reference to the claimed subject matter of the '194 patent.

In Requester's present petition, the Requester goes to great lengths to refute the assumptions and assertions made by the Examiner in the Denial Order and to reiterate

reasons why he feels that the WIPO '439 raises a substantial new question of patentability. Based upon the detailed discussion and explanation of the WIPO document found in both the Denial Order and Requester's petition, it appears that there is a substantial likelihood that a reasonable examiner would consider the WIPO '439 document important in deciding whether or not the claims of U.S. Patent No. 4,834,194 would be patentable and consequently that the WIPO '439 document does raise a substantial question of patentability.

Specifically, petitioner's assertion that the WIPO '439 reference's showing of ribs along the kelly would inherently function as annulus cutters and that a continuous gas venting passageway would be formed by the rotating ribs is concurred with. Therefore the WIPO '439 document is considered to raise a substantial new question of patentability.

The petition and the request for reexamination are **GRANTED**.

RESONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:

For Patent Owner's Statement (optional): TWO MONTHS from the mailing date of this decision. 37 CFR 1.530(b). **EXTENSIONS OF TIME ARE GOVERNED BY 37CFR 1.550(c).**

For Requester's reply (optional): TWO MONTHS from the date of service of any patent owner's statement. 37CFR 1.535. **NO EXTENSION OF TIME IS PERMITTED.** If patent owner does not file a timely statement under 37 CFR 1.530(c), no reply by the requester is permitted.

Inquiries related to this decision may be directed to Supervisory Patent Examiner David J. Bagnell at (703) 308-2151.

John F. Terapane

John F. Terapane, Director
Patent Technology Center 3600
(703) 306-4170
Facsimile No.: (703) 306-4598

SNM/DJB; 12/27/00
SM

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

#9

George C. Beck (For Patent Owner)
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Washington, D.C. 20007-5109

MAILED
AUG 21 2000
REEXAM UNIT

In re reissue application of Muira et al. Application No. 09/567,525 Filed: May 9, 2000 For: U.S. Patent No. 5,812,228	:	DECISION TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS
In re Muira et al. Reexamination Proceeding Control No. 90/005,555 Filed: November 9, 1999 For: U.S. Patent No. 5,812,228	:	

The above noted reissue and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,812,228 issued September 22, 1998.

2. On November 9, 1999, a request for reexamination was filed by patent owner, and the proceeding was assigned Control No. 90/005,555.

3. On January 24, 2000, reexamination was ordered.

4. On May 9, 2000, an application for reissue of the '228 patent was filed, and it was assigned Application No. 09/567,525.

5. The filing of the reissue application was published in the *Official Gazette* on August 1, 2000.

6. The time period for filing an Owner's statement under 37 C.F.R. § 1.530 in the reexamination proceeding has expired, and no statement was filed by patent owner.

7. A first Office action has not yet been issued in either the reexamination proceeding or the reissue application.

DISCUSSION REGARDING MERGER

Under 37 CFR § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 C.F.R. § 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue application shows that no Office action has yet been issued, but the specification and claims of the patent have been amended. A review of the reexamination file shows that reexamination was ordered on January 24, 2000. No statement under 37 C.F.R. § 1.530 has been filed by patent owner, and the reexamination is presently awaiting the issuance of a first Office action. No amendments have been filed in the reexamination proceeding. Accordingly, the claims are not identical in both proceedings.

In order to provide efficient and prompt handling of both proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination will be merged in accordance with the decision set forth below.

90005555

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-noted reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and the reexamination files for purposes of the merged proceeding. This maintenance of identical amendments in the two files is required as long as the proceedings remain merged. See 37 CFR § 1.565(d).

2. A proposed **housekeeping amendment** must be filed **within ONE (1) month** of the mailing date of this decision, to thereby place the same amendments in both cases.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, and after the expiration of two months from the O.G. Notice of August 1, 2000, the examiner should promptly prepare an Office action.

2. In the event that a housekeeping amendment is not timely submitted, any claim that does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to both the reissue application and the reexamination proceeding. Each action will contain identifying data *for both* the reissue application and the reexamination proceeding, and each action will be physically entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, filed in duplicate, each bearing a signature, for entry in both files.

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6. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissued patent, and the reissued patent will serve as the certificate under § 1.570. See MPEP 2285.

7. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned. The Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings.

8. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improper broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions remaining which cannot be considered under reexamination following dissolution of the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

9. Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 CFR § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continuation of prosecution of the reexamination proceeding.

IV. Remand to Group

1. The above noted reissue application and reexamination proceeding ARE MERGED.

2. The reissue and reexamination files are being forwarded to the examiner via the Director of Technology Center 2800. The examiner should promptly issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding after:

   (A) The appropriate housekeeping amendment pusrsuant to Part II of this decision is received, or after the time for same expires, **and**

   (B) the expiration of two months from the *Official Gazette* Notice of August 1, 2000.

3. All further examination should be conducted in accordance with Part III of this decision.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)306-5682.

Kenneth M. Schor
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

C:\KIVA\KENPET3\5555MERG.LYN
8-21-00

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C. 20231

#[redacted]6

MAILED

AUG 3 0 2000

Group 3700

Reexam Control No.: 90/004,998	:	
Filed: June 04, 1998	:	
For: U.S. Patent No. 5,242,343	:	DECISION
	:	MERGING
	:	REEXAMINATION
Reexam Control No.: 90/005,560	:	PROCEEDINGS
Filed: November 17, 1999	:	
For: U.S. Patent No. 5,242,992	:	

The above reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in 90/004,998 was ordered in a decision mailed July 14, 1998. Reexamination in 90/005,344 was ordered in a decision mailed January 19. 2000.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending. In view of the above, merger is appropriate and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims in both files. In view of the fact that amendments have been filed in Reexam 90/004,998, a housekeeping amendment is required in Proceeding 90/005,560.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action which applies to both reexamination files. The action will contain identifying data for all files and will be

physically entered in each reexamination file. Any response filed by the Patent Owner must consist of a single response filed with one copy, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See CFR 1.550(e).

Patent Owner is given 30 days from the date of this letter to file a housekeeping amendment in 90/005,560. The amendment will leave both reexaminations with identical claims and identical claim numbers.

John Kittle, Director
Technology Center 3700

JK:amo

Ronald W.Citkowski
Gifford, Krass, Groh, Sprinkle, (For Patent Owner)
Anderson, Citkowski, P.C.
280 N. Old Wooward, Suite 400
Birmingham, MI 48009

Michael McMurry
1210 Astor Street
Chicago, IL 60610 (For Requestor)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 6

Ronald W. Citkowski
GIFFORD, KRASS, GROH, SPRINKLE,
ANDERSON & CITKOWSKI, P.C.
280 N. Old Woodward, Suite 400
Birmingham, MI 48009

(for Patent Owner)

Michael B. McMurry
1210 Astor Street
Chicago, IL 60610

(for Requester)

MAILED
JAN 27 2000
REEXAM UNIT

Reexamination of U.S. Patent No. 5,383,829 to Miller.

Control No. 90/005,450
Filed: August 13, 1999

Control No. 90/005,561
Filed: November 12, 1999

DECISION DISMISSING PETITION

This is a decision on the September 2, 1999, patent owner petition under 37 CFR 1.182 which requests denial of the request for reexamination filed August 13, 1999, by third party requester Life Fitness.

This petition is before the Office of the Deputy Assistant Commissioner for Patent Policy and Projects for decision.

The petition is **DISMISSED** for the reasons set forth below.

REVIEW OF FACTS

1. On January 24, 1995, U.S. Patent No. 5,383,829 (the '829 patent) was issued.

2. On November 25, 1997, the patent owner, Larry Miller, filed a first request for reexamination of the '829 patent, which request was assigned Control No. 90/004,848.

3. On February 6, 1998, an order granting reexamination was mailed in Control No. 90/004,848.

4. On April 17, 1998, a third party requester, the NordicTrack Corporation, filed a second request for reexamination of the '829 patent, which request was assigned Control No. 90/005,030.

5. On May 15, 1998, a third party requester, the Brunswick Corporation, filed a third request for reexamination of the '829 patent, which request was assigned Control No. 90/004,999.

6. On July 9, 1998, an order granting reexamination was mailed in Control No. 90/005,030.

7. On July 14, 1998, an order granting reexamination was mailed in Control No. 90/004,999.

8. On March 18, 1999, a decision merging reexamination Control Nos. 90/004,848, 90/005,030 and 90/004,999 was mailed.

9. A nonfinal Office action for the merged proceeding of Control Nos. 90/004,848, 90/005,030 and 90/004,999 was mailed on May 5, 1999. Patent owner filed, on July 6, 1999, a response to the nonfinal Office action.

10. On August 13, 1999, a third party requester, the Life Fitness division of the Brunswick Corporation, filed a fourth request for reexamination of the '829 patent, which request was assigned Control No. 90/005,450.

11. On September 2, 1999, the present petition was filed by the patent owner, Larry Miller, requesting denial of the reexamination request Control No. 90/005,450 as harassment of the patent owner.

12. On October 18, 1999, an order granting reexamination was mailed in Control No. 90/005,450. The period for filing a patent owner's statement under 37 CFR 1.530 after the request has expired.

13. On November 12, 1999, Life Fitness filed a fifth request for reexamination of the '829 patent, which request was assigned Control No. 90/005,561.

14. A decision on the request for reexamination of U.S. Patent No. 5,383,829, in Control No. 90/005,561 has not yet been mailed.

DECISION

MPEP section 2240 sets forth the criteria for a decision on a request for reexamination, and this section specifically addresses second or subsequent requests filed during reexamination. This section indicates that "If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should generally be ordered. This is because the prior art which raised a substantial new question of patentability resulting in an order for reexamination continues to raise a substantial new question of patentability until the pending reexamination is concluded."

MPEP section 2240 also indicates that "upon petition by the patent owner under 37 C.F.R. §1.182, where it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, the request should be denied. The grant of such a request would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement that reexamination proceeding be conducted with special dispatch."

The present petition under 37 CFR 1.182 requesting denial of the request for reexamination of the '829 patent is **DISMISSED**.

With regard to the harassment issue raised by Patent Owner, consideration is being given to this issue with regard to the requests in both Control Nos. 90/005,450 and 90/005,561 reexamination proceedings, the '5,561 proceeding being addressed *sua sponte* by the U.S. Patent & Trademark Office. Accordingly, a copy of this decision is being placed in both the 90/005,450 and 90/005,561 files.

A review of the records for the reexamination proceedings reveals that the fourth and fifth requests for reexamination (Control Nos. 90/005,450 and 90/005,561) included the prior art that raised a substantial new question in the merged proceeding of Control Nos. 90/004,848, 90/005,030 and 90/004,999, along with additional prior art, and additional evidence. Based on this, reexamination could generally be ordered because the prior art which raised a substantial new question of patentability in the merged proceeding continues to raise a substantial new question of patentability until the merged proceeding is concluded.

In addition, the August 13, 1999, fourth request for reexamination (Control No. 90/005,450) was filed less than 6 weeks after the patent owner's July 6, 1999, response to the May

5, 1999, nonfinal Office action in the merged proceeding (of Control Nos. 90/004,848, 90/005,030 and 90/004,999). Thus, it does not appear that granting of the fourth request would unduly prolong the conclusion of the pending merged reexamination proceeding. Similarly, the November 12, 1999, fifth request for reexamination (Control No. 90/005,561)by the Life Fitness division of the Brunswick Corporation was filed less than one month after the October 18, 1999 order granting reexamination in Control No. 90/005,450. Thus, it does not appear that granting of the fifth request would unduly prolong the conclusion of the pending merged reexamination proceedings.

Since there is no showing that the granting of the fourth and fifth requests for reexamination would unduly prolong the conclusion of the pending merged reexamination proceeding, it has not been established that the fourth or fifth requests were filed for purposes of harassment of the patent owner. The grant of the fourth and fifth requests, and consideration of them, has not been shown to provide a delay of sufficient duration to interfere with the "special dispatch" requirement for the merged reexamination proceeding.

HANDLING OF THE PROCEEDINGS BY THE TECHNOLOGY CENTER

1. The examiner is directed to issue a decision on the fifth request for reexamination (90/005,561) immediately upon return of the reexamination proceedings to the Technology Center 3700.

2a. If reexamination *is granted* for the 90/005,561 proceeding, the five proceedings will be forwarded to the Group Director of Technology Center 3700 for issuance of a decision merging the 90/005,450 and 90/005,561 proceedings with the merged proceeding of Control Nos. 90/004,848, 90/005,030 and 90/004,999 at the appropriate time.

2b. If reexamination *is denied* for the 90/005,561 proceeding, the reexamination proceedings will be forwarded to the Group Director of Technology Center 3700 for issuance of a decision merging the present 90/005,450 proceeding with the merged proceeding of Control Nos. 90/004,848, 90/005,030 and 90/004,999.

CONCLUSION

The petition is **DISMISSED**.

The reexamination files are being forwarded to the Group Director of Technology Center 3700, for processing not inconsistent with this decision.

Telephone inquires related to this decision should be directed to Lynn M. Kryza of the Special Program Law Office, at (703) 306-5682.

Kenneth M. Schor
Senior Legal Advisor
Special Program Law Office

January 27, 2000

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

#9

MAILED
JUN 14 2000
Group 3700

Reexam Control No.: 90/004,848 Filed: November 25, 1997 For: U.S. Patent No. 5,383,879	:	
Reexam Control No.: 90/004,999 Filed: June 04, 1998 For: U.S. Patent No. 5,383,879	:	
Reexam Control No.: 90/005,030 Filed: July 02, 1998 For: U.S. Patent No. 5,383,879	:	DECISION MERGING REEXAMINATION PROCEEDINGS
Reexam Control No.: 90/005,450 Filed: August 18, 1999 For: U.S. Patent No. 5,383,879	:	
Reexam Control No.: 90/005,561 Filed: November 17, 1999 For U.S. Patent No.: 5,383,879	:	

The above reexamination requests are before the Director of Technology Center 3700 for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in 90/004,848 was ordered in a decision mailed February 06, 1998. Reexamination in 90/004,999 was ordered in a decision mailed July 14, 1998. Reexamination in 90/005,030 was ordered in a decision mailed July 09, 1998. Reexamination in 90/005,450 was ordered in a decision October 18, 1999. Reexamination in 90/005,561 was ordered in a decision mailed February 03, 2000.

The first three reexamination proceedings are already merged. Merger is proper if a reexamination is ordered while a prior reexamination proceedings are pending. Accordingly, merger is appropriate for 90/005,450 and 90/005,561 and is hereby ordered.

Requirement for Same Claims in All Proceedings

The Patent Owner is required to maintain identical claims and identical claim numbering in all five files. A housekeeping amendment is required in 90/005450 and in 90/005561.

Conduct of Proceeding

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. The Examiner's actions will take the form of a single action which applies to all five reexamination files. The action will contain identifying data for all files and will be physically entered in each reexamination file. Any response filed by the Patent Owner must consist of a single response filed with four copies, each paper bearing an original signature, for entry in each file. Any response must be served on requester and requester will be sent copies of Office actions. See CFR 1.550(e).

At this time the Patent Owner is required to file a housekeeping amendment in Reexamination Proceedings 90/005,450 and 90/005,561 so that the claims in all three proceedings are identical in content and numbering. The Patent Owner is given 1 month from the date of this letter to file the housekeeping amendments.

John J. Love

John J. Love, Director
Technology Center 3700

JJL:amo

Ronald W. Citkowski
Gifford, Krass, Groh, Sprinkle,
Anderson and Citkowski
280 N. Old Woodward, Suite 400
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(For Patent Owner)

Merger -90/004 848

90/004,999
90/005,030
90/005,450
90/005,561

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(For Requester)

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D C. 20231
www uspto gov

Paper No. 18

MAILED

APR 0 2 2002

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

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(Patent Owner's New Correspondence Address)

AIR MAIL

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(Withdrawing Attorneys)

Harold L. Novick
Nath & Associates
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Washington, D.C. 20005

(For Third Party Requester)

In re Douglas E. DeVivo :
Reexamination Proceeding : DECISION ON REQUEST
Control No. 90/005,565 : TO WITHDRAW AS
Filed: November 11, 1999 : ATTORNEYS OF RECORD
For: U.S. Patent No. 5,705,759 :

This is a decision on the request to withdraw as attorneys of record under 37 C.F.R. § 1.36, filed March 8, 2002.

The request is APPROVED.

The request was signed by David B. Woycechowsky on behalf of all attorneys of record.

Future communications from the Office will be directed to the new correspondence address in Taiwan as indicated above.

It is noted that the request to withdraw as attorneys of record was not served on the third party

requester as required. See 37 C.F.R. § 1.530(c). Patent owner is reminded that all papers submitted in this reexamination proceeding must be served on the third party requester.

Any inquiry relating to this letter should be directed to Hien H. Phan, Special Program Examiner, at (703) 308-7502.

Henry Phan for

Janice A. Falcone, Director
Technology Center 2800
Semiconductor, Electrical and Optical
Systems and Components

Enclosure: Copy of Request for Withdrawal as Attorney or Agent to third party requester only

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/005,565	11/17/1999		84051

CONFIRMATION NO. 5505

OC000000007768729

LOUIS J. CHRISTEN, III
MERCURIES ASIA, LTD.
18/F MP. 10, LSNR 376
NAN-KING EAST ROAD, SEC. 5
TAIPAEI 105,
TAIWAN

Date Mailed: 04/02/2002

NOTICE REGARDING POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/08/2002.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

RENEE M PRESTON
2800 (703) 308-2043

OFFICE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/005,565	11/17/1999		84051

CONFIRMATION NO. 5505

OC000000007768631

EDWARD H. SIKORSKI, ESQ.
LUCE, FORWARD, HAMILTON & SCRIPPS LLP
600 WEST BROADWAY, SUITE 2600
SAN DIEGO, CA 92101

Date Mailed: 04/02/2002

NOTICE REGARDING POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/08/2002.

The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

Renee Preston

RENEE M PRESTON
2800 (703) 308-2043

OFFICE COPY

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D C 20231

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

HAROLD L. NOVICK
NATH & ASSOCIATES
1030 15TH STREET, NW
6TH FLOOR
WASHINGTON, DC 20005

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,565

PATENT NO. 5,705,759

ART UNIT 2837

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding. 37 C.F.R. 1.550(e).

Where this copy is supplied after the reply by requester, 37 C.F.R. 1.535, or the time for filing a reply has passed, no submissions on behalf of the reexamination requester will be acknowledged or considered. 37 C.F.R. 1.550(e).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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#16
Cmas

Paper No. 16

Terrence Soon-Shiong
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2825 Santa Monica Blvd.
Santa Monica, CA 90404

(For Patent Owner)

Carol A. Schneider
LYON & LYON, LLP
633 West Fifth St.
Suite 4700
Los Angeles, CA 90071-2066

(For Requester)

MAILED

MAY 1 1 2001

REEXAM UNIT

DO NOT ENTER

In re Reexamination Proceeding
Control No. 90/005,566
Filed: November 18, 1999
For: U.S. Patent No. 5,334,640
Patentee: Desai, et al.

DECISION DISMISSING PETITION

This is a decision on the patent owner petition of February 22, 2001, requesting the entry of the late filed amendment in response to the final Office action of November 22, 2000. The petition is being treated as a PETITION UNDER 37 C.F.R. § 1.137(a) for the entry of late papers on the grounds of unavoidable delay; see MPEP 2268. A petition fee under 37 C.F.R. § 1.17(l) of $110.00, for the reexamination proceeding has been charged to petitioner's deposit account 50-0872, as per petitioner's instructions on page 3 of the present petition. The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 C.F.R. § 1.137(a) for the entry of late papers is **dismissed** for the reasons pointed out below.

Any request for reconsideration of this decision under 37 C.F.R. § 1.137(a) or § 1.137(b) must be submitted within **ONE (1) MONTH** from the mail date of this decision. **Extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(a) or § 1.137(b)."

REVIEW OF FACTS

1. U.S. Patent No. 5,334,640 issued to Desai, et al. on August 2, 1994.

2. A request for reexamination was filed by a third party requester on November 18, 1999, and was assigned control no. 90/005,566.

3. Reexamination was ordered on January 12, 2000.

4. A final Office action was mailed on November 22, 2000.

5. The present petition, accompanied by a proposed response to the final Office action, was received on February 22, 2001.

DECISION

I. Petition for entry of late paper due to unavoidable delay.

This reexamination proceeding terminated after January 22, 2001, for failure to timely file a response within the meaning of 37 C.F.R. § 1.113 to the final Office action of November 22, 2001, which set a shortened statutory period for response of two (2) months, and noted that extensions of time were governed by 37 C.F.R. § 1.550(c).

A grantable petition for entry of belated papers under 37 C.F.R. § 1.137(a) requires:

(A) the required reply, unless previously filed;

(B) the petition fee as set forth in 37 C.F.R. § 1.17(l);

(C) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a) was unavoidable.

The present petition lacks item (C).

The present petition states that "the Office action was mailed directly to applicants (and only to applicants), instead of being mailed to applicant's duly appointed representative." It is explained that "Applicants erroneously assumed that the 'normal' time for response, i.e., three months, was applicable here. It was only after the expiration of the two month period set for response in the Office action mailed November 22, 2000, that such error was recognized." It is also indicated that "once the Office action was received by applicants, it needed to be forwarded to applicant's representative for review and evaluation," and that this "was further complicated by the fact that applicant's representative changed employment from one firm to another during the time-frame in which a response was due in this case." It is asserted that as a result of all of the above factors that applicants <u>inadvertently</u> failed to timely respond to the Office action in this reexamination. (Emphasis added)

It is first noted that it is unclear on what basis petitioner is attempting to establish a showing of "unavoidable" delay. If petitioner is attempting to establish that such delay was "unavoidable" due to a change of address, then it should be noted that an adequate showing of "unavoidable" delay on this basis will **require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application (which in this case is a reexamination proceeding) of the change of address (see MPEP 601.03), and must include an adequate showing that a timely notification of the change of address was**

filed in the application (reexamination proceeding) concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address.

The following do **not** constitute proper notification of a change in correspondence address:

(A) the mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, without mention of the fact that an address change was being made;

(B) the notification on a paper listing plural applications as being affected (except as provided for under the Customer Number practice - see MPEP 403); or

(C) the lack of notification, or belated notification, to the Patent and Trademark Office of the change in correspondence address.

Page 4 of 5 - 90/005,566

With regard to petitioner's statement that "the Office action was mailed directly to applicants (and only to applicants), instead of being mailed to applicant's duly appointed representative," it is noted that **all previous** Office communications in this reexamination proceeding (a total of seven papers) were mailed to the same address of record. This apparently was never a problem before, as patent owner timely responded to all previous Office communications, and a request for a change of address has **not** been received. In the present petition, the petitioner indicates that "once the Office action was received by applicants, it needed to be forwarded to applicant's representative for review and evaluation," and that this "was further complicated by the fact that applicant's representative changed employment from one firm to another during the time-frame in which a response was due in this case." It is noted that to date, despite this explicit indication of petitioner's employment change in the present petition, no request for a change of address has been received in this reexamination proceeding.

Secondly, petitioner also states that "Applicants erroneously assumed that the "normal" time for response, i.e., three months, was applicable here. It was only after the expiration of the two month period set for response in the Office action mailed

November 22, 2000, that such error was recognized." From this statement, it appears that petitioner may be alleging that the "error" that was the cause of the delay was patent owner's erroneous assumption that the time period for response to the final Office action was three (3) months. However, the final Office action of November 22, 2000, clearly indicates that the "shortened statutory period for response to this action is set at two month(s) from the date of this letter," and that "Failure to respond within the period for response will cause termination of the proceeding and issuance of a reexamination certificate in accordance with this action." Further, it should be noted that **a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay.** See *Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff*, 230 USPQ621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891).

Thirdly, it is unclear if petitioner is attempting to allege that the delay was "unavoidable" based upon some type of docketing or other clerical error.

As noted in MPEP 711.03(c)§(III)(2), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable delay", provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See *In re* Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds *sub nom* Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); *In re*

Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

However, Petitioner's showing fails to meet criteria (A),(B) and (C) immediately above. Based upon petitioner's statements in the present petition, the showing fails to adequately evidence the error was the cause of the delay at issue; it fails to indicate that there was a business routine for ensuring that USPTO correspondence was properly received, docketed and forwarded; and it fails to show that the personnel were sufficiently trained in docketing due dates for reexamination proceedings such that petitioner was prudent in relying upon the personnel.

If petitioner decides to file a RENEWED PETITION UNDER 37 C.F.R. § 1.137(a) for the entry of late papers on the grounds of unavoidable delay, petitioner should be aware that with regard to an adequate showing of the cause of unavoidable delay, in addition to the criteria mentioned above, the Office requires:

(1) evidence concerning the procedures in place that should have avoided the error resulting in the delay;

(2) evidence concerning the training and experience of the persons responsible for the error; and

(3) copies of any applicable docketing records to show that the error was in fact the cause of the delay.

For the reasons set forth above, the petition is **dismissed.**

ALTERNATIVE OPTION

II. Petition for entry of late paper due to unintentional delay.

Petitioner may wish to consider the filing of a petition under 37 C.F.R. § 1.137(b) if the delay in filing the response to the final Office action of November 22, 2000, was unintentional. The unintentional delay fee provisions of 35 U.S.C. § 41(a)(7) have

been imported into, and are applicable to, all *ex parte* reexamination proceedings by Sec. 4605 of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 C.F.R. § 1.137(b) where untimely papers are filed subsequent to the order for reexamination.

Any such petition must provide:

(1) a statement that the entire delay from the due date for the response to the filing of a grantable petition was unintentional,

(2) a proposed response to continue prosecution (unless it has been previously filed), and

(3) the petition fee required by 37 C.F.R. § 1.17(m).

CONCLUSION

1. The petition is **dismissed**.

2. Any renewed petition (based upon unavoidable delay or unintentional delay) must be filed within **ONE (1) MONTH** of the mailing date of this decision.

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

90005566.051101

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

4. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Gerald A. Dost

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

May 10, 2001

Printed: 5/15/2001

#21 (mav)

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 21

Stephen E. Reiter (For Patent Owner)
FOLEY & LARDNER
402 West Broadway
23rd Floor
San Diego, CA 92101-3542

Carol A. Schneider (For Requester)
LYON & LYON, LLP
633 West Fifth St.
Suite 4700
Los Angeles, CA 90071-2066

MAILED

JUL 10 2001

REEXAM UNIT

In re Reexamination Proceeding
Control No. 90/005,566
Filed: November 18, 1999
For: U.S. Patent No. 5,334,640
Patentee: Desai, et al.

DECISION DISMISSING PETITION

This is a decision on the patent owner renewed PETITION UNDER 37 C.F.R. § 1.137(b) of June 1, 2001, for the entry of late papers on the grounds of unintentional delay, requesting the entry of the late filed amendment in response to the final Office action of November 22, 2000. A petition fee under 37 C.F.R. § 1.17(m) of $620.00, for the reexamination proceeding has been charged to petitioner's deposit account 50-0872, as per petitioner's instructions on page 2 of the present petition. The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 C.F.R. § 1.137(b) is **dismissed** for the reasons indicated below.

Any request for reconsideration of this decision under 37 C.F.R. § 1.137(b) must be submitted within **ONE (1) MONTH** from the mail date of this decision. **Extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(b)."

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The instant petition is accompanied by the required reply and the petition fee. The instant petition lack(s) item (3) above. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3), and is **not**

sufficient to meet the requirement of 37 C.F.R. § 1.137(b)(3), as it merely indicates that "the entire delay in responding to the Office Action in Re-examination mailed November 22, 2000, was unintentional." Accordingly, any renewed petition based upon unintentional delay should include the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

In view of the above, the petition for the entry of late papers is **not** sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **dismissed**.

CONCLUSION

1. The petition is **dismissed**.

2. Any renewed petition based upon unintentional delay must be filed within **ONE (1) MONTH** of the mailing date of this decision.

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Patent Legal Administration

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

4. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

July 3, 2001

90005566.060101

24 Mail

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 24

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San Diego, CA 92101-3542

(For Patent Owner)

Carol A. Schneider
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Los Angeles, CA 90071-2066

(For Requester)

MAILED
AUG 2 2 2001
REEXAM UNIT

In re Reexamination Proceeding
Control No. 90/005,566
Filed: November 18, 1999
For: U.S. Patent No. 5,334,640
Patentee: Desai, et al.

DECISION GRANTING PETITION

This is a decision on the August 7, 2001, patent owner RENEWED PETITION UNDER 37 C.F.R. § 1.137(b), requesting acceptance of the delayed response in the present reexamination proceeding and revival of the proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

DECISION

37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the renewed petition contains the language required by 37 C.F.R. § 1.137(b)(3).

The renewed petition is accompanied by a proposed amendment, which appears to be a duplicate copy of the proposed amendment filed with the previous petition of June 1, 2001, filed in response to the final rejection of November 22, 2000. The petition fee under 37 C.F.R. § 1.17(m) was paid with the previous petition of June 1, 2001. In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is granted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 1700 for consideration of the proposed amendment of August 7, 2001.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the examiner, Paul Michl, in Technology Center Art Unit 1714.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

August 21, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

21 MS

William A. Blake (For Patent Owner)
Jones, Tullar & Cooper, P.C.
P.O. Box 2266 Eads Station
Arlington, VA 22202

MAILED
JUN 07 2002
REEXAM UNIT

In re Flisik et al.
Reexamination Proceeding
Control No. 90/005,567
Filed: November 23, 1999
For: U.S. Patent No. 5,414,762

DECISION GRANTING PETITION

This is a decision on the June 4, 2002, patent owner PETITION FOR REVIVAL OF UNINTENTIONALLY TERMINATED REEXAMINATION PROCEEDING UNDER 37 CFR § 1.137(b) AND MPEP § 2268, requesting revival of the present proceeding under the unintentional standard. The petition is before the Office of Patent Legal Administration for decision.

The petition is granted.

DECISION

1. The statement of unintentional delay presented in the petition is:

> "The undersigned attorney hereby verifies that the entire delay in filing this petition with the attached Response and Proposed Amendment was unintentional."

Effective December 1, 1997, 37 CFR 1.137(b)(3) requires submission of a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." The above-quoted statement does not comply with the current rule. However, the statement presented will be accepted and so construed. If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

2. Petitioner's amendment filed on June 4, 2002 (with the present petition), has been deemed to place this proceeding in condition for issuing a Notice of Intent to Issue Reexamination Certificate (NIRC) indicating the claims to be patentable, and the amendment will be entered.

3. The instant petition is accompanied by a statement that has been accepted and construed as an appropriate statement pursuant to 37 CFR 1.137(b)(3) and by a response to the outstanding Office action. Further, the required $640 small entity petition fee has been paid by a check accompanying the petition. Accordingly, the petition is granted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 2600 for issuance of a NIRC in due course, with respect to the response received with the petition.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Harry Hong, in Technology Center 2642.

4. Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 12

John C. Janka
NIRO, SCAVONE, HALLER & NIRO
181 West Madison Street
Suite 4600
Chicago, IL 60602

(For Patent Owner)

Mailed
MAY 09 2000
Director's Office
Group 2700

Thomas K. Stine
WALLENSTEIN & WAGNER LTD.
311 South Wacker Drive
53rd Floor
Chicago, IL 60606

(For Third Party Requester)

In re Application of: Frank A. Calabrese
Application No. 90/005,568
Filed: November 24, 1999
For: DATA RELAY SYSTEM

DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.181(a)(3), §1.182 and §1.183 filed March 28, 2000 requesting that the Order Granting a Request for Reexamination (Paper No. 5, mail date January 28, 2000) be vacated.

BASIS OF OPINION

MPEP § 2246 states in relevant part:

PETITION TO VACATE THE ORDER GRANTING REEXAMINATION

A substantive determination by the Commissioner to institute reexamination pursuant to a finding that the prior art patents or printed publications raise a substantial new question of patentability **is not subject to review by petition or otherwise.**

A petition under 37 CFR § 1.181 may, however, be filed to vacate an ultra vires reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for

reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR § 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

(A) the reexamination order is not based on prior art patents or printed publications;

(B) all claims of the patent were **held to be invalid** by a final decision of a Federal Court;

PETITIONER'S POSITION

The Petitioner contends that the Reexamination Order was *Ultra Vires*, and presents the following arguments in support of this position.

1. The Examination Order was not based on prior art ***patents or printed publications***, as mandated by 35 U.S.C. § 301 and MPEP § 2217 (***Emphasis Added***) [pages 3-1 7]

This is supported by asserting that the Reexamination order is based on ".. an expansive view of the claims" allegedly attributed to the inventor. Petitioner argues that the Order is predicated upon **(A)** "matter not authorized by the statute" - that is, attorney argument unsupported by evidence, **(B)** False assertions about Mr. Calabrese's "alleged Expansive View of the Claims", **(B)(1)** Assertions with respect to Mr. Calabrese's Alleged Statements, even if true, are barred from consideration, **(B)(2)** Infringement issues which USPTO is not authorized to consider, and **(C)** False assertions by Requester with respect to the Seriplex device.

2. The Reexamination Request is an improper attempt to ***relitigate issues*** already decided by the ***United States District Court***. (***Emphasis added)*** [pages 17-20]

OPINION

a. The first issue to be resolved is whether the Reexamination Order is based on the "expansive view of the claims" as posited by Petitioner.

A careful reading of the Request for Reexamination indicates that at least with respect to Fort and Slane the statements requester attributed to Mr. Calabrese were not needed in order to raise a new issue of patentability. The matching of claim limitations to the art presented in the request does not rely on the expansive view for any element. In any case, the prior art cited in the Request raises a substantial new issue.

Therefore, despite the Examiner's choice of wording, the granting of the order was based on prior art ***patents or printed publications*** and not on improper material. Based upon this determination, items **A** is resolved. ***The order is based solely on matter authorized by the statute.***

It follows from this determination that all other issues under 1. above are moot. That is, with respect to the granting of the Order, any submissions with respect to Alleged Statements are irrelevant [items **B** and **B(1)**]. So too, whether the Examiner was permitted to consider Square D's representations with respect to infringement **[(B)(2)]** or the properties of the Seriplex device **[(C)]** has no bearing on the granting of the Order, since they need not be considered in making the determination of the new issue.

Note, that this determination of irrelevance with respect to the granting of a reexamination order does not mean that these issues need not be considered during the reexamination proceeding.

b. The second issue to be considered is whether the request is barred as an attempt to relitigate issues already decided by the District Court.

This issue has not been litigated. As Petitioner points out, the court refused to allow these references to be considered because of the perceived lack of timeliness of their presentation.

Additionally, even if the issue concerning the references were resolved by the District Court, the decision is not a final decision by a Federal Court. Only a final decision of **invalidity** by a Federal Court is binding on the Office. That is, where there is no valid patent, an order granting reexamination would be moot as there are no valid claims to reexamine. The District Court's decision in this case is one upholding validity which is not controlling on the Office as the standard of proof for validity and patenability are different. See MPEP § 2243.

Accordingly, the Petition is **DENIED**.

If the petitioner desires further review of the Director's Decision, applicant should consider filing a Petition for Review of the Director's Decision under 37 CFR §1.181(a)(3).

The application file is being forwarded to the Technology Center's Special Program Unit to await the Patent Owner's statement which is due on or before May 28, 2000. The Owner is reminded of the requirement under 35 U.S.C. § 305 to conduct reexamination proceedings with special despatch.

Jin F. Ng, Director
Technology Center 2700
Communications and Information Processing

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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LATHROP & GAGE LC
2345 GRAND AVENUE
SUITE 2800
KANSAS CITY MO 64108

(For Patent Owner)

MAILED

MAY 2 6 2005

REEXAM UNIT

In re Reexamination Proceeding
Hulse et al.
Control No. 90/005,571
Filed: November 24, 1999
U.S. Patent No. 5,935,136
Attorney Docket No. 410882

: DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on April 19, 2005, by facsimile transmission, to revive the present reexamination preceding.

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

37 CFR 1.137(b) states:

> *"Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

The present petition under 37 CFR 1.137(b) includes the requisite response (item 1), a $750.00 small entity petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition is granted.

The $750.00 small entity petition fee will be charged to counsel's deposit account No. 12-0600 in accordance with the present petition.

Thereafter, the reexamination file will be returned to Technology Center Art Unit 3731 for further examination and consideration of the amendment filed April 19, 2005, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Glenn K. Dawson, in Technology Center Art Unit 3731, who can be reached at 571-272-4694.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Conferee: Fred A. Silverberg

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#23

AUG 13 2001

John M. Collins
Hovey, Williams, Timmons & Collins
2405 Grand Boulevard Suite 400
Kansas City, Missouri 64108

In re Reexamination Proceeding
Control No. 90/005,579
Patent No. 5,522,152
Patentee: Rick Woolsey
Filed: December 2, 1999

DECISION ON
REQUEST FOR
EXTENSION OF TIME

Receipt is acknowledged of a request for extension of time under 37 CFR 1.550(c), filed on August 3, 2001 and entered in the file as paper No. 22.

A Notice of Appeal was filed on June 18, 2001 with a certificate of mailing of June 13, 2001. Patentee indicates that the appeal brief is due August 13, 2001, however in accordance with 37 CFR 1.192, the time for filing an Appeal Brief is two months from the date the Notice of Appeal is filed in the Office and not the certificate of mailing date. Therefore, patentee's time for filing the Appeal Brief ends on August 20, 2001 (August 18, 2001 being a Saturday).

The request indicates that the main reason for the extension of time is to allow an appeal brief to be filed, if necessary, after a decision on the petition filed on July 6, 2001 has been rendered. The request is for a two month extension of time which would extend the time for response to October 18, 2001.

The request for an extension of time is for sufficient cause and is granted.

The time to file an appeal brief is extended to expire on October 18, 2001.

Further extensions of time in this regard should not be expected.

Linda Sholl
Special Program Examiner
Technology Center 3700
Phone: (703) 308-1288
Fax: (703) 308-7766

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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#29

John M. Collins
HOVEY, WILLIAMS, TIMMONS & COLLINS
2405 GRAND BLVD.
SUITE 400
KANSAS CITY, MO 64108

(For Patent Owner)

MAILED

JAN 16 2002

Director's Office
Group 3700

In re Reexamination Proceeding :
Control No. 90/005,579 :
Filed: December 2, 1999 :
For: U.S. Patent No. 5,522,152 :
Patentee: Woolsey :

: WITHDRAWAL OF FINALITY OF
: OFFICE ACTION & ENTRY OF
: AMENDMENT UPON RECONSIDERATION
: OF PRIOR DECISION

DO NOT ENTER

This is a decision on the September 19, 2001 patent owner petition under 37 CFR 1.181 entitled "RENEWED PETITION UNDER 37 CFR §1.181 FOR WITHDRAWAL OF PREMATURE FINAL REJECTION AND ENTRANCE OF RESPONSIVE AMENDMENT." In view of the relief requested, the petition is taken as a request for reconsideration of the decision under 37 CFR 1.181 mailed August 30, 2001.

This is also a decision on the September 19, 2001 patent owner petition under 37 CFR 1.183, to waive the rules, and order entry and consideration of patent owner's May 21, 2001 amendment after final Office action.

(A) The request for reconsideration of the decision under 37 CFR 1.181 is **granted** for the reasons set forth below. The finality of the February 13, 2001 Office action is withdrawn, and the proposed amendment filed May 21, 2001 will be entered. The proceeding is being returned to the examiner for consideration of the amendment and further action, as appropriate.

(B) The petition under 37 CFR 1.183 is **dismissed** as moot.

(C) The appeal resulting from the June 18, 2001 Notice of Appeal is **dismissed without prejudice** to patent owner for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent Number 5,522,152 (the '152 patent) issued to Woolsey on June 4, 1996.

2. On December 2, 1999, a request for reexamination of the '152 patent was filed and was assigned Control No. 90/005,579 (the '5579 proceeding).

3. On February 23, 2000, reexamination was ordered in the '5579 proceeding, based upon Ellerbeck (US 2577315), Cross (US 4170183), and German patent 406.

4. On October 31, 2000, a first Office action on the merits was issued by the examiner. The claims of the '152 patent were rejected based upon the Ellerbeck, Cross, and German patents which three patents also served as the basis for the order of reexamination.

5. In response to the first Office action, patent owner filed the amendment of December 29, 2000, whereby the claims were amended.

6. On February 13, 2001, a final Office action on the merits was issued by the examiner. In the action, the claims pending in the reexamination proceeding were rejected based upon newly cited Japanese patent 4-62387. The action was made final based on the statement that "Applicant's [*sic.*] amendment necessitated the new ground(s) of rejection presented in this Office action."

7. On April 13, 2001, patent owner filed a first amendment after final Office action, directed to defining patentability over the Japanese patent. This amendment was denied entry in the advisory Office action of May 7, 2001, as the amendment failed to comply with the formal requirements of 37 CFR 1.530(d).

8. On May 21, 2001, patent owner filed a second amendment after final Office action, to deal with the formality problem noted in the May 7, 2001 advisory action, and again directed to defining patentability over the Japanese patent.

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9. On June 18, 2001, the patent owner timely filed a Notice of Appeal. (The Notice was timely since the advisory Office action of May 7, 2001 had extended the period for response to "4 months" from the date of the final Office action of February 13, 2001, and the Notice of Appeal bore a Certificate of Mailing dated "6-13-01.")

10. The examiner then issued a second advisory Office action on July 12, 2001, in which the second amendment after final Office action was denied entry. The reason for non-entry of the amendment was stated to be that the amendment raised new issues requiring further consideration and/or search, it raised the issue of new matter, and it failed to place the proceeding in better form for appeal by materially reducing/simplifying the issues for appeal.

11. On July 6, 2001, patent owner filed a "PETITION UNDER 37 CFR §1.181, OR IN THE ALTERNATIVE UNDER 37 CFR §1.183, FOR WITHDRAWAL OF PREMATURE FINAL REJECTION AND ENTRANCE OF RESPONSIVE AMENDMENT." The petition requested withdrawal of the February 13, 2001 final rejection as premature and entry of the unentered second amendment after final Office action.

12. On August 13, 2001, the Technology Center Special Program Examiner granted a patent owner request for an extension of time. The time for filing an appeal brief was extended to October 18, 2001.

13. On August 30, 2001, the Group Director issued a decision on the July 6, 2001 petition. The decision dismissed the petition under 37 CFR 1.183 <u>without</u> prejudice, stating a need for a separate paper directed to that petition. The decision further dismissed the petition under 37 CFR 1.181 <u>with</u> prejudice setting a two month period for requesting reconsideration of the decision.

14. The present request for reconsideration and § 1.183 petition were filed September 19, 2001.

    In the request for reconsideration, it is requested that the Group Director's decision "be reversed," the final rejection of February 13, 2001 be determined to be premature, the finality of the rejection be withdrawn, and the May 21, 2001 second amendment after final Office action be entered and considered.

The petition under 37 CFR 1.183 requests waiver of the rules, and an order for entry and consideration of patent owner's second amendment after final Office action.

15. On October 11, 2001, the Technology Center Special Program Examiner granted a patent owner request for an additional extension of time. The time for filing an appeal brief was extended to January 18, 2002.

DECISION ON RECONSIDERATION

Upon reconsideration, the relief requested in the July 6, 2001 petition is granted.

In a reexamination proceeding, Manual of Patent Examining Procedure (MPEP) 2271 and 2272 provide flexibility in deciding, based upon equity, whether to make a rejection final in a reexamination proceeding and whether to enter an amendment after final rejection when a suitable reason is given.

In the October 31, 2000 first Office action, the claims of the '152 patent were rejected based upon the Ellerbeck, Cross, and German patents which had served as the basis for the order of reexamination. In the February 13, 2001 final Office action, the claims were rejected based upon newly cited Japanese patent 4-62387, and the Ellerbeck, Cross, and German patents were not applied. Thus, in the present instance, the examiner did not merely cite a new reference to address a limitation (or limitations) newly added to the claims, but rather replaced the prior rejection of the claims with an entirely new ground of rejection. This distinguishes the facts from the usual situation where an action is made final based on an amendment necessitating a new ground of rejection, where the new reference is combined with the existing rejection (i.e., existing art), to address a limitation newly added to the claims. Given that the nature of the reexamination proceeding does not allow for continuing examination options (e.g., via a continuation or a Request for Continued Examination (RCE) which would be available in an application), equity dictates that the finality of the February 13, 2001 Office action be withdrawn, the amendment after final rejection filed May 21, 2001 be entered and another action be given, which action can be made final. Pursuant to MPEP 2260, the patent owner should take into account that the next Office action may be made final, as 35 U.S.C. 305 requires the Office to conduct reexamination proceedings with "special dispatch."

Compare Ethicon v. Quigg, 849 F.2d 1422,7 USPQ2d 1152 (Fed. Cir. 1988).

Accordingly, the finality of the February 13, 2001 Office action is hereby withdrawn, and it is directed that the proposed amendment filed May 21, 2001 be entered. The examiner will consider the amendment and issue an Office action addressing the amendment, which action may, or may not, be made final.

Patent owner need not take any action at present, and may await the issuance of the examiner's Office action.

DECISION ON § 1.183 PETITION

The petition under 37 CFR 1.183 is dismissed as moot. The petition requests the Commissioner "to suspend the rules and order entrance and full consideration of the last amendment [patent owner's May 21, 2001 amendment] filed by Patentee." There is no need for suspension of the rules, since, upon reconsideration, the requested relief has been granted, i.e., the entrance and full consideration of patent owner's May 21, 2001 amendment.

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PATENT OWNER'S APPEAL

As pointed out above, on June 18, 2001, the patent owner filed a Notice of Appeal. The appeal is moot in view of the withdrawal of the finality of the February 13, 2001 Office action. Accordingly, the appeal is dismissed without prejudice to patent owner.

The appeal fee that was paid may be applied to any future appeal taken in this proceeding.

CONCLUSION

1. The request for reconsideration is **granted.** The finality of the February 13, 2001 Office action is withdrawn, and the proposed amendment filed May 21, 2001 will be entered and considered.

2. The petition under 37 CFR 1.183 is **dismissed** as moot.

3. The appeal (resulting from the June 18, 2001 Notice of Appeal) is **dismissed without prejudice** to patent owner.

Richard Bertsch
Group Director
Technology Center 3700
Phone: 703-308-0975
Fax: 703-308-7764

January 2, 2001
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FISH AND NEAVE
1251 Avenue of the Americas
New York, New York 10020-1104

Paper No. 15

U.S. Patent Number: 4,706,275
Reexamination Control No.: 90/005,580
Filed: December 2, 1999
For: TELEPHONE SYSTEM

DECISION ON REQUEST FOR EXTENSION OF TIME

This is a decision on a request for an extension of time under 37 C.F.R. § 1.550(c) filed on January 10, 2001. The request is for an extension of time of one month. This petition requests an extension until February 20, 2001 to file a response to the outstanding Office action.

Pursuant to 37 C.F.R. § 1.550(c):

> *The time for taking any action by a patent owner in a reexamination proceeding will be extended only for a sufficient cause, and for a reasonable time specified. Any request for such an extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of the request effect any extension. See Section 1.304(a) for extensions of time for filing a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.*

The request sets forth that the Patent Owner is unable to interview examiner Barnie before the current due date for reply to the outstanding Office action because examiner Barnie has been out of the Office on leave and will not return until January 24, 2001, after the end of the period given for response. Therefore, the request has set forth sufficient cause and indicates a situation beyond the ordinary in which the owner would have difficulty in responding within the period set forth in the last Office action.

Accordingly, the request is **GRANTED**.

The Owner is reminded of the requirement under 35 U.S. § 305 to conduct reexamination proceedings with special dispatch.

James Dwyer, Director
Technology Center 2600
Communications

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,380	12/02/99	4700278	[illegible]

WM41/0308

JEFFREY H. INGERMAN
FISH & NEAVE
1251 AVENUE OF THE AMERICAS
NEW YORK NY 10020-1104

EXAMINER
[illegible]

ART UNIT	PAPER NUMBER
[illegible]	19

DATE MAILED: 03/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D C. 20231
www uspto gov

Paper No. 19

Jeffrey H. Ingerman FISH & NEAVE 1251 Avenue of the Americas New York, NY 10020-1104	FOR OWNER
Michael A. Stallman LIMBACH & LIMBACH, LLP 2001 Ferry Building San Francisco, CA 94111-4262	FOR THIRD PARTY REQUESTER
Wesley L. Strickland McDERMOTT, WILL & EMERY 600 13th Street NW Washington, DC 20005	FOR THIRD PARTY REQUESTER
In re Kamil Reexamination Proceeding Control No. 90/005,580 Filed: December 2, 1999 For: U.S. Patent No. 4,706,275	DECISION SUA SPONTE, MERGING REEXAMINATION PROCEEDINGS
In re Kamil Reexamination Proceeding Control No. 90/005,725 Filed: May 15, 2000 For: U.S. Patent No. 4,706,275	

Electronic Acknowledgement Receipt

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 4,706,275 issued on November 10, 1987.

2. A first request for reexamination, Control No. 90/005,580 ('580) was filed by the Owner on December 2, 1999.

3. Reexamination was ordered in the '580 reexamination proceeding on January 31, 2000.

4. A second request for reexamination, Control No. 90/005,725 ('725) was filed by the Third Party Requester on May 15, 2000.

5. Reexamination was ordered in the '725 reexamination proceeding on July 31, 2000.

6. A first Office action was mailed on December 20, 2000 in both reexamination proceedings, rejecting claims 1-23 (all pending claims).

7. An Interview in both reexamination proceedings was held on February 8, 2001.

8. A response to the first Office action in both reexamination proceedings was filed on February 20, 2001.

DISCUSSION

37 CFR § 1.565(c) states:

"If reexamination is ordered while a prior reexamination is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570."

DECISION

I. Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '580 and '725 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in all Proceedings

The Patent Owner is required to maintain the same claims and specification in both files.

III. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry into each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

Since the files currently maintain the same claims and specification, no "housekeeping" amendment is required. Therefore, the reexamination files are being forwarded to the examiner for action in response to the request for reconsideration filed February 20, 2001 commensurate with this decision.

James L. Dwyer, Director
Technology Center 2600
Communications

Electronic Acknowledgement Receipt

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

CONTROL NUMBER	FILING DATE	PATENT UNDER REEXAMINATION	ATTORNEY DOCKET NO.
90/005,951	03/14/01	4706275	45456-025

WM41/0908

JEFFREY INGERMAN
FISH AND NEAVE
1251 AVENUE OF THE AMERICAS
NEW YORK NY 10020-1104

EXAMINER	
BARNIE, R	
ART UNIT	PAPER NUMBER
2643	21

DATE MAILED: 09/08/01

REEXAMINATION COMMUNICATION

~~A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE _____ MONTH(S) FROM THE DATE OF THIS LETTER. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).~~

cc: Requester

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D C 20231
www uspto gov

Paper No. 21

Jeffrey H. Ingerman FISH & NEAVE 1251 Avenue of the Americas New York, NY 10020-1104	FOR OWNER
Michael A. Stallman LIMBACH & LIMBACH, LLP 2001 Ferry Building San Francisco, CA 94111-4262	FOR THIRD PARTY REQUESTER
Wesley L. Strickland McDERMOTT, WILL & EMERY 600 13th Street NW Washington, DC 20005	FOR THIRD PARTY REQUESTER
In re Kamil Reexamination Proceeding Control No. 90/005,580 Filed: December 2, 1999 For: U.S. Patent No. 4,706,275	DECISION SUA SPONTE, MERGING REEXAMINATION PROCEEDINGS
In re Kamil Reexamination Proceeding Control No. 90/005,725 Filed: May 15, 2000 For: U.S. Patent No. 4,706,275	
In re Kamil Reexamination Proceeding Control No. 90/005951 Filed: March 14, 2001 For: U.S. Patent No. 4,706,275	

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 4,706,275 issued on November 10, 1987.

2. A first request for reexamination, Control No. 90/005,580 ('580) was filed by a first Third Party Requester on December 2, 1999.

3. Reexamination was ordered in the '580 reexamination proceeding on January 31, 2000.

4. A second request for reexamination, Control No. 90/005,725 ('725) was filed by a second Third Party Requester on May 15, 2000.

5. Reexamination was ordered in the '725 reexamination proceeding on July 31, 2000.

6. A first Office action was mailed on December 20, 2000 in both reexamination proceedings, rejecting claims 1-23 (all pending claims).

7. An Interview in both reexamination proceedings was held on February 8, 2001.

8. A response to the first Office action in both reexamination proceedings was filed on February 20, 2001.

9. Control No. 90/005,580 ('580) and 90/005,725 ('725) were merged on March 8, 2001.

10. A third request for reexamination, Control No. 09/005,951 ('951) was filed on March 14, 2001 by the second Third Party Requester.

11. Reexamination was ordered in the '951 reexamination proceeding on May 10, 2001.

12. A waiver of Patent Owner's statement was filed on May 24, 2001 in the '951 reexamination proceeding.

DISCUSSION

37 CFR § 1.565(c) states:

"If reexamination is ordered while a prior reexamination is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570."

DECISION

I. Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '580, '725 and '951 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines

and requirements.

II. Requirement for Same Amendments in all Proceedings

The Patent Owner is required to maintain the same claims and specification in all three files.

III. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all three files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature, for entry into each file. All papers filed by the patent owner must be served on both requesters and both requesters will be sent copies of all papers mailed by the Office.

Since the files currently maintain the same claims and specification, no "housekeeping" amendment is required. Therefore, the reexamination files are being forwarded to the examiner for action in response to the request for reconsideration filed February 20, 2001 and for consideration of the Prior Art filed April 6, 2001 commensurate with this decision.

James L. Dwyer, Director
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 28

Jeffrey H. Ingerman (Patent Owner)
FISH & NEAVE
1251 Avenue of the Americas
New York, NY 10020-1105

Enclosure: Copy of petition filed October 24, 2001.

Michael A. Stallman (Requester)
LIMBACH & LIMBACH, LLP
2001 Ferry Building
San Francisco, CA 94111-4262

Enclosure: Copy of petition filed October 24, 2001.

Wesley L. Strickland (Requester)
McDERMOTT, WILL & EMERY
600 13th Street NW
Washington, DC 20005

Enclosure: Petition filed October 24, 2001.

MAILED

MAR 21 2002

REEXAM UNIT

DO NOT DETACH THIS COPY

In re Kamil
Reexamination Proceeding
Control No. 90/005,580
Filed: December 2, 1999
For: U.S. Patent No. 4,706,275

In re Kamil
Reexamination Proceeding
Control No. 90/005,725
Filed: May 15, 2000
For: U.S. Patent No. 4,706,275

In re Kamil
Reexamination Proceeding
Control No. 90/005,951
Filed: March 14, 2001
For: U.S. Patent No. 4,706,275

DECISION DISMISSING AND RETURNING PETITION UNDER 37 CFR 1.182/1.183

This is a decision on the October 24, 2001, petition filed by requester Sprint under 37 CFR 1.182/1.183, to suspend the rules, to exercise supervisory authority over the present reexamination proceeding, and to decide a question not provided for in the rules.

The petition is before the Office of Patent Legal Administration for decision.

Petitioner has paid the $130.00 fee associated with this type of petition, in accordance with 37 CFR 1.17(h).

The petition is dismissed and is being returned to the third party requester for the reasons set forth below.

DECISION ON PETITION

37 CFR 1.550(g) provides:

> (g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (1) in accordance with § 1.510 or § 1.535; or
>
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.

The present petition is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, and it is not a reply pursuant to 37 CFR 1.535. Nor does the petition qualify as a prior art statement under 37 CFR 1.501. Neither the rules nor any provision of the statute provide authority for a third party requester of a reexamination proceeding requested under 35 U.S.C. 302 to file a paper directed to the issues of the reexamination proceeding. *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). The statute and its intent are clear that a reexamination proceeding requested under 35 U.S.C. 302 must be *ex parte*. In the present instance, at pages 3-12, petitioner raises concerns with regard to patent owner's "requested claim for foreign priority." Petitioner asserts that the priority is not justified because applicant "never showed any intent to claim priority" and did not make such a claim until many years after the patent had issued. Petitioner further asserts that the foreign applications upon which the claim is based are not enabling and describe a "system that cannot work." These assertions by petitioner are clearly directed to the merits of the reexamination proceeding, and addressing same would be contrary to the content of the statute. Comments by third parties at this stage are precluded since a reexamination proceeding requested under 35 U.S.C. 302 is an

ex parte proceeding (after the expiration of the statement/reply period under §§ 1.530 and 1.535). A waiver/suspension of the rules in the present case to permit a third party submission would not be justified in view of the intent of the legislation and rules to make reexamination under 35 U.S.C. 302 - 307 an *ex parte* proceeding. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO).

Accordingly, the third party requester petition of October 24, 2001, is an improper submission under 37 CFR 1.550(g), and it is being returned to the third party requester.

Lack of Service:

It is to be noted that the requisite proof of service (of the petition) by third party requester Sprint on the patent owner and on the other third party requester (in this merged proceeding) was not included with the present petition. Pursuant to 37 CFR 1.550(f):

> After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. **The document must reflect service or the document may be refused consideration by the Office.** [Emphasis added]

Since there is no indication that either the patent owner or the other third party requester (in the present merged proceeding) was provided with a copy of the present petition, a copy of the petition is being forwarded to both the patent owner and the other third party requester. Any future communications filed by third party requester Sprint in the present merged proceeding must include proof of service on the patent owner and on the other third party requester in the merged proceeding.

CONCLUSION

1. The third party requester petition filed December 17, 1999 is **dismissed** and is being returned to requester Sprint (the submitter of the petition).

2. A copy of the petition is being forwarded to both the patent owner and the third party requester that did not submit the petition (Limbach & Limbach, LLP).

3. A copy of this decision is being made of record in the three reexamination files of the instant merged proceeding.

4. The reexamination files of the merged proceeding are being forwarded to the Group Director of Technology Center 2600.

5. Telephone inquiries related to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (703) 308-6710.

Kenneth M. Schor
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

C:\KIVA\KIMPROPA3\5580-183.WPD
3-19-02

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,582	12/06/99	5371017	0125-0015

HM12/0102

ALISA A HARBIN
CHIRON CORPORATION
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P O BOX 8097
EMERYVILLE CA 94608

EXAMINER
MOORE, W

ART UNIT	PAPER NUMBER
1652	06

DATE MAILED: 01/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

90005582.010201

PTO-90C (Rev. 2/95) U.S. G P.O. 1999 460-693 1- File Copy

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAILED IN TECH CENTER
1600 01/02/01

ALISA A HARBIN
CHIRON CORPORATION
INTELLECTUAL PROPERTY R440
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EMERYVILLE , CA 94608

FOR PATENT OWNER

MARIA L. MAEBIUS
SHANKS & HERBERT
1033 NORTH FAIRFAX STREET
SUITE 306
ALEXANDRIA, VA 22314

FOR REQUESTER

In re Houghton et al
Reexamination Proceeding
Control No.: 90/005,512
Filed: October 8, 1999
For: U.S. Patent No. 5,371,017

In re Houghton et al
Reexamination Proceeding
Control No.: 90/005,512
Filed: December 6, 1999
For: U.S. PATENT No. 5,371,017

: DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

The above noted reexamination files are before the director of Technology Center 1600 for consideration of merger of the proceedings under 37 CFR 1.656(c).

BACKGROUND

1. Patent No. 5,573,751 issued December 6, 1994.

2. A first request for reexamination, Control No. 90/005,512, was filed by patent owner on October 8, 1999.

3. Reexamination was ordered in the '512 reexamination proceeding on December 22, 1999

4. A second request for reexamination, Control No. 90/005,582, was filed by third party requester on December 6, 1999.

5. Reexamination was ordered in the '582 reexamination proceeding on February 22, 2000.

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above review of facts, reexamination has been ordered in both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '512 and '582 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

Patent Owner is required to maintain the same claims and specification in both files.

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the Patent Owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

The Office action in '512, mailed November 9, 2000, is hereby vacated in view of the merger. A new Office action will issue in due course following the merger.

CONCLUSION

Reexamination Control Nos. 90/005,512 and 90/005,582 are merged. Upon receipt of the required paper placing the same amendments in both files, an Office action will issue in due course.

Jasemine C. Chambers
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C 20231
www uspto gov

Paper No. 8

Richard T. Redano, Esq.
DUANE MORRIS & HECKSCHER LLP
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FOR OWNER

MAIL

MAR 29 2001

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Loren G. Helmreich
BROWNING BUSHMAN
5718 Westheimer, Ste. 1800
Houston, TX 77057

FOR THIRD PARTY REQUESTER

In re McLatchy, et al.
Reexamination Proceeding
Control No. 90/005,583
Filed: December 7, 1999
For: U.S. Patent No. 5,673,038

DECISION SUA SPONTE, MERGING REEXAMINATION PROCEEDINGS

In re McLatchy, et al.
Reexamination Proceeding
Control No. 90/005,808
Filed: September 1, 2000
For: U.S. Patent No. 5,673,038

Do Not Enter

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 5,673;038 issued on September 30, 1997.

2. A first request for reexamination, Control No. 90/005,583 ('583) was filed by the Owner on December 7, 1999.

3. Reexamination was ordered in the '583 reexamination proceeding on February 29, 2000.

4. A second request for reexamination, Control No. 90/005,808 ('808) was filed by the Third Party Requester on September 1, 2000.

5. Reexamination was ordered in the '808 reexamination proceeding on November 27, 2000.

DISCUSSION

37 CFR § 1.565(c) states:

"If reexamination is ordered while a prior reexamination is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570."

DECISION

I. Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '583 and '808 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in all Proceedings

The Patent Owner is required to maintain the same claims and specification in both files.

III. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry into each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

Since the files currently maintain the same claims and specification, no "housekeeping" amendment is required. Therefore, the reexamination files are being forwarded to the examiner for action commensurate with this decision.

Jin F. Ng, Director
Technology Center 2600
Communications

90005583.120799

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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#27 (mav)

Paper No. 27

Robert M. Siminski
HARNESS, DICKEY & PIERCE, PLC
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Bloomfield Hills, MI 48303

(For Patent Owner)

Arnold S. Weintraub
PLUNKETT & COONEY, PC
38505 North Woodward
Ste. 3000
Bloomfield Hills, MI 48304

(For Requester)

MAILED

JAN 18 2002

REEXAM UNIT

DO NOT ENTER

In re Reexamination Proceeding
Control No. 90/005,587
Filed: December 15, 1999
For: U.S. Patent No. 5,623,812
Patentee: Todt

DECISION DISMISSING PETITION

This is a decision on the patent owner PETITION UNDER 37 C.F.R. § 1.137(b) of November 28, 2001, for the entry of late papers on the grounds of unintentional delay, requesting the entry of the late filed amendment in response to the final Office action of June 19, 2001. A petition fee under 37 C.F.R. § 1.17(m) of $1280.00, as well as a Notice of Appeal fee of $320.00, for the reexamination proceeding has been charged to patent owner's deposit account, as indicated on page 1 of the present petition. The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 C.F.R. § 1.137(b) is **dismissed** for the reasons indicated below.
Any request for reconsideration of this decision under 37 C.F.R. § 1.137(b) must be submitted within **ONE (1) MONTH** from the mail date of this decision. **Extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(b)."

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The instant petition is accompanied by the required reply and the petition fee. The instant petition lacks item (3) above. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3), and is **not** sufficient to meet the requirement of 37 C.F.R. § 1.137(b)(3), as it merely indicates that "the entire delay in filing the required reply and/or Notice of Appeal was unintentional." Accordingly, any renewed petition based upon unintentional delay should include the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was

unintentional.

In view of the above, the petition for the entry of late papers is **not** sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **dismissed**.

CONCLUSION

1. The petition is **dismissed**.

2. Any renewed petition based upon unintentional delay must be filed within **ONE (1) MONTH** of the mailing date of this decision.

3. Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Patent Legal Administration

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

4. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

January 17, 2002

ATTACHMENT

#29mail

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 29

Robert M. Siminski
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P.O. BOX 828
Bloomfield Hills, MI 48303

(For Patent Owner)

Arnold S. Weintraub
PLUNKETT & COONEY, PC
38505 North Woodward
Ste. 3000
Bloomfield Hills, MI 48304

(For Requester)

MAILED

FEB 0 1 2002

REEXAM UNIT

In re Reexamination Proceeding
Control No. 90/005,587
Filed: December 15, 1999
For: U.S. Patent No. 5,623,812
Patentee: Todt

DECISION GRANTING PETITION

This is a decision on the patent owner renewed PETITION UNDER 37 C.F.R. § 1.137(b) of January 31, 2002, for the entry of late papers on the grounds of unintentional delay, requesting the entry of the late filed amendment in response to the final Office action of June 19, 2001. A petition fee under 37 C.F.R. § 1.17(m) of $1260.00, as well as a Notice of Appeal fee of $320.00, for the reexamination proceeding have been charged to patent owner's deposit account, as authorized on page 1 of the previous petition of November 28, 2001. The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 C.F.R. § 1.137(b) is **granted** for the reasons indicated below.

DECISION

The previous petition of November 28, 2001, was accompanied by the required reply and the petition fee in compliance with 37 C.F.R. § 1.137(b)(1) and (2). It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is granted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 3700 for consideration of the amendment.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Stephen F. Gerrity, in Technology Center 3700.

4. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

February 1, 2002

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,569	12/14/99	5940464	JCV-RE

PM51/1107

RICHARD WIENER ESQ
POLLOCK VANDE SANDE AND PRIDDY
1990 M STREET N W
WASHINGTON DC 20036-3425

EXAMINER
BEHREND, H

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 11/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)
U S G P O 2000 ; 465-188/25266
1- File Copy

UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

PATENT OWNER:

RICHARD WIENER, ESQ
POLLOCK, VANDE, SANDE AND PRIDDY
1990 M. STREET N.W.
WASHINGTON, DC 20036-3425

REQUESTER:

WESTINGHOUSE ELECTRIC CORP, LLC
P.O. BOX 355
PITTSBURG, PA 15230-0355

Reexamination Proceeding
Control No. 90/005,589
Filed: December 14, 1999
For: U.S. Patent No. 5,940,464

PETITION TO REVIEW DENIAL OF REEXAMINATION REQUEST UNDER 37 CFR 1.515(C)

This is a decision on the petition filed by the requestor under 37 CFR 1.515(c) and 1.181(b) on March 31, 2000. The petition requests the withdrawal of the Examiner's Order denying request for reexamination.

The petition is GRANTED.

The request for reexamination filed December 14, 1999 was denied on March 8, 2000.

MPEP 2242 states that a substantial new question of patentability is raised where there is a substantial likelihood that a reasonable examiner would consider the prior art patent important in deciding whether or not a claim is patentable.

The requestor cites Sabol et al. (U.S. 4,649,023) as raising a new question of patentability over claims 1-4 and Sabol et al. in view of Nikulina et al. as raising a question of patentablity over claims 5-8. Neither of these references was considered in the examination of U.S. patent 5,940,464. Additionally, these references are neither duplicative nor share a common issue which was discussed in the examination of the U.S. patent and which reexamination has been requested.

The patent to Sabol et al. is considered material to examination of the claims in that the range of tin is initially disclosed, i.e., "up to 1.5%" as including the claimed range of "0.2% to 0.6%". Although other parts of the reference or other references may or may not substantiate this lower range, the issue has been raised which requires further consideration by the examiner.

The Patent Owner is given TWO months from the mailing date of this decision in which the Patent Owner may file a statement on the new question of patentability including any proposed amendments the patent owner wishes to make. Any statement filed by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248.

Summary: Petition is GRANTED.

Steven N. Meyers
Special Program Examiner
Technology Center 3600
(703) 308-3868

CONCUR:

John F. Terapane, Jr.
Director,
Technology Center 3600
(703) 306-4180

snm/mc: 10/30/00

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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Office of the Director
Group 3600

Burton A. Amernick
Connolly, Bove, Lodge & Hutz
P.O. Box 19088
Washington, DC 20036

In re Reexamination Proceeding of :
Jean-Paul Mardon, et al :
Reexamination Control No. 90/005,589 :
Filed: December 14, 1999 :
For: TUBE FOR A NUCLEAR FUEL ASSEMBLY, AND METHOD FOR MAKING SAME

DECISION ON PETITION TO ACCEPT LATE FILED PAPERS

This is in response to patent owner's communication filed in the United States Patent and Trademark Office (USPTO) on October 3, 2001. This communication is being treated as a petition for the acceptance of late filed papers.

The petition is **GRANTED**.

A review of the file record indicates that in the above-noted Reexamination Proceeding the response to the Office action dated May 24, 2001 was never received by the Office.

The patent owner has submitted a copy of a response, which includes a copy of a post card identifying the response and related documents and which included a USPTO Mail Room receipt date of July 20, 2001. This is acceptable evidence of a timely response.

Since a timely response to the Office action was filed, the Reexamination Proceeding is restored to pending status. The Reexamination Proceeding is being forwarded to the Supervisory Legal Instruments Examiner for entry of the Response filed with the petition, and then to the Examiner for prompt action on the merits of the claims.

Telephone inquiries relative to this decision should be directed to Special Programs Examiner Steven Meyers at (703) 308-3868.

Gerald Goldberg

Gerald Goldberg, Director
Patent Technology Center 3600
(703) 308-1134
Facsimile No.: (703) 308-2177

SM/dc: 10/25/01
SM

UNITED STATES PATENT & TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

#21

Paper No. 21

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MAY 17 2002

Office of the Director
Group 3600

Joseph P. Aiena (For Patent Owner)
Kenyon & Kenyon
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New York, NY 10004

James C. Valentine (For Requester)
Westinghouse Electric Corporation LLC
P.O. Box 355
Pittsburgh, PA 15230-0355

90005589 - 95565

In re Reexamination Proceeding No. 90/005,589 : **REQUEST FOR**
Filed: December 14, 1999 : **EXTENSION OF TIME**
For: U.S. Patent No. 5,940,464 : *37 CFR 1.550(c)*

This is a decision on the request for extension of time filed by the Patent Owner under 37 CFR 1.550(c) on May 9, 2002.

A Final Office action was mailed on March 28, 2002 wherein a shortened statutory period for response of two months was set. Patent Owner requests an extension of time of one month to submit a response to the Final rejection. The reasons for the request are: (1) that the Counsel of record replaced a prior law firm during prosecution of this reexamination proceeding, (2) that the Patent Owner requires more time to determine whether to file an affidavit and to consult with various individuals in preparing such an affidavit, and (3) an interview has been scheduled with the examiner of record for the week of May 13, 2002.

An extension of time for the Patent Owner to submit an Appeal Brief is granted for a period of one month. The period for response will expire on June 28, 2002.

Further extensions of time to respond to the Office action should not be expected, and will be granted only in extraordinary circumstances.

SUMMARY: Request **granted**.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

Concur:
Michael Carone
Acting Director
Technology Center 3600
(703) 306-4180

snm/snm: 5/16/02

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 34

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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KENYON & KENYON
One Broadway
New York, NY 10004

(For Patent Owner)

Westinghouse Electric Company, LLC
P.O. BOX 355
Pittsburgh, PA 15230-0355

(For Requester)

MAILED

APR 05 2005

REEXAM UNIT

In re Mardon, et al.
Reexamination Proceeding
Control No. 90/005,589 ✓
Filed: December 14, 1999
For: U.S. Patent No. 5,940,464

In re reissue application of
Mardon, et al.
Application No. 10/624,757
Filed: July 21, 2003
For: U.S. Patent No. 5,940,464

DECISION ON PETITION TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS

This is a decision on the July 21, 2003, patent owner petition filed under 37 C.F.R. § 1.182, requesting that either (1) the above-mentioned reexamination and reissue proceedings be merged; or (2) the reexamination proceeding be stayed/suspended in favor of the reissue application. The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $130.00 pursuant to 37 C.F.R. § 1.17(h) for the petition under 37 C.F.R. § 1.182 has been charged to patent owner's deposit account no. 11-0600, as authorized on page 2 of the present petition.

The petition under 37 C.F.R. § 1.182 requesting that the above-mentioned reexamination and reissue proceedings be merged is **dismissed** for the reasons indicated below.

The alternate relief requested that the reexamination proceeding be stayed/suspended in favor of the reissue application is **dismissed** for the reasons indicated below.

The reissue application is **stayed/suspended** pursuant to 37 C.F.R. § 1.103(e) in favor or the reexamination proceeding, for the reasons indicated below.

REVIEW OF FACTS

1. U.S. Patent No. 5,940,464 issued to Mardon, et al., on August 17, 1999.

2. Reexamination of the '464 patent was requested by a third party requester on December 14, 1999, and the resulting reexamination proceeding was assigned Control No. 90/005,589.

3. Reexamination was denied in a decision mailed March 8, 2000, in the '5589 proceeding.

4. A petition requesting reconsideration of the denial was filed on March 31, 2000, in the '5589 proceeding.

5. A decision granting the petition and ordering reexamination was mailed in the '5589 proceeding on November 7, 2000.

6. A non-final rejection was mailed on May 24, 2001, and a response was filed on October 2, 2001, in the '5589 proceeding.

7. A final rejection was mailed on March 28, 2002, and a response to the final rejection was filed on June 28, 2002, including a proposed amendment to claim 1, in the '5589 proceeding.

8. On July 29, 2002, a Notice of Appeal was filed in the '5589 proceeding.

9. An advisory action was mailed on August 29, 2002, in the '5589 proceeding, advising the patent owner that the proposed amendment in response to the final rejection was not entered.

10. On September 30, 2002, an appeal brief was filed, and on December 18, 2002, a Notice of Defective Brief was mailed in the '5589 proceeding.

11. On January 27, 2003, an appeal brief was filed, and on May 20, 2003, an examiner's answer was mailed in the '5589 proceeding.

12. Patent owner filed a reissue application based on the '464 patent, on July 21, 2003, which was assigned Application No. 10/624,757. A preliminary amendment was included which amended claim 1.

13. Also on July 21, 2003, the present petition to merge proceedings or alternatively to stay the reexamination proceeding, was filed in the '757 reissue application.

14. On December 9, 2003, a Notice of Incomplete Application was mailed, and on February 4, 2004, a response to the notice was filed, in the '757 reissue application.

15. On April 5, 2004, the reissue application was determined to be complete.

16. Notice of the filing of the '757 reissue application was published in the *Official Gazette* on May 11, 2004.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '5589 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the '5589 reexamination file shows that original claims 1-8 are pending; claims 5-8 are indicated to be patentable; and claims 1-4 stand rejected and are on appeal to the Board of Patent Appeals and Interferences (BPAI). Since the examiner's answer was mailed on May 20, 2003, and no further papers have been received in the '5589 proceeding, the issues on appeal in this reexamination proceeding are ready for consideration by the BPAI.

A review of the reissue (Application No. 10/624,757) prosecution history shows that the reissue application was published in the *Official Gazette* on May 11, 2004. In the reissue application, patent owner has amended claim 1. Therefore, the specification and claims are **not** identical in both proceedings. No Office

action has yet been mailed in the '757 reissue application.

In the reissue application filed on July 21, 2003, the patent owner appears to be presenting the same amendment to the claims that was denied entry after final rejection in the reexamination proceeding. In the reexamination proceeding, an advisory action was mailed on August 29, 2002, advising the patent owner that the proposed amendment in response to the final rejection was not entered. The examiner's reasons for denying entry of this proposed amendment indicated that the amendment to claim 1 raises the issue of new matter because the proposed narrowing language does not appear to be supported in the original patent application disclosure. It is noted that the reissue application was filed almost one year from the date of mailing of the advisory action notifying the patent owner that the proposed amendment was not entered in the reexamination proceeding.

DECISION

35 USC 305 states (in part):

> "All reexamination proceedings under this section, including any on appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office."

The decision on whether to merge the proceedings or stay/suspend a proceeding will be made on a case-by-case basis based upon the status of the various proceedings. Due consideration will be given to the finality of the reexamination requested. In the present reexamination proceeding, claims 1-4 stand rejected and are on appeal to the BPAI, which fact is important in considering whether the proceedings should be merged, or one of them stayed. (See *In re Stoddard*, 213 USPQ 386 (Comm'r Pat. 1982); and *In re Scragg*, 215 USPQ 715 (Comm'r Pat. 1982).)

The statute directs that all reexamination proceedings, including any on appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office (emphasis added). In the present instance, the patent owner delayed in the filing of the reissue application almost one year from the date of the mailing of the advisory action notifying the patent owner that the proposed amendment was not entered in the

reexamination proceeding. The patent owner could have filed the reissue application prior to the issuance of the examiner's answer in the reexamination proceeding, but chose not to do so. As a result, the appeal in the present reexamination proceeding is ready for consideration by the BPAI. While in other situations it may be beneficial to consolidate reexamination and reissue proceedings within the Office, in this instance, such consolidation would necessitate the reopening of prosecution in the reexamination proceeding at a point where the appeal is ready for consideration by the BPAI. Any such reopening of prosecution in the reexamination proceeding would be contrary to the **special dispatch** requirement set by the statute. Therefore, rather than merging the reeexamination and reissue proceedings in this instance, it is instead appropriate that the reissue application be **stayed/suspended**. The suspension of the reissue application will prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner into the reissue application. The suspension of the reissue application will also permit the reexamination proceeding to be promptly forwarded to the BPAI for consideration of the issues on appeal, as this will provide the most efficient and prompt handling of the reexamination proceeding.

Accordingly, the petition under 37 C.F.R. § 1.182 requesting that the above-mentioned reexamination and reissue proceedings be merged is **dismissed**.

The alternate relief requested in the present petition that the reexamination proceeding be stayed/suspended in favor of the reissue application is **dismissed**. To suspend the reexamination proceeding would run counter to the statutory requirement of **special dispatch**. Since the reexamination proceeding is ready for consideration by the BPAI, prosecution of the reexamination proceeding will continue so that a decision by the BPAI may be promptly rendered.

The reissue application is **stayed/suspended,** at least until such time as a decision on the appeal in the reexamination proceeding is rendered by the BPAI. Once a decision by the BPAI on the appeal has been rendered, the reexamination and reissue files should be returned to the Office of Patent Legal Administration for reconsideration of whether the reissue application should continue to be stayed/suspended, or the reexamination and reissue proceedings should be merged at that time.

CONCLUSION

1. The petition requesting that the above-mentioned reexamination and reissue proceedings be merged is **dismissed**.

2. The alternate relief requested that the reexamination proceeding be stayed/suspended is **dismissed**.

3. The 10/624,757 reissue application is **stayed/suspended**, at least until such time as a decision on the appeal in the reexamination proceeding is rendered by the BPAI.

4. A copy of the instant decision will be placed in each of the above-mentioned reexamination and reissue files.

5. The 90/005,589 reexamination file is being forwarded to the Board of Patent Appeals and Interferences (BPAI) for prompt consideration of the issues on appeal.

6. Once a decision by the BPAI on the appeal has been rendered, the reexamination and reissue files should be returned to the Office of Patent Legal Administration for reconsideration of whether the reissue application should continue to be stayed/suspended, or the reexamination and reissue proceedings should be merged at that time.

7. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7722.

Lynn M. Kryza
Senior Patent Special Projects Advisor
Office of Patent Legal Administration

April 4, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

9

William C. Cray (For Patent Owner)
Levin & Hawes LLP
384 Forest Avenue, Suite 13
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Paul E. Crawford (For Requester #1)
Connolly Bove Lodge & Hutz LLP
1200 Market Street
Wilmington, DE 19801

Ross F. Hunt, Jr. (For Requester #2)
Larson & Taylor
1199 North Fairfax St., Suite 900
Alexandria, VA 22314

90005592 - 11/06/00

In re reissue application of
Dickens
Serial No. 09/512,592
Filed: February 23, 2000
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/005,592
Filed: December 21, 1999
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/005,628
Filed: February 2, 2000
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/005,727
Filed: May 16, 2000
For: U.S. Patent No. 5,806,063

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REEXAM UNIT

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue application and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,806,063 issued to Bruce M. Dickens on September 8, 1998, and a certificate of correction issued in the '063 patent on November 30, 1998.

2. The Commissioner of the USPTO ordered, on his own initiative, reexamination of the '063 patent on December 21, 1999, and the resulting reexamination proceeding was assigned Control No. 90/005,592.

3. On February 2, 2000, a third party requester (requester #1), Paul E. Crawford, filed a request for reexamination, and the request was assigned Control No. 90/005,628.

4. On February 18, 2000, patent owner filed in the '5592 proceeding, a statement under 37 CFR § 1.530 in response to the Commissioner's order for reexamination.

5. On February 23, 2000, patent owner filed a reissue application which was assigned Application No. 09/512,592.

6. Reexamination was ordered in the '5628 proceeding on March 10, 2000.

7. On May 16, 2000, a third party requester (requester #2), Ross F. Hunt, Jr., filed a request for reexamination, and the request was assigned Control No. 90/005,727.

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8. Reexamination was ordered in the '5727 proceeding on August 10, 2000.

9. On October 10, 2000, patent owner filed in the '5727 proceeding, a statement under 37 CFR § 1.530 in response to the order for reexamination. The patent owner statement contained a Certificate of Service dated October 10, 2000.

10. A requester's reply under 37 CFR § 1.535 has not been received from requester #2 as of the date of this decision, and the time for filing same has not yet expired.

DISCUSSION REGARDING MERGER

Under 37 CFR § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the three reexamination proceedings are currently pending. Since the Order has been mailed pursuant to § 1.520 in the '5592 reexamination proceeding, and pursuant to § 1.525 in the '5628 and '5727 reexamination proceedings, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making

a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution histories of the '5592, '5628 and '5727 reexamination files shows that (a) the '5592 and '5628 reexaminations are awaiting a first Office action by the examiner and (b) the '5727 reexamination is awaiting the filing of a requester's reply under 37 CFR § 1.530 or the expiration of the time to do so (after December 11, 2000). The original specification, drawings and patent claims are presently in each of the '5592 and '5628 and '5727 reexamination files.

A review of the reissue (Application No. 09/512,592) prosecution history shows that the reissue application was published in the *Official Gazette* on May 16, 2000. Two months from the publication of the present reissue have passed, and the application is awaiting a first Office action on the merits by the examiner. Further, in addition to the original unamended patent claims in the reissue application, applicant has submitted new claims 16-76 for consideration. Thus, the claims are <u>not</u> identical in all four proceedings. In order to provide efficient and prompt handling of all four proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the three reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the first, second, and third reexamination proceedings will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are, *sua sponte*, merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in All Proceedings

The patent owner is required to maintain identical amendments in the reissue application and three reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all four files is required as long as the proceedings remain merged. See 37 CFR § 1.565(d). **An appropriate housekeeping amendment is required within TWO (2) MONTHS[1] of this decision placing the same amendments in all four cases**, specifically, Application No. 09/512,592, and Control Numbers 90/005,592 and 90/005,628 and 90/005,727. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must **not** address the issues of any of the proceedings in the housekeeping amendment.

III. Requirement for Information in the Merged Reissue and Reexamination Proceedings

Patent owner is required under 37 CFR § 1.105 to provide the information identified below that the Office has determined is reasonably necessary to the examination of the merged proceeding.

The information is required to determine which art, outside of the existing U.S. patents, is *relevant* to the claimed subject matter of converting date information identifying dates from more than a single century, from formats containing 2 digits for year data to formats containing more than 2 digits for year data in computer memory. The requirement for additional art is necessary because limited amounts of art related to the claimed subject matter are available within the Office, and the Office needs to consider all of the prior art that is relevant to the patent under reexamination and reissue that the patent owner/applicant has become aware of.

[1] Generally, a one (1) month period is set for the filing of the housekeeping amendment in response to a merger decision. In the present instance, however, a two (2) month period is set for response to the requirement for information under 37 CFR 1.105 made in the next part of this decision, in order to provide sufficient time to comply. Thus, a two (2) month period has also been set for the filing of the housekeeping amendment, in order to avoid the potential confusion of two different periods running against the applicant/patent owner.

The information to be provided is as follows:

Patent owner/applicant is requested to provide citations and copies of any prior art, published prior to the filing date of the applicant's patent application, which the patent owner is aware of, which is relevant to the claimed aspects of the invention of-

1) converting date information in computer memory from a format whose data structure representing the year contains 2 digits to a format whose data structure representing the year contains more than 2 digits;

2) selecting ranges of years which will be assigned to different centuries in date conversion;

3) establishing the criteria for selecting such ranges of years;

4) creating the sequence for century, year, month and date data within the data structure for date data; and

5) identifying and converting multiple different date formats into a common date format, including particularly conversion that removes embedded slash marks from eight character date formats,

which prior art has not yet been submitted in a prior art statement, prior art citation or information disclosure statement in any of the reissue or three reexamination proceedings pertaining to this patent to date.

The fee and certification requirements of 37 CFR § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR § 1.105 that are included in the patent owner/applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR § 1.105 are subject to the fee and certification requirements of 37 CFR § 1.97.

Patent owner/applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR § 1.56.

A complete response to the present Decision Merging Reissue and Reexamination Proceedings **must include** a complete response to this requirement under 37 CFR § 1.105. Where the patent owner/applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to this requirement, for that item.

The time period for reply to this requirement coincides with the time period for providing a housekeeping amendment in the Merged Reissue and Reexamination Proceedings, i.e., **within TWO (2) MONTHS of this decision.**

Failure to timely respond to the present 37 CFR 1.105 requirement will result in abandonment of the reissue application and the dissolving of the merged proceeding as to the reissue application; the reexamination proceedings would remain merged, and prosecution of such merged reexamination proceeding would continue until termination of the proceeding, i.e., issuance of a reexamination certificate.

90005592 - 11660

IV. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. However, periods of response should be set at 2 months to comply with the statutory requirement for special dispatch in reexamination(35 U.S.C. 305).

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the three reexamination proceedings. Each action will contain identifying data *for all of the cases*, i.e, the reissue application and the three reexamination proceedings. Each action will be physically entered into all four files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with four copies being filed for entry in the four files, with each of the four bearing a signature. Any such responses must be served on the requesters, who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

If the reissue application ultimately matures into a reissue patent, the reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved *as to the reissue application*. With respect to the three reexamination proceedings that will remain merged as one proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding *as to the reissue application*, and continue examination as to the three reexamination proceedings that will remain merged as one proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 CFR § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continued prosecution of the three reexamination proceedings that will remain merged as one proceeding.

V. Requester's Reply under 37 CFR § 1.535 for the '5727 Proceeding

On October 10, 2000, patent owner filed, in the '5727 proceeding, a statement under 37 CFR § 1.530 in response to the order for reexamination. The patent owner statement contained a Certificate of Service dated October 10, 2000. Pursuant to 37 CFR § 1.530, any requester reply to patent owner's statement must be filed by December 11, 2000. No reply has been received from requester #2 as of the date of this decision, and the time for filing same has not yet expired. Accordingly, the examiner will delay action on the merits until the earlier of (a) the receipt of the reply, or (b) December 12, 2000, plus time for matching a reply that might have been timely filed.

CONCLUSION

1. The above-identified reissue application and first, second and third reexamination proceedings ARE MERGED into a single consolidated proceeding.

2. The reissue application file and the three reexamination files are being forwarded to the Group Director of Technology Center 2100. All further examination should be conducted in accordance with this decision.

3. Pursuant to Part II of this decision, a housekeeping amendment is required **within TWO (2) MONTHS of this decision,** placing the same amendments in all cases of the present merged proceeding.

4. Pursuant to Part III of this decision, Patent owner is required under 37 CFR § 1.105 to provide prior art information to the Office which is reasonably necessary to the examination of the present merged proceeding. A complete response to the enclosed Decision Merging Reissue and Reexamination Proceedings **must include** a complete response to this requirement. The time period for reply to this requirement coincides with the time period for providing a housekeeping amendment in the Merged Reissue and Reexamination Proceedings, i.e., **within TWO (2) MONTHS of this decision.**

5. The examiner should issue an Office action for the present merged proceeding of the reissue application and reexamination proceedings **after** both of the following events have occurred:

I. The earlier of (a) the submission of the housekeeping amendment to place the same amendments in both cases **and** a response to the requirement under 37 CFR § 1.105 to provide information, or (b) the expiration of the TWO (2) month period from the mailing of this decision for filing the amendment.

II. The earlier of (a) the filing of a requester's reply under 37 CFR § 1.535 by the requester of the '5727 proceeding (requester #2), or (b) the expiration of the time to do so after December 11, 2000 plus time for matching the reply.

6. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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November 3, 2000

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MAILED

MAR 12 2004

REEXAM UNIT

In re reissue application of
Dickens
Serial No. 09/512,592
Filed: February 23, 2000
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/005,592
Filed: December 21, 1999
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/005,628
Filed: February 2, 2000
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/005,727
Filed: May 16, 2000
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/006,541
Filed: February 2, 2003
For: U.S. Patent No. 5,806,063

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS

DOCUMENT COPY

The above-identified reissue application and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,806,063 issued to Bruce M. Dickens on September 8, 1998, and a certificate of correction issued in the '063 patent on November 30, 1998.

2. The Commissioner of the USPTO ordered, on his own initiative, reexamination of the '063 patent on December 21, 1999, and the resulting reexamination proceeding was assigned Control No. 90/005,592.

3. On February 2, 2000, a third party requester (requester #1), Paul E. Crawford, filed a request for reexamination, and the request was assigned Control No. 90/005,628.

4. On February 18, 2000, patent owner filed in the '5592 proceeding, a statement under 37 CFR § 1.530 in response to the Commissioner's order for reexamination.

5. On February 23, 2000, patent owner filed a reissue application which was assigned Application No. 09/512,592.

6. Reexamination was ordered in the '5628 proceeding on March 10, 2000.

7. On May 16, 2000, a third party requester (requester #2), Ross F. Hunt, Jr., filed a request for reexamination, and the request was assigned Control No. 90/005,727.

8. Reexamination was ordered in the '5727 proceeding on August 10, 2000.

9. On October 10, 2000, patent owner filed in the '5727 proceeding, a statement under 37 CFR § 1.530 in response to the order for reexamination. The patent owner statement contained a Certificate of Service dated October 10, 2000.

10. A requester's reply under 37 CFR § 1.535 was not received from requester #2, and the time for filing same has expired.

11. Reexamination Control Nos. 90/005,592, 90/005,628, 09/005,727 and Reissue Application No. 09/512,592 were merged in a decision mailed on November 6, 2000.

12. A housekeeping amendment was filed in the 4 merged proceedings on January 5, 2001, placing the same claims in all 4 cases.

13. On February 7, 2003, a third party requester (requester #3), Stanley B. Green, filed a request for reexamination, and the request was assigned Control No. 90/006,541.

14. Prosecution ensued and a final rejection was mailed in the 4 merged proceedings on April 16, 2003.

15. On April 21, 2003, reexamination was ordered in the '6541 proceeding.

16. A Notice of Appeal was filed in the 4 merged proceedings on August 11, 2003.

17. On October 15, 2003, a Request for Continued Examination (RCE) was filed, along with the fee, a substitute specification, reissue declaration, response to the outstanding Office action, and an affidavit/declaration, in the 4 merged proceedings.

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DISCUSSION REGARDING MERGER

Under 37 CFR § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the four reexamination proceedings are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '6541 reexamination proceeding, and a response to the outstanding Office action has been filed in the 4 merged proceedings (Reexamination Control Nos. 90/005,592, 90/005,628, 09/005,727 and Reissue Application No. 09/512,592), a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of

expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the files shows that (a) the '6541 reexamination has been ordered and is awaiting a first Office action by the examiner and (b) the '5592, '5628, and'5727 reexaminations are merged with the reissue Application No. 09/512,592, and a response to the outstanding rejection was received, and the 4 merged proceedings are awaiting the next Office action. More specifically, on October 15, 2003 a Request for Continued Examination (RCE) was filed, along with a substitute specification, reissue declaration, response to the outstanding Office action, and an affidavit/declaration, in the merged proceeding. Also, the original patent abstract has been amended. Further, in addition to the original unamended patent claims 1-9 and 11-15 in the merged proceeding, applicant/patent owner has amended original patent claim 10, and submitted new claims 16-76 for consideration. In the '6541 reexamination proceeding, no amendments have been filed.

Accordingly, the specification, abstract and claims are <u>not</u> identical in all five proceedings. In order to provide efficient and prompt handling of all five proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue application and the four reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the first, second, third and fourth reexamination proceedings will be conducted in accordance with the decision set forth below.

<u>DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS</u>

I. <u>Merger of Proceedings</u>

In accordance with 37 C.F.R. 1.565 § , the above-identified reissue and reexamination proceedings are, *sua sponte*, merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. <u>Requirement for Same Amendments in All Proceedings</u>

The patent owner is required to maintain identical amendments in the reissue application and four reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all five files is required as long as the proceedings remain merged. See 37 CFR § 1.565(d). **An appropriate housekeeping amendment is required within <u>ONE (1)</u>**

MONTH of this decision placing the same amendments in all five cases, specifically, Application No. 09/512,592, and Control Numbers 90/005,592, 90/005,628, 90/005,727 and 90/006,541. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must **not** address the issues of any of the proceedings in the housekeeping amendment.

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. However, periods of response should be set at 2 months to comply with the statutory requirement for special dispatch in reexamination(35 U.S.C. 305).

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the four reexamination proceedings. Each action will contain identifying data *for all of the cases*, i.e, the reissue application and the four reexamination proceedings. Each action will be physically entered into all five files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with five copies being filed for entry in the five files, with each of the five bearing a signature. Any such responses must be served on the requesters, who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

If the reissue application ultimately matures into a reissue patent, the reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved *as to the reissue application*. With respect to the four reexamination proceedings that will remain merged as one proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding *as to the reissue application*, and continue examination as to the four reexamination proceedings

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that will remain merged as one proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 C.F.R. § 1.114, the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

Copies of all Office actions must be provided by the Office to all of the third party requesters. Further, any paper filed by the patent owner/applicant in the merged reissue/reexamination proceeding must be served on all of the third party requesters.

If a final rejection is mailed, the patent owner/applicant may then file "after-final" submissions (*e.g.*, amendment-after-final, affidavit(s), notice of appeal), all as appropriate to patent owner's situation and they will be dealt with as they are dealt with in a reissue application that is not merged.

CONCLUSION

1. The above-identified reissue application and first, second, third and fourth reexamination proceedings ARE MERGED into a single consolidated proceeding.

2. A copy of this decision will be placed into each of the five files.

3. The reissue application file and the four reexamination files are being forwarded to the Group Director of Technology Center 2100. All further examination should be conducted in accordance with this decision.

4. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in all five cases of the present merged proceeding.

5. The examiner should issue an Office action for the present merged proceeding of the reissue application and the four

reexamination proceedings **after** the following events have occurred:

The earlier of

(a) the submission of the housekeeping amendment to place the same amendments in both cases, or

(b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.

6. It should be noted that failure to submit an appropriate "housekeeping amendment" **within <u>one month</u> of this decision** placing the same amendments in all five files will result in the Office's rejection of any claim that does not contain identical text in all five merged proceedings under 35 U.S.C. 112, second paragraph, as being indefinite as to the content of the claims, and therefore failing to particularly point out the invention.

7. All further examination should be conducted in accordance with Parts II and III of this decision.

8. Telephone inquiries related to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,541	02/07/2003	5806063	22058-00003-US	8322

7590 05/13/2004

Bruce Dickens
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EXAMINER	
Jean Homere	
ART UNIT	PAPER NUMBER
2177	39

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90/006541	02/07/03	5,806,063	

STANLEY B. GREEN
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1990 M STREET N.W. SUITE 800
WASHINGTON DC 20036

EXAMINER
JEAN HOMERE

ART UNIT	PAPER
2177	39

DATE MAILED: MAY 13, 2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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WASHINGTON, D.C. 2023
www.uspto g

Paper No. 39

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FOR PATENT OWNER

MAY 13 2004

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Alexandria, Virginia 22314

FOR THIRD PARTY REQUESTOR ['5727]

In re Reexamination of:
U.S. Patent No. 5,806,063
Reexamination Control No.
90/005,592; 90/005,628;
90/005,727; 90/006,541
Reissue Serial No. 09/512,591
For: DATE FORMATTING AND SORTING FOR DATES SPANNING THE TURN OF THE CENTURY

DECISION TO ACCEPT PAPERS AS TIMELY FILED AND NOTICE OF NON-COMPLIANT AMENDMENT

This is a decision accepting papers as timely filed and thereby preventing premature termination of this reexamination proceeding. A copy of the papers which Patent Owner seeks to have accepted was faxes to the undersigned on May 11, 2004. The submission is being treated as a petition to accept papers as timely filed.

The petition is **GRANTED**.

BACKGROUND

A Decision merging all the above-identified proceedings and setting a 1-month period for submitting a housekeeping amendment was mailed March 12, 2004. As of May 10, 2004 no response had been received. The undersigned called Patent Owner to inquire as to the status and was informed that a response had been submitted on April 12, 2003.

DECISION

Patent Owner provides a copy of the submission filed in response to the Office mailing of March 12, 2004, consisting of a Housekeeping Amendment, a Cover letter, Certificate of Service, and a certificate of mailing; a copy of the post card with a PTO stamp indicating receipt at the USPTO of the aforementioned submission on April 12, 2004[1]; a copy of the U.S. Express Mail label, number ER567448678US;; and a statement by Bruce Dickens attesting that the papers submitted are copies of the response to the merger order of March 12, 2004.

The post card receipt is prima facie evidence of the receipt in the USPTO of the documents listed thereon. Accordingly, the papers are being entered in the file.

NONCOMPLIANCE OF THE HOUSEKEEPING AMENDMENT

1. Receipt is acknowledged of a housekeeping amendment filed on April 12, 2004.

2. The amendment is informal/nonresponsive because it fails to comply with 37 C.F.R. §1.121(j) and 37 C.F.R. §1.530(d) and (f). See 37 C.F.R. §1.121(j) wherein it is stated that 37 C.F.R. §1.121 does not apply to reexamination proceedings. Amendments must continue to be filed pursuant to 37 C.F.R. §1.530.

a. The amendment to the abstract does not include markings pursuant to paragraph (f) of 37 CFR §1.530 as required by 37 CFR §1.530(d)(1). Specifically, there is no underlining and/or bracketing with respect to the patent as issued[2].

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[1] The PTO stamp carries the date granted on the date in field of the Express mail label.

[2] All references to "the patent as issued" include the certificate of correction of November 30, 1998.

b. The amendment to the specification does not include markings pursuant to paragraph (f) of 37 CFR §1.530 as required by 37 CFR §1.530(d)(1). Specifically, there is no underlining and/or bracketing with respect to the patent as issued.

c. The amendment to claim 10 does not include markings pursuant to paragraph (f) of 37 CFR §1.530 as required by 37 CFR §1.530(d)(2). Specifically, the claim should be presented with underlining and bracketing with respect to the issued patent.

d. Newly presented claims 16-75 must be underlined in their entirety as per 37 CFR §1.530(f)(2);

e. Further, presenting all claims is unnecessary. Presentation only of claims currently being amended or newly added, and directions to cancel claims currently to be canceled, suffices.

As amendments cannot be entered in part, ***a substitute amendment is required.***

The undersigned recommends that the housekeeping amendment be made so as to incorporate into the '6541 proceeding all amendments to the original patent currently entered in the reissue application. This should be done by presenting the amendment with underlining and bracketing with respect to the issued patent. Any further amendments desired should be submitted as a separate amendment which can then be entered in each of the 5 files.

Patent Owner is given a **ONE MONTH** time period to file an amendment which complies with 37 C.F.R. §1.530. This time period may be extended ONLY pursuant to 37 C.F.R. §1.550(c). The newly filed amendment must be served on the third party Requesters, see 37 C.F.R. §1.550(f).

Any inquiries with respect to this communication may be directed to the undersigned.

Pinchus M. Laufer
Special Programs Examiner
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Computer Architecture, Software, and Information Security
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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
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Paper No. 3 5

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(For Requester)

In re reissue application of
Noiles
Application No. 07/191,225
Filed: May 6, 1988
For: U.S. Patent No. 4,678,472

In re Noiles
Reexamination Proceeding
Control No. 90/004,732
Filed: August 26, 1997
For: U.S. Patent No. 4,678,472

In re Noiles
Reexamination Proceeding
Control No. 90/005,596
Filed: June 22, 1999
For: U.S. Patent No. 4,678,472

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REEXAM UNIT

DECISION *SUA SPONTE* MERGING REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue application and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 4,678,472 issued to Noiles on July 7, 1987.

2. Patent owner filed a reissue application based on the '472 patent, on May 6, 1988, which was assigned Application No. 07/191,225. Portions of the specification, as well as claims 1, 3-5 and 7-8 were amended, and claims 9-14 were added.

3. Notice of the filing of the reissue application was published in the *Official Gazette* on July 5, 1988, and the reissue application (hereinafter '225 application) has undergone extensive prosecution.

4. The '225 application was placed into interference on December 8, 1992 and was assigned Interference No. 102,732. On March 3, 1997, the Board of Patent Appeals and Interferences issued a decision awarding priority of invention to Noiles.

5. A request for reexamination of the '472 patent was filed by a third party requester on August 26, 1997, and the resulting reexamination proceeding was assigned Control No. 90/004,732.

6. On November 14, 1997, reexamination was ordered in the '4732 proceeding.

7. A patent owner's statement under 37 C.F.R. § 1.530 was filed in the '4732 proceeding on December 19, 1997, including an amendment to place the same amendments in the reexam, as those in the reissue application.

8. A requester's reply under 37 C.F.R. § 1.535 was filed on February 23, 1998.

9. On February 26, 1998, a decision merging the '225 application and '4732 proceeding was mailed.

10. A non-final Office action was mailed in the merged proceeding on August 7, 1998.

11. A response, along with a request for an extension of time, was filed in the merged proceeding on February 3, 1999.

12. A request for reexamination of the '472 patent was filed by a third party requester on June 22, 1999, and the resulting reexamination proceeding was assigned Control No. 90/005,596.

13. Reexamination was ordered in the '5596 proceeding on February 7, 2000.

14. An amendment placing the same claims in the '5596 proceeding as are present in the merged proceeding was filed on February 26, 2003.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceedings are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '5596 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue (Application No. 07/191,225) prosecution history shows that the reissue application was published in the *Official Gazette* on July 5, 1988. Substantive prosecution took place in the reissue application. In the reissue application, patent owner has amended portions of the specification, as well as claims 1, 3-5 and 7-8, and has added claims 9-14.

In the '4732 proceeding, which is merged with the '225 application, these same amendments have been presented.

A review of the prosecution history of the '5596 reexamination file shows that the same amendments presented in the merged proceeding have been filed in a preliminary amendment in this reexamination file.

Therefore, the claims are identical in all three proceedings.

In order to provide efficient and prompt handling of all three proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the two reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the two reexamination proceedings will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in All Three Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all three files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d).

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a **single action** which jointly applies to the reissue application and the reexamination proceedings. Each action will contain identifying data **for all three of the cases,** *i.e*, the reissue application and the two reexamination proceedings. Each action will be physically entered into all three files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with **three copies being filed** for entry in each of the three files, with each of the three copies bearing a signature, and containing identifying data for all three of the cases (*i.e*, the reissue Application No. and the reexamination proceeding Control Nos.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be modified as follows. The reissue application will be held abandoned, and withdrawn from the merged proceeding. With respect to the merged reexamination proceedings, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, withdraw the reissue from the merged proceeding, and continue examination as to the merged reexamination proceedings.

Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improperly broadened claims) would be made by the examiner upon withdrawal of the reissue from the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the withdrawal of the reissue from the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

CONCLUSION

1. The above-identified reissue application and reexamination proceedings **ARE MERGED** into a single consolidated proceeding.

2. The reissue application file and the reexamination files are being forwarded to the Group Director of Technology Center 3700.

3. The examiner should immediately issue an Office action for the present merged proceeding of the reissue application and reexamination proceedings. All further examination should be conducted in accordance with Parts II and III of this decision.

4. Telephone inquiries related to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

April 17, 2003

#6
(mas)

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 6

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Enclosure: Third Party Paper filed March 30, 2001

MAILED

JUN 11 2001

REEXAM UNIT

In re Henderson
Reexamination Proceeding
Control No. 90/005,599
Filed: December 24, 1999
For: U.S. Patent No. 5,364,845

DECISION DISMISSING PETITION AND RETURNING IMPROPER SUBMISSION

This is a decision on the March 30, 2001, third party requester petition filed under 37 C.F.R. § 1.181(a)(3), to invoke the supervisory authority of the Commissioner to mandate disclosure by Henderson of all information discovered in *Nutramax Laboratories, Inc. V. Twin Labs, et al.*, (DC Baltimore, MD, CASE NO.: CIV-B-97-787) that is material to the patentability of U.S. Patent No. 5,364,845; and/or under 37 C.F.R. § 1.182, to invoke the supervisory authority of the Commissioner to strike U.S. Patent No. 5,364,845; and/or under 37 C.F.R. § 1.183, to waive the rules to permit the requester to participate in the reexamination of U.S. Patent No. 5,364,845.

It should be noted that 37 C.F.R. § 1.4(c) states:

> **§ 1.4 Nature of correspondence and signature requirements.**
>
> (c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

The present petition requests relief under three different rules, which technically should have been presented in three different papers pursuant to 37 C.F.R. § 1.14(c). However, in the interest of expediency, these requests for relief have been treated and addressed in the form of a single three-part petition decision as follows below.

The petition fee of $130 pursuant to 37 C.F.R. § 1.17(h) for the petition under 37 C.F.R. § 1.182 has been paid by check. The petition fee of $130 pursuant to 37 C.F.R. § 1.17(h) for the petition under 37 C.F.R. § 1.183 has also been paid by check.

The third party requester petition is before the Office of Patent Legal Administration for decision.

For the reasons set forth below, the petition is **dismissed**, and the papers are being returned as an improper submission.

REVIEW OF FACTS

1. U.S. Patent No. 5,364,845 issued to Henderson on November 15, 1994.

2. On December 24, 1999, a request for reexamination of the '845 patent was filed by a third party requester, which proceeding was assigned control no. 90/005,599.

3. Reexamination was ordered in the '5599 proceeding on February 10, 2000.

4. On March 30, 2001, third party requester filed the present petition under 37 C.F.R. § 1.181(a)(3), to invoke the supervisory authority of the Commissioner to mandate disclosure by Henderson of all information discovered in *Nutramax Laboratories, Inc. V. Twin Labs, et al.*, (*supra*), that is material to the patentability of U.S. Patent No.

5,364,845; and/or under 37 C.F.R. § 1.182 , to invoke the supervisory authority of the Commissioner to strike U.S. Patent No. 5,364,845; and/or under 37 C.F.R. § 1.183, to waive the rules to permit the requestor to participate in the reexamination of U.S. Patent No. 5,364,845.

DECISION

Under 37 C.F.R. § 1.540:

> ... No submissions other than the statement pursuant to § 1.530 and the reply by the requester pursuant to § 1.535 will be considered prior to examination.

The March 30, 2001, third party requester petition to mandate disclosure by Henderson; to strike the '845 patent; and to permit third party requester participation was filed prior to the start of the examination on the merits. Accordingly, the March 30, 2001, third party requester petition is **dismissed** as being an improper submission under § 1.540 and is being returned.

Part I. Petition under 37 C.F.R. § 1.181(a)(3)

With regard to third party requester's petition under 37 C.F.R. § 1.181(a)(3), to invoke the supervisory authority of the Commissioner to mandate disclosure by Henderson of all information discovered in *Nutramax Laboratories, Inc. V. Twin Labs, et al.*, (*supra*), that is material to the patentability of U.S. Patent No. 5,364,845, it should be noted that there is a continuing duty of disclosure requirement pursuant to 37 C.F.R. § 1.555, which states (in part):

> (a) . . . Each individual associated with the patent owner in a reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding. The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding until the claim is canceled. Information material to the patentability of a canceled claim need not be submitted if the information is not material to patentability of any claim remaining under consideration in the reexamination proceeding.

> The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible. . .

However, it should also be noted that part (c) of this same section states:

> (c) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.552(c).

Accordingly, the duty of disclosure issue raised by petitioner will not be addressed in the present reexamination.

Note however, that 37 C.F.R. § 1.165(a) states (in part):

> (a) In an *ex parte* reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, *inter partes* reexaminations, or litigation and the results of such proceedings. . .

And MPEP § 2282 indicates that:

> ". . . the Office will, at any time, accept for placement in the patent file copies from any parties of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent. Persons making such submissions must limit the submissions to the notification, and must not include further arguments or information. Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office."

Since the instant petition papers are not limited to bare notice

of the prior or concurrent proceedings, they do not qualify for entry into the patent file pursuant to MPEP § 2282, and therefore the petition under 37 C.F.R. § 1.181(a)(3), to invoke the supervisory authority of the Commissioner to mandate disclosure by Henderson of all information discovered in *Nutramax Laboratories, Inc. V. Twin Labs, et al.*, (*supra*) is **dismissed**, and the papers are being returned by the Office. However, if the litigation information were resubmitted in the **proper form**, i.e., **limited to bare notice** of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent, it would be entered in the patent file in accordance with MPEP § 2282.

Part II. Petition under 37 C.F.R. § 1.182

Concerning third party requester's petition under 37 C.F.R. § 1.182, to invoke the supervisory authority of the Commissioner to strike U.S. Patent No. 5,364,845, for the failure of disclosure of all information material to the patentability of the '845 patent, the rules no longer provide for the USPTO to address duty of disclosure issues. The responsibility for compliance with the duty of disclosure requirement rests upon the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. No evaluation will be made by the Office in the reexamination proceeding as to compliance with § 1.555. If questions of compliance with § 1.555 are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.552(c). Therefore, the petition under 37 C.F.R. § 1.182 , to invoke the supervisory authority of the Commissioner to strike U.S. Patent No. 5,364,845 is **dismissed**, and the papers are being returned by the Office.

Part III. Petition under 37 C.F.R. § 1.183

With respect to third party requester's petition under 37 C.F.R. § 1.183, to waive the rules to permit the requestor to participate in the reexamination of U.S. Patent No. 5,364,845, it should be noted that 37 C.F.R. § 1.550 states:

> (g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submission on behalf of any third parties will be acknowledged or considered unless such submissions are:
> (1) in accordance with § 1.510 or § 1.535; or
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.
>
> (h) Submissions by third parties, filed after the date of the

order for *ex parte* reexamination pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a).

The present third party petition is not a request for reexamination in compliance with the requirements of § 1.510 and is not a submission that was entered in the patent file prior to the date of the order to reexamine pursuant to § 1.525. Nor does the petition qualify as a prior art statement under § 1.501. Therefore, the third party requester's petition of March 30, 2001, is an improper submission under § 1.550(e) and is not subject to entry and consideration.

The assertions in the petition are clearly directed to the issues and merits of the reexamination proceeding. However, neither the rules not any provision of the statute provide authority for a third party to file comments directed to the issues and merits of a reexamination proceeding. *In re Amp, 212 USPQ 826* (Comr. Pats. 1981). Such comments by third parties are precluded, since the examination of a reexamination proceeding is *ex parte*. A waiver of the rules would be necessary to provide the relief requested in the instant petition to permit the entry of the third party comments directed to the issues and merits of the reexamination proceeding. However, a waiver of the rules to permit such a third party submission would not be justified in view of the intent of the legislation and rules to make reexamination an *ex parte* proceeding. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office, 11 USPA2d 1866, 1869* (Fed. Cir. 1989) (third parties do not participate before the USPTO).

Accordingly, a waiver of the rules will not be granted, and the present petition remains an improper submission under 37 C.F.R. § 1.550(e), and is not subject to entry and consideration. As an improper submission under 37 C.F.R. § 1.550(e), the third party petition under 37 C.F.R. § 1.183, to waive the rules to permit the requestor to participate in the reexamination of U.S. Patent No. 5,364,845 is **dismissed**, and the papers are being returned to the third party requester. The present decision will be made of record in the reexamination file.

CONCLUSION

1. The third party requester petition filed March 30, 2001, under 37 C.F.R. § 1.181(a)(3), to mandate disclosure by Henderson; and/or under 37 C.F.R. § 1.182 , to strike the '845 patent; and/or under 37 C.F.R. § 1.183, to permit third party requester participation is dismissed.

2. The petition papers are being returned to the requester as an improper submission.

3. The reexamination file is being forwarded to the examiner assigned to the reexamination proceeding for issuance of a first Office action in due course not inconsistent with this decision.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza, Special Projects Examiner, at (703) 308-0255.

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

June 7, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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RALPH J MANCINI (For Patent Owner)
Akzo America Inc.
Patent And Trademark Department
7 Livingstone Avenue
Dobbs Ferry, NY 10522

MAILED
MAY 0 7 2003
REEXAM UNIT

HOWARD C. MISKIN, (For Requester)
Stoll, Miskin, Hoffman & Badie
350 Fifth Avenue
Empire State Building, Suite 4710
New York, NY 10118

Decision Mailed

In re Steeghs :
Reexamination Proceeding : **DECISION**
Control No. 90/005,602 : **GRANTING**
Filed: December 30, 1999 : **PETITION**
For: U.S. Patent No. 5,372,628 :

This is a decision on the January 22, 2003, patent owner "PETITION UNDER 37 C.F.R. § 1.313 TO REOPEN PROSECUTION ON THE MERITS." The provisions of 37 CFR 1.313 apply to an application for patent and not to a reexamination proceeding. Accordingly, the petition is being taken as a petition under 37 CFR 1.182 to withdraw the present reexamination from the certificate publication process and reopen prosecution in the proceeding. The petition is before the Office of Patent Legal Administration for decision.

The petition fee set forth in 37 CFR 1.17(h) for both a petition under 37 CFR 1.313 and a petition under 37 CFR 1.182 is $130.00. The $130.00 petition fee paid with the filing of the present petition under 37 CFR 1.313 is accordingly applied as the fee for deciding the present petition under 37 CFR 1.182.

The petition is granted for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,372,628 (the '628 patent) issued to Steeghs on December 13, 1994.

2. On December 30, 1999, a request for reexamination of the '628 patent was filed by a third party requester. It was assigned Control No. 90/005,602 (the '5,602 proceeding).

3. On February 23, 2000, reexamination was ordered in for '5,602 proceeding.

4. Prosecution progressed in the '5,602 proceeding to the point where a Notice of Intent to Issue Reexamination Certificate (NIRC) was issued by the examiner on December 11, 2002. In the NIRC, claims 1, 3-11, 13 and 14 were found to be patentable as amended, and new claims 15 and 17-19 (renumbered as claims 15-18) were found to be patentable. Patent claims 2 and 12 were canceled.

5. On January 22, 2003, the patent owner filed the present petition requesting reopening of the prosecution to enter and consider an amendment of claims 1 and 17 [1] filed together with the petition, i.e., filed subsequent to the NIRC mailed December 11, 2002.

6. The present proceeding was then withdrawn from the publication cycle for consideration of the petition. The proceeding was, however, erroneously listed in the *Official Gazette* on March 18, 2002, and assigned Reexamination Certificate No. B1 5,372,628. The withdrawal of the present proceeding occurred too late for the physical removal of the erroneous listing in the *Official Gazette*.

---

[1] Claim 17 is the working number of the claim that was renumbered when the NIRC was issued. For purposes of prosecution, the working numbers of the claims will be used.

DECISION

In the petition, it is urged that the submitted amendment is necessary to prevent impermissible broadening of the claims. The case was referred to the patent examiner having charge of the proceeding, and he concurs that there is indeed enlargement of the scope of the patent claims in violation of 35 U.S.C. 305. In view of the statutory prohibition against enlargement of the scope of the patent claims in a reexamination, it is appropriate that the submitted amendment be addressed, and the proceeding be considered by the examiner.

The petition is **granted**.

REQUIREMENT FOR HOUSEKEEPING AMENDMENT

The proposed amendment which accompanies the present petition is not in conformance with the amendment format for reexamination proceedings which is set forth in 37 CFR 1.530:

Pursuant to 37 CFR 1.530(i), "[a]ll amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination." The amendment accompanying the present petition fails to completely underline claim 17; yet, the entirety of claim 17 is new with respect to the patent claims that were in effect as of the date of filing the present request for reexamination. Further, in claim 1, "in a dispersion" should not have been underlined, since it is present in the printed patent; and, in addition, the 37 CFR 1.530(f) "markings" are otherwise not made relative to the patent claims in effect as of the date of filing the request for reexamination. Also, the amendment should include a parenthetical expression "amended," "twice amended," *etc.*, following the original claim number, pursuant to 37 CFR 1.530(d)(2)(i)(C). Finally, the amendment to the claims should be submitted as a separate amendment paper, with the marked-up amended/new claims presented at the beginning of the paper. A clean copy of the claims should not be included.

Accordingly, in response to this decision, petitioner is required to submit a housekeeping amendment which complies with 37 CFR 1.530, within **one (1) month** of the mailing date of this decision granting the petition.

ERRONEOUS LISTING OF REEXAMINATION CERTIFICATE IN THE *OFFICIAL GAZETTE*

The above-identified reexamination proceeding was erroneously listed in the *Official Gazette* on March 18, 2002, and assigned Reexamination Certificate No. B1 5,372,628, notwithstanding the fact that the proceeding had been withdrawn from the publication cycle. The withdrawal of the proceeding occurred too late for physical removal of the erroneous listing in the *Official Gazette*. An appropriate erratum will be published in the *Official Gazette* in due course.

CONCLUSION

1. The petition is **GRANTED**.

2. A housekeeping amendment pursuant to the requirement set forth above must be filed within ONE (1) MONTH of the mailing date of this decision.

3. The reexamination file is being returned to Technology Center 1700 to await the filing of the above-required housekeeping amendment, or the expiration of the time for filing same. The examiner will then consider the patent owner's amendment of the claims (and the proceeding as a whole), and the examiner will reopen prosecution, issue a supplemental NIRC, or take whatever other action is deemed appropriate, consistent with this decision.

4. In due course, an appropriate erratum will be publish in the *Official Gazette* stating that the present reexamination proceeding was erroneously listed in the *Official Gazette* and assigned a reexamination certificate number.

5. The reexamination file is being returned to Technology Center 1700 for action not inconsistent with this decision.

6. Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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May 7, 2003

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,603	12/30/99	5575925	6014-6

IM62/1013

WILLIAM F. WESTERMAN
ARMSTRONG, WESTERMAN, HATTORI, MCLELAND
1725 K STREET N.W.
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EXAMINER
POPOVICS,R

ART UNIT	PAPER NUMBER
1723	11

DATE MAILED: 10/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)
1- File Copy
U.S. G P O 2000 ; 465-188/25266

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WASHINGTON, D.C. 20231
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CST

Mailed: Paper Number ___

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(for Third Party)

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202 Delaware Building
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(for Third Party)

In re Logue, Jr.
Reexamination Proceeding
Control No. 90/005,603
Filed: December 30, 1999
For: U.S. Patent No. 5,575,925

In re Logue, Jr.
Reexamination Proceeding
Control No. 90/005,652
Filed: February 29, 2000
For: U.S. Patent No. 5,575,925

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technical Center 1700 for consideration of the merger of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 5,575,925, issued November 19, 1996, is the subject of Reexamination Control Nos. 90/005,603 and 90/005,652.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,603 ('603), was filed December 30, 1999 by Scott A. Schaffer of Marger Johnson & McCollom, 1030 SW Morrison Street, Portland, OR 97205. The request urged that a substantial new question of patentability was raised by the teachings of the flyer "Metal-Era Inlet Basket" by Metal-Era, Inc.; the Soil Erosion Control Plan for Milwaukee, Wisconsin; and "Wisconsin Construction Site Best Management Practice Handbook", a publication from the Wisconsin Department of Natural Resources.

3. A second request for reexamination, assigned Reexamination Control No. 90/005,652 ('652), was filed February 29, 2000 by John D. Gugliotta, 202 Delaware Building, 137 South Main Street, Akron, OH 44308. The request urged that a substantial new question of patentability was raised by the teachings of the flyer "Metal-Era Inlet Basket" by Metal-Era, Inc.; the Soil Erosion Control Plan for Milwaukee, Wisconsin; and "Wisconsin Construction Site Best Management Practice Handbook", a publication from the Wisconsin Department of Natural Resources.

4. Reexamination was ordered for '603 on March 3, 2000.

5. Reexamination was ordered for '652 on April 13, 2000.

6. A first Office action for '603 was mailed on June 14, 2000 and contained the rejection of claims 10-11 under 35 U.S.C. 102(b) as being anticipated by the Wisconsin Construction Site Best Management Practice Handbook; and the rejection of claim 12 under 35 U.S.C. 102(b), as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Wisconsin Construction Site Best Management Practice Handbook. The patentability of claims 1-9 and 13-15 was confirmed.

7. Patent owner responded to the first Office action with a timely RESPONSE TO OFFICE ACTION IN REEXAMINATION on July 14, 2000.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> "If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under 37 C.F.R. 1.570."

As noted in the above review of facts, reexamination has been ordered in each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c)

is appropriate. The MPEP Chapter 2283, further sets forth:

> "If the second request is based upon essentially the same patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as those raised in the first request, and if reexamination is ordered, the examination of the merged proceeding will continue at the point reached in the first reexamination proceeding. If, however, new patents or printed publications are presented in the second request which raise different questions than those raised in the first request, then prosecution in the merged reexamination proceeding will be reopened, if applicable, to the extent necessary to fully treat the questions raised."

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/005,603 and 90/005,652 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. REQUIREMENTS FOR SAME AMENDMENTS IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims and specification in both files. Since the claims are the same in both files, a "housekeeping amendment" is NOT needed. See MPEP 2282, under "Merger of Reexaminations".

III. CONDUCT OF MERGED PROCEEDING

Since the same prior art was cited in each request for reexamination, the merged reexamination proceeding shall proceed from the point reached in the '603 reexamination, i.e. consideration of the RESPONSE TO OFFICE ACTION IN REEXAMINATION, submitted July 14, 2000 in the '603 proceeding. The reexamination files shall be forwarded to the examiner for consideration of the REQUEST FOR REEXAMINATION in the '652 reexamination proceeding, as well as consideration of the RESPONSE TO OFFICE ACTION IN REEXAMINATION, submitted July 14, 2000 in the '603 reexamination proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature and identifying data for all files, for entry into each file. All correspondence from the PTO will be addressed to the patent owner's representative address listed in the

Reexamination Control No. 90/005,603 and No. 90/005,652 as:

William F. Westerman
Armstrong, Westerman, Hattori, McLeland
& Naughton
1725 K Street, NW
Suite 1000
Washington, DC 20006

CONCLUSION

Reexamination Control Nos. 90/005,603 and 90/005,652 are merged. The files shall be forwarded to the examiner for consideration of the Patent Owner's response of July 14, 2000, as well as consideration of the issues raised by the Request for Reexamination in 90/005,652 of February 29, 2000. An Office action shall follow in due course.

Jerome W. Massie, Director (Acting)
Technology Center 1700
Chemical and Materials Engineering